

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Domain Name: covercrete.ca
Complainant: Covercrete (Canada) Ltd.
Registrant: Epoxy Solutions Inc.
Registrar: Reggie.ca Inc.
Panel: Rodney C. Kyle
Service Provider: Resolution Canada Inc.

DECISION

PARTIES

Complainant is **Covercrete (Canada) Ltd.**, of Unit 27, 1550 Bayly Street, Pickering, Ontario L1W 3W1 (“Complainant”), represented by **Robin Mason**, of **Mason Bennett Johncox**, of Whitby, Ontario.

Registrant is **Epoxy Solutions Inc.**, of P.O. Box 2097, Brampton, Ontario L6T 3S3 (“Registrant”), unrepresented.

REGISTRAR AND CONTESTED DOMAIN NAME

The contested domain name is <**covercrete.ca**> (“the contested domain name”), registered with **Reggie.ca Inc.**

PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this Proceeding.

Rodney C. Kyle as Sole Panelist.

PROCEDURAL HISTORY

On May 21, 2004, Complainant apparently submitted a Complaint to Resolution Canada Inc. (“Resolution Canada”) electronically and in hard copy, each of which, instead of referring to the contested domain name, referred to <www.covercrete.ca>. On May 25, 2004, Resolution Canada received a finalized version of the Complaint in that, by a fax of that date, Complainant requested that in the May 21, 2004 version of the Complaint each reference to <www.covercrete.ca> be read as <covercrete.ca>. (Hereinafter, “the Complaint” is the May 21, 2004 Complaint version and the May 25, 2004 fax.)

The Panel assumes that in accordance with CIRA Dispute Resolution Rules Version 1.2 (“Resolution Rules”) ¶ 4.3 made under CIRA Dispute Resolution Policy Version 1.1 (the “Policy”), and in the manner prescribed by Resolution Rules ¶ 2.1, Resolution Canada

sent the Complaint to Registrant. (On June 29, 2004, and subsequently, the Panel e-mailed Resolution Canada inquiring as to such things as whether and on what date that sending of the Complaint occurred, but those inquiries are unanswered.)

The Panel assumes that in accordance with Resolution Rules ¶ 4.4 and pursuant to Resolution Rules ¶ 2.6, Resolution Canada sent a notice of the commencement of the Proceeding to Registrant, setting a deadline by which Registrant could file a Response to the Complaint. (On June 29, 2004, and subsequently, the Panel e-mailed Resolution Canada inquiring as to such things as whether and on what date that sending of a notice occurred, and whether and what deadline Resolution Canada had set for a Response, but those inquiries are unanswered.)

A Response was apparently not received by Resolution Canada.

On June 26, 2004, in accordance with Resolution Rules ¶ 6.5 and 6.8, and pursuant to Complainant's request to have the dispute decided by a sole panelist, Resolution Canada appointed Rodney C. Kyle as the Panelist, gave the Parties (as well as Reggie.ca Inc., CIRA, and the Panel) notice of that appointment, and forwarded the file for the Proceeding to the Panel.¹ (By "the file for the Proceeding," the Panel means solely the Complaint.) In accordance with Resolution Rules ¶¶ 7.1 and 7.2, prior to being appointed the Panelist provided Resolution Canada with his declaration of his independence and impartiality.

RELIEF SOUGHT

Complainant requests the transfer of the contested domain name to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Basically, in the Complaint, Complainant makes four main sets of contentions.

FIRST MAIN SET

In the first main set of contentions, Complainant basically contends that Complainant is eligible to initiate the Proceeding. More particularly, Complainant basically contends (i) that on April 19, 1984, a corporation named "Covercrete (Canada) Ltd." was incorporated under Canadian federal law and that Complainant is that corporation, as evidenced by the copy of a Certificate of Incorporation that is Complaint Schedule A; and (ii) that the Complaint relates to two trade-marks registered in the Canadian Intellectual Property Office (as registrations TMA562801 and TMA562802, each for COVERCRETE FLOORING SYSTEMS plus respective design features) and that Complainant is the owner of those trade-marks, as respectively evidenced by copies of such registrations that are Complaint Schedules B and C.

¹ That notice also stated July 19, 2004 as the date by which the Panel was to forward its decision in the Proceeding to Resolution Canada. In accordance with Policy ¶ 4.2 and Resolution Rules ¶ 9.1(c) and 1.4, that date was extended to July 26, 2004.

SECOND MAIN SET

In the second main set of contentions, Complainant basically makes contentions by way of three points.

The first point is that the contested domain name is registered to Registrant.

The second point is as to Complainant "Rights" in four "Marks," and has two sub-points.

The first sub-point is that there are four marks owned by Complainant, each of which is a "Mark" within the meaning of that expression as defined by Policy ¶ 3.2: (i) two "Marks" being within Policy ¶ 3.2(a) as a common-law trade-mark and a common-law trade-name, each for COVERCRETE, through having been used in Canada by Complainant or Complainant's predecessor-in-title (i.e. a named individual who is the President, and a director, of Complainant and is the contact person of Complainant) since at least as early as January, 1983 (as a trade-mark in association with services and as a trade-name in association with a services business) and by Complainant since January, 1998 (as a trade-mark in association with wares and as a trade-name in association with a wares business), for the purposes of distinguishing (and to the point of gaining independent recognition of and goodwill associated with) the wares, services, and business of Complainant or its predecessor-in-title from the wares, services, and business of one or more other persons; and (ii) the other two "Marks" being within Policy ¶ 3.2(c) as CIPO-registered trade-marks TMA562801 and TMA562802 each for COVERCRETE FLOORING SYSTEMS plus respective design features, through Complainant having applied for such registrations on the basis of proposed trade-mark use and having obtained such registrations on May 29, 2002 for wares and services, on bases that included declarations of trade-mark use dated May 22, 2002 although, Complainant contends, each was actually first used as a trade-mark and trade-name in January, 1998 and has been continually used as a trade-mark and trade-name ever since that date. (Complainant also basically contends that for the respective four contended "Marks," (i) the wares, services, and business activities are as stated in the CIPO registrations; and (ii) the Complaint sets out those wares, services, and business activities.)

More particularly, Complainant contends that as to the contended common-law trade-mark and common-law trade-name, the use of COVERCRETE was (i) by registration of "Covercrete Flooring" as a business name in 1982 under Ontario's Business Names Act and subsequent use thereof, and by the April 19, 1984 incorporation of Complainant and use since then of Complainant's corporate name (i.e. "Covercrete (Canada) Ltd."), each of said registration and said incorporation having been seen to by the above-mentioned individual (who is the President, and a director, of Complainant and is the contact person of Complainant), all as evidenced by that individual's statutory declaration that is Complaint Schedule D and by the copy of a Certificate of Incorporation that is Complaint Schedule A; and (ii) by Complainant's use in Canada of the domain name <covercrete.com> as an internet trade-name, beginning since shortly after Complainant's April 22, 1998 registration thereof, said registration being evidenced by the copy of the domain name registration record that is Complaint Schedule E, and said use being

evidenced by the copies of all of the pages that resolve through Complainant's web site at <www.covercrete.com> that are Complaint Schedule F. Also more particularly, Complainant contends, mainly as to the two CIPO registrations, that (i) they are respectively evidenced by the copies of registration records that are Complaint Schedules B and C; (ii) a statutory declaration, i.e. Complaint Schedule G by the above-mentioned individual (who is the President, and a director, of Complainant and is the contact person of Complainant), evidences that each CIPO-registered mark was actually first used as a trade-mark, and trade-name, in January, 1998; and (iii) the business name use and corporate name use, each contended above, is longstanding and thereby necessarily creates a nexus between those two names and the two CIPO registrations such that the subsequent CIPO registrations "should be of persuasive weight in the determination of the issues of ownership and use of such Marks."

The second sub-point is that, with respect to each of those four contended "Marks," not only does Complainant have "Rights" within the meaning of that expression as defined by Policy ¶ 3.3 (which Complainant basically contends through what is set out in the two immediately preceding paragraphs hereof), but also that Complainant had such "Rights" prior to the date of registration of the contested domain name.

The third point is that the contested domain name is "Confusingly Similar" to each of those four contended "Marks," within the meaning of the expression "Confusingly Similar" as defined by Policy ¶ 3.4. More particularly, Complainant contends that the contested domain name is "Confusingly Similar" to each of those contended "Marks," on the bases that (i) the Policy ¶ 1.2 definition of "domain name" excludes the dot-ca suffix such that the contested domain name is identical to each of those four "Marks" and, being identical thereto, any use of the contested domain name is "Confusingly Similar" use; (ii) "Covercrete" is a coined word, such that any use of that word is likely to be "Confusingly Similar" use; (iii) there is a component of the common-law trade-mark Mark, and of the common-law trade-name Mark, which is a unique identifier and said unique identifier is "Covercrete," rather than "Flooring" in "Covercrete Flooring" and especially rather than "(Canada)" in "Covercrete (Canada) Ltd." since in that corporate name the parentheses in "(Canada)" inclines a reader of that corporate name to read "Covercrete" as separate from that corporate name.

In the second main set of contentions, Complainant also contends that on topics addressed by the second main set of contentions the facts of the present case are analogous to the facts of various panel decisions made under the Policy or under another domain name dispute resolution policy, which decisions Complainant quotes from, cites, indexes, and attaches to the Complaint.

