

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

Dispute Number: DCA-1322-CIRA
Domain Name: mrappliance.ca
Complainant: Mr. Appliance Corp.
Registrant: Computerfest
Registrar: DomainsAtCost Corp.
Panel: W.A. Derry Millar
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

THE PARTIES

1. The Complainant in this proceeding is Mr. Appliance Corp., an incorporated company based in Texas, the principal office of which is located at 1010-1020 North University Parks Drive, Waco, Texas, United States, 76707.
2. The Registrant is Computerfest whose administrative contact is George Bachir, 3595 St. Clair Avenue E., #3, Scarborough, ON M1K 1L8.

THE DOMAIN NAME AND REGISTRAR

3. The Domain Name in issue (“**Domain Name**”) in this proceeding is: mrappliance.ca.
4. The Registrar is: DomainsAtCost Corp.
5. The Domain Name was registered by the Registrant on September 29, 2008.

PROCEDURAL HISTORY

6. The British Columbia International Commercial Arbitration Centre (“**BCICAC**”) is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (“**Policy**”) of the Canadian Internet Registration Authority (“**CIRA**”).
7. According to the information provided by the BCICAC:
 - (a) The Complainant filed a Complaint with respect to the Domain Name in accordance with the Policy on May 17, 2011;
 - (b) The Complaint was reviewed and found to be compliant. By letter dated May 20, 2011, the BCICAC as Service Provider confirmed compliance of the Complaint and commencement of the dispute resolution process;
 - (c) The Complaint was sent to the Registrant by FedEx courier on May 20, 2011, and delivered on June 6, 2011;
 - (d) The Registrant has not provided a Response;
 - (e) As permitted under CIRA Domain Name Dispute Resolution Rules (“**Rules**”) the Complainant elected under Rule 6.5 to convert from a panel of three to a single arbitrator.
8. On June 20, 2011, the BCICAC named W. A. Derry Millar as the Panel.
9. The Panel has reviewed all of the material submitted by the Complainant and is satisfied that the Complainant is an eligible Complainant under the Policy and Rules.
10. In accordance with Rule 5.8, where, as here, no Response is submitted, the Panel shall decide the Proceeding on the basis of the Complaint.

FACTS

11. The facts set out below are taken from the Complaint.

The Complainant's Business and MR. APPLIANCE Brand

12. The Complainant is a subsidiary of The Dwyer Group, Inc. and is one of the largest full-service appliance repair companies in the world. Since 2002, the Complainant has, through its franchisees, carried on business in Canada installing, repairing and refurbishing all types of appliances in association with the trade-mark MR. APPLIANCE (and design versions thereof). As a result of the use and promotion in Canada of the MR. APPLIANCE mark, including on the Complainant's website, <mrappliance.com>, the Complainant is the owner of significant goodwill attaching to the MR. APPLIANCE mark in Canada in association with the installation, repair and refurbishment of all types of appliances, and related wares and services.

13. The MR. APPLIANCE trade-mark is widely advertised and promoted, and is well-known throughout Canada within the appliance repair industry. The MR. APPLIANCE trade-mark is unique. There are no other MR. APPLIANCE-formative marks registered in Canada except those of the Complainant, and to the Complainant's knowledge, the MR. APPLIANCE mark is not associated with any other wares or services except those of the Complainant.

Complainant's Trade-marks and Domain Names

14. The Complainant is the owner of the following Canadian trade-mark registrations for MR. APPLIANCE, upon which this Complaint is based:

- (a) MR. APPLIANCE, registered in Canada under No. TMA 629,635, on January 6, 2005, in association with: Installation, repair and refurbishment of all types of appliances; and
- (b) MR. APPLIANCE & Design, registered in Canada under No. TMA 629,614, on January 6, 2005, in association with: Installation, repair and refurbishment of all types of appliances

15. The Complainant owns various trade-mark registrations and pending applications for MR. APPLIANCE-formative marks in other countries, including the United States, the European Community (OHIM), the United Kingdom, China, India, Bermuda and the Cayman

Islands. A table outlining these registrations and pending applications, along with the full particulars of the United States and European Community (OHIM) registrations, was provided as an attachment to the Complaint.

