

**IN THE MATTER OF THE ARBITRATION OF A COMPLAINT PURSUANT TO THE
CANADIAN INTERNET REGISTRATION AUTHORITY (CIRA) DOMAIN NAME
DISPUTE RESOLUTION POLICY (CDRP)**

Domain in Dispute: <slatervecchio.ca>

Complainant: Slater Vecchio LLP

Registrant: K. Mullen

Panel: Douglas M. Isenberg, Esq.

Provider: British Columbia International Commercial Arbitration Centre (BCICAC)

BCICAC File: DCA-2143-CIRA

DECISION

1. The Parties

The Complainant is Slater Vecchio LLP of Vancouver, BC, Canada (“Complainant”), represented by David Kenneth Georgetti of Yertlieb & Co. of Vancouver, BC, Canada.

According to a Supplemental Submission to the Complainant, the Registrant is K. Mullen of Victoria, British Columbia, Canada (“Registrant”).

2. The Domain Name and Registrar

The disputed domain name is <slatervecchio.ca> (the “Disputed Domain Name”), which was created on March 15, 2016, and updated on July 13, 2019.

3. Governing Policy and Rules

This is a proceeding filed with the British Columbia International Commercial Arbitration Centre (“BCICAC” or “Centre”) under the CIRA Domain Name Dispute Resolution Policy, Version 1.3 (August 22, 2011) (“CDRP” or “Policy”) and the CIRA Domain Name Dispute Resolution Rules, Version 1.5 (July 28, 2014) (“Rules”). Paragraph 1.8 of the Policy states: “The version of the Policy in effect at the time a Proceeding is initiated will apply to the Proceeding.” Paragraph 1.2 of the Rules states: “The version of the Resolution Rules in effect at the time a Proceeding is initiated will apply to that Proceeding.”

4. Procedural History

The history of this proceeding, according to the information provided by the Centre, is as follows:

- a. On September 24, 2019, Complainant filed a Complaint pursuant to the CDRP and the Rules.
- b. The Complainant identified Heinz Kreutz as the Registrant in this matter.
- c. The Centre contacted the CIRA office with a request to lock the disputed domain name and confirm the name of the Registrant. On September 24, 2019 the CIRA office advised the Centre that the Registrant of the disputed domain name is K. Mullen.

- d. On September 26, 2019, counsel for the Complainant filed a Supplemental Submission as permitted by Paragraph 11.1 of the CIRA Rules.
- e. The Complaint was successfully delivered to the Registrant, K. Mullen via electronic transmission. The deadline for the Registrant's response was set for October 15, 2019.
- f. The Registrant did not provide a Response by its due date. On October 21, 2019, the Centre notified the parties that the Registrant failed to submit the Response; therefore, under Rule 6.5, the Complainant may elect to convert from a three-person tribunal to a single-member Panel.
- g. On October 21, 2019, counsel for the Complainant advised the Centre that the Complainant has elected under Rule 6.5 to convert from a three-member Panel to a single-member Panel.
- h. On October 24, 2019, the Centre appointed the undersigned, Douglas M. Isenberg, Esq., a single-member Panel in this matter.

The Panel finds that it was properly constituted and appointed in accordance with the CDRP and the Resolution Rules. Based upon the information provided by BCICAC, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding have been met.

5. Eligible Complainant

Paragraph 1.4 of the CDRP states: "The person initiating a Proceeding (the 'Complainant') must, at the time of submitting a complaint (the 'Complaint'), satisfy the Canadian Presence Requirements for Registrants (the 'CPR') in respect of the domain name that is the subject of the Proceeding unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office ('CIPO') and the Complainant is the owner of the trade-mark." Paragraph 2(d) of the CPR states that "[a] corporation under the laws of Canada or any province or territory of Canada" is permitted to apply to CIRA (through a CIRA certified registrar) for the registration of, and to hold and maintain the registration of, a .ca domain name.

The Complainant states that it satisfies the CPR because it "is a limited liability partnership constituted under the Partnership Act, [RSBC 1996] c. 348, registered in 2008."

As a result, the Panel finds that, based on the Complaint and without any objection from the Registrant, the Complainant is an eligible complainant under paragraph 1.4 of the CDRP.

6. Factual Background and Parties' Contentions

Complainant states that "[s]ince early 1998, the Complaint has carried on business as Slater Vecchio as a firm of barristers, specifically focusing on plaintiff-side personal injury cases"; and that "Complainant's (official) website domain is www.slatervechio.com, which was registered in October of 1997 and has been in continuous use as the Complainant's primary portal to the public since early 1998."