THIRD MAIN SET

In the third main set of contentions, Complainant basically contends that Registrant has no "legitimate interest" in the contested domain name, within the meaning of the expression "legitimate interest" as defined by Policy ¶ 3.6, in that

- (a) in contrast with Complainant's ownership resulting from longstanding and uninterrupted use of each of Complainant's four contended "Marks" comprising "Covercrete," Registrant has no Rights in any of those four contended "Marks," the contested domain name is not used as a "Mark" of Registrant, and the expression is not being used by the Registrant in good faith;
- (b) (1) each of Complainant's four contended "Marks" is comprised of the expression "Covercrete," aside from the ".ca" ccTLD the contested domain name consists of that expression, Registrant does not appear to use that expression other than in the contested domain name, and Registrant uses the contested domain name only to point to Registrant's web site <www.epoxysolutions.com>, so Registrant is not using that expression in good faith— that none of Complainant's four contended "Marks" is used on said web site is evidenced by the copies of pages therefrom that are Complaint Schedule H, and that said web site is Registrant's web site is evidenced by the copies of Registrant's Canada 411 promotional piece or advertisement that is Complaint Schedule I— and

(2) the expression is not 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) each of Complainant's four contended "Marks" is comprised of a unique coined word ("Covercrete") which is not understood in Canada to be the generic name of wares or services or business in any language, aside from the ".ca" ccTLD the contested domain name consists of that unique coined word, and Registrant is using the contested domain name, so Registrant is not using any of Complainant's four contended "Marks" in good faith;
- (d) Registrant is using the contested domain name in bad faith and in association with a commercial activity;
- (e) the contested domain name does not comprise the legal name of Registrant or the name, surname or other reference by which the Registrant is commonly identified; and
- (f) the contested domain name is not the geographical name of the location of Registrant's place of business.

In the third main set of contentions, Complainant also contends that on a topic addressed by the third main set of contentions the facts of the present case are analogous to the facts of another panel decision made under the Policy, which decision Complainant quotes from, cites, indexes, and attaches to the Complaint.

FOURTH MAIN SET

In the fourth main set of contentions, Complainant basically makes two contentions.

First, Complainant contends that Registrant has registered the contested domain name in “bad faith,” within the meaning of that expression as defined by Policy ¶ 3.7, in that Registrant is a competitor of Complainant and registered the contested domain name primarily for the purpose of disrupting the business of Complainant. More particularly, Complainant contends that said competition and said primary purpose of registering the contested domain name are particularized by (i) the expression “Covercrete” being a unique word coined by Complainant; (ii) Registrant’s providing wares and services in competition with those provided by Complainant; and (iii) from those two facts and Registrant’s registration of the contested domain name, that Registrant necessarily knew of the goodwill associated with Complainant’s domain name <covercrete.com> and four contended “Marks,” so Registrant is knowingly attempting to pass off Registrant’s wares and services as Complainant’s wares and services, and that such a knowing attempt proves said primary purpose.

Second, Complainant contends that Registrant has registered the contested domain name in “bad faith,” in that (i) basically to request transfer of the contested domain name, both the above-mentioned named individual (who is the President, and a director, of Complainant and is the contact person of Complainant) and six months later an individual named as that individual’s son, telephoned a person who is named in the Complaint as being a, or the, “principal” of Registrant and as being Registrant’s contact person, and the response from Registrant’s contact person in each instance was basically to tell Complainant to “sue me”; (ii) to request transfer of the contested domain name, a letter to Registrant’s contact person was faxed, e-mailed, mailed by registered mail (receipt of which was refused by that contact person), and then mailed by regular mail, by the lawyer who became Complainant’s representative in this Proceeding, but the lawyer received no response from Registrant’s contact person; (iii) Registrant’s contact person saw to the registration of the contested domain name, and has neither defended that he saw to such registration nor expressed that he has any right to the use of the contested domain name; (iv) a copy of the letter is Complaint Schedule J; and (v) a copy of the envelope of the registered letter, returned from Canada Post and bearing a notation to that effect, is Complaint Schedule K.

In the fourth main set of contentions, Complainant also contends that on topics addressed by the fourth main set of contentions the facts of the present case are analogous to the facts of various panel decisions made under the Policy or under another domain name dispute resolution policy, which decisions Complainant quotes from, cites, indexes, and attaches to the Complaint.

B. Registrant

Registrant did not make any contentions.

FINDINGS

The Panel finds

- (i) Complainant is eligible to initiate the Proceeding in that, as required by Policy ¶ 1.4, at the time of submitting the Complaint, Complainant satisfies the Canadian Presence Requirements for Registrants Version 1.3 (“CPR”) in respect of the contested domain name, by being a “corporation under the laws of Canada” within the meaning of that expression as it appears in CPR ¶ 2(d);
- (ii) Registrant is required to submit to this Proceeding in that, as required by Policy ¶ 3.1, the Complaint is “submitted in compliance with the Policy and the Resolution Rules” and contains contentions of each of the Policy ¶ 3.1 elements “(a)”, “(b)”, and “(c)”;
 - (a) the contested domain name is registered to Registrant, said registration having been approved on March 1, 2001,
 - (b) it has not been proven in this Proceeding that there is a “Mark” within the meaning of that expression as defined by Policy ¶ 3.2(a), whether a common-law trade-mark or a common-law trade-name, for COVERCRETE, and in which Complainant has “Rights,” within the meaning of that expression as defined by Policy ¶ 3.3, or in any event not prior to the date of registration of the contested domain name (i.e. March 1, 2001),
 - (c) there are two “Marks,” within the meaning of “Mark” as defined by Policy ¶ 3.2(c), i.e. CIPO-registered trade-marks TMA562801 and TMA562802 each for COVERCRETE FLOORING SYSTEMS plus respective design features, and in which Complainant has “Rights,” within the meaning of that expression as defined by Policy ¶ 3.3,
 - (d) Complainant has “Rights” in each of the Policy ¶ 3.2(c) “Marks” since May 29, 2004 but it has not been proven in this Proceeding that Complainant had “Rights” in either of the Policy ¶ 3.2(c) “Marks” prior to the date of registration of the contested domain name (i.e. March 1, 2001), and
 - (e) whether the contested domain name is “Confusingly Similar,” within the meaning of that expression as defined by Policy ¶ 3.4, need not be found by the Panel;
- (iv) whether Registrant has a “legitimate interest” in the contested domain name, within the meaning of “legitimate interest” as defined by Policy ¶ 3.6, need not be found by the Panel; and
- (v) whether Registrant has registered the contested domain name in “bad faith,” within the meaning of that expression as defined by Policy ¶ 3.7, need not be found by the Panel.

DISCUSSION

Introduction

Resolution Rules ¶ 4.5 is that “The Administrator may provide administrative assistance to the Panel or a Panellist, but shall have no authority to decide matters of a substantive nature in the Proceeding.” (By Resolution Rules ¶ 1.1(a), the expression “Administrator” means, “with respect to a Proceeding, the case administrator appointed by [a “Provider” such as Resolution Canada] to be responsible for all administrative matters relating to the

Proceeding.”) In a proceeding under the Policy, matters of a substantive nature (as contrasted with matters of a solely administrative nature) include complainant eligibility under Policy ¶¶ 1.4 and 4.6 (last sentence),² complaint compliance with Policy ¶ 3.1,³ whether the Policy ¶ 4.1 onus is satisfied,⁴ remedy eligibility under Policy ¶ 4.3,⁵ and

² Policy ¶ 1.4 is as follows:

1.4 Eligible Complainants. 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**”) (currently available at http://www.cira.ca/en/cat_Registration.html) 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.

Policy ¶ 4.6 is as follows:

4.6 Bad Faith of Complainant. If the Registrant is successful, and the Registrant 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 which is the subject of the Proceeding, then the Panel may order the Complainant to pay to the Provider in trust for the Registrant an amount of up to five thousand dollars (\$5000) to defray the costs incurred by the Registrant in preparing for, and filing material in the Proceeding. The Complainant will be ineligible to file another Complaint in respect of any Registration with any Provider until the amount owing is paid in full to the Provider.

³ Policy ¶ 3.1 is as follows:

3.1 Applicable Disputes. A Registrant must submit to a Proceeding if a Complainant asserts in a Complaint submitted in compliance with the Policy and the Resolution Rules 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;
- (b) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6; and
- (c) the Registrant has registered the domain name in bad faith as described in paragraph 3.7.

For the purposes of this Policy, the date of registration of a domain name is the date on which the domain name was first registered in the Registry or the predecessor registry operated by the University of British Columbia.

⁴ Policy ¶ 4.1 is as follows:

4.1 Onus. To succeed in the Proceeding, the Complainant must prove, on a balance of probabilities, that:

- (a) the Registrant’s dot-ca domain name is Confusingly Similar [as defined by Policy ¶ 3.4] to a Mark [as defined by Policy ¶ 3.2] in which the Complainant had Rights [as defined by Policy ¶ 3.3] 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 [Policy ¶] 3.7;

and the Complainant must provide some evidence that:

complainant bad faith under Policy ¶ 4.6.⁶ The Panel therefore has authority to decide not only matters such as compliance with Policy ¶ 4.1 but also matters such as compliance with Policy ¶¶ 1.4 and 3.1, even though under Resolution Rules ¶ 4.3 Resolution Canada (i) apparently was satisfied that the Complaint is in administrative compliance with the Policy and the Resolution Rules and that Complainant appears to be eligible to commence the Proceeding in accordance with Policy ¶¶ 1.4 and 4.6; and (ii) as a result, apparently sent the Complaint to Registrant in the manner prescribed by Resolution Rules ¶ 2.1.

Policy ¶ 4.2 and Resolution Rules ¶¶ 9.1(a), 11.2, and 12.1 respectively instruct this Panel to “render its decision in accordance with the Policy and the Resolution Rules,” “conduct the Proceeding in such manner as it considers appropriate in accordance with the Policy and the Resolution Rules,” treat “[t]he Complaint, the Response and any additional evidence and argument submitted pursuant to [Resolution Rules ¶ 11.1 as constituting] the complete record to be considered by the Panel in the Proceeding,” and “render a decision in a Proceeding on the basis of the evidence and argument submitted and in accordance with the Policy, the Resolution Rules and any rules and principles of the laws of Ontario, or, if the Registrant is domiciled in Quebec, the laws of Quebec, or, if a preference for the laws of another province or territory has been indicated by both parties, the laws of the other province or territory and, in any event, the laws of Canada applicable therein.”