16. The Complainant's MR. APPLIANCE appliance repair business is widely promoted and advertised in Canada, for example, through print and on-line advertising.

17. The Complainant has spent significant sums on advertising and promoting its services in association with the MR. APPLIANCE trade-mark in Canada.

18. In addition to its MR. APPLIANCE trade-mark registrations, the Complainant also has a strong presence on the Internet in association with the MR. APPLIANCE mark as evidenced by its website, <mrappliance.com>, which provides information about the MR. APPLIANCE brand, and which was registered by the Complainant's parent The Dwyer Group, Inc. in March, 1996, years prior to the Registrant's registration of the Domain Name.

The Registrant's Activities

19. Computerfest registered the Domain Name on September 29, 2008 and thereafter began to operate a corresponding website under the Domain Name.

20. The Domain Name resolves to a website that displays a number of topics listed under the heading of "related searches", including the following topics:

- Appliance Repair
- Kitchen Appliances
- Appliances
- Kitchen Aid
- Dishwasher
- Refrigerators
- Dryer
- Oven

- Freezers

21. The above topics contain links directing users to various websites, including third party providers of appliance repair services in Canada. These third party providers of appliance repair services are not affiliated with the Complainant and provide services competing with the Complainant.

22. The Complainant, through its solicitors, put the Registrant's administrative contact, George Bachir, on notice of the Complainant's trade-mark rights to its mark MR. APPLIANCE, and its intent to assert and protect these rights, by the Complainant's letter dated February 14, 2011 sent by courier (but which was returned as undeliverable) and by e-mail. The Complainant's solicitors re-sent the letter to Mr. Bachir via e-mail on March 2, 2011. The Complainant's solicitors have not received a response from Mr. Bachir.

POSITION OF THE COMPLAINANT

23. The Complainant submits that:

- (a) The Domain Name is confusingly similar to a trade-mark in which the Complainant has rights. The Domain Name is virtually identical in appearance (only the absence of a period after "MR" differentiates the Domain Name from the MR. APPLIANCE trade-mark) and identical in sound and ideas suggested to the Complainant's MR. APPLIANCE Canadian trade-mark, registered on January 6, 2005, over 3 years before the Registrant registered the Domain Name in September 2008;
- (b) The registration of a mark with CIPO is sufficient in and of itself to establish "rights" within the meaning of the policy. The Complainant, therefore, has prior rights to the mark MR. APPLIANCE and continues to have such rights in accordance with subparagraphs 3.3(b) of the Policy;
- (c) Given that (i) the Domain Name is virtually identical to the Complainant's MR. APPLIANCE trade-mark, and (ii) the Complainant's MR. APPLIANCE trade-mark has developed good will throughout Canada, there is no doubt that

consumers would likely mistake the Domain Name for the Complainant's MR. APPLIANCE mark. Internet users who wish to access a website operated by the Complainant either by entering a domain name including the MR. APPLIANCE mark into the address bar of the Internet browser, or by entering the key term of the Domain Name into an Internet search engine, would likely be confused with and misled by the Domain Name as a matter of first impression;

- (d) The Registrant has no legitimate interest in the Domain Name as the Domain Name does not meet any of the 6 criteria set out in paragraph 3.6 of the Policy;
- (e) The Domain Name is comprised of virtually the exact mark (with the exception of the absence of a period after "MR") owned by the Complainant in Canada. The Registrant has never been licensed or authorized to use the MR. APPLIANCE mark in any matter;
- (f) The Registrant, at the time of registering the Domain Name on September 29, 2008, had no rights in the "MR. APPLIANCE" mark and continues to have no rights in the MR. APPLIANCE mark. On the balance of probabilities, the Registrant was well aware at the time of registering the Domain Name of the Complainant's prior trade-mark rights in the MR. APPLIANCE mark and of the Complainant's business in view of the Complainant's Canadian trade-mark registrations, the Domain Name registration and significant use of and reputation in the MR. APPLIANCE mark in Canada and the United States for several years prior to registration of the Domain Name;
- (g) There is no evidence that the Registrant has used, is using, or is preparing to use the Domain Name in good faith in connection with any *bona fide* wares or services, or for a legitimate non-commercial use. The Registrant is using the Domain Name to attract users to its website through consumer confusion with the Complainant's MR. APPLIANCE trade-mark and website, and to obtain advertising revenue by posting various third-party links on his website to re-direct consumers as the Domain Name is also a website that appears to be associated

