

**IN THE MATTER OF A COMPLAINT MADE PURSUANT TO THE CANADIAN  
INTERNET REGISTRATION AUTHORITY DOMAIN NAME DISPUTE REGISTRATION  
RESOLUTION POLICY (v 1.3) AND RULES (v 1.5)**

**Complainant:** Urban Sawing & Scanning Co. Ltd.  
c/o Shapiro Hankinson & Knutson Law Corp.  
700-555 Burrard Street,  
Vancouver, B.C., V7X 1M8

**Contact Person:** Vanessa L. Reakes  
Tel: 604-684-0727  
Fax: 604-684-7094  
Email: vlr@shk.ca

**Registrant:** Canadian Travelers Mobile Limited  
345-15216 North Bluff Road,  
White Rock, B.C., V4B 0A7

Administrative Contact: George Slade  
Tel: 604-307-1119  
Email: [George@gwslade.ca](mailto:George@gwslade.ca)

**Disputed Domain Name** urbansawing.ca  
(the “Domain Name”)

**Registrar:** Go Daddy Domains Canada, Inc.

**Panel:** Thomas Manson, QC  
David Wotherspoon  
John Rogers (Chair)

**Service Provider:** British Columbia International Commercial Arbitration Centre  
(the “BCICAC”)

**BCICAC File:** DCA-1647 - CIRA

**PROCEDURAL HISTORY**

The BCICAC is a recognized service provider pursuant to the Domain Name Dispute Resolution Policy (the “Policy”) and Rules (the “Rules”) of the Canadian Internet Registration Authority.

The Complainant filed a complaint dated February 25, 2015 (the “Complaint”) with the BCICAC seeking an order in accordance with the Policy and the Rules directing that the registration of the Domain Name be transferred to the Complainant.

The BCICAC determined the Complaint to be in administrative compliance with the requirements of Rule 4.2 of the Rules and, by letter of transmittal dated February 26, 2015 (the “Transmittal Letter”), forwarded a copy of the Complaint to the Registrant to serve as notice of the Complaint in accordance with Rule 2.1 and Rule 4.3 of the Rules. The Transmittal Letter determined the date of the commencement of proceedings in accordance with Rule 4.4 of the Rules to be February 26, 2015 and advised the Registrant that in accordance with the provisions of Rule 5 of the Rules, a Response to the Complaint was to be filed within 20 days of the date of commencement of proceedings, or March 18, 2015.

The Registrant delivered its Response to the BCICAC on March 17, 2015 (the “Response”) in compliance with the Policy and the Rules and the BCICAC after a review of the Response determined it to be compliant.

The Registrant in its Response included a claim for costs. The BCICAC determined that in accordance with paragraph 4.6 of the Policy the Complainant had until March 24, 2015 to respond to this claim. By way of a document dated March 24, 2015, the Complainant submitted its Reply (the “Reply”) to the Registrant’s claim for costs.

In accordance with the provisions of Paragraph 6 of the Rules, the BCICAC appointed the undersigned as a three-person panel (“Panel”).

The Panel determines that they have been properly appointed and constituted as the three member panel to determine the Complaint in accordance with the Rules.

### **CANADIAN PRESENCE REQUIREMENTS**

The Canadian Presence Requirements for Registrants (“Presence Requirements”) require that to be permitted to apply for registration of, and to hold and maintain the registration of, a .ca domain name, the applicant must meet at least one of the criteria listed as establishing a Canadian presence. Section 2(d) of the Presence Requirements specifies that a corporation incorporated pursuant to the laws of Canada or a Canadian province satisfies this requirement.

The Complainant is incorporated under the laws of the Province of British Columbia. Although not specifically referred to in the material before us, no objection has been raised by the Complainant as to the Registrant’s status and we therefore have proceeded on the basis that there is no issue as to the Canadian presence requirement.

**ALL TECHNICAL REQUIREMENTS MET**

Based upon the information provided by the BCICAC, the Panel finds that all technical requirements for the prosecution of this proceeding have been met and that the Panel has jurisdiction to consider this matter.

**EVIDENCE**

The information before the Panel includes the following:

1. The Complainant is in the business of concrete drilling, sawing and scanning for applications in residential and commercial construction, which business it has carried on in the Lower Mainland area of British Columbia for 39 years;
2. The Complainant alleges that during the time that it has operated its business, it has established goodwill in the construction industry in the Lower Mainland area of British Columbia under the name “Urban Sawing” to the extent that this name has become a trade name (the “Trade Name”) used by the Complainant for the purpose of distinguishing its wares, services and business from that of other persons and/or corporations;
3. By way of a letter of intent dated February 25, 2014 (the “LOI”) addressed to the shareholders of the Complainant and signed by the Registrant’s Administrative Contact, George Slade, (“Mr. Slade”), Mr. Slade offered in good faith to negotiate the purchase all of the outstanding shares of the Complainant;
4. The shareholders of the Complainant executed the LOI on February 28, 2014 accepting the terms of the LOI;
5. The Complainant says that on or about March 6, 2014 the shareholders of the Complainant advised that they were “not interested in selling any interest” in the Complainant to Mr. Slade;
6. The Registrant says that on or about March 24, 2014, Mr. Slade was informed that the shareholders of the Complainant had elected to cancel the LOI;
7. The Registrant alleges that during the discussions leading up to the signing of the LOI, Mr. Slade inquired about registering the Domain Name and was advised by the shareholders of the Complainant that they “felt that websites were of no value”;
8. The Registrant on February 26, 2014 registered the Domain Name;
9. The Complainant denies that its shareholders expressed the sentiments about websites as alleged by the Registrant and points to the fact that the Complainant registered the domain name “urbansaw.com” on March 19, 2010;
10. The Complainant also notes that the Domain Name was registered by the Registrant on February 26, 2014, two days before the LOI was executed by the shareholders of the Complainant; and notes further that the LOI contains express terms that the “LOI is not intended to constitute and does not constitute a binding contract or agreement”;
11. On or about January 5, 2015, the Complainant attempted to register the Domain Name and was advised of the previous registration of the Domain Name in the Registrant’s favour;
12. Parties accessing the Domain Name are automatically forwarded to a website operated by and advertising the services of West Coast Cutting and Coring Ltd., a competitor of the Complainant in the construction industry in the Lower Mainland of British Columbia;
13. The URL to which the Domain Name currently resolves includes a banner which states “Urban

Sawing has been sold”;

14. The Registrant has refused the request of the Complainant to cease forwarding parties who access the Domain Name to the website of West Coast Cutting and Coring Ltd.

### **REMEDY SOUGHT**

The Complainant seeks:

1. a declaration from the Panel that the Registrant has no legitimate interest in the Trade Name or the Domain Name;
2. a declaration that the Registrant registered the Domain Name in bad faith;
3. an order that the Domain Name be transferred to the Complainant from the Registrant; and
4. an order for costs of this proceeding on a solicitor-client basis.

### **THE CDRP POLICY AND ANALYSIS**

The purpose of the Policy as stated in paragraph 1.1 thereof is to provide a forum in which cases of bad faith registration of .ca domain names can be dealt with relatively inexpensively and quickly.

Paragraph 4.1 of the Policy puts the onus on the Complainant to demonstrate this “bad faith registration” by proving on a balance of probabilities that:

1. the Trade Name qualifies as a “Mark” as defined in paragraph 3.2 of the Policy;
2. the Domain Name is “Confusingly Similar” to the Trade Name as the concept of “Confusingly Similar” is defined in paragraph 3.3 of the Policy; and
3. the Registrant has registered the Domain Name in “bad faith” in accordance with the definition of “bad faith” contained in paragraph 3.5 of the Policy.

In addition, the Complainant must provide some evidence that the Registrant has no “legitimate interest” in the Domain Name as the concept of “legitimate interest” is defined in paragraph 3.4 of the Policy.

If the Complainant is unable to satisfy the onus placed upon it by paragraph 4.1, bad faith registration is not demonstrated and the Complaint fails.

### **THE TRADE NAME AS A MARK**

The relevant portion of paragraph 3.2 of the Policy states that for the purpose of the Policy a “Mark” is:

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;

The Complainant has used the Trade Name as its common law trademark in Canada for at least 39 years to distinguish its business of concrete drilling, sawing and scanning from another provider of such goods and services. The Complainant continues to use the Trade Name in a similar capacity.

The Complainant has established that the Trade Name qualifies as a “Mark” within the provisions of paragraph 3.2 (a) of the Policy.

### **CONFUSINGLY SIMILAR**

Policy paragraph 3.3 provides that the Domain Name will be “Confusingly Similar” to the Trade Name if the Domain Name so nearly resembles the Trade Name in appearance, sound or the ideas suggested by the Trade Name as to be likely to be mistaken for the Trade Name.

In the matter at hand, the Domain Name consists of a portion of the Trade Name consisting of the words “Urban” and “Sawing” combined together followed by the .ca suffix. As paragraph 1.2 of the Policy defines the Domain Name for the purpose of this proceeding to exclude the .ca suffix, it is only the coined word resulting from this combination of words which is relevant for comparison purposes.

Therefore, to satisfy the onus placed upon it by the Policy, the Complainant must demonstrate that “urbansawing” so nearly resembles the Trade Name in appearance, sound or the ideas suggested by the Trade Name as to be likely to be mistaken for the Trade Name.