In view especially of the two immediately preceding paragraphs hereof, the Panel notes four rules and principles of law that it especially considers to be generally appropriate for ascertaining whether Policy ¶¶ 1.4, 3.1, and 4.1 are satisfied. First, that

Both [dispositive] and evidential facts must, under the law, be *ascertained* in some one or more of four possible modes: 1. By judicial admission (what is not disputed); 2. By judicial notice, or knowledge (what is known or easily knowable); 3. By judicial perception (what is ascertained directly through the senses; *cf.* “real evidence”); 4. By judicial inference (what is ascertained by

(c) the Registrant has no legitimate interest in the domain name as described in [Policy ¶] 3.6.

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 3.6.

⁵ Policy ¶ 4.3 is as follows:

4.3 Remedies. If the Panel decides in favour of the Complainant, the Panel will decide whether the Registration should be cancelled or transferred to the Complainant or in the case where the Complainant does not satisfy the CPR in respect of the domain name that is subject of the Proceeding, a nominee of the Complainant that satisfies the CPR in respect of the domain name that is subject of the Proceeding (the “**Nominee**”).

⁶ *Supra* note 2.

reasoning from facts already ascertained by one or more of the four methods here outlined).⁷

Second, especially as to mode “3,” that Policy ¶ 4.2 and Resolution Rules ¶ 9.1(d) respectively provide that the Panel shall “consider all the evidence presented in the Proceeding” by determining “the admissibility, relevance, materiality and weight of the evidence.”⁸ Third, as to construing and applying Policy ¶ 4.2 and Resolution Rules ¶ 9.1(d), especially as to whether mode “1” rather than mode “3” applies: a complainant’s pleading of fact that is not disputed (or, phrased differently, not “put in issue”) by a registrant against whom it is contended, is an admission by that registrant,⁹ so evidence tendered as being rationally probative of (i.e. as being “relevant to”) establishing that fact becomes immaterial, and hence inadmissible, as to establishing that fact.¹⁰ Fourth, as to

⁷ W.N. Hohfeld, “Some Fundamental Legal Conceptions as Applied in Judicial Reasoning,” 23 *Yale L. J.*, 16, at 27, footnote 23 (emphasis in original).

⁸ For example, (i) where the Panel is satisfied as to the authenticity of a copy of a document or other thing, that copy may be admitted as evidence; and (ii) the Panel may admit as evidence, whether or not given or proven under oath or affirmation or admissible as evidence in a court, any document or other thing, relevant to the subject-matter of the Proceeding and may act on such evidence, but the Panel may exclude anything unduly repetitious, and (a) nothing is admissible in evidence, that is inadmissible by any statute and (b) nothing in the preamble of part “(ii)” of this sentence overrides the provisions of any Act expressly limiting the extent to or purposes for which any documents or things may be admitted or used in evidence in the Proceeding. Cf. *Arbitration Act, 1991*, S.O. 1991, c. 17, s. 21 as to *Statutory Powers Procedures Act*, R.S.O. 1990, c. S.22, ss. 15(4), 15(1)(b), 15(2)(b), and 15(3).

See also *Black’s Law Dictionary*, 5th ed. (St. Paul, Minnesota: West Publishing Co., 1979), at 277 (“Consider. To fix the mind on, with a view to careful examination; to examine; to inspect. To deliberate about and ponder over. To entertain or give heed to. See also Considered.”) and at 278 (“Considered. ... For example, evidence may be said to have been ‘considered’ when it has been reviewed by a court to determine whether any probative force should be given to it.”).

⁹ See, e.g., Resolution Rules ¶¶ 5.2(C)(d), 5.2(C)(i), and 11.5: Resolution Rules ¶ 5.2(C)(d) includes that “The Response will ... respond ... specifically to the evidence and the arguments in the Complaint and include reference to any and all bases for the Registrant to maintain the Registration of each domain name in issue, including in particular why the Registrant should be considered as having a legitimate interest in the domain name as described in paragraph 3.6 of the Policy”; Resolution Rules ¶ 5.2(C)(i) includes that “The response will ... have any Schedules, together with an index thereto, annexed”— “Schedule” being defined by Resolution Rules ¶ 1.1(j) as meaning “documentary or other evidence, including without limitation a copy of any trade-mark registration, articles of incorporation or trade name registration, upon which a Party relies annexed to a Complaint, a Response or a written request, as the case may be”; and Resolution Rules ¶ 11.5 includes that “If a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Resolution Rules ... the Panel shall draw such inferences therefrom as it considers appropriate.” Resolution Rules ¶¶ 5.2(C)(d) and 5.2(C)(i) are each clearly a “provision of, or requirement under, the Resolution Rules” within the meaning of that expression as it appears in Resolution Rules ¶ 11.5.

¹⁰ Compare Hohfeld, *supra* note 7 (mode “1”) with Ronald Joseph Delisle, *Evidence Principles and Problems* 5, (1st ed. 1984):

The concept of relevancy is simply dictated by our own present insistence on a rational method of fact-finding.

However, not only must the evidence tendered be rationally probative of the fact sought to be established; the fact sought to be established must concern a matter in issue between the parties, i.e. it must be material. ...

whether mode “2” rather than either of mode “1” or mode “3” applies, a canvassing of law and commentary shows that

It was not desirable, nor indeed possible, to foreclose the trier’s use of background information but should the matter noticed be in the forefront of the controversy, should the fact be determinative, the law protected the adversary by insisting that the matter be so commonly known, and hence indisputable, that its notice could not prejudice the opponent.¹¹

and that “The party who has the burden of proof on the issue may have to call on the trier to judicially notice the fact when it comes time to analyze the question.”¹²

However, the fact that a Response was not received makes for some exceptions to the otherwise generally appropriate four rules and principles of law set out in the immediately preceding paragraph. Those exceptions are as to materiality and as to judicial admission. Resolution Rules ¶¶ 5.8 and 11.4 respectively include that “If a Registrant does not submit a Response within the period for submission of a Response . . . , the Panel shall decide the Proceeding on the basis of the Complaint ” and that “After the Date of Commencement of a Proceeding, in the event that a Party, in the absence of exceptional circumstances, does not comply with any time period established by the Resolution Rules . . . , the Panel shall proceed to a decision on the Complaint”— “Date of Commencement of a Proceeding” being defined by Resolution Rules ¶¶ 1.1(c) and 1.6 as meaning “the date on which the Provider gives the Parties notice of the Proceeding pursuant to [Resolution Rules ¶] 4.4.” In this proceeding, (i) the “Date of Commencement of [this] Proceeding” is not directly known to the Panel, but the twenty-day time period established by Resolution Rules ¶ 5.1 within which Registrant was to “respond to the Complaint by filing with [Resolution Canada] a Response in accordance with the Policy and the Resolution Rules” has apparently ended without Registrant having complied therewith; (ii) there do not appear to be “exceptional circumstances” within the meaning of that expression as it occurs in Resolution Rules ¶ 11.4; and (iii) in accordance with Resolution Rules ¶¶ 11.4 and 5.8 respectively, the Panel shall therefore “proceed to a decision on the Complaint” and “decide the Proceeding on the basis of the Complaint.” In doing so, as also accords with Resolution Rules ¶¶ 5.8 and 11.4, the Panel shall not treat the failure to submit a Response as an admission of Complainant’s allegations¹³ and shall make a

The law of evidence then principally consists of the study of canons of exclusion, rules regarding admissibility, which deny receipt into evidence of information [that] is rationally probative of a matter in issue between the parties.

Therefore, evidence that is immaterial, or is material but irrelevant, is inadmissible, and even evidence that is material and relevant may still be inadmissible in view of further inadmissibility rules of evidence law.

¹¹ Delisle, *supra* note 10, at 94. Similarly, the Panel may take notice of facts that may be judicially noticed and of any generally recognized scientific or technical facts, information or opinions within its scientific or specialized knowledge; *cf. Arbitration Act, 1991*, S.O. 1991, c. 17, s. 21 as to *Statutory Powers Procedures Act*, R.S.O. 1990, c. S.22, s.16.

¹² Delisle, *supra* note 10, at 91.

¹³ *Cf. Arbitration Act, 1991*, S.O. 1991, c. 17, s. 27(2).

decision on the evidence before the Panel,¹⁴ all of which is an approach that also apparently accords with all the default decisions thus far made under the Policy.¹⁵

Complainant Eligibility

Policy ¶ 1.4 has first and second parts, and the two contentions of Complainant's first main set of contentions are respectively contentions that Complainant is eligible under each part of Policy ¶ 1.4.

Whether or not 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" (within the meaning of that expression from the second part of Policy ¶ 1.4), Complainant is eligible to initiate the Proceeding. The following three paragraphs set out that as required by the first part of Policy ¶ 1.4, at the time of submitting the Complaint, Complainant satisfies the CPR in respect of the contested domain name, by being a "corporation under the laws of Canada" within the meaning of that expression as it appears in CPR ¶ 2(d).

The first contention (i.e. that on April 19, 1984, a corporation was incorporated under Canadian federal law as Covercrete (Canada) Ltd. and that Complainant is that corporation, as evidenced by the copy of the Certificate of Incorporation that is Complaint Schedule A) amounts to a contention of being within CPR ¶ 2(d), which is as follows:

2. **Canadian Presence Requirements.** On and after November 8, 2000 only the following individuals and entities will be 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:

...

(d) **Corporation.** A corporation under the laws of Canada or any province or territory of Canada[.]

Complaint Schedule A is relevant, admissible, and of sufficient weight to prove some, but not all, of the components of the Policy ¶ 1.4 first-part contentions that Complainant contends it proves.¹⁶ On the one hand, it bears the title "Certificate of Incorporation,"

¹⁴ Cf. *Arbitration Act, 1991*, S.O. 1991, c. 17, s. 27(3).

