

IN THE MATTER OF A COMPLAINT PURSUANT TO THE
CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY

Case Number: DCA-1382-CIRA

Disputed Domain Name: <angelsoft.ca>

Registrant: James Walker

Registrar: Hexonet Services Inc.

Panelists: Harold Margles (Chair), James Redmond Q.C.,
David Wotherspoon

Service Provider: British Columbia International Commercial Arbitration
Centre (BCICAC)

Parties

The Complainant is Georgia-Pacific Consumer Products LP, whose principal office is located at 133 Peachtree Street in Atlanta Georgia, U.S.A. The Complainant is represented by Antonio Turco of the law firm Blake, Cassels & Graydon LLP located in Toronto, Ontario.

The Registrant information was not available on the CIRA WHOIS database, and was obtained by the Complainant's solicitor under the CIRA Request for Disclosure of Registrant Information, which revealed that the Registrant is James Walker of 81 Murray Street, P.O. Box 375, Richmond, Ontario KOA 2Z0. The search disclosed no telephone or fax numbers.

The Domain Name and Registrar

The Domain Name in issue is < angelsoft.ca>. The Registrar is Hexonet Services Inc.

Procedural History

On March 23, 2012, the Complainant submitted the Complaint to BCICAC as service provider in respect of the CIRA Domain Name Dispute Resolution Policy, hereinafter referred to as the **Policy**. BCICAC served notice of the Complaint on the Registrant as required by rule 4.3 of the Canadian Internet Registration Authority, hereinafter referred to as CIRA, on March 26, 2012. No Response to the Complaint was received from the Registrant. Counsel for the Complainant requested that the proceeding not continue while discussions with the Registrant took place. On August 12, 2012, Counsel for the Complainant requested that the proceeding continue in its normal course.

BCICAC selected Harold Margles, James Redmond Q.C. and David Wotherspoon as panelists for this Complaint.

Panel Members Impartiality and Independence Statement

As required by CIRA Rule 7.1, each of the panelists have declared to BCICAC that each can act impartially and independently in respect of this matter as there are no circumstances known to any of them that would prevent any of them from so acting.

Basis for Deciding the Complaint

Inasmuch as the Registrant has not submitted a Response to the Complaint, the Panel shall decide the matter solely on the basis of the material contained in the Complaint and all reasonable inferences to be drawn therefrom, pursuant to CIRA Domain Dispute Resolution Rule 5.8.

Factual Background

BCICAC has certified that the Complainant has complied with the formal requirements under the Rules.

The facts are set out in the submission and appendices provided by Mr. Turco, the solicitor for the Complainant. These are unchallenged by the Registrant.

The Complainant is the owner of the Canadian registered trade-mark **ANGEL SOFT**, which was registered as number TMA 429, 245 on June 24, 1994, in association with paper tissues, bathroom tissue, paper napkins and paper towels. The trade-mark had been used in the United States since October 6, 1981, by Georgia Pacific Corporation, presumably a corporation related to the Complainant. The Complainant sells and advertises its products for sale in association with the trade-mark in Canada. In 2011, such Canadian sales of bathroom tissues exceeded \$200,000.

The Complainant is the owner of the Domain Name <angelsoft.com>, a website advertising its bathroom tissues in association with its trade-mark Angel Soft.

The Registrant registered the Domain Name on April 8, 2011, and thereafter began to operate a corresponding “parked” website under the Domain Name. The website displays a number of advertisements of the products and services of others. Of particular note, the website:

1. Directs the viewer to Bounty Paper Towels, a competitor of the Complainant
2. Directs the viewer to related searches for each of toilet paper and Bounty coupons
3. In 2 separate locations on the site states

“The domain **angelsoft.ca** may be for sale by its owner”

CIRA Policy

The Complainant must prove, on a balance of probabilities, that:

- (a) The Registrant's dot-ca Domain Name is confusingly similar to a Mark in which the Complainant had Rights prior to the date of the registration of the Domain Name, and continues to have such Rights – Paragraph 3.1 (a) of the Policy.
- (b) The Registrant has no legitimate interest in the Domain Name as described in Paragraph 3.6 of the Policy.
- (c) The Registrant has registered the Domain Name in bad faith, as described in Paragraph 3.5 of the Policy.

The Complainant must provide some evidence that the Registrant has no legitimate interest in the Domain Name, as set forth in Paragraph 3.4 of the Policy.

Is the Domain Name <angelsoft.ca> confusingly similar to the registered trade-mark ANGEL SOFT?

For the purpose of determining whether a Domain Name is confusingly similar to a Mark, Policy paragraph 1.2 indicates that the “dot-ca” suffix of the Domain Name should not be considered. Absent the “dot-ca” suffix, the Complainant's trade-mark and the Domain Name are identical.

The Complainant's registration of its trade-mark on June 24, 1994, pre-dates the registration date of the Domain Name in Canada on April 8, 2011. The Complainant's use of the trade-mark in Canada in association with the sale of bathroom tissue, pre-dates the Registrant's use of the Domain Name in association with competing products. The Complainant's registration of its trade-mark with CIPO is sufficient, in and of itself, to establish "rights" within the meaning of the Policy. *Viacom international Inc. v. Harvey Ross Enterprises Ltd.* BCICAC Case No.00015

Policy Paragraph 3.3 provides:

"A domain name is "Confusingly Similar" to a Mark if 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."

The Domain Name completely resembles the Complainant's trade-mark in appearance, sound, and the idea conveyed, and is confusingly similar thereto within the requirements of the Policy.

Does the Registrant have a legitimate interest in the Domain Name <angelsoft.ca>?