Complainant states that the entity it named as the Registrant in the original Complaint, Heinz Kreutz ("Kreutz"), is a former client of Complainant and that Complainant and Kreutz are involved

in a defamation suit that does not relate to the Disputed Domain Name. The Complainant states that, after it learned of the Disputed Domain Name in June or July 2019 (following an injunction and contempt finding against Kreutz in the defamation action), the Disputed Domain Name “began regularly featuring additional content (nearly on a daily basis), all of which was highly disparaging of the Complainant and related parties,” including “a tab entitled ‘Hello Tony’ (a reference to Anthony Vecchio Q.C.)” that, when “clicked on, . . . redirected to a pornography site graphically displaying a photograph of three elderly men performing sexual acts on one another.”

In its supplemental submission, following identification of the Registrant as “K. Mullen,” the Complainant stated that it “is not aware of who ‘K. Mullen’ is, or indeed whether or not the registrant is a real person or a fictitious name or alter ego created by Heinz Kreutz.”

The Complainant states, but provides no evidence in support thereof, that “Complainant has common law rights to the name [Slater Vecchio] and also as it is a trade name which has been used in Canada for the purpose of distinguishing the wares, services or business of the Complainant from the wares, services or business of another”; that “[f]or over 20 years, the Complainant has continuously carried on business under the name Slater Vecchio (the ‘Mark’) and has associated with it significant goodwill and a brand reputation for providing legal services representing plaintiffs in personal injury actions”; and that “[t]he Mark is well known among the public, the medical community and the bar in respect of the provision of those services.” The Complainant states that the Disputed Domain Name is, “is, on its face, confusingly similar” to the SLATER VECCHIO mark.

Complainant argues that the Registrant has registered the Disputed Domain Name in bad faith pursuant to paragraph 3.5(3),¹ which states that the following shall be evidence that a Registrant has registered a domain name in bad faith:

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.

In support thereof, the Complainant cites *McKee Homes Ltd. v. Gerlinde Honsek*, CIRA Case No. 00079 (Resolution Canada, Inc.). In that case, the panel found bad faith even though “the Registrant’s website is intended to be a non-commercial gripe or protest website dedicated to legitimate critical commentary,” because “the use of the domain name is likely to mislead or confuse Internet users into believing that the Registrant is somehow affiliated with, or endorsed by, the Complainant” and “by adopting a domain name identical to the Complainant’s trade-mark, the Registrant is competing with the Complainant for Internet traffic by capitalizing on consumer confusion.” The Complainant does not provide any further arguments on the issue of bad faith.

The Complainant also cites the *McKee Homes* decision in support of its argument that the Registrant “has no rights in the Mark” because, although the Registrant “suggest[ed] that he and others may commence a ‘class action’ against the Complainant,” “*McKee* is authority for the proposition that even if the Registrant was pursuing a class proceeding, registering a domain which in essence is the same as a Complainant’s Mark is not a legitimate use.” The Complainant further

¹ The Complainant refers to “para. 3.5(c)” – but, based on the context, it is apparent that the Complainant is referring to paragraph 3.5(3) of the CDRP.

argues that the Registrant has no rights in the Mark because the Disputed Domain Name “is not descriptive of any wares or services”; “is not the legal name of the Registrant or other reference by which the Registrant is commonly identified”; and “is not the geographical name of the location of the Registrant’s non-commercial activity or place of business.”

As noted above, the Registrant did not submit a Response.

The Complainant requests that the Disputed Domain Name be transferred from the Registrant to the Complainant.

7. Discussion and Findings

To obtain a transfer of the Disputed Domain Name, the Complainant must, as set forth in paragraph 4.1 of the CDRP, 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.

Rights and Confusingly Similar

The CDRP, paragraph 3.2, defines a “Mark” as:

1. 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;
2. a certification mark, including the word elements of a design mark, that has been used in Canada by a person or the person’s predecessor in title, for the purpose of distinguishing wares or services that are of a defined standard;
3. a trade-mark, including the word elements of a design mark, that is registered in CIPO; or
4. 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).

It is apparent from the Complaint that the name SLATER VECCHIO does not satisfy paragraph 3.2(2) of the CDRP, because the Complainant does not allege that SLATER VECCHIO is a “certification mark”; or paragraph 3.2(3) of the CDRP, because the Complainant does not cite any

relevant registrations in the Canadian Intellectual Property Office; or paragraph 3.2(4), because the Complainant does not allege that SLATER VECCHIO satisfies the requirements of a “badge, crest, emblem or mark” in paragraph 9(1)(n) of the Trade-marks Act (Canada), which specifically refers to marks that are “(i) adopted or used by any of Her Majesty’s Forces as defined in the National Defence Act, (ii) of any university, or (iii) adopted and used by any public authority, in Canada as an official mark for goods or services.”