¹⁵ See the following decisions that are in the Complaint, apparently cited by Complainant with other propositions in mind: *Trans Union LLC v. 1491070 Ontario Inc.* (CIRA 00008) at 5 (first para.); *Coca-Cola Ltd. Amos B. Hennan* (CIRA 00014) at paras. 21 and 22 (cf. para. 23); *Biogen, Inc. v. Xcalibur Communication* (CIRA 00003) at para.3.1.3; *Browne & Co. Ltd./Lteé v. Bluebird Industries* (CIRA 00002) at the last para. of item "B" of "Rulings on Procedural Matters" (cf. the last sentence of that para.) and the last para. of item "D" of "Findings & Discussion"; and *Christian Houle v. Jean-Pierre Ranger International, Inc.* (CIRA 00010) at paras. 10bis (actually 12th para.), 11bis (actually 13th para.) 15, 24 and 27. See also the following decisions that are not in the Complaint: *Red Robin International, Inc. v. Greg Tieu* (CIRA 00001) at paras. 1, 3, 6, 8, and 9; *Elysium Wealth Management Inc. v. Brian Driscoll* (CIRA 00005) at para. 2.3; and *Independent Order of Foresters v. Noredu Enterprises Canada Inc., operating as Forester College of Technology* (CIRA 00017) at paras. 6, 26, 32, and 44.

appears to be issued under the signature of a “Director” of a Canadian federal government entity responsible for federal incorporations, and proves that the “Date of Incorporation,” under the Canadian federal law known as the “Canada Business Corporations Act,” of a corporation named “COVERCRETE (CANADA) LTD.” (and numbered “167181-2”) was “April 19, 1984.” On the other hand, (i) it is incomplete in that although it states that “the Articles of Incorporation” of that corporation are attached to that certificate, no articles are attached thereto; and (ii) perhaps more importantly, it does not prove that Complainant *is* the corporation that *was* incorporated under that law on that date with that name and number. Specifically, there does not appear to be any rule of law that in the absence of evidence to the contrary any evidence that such a corporation was created is evidence that such a corporation continues to exist; indeed, in contrast, the absence of such a rule appears to be why what are commonly referred to as certificates of “good standing” or “corporate existence” are available¹⁷ and why such certificates, rather than merely certificates of incorporation, are obtained and submitted as evidence.

In view of those two deficiencies, the Panel takes judicial notice of a search engine regarding Canadian federal corporations, available at <http://strategis.ic.gc.ca/cgi-bin/sc_mrksv/corpcdir/dataOnline/corpn_s>, which shows a record regarding the corporation of that number at <http://strategis.ic.gc.ca/cgi-bin/sc_mrksv/corpcdir/dataOnline/corpn_re?company_select=1671812>. That search engine record includes that the corporation of that number has a date of “Incorporation” of “1984/04/19” and, at least as late as “2004/02/12,” has been “Active” since at least as early as “1993/07/08” (there having been a “Dissolution in Progress” as of “1988/08/08”). Also, the Complaint and that search engine record are identical as to corporation name and mailing address; and the name of the individual stated in the Complaint as being Complainant’s contact person’s name is the name of one of the corporation’s current directors listed in that search engine record. In view of the foregoing, the Panel finds that Complainant *is*

¹⁶ The Panel takes this opportunity to state an observation of general applicability to the evidence proffered in the Complaint Schedules: as to the contended Policy ¶ 1.4 facts and other contended facts, whether or not to any extent any of the Complaint Schedule documents are hearsay, they appear to be admissible either as a result of one or more statutory provisions or under the “business records” exception to the hearsay rule. (As to such statutory provisions, see e.g. (i) item “(i)” of the first para. of *supra* note 8; and (ii) *Evidence Act*, R.S.O. 1990, c. E.23, ss. 1, 2, 25.) As for the hearsay rule, in this Proceeding, hearsay is evidence, by an intermediary, of an extrajudicial testimonial assertion, where the assertor does not give evidence in this Proceeding. (See e.g., Delisle, *supra* note 10, at 203.) As for the “business records” exception to the hearsay rule, “business” is meant to include every kind of business, profession, occupation, calling, operation or activity, whether carried on for profit or otherwise, “record” is meant to include any information that is recorded or stored by means of any device, and “business record” is meant to include a record made in the usual and ordinary course of business. (See e.g., Delisle, *supra* note 10, at 237-243 and *Ares v. Venner* [1970] S.C.R. 608; and *cf. Evidence Act*, R.S.O. 1990, c. E.23, s. 35.)

¹⁷ See e.g. *Canada Business Corporations Act*, R.S.C. 1985, c. C-44, ss. 263.1(1)(c) and (2) as to the person, in the position of the above-mentioned “Director,” issuing such a certificate:

263.1 (1) The Director may provide any person with a certificate stating that a corporation ...
(c) exists as of a certain date.

(2) For greater certainty, the Director may refuse to issue a certificate described in paragraph (1)(c) if the Director has knowledge that the corporation is in default of sending a document required to be sent under this Act or is in default of paying a required fee.

Canadian federal corporation number 167181-2, such that Complainant is within CPR ¶ 2(d) and thence within the first part of Policy ¶ 1.4.

Complaint Compliance

Policy ¶ 3.1 (preamble) includes that Registrant must submit to this Proceeding if the Complaint is “submitted in compliance with the Policy and the Resolution Rules.” Basically between the Complaint’s first and second main sets of contentions, the Complaint includes an assertion of Complaint compliance with Policy ¶ 3.1.

As to Policy ¶ 3.1, the Complaint is a strictly *pro forma* pleading of the wording of each of the elements “(a)”, “(b)”, and “(c)” thereof, without the preamble of Policy ¶ 3.1. More importantly, as set out in the following seven paragraphs hereof, the Panel finds that only by the slimmest of margins is the Complaint in compliance with Resolution Rules ¶ 3.2(D)(i)(1) and thence in compliance with Policy ¶ 3.1 (preamble): it appears that at the time of submitting the Complaint, Complainant knowingly chose to neither plead nor directly evidence the particulars of the date of registration of the contested domain name even though Complainant had knowledge thereof and of such evidence and even though Complainant can reasonably be inferred to have known that such pleading and such evidence could, and should, be included in the Complaint.

Resolution Rules ¶¶ 3.2(D)(d), 3.2(D)(e), 3.2(D)(g), and 3.2(D)(i)(1) pertain to whether the Complaint’s pleadings do not describe the particulars of the date of registration of the contested domain name and, if so, then whether that puts the Complaint in noncompliance with either or both of the Policy and Resolution Rules, and therefore puts the Complaint in noncompliance with Policy ¶ 3.1 (preamble). They pertain by way of contrast and background, or by providing close context, or quite directly.

Contrast is provided by Resolution Rules ¶ 3.2(D)(d) which includes that “The Complaint shall ... provide ... all Registration Information ... in sufficient detail to allow [a “Provider” such as Resolution Canada] to send the Complaint to the Registrant pursuant to paragraph 2.1.” (By Resolution Rules ¶¶ 1.1 (preamble) and 1.1(h) and Policy ¶¶ 1.1 and 1.2, the expression “Registration Information” in Resolution Rules ¶ 3.2(D)(d) is defined as “the information of record regarding a [registration of a domain name in the dot-ca country code top level domain name registry operated by CIRA] in [the dot-ca country code top level domain name registry operated by CIRA]’s WHOIS database.”) As a result, it appears quite clear that Resolution Rules ¶ 3.2(D)(d) should be construed as only requiring complaints to provide such details of that information as suffice to allow the complaint to be sent that way. The date of registration of a disputed domain name does not appear to be such a detail.

Close context is provided by Resolution Rules ¶ 3.2(D)(e), which includes that “The Complaint shall ... specify every Registration that is the subject of the Complaint.” (By Resolution Rules ¶¶ 1.1 (preamble) and Policy ¶¶ 1.1 and 1.2, the expression “Registration” in Resolution Rules ¶ 3.2(D)(e) is defined as “registration of a domain name in [the dot-ca country code top level domain name registry operated by CIRA].”)

As a result, Resolution Rules ¶ 3.2(D)(e) could well be construed as only requiring complaints to specify each disputed domain name, rather than also requiring complaints to specify the date that each disputed domain name was registered. That said, however, in view of the paucity and distancing of information provided to this Panel as to the registration date of the contested domain name, and also in view of the next four paragraphs of these reasons for decision, it seems to the Panel to be at least good practice that wherever a disputed domain name is first specified in a complaint its date of registration (and the contended evidentiary basis for that date) is specified immediately after it.

Resolution Rules ¶¶ 3.2(D)(i)(1), and 3.2(D)(d) and 3.2(D)(g), pertain quite directly.

Resolution Rules ¶ 3.2(D)(i)(1) includes that “The Complaint shall ... describe the particulars of the basis for the Complaint, including in particular ... the date of registration of the domain name ...”. For a complaint to describe the particulars of what has been replaced by the second ellipsis (i.e. the particulars of “why the Registrant’s dot-ca domain name should be considered as Confusingly Similar to a Mark in which the Complainant had Rights prior to”) and by the third ellipsis (i.e. the particulars of “and continues to have such Rights”) necessarily requires a complaint to describe the particulars bracketed by those two ellipses, i.e. to describe the particulars of “the date of registration of the domain name.” The Complaint’s pleadings do not describe the particulars of the date of registration of the contested domain name. Instead, the Complaint merely provides indirect evidence of that date, as part of a letter to which contended Registrant non-responsiveness is contended to evidence Registrant bad faith rather than in any way being contended to evidence either Complaint compliance with Policy ¶ 3.1(a) or that the Policy ¶ 4.1(a) onus is satisfied. It provides that indirect evidence by stating Complainant’s understanding of that date, and it does so through the last line of the second page of the copy of the four-page letter that is Complaint Schedule J. Complaint Schedule J is the second-last Complaint Schedule and, since the last Complaint Schedule is only one page long, Complaint Schedule J is basically at the bottom of approximately 3.5 cm of Complaint Schedule documents; by being proffered as rationally probative of Registrant bad faith, it would ordinarily not have been reviewed by the Panel except as to Policy ¶¶ 3.1(c) and 4.1(b).

The Panel takes judicial notice that the internet’s domain name system appears to date from no earlier than 1983¹⁸ or more specifically from November, 1983,¹⁹ or even from as

¹⁸ See at <<http://www.nominum.com/history.php>> that “Paul Mockapetris invented the Domain Name System in 1983.”

