

**CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

DECISION

Domain Name: thedeckstoreinc.ca

Complainant: The Deck Store Inc.

Registrant: 1527977 Ontario Inc. o/a Deck Masters of Canada

Registrar: Tucows.com Co.

Service Provider: ResolutionCanada Inc.

Panelists: Eric Macramalla (Chair), Paul Braunovan and Alessandro Colonnier

A. THE PARTIES

1. The Complainant is The Deck Store Inc. (the “Complainant”).
2. The Registrant is 1527977 Ontario Inc. o/a Deck Masters of Canada (the “Registrant”).

B. DISPUTED DOMAIN NAME & REGISTRAR

3. The disputed domain name is thedeckstoreinc.ca (the “Domain Name”) and the Registrar is Tucows.com Co.

C. PROCEDURAL HISTORY

4. This is a dispute resolution proceeding initiated pursuant to the *CIRA Domain Name Dispute Resolution Policy* (the “Policy”) and the *CIRA Policies, Rules, and Procedures - CIRA Domain Name Dispute Resolution Rules* (the “Rules”). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of this dispute pursuant to the Policy and the Rules.
5. The Complainant filed its complaint (the “Complaint”) on March 10, 2014. With a view to addressing relatively minor administrative deficiencies in the Complaint, including indicating the contact information for the Complainant’s representative, an amended complaint was filed on March 27, 2014. The Date of Commencement of the proceeding was March 28, 2014.
6. The Registrant’s response (“Response”) was filed on April 16, 2014. On April 30, 2014, an amended response was filed curing minor administrative deficiencies, including indicating the means by which the Provider should communicate with the Registrant.
7. On May 21, 2014, the Panel was appointed. As prescribed by the Policy, the Panel has declared to the Provider that it can act impartially and independently in connection with this matter, and that there are no circumstances known to the Panel which would prevent it from so acting.

D. CANADIAN PRESENCE REQUIREMENTS: ELIGIBILITY OF THE COMPLAINANT

8. The Complainant is incorporated pursuant to the laws of the Province of Ontario. The Panel is therefore satisfied that the Complainant is eligible to initiate these proceedings.

E. THE POSITIONS OF THE PARTIES

The Complainant's Position

9. As per the Ontario Corporate Profile Report, the Complainant was incorporated in the Province of Ontario on January 28, 2008. The Complainant is Ontario's "largest independent deck design, supplier and builder company with the only substantial indoor showrooms for Toronto, Oakville, Oshawa and Milton". It has approximately 72 employees comprised of "building crews, yard workers, experienced deck and landscape designers, outside and inside sales representatives for both residential and commercial sales".
10. A significant percentage of the Complainant's business is derived online through its website located at deckstore.ca.
11. The Registrant is a direct competitor of the Complainant. The Registrant's head office is located in Beeton, Ontario, which is approximately a one hour drive from the Complainant.
12. The Domain Name was registered on June 1, 2013 without the permission of the Complainant and made to resolve to the Registrant's website located at deckmasters.ca. Rather than hyperlink to deckmasters.ca, the Domain Name has maintained its gripping function and remains in the URL window once the end user arrives at the Registrant's website.
13. The Domain Name is confusingly similar with the trade name The Deck Store Inc. and the common law trade-mark THE DECK STORE. The Registrant does not have a legitimate interest in the Domain Name as it is not licensed, or otherwise authorized, to use the Complainant's trade name or trade-mark. The Registrant registered the Domain Name in bad faith in that it registered the Domain Name primarily for the purpose of disrupting the business of the Complainant, a competitor. Further, the Registrant registered the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement. The Complainant also alleges that the Registrant registered the Domain Name to sell for a profit and has also engaged in a pattern of unauthorized domain name registrations by virtue of its registration of the domain name thedeckstore.ca. With respect to this latter domain name, it was previously owned by the Registrant but has since been sold to a third party.
14. The Complainant has requested the transfer of the Domain Name.

