



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE
DOMAIN NAME DISPUTE
ADMINISTRATIVE PANEL
DECISION

CIIDRC case number:	20804-CDRP	Decision date: September 18, 2023
Domain Name:	Vacuumspecialists.ca	
Panel:	Ivett Paulovics	
Complainant:	Vacuum Specialists (1985) Ltd.	
Complainant's representative:	Elizabeth S. Dipchand of Dipchand LLP	
Registrant:	Terry Smith	

1. PROCEDURAL HISTORY

The procedural history of this case was set out in a letter from the Canadian International Internet Dispute Resolution Centre (CIIDRC) to the Panel:

1. On July 6, 2023, Ms. Dipchand filed a Complaint on behalf of the Complainant, Vacuum Specialists (1985) Ltd, pursuant to the CDRP and the Resolution Rules. The identity of the Registrant is not published in the public WHOIS database; therefore, the Registrant's name was not included in the Complaint.
2. On July 6, 2023, CIRA was notified of this proceeding. On the same date, CIRA transmitted by email to CIIDRC its verification response informing who is the Registrant of the disputed domain name. CIRA also confirmed that the disputed domain name was placed on a Registrar LOCK.
3. As permitted by section 11.1 of the CIRA Domain Name Dispute Resolution Rules Version 1.5, counsel for the Complainant made further submission by revising its Complaint and including the Registrant's name to the Complaint.
4. On July 18, 2023, CIIDRC, as Service Provider, confirmed compliance of the Complaint and commencement of the dispute resolution process.
5. The Registrant failed to file its Response by the due date of August 8, 2023.

Domain Name: vacuumspecialists.ca
20804-CDRP

6. The Complainant in this administrative proceeding has elected for a Panel consisting of a single-member.
7. On August 28, 2023, CIIDRC appointed Ivett Paulovics as a single-member Panel.

The Domain Name was registered on February 6, 2021 by Terry Smith, an individual residing in Calgary, Alberta.

This matter is conducted pursuant to the Canadian Dispute Resolution Policy (CDRP) and the Canadian Dispute Resolution Rules (Resolution Rules) of the Canadian Internet Registry Authority (CIRA).

2. FACTS ALLEGED BY THE PARTIES

The Complainant has been in the business of selling vacuums, vacuum accessories and cleaning products for residential homes and commercial businesses since the 1970's, prior to incorporating in 1985. Since its inception, the Complainant has operated three physical store locations in and around the greater Calgary area. As well, it operates an online retail store at the URL vacuumspecialists.com that distributes to customers across Canada.

Over their forty years in business, the Complainant established itself as a leader in their respective market. It is the exclusive dealer of several major brands of central and portable, residential and commercial vacuums. As well, the Complainant is the exclusive suppliers to numerous major builders in the Calgary-area.

The Complainant has been extensively and continuously using the trade name VACUUM SPECIALISTS and the associated trademarks since 1985. In or around August 23, 2022, the Complainant filed an application for trademark registration of the VACUUM SPECIALISTS design mark no. 2205515 in Nice Classes 7, 35, 37. Through its continuous 40 years of use, the Complainant has also acquired common law trademark rights in the name VACUUM SPECIALISTS.

The Complainant is also owner of the domain name <vacuumspecialists.com>, registered since 1997 and used to offer the Complainant's products and services.

The Domain Name was registered on February 6, 2021 and hosts a landing page. The Registrant of the Domain Name is an individual named Terry Smith, a resident of Calgary, Alberta. The Registrant of the Domain Name is the owner of one of the Complainant's competitors and is well aware of the Complainant, its business and trademarks.

3. CONTENTIONS OF THE PARTIES

- **Complainant**

The Complainant asserts that the Domain Name satisfies the three touchstones of the CDRP. First, the Complainant submits that the Domain Name is confusingly similar to a mark in which the Complainant had rights prior to registration of the Domain Name and continues to have rights. Furthermore, the Complainant

Domain Name: vacuumspecialists.ca

20804-CDRP

asserts that the circumstances are such the Registrant has no legitimate interest in the Domain Name, and, as well, that the Domain Name was registered in bad faith per the purpose of the CDRP.

- **Registrant**

No Response has been filed by the Registrant.

- **Remedy Sought**

The Complainant requests the Domain Name be transferred to it.

