

IN THE MATTER OF A COMPLAINT PURSUANT TO THE
CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY

Domain Name: CANASA.CA

Complainant: Canadian Security Association

Registrant: 1687734 Ontario Inc.
o/a Trademark Protection

Registrar: Namespro Solutions Inc.

Panelists: Sharon Groom, Jay Josefo, Teresa Scassa (Chair)

Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant, Canadian Securities Association, is incorporated under the laws of Canada since October 14, 1977. Its principal place of business is located at 610 Alden Rd., Suite 100, Markham, Ontario.

2. The Registrant of the disputed domain name is 1687734 Ontario Inc., o/a Trademark Protection, which has its principal place of business at 18 Marcel Place, Hamilton, Ontario. The administrative contact is Carmine Lofaro, who is also a director and president of the Registrant corporation.

B. The Domain Name and Registrar

3. The disputed domain name is CANASA.CA. The Registrar for the domain name is Namespro Solutions Inc. The disputed domain name was registered on June 1, 2005.

C. Procedural History

4. This is a proceeding under the Canadian Internet Registration Authority (CIRA) *Domain Name Dispute Resolution Policy* (Version 1.2) (the *Policy*) and the CIRA *Domain Name Dispute Resolution Rules* (Version 1.3) (the *Rules*).

5. The history of the proceeding, according to information provided by the dispute resolution provider, Resolution Canada, Inc., is as follows:

- The Complainant filed a complaint against the Registrant with Resolution Canada, Inc., requesting that the current registration of the domain name CANASA.CA be transferred to the Canadian Security Association. The Complaint was received by Resolution Canada on April 16, 2009.
- Notice and an electronic version of the Complaint were sent to the Registrant on April 20, 2009. A hard copy of the Complaint was also sent by courier.
- On May 8, 2009 the Registrant requested a 20 day extension in which to file his response pursuant to Paragraph 5.4 of the *Rules*. The request for a 20-day extension was denied on the basis that the Registrant was unable to establish exceptional circumstances required by Para. 5.4. However, the deadline was extended to May 14, 2009.
- On May 15, 2009, Resolution Canada (the Provider) communicated to the Registrant that the Response he filed was not in administrative compliance with the *Policy* and *Rules*. In particular, the deficiencies were:
 - failure to provide the name, postal and e-mail addresses, and the telephone and facsimile numbers of the Registrant and any authorized representative of the Registrant (*Rules*, Paragraph 5.2 (a))
 - failure to indicate a preferred method for communications directed to the Registrant (*Rules*, Paragraph 5.2(b))
 - failure to conclude with the certification of the Registrant in the form set out in the *Rules*, Appendix B, followed by the signature of the Registrant or its authorized representative
- The Registrant was given until May 25, 2009 to correct the deficiencies in accordance with Paragraph 5.6 of the *Rules*.
- On May 25, the Registrant sent an Amendment to Response to the Provider. The Amendment included the name and telephone number of the contact person, Carmine Lofaro. A fax number was noted as “not available”. No postal address was provided. A preferred method for communications was not indicated. The certification set out in the *Rules*, Appendix B, and required by Paragraph 5.2(i) of the *Rules* was not provided.
- On May 26, the parties were notified of the selection of the panelists, with a deadline for the forwarding of a decision by June 16, 2009.
- Following the withdrawal of one of the panelists, the Provider sent out a notice of Re-Selection of Panelist on May 29, 2009, pursuant to Paragraph 7.3 of the *Rules*. The panel appointed consists of Sharon Groom, Jay Josefo and Teresa Scassa. Dr. Scassa was named as Chair of the panel. The revised deadline for the forwarding of a decision of the panel was June 19, 2009.
- As required by Paragraph 7.2 of the *Rules* all three panelists have submitted to the Provider a declaration of impartiality and independence in relation to this dispute.
- On May 29, 2009, Resolution Canada received a Supplemental Submission from the Complainant. The panel was asked if it wished to have the supplemental submission forwarded to it. The panel declined, citing

Paragraph 11.1 of the *Rules*, which gives the panel the sole discretion to request further evidence or argument from either of the Parties, and gives neither party the right to make additional submissions unless such a request is made.