¹⁹ See at <<http://cyber.law.harvard.edu/icann/pressingissues2000/briefingbook/dnshistory.html>> the entry for “November 1983,” i.e. that “The rapid growth of the internet caused massive problems in bookkeeping. To deal with this problem a group including Jon Postel, Paul Mockapetris and Craig Partridge published RFC 882 which created the domain name system (DNS) to make Internet navigation easier. With DNS, users can type host names such as ‘USC-ISIF’ instead of ‘10.2.0.52.’ Every Address would have information from specific to general.”

late as 1984.²⁰ In view of those dates, it might be inferred that the Complainant's pleadings do not describe the particulars of the date of registration of the contested domain name because Complainant is of the view that it would be absurd to describe those particulars in that way. More specifically, Complainant might be considered to have chosen to implicitly contend that for the date of registration of the contested domain name to have been prior to the earliest date that the Complaint contends for the onset of Complainant's Policy ¶ 3.3 "Rights" would have required the contested domain name to have been registered prior to January, 1983 which appears to be a date before the internet's domain name system existed. However, for the onset of Policy ¶ 3.3 Complainant "Rights," the Complaint also contends the much later date of January, 1998; and both January, 1983 as well as January, 1998, are, after all, contended dates, so the inference that Complainant is of the view that it would be absurd to describe the particulars of the date of registration of the contested domain name in the way required by Resolution Rules ¶ 3.2(D)(i)(1) is tenuous at best. In any event, whatever contended or proven dates for the onset of Policy ¶ 3.3 "Rights" there happen to be in proceedings under the Policy, complainants should not be encouraged to rely on such implicit contentions of absurdity.

Moreover, Resolution Rules ¶ 3.2(D)(d) not only provides the contrast set out several paragraphs earlier in these reasons for decision but together with Resolution Rules ¶ 3.2(D)(g) it also provides background. The background shows that unless panels are to be forced to take judicial notice of the CIRA WHOIS database, or make requests for Resolution Rules ¶ 11.1 additional submissions, or extend time periods, (i) Resolution Rules ¶ 3.2(D)(i)(1) should be construed as requiring a complaint to include a pleading expressly describing the particulars of the date of registration of each disputed domain name; and (ii) it is at least good practice that wherever a disputed domain name and its date of registration are first specified in a complaint the contended evidentiary basis for that date is specified immediately thereafter. More specifically, Resolution Rules ¶ 3.2(D)(d) requires a complaint to provide address information, regarding the registrant of a disputed domain name, from the CIRA WHOIS database referred to several paragraphs earlier in these reasons for decision; similarly, Resolution Rules ¶ 3.2(D)(g) includes that "The Complaint shall ... identify the Registrar of record in respect of each Registration at the time the Complaint is submitted." (By Policy ¶¶ 1.1 and 1.2 and Resolution Rules ¶ 1.1 (preamble), in Resolution Rules ¶ 3.2(D)(g) the expression "Registrar" is defined as "a CIRA certified registrar" and the expression "Registration" is defined as "registration of a domain name in the dot-ca country code top level domain name registry operated by CIRA.") As part of complying with Resolution Rules ¶ 3.2(D)(d), the Complaint provides an address of Registrant, and then refers to that address as the "CIRA 'WHOIS' listed address"; similarly, in complying with Resolution Rules ¶ 3.2(D)(g), the Complaint names the "Registrar of Record" for the contested domain name as "Reggie.ca Inc." However, the Complaint does not include any contention that any evidence included in any Complaint Schedule evidences either that address (as contrasted with a "Canada 411

²⁰ See at <<http://www.sun.com/hardware/serverappliances/pdfs/support/dns.history.pdf>>, at page 1 of 2, that "In 1984, the architecture of a new system called Domain Name System (DNS) was designed and is the basis of the DNS service used today on the Internet."

listed address” also contended by the Complaint) or that registrar name. Nor does the Complaint include any such evidence. How then, did Complainant come to contend that address (especially as a “CIRA ‘WHOIS’ listed address”) and that registrar name? The Panel takes judicial notice that the date of registration of each “.ca” domain name is contained in each respective record in that database and the Panel combines that judicial notice with the facts set out earlier in this paragraph, to conclude that at the time the Complaint was filed, Complainant (i) was aware, not only of that whois database and of the record therein of the registration of the contested domain name, but also that said record included that address, that registrar name, and the date of registration of the contested domain name; and (ii) chose to include, in the Complaint, neither a pleading expressly describing the particulars of the date of registration of the contested domain name nor any evidence of that record.

Confusing Similarity

The context in which this part of this discussion occurs includes Policy ¶¶ 3.2,²¹ 3.3,²² and 3.4²³ (which respectively define the expressions “Mark,” “Rights,” and “Confusingly

²¹ Policy ¶ 3.2 is as follows:

3.2 Mark. A “**Mark**” is:

- (a) 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;
- (b) 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;
- (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).

²² Policy ¶ 3.3 is as follows:

3.3 Rights. A person has “**Rights**” in a Mark if:

- (a) in the case of paragraphs 3.2 (a) and 3.2(b), the Mark has been used in Canada by that person, that person’s predecessor in title or a licensor of that person or predecessor;
- (b) in the case of paragraph 3.2(c), the Mark is registered in CIPO in the name of that person, that person’s predecessor in title or a licensor of that person; or
- (c) in the case of paragraph 3.2(d), public notice of adoption and use was given at the request of that person.

²³ Policy ¶ 3.4 is as follows:

3.4 “Confusingly Similar”. 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 to be mistaken for the Mark.

Similar” that appear in Policy ¶ 4.1(a) and 3.5²⁴ (which defines “use” and “used, which appear in Policy ¶¶ 3.2 and 3.3).

Complainant’s second main set of contentions amounts to a contention that Complainant satisfies the Policy ¶ 4.1(a) onus.

Contested Domain Name Registered to Registrant

No Complaint Schedule is pleaded by Complainant as being rationally probative of Complainant’s contention that the contested domain name is registered to Registrant.

One portion of one of the Complaint Schedules is relevant and admissible, but the one portion is of insufficient weight to prove that the contested domain name is registered to Registrant. Specifically, Complaint Schedule J appears to be a copy of a March 19, 2004 letter to Registrant from the lawyer who became Complainant’s representative in this Proceeding. The second-last line of page 2 thereof includes that the writer of that letter “understand[s] that [Registrant] is the registrant of the domain name www.covercrete.ca.” In view of Complainant’s May 25, 2004 fax to Resolution Canada (whereby Complainant requested that in Complainant’s May 21, 2004 version of the Complaint each reference to <www.covercrete.ca> be read as <covercrete.ca>), the March 19, 2004 reference to <www.covercrete.ca> can be read as <covercrete.ca> in the sense that Complainant “understands” that the contested domain name is registered to Registrant. However, even on that reading, that passage from Complaint Schedule J does not prove that the contested domain name is registered to Registrant.

In domain name dispute resolution proceedings conducted under various domain name dispute resolution policies, regarding domain names in other than the “.ca” ccTLD, either or both of two events commonly occur. One event is that (i) before the parties’ submissions are provided to the panel, the dispute resolution service provider sends an e-mail to the domain name registrar asking it to confirm by reply e-mail that (a) the

²⁴ Policy ¶ 3.5 is as follows:

3.5 Use. A Mark is deemed to be in “use” or “used” in association with:

- (a) wares: (i) if, at the time of the transfer of the property in or possession of the wares in the normal course of trade, the Mark is marked on the wares themselves or on the packages in which they are distributed or the Mark is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred; or (ii) at the time the wares are exported from Canada, if the Mark was marked in Canada on the wares or on the packages in which they are contained and the wares or packages are still marked when exported;
- (b) services, if the Mark is used or displayed in the performance or advertising of those services;
- (c) a business, if the Mark is displayed in the operating, advertising or promoting of the business; or
- (d) promoting or advertising of the non-commercial activity.

disputed domain name is registered with that registrar, (b) the entity named as the respondent in the proceeding is the current registrant of the disputed domain name, and (c) the registrant is bound by the registrar's registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with the domain name dispute resolution policy; and (ii) then, if the dispute resolution service provider receives such a reply, the dispute resolution service provider provides the e-mail string to the panel along with the parties' submissions. The other event is that the complainant not only pleads, but also submits evidence to prove, each of those three points "(a)", "(b)", and "(c)". In this Proceeding, (i) such an e-mail string was not provided to the Panel at the time Resolution Canada provided the Panel with the Complaint, so on June 29, 2004, and subsequently, the Panel e-mailed the Administrator assigned by Resolution Canada, asking the Administrator to inform the Panel by reply e-mail of such things as whether an e-mailed inquiry from Resolution Canada as to those three points "(a)", "(b)", and "(c)" was sent to Reggie.ca Inc. and whether Resolution Canada had received a reply thereto; (ii) by the end of July 2, 2004, the Administrator had not replied to the Panel, and has still not replied to the Panel; and (iii) Complainant has on this topic pleaded only that the contested domain name is registered with Reggie.ca Inc. and that Registrant is the current registrant of the contested domain name, and has neither submitted evidence as to any of the three points "(a)", "(b)", and "(c)" nor even pleaded the third point "(c)".

