

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number: DCA - 2107 - CIRA
Domain Name: redbird.ca
Complainant: Redbird Communications Inc.
Registrant: Carmine Lofaro / 1687734 Ontario Inc.
Panel: The Honourable Neil Anthony Brown, QC, Douglas M. Isenberg, Esq;
and Claude Freeman. LL.M. (ADR), C. Med., C. Arb., (Chair)
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

The Parties

1. The complainant is Redbird Communications Inc. of Saskatoon, Saskatchewan (the Complainant).
2. The Registrant is Carmine Lofaro / 1687734 Ontario Inc. of Hamilton, Ontario, and also of Richmond, British Columbia (the Registrant).

The Disputed Domain Name and Registrar

3. The Domain Name at issue is redbird.ca (the Disputed Domain Name).
4. The Registrar of record for the Disputed Domain Name is Namespro Solutions Inc.
5. The Disputed Domain Name was registered on or about May 11, 2011.

Procedural History

6. The British Columbia International Commercial Arbitration Centre (BCICAC) is a recognized service provider to the CIRA Domain Name Dispute Resolution Policy (the Policy) and the CIRA Domain Name Dispute Resolution Rules (the Rules).

7. The Complainant filed a complaint on June 6, 2019 (the Complaint) with the BCICAC seeking an order in accordance with the Policy and the Rules that the Disputed Domain Name be transferred to the Complainant.
8. BCICAC confirmed the Complaint to be in administrative compliance with the Rules and forwarded copy of the Complaint to the Registrant in accordance with the Rules.
9. The Registrant's response was due on July 2, 2019; however, counsel for the Registrant requested an extension of four business days. This extension was granted by the BCICAC, and on July 8, 2019 the Registrant delivered its response to the BCICAC.
10. On July 12, 2019, the BCICAC named The Honourable Neil Anthony Brown, QC, Douglas M. Isenberg, Esq., as panelists, and Claude Freeman, LL.M., C. Med., C. Arb. as chair of the Panel to determine the matter.
11. As prescribed by the Policy, the Panel has declared that it can act impartially and independently and that there are no circumstances known to the Panel which would prevent it from so doing. The Complaint and the Responses were filed in English, which shall be the language of the proceeding.
12. On or about July 15, 2019, the Panel received notice from the BCICAC of new, supplementary information having been submitted by the parties in support of their positions. The Panel advised the BCICAC that it would be prepared to entertain such supplementary information and their responses, if received by the parties no later than the close of business July 19, 2019. As of July 22, 2019, no further information or responses had been received.

Canadian Presence Requirements

14. 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 Canadian Presence Requirements for Registrants (the Presence Requirements) require that the applicant meet at least one of the criteria listed as establishing a Canadian presence.
15. The Complainant does not assert that it is the owner of any Canadian trade-mark registrations whatsoever.
16. The Complainant states, and provides evidence, that it is incorporated under the laws of Saskatchewan on August 25, 2008. Accordingly, paragraph 2(4) of the Presence Requirements ("[a] corporation under the laws of Canada or any province or territory of Canada") is satisfied. The Registrant also acknowledges that Complainant has satisfied the Canadian Presence Requirements.

The Position of the Parties

The Position of the Complainant

17. The Complainant's position is quite straightforward. It submits having incorporated its business in August of 2008. Its prime area of business is provision of fiber optic, wireless internet and related services, since the outset. The complainant does not submit any prior or existing Mark(s) of any kind as being registered with CIPO.

19. The Complainant submits having similar domain names as that of the domain name in dispute. It submits having registered: getredbird.ca, redbirdcommunications.ca, redbirdgroup.ca, and redbirdfiber.ca. The Complainant asserts that "redbird.ca" is confusingly similar to others it has registered and thereby confusingly similar to the thrust of its business mandate, as established in 2008. It asserts this by indicating that on numerous occasions, its business legitimacy has been put in doubt by visitors landing on the disputed website, and allegedly being told by the Registrant that the website at issue is up for sale. No further details in support of these allegations have been submitted.

