

IN THE MATTER OF
A Complaint pursuant to the Canadian Internet Registration Authority (**CIRA**)
Dispute Resolution Policy (“**Policy**”) and Domain Name Dispute Resolution Rules (the **Rules**).

File Number: **2243-CIRA**
Domain Name: trucksuite.ca
Complainant: Trucksuite LLC
Registrant: Paul Donofrio / Donofrio Auto Group /
 My Trucks Advisor
Registrar: Netfirms Ltd.
Panel: Chair - Michael Erdle
 Member – Craig R. Chiasson
 Member – Melvyn J. Simburg
Service Provider: British Columbia International Commercial Arbitration Centre (BCICAC)

DECISION

Procedural History

On July 2, 2020, the Complainant filed a complaint (the “Complaint”) against the Registrant with the BCICAC, with respect to the registration of <**trucksuite.ca**> (the “Domain Name”).

On July 3, 2020, the BCICAC forwarded a copy of the Complaint to the Registrant via email, in accordance with the Rules.

On July 23, 2020, the Registrant submitted its response (the “Response”) to the Complaint to the BCICAC, in accordance with the Policy and Rules.

On July 29, 2020, the Complainant submitted a further response (the “Complainant’s Response”) under Rule 11.1, with respect to Registrant’s request for costs.

The panel members were appointed by BCICAC in accordance with the Rules, on August 4, 2020. Each of the panel members accepted the appointment and confirmed his impartiality and independence, as required under Paragraph 7 of the Rules.

Factual Background

The following summarizes the evidence and submissions in the Complaint, Response and Complainant’s Response.

The Complainant is Trucksuite LLC, with a business address at 160 Charlois Boulevard, Winston Salem, North Carolina, United States of America.

The Complainant states that it began operations as Trucksuite in the USA on or about December 9, 2016. It states it began doing business in Canada in the spring of 2019.

The Complainant provides a variety of transportation-related services, including truck warranty services.

It alleges that it uses the domain name <trucksuite.com> in the USA.

The Complainant does not have a registered trademark for TRUCKSUITE; however, it states that it has common law rights in the mark under paragraph 3.2(a) of the Policy based on its trademark application filed with CIPO and based on its operations in the USA under the mark “TRUCKSUITE” for four years.

The Complainant filed a trademark application in the United States of America on October 8, 2019, for the mark TRUCKSUITE, for various truck-related services.

The Complainant filed a trademark application in Canada on February 26, 2020, for the word TRUCKSUITE in association with services, including accounting and bookkeeping, truck warranty services, truck repair, maintenance and monitoring services. The application claims a priority date of October 8, 2019, based on Complainant’s US trademark application. The Domain Name was registered by the Registrant on April 23, 2019.

The Registrant is identified by the BCICAC as Paul Donofrio, carrying on business as Donofrio Auto Group, with an address in Woodbridge Ontario. In the Complaint and Response, the Registrant is referred to as “My Trucks Advisor” a truck warranty business carried on by Mr. Donofrio.

The Registrant states that Mr. Donofrio is “a long-time Canadian truck warranty business insider.” He entered into discussions with Lynn Murphy, the representative of the Complainant, in the spring of 2019, about expanding the Trucksuite business into Canada.

The Registrant states that Mr. Donofrio registered the business name “Trucksuite Canada” in Ontario in April 2019. He registered the Domain Name at the same time.

The Registrant states that the parties continued to discuss a potential business relationship during the summer and fall of 2019.

Trucksuite Canada Limited was incorporated under the Canada Business Corporations Act, on January 2, 2020. Neither party submitted any evidence with respect to the ownership of Trucksuite Canada, or its legal relationship to the Complainant. The Complainant states that “...it is incorporated under the name Trucksuite LLC in Canada...” but the Complainant makes no claim about Trucksuite Canada Ltd., which necessarily is an entity different from Trucksuite LLC, the Complainant.

Ms. Murphy and Mr. Donofrio were listed as two of the four directors of Trucksuite Canada Ltd. in a Federal Corporation Information report dated June 27, 2020, submitted by the Registrant.

Scope of the Complaint

According to the Policy, the purpose of the Policy is to “provide a forum in which cases of bad faith registration of [.ca] domain names ... can be dealt with relatively inexpensively and quickly.”

It is not intended to resolve broader business or other disputes which may arise between trademark owners and registrants of domain names.

From the materials submitted by both parties, it appears that their discussions and business relationship broke down in February 2020.

While the parties contest the details of events that occurred in 2020, it appears that there is an ongoing business dispute between the parties with respect to Mr. Donofrio's involvement in the Canadian venture, his registration of the business name and Domain Name in 2019, his role in the Canadian corporation after it was incorporated in 2020, and various activities to promote the business venture in Canada.