4. DISCUSSION AND FINDINGS

4.1 Eligibility

Paragraph 1.4 of the CDRP requires that the Complainant, at the time of the initiation of the Complaint, must satisfy CIRA's Canadian Presence Requirements for Registrants (CPR) unless the Complaint relates to a trademark registered in the Canadian Intellectual Property Office (CIPO) and the Complainant is the owner of that trademark. Paragraph 2.4 of the CPR provides that "A corporation under the laws of Canada or any province or territory of Canada" satisfies those requirements. The evidence before the Panel is that the Complainant has been incorporated under the laws of the Province of Alberta since 1986. Accordingly, the Panel finds that the Complainant is an eligible complainant under paragraph 1.4 of the CDRP.

4.2 Requirements

In accordance with Paragraph 4.1 of the CDRP, to succeed in the proceeding, the onus is on the Complainant to prove, on the "balance of the probabilities", that:

- The 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
- The Domain Name has been registered in bad faith as described in paragraph 3.5;

and the Complainant must provide some evidence that:

- The Registrant has no legitimate interest in the Domain Name as described in paragraph 3.4.

The Panel will consider each of these requirements in turn.

4.3 Analysis

Despite the Registrant did not provide a Response, this Panel, in accordance with Paragraphs 5.8 and 9.1 of the Resolution Rules, after performed a careful and detailed review of the facts and evidence submitted by the Complainant in this case, finds that the Complaint shall be denied for the reasons described below.

Domain Name: vacuumspecialists.ca

20804-CDRP

4.3.1 That the Domain Name is Confusingly Similar to a Mark in which the Complainant has Rights

Under Paragraph 3.2 of the CDRP, a “Mark” is:

- (a) a trade-mark, including the word elements of a design mark, or a trade name that has been used in Canada by a person, or the person’s predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person;
- (b) a certification mark, including the word elements of a design mark, that has been used in Canada by a person or the person’s predecessor in title, for the purpose of distinguishing wares or services that are of a defined standard;
- (c) a trade-mark, including the word elements of a design mark, that is registered in CIPO; or
- (d) the alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of which the Registrar of Trade-marks has given public notice of adoption and use pursuant to paragraph 9(1)(n) of the Trade-marks Act (Canada).

In this case, the Complainant relies on:

- the trade name “VACUUM SPECIALISTS (1985) LTD”;
- the Canadian trademark application “VACUUM SPECIALISTS” (design) no. 2205515 filed at CIPO on August 23, 2022 in Nice Classes 7, 35, 37;
- the common law trademark “VACUUM SPECIALISTS”.

To this end, Complainant provides the following documents:

- Certificate of Incorporation of “VACUUM SPECIALISTS (1985) LTD” dated January 24, 1986 (see Annex B);
- Printout from the CIPO database of the Canadian trademark application “VACUUM SPECIALISTS” (design) no. 2205515 filed on August 23, 2022 in Nice classes 7, 35, 37 (see Annex C);
- Printout of the portal “BlueOcean Interactive Marketing” (see Annex D);
- 2 pages of undated screenshots of the website content associated with the domain name <vacuumspecialists.com> (see Annex E).

The Complainant’s trade name

The Panel concludes that the Complainant has established that it had rights in the trade name “VACUUM SPECIALISTS (1985) LTD” since 1986, thus, prior to the date of registration of the Domain Name (February 6, 2021) and continues to have such rights. The trade name “VACUUM SPECIALISTS (1985) LTD” qualifies as “Mark” under paragraph 3.2(a) of the CDRP.

The Complainant’s trademark application

Domain Name: vacuumspecialists.ca
20804-CDRP

Since the trademark application “VACUUM SPECIALISTS” was filed on August 23, 2022, one year and half after to the date of registration of the Domain Name (February 6, 2021), and has not been registered yet, the Complainant has not established that it had rights in such mark prior to the date of registration of the Domain Name under Paragraph 3.1(a) of the CDRP, and that such mark qualifies as “Mark” under Paragraph 3.2(c) of the CDRP.

The Complainant’s common law trademark

The Complainant asserts that it “has been in the business of selling vacuums, vacuum accessories and cleaning products for residential homes and commercial businesses since the 1970’s, prior to incorporating in 1985. Since its inception, Vacuum Specialists have operated three physical store locations in and around the greater Calgary area. As well, they operate an online retail store at the URL vacuumspecialists.com that distributes to customers across Canada”. Moreover, the Complainant asserts that: “Over their forty years in business, Vacuum Specialists established themselves as a leader in their respective market. They are the exclusive dealer of several major brands of central and portable, residential and commercial vacuums. As well, Vacuum Specialists are the exclusive suppliers to numerous major builders in the Calgary-area”. Finally, the Complainant contends that it “has been extensively and continuously using the trade name VACUUM SPECIALISTS and the associated trademarks since 1985. In or around August 23, 2022, the Complainant filed for trademark registration of their VACUUM SPECIALISTS design mark (the “Design Mark”). Through its continuous 40 years of use, the Complainant has also acquired common law trademark rights in the name VACUUM SPECIALISTS (the “Word Mark”; together with the Design Marks, known as the “Marks”).”