19. The Complainant submits that the Registrant has been quite candid about communications between them as it relates to negotiations and pricing relating to the sale of the domain name in dispute. It has also submitted various copies of email trails in that regard. The Complainant asserts having made attempts with the Registrant to negotiate and arrive at an amicable settlement for the purchase of the disputed domain name, but when negotiations broke down, the Complainant declined the purchase of the disputed domain name, and escalated the dispute to the BCICAC. The Complainant contends that the Registrant is not using the disputed domain name for any legitimate business purpose and that the registration of "redbird.ca" and that the Registrant currently owns/holds some 1,357 domain names for the sole purpose of domain squatting destined for financial gain through sale. This, the Complainant submits, is the basis of the Registrant's "bad faith".

20. In sum, the Complainant submits that: a) the Disputed Domain Name was registered on or about May 11, 2011, without the authority of the Complainant, b) is confusingly similar to the Complainant's corporate trade name, c) the Registrant has no legitimate interest in the Disputed Domain Name and that d) the Disputed Domain Name was registered in bad faith in accordance with paragraph 3.5 of the Policy.

21. Accordingly, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

The Position of the Registrant

22. The Registrant claims that the use of the Disputed Domain Name is one of dozens of trademark registrations in the WIPO Global Brand Database composed of or comprising RED BIRD or REDBIRD for all manner of goods and services throughout the world, none of them belonging to the Complainant. Further, there are only two registered trademarks in Canada for REDBIRD, one for paint brushes used in 1950 and another for matches in 1992. The Registrant indicates having registered the domain name at the outset since he invests in generic domain

names, which forms part of his company's stock and trade of such generic and descriptive domain names. The complainant submits having never approached or solicited the Complainant about the domain name, until the Complainant contacted the Registrant in 2017 apparently on behalf of an anonymous client to try to purchase the domain name.

The Registrant submits that when it comes to a "Mark" under the Policy, it contemplates more than a simple complaint – not just merely having a corporate name, and of its' past use. It submits that the Complainant does not claim a certification mark, registered trademark, badge crest, emblem or mark under Section 9(1)(n) of the Trade-Marks Act. The Complainant has not adduced any evidence of a trade-mark or trade name prior to the date of the registration of the disputed domain name, and that the Complainant's corporate name is not evidence of trademark use, and does not have "legitimate use".

23. The Registrant submits that the Complainant's corporate name does not identically correspond to the alleged Mark/trade name of "Redbird" as the corporate name contains the word "Communications" as well. Accordingly, use of the corporate name alone, even if evidence of it had been provided, (which it was not), would have been insufficient to prove the use of "Red Bird" as an alleged "trade name". The Complainant submits that under this reasoning, the disputed domain name is not confusingly similar.

24. As for the issue of bad faith, the Registrant asserts that the Complainant makes no allegations that it was targeted by the Registrant. Furthermore, the Complainant fails to make any express allegations which correspond to the examples of bad faith set out at Paragraph 3.5 of the Policy, but rather the Complainant makes generalized and vague allegations of bad faith, ostensibly claiming that reselling domain names for a profit constitutes bad faith under the Policy, when it does not except in limited circumstances. Accordingly, the Registrant claims that the registration of the Disputed Domain Name was not in bad faith, the use of the Disputed Domain Name is not confusingly similar to the Complainant's corporate name, and that the Registrant has a legitimate use.

It requests the Panel reject the transfer of the Disputed Domain Name to the Complainant.

Analysis and Findings

24. The purpose of the Policy as stated in paragraph 1.1 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

25. 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.

26. Paragraph 3.2 of the Policy provides in part:

3.2 Mark. A "Mark" is

(a) a trade-mark, including the word elements of a design mark, or a tradename 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;

(b) a certification mark, including the word elements of a design mark that has been used in Canada by a person or that person's predecessor in title, for the purpose of distinguishing the wares or services that are of a defined standard;

(c) a trade-mark, including the word elements of a design mark, that is registered in CIPO; or

(d) the alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of which the Registrar of Trade-marks has given public notice of adoption and use pursuant to paragraph 9(1)(n) of the *Trade-marks Act* (Canada).

27. 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 be likely to be mistaken for the Mark.

28. 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 the 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 registered the domain name in Canada in good faith in association with 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 paragraph 3.4(d) "use" by the Registrant includes, but is not limited to, use to identify a website.