According to the Complainant, Mr. Donofrio exceeded his mandate in purporting to act on behalf of the business and acted in bad faith in registering the Domain Name and business name.

According to Mr. Donofrio, the Complainant acted in bad faith in cutting him out of the business venture and entering into an agreement with a third party in March 2020.

This larger business dispute is outside the scope of this Complaint and the Policy generally and, in making this award, we make no comments or findings intended to influence or determine any aspect of the merits of that dispute.

Requested Remedies

The Complainant requests that the Panel order that the Domain Name be transferred to the Complainant.

The Registrant requests that the Panel dismiss the complaint, with costs against the Complainant.

Eligibility

Paragraph 1.4 of the Policy requires that the person initiating a Complaint must, at the time of submitting the Complaint, satisfy the Canadian Presence Requirements for Registrants ("CPR") in respect of the domain name, unless the Complaint related to a trademark registered with the Canadian Intellectual Property Office ("CIPO") and the Complainant is the owner of the trademark.

The Complainant states that it satisfies the CPR because it is a corporation incorporated under the laws of Canada.

However, based on the record before us, including the Complainant's own description of itself in the Complaint, the Complainant is not a corporation incorporated under the laws of Canada but is instead an LLC registered in the United States. On this basis alone, it does not satisfy the CPR.

Based on the record before us, the Complainant is not currently the owner of a trademark which is the subject of a registration under the Trade-marks Act (Canada), as provided in Paragraph 2(q) of the CPR. The record shows that it has a pending application, which does not satisfy the CPR.

The Complainant has not asserted or provided any evidence that could give rise to another basis for meeting the CPR.

Accordingly, we conclude that the Complainant does not satisfy the CPR.

Even if we were to have found that the Complainant had satisfied the CPR, we find that the Complainant does not satisfy the requirements for a transfer or deletion of the Domain Name, for the following reasons.

Reasons for Award

Burden of Proof

Under the Paragraph 4.1 of the Policy, the onus is on the Complainant to prove on a balance of probabilities that the domain name is confusingly similar to Complainant's trademark, that the Complainant has rights in the mark, and that it has been registered in bad faith.

The Complainant must also provide "some evidence" that the Registrant has no legitimate interest in the disputed domain name.

If the Complainant satisfies these requirements, the Registrant will succeed if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name.

Confusingly Similar & Rights in the Trade-mark

Paragraph 4.1(a) of the Policy requires that the Complainant must prove, on a balance of probabilities, that:

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.

There is no dispute that the Domain Name is identical to the TRUCKSUITE mark claimed by the Complainant. If that were the end of the analysis, the claimed mark would be confusingly similar pursuant to the Policy.

However, there is a dispute with respect to the Complainant's Rights in a Mark, as defined by the Policy.

The Complainant's position is that it has common law trademark rights in Canada because it has been operating in the United States since 2016. It says the term "TRUCKSUITE" is generally understood by the public in Canada and the United States to refer to the Complainant.

The Registrant's position is that the Complainant had no business presence in Canada prior to April 2019. He claims that he has common law rights in the disputed name by virtue of his own business name registration for "Trucksuite Canada". He further claims that the Complainant had no goodwill or reputation in Canada prior to registration of the Domain Name.

The Registrant also submitted material indicating that, on January 22, 2020, the United States Patent and Trademark Office (USPTO) issued a refusal to register the mark on the basis that it "merely describes a feature or characteristic of applicant's services." The extract from the notice submitted by the Registrant states that the applicant may challenge the refusal, and may elect to amend the application to seek registration on the Supplemental Register. We have no further evidence relating to the USPTO application.

The Registrant argues that this refusal shows that the Complainant has no “Rights” in the TRUCKSUITE mark, as required by the Policy. We do not agree. The word “Rights” is not defined in the Policy and may include common law rights.

The question then is whether the Complainant had Rights in a “Mark”, as defined in the Policy.

A “Mark” includes a trademark registered in Canada. The Complainant does not have a registered trademark. It has a pending application.

A “Mark” is also defined, in part, as “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 (emphasis added).” (Paragraph 3.2(a))

This includes common law trademarks and trade names, but requires that the Complainant must show that the trademark or trade name was used in Canada prior to the registration of the Domain Name. The Complainant has not provided any evidence of such use by Complainant.

The Complaint and Response raise issues of fact as to whether the Registrant’s registration in Ontario of the trade name “Trucksuite Canada” was intended to be or should have been on behalf of the Complainant. Resolution of those factual issues is outside the scope of this decision and part of the parties’ larger business dispute referred to above.

Based on the record before us, we find that the Complainant has not met the onus of proving on a balance of probabilities that it had rights in a trademark or trade name used in Canada prior to the date of registration of the Domain Name, as required by Paragraph 4.1(a) of the Policy.

