

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

Dispute Number: DCA- 1371– CIRA
Domain(s) in Dispute: westernricemills.ca
Complainant: Western Rice Mills Ltd
Registrant: Third Planet Foods
Registrar: Webnames.ca.Inc.
Service Provider: British Columbia International Commercial Arbitration Centre
Panel: W.A. Derry Millar, Claude Freeman and Elizabeth Cuddihy (Chair)

DECISION

The Parties

1. The Complainant is Western Rice Mills Ltd of 6231 Westminster Hwy, Brighthouse West Business Park, Richmond, B.C. V7C 4V3, Canada, hereinafter referred to as the “Complainant”.
2. The Registrant is Third Planet Foods, c/o Georgia Pacific Realty, Suite 400 – 601 W. Broadway, Vancouver, B.C. V5Z 4C2, hereinafter referred to as the “Registrant”.

The Disputed Domain Names and Registrar

3. The Domain name at issue is westernricemills.ca, hereinafter referred to as the “Disputed Domain Name”.
4. The Registrar for the Disputed Domain Names is Webnames.ca Inc.
5. The Registrant is Third Planet Foods of Suite 400 – 601 W. Broadway, c/o Georgia Pacific Realty, Vancouver, B.C. V5Z 4C2
6. The Disputed Domain Name was registered on November 9, 2000.

Procedural History

7. The British Columbia International Commercial Arbitration Centre (“BCICAC”) is a recognized service provider to the Domain Name Dispute Resolution Policy (the “Policy”) and Rules (the “Rules”) of the Canadian Internet Registration Authority (“CIRA”).

8. The Complainant filed a complaint dated February 10, 2012, (the "Complaint") with the BCICAC seeking an order in accordance with the Policy and the Rules directing that the registration of the Disputed Domain Name be transferred to the Complainant forthwith.

9. The BCICAC determined the Complaint to be in administrative compliance with the requirement of the Rules, and, by letter and email dated February 13, 2012 so advised the parties and forwarded a copy of the Complaint to the Registrant and on December 22, 2010 forwarded a copy of the Complaint.

10. Within the timeframe to file a Response, the Registrant requested an extension, which the BCICAC granted. On March 23, 2012, the Registrant delivered to the BCICAC its Response to the Complaint in compliance with the Policy and the Rules. The BCICAC found the Response to be in administrative compliance and, on March 27, 2012 delivered a copy of the Response to the Complainant.

11. By letter dated April 3, 2012, the BCICAC appointed the above-named persons as a three-person panel (the "Panel").

12. Relying on the BCICAC, the Panel deems that it has been properly constituted as the three member panel to determine the Complaint in accordance with the Rules.

Canadian Presence Requirements

13. The Canadian Presence Requirements for Registrants (the "Presence Requirements") require that in order for a Registrant to be permitted to apply for registration of, and to hold and maintain the registration of a dot 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 of a Canadian province satisfies this requirement.

14. The Complainant is incorporated under the laws of the Province of British Columbia and accordingly, satisfies the Canadian Presence Requirements.

The Position of the Parties

The Complainant's Position

16. The Complainant is a British Columbia based company which has been providing rice products and marketing services including rice, export and distribution since its incorporation in 1964.

17. As part of the Complainant's strategic and marketing goals, it recognized the need to promote the company as well as its products and its services using internet technology.

18. To that end, the Complainant consented to the registration of the Disputed Domain Name on the implied understanding that it would be registered to promote the interest of the Complainant. During this period of development, Mr. Kevin K. Chiang was associated with the Complainant and responsible for its corporate development and marketing activities. In that capacity his responsibilities included the design and implementation of the Complainant's website and the sale and marketing of products, including its product line, Third Planet Foods.

19. On November 9, 2000, while Kevin K. Chiang was associated with the Complainant in the capacity noted above, he initiated the registration of the Disputed Domain Name, which bears exactly the Complainant's corporate name, Western Rice Mills Ltd.

20. Since the creation of the Disputed Domain Name on November 9, 2000, it was implied by the Complainant that the Disputed Domain Name had been registered on behalf of the Complainant by Kevin K. Chiang and the Complainant deemed that he had represented the Complainant in all aspects of registration as he was associated with the Complainant in that capacity. Since the date of registration of the Disputed Domain Name in 2000 www.westernricemills.ca has been the official web site of the Complainant. Visitors to the website, including clients and suppliers have recognized the web site address and acknowledged the information published on the web site, which includes several web pages (with images, text and scripts), such as the home page, company profile, products (including brands and logos), markets serviced and services.

21. The Complainant has gathered information that shows that in an updated (December 1, 2009) domain registry record that Georgia Pacific Realty Inc. was the Registrant of the Disputed Domain Name and that Mr. K. Chiang, the named administrative contact.

22. The Complainant further learned that an updated (October, 25 2010) domain registry record, records a change of Registrant by the administrative contact, Kevin K. Chiang, from Georgia Pacific Realty to Third Planet Foods while maintaining himself as the Administrative Contact.