with a pay-per-click service. The Registrant is unfairly and illegally exploiting the good will attached to the Complainant's MR. APPLIANCE trade-mark;

- (h) The Registrant selected the Domain Name to increase its chances of traffic to its website through confusion with the Complainant's trade-mark and <mrappliance.com> domain name. The Registrant's primary interest in the Domain Name was for the financial benefits potentially gained in using a mark that has already acquired significant good will in Canada by the Complainant. The Domain Name was registered and used to mislead Internet users into believing that the registered business associated with the Domain Name is the business of the Complainant or is at least endorsed, sponsored or approved by the Complainant, which is not the case;
- (i) The Domain Name is not understood to be a generic word in Canada nor is the MR. APPLIANCE mark the generic name of the Registrant's "services" of providing a website with third-party links;
- (j) The Domain Name is not being used in association with a non-commercial activity given it is used in connection with a website the only purpose of which is to advertise the good services of others and generate revenue as a result;
- (k) The Domain Name is not comprised of the legal name of the Registrant, nor is there any evidence that MR. APPLIANCE was the name, surname or other reference by which the Registrant is commonly identified;
- (l) The Domain Name is not composed of the geographical name of the location of the Registrant's non-commercial entity or place of business;
- (m) The Registrant has used and registered the Domain Name in bad faith because it registered the Domain Name to exploit the good will of, and cause confusion with, the Complainant's mark, and to disrupt the business of the Complainant. The Registrant's use of the Complainant's mark in the Domain Name to attract users to its website through consumer confusion with the Complainant's MR. APPLIANCE trade-mark and website, thereby creating traffic to its own website

and obtaining advertising revenue from third parties, is evidence of bad faith use and registration;

- (n) The Registrant has used and registered the Domain Name in bad faith because the registration of the Domain Name prevents the Complainant from reflecting its MR. APPLIANCE mark in a corresponding dot-ca Domain Name, the Registrant appears to have engaged in such conduct at least once previously. In a proceeding brought pursuant to the Policy in December 2010, the Registrant was ordered to transfer the Janpro.ca domain name to Jan-Pro Canada Inc., the Canadian master franchisee of Jan-Pro International, which is a franchisor of businesses that perform commercial, industrial and institutional cleaning and maintenance services under the name "JAN-PRO".¹
- (o) The Registrant acquired the registration of the Domain Name for the purposes of disrupting the business of the Complainant, including misleading users encountering the Domain Name that the Registrant's business associated with the Domain Name is a business of the Complainant, or is at least endorsed, sponsored or approved by the Complainant; registration of the Domain Name is preventing the Complainant from registering its mark as a dot-ca name, in a country in which it has acquired strong rights, and is the owner of a trade mark registration for virtually the identical trade mark. As a result, the Complainant's ability to advertise its business to the Canadian market is unfairly interfered with.
- (p) The Registrant is competing with the Complainant for Internet traffic, and would appear to be taking advantage of the reputation of the Complainant and the goodwill associated with the MR. APPLIANCE mark by exploiting the Internet traffic that was intended for a domain name corresponding to the Complainant's mark.

24. The Complainant requests that the Domain Name, mrappliance.ca, be transferred from the Registrant to the Complainant.

¹ Jan-Pro Canada Inc. v. Computerfest, c/O George Bashir, RC, Case No. 00162, 2011.