Even if the complaint had been made by Trucksuite Canada Ltd., it would not meet the test for Rights in a Mark in Canada prior to the date of registration of the Domain Name because Trucksuite Canada Ltd. was not incorporated until after that date.

Based on the Complainant’s failure to meet the CPR requirements and failure to meet the requirements in Paragraph 4.1(a) of the Policy, we find in favour of the Registrant and the Complainant’s application is denied.

Registration in Bad Faith and Legitimate Interest

Paragraph 4.1(b) of the Policy requires that the Complainant must prove, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith as described in Paragraph 3.5, which provides non-exhaustive examples of bad faith registration.

Paragraph 4.1(c) of the Policy requires that the Complainant provide “some evidence” that the Registrant has no legitimate interest in the Domain Name. The onus is then on the Registrant to show that he does have a legitimate interest.

Paragraph 3.4 of the Policy provides a list of instances when a registrant can establish a “Legitimate Interest” in a domain name.

The Complainant’s position is that the Registrant registered the Domain Name in bad faith because he registered both the trade name Trucksuite Canada and the Domain Name for the purpose of transferring them to the Complainant, or to a corporation to be incorporated in Canada.

The Complainant also states that Registrant linked the Domain Name to his own personal website. It says the Registrant subsequently directed the domain name to Complainant's US website, but when their relationship broke down, he redirected it to his own site and used it for his own commercial gain.

The Complainant says the Registrant also linked the Domain Name to a strip club or pornography site in China for a period of time. It says this was intended to disrupt the Complainant's business. No evidence was submitted in relation to this allegation.

The Complainant also did not provide any evidence in support of the claim that the Domain Name was used for commercial gain by the Registrant or used to disrupt the Complainant's business.

The Complainant's position is that the Registrant has no legitimate interest, because he did not register the Domain Name in good faith and is not currently involved in the Canadian business venture. It says the Registrant does not meet any of the criteria in the Paragraph 3.4 of the Policy.

The Registrant's position is that he does have a legitimate interest due to the promises made to him regarding the Canadian business venture and his involvement as a director and shareholder of the Canadian venture.

The Registrant's position is that he acted in good faith in registering the Domain Name in anticipation of his involvement in the Canadian business. He states that the Complainant was aware of the registration and that it was made to protect their mutual business interests. He states that the parties spent much of 2019 discussing details of the proposed business venture and alleges that the Complainant's objections and this complaint arose only after their relationship broke down and are the result of their ongoing business dispute.

As previously noted, the merits of that dispute are beyond the scope of this Complaint.

In light of our determination with respect to Eligibility and Rights in the Trademark, above, we do not find it necessary to decide whether the Registrant registered or used the Domain Name in bad faith or whether the Registrant has a legitimate interest in the Domain Name and we do not do so.

Nothing in our decision should have any bearing on whether a court or arbitrator of competent jurisdiction over the parties' broader commercial dispute may find other reasons for making orders in relation to the use and ownership of the Domain Name, including bad faith on the part of one party or the other or a legitimate interest of the Registrant.

Costs

In his submission, the Registrant seeks dismissal of the Complaint "with costs against the Complainant."

The Complainant's Response addresses the request for costs.

Paragraph 4.6 of the Policy provides that if the Registrant is successful and 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" the Panel may order the Complainant to pay up to \$5000 for defray Registrant's costs relating to the proceeding.

The Registrant argues that the Complaint was commenced by the Complainant unfairly and without colour of right (in bad faith) due to the broader business dispute between the parties.

The Complainant submits that, even if the Registrant is successful, there is no basis for a finding that the Complainant commenced the proceeding unfairly and without colour of right.

We agree.

As acknowledged by the Registrant in his submissions, the parties clearly have a dispute relating to the Domain Name:

The matters at issue in this dispute are, with all due respect, too complex to be decided in this forum. The CIRA dispute resolution process is designed for a quick and expedited proceedings of simple matters. This venue is not the proper forum as there are complex material issues involving years long relationship that can only be properly heard in a full court proceeding.

Although these broader material issues exist, we do not find that the Complainant commenced the proceeding unfairly and without colour of right.

Decision and Order

Based on the evidence and record before us, we find that:

1. The Complainant does not meet the Canadian Presence Requirement, pursuant to Paragraph 1.4 of the Policy.
2. The Complainant has not proven on a balance of probabilities that the Domain Name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the Domain Name, pursuant to Paragraphs 3.1(a), 3.2, and 4.1(a) of the Policy.
3. The Registrant has not proven on a balance of probabilities that the Complainant acted unfairly and without colour of right in making the Complaint.

For the reasons above, we do not find it necessary or appropriate in the circumstances to make findings on the issues of bad faith and legitimate interest.

We order and direct that the Complaint be denied, without costs.

Made this 20th day of August, 2020.



Michael Erdle, chair, on behalf of the panel

Craig R. Chiasson

Melvyn J. Simburg