23. Mr. K. Chiang's association with the Complainant was severed as of November 1, 2010 and the Complainant has not been given access to its web site. In fact the web site which includes the Disputed Domain Name has been put "up for lease" or re-directed to a competitor. In addition, Mr. K. Chiang on November 16, 2010, following the severance of his relationship with the Complainant incorporated a company named Third Planet Foods Inc., with his name being the sole proprietor, and the business

address c/o Georgia Pacific Realty. Third Planet Foods is a Canadian registered trade mark owned by the Complainant.

24. The Complainant claims that Mr. K. Chiang is not in a position to represent the Complainant nor to manage the technical execution of its domain name and further claims that the registration of the Disputed Domain Name is confusingly similar to its mark, the Complainant's corporate name in which it had rights prior to the registration and updating of the Disputed Domain Name and continues to have such rights, that the Disputed Domain Name was registered in bad faith and that the Registrant has no legitimate interest in the Disputed Domain Name and requests an order transferring the Disputed Domain Name to the Complainant forthwith.

The Registrant's Position

25. The Registrant alleges that its principal, Kevin Chiang as a shareholder, director, officer and management employee of the Complainant over several years, acquired rights and ownership of the Disputed Domain Name, which rights, stem from implied and express capacity and authority which have neither been rescinded nor revoked during the applicable and relevant times.

27. Pursuant to the above noted acquired rights in the ownership of the Disputed Domain Name, the Registrant alleges, that he licensed the use of the Disputed Domain Name to the Complainant in part portion billings comprising of personal service billings and licensee fee billings.

28. The Registrant further alleges that the materials for the web site containing the Disputed Domain Name were provided by and with the approval of the Complainant.

29. The Registrant requests that the Complainant's claim for the transfer to it of the Disputed Domain Name be denied.

Analysis and Findings

30. The purpose of the Policy as stated in paragraph 1.1 of the Policy is to provide a forum by which cases of bad faith registration of dot-ca domain names can be dealt with relatively inexpensively and quickly. The Policy does not apply to other types of differences between owners of trade-marks and Registrants of Domain names.

Relevant provisions of the Policy are provided below

32. Paragraph 4.1 of the Policy provides

4.1 **Onus.** To succeed in a 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.

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 3.4.

33. Paragraph 3.2 of the Policy provides in part

3.2 **Mark.** A "Mark" is

(a) A trademark, including the word elements of a design mark, or a trade name that has been used in Canada by a person, or a 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 for the wares, services or business of another person;

34. Paragraph 3.3 provides

3.3 **"Confusingly Similar"**. 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 the likely to be mistaken for the Mark.

35. Paragraph 3.4 provides:

3.4 **Legitimate Interest.** For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in the domain name:

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

36. Paragraph 3.5 provides:

3.5 **Registration in Bad Faith.** For the purposes of paragraph 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:

- (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 Registrants' 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.

37. In summary, to succeed in a proceeding, the Complainant must prove on a balance of probabilities that:

1. The dot-ca domain name is confusingly similar to a mark in which the Complainant had rights prior to the registration of the domain name and continues to have such rights;
2. The Registrant has registered the domain name in bad faith; and
3. The Complainant must provide some evidence that the Registrant has no legitimate interest in the domain name.

Notwithstanding the above, the Registrant will succeed if the Registrant proves on a balance of probabilities that he has a legitimate interest in the domain name.

Confusingly Similar

38. The subject matter of this case is not a newly created and competing registered name but rather a Disputed Domain Name registered at the behest and expense of the Complainant which the Registrant does not deny. The Disputed Domain Name is the corporate or trade name of the Complainant which has been in use in Canada since 1964. There is no question as to whether it is confusingly similar to the Complainant's Mark as it the Complainant's corporate or trade name and accordingly meets the test of confusingly similar.

39. Evidence also shows that the Complainant's mark predates by many years the registration of the Disputed Domain Name. Accordingly the Complainant's rights in the Mark predate the registration of the Disputed Domain Name and further evidence shows that the Complainant continues to have such

rights. Accordingly the Complainant has satisfied the burden of confusingly similar prior and continued rights.

Was the Disputed Domain Name registered in bad faith?

40. The Complainant relies on paragraphs 3.5 (b), (a) and (c) of the Policy in support of its claim.

41. Referring to paragraph 3.5 (b) of the Policy, the Complainant argues that the Registrant was aware of the business operation of the Complainant, its mark, Western Rice Mills, the fact that the Complainant had established reputation in the trade since 1964, and carried several rice products, including the brand name “Third Planet Foods”, which is a Canadian trade mark owned by the Complainant. Mr. Kevin K. Chiang was associated with the Complainant and had been assigned as one of his tasks, the overseeing of the Complainant’s web site including the registration the Complainant’s domain name “westernricemills.ca” during his tenure with the Complainant.

42. The Complainant further argues that following the severance of his association with the Complainant, Mr. Kevin Chiang incorporated a company named Third Planet Foods Inc. which is confusingly similar to the Canadian registered trade mark “Third Planet Foods”, which is owned by the Complainant. In addition, the Complainant argues that changing the Registrant of the Disputed Domain Name from Georgia Pacific Realty to Third Planet Foods shows bad faith in that it prevents the Complainant from registering the Disputed Domain Name.