In view especially of the two immediately preceding paragraphs hereof, on July 3, 2004 the Panel took judicial notice of records through two on-line sources. First, the Panel took judicial notice, through a "whois" search engine regarding ".ca" registrations available at <<http://www.cira.ca/cira/public>>, of a whois record regarding the contested domain name. As of that date, that search engine record included that the registration had been "Last changed" on "2004/05/28," and that, as contended in the Complaint, the contested domain name is registered with "Reggie.ca Inc." and the registrant of the contested domain name is "Epoxy Solutions Inc.," i.e. the same name as Registrant; also, the Complaint and that search engine record are identical as to one of the Complaint's addresses for Registrant and as to the contact individual's name, telephone number, fax number, and e-mail address. Second, the Panel took judicial notice of the Reggie.ca Inc. form of agreement at <<http://www.reggie.ca/agreement.html>>, which *inter alia* is for registration of domain names such as the contested domain name. That form of agreement has a section 11 which includes that a registrant, such as Registrant,

acknowledge[s] and agree[s] that [the registration of the contested domain name] is subject to suspension, cancellation, transfer or modification pursuant to the terms of any rules or policies applicable [thereto], including, but not limited to, ... any CIRA adopted policy [such as the Policy and the Resolution Rules] ... [and also agrees] that Reggie.ca shall have the right in its sole discretion to suspend, cancel, transfer or otherwise modify [the registration of the contested domain name] at such time as Reggie.ca receives ... an arbitration award requiring the suspension, cancellation, transfer or modification [thereof].

In view of those two judicially noticed records, the Panel finds that the contested domain name is registered with Reggie.ca Inc., the contested domain name is registered to Registrant, and Registrant is bound by Reggie.ca Inc.'s registration agreement and has

thereby agreed to resolve domain-name disputes brought by third parties (such as Complainant) in accordance with the Policy and the Resolution Rules.

Complainant “Rights” in One or More “Marks”

The Panel has reviewed mainly Complaint Schedules A to G and finds them relevant, admissible, and of sufficient weight to prove some (but not all) of Complainant’s first sub-point contentions (i.e. as to the existence and ownership of Complainant “Rights” in four “Marks”), but of insufficient weight to prove any of Complainant’s second sub-point contentions (i.e. as to the onset of any of those “Rights” being prior to the date of registration of the contested domain name).

As to Complainant’s first sub-point, there are mainly the above-mentioned Complaint Schedules A to G, the Panel’s consideration of which is set out in the following nineteen paragraphs (the first eleven paragraphs basically being as to contended Policy ¶ 3.2(a) “Marks” and the twelfth to nineteenth paragraphs basically being as to contended Policy ¶ 3.2(c) “Marks”).

CONTENDED POLICY ¶ 3.2(a) “MARKS”

First, there are what are contended to be two “Marks” within Policy ¶ 3.2(a) as a common-law trade-mark and a common-law trade-name, each for COVERCRETE.

Complaint Schedules A and D are proffered by Complainant as rationally probative of services trade-mark use, or services-based trade-name use, in Canada since at least as early as January, 1983 by Complainant or Complainant’s contended predecessor-in-title (i.e. a named individual who is the President, and a director, of Complainant and is the contact person of Complainant). To the extent Complainant contends that either or both of registration of “Covercrete Flooring” as a business name in 1982 under Ontario’s *Business Names Act*, or April 19, 1984 incorporation of Complainant under the corporate name “Covercrete (Canada) Ltd.”, amounts to any trade-mark use or any trade-name use, of any date, Complainant is mistaken, both as a general matter of trade-mark and trade-name law and, more importantly as far as this Proceeding is concerned, as a matter of the requirements for rights-yielding mark use set out in Policy ¶¶ 3.2(a), 3.3(a), and 3.5(b) and 3.5(c). Neither individually nor collectively do such registration or such incorporation amount to a “Mark” being “used or displayed in the performance or advertising of those services” within the meaning of that expression in Policy ¶ 3.5(b) or “displayed in the operating, advertising or promoting of the business” within the meaning of that expression in Policy ¶ 3.5(c).

Complainant does however contend further, but not that Complaint Schedules A and D evidence use of the corporate name. (The incorporation of Complainant under its present name is indeed evidenced by the copy of a Certificate of Incorporation that is Complaint Schedule A, but neither Schedule A nor the May 11, 2004 statutory declaration of that named individual which is Schedule D, evidences, or apparently is even contended to evidence, that the corporate name was used by Complainant as a trade-mark or trade-name.) Only the contended business name registration, and contended use of that

registered business name as a trade-mark and as a trade-name, are contended to be evidenced by Complaint Schedule D, implicitly that the registration was in that individual's name and expressly both that the registration was "effective in the Province of Ontario for the succeeding five (5) year period" and that as of May 16, 1983 the individual was "operating as 'Covercrete Flooring'." Complaint Schedule D does not include a copy of the contended business name registration, but does include as its "Exhibit 'A'" what is evidenced by the Schedule D statutory declaration as being, and indeed appears to be, a copy of a May 16, 1983 credit note issued to that individual by a corporation in Ontario named "W.E.C.O. Ltd.". In that Exhibit "A," there is what appears to be an address area, in which the individual's name is stated; the individual's name is then immediately followed by "'Covercrete Flooring'"; and then, on subsequent lines in that area, there is an Ontario address.

For three reasons, Schedule D does not appear to the Panel to be sufficient evidence of Policy ¶¶ 3.5(b) or 3.5(c) services trade-mark or services-based trade-name "use" of COVERCRETE as a Policy ¶ 3.2(a) "Mark" yielding Policy ¶ 3.3 "Rights" for Complainant. First, Schedule D does not evidence use of COVERCRETE, in view of the rule from *Registrar of Trade marks v. Compagnie internationale pour l'informatique CII Honeywell Bull, Société anonyme et al.* (1985), 4 C.P.R. (3d) 523 (F.C.A.), at page 525, which has been applied in at least two panel decisions under the Policy:²⁵ *when using a composite mark, one does not use only a part of it.* Second, even if Schedule D were evidence of use of COVERCRETE, it is respectively neither sufficient evidence of *use or display* of any Policy ¶ 3.2(a) "Mark" *in the performance or advertising of services* nor sufficient evidence of *display* of any Policy ¶ 3.2(a) "Mark" *in the operating, advertising or promoting of the business.* Third, in any event, neither Complaint Schedules A and D, nor any other of the Complaint Schedules, appear to include any evidence of chain-of-title from that individual to Complainant; Policy ¶ 1.1 states the purpose of the Policy to be that appropriate cases "can be dealt with relatively inexpensively and quickly," but that provision neither relieves Complainant from proffering chain-of-title evidence nor results in this Panel ascertaining chain-of-title merely through the Complainant's pleading.

Complaint Schedules E and F are proffered as rationally probative of wares (and apparently also service) trade-mark, or wares-based (and apparently also service-based) trade-name, use in Canada of the domain name <covercrete.com> as an internet trade-name by Complainant since shortly after April 22, 1998.²⁶ Although Complaint Schedule E is contended to be, and indeed appears to be, a copy of a domain name registration record for <covercrete.com>, and is contended to evidence, and indeed appears to evidence, the April 22, 1998 registration of that domain name, it is also contended to evidence, but actually does not evidence at all, that the registrant of that domain name is

²⁵ See particularly *Acrobat Construction/Entreprise Management Inc. v. 1550507 Ontario Inc.* (CIRA 00013) at 8. See also *Cheap Tickets and Travel Inc. v. Email.ca Inc.* (CIRA 00004).

²⁶ Clearly then, the Complainant's contention of a January, 1998 rights onset date cannot be based on internet use contended to be evidenced by Complaint Schedules E and F. Instead, that earlier date is contended to be evidenced by Complaint Schedule G which, together with the contended CIPO-registered trade-marks, is discussed further below, largely under the heading of "Contended Policy ¶ 3.2(c) 'Marks' and Policy ¶ 3.2(a) Revisited."

Complainant. Instead, that record shows the registrant of that domain name is “IT Consortium,” an entity that is not even pleaded, let alone sufficiently evidenced, as having any connection to Complainant (whether by or through Schedule E or any other Complaint Schedule); it does not suffice that Complaint Schedule E shows that the addresses for the <covercrete.com> registrant, and contacts, are in the same Ontario city as Complainant’s address (i.e. Pickering). Likewise, although Complaint Schedule F is contended to be, and may well be, copies of all of the pages that resolve through a web site at <www.covercrete.com>, it is also contended but is not sufficiently evidenced that <www.covercrete.com> is Complainant’s web site.

More specifically, the question basically is whether Complaint Schedule F shows the use of COVERCRETE as a Policy ¶ 3.2(a) “Mark” in association with wares (in the manner required by Policy ¶ 3.5(a)), in association with services (in the manner required by Policy ¶ 3.5(b)), or in association with a business (in the manner required by Policy ¶ 3.5(c)), and, if there is any such use, then whether such use confers Policy 3.3(a) “Rights” on Complainant by being within the expression “used in Canada by that person, that person’s predecessor in title or a licensor of that person or predecessor.” The short answer is “no.”

As for wares in the manner required by Policy ¶ 3.5(a), the requirement is

- (i) if, at the time of the transfer of the property in or possession of the wares in the normal course of trade, the Mark is marked on the wares themselves or on the packages in which they are distributed or the Mark is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred; or (ii) at the time the wares are exported from Canada, if the Mark was marked in Canada on the wares or on the packages in which they are contained and the wares or packages are still marked when exported.

Schedule F does not appear to include evidence of any such use. On various pages of the Schedule, the URL text “http://www.covercrete.com/” appears in small font in the bottom left-hand corners (either *simpliciter* or with further text following immediately to the right of the third forward-slash), various wares are referred to as “Covercrete” wares or “COVERCRETE” wares, and attributes and usage of such wares are mentioned, but there does not appear to be evidence of any mark even comprising COVERCRETE being marked on wares themselves or on the packages in which they are distributed, whether internally to Canada or in being exported from Canada. Nor do any of those pages appear to evidence any mark even comprising COVERCRETE is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

As for services in the manner required by Policy ¶ 3.5(b), the requirement is “if the Mark is used or displayed in the performance or advertising of those services.” Schedule F does not appear to include any evidence of use or display of COVERCRETE in the performance of services. Schedule F might instead appear to include evidence of Policy ¶ 3.5(b) use of COVERCRETE, in that various of the pages include, in the advertising of

services, the use or display of one or more of COVERCRETE FLOORING SYSTEMS, either or both of two COVERCRETE FLOORING SYSTEMS (plus respective design features) marks,²⁷ and the above-mentioned URL. However, the rule from *CII Honeywell Bull*, referred to above,²⁸ applies once again.