Referring to the UDRP system as an analogue for this issue, to establish common law trademark rights, a complainant must demonstrate the mark has achieved strong secondary meaning in the minds of consumers, i.e., that it has become a distinctive identifier which consumers associate with the complainant’s goods and services (see Section 1.3 WIPO Jurisprudential Overview 3.0). Relevant evidence demonstrating such acquired distinctiveness includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys. Specific evidence supporting assertions of acquired distinctiveness should be submitted with the complaint (see also Slater Vecchio LLP. V. Mullen, BCICAC Case No. DCA-2143-CIRA (Nov. 11, 2019), at page 5. “Specific evidence supporting assertions of distinctiveness should be included in the complaint). Conclusory allegations of common law rights are insufficient to show secondary meaning/acquired distinctiveness.

The Panel determines that the Complainant failed to prove that it has common law rights in the “VACUUM SPECIALISTS” trademark. The evidence submitted by the Complainant is inadequate to prove those rights, because:

1. The Certificate of Incorporation provides only proof of the existence of the Complainant (“VACUUM SPECIALISTS (1985) LTD” since 1986, but nothing else on “the continuous 40 years of use” of its trademarks.
2. The copy of the Complainant’s trademark application of the design mark “VACUUM SPECIALISTS” shows that the application dates back August 2022.
3. The 2-page undated screenshots of the Complainant’s website contain a few information about the Complainant and its products and services which is clearly autoreferential. It is also not clear how long has the Complainant’s website or that website content been online.
4. The document defined by the Complainant as copy of the registration of the domain name <vacuumspecialists.com> does not make any reference to such domain name. Even accepting that such domain name has been registered by the Complainant since September 2017, the Complainant has not showed that it has been used since such date or any other date with reference to any active website.

Having been in business for over 40 years, the Complainant could have easily provided specific evidence of its above-mentioned assertions. However, no any figure on the amount of sales, any promotional material in specialized journals, any recognition by the Complainant’s industry or by the consumers, any consumer survey or any other evidence has been provided to support the Complainant’s conclusory allegations. In absence of additional materials supporting the Complainant’s allegations, the Panel cannot accept the Complainant’s statements of having common law rights in the “VACUUM SPECIALISTS” trademark.

Confusing similarity

Now, the Panel turns to assess the identity or confusing similarity between the Complainant’s Mark (i.e. the “VACUUM SPECIALISTS (1985) LTD” trade name) and the Domain Name.

Paragraph 3.3 of the CDRP states that: “In determining whether a domain name is “Confusingly Similar” to a Mark, the Panel shall only consider whether the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark”. CDRP panels agree that confusion will be established when the domain name incorporates the entirety or at least the distinctive element of the complainant’s mark. Where the relevant trademark is recognizable within the domain name, adding, deleting, or substituting letters or numbers will not preclude a finding of confusing similarity. Furthermore, Paragraph 1.2 of the CDRP makes it clear that the “.ca” suffix is to be disregarded in determining confusing similarity of the Domain Name to the Mark.

In assessing confusing similarity in this matter, the Panel finds that the Domain Name incorporates the entirety of the Complainant’s trade name “VACUUM SPECIALISTS (1985) LTD” and differs from such Mark by merely deleting the number “1985” (which refers to the date of incorporation of the Complainant) and the letters “LTD” (which is the abbreviation of “Limited”, the form of the corporate structure of the Complainant).

Accordingly, the Panel finds that the Complainant has met its burden of proof with respect to paragraph 3.1(a) of the CDRP and the Domain Name is confusingly similar to the Mark in which the Complainant has rights.

4.3.2 That the Registrant has Legitimate Interest in the Domain Name

To succeed in the Complaint, Paragraph 4.1 of the CDRP requires that the Complainant provides some evidence that the Registrant has no legitimate interest in the Domain Name as described in Paragraph 3.4. For this, Paragraph 3.4 of the CDRP provides a non-exhaustive list of circumstances, which, if found to be proved upon evaluation of all evidence presented, shall demonstrate that the Registrant does have a legitimate interest in the Domain Name.