43. The Registrant claims that, having acquired the right of ownership in the Disputed Domain Name from a former principal of the Complainant, there was an express and implied license arrangement with the Complainant for it to use the Disputed Domain Name. This license arrangement had not been revoked or rescinded. In support of this assertion, the Registrant relies on Annex “A” to the Complaint.

44. It is the view of the Complainant that the creation and registration of the Disputed Domain Name was effected by Mr. K. Chiang, on behalf of, and representing the Complainant in all respects. The Registrant does not deny this.

45. It is difficult to conclude otherwise that the registration undertaken at the request of the Complainant was for any purpose other than for promoting and distinguishing the wares/services/business of the Complainant. On this basis alone, the legitimate interest clearly arose out of the business and promotional needs of the Complainant. For the Complainant to rely on the work (business web site, domain name registration) of the Registrant as work carried out on its behalf and for the attainment of its goals would be expected.

46. In the Panel's view, the argument of ownership rights acquired from a previous principal of the Complainant put forth by the Respondent is not supported by any evidence. Neither does Annex "A" to the Complaint that the Registrant relies on support that claim. Consequently the change in registration of the Disputed Domain Name to Third Planet Foods, a company, solely owned (of his own admission) by Mr. Kevin K. Chiang prevents the Complainant from registering its own mark, trade name.

Referring to paragraph 3.5 (a)

47. As noted in paragraph 44, the Disputed Domain Name was created by the Registrant while associated with the Complainant. Updates of the Disputed Domain Name records indicate, the Registrant, in one instance Georgia Pacific Realty and later in 2010, a change to Third Planet Foods as the Registrant and Kevin Chiang as the administrative contact, c/o Suite 400 – 601 Broadway, c/o Georgia Pacific Realty, Vancouver. B. C.

48. The Complainant alleges that the Registrant registered or acquired the Disputed Domain Name primarily for the purpose of selling, licensing or otherwise transferring the registration to the Complainant or its licensor or licensee for valuable consideration far in excess of the cost of registration.

49. The Complainant severed association with Mr. Kevin K. Chiang as of November 1, 2010. The evidence also shows that Mr. Kevin Chiang incorporated a company named Third Planet Foods Inc following his severance with the Complainant. Third Planet Foods is a trade-mark owned by the Complainant which is registered in the Canadian Intellectual Property Office.

50. In response to the claim noted in paragraph 40 above, the Registrant relies on his purported ownership rights and provides the following alternatives: give notice of termination of the license agreement stemming from his purported ownership rights, or provide updated materials both alternatives "conditional on the payment of amount owing to Third Planet Foods from November 1, 2010 to the current date or to the effective date of termination of the license agreement."

51. As noted in paragraph 46, in the Panel's view, the Registrant has not established ownership rights in the Disputed Domain Name as alleged. The Complainant relied heavily, perhaps even exclusively on the registration work carried out by Mr. Chiang while he was associated with the Complainant and the legitimacy of the ownership of its own domain name. The invoices of \$2500.00 per month from November 1, 2010 could point to some form of previous expectation by Mr. K. Chiang of some form of future remuneration, despite the fact that he was previously paid by the Complainant for the work. In any case, the payment would be far in excess of the cost of registration of the Disputed Domain Name.

52. Based on the evidence provided and as noted above, the Panel determines that, on a balance of probabilities, notwithstanding the fact that the Disputed Domain Name was registered at the request and with the approval of the Complainant, it was nevertheless registered or acquired in bad faith.

Legitimate Interest of the Registrant

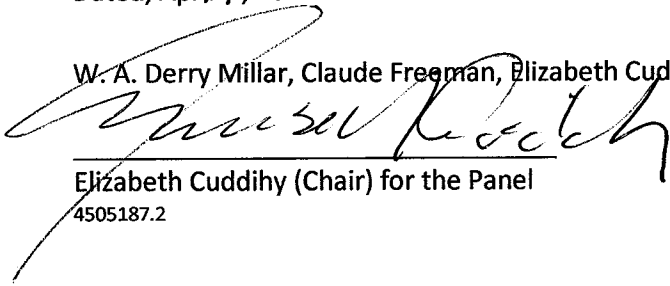
53. The Panel is satisfied that the Complainant has provided some evidence that the Registrant does not have a legitimate interest in the Disputed Domain Name as required by paragraphs 3.4 and 4.1(c). As noted above, based on the material provided by the Registrant, in the Panel's view, the Registrant has not proven, on a balance of probabilities that he has a legitimate interest in the Disputed Domain Name.

Decision

54. For the reasons set out herein, the Panel decides in favour of the Complainant and orders the transfer of the Disputed Domain Name to the Complainant forthwith.

Dated, April ^{AL}7, 2012

W. A. Derry Millar, Claude Freeman, Elizabeth Cuddihy (Chair)



Elizabeth Cuddihy (Chair) for the Panel

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