The Registrant's Position

15. The Registrant is a former supplier of the Complainant and operates in the same field as the Complainant.
16. The Registrant owns several hundred domain names all related to the deck material supply business and has registered each in good faith in an effort to utilize them as part of their growth and marketing strategy. The Respondent "owns several domains that contain "deckstore" in several fashions including but not limited to inc, ltd, llc in an effort to reserve them for their planned future growth".
17. There are at least five (5) other businesses in the U.S. operating under the same name as the Complainant.
18. The Complainant should have purchased the Domain Name "back in 2008, or 09, or 10, or 11, or 12, or 13" if it was so valuable.
19. The Respondent was never made aware of the incorporation of the Complainant.
20. The Complainant owes the Respondent over \$19,000, and the "Respondent is open to transferring the domain in question to the Complainant once the outstanding bills, plus accrued interest are paid in full".
21. The Domain Name was not registered in bad faith and the Complainant's name does not give rise to enforceable rights by virtue of the coexistence of similar marks in the marketplace.
22. The Respondent is alleging reverse domain name hijacking and requesting \$3000.00 as compensation.

F. DISCUSSION & REASONS

23. In accordance with paragraph 4.1 of the Policy, to succeed in this proceeding, the Complainant must prove, on a balance of probabilities, that:
 - (a) the Registrant's Domain Name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights; and
 - (b) the Registrant has registered the domain name in bad faith as described in paragraph 3.5 of the Policy;

and the Complainant must provide some evidence that:
 - (c) the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.4 of the Policy.

CONFUSINGLY SIMILAR - PARAGRAPH 3.3

24. As per paragraph 3.2(a), a complainant may rely on its trade name or common law trade-mark rights when seeking to establish the requisite Rights as prescribed by the Policy.
25. Under the circumstances, the Panel accepts that the Complainant has rights in the trade name “The Deck Store Inc.” and the common law trade-mark THE DECK STORE. Further, the Panel accepts that these rights precede the June 1, 2013 registration of the Domain Name.
26. As per paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if the domain name so nearly resembles the mark in appearance, sound or in the ideas suggested by the mark so as to be likely to be mistaken for the mark.
27. Pursuant to paragraph 1.2 of the Policy, a domain name is defined as the second level domain (the portion that immediately precedes the dot-ca suffix).
28. The test to be applied when considering “confusingly similar” is one of first impression and imperfect recollection. The Complainant must prove, on a balance of probabilities, that a person, as a matter of first impression, knowing the Complainant’s corresponding marks only, and having an imperfect recollection of the marks, would likely confuse the Domain Name for the Complainant’s marks based upon the appearance, sound or the ideas suggested by the mark.
29. It should be noted that the test for confusion under the Policy is not the same test for confusion set out under the Canadian *Trade-marks Act*. Under the Section 6(5) of the *Trade-mark Act*, when assessing the likelihood of confusion between marks, the factors to consider are as follows: (a) the inherent distinctiveness of the marks and the extent to which they have become known; (b) the length of time the marks have been in use; (c) the nature of the wares, services, or businesses; (d) the nature of the trade; (e) the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them; and (f) the surrounding circumstances.
30. In contrast, the Policy provides that confusion is established if a domain name so nearly resembles a mark in appearance, sound or in the ideas suggested. This is similar to the test set out under Section 6(5)(e) of the *Trade-marks Act*. However, the remaining factors as set out under the *Trade-marks Act* do not apply to the assessment of confusion under the Policy. The Policy’s summary proceedings are ill-suited for the in-depth and traditional confusion analysis contemplated by the *Trade-marks Act*.
31. The Domain Name is identical to the trade name “The Deck Store Inc.” This by itself is sufficient to make a finding of confusion. Further, the Domain Name is confusing with the trade-mark THE DECK STORE given that they are nearly identical.

