

CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY

Dispute Number: DCA - 2211 - CIRA
Domain Names: mapgroup.ca / mapcapital.ca
Complainants: MAP Asset Management Corporation and Mike Petrovski
Registrant: Andrej Kalesoski
Panel: Douglas M. Isenberg, Esq., Anton Melnyk, QC,
and Claude Freeman, LL.M., C. Med., C. Arb. (Chair)
Service Provider: British Columbia International Commercial Arbitration
Centre

DECISION

The Parties

1. The complainants are MAP Asset Management Corporation (“MAPA”) and Mike Petrovski of Markham, Ontario (the “Complainants”).
2. The Registrant is Andrej Kalesoski (the “Registrant”).

The Disputed Domain Name and Registrar

3. The Domain Names at issue are mapgroup.ca / mapcapital.ca (the Disputed Domain Names).
4. The original Registrar of record for the Disputed Domain Names is NameSilo Technologies Inc.
5. The Disputed Domain Names were registered on January 25, 2019, and July 21, 2019, respectively.

Procedural History

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

7. The Complainants filed a complaint on April 21, 2020 (the Complaint) with the BCICAC (via email) seeking an order in accordance with the Policy and the Rules that the Disputed Domain Names be transferred to the Complainant.
8. BCICAC confirmed the Complaint to be in administrative compliance with the Rules and on April 24, 2020, forwarded copy of the Complaint to the Registrant in accordance with the Rules, and advised the Registrant that the response was due on May 14, 2020.
9. Since the Complaint and the attachments were filed exclusively online, the Centre delivered the Complaint to the Registrant only via email.
10. On May 15, 2020, the Registrant delivered its response to the Centre via email. Included in the Response was a claim for costs as permitted by Paragraph 4.6 of the Policy. The Registrant's Response was reviewed by the Centre and delivered to the Complainants the same day.
11. The Complainants filed a Supplemental Response on May 20, 2020.
12. The Registrant in his email of May 20, 2020, raised concerns that the Complainants' Supplemental Response is "*outside of the scope of an answer to the 4.6 claim*".
13. On May 21, 2020, the BCICAC (in accordance with Paragraph 6 of the Rules), named Douglas M. Isenberg, Esq., Anton Melnyk, QC as panelists, and Claude Freeman, LL.M., C. Med., C. Arb. as Chair of the Panel to determine the matter.
14. 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.

Canadian Presence Requirements

15. 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.
16. Though the Complainants are not the owners of any Canadian trade mark registrations, the corporate complainants are registered Ontario corporations. Accordingly, the Presence Requirements are satisfied.

The Position of the Parties

The Position of the Complainant

17. The Complainant's position is quite straightforward. It submits having incorporated its business on May 7, 2018. Its primary area of business is the sourcing, development and building of sustainable, affordable housing to create a more consumer diverse housing supply in growing communities.

18. On May 7, 2018, MAPA was incorporated pursuant to the laws of the Province of Ontario. On February 28, 2019, MAPA filed a certificate of incorporation for a subsidiary company by the name of MAP Capital Inc ("MAPAC"). The Complainants submit that they have been using the MAP GROUP and MAP CAPITAL "trademarks" on promotional material and all business cards distributed to potential investors and consumers for both companies, since the outset of the operations. Copies of the cards and promotional materials have been submitted as exhibits in support of the Complaint.

As well, the domains names in dispute have been regularly displayed and used on the business cards and materials used in promoting the services of the corporate complainant(s). It is important to note that, in the complaint documents MAPAC is captured as a corporate complainant via the founder of MAPA, since the registration of MAPAC was initiated by the founder of MAPA, Mr. Mike Petrovski (also a Complainant to this proceeding). MAPAC is a wholly owned subsidiary of MAPA.

The Complaints assert that "mapgroup.ca" and "mapcapital.ca" are not only corporate assets of the respective corporate complainant(s), but that any use of these .ca names elsewhere is confusingly similar to the corporate names of the complainant(s).

The Complaints submit copies of registered corporate existence in support of its business legitimacy, existence and market presence, since the outset of their operations.

In sum, the corporate Complainant (MAPA), which is also on record for being the parent company of MAPAC, refers to its registered trade name and public use of promotional and other materials, including public funding offerings, in support of its business and ownership legitimacy, including the disputed domain names. The Complainant submits having "unregistered trade marks" in the corporate entities of MAPA and MAPAC.

The complainant(s) also submit that its uninterrupted business legitimacy also includes the control of the disputed domain names.

The issue of control is at the heart of this proceeding, since the Complainant(s) allege that the Registrant has effectively locked out the Complainant(s) from their ability to enter into the website hosting administration platform such that website updates and modifications can be conducted. This issue has been supported by email communications between the website hosting company and the Registrant.

The Complainant(s) go further to submit that they attempted to resolve the matter amicably, without the need for this proceeding, however, those efforts went without any cooperation by the Registrant.

The Complainant(s) submit that the Registrant has no legitimate use of the Disputed domain Names, and that their remedy request therefore is that ownership of the Disputed Domain Names be transferred to the Complainant(s) immediately.

What makes this particular case different from other .ca disputes is that in this particular case, the .ca names in dispute were originally registered by the Registrant on behalf of the Complainants and are still being used for Complainants' benefit.

The domains names in dispute were registered by the Registrant during his employment tenure as an IT specialist with the corporate complainant(s). The registrations were made and paid for by the corporate complainant(s), at the behest of his employer, and for enduring benefit of the company.

The central issues at stake in this matter are those of ownership legitimacy, and confusingly similar (in the unforeseen event that ownership by the corporate complainant(s) isn't supported), with the next issue being that of bad faith.