ANALYSIS AND FINDINGS

25. Under paragraph 4.1 of the 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 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 3.7;

and the Complainant must provide some evidence that

- (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6.

26. Paragraph 4.1 of the Policy also provides that:

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in paragraph 3.6.

27. The Registrant has filed no response to the Complaint and accordingly, the Registrant has provided no evidence of legitimate use.

CONFUSINGLY SIMILAR - PARAGRAPH 4.1 (a) OF THE POLICY

28. MR. APPLIANCE and MR. APPLIANCE & Design are trade-marks registered by the Complainant in the Canadian Intellectual Property Office ("CIPO") on January 6, 2005, in relation to the installation, repair and refurbishment of all types of appliances. MR. APPLIANCE is a "Mark" as defined in paragraph 3.2(c) of the Policy. The Complainant has carried on business in Canada of installing, repairing and refurbishing all types of appliances, through its franchisees, under the MR. APPLIANCE trade-mark since August 2002. MR. APPLIANCE is also a "Mark" as defined in paragraph 3.2(a) of the Policy.

29. The Complainant has the rights to the "MR. APPLIANCE" Mark as required under paragraphs 3.3 (a) and (b) of the Policy.

30. The Complainant has established that the Registrant's Domain Name "mrappliance.ca" is confusingly similar to the Complainant's Mark.

31. Paragraph 3.4 of the Policy defines "confusingly similar" as follows:

(a) domain name is '**Confusingly Similar**' to a Mark if the domain name so nearly resembles the Mark in appearance, sound or ideas suggested by the Mark as to be likely to be mistaken for the Mark.

32. The test to be applied in determining the issue of "confusingly similar" is set out in paragraph 66 of the decision in *Government of Canada v. David Bedford, c.o.b. Abundance Computer Consulting*²:

The test for "Confusingly Similar" under Policy paragraph 3.4 is one of resemblance based on first impression and imperfect recollection. Accordingly, for each domain name the Complainant must prove on a balance of the probabilities that a person, on a first impression, knowing the Complainant's corresponding mark only and having an imperfect recollection of it, would likely mistake the domain name (without the .ca suffix) for the Complainant's corresponding mark based upon the appearance, sound or ideas suggested by the Mark.

33. In the Panel's view, a person knowing the Complainant's Mark "MR. APPLIANCE" only and "having an imperfect recollection of" it "would likely mistake the Domain Name" "mrappliance.ca" "for the Complainant's corresponding mark based upon the appearance, sound or ideas suggested by the Mark."

BAD FAITH - PARAGRAPH 4.1(b) OF THE POLICY

34. In order to establish bad faith, the Complainants must establish on the balance of probabilities, one of paragraphs 3.7(a), (b) or (c) of the Policy. The Complainants rely on paragraphs (b) and (c).

35. Paragraph 3.7 defines "registration in bad faith" for the purposes of the Policy. The relevant portions of paragraph 3.7 read as follows:

² BCICAC Case No. 00011 (May 27, 2003)

For the purposes of paragraph 3.1(c), a Registrant will be considered to have registered a domain name in bad faith if, and only if:

(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 is engaged in a pattern of registering domain names in order to prevent persons who have rights and 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."

36. The Panel finds that the Complainant has satisfied the requirements of paragraphs 3.7(b) and 3.7(c) of the Policy and is entitled to a finding that the Registrant has registered the Domain Name "mrappliance.ca" in bad faith.

Bad Faith – Paragraph 3.7(b) of the Policy

37. Where, as here, the Registrant has neither responded to the Complainant's letter and e-mails nor to the Complaint, the intent of the Registrant must be inferred from the Registrant's conduct. In the Panel's view, the registration of the domain name " mrappliance.ca " on September 29, 2008, in the face of the registration by the Complainant of its trade-marks on January 6, 2005, and the use by the Complainant of the MR. APPLIANCE trade-mark (and design version) in Canada since 2002 leads only to the conclusion that "the Registrant registered the domain name ... to prevent the Complainant or the Complainants' licensor or licensee of the Mark, from registering the Mark as a domain name."