29. 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 licensor or licensee for valuable consideration in excess of the Registrant's 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 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.

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

(a) The 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 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 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.

Confusingly Similar to a Mark

31. Evidence shows that the Complainant is not the owner of any registered Mark, nor has Complainant demonstrated that it has rights in any relevant Mark.

32. In accordance with paragraph 3.3 of the Policy, 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 mistaken for the Mark. In assessing the domain name, the dot-ca suffix is ignored. It is the narrow resemblance that is applied.

33. The Disputed Domain Name incorporates part of a name of the Complainant's trade name only.

34. Accordingly, for the reason stated above, the Disputed Domain Name is not confusingly similar to a Complainant's Mark, since the Complainant has no Mark.

Rights in the Mark prior to the Disputed Domain Name registration and continuing Rights

35. The Disputed Domain Name was registered on May 11, 2011.

36. As noted above, the Complainant has no registered Mark to rely upon.

37. The Panel is satisfied that in the absence of a registered Complainant's Mark that pre-dates the registration of the domain name in dispute, the Registrant does not infringe on what is essentially a corporate trade name.

Was the Disputed Domain Name registered in bad faith?

38. The Complainant relies on paragraphs (c) and (d) of 3.5 of the Policy in support of bad faith registration of the Disputed Domain Name by the Registrant. The Panel notes that the Policy provides that “if any of the 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”.

39. The Complainant relies mainly on the issue/allegation that the Registrant attempted to negotiate a price with the Complainant for the transfer of the domain name to the Complainant. Ironically, based on the email trail submitted by the Complainant, had the parties actually reached a meeting of the minds (financially), this dispute would very likely not have occurred. By way of the information submitted, what did occur is that the Complainant did not want to agree with the Registrant’s financial demands. Simply, the financial bridge between them on a proposed transaction broke down. As stated earlier, the practice of buying/registering and later selling domain names is not in and of itself prohibited by the Policy, and it continues to be an active (and, in some instances, legitimate) business practice. The prime test being that Registrants do not violate: Marks, confusingly similar phonetics, and bad faith principles of the Policy. The Complainant has attempted to establish bad faith in the Registration by and the use by the Registrant of the Complainant’s corporate trade name (which otherwise would be a Mark). The Complainant refers mainly to the similarity of the Complainant’s trade name but omits that “Red Bird” is also used and registered many times elsewhere (WIPO). Accordingly, the Complainant has not provided any relevant evidence or argument to support a bad faith registration by the Registrant.

40. The Registrant has not to the panel’s knowledge, nor has the Complainant made any attempt to compete with, or otherwise maliciously injure the Complainant’s business other than try to negotiate a transfer price with the Complainant.

41. Based on all the circumstances demonstrated in the material and all the evidence provided by the parties, the Panel is satisfied that the Complainant has not proven bad faith registration of the Disputed Domain Name as required by the Policy.

Legitimate Interest of the Registrant

42. Paragraph 3.4 of the Policy sets out a non-exhaustive list of criteria upon which the Panel may find, based on all the evidence, that the Registrant has a legitimate interest in the Disputed Domain Name. Paragraph 4.1 of the Policy places the onus on the Complainant to provide “some evidence” that the Registrant did not have a legitimate interest in the Disputed Domain Name. Although “some evidence” is not defined, it imposes, in the Panel’s view, a lower threshold than on a balance of probabilities. The onus on the Complainant is to provide “some evidence” of a negative impact.

43. The Complainant has not provided evidence in respect of the non-exhaustive list contained in paragraph 3.4 of the Policy that the Registrant has no legitimate interest in the Disputed Domain Name.

44. Based on all the evidence provided, the Panel is not satisfied that the Complainant has a legitimate interest in the Disputed Domain Name.

Decision

45. For the reasons set out herein, the Panel decides in favour of the Registrant and orders the Disputed Domain Name registration can be maintained by the Registrant.

Dated on July 30, 2019

The Panel:

The Honourable Neil Anthony Brown, QC, Douglas M. Isenberg, Esq.,
and Claude Freeman, LL.M., C. Med., C. Arb.

Per: 

Claude Freeman (Chair)