We find that the Complainant has satisfied the onus placed upon it and has demonstrated that the Domain Name is confusingly similar to the Trade Name.

### **NO LEGITIMATE INTEREST**

Paragraph 4.1 of the Policy requires that to succeed in the Complaint, the Complainant must provide some evidence that the Registrant has no legitimate interest in the Domain Name as the concept of “legitimate interest” is provided for in paragraph 3.4.

Paragraph 3.4 of the Policy provides that:

The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint was submitted:

- (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 used 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 used 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 paragraphs 3.4 (d) "use" by the Registrants includes, but is not limited to, use to identify a web site.

There is no evidence before the Panel that the Domain Name is a Mark in which the Registrant has Rights and that the Registrant used the Domain Name in good faith prior to the filing of the Complaint as set out in paragraph 3.4(a).

We have no evidence before us to demonstrate that the Domain Name appears to be clearly descriptive of wares, services or business of the Registrant or of the people involved in or place of origin thereof as provided for in paragraph 3.4(b).

Similarly, there is no evidence that the Domain Name is understood in Canada as the generic name of wares, services, or business offered by the Registrant, that the Domain Name is used in Canada in connection with a non-commercial activity of the Registrant, that the Domain Name is a name by which the Registrant is commonly identified, or that the Domain Name is the geographical name of the location of the Registrant's non-commercial activity or place of business. Therefore, the provisions of paragraphs 3.4(c), 3.4(d), 3.4(e) and 3.4(f) do not apply.

The Registrant submits in its Response that it had a legitimate interest in the Domain Name at the date of its registration due to the fact that Mr. Slade had entered into the LOI at the date of registration of the Domain Name. To ensure that the Registrant had the ability to use the Domain Name upon completion of the purchase of the shares of the Complainant by Mr. Slade, the Registrant effected the registration of the Domain Name.

We have difficulty with accepting this submission by the Registrant. The Registrant appears to suggest in its submission that the LOI granted it a colour of right with respect to the registration of the Domain

Name in anticipation of the purchase of the shares of the Complainant by Mr. Slade. However, the evidence before us clearly sets out the fact that the LOI was not accepted by the shareholders of the Complainant until February 28, 2014, two days after the registration of the Domain Name by the Registrant. Therefore, even if the LOI did grant to the Registrant a colour of right, which is nebulous given the wording in the LOI to the effect that it was not intended to create a binding contract or agreement, at the date of the registration of the Domain Name such a colour of right did not exist with the Registrant.

Other than its submission on having a colour of right as a result of submitting the LOI to the shareholders of the Complainant and anticipating their execution of this document, the Registrant has submitted no evidence that it has a legitimate interest in the Domain Name meeting any of the criteria set out in paragraph 3.4.

Therefore, the Panel finds that the Complainant has provided some evidence that the Registrant has not demonstrated a legitimate interest in the Domain Name in accordance with the provisions of paragraph 3.4.

### **BAD FAITH**

Under paragraph 3.5 of the Policy, the Registrant will be considered to have registered the Domain Name in bad faith if, and only if, the Complainant can demonstrate that the Registrant in effecting the registration of the Domain Name was motivated by circumstances of bad faith addressed, but without limitation, in the circumstances described in paragraph 3.5.

Sub-paragraphs 3.5 (a) to (d) identify evidence that will presumptively satisfy the bad faith requirement. Of these, it would appear that paragraph 3.5(d) is the one most applicable to the matter at hand.

Paragraph 3.5(d) provides as follows:

(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.

From the submissions of the Registrant, it would appear that at the date of the registration of the Domain Name, the intention of the Registrant was to protect the interests of Mr. Slade in the event that he was successful in purchasing the shares of the Complainant. That might well be the case. However, the provisions of paragraph 3.5(d) speak not to the intention of the Registrant at the date of registration of the Domain Name, but to the Registrant's intention following such registration.

There is before the Panel no direct evidence of the Registrant's intention following the registration of

the Domain Name. Such intention must therefore be based upon a common sense inference from the Domain Name website and from the Registrant's use of this website following the registration.

Following the notification to Mr. Slade by the shareholders of the Complainant that they did not intend to proceed with the sale of the shares of the Complainant to Mr. Slade, it would appear that the Registrant's interest in owning the Domain Name would have ceased. Indeed, the Registrant's own submissions state that the "Registrant has been willing to consider an offer from the Complainant. The Complainant demanded action with no offer of compensation. The Registrant has legitimate expenses involved in registering" the Domain Name.

The allegation by the Complainant that parties accessing the Domain Name are automatically forwarded to a website operated by and advertising the services of West Coast Cutting and Coring Ltd., a competitor of the Complainant in the construction industry in the Lower Mainland of British Columbia has not been denied by the Registrant. Nor has the Registrant denied the Complainant's allegation that the Registrant has refused the request of the Complainant to cease forwarding parties who access the Domain Name to the website of West Coast Cutting and Coring Ltd.