The Position of the Registrant

19. The Registrant claims that the Complaint is fraudulent, in error, and has no basis in fact or law.

20. More specifically, in his Response, the Registrant has considerably discussed that there is existing litigation and disputed issues between himself and the principal of the corporate complainant(s), Mike Petrovski. However, these litigation issues have not been provided in evidence by the Registrant.

A great deal of the Response recites and deals with a litany of these disputed issues between himself and the Complainant(s). These issues raised by the Registrant didn't address the issues/tests of legitimate interest, confusingly similar, and bad faith.

The registrant also submits explanations regarding his involvement and participation in the two corporate entities whose disputed domain names are at issue, however again didn't address the issues/tests of legitimate interest, confusingly similar and bad faith.

In respect of the response provided by the Registrant that deals directly with the Disputed Domain Names, the Registrant agrees (paragraph #18) that the 'Map Group' mark rightfully belongs to MAPA. In paragraph #19 of the response the Registrant cites that the 'Map Capital' mark rightfully belongs to Map Capital Inc. The Registrant further refers to sole and personal ownership of the marks as the core issue of the debate.

In paragraph #82 of the Registrant's response, he goes further to indicate that there is a genuine dispute regarding the ownership of the companies, and that the CDRP is not the appropriate venue to resolve it.

The Registrant has also raised the issue of seeking financial awards (under Parag. 4.6 of the Policy) in the event the Registrant is successful, and proves on a balance of probabilities, that the Complaint was commenced for the purpose of unfairly and without colour of right, to cancel or otherwise or obtain a transfer of any Registration which is the subject of the proceeding.

Analysis and Findings

21. 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

22. 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.

23. 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).

23. 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.

24. 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.

25. 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.

26. 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 Disputed Domain Name and continues to have such Rights;
 2. The Registrant has registered the Disputed Domain Name in bad faith; and
 3. The Complainant must provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Name.
 4. Notwithstanding the evidence presented that the Registrant has no legitimate interest in the Disputed Domain Name, the Registrant will succeed if the Registrant proves on a balance of probabilities that he has a legitimate interest in the Disputed Domain Name.

Confusingly Similar to a Mark

27. Evidence shows that the Complainants are not the owner of any registered Trade Mark, but of trade names, or at the least unregistered trademark rights. As set forth above, the Policy provides that "a trade name that has been used in Canada" qualifies as a "Mark."

28. 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.

29. The Disputed Domain Names incorporate parts of the Complainant's trade names.

30. Accordingly, for the reason stated above, the Disputed Domain Names are confusingly similar to the Complainant(s) Marks.

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

31. The Disputed Domain Names were registered on May 7, 2018 and February 28, 2019 respectively.

32. As noted above, the Complainant(s) have Marks to rely upon.

33. The Panel is satisfied that the Complainant(s) Marks pre-date the registration/control of the domain names in dispute. In sum, the incorporations of the corporations are listed as May 7, 2018, and February 28, 2019. The materials used in marketing/promotion and sales of the corporate entities have been submitted in support of the usage of the trade names or Mark, which all pre-dates the registration of the Domain Names in dispute. The domain names of “mapcapital.ca” and “mapgroup.ca” were registered on January 25, 2019 and July 21, 2019 respectively. The transfer of control of the Domain Names in dispute were transferred after the registration dates above, though a string of emails was submitted in the Complaint dated December, 2019 between the Registrant and the Registrar of record NameSilo Technologies Corp discussing the recent freezing/locking out of the entire account.

Was the Disputed Domain Name registered in bad faith?

34. 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”.

35. The Complainant relies heavily on the issue/allegation that the Registrant attempted to, and successfully interfered with the administrative webhosting controls for the Disputed Domain Names, by effectively locking out the corporations whose names relate to those Domain Names. By so doing, this has set into motion the inability for the corporations to manage their business web identities that have an interrelationship between trade names and domain names, which have since the outset of their incorporations been intertwined and synonymous. This particular Domain Names by virtue of his shareholdings in the corporations.

Although the Disputed Domain Names are currently still being used for Complainants’ benefit, Complainants do not have control over the Disputed Domain Names and, therefore, cannot determine how email addresses associated with the Disputed Domain Names may be configured, nor can Complainants be certain that the Disputed Domain Names will continue to resolve to Complainants’ website. Complainants need not wait for some future use of the Disputed Domain Names to occur to demonstrate the Registrant’s bad faith use. Instead, by taking control of the Disputed Domain Names away from Complainants, the Registrant has misappropriated the Disputed Domain Names.

36. 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 proven bad faith registration of the Disputed Domain Name as required by the Policy.

Legitimate Interest of the Registrant

37. 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.

38. The Complainant has 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 Names.

39. Based on all the evidence provided, the Panel is satisfied that the Corporate Complainant has a legitimate interest in its Disputed Domain Name.

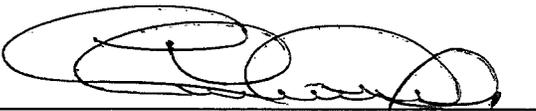
Decision

40. For the reasons set out herein, the Panel decides in favour of the corporate Complainant (MAPA), and orders the Disputed Domain Name registrations of “mapgroup.ca” and “mapcapital.ca” be immediately transferred to the Complainant MAP Asset Management Corporation.

Dated on June 9, 2020

The Panel:

Douglas M. Isenberg, Esq., Anton Melnyk, QC, and Claude Freeman, LL.M., C.Med., C. Arb.

Per: 
Claude Freeman (Chair)