Paragraph 3.4 of the Policy lists 6 non-exclusive criteria upon which the panel may find, upon all the evidence, that the Registrant has a legitimate interest in the Domain Name. Examining the enumerated criteria, the Panel finds as follows:

- (a) The Domain Name was a Mark of the Complainant, not of the Registrant, who had no rights in the Mark and has not used it in good faith.
- (b) The Registrant did not register the Domain Name in Canada in good faith in association with any wares, services or business. The Domain Name is not clearly descriptive of the character or quality of any wares, services or business, the conditions of, or the persons employed in the production of the wares, or the place of origin of the wares.
- (c) The Domain Name is not understood in Canada to be the generic name of wares in any language.
- (d) The Registrant has not used the Domain Name in Canada in association with any non-commercial activity.
- (e) The Domain Name does not comprise the legal name of the Registrant.
- (f) The Domain Name is not the geographical name of the location of the Registrant's place of business.

Prior to August 22, 2011, the Panel was limited to a finding within any one of the 6 criteria set forth in Paragraph (now) 3.4. The amending paragraph 3.4 leaves it open to the Panel to find a legitimate interest in the Registrant on other grounds on the evidence presented.

The Registrant has provided no evidence for a finding of legitimate interest upon any other basis.

In the result, the Panel finds that the Registrant has no legitimate interest in the Domain Name.

Did the Registrant register the Domain Name in bad faith?

Prior to the amended Policy on August 22, 2011, then Paragraph 3.7 mandated that a Registrant will be considered to have registered a Domain Name in bad faith *if and only if* the panel found that the Registrant's conduct fell within one of the enumerated sub-paragraphs of 3.7.

Given that the Complainant has no ability to test the Registrant's evidence by cross-examination, or indeed to require the Registrant to file evidence to establish its intention, or indeed anything else, the burden upon the Complainant was untenable. The August 22, 2011 revision of the Policy reduced this burden to manageable proportions.

Rule 3.5 now provides:

Registration in bad faith.

For the purposes of paragraphs 3.1 (c) and 4.1 (b), *any* of the following circumstances, *in particular but without limitation*, if found by the Panel to be present, *shall be evidence* that the Registrant has registered a domain name in bad faith: (emphasis added).

(a) "The Registrant registered the domain name or acquired the Registration, primarily for the purpose of selling...or otherwise transferring the Registration to the Complainant.... for valuable consideration in excess of the Registrant's actual costs in registering the domain name or acquiring the Registration."

It is reasonable to find, on the balance of probabilities, that the Registrant knew of the Complainant's trade-mark, the bathroom tissue and other paper products with which it is associated, and the Complainant's Domain Name and website utilizing its trade-mark in association with an advertisement for bathroom tissue.

The Registrant's website specifically refers to the Bounty brand paper towels and "toilet paper sale" in association with the Domain Name and the advice that the Domain Name may be for sale by its owner. The name of the owner of the

Domain Name is not specifically identified. However, it would be straining credibility for such information to appear on the website of any one other than the owner of the website and the Domain Name. It is also reasonable to find that such information was directed to the attention of the Complainant or a competitor. The reasonable inference is that this website posting was both an incentive to the Complainant or a competitor, such as the manufacturer of Bounty, to buy, and an offer of sale of the Domain Name.

There is no evidence of a specific offer being made to the Complainant at a specific price. This sub-paragraph requires a very specific primary intention which has not been proven.

(b) The Registrant did not register the Domain Name to prevent the Complainant from registering its Mark. The Complainant registered its Mark prior to the registration of the Domain Name.

(c) "the Registrant registered the domain name...*primarily* for the purpose of disrupting the business of the Complainant....who is a competitor of the Complainant." (emphasis added)

The Registrant's website discloses no consistent product line or area of business. There is no image or idea in the product line or services being offered by the Registrant that bears any relationship to the Domain Name. The only consistent theme in the website is its identification with the Complainant's trade-mark, website and the products associated with the registered trade-mark.

The tentative offer of the Domain Name for sale appears twice in the website. The only conclusion that can be drawn is that the Registrant is placing this website in conflict with the trade-mark, Domain Name and website of the Complainant for the primary purpose of disrupting the business of the Complainant. The obvious hope of the Registrant is that such disruption would induce the Complainant to make an unsolicited offer for the Domain Name at a price attractive to the Registrant.

Such conduct by the Registrant constitutes bad faith with the meaning of Paragraph 3.5 (b) of the Policy.

(d) " the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website.....by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement...or location of a product or service on the Registrant's website or location"

The Complainant's trade-mark ANGEL SOFT has acquired goodwill over the years of its use in association with the paper products and in website advertisements in Canada of the Complainant. Website users, searching for the

trademarked products of the Complainant, and being directed to the Domain Name website angelsoft.ca, and finding the Bounty paper products listed for sale, would be confused into believing that in buying the Bounty products, they are buying the products of the Complainant.

The commercial gain for the Registrant is in the commission or profit that he would receive from effecting such sale as a result of the intentional confusion he has created.

Such conduct is bad faith within the meaning of Paragraph 3.5 (d) of the Policy

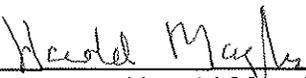
Conclusion and Decision

The Complainant has proven on the balance of probabilities that:

1. The Domain Name is confusingly similar to the Complainant's registered trade-mark ANGEL SOFT.
2. The Registrant registered the Domain Name in bad faith.
3. The Complainant adduced some evidence that the Registrant has no legitimate interest in the Domain Name. The Registrant has adduced no evidence to establish, on the balance of probabilities, that it has such a legitimate interest.

Accordingly, the Panel orders that the registration of <angelsoft.ca> be transferred to the Complainant by the Registrar HEXONET Services Inc.

Harold Margles, James E Redmond Q.C., David Wotherspoon



Harold Margles
Chair

Date: August 15, 2012