Similarly, as for a business in the manner required by Policy ¶ 3.5(c), the requirement is “if the Mark is displayed in the operating, advertising or promoting of the business.” Schedule F does not appear to include any display of COVERCRETE in the operating of the business. Schedule F might instead appear to include evidence of Policy ¶ 3.5(c) use of COVERCRETE, in that various of the pages include, in the advertising or promoting of a business, the display of one or more of COVERCRETE FLOORING SYSTEMS, either or both of the two COVERCRETE FLOORING SYSTEMS (plus respective design features) marks mentioned in the immediately preceding paragraph hereof,²⁹ and the above-mentioned URL. However, once again, the rule from *CII Honeywell Bull* likewise applies.³⁰ Moreover, Ontario’s *Business Names Act* prohibits corporations from carrying on business, or identifying themselves to the public, under names other than their corporate names unless those other names are registered under that Act by those corporations or unless otherwise excepted;³¹ the Complaint contains no evidence of any such registration or that any such exception applies.³²

As for the person to whom the benefit of such contended use would inure as required by Policy 3.3(a), several of the Complaint Schedule F documents state Complainant’s contact information along with Complainant’s corporate name. However, rather than doing so in the sense of referring internet users to Complainant, the statements recite that

²⁷ That last page of Complaint Schedule F (i) appears to have the same content as the first two pages of Complaint Schedule F (aside from each photograph being different); and (ii) is an example of those of the Complaint Schedule F pages that include either or both of those two COVERCRETE FLOORING SYSTEMS (plus respective design features) marks, at least in the sense of how those marks appear.

²⁸ Associated with *supra* note 25: when using a composite mark, one does not use only a part of it.

²⁹ *Supra* note 27.

³⁰ Associated with *supra* note 25: when using a composite mark, one does not use only a part of it.

³¹ *Business Names Act*, R.S.O. 1990, c. B.17, s. 2(1) in view of the s. 1 definitions of “corporation”, “business”, and “registered” which respectively appear in brackets herein (with changes required for grammatical purposes), is as follows: “No corporation [wherever or however incorporated] shall carry on business [and business includes every trade, occupation, profession, service or venture carried on with a view to profit] or identify itself to the public under a name other than its corporate name unless the name is [registered under this Act] by that corporation.” Exceptions are provided for, such as by *Business Names Act*, R.S.O. 1990, c. B.17, s. 2(3.2) that the other “name is set out in a partnership registration under subsection 4(1) or a declaration under the *Limited Partnerships Act*.”

³² Complainant is such a corporation (as per the Policy ¶ 1.4 discussion above); *arguendo*, even if it either carries on such business, or identifies itself to the public, under other than its corporate name, there is in this Proceeding no evidence of any such registration or that any such exception applies. The Panel takes judicial notice that copies of such registrations are available from the Ontario Ministry of Consumer and Business Services, as provided for by *Business Names Act*, R.S.O. 1990, c. B.17, s. 8.

corporate name and contact information in connection with Complainant being a “Company” regarding, or “Manufacturer/Supplier” of, various “Covercrete” wares and as the source of those various documents, which contain that contact information and corporate name and which describe mainly technical or health and safety aspects of such wares. Also, one of the pages refers internet users to various entities which are apparently carrying on business using the expression “Covercrete” followed by a geographic locator whether foreign (i.e. “Covercrete Argentina,” “Covercrete Brasil,” and “Covercrete Mexico”) or domestic (i.e. “Covercrete Canada (Ontario)” and “Covercrete Canada (BC)”); the relationship between Complainant and those various entities is neither pleaded nor sufficiently evidenced. As well, the Complaint contact person is stated on two locations at the web site to be “President” but president of what is not stated; Complainant’s corporate name does not appear on the <www.covercrete.com> web site in that way.

In any event, even if Complaint Schedule F otherwise evidences what Complainant contends it evidences, Complaint Schedule F would not overcome the problems described below under the heading of “‘Rights’ Onset Prior to Contested Domain Name Registration.”

CONTENDED POLICY ¶ 3.2(c) “MARKS” AND POLICY ¶ 3.2(a) REVISITED

That there are two “Marks” within Policy ¶ 3.2(c) as CIPO-registered trade-marks TMA562801 and TMA562802 (each for COVERCRETE FLOORING SYSTEMS plus respective design features) is contended to be evidenced by respective CIPO trade-mark database records for each of them: Complaint Schedule B and Complaint Schedule C. Complaint Schedule B was printed on “4/28/2004” and Complaint Schedule C was printed on “3/31/2004”; each is three pages long. Through such information as the CIPO trade-mark database URLs on each of those two Schedules, the second and third pages of Schedule C clearly indicate that they are actually merely the second and third pages of Schedule B. As a result, the Panel takes judicial notice of the respective CIPO trade-mark database records at <<http://strategis.ic.gc.ca/SSG/1003/trdp100370100e.html>> and <<http://strategis.ic.gc.ca/SSG/1003/trdp100370200e.html>>. By doing so, the Panel finds that there are two “Marks,” within the meaning of “Mark” as defined by Policy ¶ 3.2(c) and in which Complainant has “Rights,” within the meaning of that expression as defined by Policy ¶ 3.3: CIPO-registered trade-marks TMA562801 (referred to hereinafter as “the ‘801 registration’”) and TMA562802 (referred to hereinafter as “the ‘802 registration’”), each for COVERCRETE FLOORING SYSTEMS plus respective design features. The mark of the ‘801 registration is referred to hereinafter as “the ‘801 mark’” and the mark of the ‘802 registration is referred to hereinafter as “the ‘802 mark’”.

The records at those URLs of the ‘801 registration and of the ‘802 registration show that each of the two applications that resulted in those registrations (i) was filed on February 1, 1999 on the basis of proposed use; (ii) was advertised on July 12, 2000 in *Trade-marks Journal*, Volume 47, Issue 2385;³³ (iii) was allowed on September 29, 2000; (iv) was

³³ In general, the *Trade-marks Journal* web site at <[http://napoleon.ic.gc.ca/cipo/tradejournal.nsf/\\$\\$ViewTemplate+](http://napoleon.ic.gc.ca/cipo/tradejournal.nsf/$$ViewTemplate+)

abandoned on February 20, 2002 under *Trade-marks Act*, R.S.C. 1985, c. T-13, s. 40(3); (v) had a declaration of use filed on May 22, 2002; and (vi) resulted in the trade-mark registrations on May 29, 2002.³⁴

Then there is the May 11, 2004 statutory declaration (with its “Exhibit ‘A’”) that is Complaint Schedule G. The body of that statutory declaration includes the following six statements as to the two CIPO-registered trade-marks: (i) they became CIPO-registered on May 29, 2002; (ii) the registrations resulted from applications “filed with CIPO on the basis of *proposed use*” (emphasis in original); (iii) the marks are “‘Covercrete Flooring’ and accompanying design features”; (iv) use of the two CIPO-registered marks by Complainant in commerce within Canada is evidenced by a copy of Complainant’s “generic product label” which is Exhibit “A”; (v) use of that proffered product label, by Complainant in commerce within Canada, was since at least as early as January, 1998; and (vi) that the applications which resulted in those two registrations were filed based on proposed use happened “inadvertently.” Each of those listed statements is addressed in the following five paragraphs.

As for statements “(i)” and “(ii)” of that list, the ‘801 mark and the ‘802 mark did indeed become CIPO-registered on May 29, 2002 as a result of applications filed with CIPO on the basis of proposed use. That is proven by the CIPO records referred to in the two paragraphs before the immediately preceding paragraph hereof.

As for statement “(iii)” of that list (i.e. that each of the ‘801 mark and the ‘802 mark is of “‘Covercrete Flooring’ and accompanying design features”), Complainant is mistaken in that each of the ‘801 mark and the ‘802 mark also includes SYSTEMS. Neither the ‘801 mark nor the ‘802 mark is COVERCRETE FLOORING and respective design features. Instead, each of the ‘801 mark and the ‘802 mark is COVERCRETE FLOORING SYSTEMS and respective design features.

As for statement “(iv)” of that list (i.e. that use of either or both of the ‘801 mark and the ‘802 mark is evidenced by use of Complainant’s “generic product label,” a copy of which is Complaint Schedule G’s Exhibit “A”), Complainant is mistaken. Instead, from comparing the proffered product label with each of the ‘801 mark and the ‘802 mark, it appears that neither the ‘801 mark nor the ‘802 mark is in the proffered product label and

for+TMJournal+English?OpenForm> includes that “The electronic form of the Journal is the official version.” (However, the Panel also notices that each issue of the *Trade-marks Journal* contains a notice that “The Registrar of Trade-marks cannot guarantee the accuracy of this publication, nor assume any responsibility for errors or omissions or the consequences of these.”) The Panel takes judicial notice of *Trade-marks Journal*, Volume 47, Issue 2385, at <http://strategis.ic.gc.ca/sc_mrksv/cipo/tm/tm_journal2000/12juil2000.pdf>, which summarizes the application for registration of the ‘801 mark at 45-46 and the application for registration of the ‘802 mark at 46, and, for each, shows the respective mark and confirms the February 1, 1999 filing date and the proposed use application basis.

³⁴ The Panel takes judicial notice of *Trade-marks Journal*, Volume 49, Issue 2486, at <http://strategis.ic.gc.ca/sc_mrksv/cipo/tm/tm_journal2002/19jun2002.pdf>, which confirms the following about the applications to register each of the ‘801 and ‘802 marks: the May 29, 2002 registration, the application number, the volume and issue of the *Trade-marks Journal* in which the application was advertised, and the July 12, 2000 advertisement date.

that the proffered product label shows a composite mark comprised of at least two components: (1) what appears to be the *top-most part* of the '801 mark (without including any word-design element of the '801 mark); and (2) below that, "FLOORING SYSTEMS" surmounted by what appears to be the *top-most part* of the '802 mark. Indeed, between those two components, there appears to also be a further component to the proffered product label: two lines of text the upper-most of which is "DO IT RIGHT" immediately followed by the lower-most line of the two lines of text, which is "DO IT ONCE". "DO IT RIGHT" is substantially offset downwardly from the bottom of what appears to be the *top-most part* of the '801 mark and "DO IT ONCE" is substantially offset upwardly from what appears to be the *top-most part* of the '802 mark; "DO IT RIGHT" and "DO IT ONCE" are also in close proximity to one another and may well appear on the proffered label as a trade-mark.³⁵ In any event, the proffered product label shows a composite mark that does not include either or both of the '801 mark or the '802 mark and, once again, the above-mentioned rule from *CII Honeywell Bull* applies, i.e. when using a composite mark, one does not use only a part of it;³⁶ and the proffered product label does not evidence use of either or both of the '801 mark or the '802 mark.