32. Under the circumstances, the Panel concludes that the Domain Name is confusingly similar with the Complainant's trade name and trade-mark, given that the Domain Name so nearly resembles the Complainant's marks in appearance, sound and in the ideas suggested so as to be likely to be mistaken for the marks.

Conclusion - Confusion

33. The Panel finds that the Complainant has satisfied the requirements enumerated under paragraph 3.1 of the Policy.

BAD FAITH REGISTRATION

34. The Complainant has alleged that the Domain Name was registered in bad faith pursuant to paragraphs 3.5(a), (b), (c) and (d).
35. The Panel concludes that the Complainant's claims do not support a finding of bad faith pursuant to paragraph 3.5(a). Specifically, there is no evidence that the Registrant acquired the Domain Name to sell for a profit.
36. The Panel also cannot conclude that the Registrant has engaged in a pattern of unauthorized domain name registrations. While the Registrant previously owned the domain name thedeckstore.ca, the Panel is not prepared to make a finding that these two domain names constitute a pattern of abusive registration in this particular circumstance. While two domain names may constitute a pattern as per paragraph 3.5(b), in this case the Panel does not feel it is necessary or appropriate to engage in an examination of whether this second domain name would properly give rise to a finding of bad faith, in light of the Panel's other findings of bad faith under paragraph 3.5(c) and 3.5(d) (discussed below).
37. In keeping with paragraph 3.5(c), the Panel notes that the Domain Name is identical to the Complainant's trade name and resolves to the Registrant's website, a direct competitor of the Complainant. Such use is likely to disrupt the business of the Complainant.
38. Under the circumstances, the Panel concludes that the registration of the Domain Name by the Registrant constitutes a straightforward case of cybersquatting pursuant to paragraph 3.5(c). The Panel also notes that the Registrant appears to have intended to disrupt the business of the Complainant. The Registrant has indicated that it would be "open to transferring" the Domain Name to the Complainant once the Complainant settles its debt with the Registrant. This declaration by the Registrant only reinforces a finding of bad faith.
39. The Panel also finds bad faith as per paragraph 3.5(d), namely that the Registrant has intentionally attempted to attract, for commercial gain, Internet users its website by creating a likelihood of confusion with the Complainant's mark as to the source or sponsorship. The Registrant is piggybacking on the Complainant's name with a view to redirecting Internet traffic to its site for commercial gain.

LEGITIMATE INTEREST

40. The final element to determine is whether the Registrant has a legitimate interest in the Domain Name.
41. As per paragraph 4.1 of the Policy, the Complainant must provide “some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.4”.
42. Once this onus has been discharged by the Complainant, the Registrant may still succeed if it can show, on a balance of probabilities, that it has a legitimate interest in the Domain Name pursuant to paragraph 3.4.
43. Based upon the foregoing, the Complainant has met its burden to show some evidence that the Registrant has no legitimate interest.
44. In the view of the Panel, and with regard to the evidence, the Registrant does not meet any of the circumstances listed in paragraph 3.4 of the Policy. The Registrant’s registration and use of the Domain Name cannot be said to be *bona fide* in nature and was designed to disrupt the Complainant’s business. Further, the Domain Name cannot be said to be descriptive or generic. The purpose behind the registration was both transparent and ill-conceived.
45. Under the circumstances, the Panel is of the view that the Registrant has failed to satisfy the onus under paragraphs 4.1(c) and 3.4 of the Policy.
46. Accordingly, the Panel finds that the Registrant does not have a legitimate interest in the Domain Name.

DECISION & ORDER

47. For the reasons set out herein, the Panel decides this dispute in favour of the Complainant.
48. Pursuant to paragraph 4.3 of the Policy, the Panel orders the transfer of the domain name thedeckstoreinc.ca to the Complainant.

Dated at Ottawa, Ontario, Canada, this 16th day of June, 2014.



Eric Macramalla (Chair) for the Panel
Paul Braunovan
Alessandro Colonnier