38. The Panel is also of the opinion that the second part of paragraph 3.7(b) has been satisfied by the evidence of the registration by the Registrant of at least one other dot-ca domain name composed of, or containing, third party marks. In *Jan-Pro Canada Inc. v. Computerfest*³ the Registrant was found to have registered the domain name janpro.ca incorporating the JAN-

³ *Supra*, Footnote 1.

PRO trade-mark owned by Jan-Pro International and licensed for use in Canada by Jan-Pro Canada. The trade-mark had been registered on September 27, 1996 and had been used in Canada since August 18, 1995. The disputed domain name had been registered on March 21, 2008.

39. *Viacom International Inc. v. Harvey Ross Enterprises. Ltd.*⁴ decided that evidence indicating that a registrant owns multiple domain names which correspond to third party trade-marks constitutes *prima facie* evidence of bad faith registration. In *Great Pacific Industries Inc. v. Ghalib Dhalla*⁵ and *Volvo Trademark Holding AB v. Cup International Limited*,⁶ the Panels held that as few as two (2) domain name registrations, which include the domain name in dispute, is sufficient to establish that a registrant has engaged in a pattern of abusive registrations.⁷

40. The Panel finds that the registration of the domain name mrappliance.ca and janpro.ca by the Registrant constitutes a pattern of abusive registrations within 3.7(b) of the Policy.

REGISTRATION IN BAD FAITH - PARAGRAPH 3.7(c) OF THE POLICY

41. Under paragraph 3.7(c), the Complainant must establish that:

(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.

42. The Complainants have established bad faith under this subparagraph. The Panel agrees with the Complainant that its business is disrupted or potentially disrupted as the registration of the Domain Name will attract users to the Registrant's website through consumer confusion with the Complainant's MR. APPLIANCE Mark and website, thereby creating traffic to the Registrant's website from which the Registrant will obtain advertising revenue from third parties, some of whom are competitors of the Complainant.. The conduct of the Registrant meets

⁴ BCICAC Case No. 00015 (October 15, 2003).

⁵ BCICAC Case No. 00009 (April 21, 2003).

⁶ WIPO Case No. D2000-0338 (June 12, 2000).

⁷ See also: Alberta Treasury Branches v. Jim Yoon, CIRA Case No. 00052 (February 13, 2006).

the requirements set out in Section 3.7(c) of the Policy and demonstrates the Registrant's bad faith.

43. In addition, the Registrant's registration of the Domain Name will mislead the users encountering it to consider that the Registrant's business associated with the Domain Name is the business of the Complainant or is endorsed sponsored or approved of by the Complainant. Bad faith exists where, as here, the use of the domain name is likely to cause confusion among Internet users as to affiliation or sponsorship.⁸

44. In the absence of an explanation from the Registrant, the only reasonable inference to be drawn from the registration of the Domain Name "mrappliance.ca" is that it was done to disrupt the business of the Complainants by directing Internet users seeking the Complainants' products to their competitors.

**LEGITIMATE INTEREST IN DOMAIN NAME 4.1(c) OF THE POLICY –
LEGITIMATE INTEREST, PARAGRAPH 3.6 OF THE POLICY**

45. The Panel finds that the Complainants have met their burden under paragraph 4.1(c) of the Policy to provide some evidence that the Registrant does not have a legitimate interest in the Domain Name. As the Registrant has not replied to the Complaint, the Registrant has not proven that the Registrant has a legitimate interest in the Domain Name as described in paragraph 3.6 of the Policy.

ORDER

46. The Complainant has met the requirements of paragraph 4.1 of the Policy. The Panel directs that the registration of the Domain Name "mrappliance.ca" be transferred from the Registrant to the Complainant.

Date: July 11, 2011.

W. A. Derry Millar

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⁸ *Bell Canada v. Archer Enterprises*, BCICAC Case No. 00038 (August 30, 2005).