As for statement "(v)" of that list (i.e. that use of that proffered product label, by Complainant in commerce within Canada, was since at least as early as January, 1998), the immediately preceding paragraph hereof renders it unnecessary for the Panel to make a finding on the point. In any event, Complaint Schedule G's Exhibit "A" is undated and appears to be only part of a product label.

As for statement "(vi)" of that list (i.e. that the applications which resulted in the '801 registration and in the '802 registration were filed based on proposed use happened "inadvertently"), the next-to-immediately preceding paragraph hereof renders it unnecessary for the Panel to make a finding on the point. In any event, the second sentence of the immediately preceding paragraph hereof, along with the discussion above in the first two paragraphs under this heading of "Contended Policy ¶ 3.2(c) 'Marks' and Policy ¶ 3.2(a) Revisited" and all the discussion below under the heading of "Rights' Onset Prior to Contested Domain Name Registration," render the statement insufficient.

"RIGHTS" ONSET PRIOR TO CONTESTED DOMAIN NAME REGISTRATION

In the above-mentioned Complaint Schedule J (i.e. a copy of what appears to be a March 19, 2004 letter to Registrant from the lawyer who became Complainant's representative in this Proceeding), the last line of "Page 2" includes that the writer of that letter "understand[s] that [the] registration [of the contested domain name] was effected on March 1, 2001." That does not prove that the contested domain name was registered on

³⁵ The text "Do It Right, Do It Once!" features prominently on the web site which resolves through <www.covercrete.com> (i.e. at the top of its first and last pages), with "Do It Right, Do It Once!" being immediately followed (i.e. the next line down) by "The Ultimate in Polyurethane Flooring Technology" and being referred to shortly thereafter on those two pages as "Our motto". Neither the '801 mark nor the '802 mark appears on that web site.

³⁶ See *supra* note 25.

that date. However, the above-mentioned judicially noticed whois record regarding the contested domain name does basically prove that, by including that the “Date” on which the registration was “approved” was “2001/03/01”.³⁷

Despite Complainant’s pleading of longstanding use (seemingly made as to all four contended “Marks”), the Complaint does not contain one or more of the sorts of evidence that can reasonably be inferred would be available to Complainant if such use by Complainant or Complainant’s contended predecessor-in-title had occurred at the respective times the Complaint contends it occurred.³⁸ Evidence of that sort has been referred to in various panel decisions made under the Policy, one of which is included in the Complaint.³⁹ In this Proceeding, evidence of use at the pertinent times can reasonably be expected to have included one or more of date-bearing versions of such things as business cards, letterhead, fax cover sheets, invoice or purchase order forms, product brochures, newspaper or other advertisements, yellow-pages listings, flooring-trade directory listings, web site content, and contract documents (such as for the creation or use of such things and which include galley-proofs of such things or the things as actually used).

As to Complaint Schedule F, even if it otherwise evidences what Complainant contends it evidences, (i) most of the Complaint Schedule F pages are undated or are dated April 1, 2004,⁴⁰ which is 37 months after the March 1, 2001 date of registration of the contested domain name and is on the order of at least two weeks after the dispute between Complainant and Registrant arose;⁴¹ and (ii) the earliest (and apparently only) purported

³⁷ Another date in that same record has the number in its right-most digit-set larger than the number of months in the year, so the right-most digit-set must be for days; hence, the approval date appears to be March 1, 2001. The Panel has applied similar analyses to Complaint Schedules and to the records found at the URLs for the two CIPO-registered trade-marks.

³⁸ Cf. *Riches, McKenzie & Herbert v. Pepper King Ltd.*, Federal Court (T-1431-99, 28th September, 2000) on-line at <<http://decisions.fct-cf.gc.ca/sino/disp.pl/fct/2000/t-1431-99.shtml>> especially at paras. 3 to 5, 16 to 18, and 21 to 22.

³⁹ See e.g. *Browne & Co. Ltd./Lteé v. Bluebird Industries* (CIRA 00002). See also, *Acrobat Construction/Entreprise Management Inc. v. 1550507 Ontario Inc.* (CIRA 00013) and *Cheap Tickets and Travel Inc. v. E-mail.ca Inc.* (CIRA 00004).

⁴⁰ As mentioned above under the heading of “Contended Policy ¶ 3.2(c) ‘Marks’ and Policy ¶ 3.2(a) Revisited” Complaint Schedules B and C bear particular dates of printing. Those Schedules and Schedule F appear to have been printed by or on behalf of Complainant through a computer system in preparation for this Proceeding and it can reasonably be inferred that they all have the same printing-date specification-preference; that appears to be supported by a review of all the Schedules. The Schedule B and C dates include, as the middle set of the three sets of digits in each date, numbers which exceed the number of months in the year, so, in each instance, the left-most digit-set of each date appears to specify the *month*, with the middle digit-set specifying the *day* of that month. The computer-system printing date on those of the Complaint Schedule F pages that bear such a date is “4/1/2004” which is therefore April 1, 2004.

⁴¹ The Complaint Schedule J letter is dated “March 19, 2004” and is indicated by the last two lines on its last page (i.e. “Page 4”) as being copied to Complainant. On page 3, it refers to the first contended telephone call, and includes as the last two lines on that page the paraphrased Policy ¶ 4.1(a) requirement “That the registrant’s dot-ca

authoring date on any of the Schedule F pages is marked as “February 2002” which is approximately eleven months after the March 1, 2001 date of registration of the contested domain name.

As to Complaint Schedule G, the question basically is whether it shows the use of COVERCRETE as a Policy ¶ 3.2(a) “Mark” in association with wares (in the manner required by Policy ¶ 3.5(a)), in association with services (in the manner required by Policy ¶ 3.5(b)), or in association with a business (in the manner required by Policy ¶ 3.5(c)), and, if there is any such use, then whether such use confers Policy 3.3(a) “Rights” on Complainant by being within the expression “used in Canada by that person, that person’s predecessor in title or a licensor of that person or predecessor.” The short answer is “no.” An analysis largely structured in a manner similar to the analysis set out above as to Complaint Schedule F pertains , but it will not repeated here. Suffice it to say, the Complaint Schedule G evidence does not suffice. The Policy ¶ 1.1 purpose that appropriate cases “be dealt with relatively inexpensively and quickly,” neither relieves Complainant from proffering sufficient evidence nor results in this Panel ascertaining the facts of mark use merely through the Complaint’s pleading or from the very general statements in the body of Complaint Schedule G.⁴²

Lastly, there is Complainant’s contention that business name use and corporate name use, each contended above, is longstanding and thereby necessarily creates a nexus between those two names and the two CIPO registrations such that the subsequent CIPO registrations “should be of persuasive weight in the determination of the issues of ownership and use of such Marks.” In view of the above findings regarding Policy ¶ 4.1(a), the sort of simultaneous mutual bootstrapping contended for Complainant does not avail.

Policy ¶ 3.4: “Confusingly Similar”

In view of the “Complainant ‘Rights’ in One or More ‘Marks’” part of this discussion, the Panel need not find whether the contested domain name is “Confusingly Similar,” within the meaning of that expression as defined by Policy ¶ 3.4.

Legitimate Interests

The context in which this part of this discussion would have occurred includes Policy ¶¶ 3.5 (which defines “use” and “used,” and is set out above in the “Confusing Similarity” part of this discussion) and 3.6 (which is expressly referred to in Policy ¶ 4.1(c), refers to “use” and “used,” and defines domain-name registrant legitimate interests in a disputed domain name).⁴³ However, Policy ¶ 4.1(a) has not been satisfied. Therefore, whether

domain name is confusingly similar to a mark in which the complainant had rights prior to the date of registration of the domain name.”

⁴² Compare, *Riches, McKenzie & Herbert v. Pepper King Ltd.*, *supra* note 38.

⁴³ Policy ¶ 3.6 is as follows

Registrant has a “legitimate interest” in the contested domain name, within the meaning of “legitimate interest” as defined by Policy ¶ 3.6, need not be found by the Panel.

Registration in Bad Faith

The context in which this part of this discussion would have occurred includes Policy ¶ 3.7, which is expressly referred to in Policy ¶ 4.1(b) and defines bad-faith registration of a disputed domain name.⁴⁴ However, Policy ¶ 4.1(a) has not been satisfied. Therefore,

3.6 Legitimate Interests. The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint was submitted:

- (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 used 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 3.6 (b), (c), and (d) “use” by the Registrants includes, but is not limited to, use to identify a web site.

⁴⁴ Policy ¶ 3.7 is as follows:

3.7 Registration in Bad Faith. For the purposes of paragraph 3.1(c), a Registrant will be considered to have registered a domain name in bad faith if, and only if:

- (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 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

whether Registrant has registered the contested domain name in “bad faith,” within the meaning of that expression as defined by Policy ¶ 3.7, need not be found by the Panel.

DECISION

Policy ¶¶ 1.4 and 3.1 having been satisfied, but Policy ¶ 4.1 having not been satisfied, the Panel concludes that the relief requested by Complainant shall be **DENIED**.

Rodney C. Kyle, Sole Panelist
Ottawa, Ontario Canada
Dated: July 26, 2004

prevent persons who have Rights in Marks from registering the Marks as domain names;
or

- (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.