

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

|                                               |                                                              |
|-----------------------------------------------|--------------------------------------------------------------|
| <b>Complainant:</b>                           | <b>Alberta Foundation and Concrete Lifting Ltd.</b>          |
| <b>Complainant authorized representative:</b> | Ronald J. Lindhold                                           |
| <b>Registrant:</b>                            | Concrete Specialists Ltd.                                    |
| <b>Panel:</b>                                 | Barry C. Effler                                              |
| <b>Service Provider:</b>                      | British Columbia International Commercial Arbitration Centre |
| <b>BCICAC File Number:</b>                    | DCA-1427-CIRA                                                |

**DECISION**

The Parties, Domain Names and Registrar

1. The Complainant is Alberta Foundation and Concrete Lifting Ltd., a corporation incorporated and carrying on business in the Province of Alberta, Canada.
2. The Registrant is Concrete Specialists Ltd., a corporation carrying on business in the Province of Alberta, Canada.
3. The Domain Names at issue in this dispute are AlbertaFoundationAndConcreteLifting.ca and AlbertaFoundationConcreteLifting.ca.
4. The Registrar is GODADDY DOMAINS CANADA, INC.
5. The Domain names were registered by the Registrant on August 23, 2010.

Procedural History

6. The procedural history of this matter was set out in a letter from the British Columbia International Commercial Arbitration Centre to the Panel herein dated October 29, 2012:

The British Columbia International Commercial Arbitration Centre (the "Centre") is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy of the Canadian Internet Registration Authority (CIRA).

On September 24, 2012 the above-named Complainant filed a Complaint pursuant to the CDRP and the Rules.

The Complaint was reviewed and found to be compliant. By letter and email dated September 28, 2012, BCICAC as Service Provider so advised the parties and forwarded a copy of the Complaint to the Registrant.

The Registrant has not provided a Response. As permitted given the absence of a Response, the Complainant has elected under Rule 6.5 to convert from a panel of three to a single arbitrator.

The Centre hereby appoints you, Barry C. Effler, LL.B., LL.M., C. Arb. (Fellow), as sole arbitrator in the above-referenced matter.

7. As required by paragraph 7.1 of the Rules, the Panellist has declared to BCICAC that he can act impartially and independently in this matter as there are no circumstances known to him which would prevent him from so acting.
8. The Panel is not aware of any other legal proceeding or other arbitration in relation to the Domain Name that would give rise, under paragraph 13.2 of the Rules, to a need to stay or terminate the progress of this proceeding.

#### Eligibility of Complainant

9. The Panel has reviewed the material submitted by the Complainant and is satisfied that the Complainant is an eligible complainant under paragraph 1.4 of the Policy, because it is a corporation incorporated under the laws of a province in Canada.

#### Relief Requested

10. The Complainant requests that the Domain Names in dispute be transferred from the Registrant to the Complainant.

#### Applicable Law

11. As directed by paragraph 12.1 of the Rules, the Panel will render its decision based upon the rules and principles of the laws of Ontario, and the laws of Canada.

#### Facts

12. The Complainant was incorporated on January 30, 1987 in the Province of Alberta using the name Alberta Foundation and Concrete Lifting Ltd.
13. No evidence was submitted that there are any Trade-marks registered by the Complainant.

## Discussion and Findings

14. Policy paragraph 4.1 sets forth the onus on a complainant. It provides, in relevant part, as follows:

4.1 **Onus.** *To succeed in the Proceeding, 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 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;*

*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.*

15. The Complainant is not the owner of a registered Canadian trade-mark for ALBERTFOUNDATIONANDCONCRETELIFTING or ALBERTAFoundationCONCRETELIFTING, so it cannot rely upon any trade-mark. Instead, the Complainant must prove that it has rights in a trade name that was a "Mark" prior to the date on which the Domain Names were registered.

16. The Policy provides a definition of the term "Mark" (but as amended no longer defines Rights):

3.2 **Mark.** *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; ... (emphasis added)*

17. The relevant definition of "Mark" requires that a trade-mark be "used". The term "use" is no longer defined in the Policy.

18. Despite the amendments to the Policy, a complainant who relies upon an unregistered trade-mark or trade name as a “Mark” and asserts “Rights” in that Mark must continue to prove that the trade-mark or trade name was in “use” or was “used” by that complainant or its predecessor or by a licensor before the disputed domain names was registered.<sup>1</sup>
19. The Complainant meets this test. It submitted evidence supporting that it has been in business since incorporation using its name including City of Calgary Building permits, Yellow Pages Advertisements, Annual Corporation filings with the Province of Alberta and Banking records.
20. The Panel is satisfied that the Complainant has Rights in the Mark “Alberta Foundation and Concrete Lifting” that existed prior to the registration date for the two Domain Names.
21. The Panel is satisfied that the two Domain Names are confusingly similar to the Complainant’s Mark. The relevant key words in both Domain Names are the same words as in the Mark, with the exclusion of the “and” in one name and the dot ca in each Domain Name.
22. The two Domain Names point to web pages which include links to the Registrant’s business. This business is also in the field of concrete lifting and repair and clearly is a competitor of the Complainant. The Panel is satisfied that this establishes bad faith by the Registrant for the purposes of paragraphs 3.5 (c) and 4.1 of the Policy.

Paragraph 3.5 (c) of the Policy:

**3.5 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 a Registrant has registered a domain name in bad faith:

...

(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;

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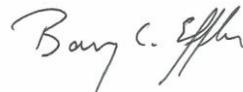
<sup>1</sup> A more lengthy analysis regarding “use” of a Mark is set out in *Forest Laboratories Canada Inc. v. Netnic Corporation*, CIRA Dispute no. 00187 <http://cira.ca/assets/Uploads/Final-Decision-DCA-1368-CIRA-Forestlaboratories-Forestlabs2.pdf>. That analysis is the basis for this analysis and I have borrowed some of the language from that decision.

23. The Registrant's name is Concrete Specialists Ltd. and there is no evidence that the Registrant owns any relevant Trade-marks or operates under any other name other than its own. It operates the Domain "www.concretespecialistsltd.ca" and it is to that site the two Domain names at issue resolve to. None of the circumstances outlined in paragraph 3.4 of the Policy regarding legitimate interest apply and the Panel is satisfied that the Registrant has no legitimate interest in the Domain Names.
24. The Panel is satisfied that the Complainant has met the onus on it to succeed, as required by paragraph 4.1 of the Policy.

Order

25. For the reasons set forth above, the Panel orders the two Domain Names in issue to be transferred to the Complainant.

Dated: November 19, 2012



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Barry C. Effler, Sole Panellist