They are as follows:

- (a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;
- (b) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of: (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;
- (c) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;
- (d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;
- (e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or
- (f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

In Paragraph 3.4(d) of the CDRP "use" by the Registrant includes, but is not limited to, use to identify a web site.

The Registrant of the Domain Name is Terry Smith, an individual residing in Calgary, Alberta.

The Complainant asserts that: "The Registrant is a known competitor of the Complainant who operate concurrently in Alberta. They cater to the same client base and are well aware the Marks are an important asset of the Complainant, which reflect Vacuum Specialists' goodwill and stellar reputation as a leader in its respective industry".

There is no specific evidence before the Panel provided by the Complainant that supports the Complainant's allegations, i.e. that the Respondent is a competitor of the Complainant; the Respondent is aware of the Complainant's Mark; the Complainant's Mark enjoys reputation; and the Respondent has targeted the Complainant's Mark.

The Complainant has only provided a screenshot of the website associated to the domain name <superiorvacuums.ca>. However, the Complainant has not proved that such domain name is related to the Respondent and/or the Respondent is owner of whatever company which is a competitor of the Complainant.

The Domain Name consists of the generic English words "vacuum" and "specialists", descriptive of the character or quality of the wares, services or business, and the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business. On the other hand, as mentioned above, the Complainant has not proved by strong and rigorous evidence that its Mark has become a distinctive identifier which consumers associate with the Complainant's goods and services.

The screenshots of the website submitted by the Complainant evidence that the Domain Name is used by the Respondent to host a parking page. Links to "Related searches" shown on that page include "Hand Vacuum Pump", "Cleaning Service", "Cordless Vacuum" and do not mention at all the Complainant or its Mark. According to this Panel, such use of the Domain Name, consisting in dictionary and descriptive words, is consistent with the Respondent's legitimate interest under Paragraph 3.4(b) of the CDRP. The Panel is unconvinced (since no specific evidence has been provided by the Complainant to show the contrary) that the Domain Name is capitalizing on the reputation and goodwill of the Complainant's Mark (which reputation and goodwill also have not been demonstrated by the Complainant).

Accordingly, the Panel finds that the Complainant has not met its burden of proof with respect to paragraph 3.1(b) of the CDRP and the Registrant has legitimate interest in the Domain Name.

4.3.3 that the Registrant has Not Registered the Domain Name in Bad Faith

Paragraph 3.5 of the CDRP provides a non-exhaustive list of circumstances, which, if found to be present, shall evidence that the Registrant has registered the Domain Name in bad faith:

- (a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration;
- (b) the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone or in concert with one or more additional persons has

- engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names;
- (c) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant; or
 - (d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

The Complainant asserts that "Over their forty years in business, Vacuum Specialists established themselves as a leader in their respective market. They are the exclusive dealer of several major brands of central and portable, residential and commercial vacuums. As well, Vacuum Specialists are the exclusive suppliers to numerous major builders in the Calgary-area". It also asserts to have registered the domain name <vacuumspecialists.com> in 1997 distributing to customers across Canada. However, the Panel notes that the Respondent had not registered the corresponding dot-ca domain name. Moreover, only in August 2022, one year and a half after the registration of the Domain Name by the Respondent (February 2021), the Complainant submitted a trademark application at CIPO, which has not been registered yet, and, thus, cannot be validly invoked in the dispute. The Complainant relies in this dispute on its trade name and asserts to have common law rights in the VACUUM SPECIALISTS trademark without providing specific evidence to prove the distinctiveness of such mark and its continuous use.

The Complainant has not provided any evidence which clearly shows that the Registrant is aware or should have been aware of the Complainant, its business and Mark, and has targeted the Complainant and its Mark with the registration of the Domain Name or otherwise misled consumers. The Domain Name consists of dictionary words ("VACUUM" and "SPECIALISTS") and is used to host links genuinely related to the dictionary meaning of those words comprising the Domain Name, and not to trade off the Complainant's Mark.

Therefore, the Panel is not persuaded that bad faith exists pursuant to paragraph 3.5 of the CDRP.

In light of the above, the Panel finds that the Complainant has not met its burden of proof with respect to paragraph 3.1(c) of the CDRP and the Registrant has not registered the Domain Name in bad faith.

5 DECISION and ORDER

For the above reasons, in accordance with Paragraph 4 of the CDRP, Paragraph 12 of the Resolution Rules, the Panel orders that: the Complaint be Denied.

Made as of September 18, 2023

SIGNATURE OF PANEL

Domain Name: vacuumspecialists.ca
20804-CDRP

1994 Powers