Rather, the Complainant explicitly says that it “has common law rights to the name” SLATER VECCHIO. The CDRP does not specifically state whether common law trademark rights are sufficient. However, because the CIRA Domain Name Dispute Resolution Rules expressly allow references to “dispute resolution proceedings which apply to domain names registered under any other top level domain which [a party] considers persuasive,” the Panel here looks to the Uniform Domain Name Dispute Resolution Policy (UDRP), which has often addressed the issue of common law trademark rights in domain name disputes. The consensus under the UDRP, as set forth in section 1.3 of the influential and often-cited WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, is as follows:

To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services.

Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys....

Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning. In cases involving unregistered or common law marks that are comprised solely of descriptive terms which are not inherently distinctive, there is a greater onus on the complainant to present evidence of acquired distinctiveness/secondary meaning.

In this case, the only one of the five factors listed above that the Complainant has referenced is the duration of its use of the name “Slater Vecchio,” which the Complainant says it has used since early 1998. While 21+ years is indeed a relatively long period of time, the duration of use is only one of multiple factors to consider. And, perhaps even more importantly, the Complainant has provided no “[s]pecific evidence supporting assertions of acquired distinctiveness” and instead has made only “conclusory allegations of unregistered or common law rights” – which the WIPO Overview makes clear is normally insufficient.

The WIPO Overview’s description of common law trademark rights is not unique to the UDRP. Indeed, CDRP panels have taken a similar position. For example, in *Delta9 Bio-Tech Inc. v. DELTA NINE*, DCA-1980-CIRA, the panel found that the complainant had acquired common law rights in the relevant trademark – but only after examining relevant evidence submitted by the complainant, including a press release, magazine article and “evidence of the Complainant’s website” as of a date that pre-dated registration of the disputed domain name. In that case, the

complainant also presented copies of three trademark applications at CIPO, two of which the panel said “support the proposition that the Complainant adopted [the relevant mark] as its trademarks in the trade and industry in question from at least” a date prior to registration of the disputed domain name.

Here, unlike in *Delta9 Bio-Tech*, the Complainant has provided no press releases or magazine articles showing use of the name “Slater Vecchio,” and although the Complainant provided printouts of multiple pages from its website using the name, the printouts are not dated and the Complainant does not state when the printouts were obtained. Plus, although the Panel is skeptical of the relevance of pending trademark applications, the Complainant here, unlike in *Delta9 Bio-Tech*, did not present evidence of any applications for the SLATER VECCHIO mark.

While it may be that the Complainant has Rights in the name “Slater Vecchio” as a Mark, the Panel cannot reach such a conclusion based upon the evidence (or, rather, the lack of evidence) in the record. Granted, the Panel could issue an order to the Complainant pursuant to the Panel’s powers under paragraph 9.1 of the Rules, requesting evidence that the name “Slater Vecchio” is a Mark, but doing so would be contrary to the stated purpose of the CDRP, which “is to provide a forum in which cases of bad faith registration of domain names registered in the dot-ca country code top level domain name registry operated by CIRA (the ‘Registry’) can be dealt with relatively inexpensively and quickly.” CDRP, paragraph 1.1 (emphasis added).

Accordingly, the Panel finds that the Complainant has not proven on a balance of probabilities that the Disputed Domain Name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the Disputed Domain Name and continues to have such Rights, as required by paragraph 4.1(1) of the CDRP.

Bad Faith

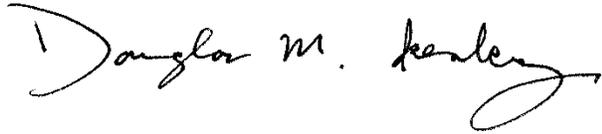
In light of the Panel’s findings above, it is unnecessary for the Panel to determine whether the Complainant has met its burden of proof with respect to bad faith under paragraph 4.1(2) of the CDRP and, accordingly, the Panel declines to do so.

No Legitimate Interest

In light of the Panel’s findings above, it is unnecessary for the Panel to determine whether the Complainant has met its burden of proof with respect to legitimate interests under paragraph 4.1(3) of the CDRP and, accordingly, the Panel declines to do so.

8. Decision

For all the foregoing reasons, in accordance with paragraph 4.3 of the CDRP, the Panel orders that the Disputed Domain Name <slatervecchio.ca> remain with the Registrant.

A handwritten signature in black ink that reads "Douglas M. Isenberg". The signature is written in a cursive style with a large, looping initial 'D' and a long, sweeping underline.

Douglas M. Isenberg, Esq. (Sole Panelist)

Dated: November 11, 2019