The Registrant in its submissions did deny the Complainant's allegation that a banner contained within the URL to which the Domain Name currently resolves states that the Complainant's business has been sold. However, in the Reply, the Complainant provided direct evidence of a banner clearly stating "Urban Sawing has been sold".

We find that the Complainant has satisfied the provisions of paragraph 3.5(d) of the Policy by establishing that the Registrant has by its actions intentionally attempted to attract for commercial gain Internet users to an on-line location by creating a likelihood of confusion with the Complainant's Trade Name.

## **DECISION**

As was above set out, paragraph 4.1 of the Policy provides that to be successful in the Complaint the Complainant has the onus of proving on a balance of probabilities three specific items and of providing some evidence that the Registrant has no legitimate interest in the Domain Name.

We find that the Complainant has satisfied this onus with respect to all three of these items by demonstrating that the Trade Name qualifies as a Mark in accordance with paragraph 3.2 of the Policy; that the Domain Name is Confusingly Similar to the Trade Name; and that the Registrant has registered the Domain Name in bad faith in accordance with the provisions of paragraph 3.5 of the Policy. We have also found that the Complainant has shown some evidence that the Registrant does not have a legitimate interest in the Domain Name in accordance with the provisions of paragraph 3.4.

**CLAIM FOR COSTS**

The Registrant has claimed costs pursuant to paragraph 4.6 of the Policy.

Paragraph 4.6 of the Policy entitled “**Bad Faith of Complainant**” states:

If the Registrant is successful, and the Registrant proves, on a balance of probabilities, that the Complaint was commenced by the Complainant for the purpose of attempting, unfairly and without colour of right, to cancel or obtain a transfer of any Registration which is the subject of the Proceeding, then the Panel may order the Complainant to pay to the Provider in trust for the Registrant an amount of up to five thousand dollars (\$5000) to defray the costs incurred by the Registrant in preparing for, and filing material in the Proceeding. The Complainant will be ineligible to file another Complaint in respect of any Registration with any Provider until the amount owing is paid in full to the Provider.

Paragraph 4.6 requires that the Registrant be successful for its claim for costs to be considered. As we have found against the Registrant, its claim is moot.

The Complainant has, as well, sought costs for this proceeding on a solicitor-client basis. It is to be noted that paragraph 4.6 deals with costs in favour of the Registrant and not the Complainant.

Paragraph 4.3 of the Policy references a panel decision in favour of the Complainant, but does not authorize the panel to award costs in such an instance.

In any event, we do not find that an award of costs in the Complainant’s favour is warranted in this matter.

**ORDER**

In reviewing the material before us, the Panel is troubled by the manner in which it was presented to us.

In the Complaint there were no appendices provided by the Complainant which provided statements, under oath or otherwise, to support the allegations made by the Complainant in the Complaint. This left the Panel with the allegations in the Complaint being nothing more than unsupported allegations.

Of greater concern to the Panel is that the Complainant’s position with respect to the LOI and the negotiations between the Complainant’s shareholders and Mr. Slade was presented by the Complainant in the Reply after the Response was filed referencing the LOI. As the registration of the Domain Name was concurrently with and appeared to be a result of these negotiations, it would have been preferable if the Complainant’s position on these matters was included in the Complaint in the first instance. The fact that it was not and that it was dealt with by the Complainant only in the Reply left the Registrant in a disadvantage as under the Rules it had no ability to respond to the submissions of the Complainant in the Reply without further application to the Panel under Rule 9.1.

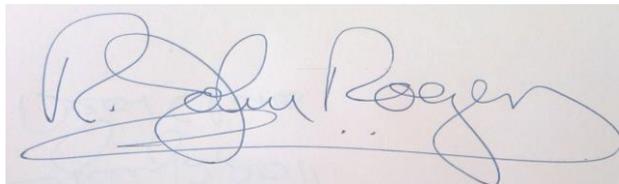
In that the Reply went beyond the Complainant responding to the Registrant's application for costs, the Panel considered dismissing this matter with leave to the Complainant to refile the Complaint and to the Registrant to refile the Response.

However, we are mindful of the main purpose of the Policy as being one to provide a forum in which cases of bad faith registration of .ca domain names can be dealt with relatively inexpensively and quickly. As we are not of the view that re-examining this matter will clearly result in a different outcome, we have not chosen to go this route.

Therefore, the Panel orders that the domain name, <urbansawing. ca> be transferred to the Complainant.

Dated: April 13, 2015.

On behalf of the Panel.

A handwritten signature in blue ink, appearing to read "R. John Rogers", is centered on a light-colored rectangular background. The signature is fluid and cursive.

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R. John Rogers, Chair