D. The Deficient Response

6. As stated above in the Chronology, the Registrant was notified that its initial Response to the Complaint was not in compliance with the *Rules*. The non-compliance related to a failure to provide the contact information required in clause 5.2(a) of the *Rules*, failure to indicate a preferred method of communication (*Rules*, 5.2(b)) and failure to include the certification of the Registrant (*Rules*, 5.2(i)).

7. Paragraph 5.2(i) specifically requires that the Response “conclude with the certification of the Registrant in the form set out in Appendix B, followed by the signature of the Registrant or its authorized representative.” Appendix B sets out the language to be included in the Response, which the Registrant must certify. Appendix B reads:

1. The Registrant certifies that the information contained in this Response is to the best of the Registrant’s knowledge complete and accurate and that the assertions in this Response are warranted under the CIRA Domain Name Dispute Resolution Policy (the “Policy”) and the CIRA Domain Name Dispute Resolution Rules (the “Resolution Rules”) and under applicable Canadian law, as it now exists or as it may be extended by a good faith and reasonable argument.

2 The Registrant will submit, with respect to any challenge to a decision in the Proceeding to the jurisdiction of a superior court of a province or territory of Canada having jurisdiction over the Registrant pursuant to the rules of such court or, if no such court has jurisdiction pursuant to its rules, to the jurisdiction of the superior court of the province or territory in Canada in the city in which the Provider has its principal place of business in Canada, as posted on the Provider’s website, or the jurisdiction of the superior court in the City of Ottawa in the Province of Ontario.

A Notice of Deficient Response was sent by Resolution Canada to the Registrant. The Registrant responded with some additional particulars as to contact information. However, in spite of clear notice that his Response was deficient in this respect, the Registrant did not provide the certification required by Paragraph 5.2(i) of the *Rules* as set out in Appendix B.

8. According to the *Rules*, if deficiencies in a Response are not corrected to the satisfaction of the Provider, “the Panel shall decide the Proceeding on the basis of the Complaint.” (*Rules*, 5.6).

9. In this case the non-compliance with the prescribed form of the Response is not merely technical. The Registrant has not certified the completeness and accuracy of its

response, nor has it confirmed a willingness to submit to the jurisdiction of a superior court of Canada in the event of a challenge to the decision. In the view of the panel, the failure to certify the Response in the manner set out in Appendix B is a substantive element of non-compliance.

10. Notwithstanding the fact that he was given an opportunity to correct the deficiency in its Response, the Registrant did not certify the completeness, accuracy and good faith of its Response. As a result, the panel will decide the Proceeding on the basis of the Complaint only, as required by Paragraph 5.6 of the Rules.

E. Canadian Presence Requirements

11. The Complainant, Canadian Security Association, is a company incorporated under the laws of Canada. As such, it meets the Canadian Presence Requirements under paragraph 2(d) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3.

F. Factual Background

12. The Complainant owns the Canadian registered trade-mark CANASA. This mark was registered on November 3, 1998 (TMA 503598) for use in association with:

WARES:

(1) Alarms (namely, burglar, fire, anti-intrusion) for use in homes and businesses.

SERVICES:

(1) Analysis, education and research relating to the alarm and security industry; advocacy, lobbying and conducting of trade shows and expositions on behalf of the alarm and security industry.

13. The Complainant claims use in Canada of the CANASA mark since 1977. The Complainant operates a web site at CANASA.ORG. Reference to the CIRA WHOIS database indicates that the domain name for this site was approved on September 4, 1996.

14. The Registrant, Trademark Protection, registered the disputed domain name CANASA.CA on June 1, 2005. The Complainant has provided evidence, in the form of a screen shot captured on March 19, 2009, that for some period of time the domain name resolved to a web site that provided a series of links to various products or services. Although not all of the headings for the links were security-related, many were. They included: Home Security Systems, Network Security, Home Alarm System, and Home Security. Other links on the page included: Join Canasa, Canasa Members and Membership Fees.

G. CIRA *Domain Name Dispute Resolution Policy* Requirements

15. Paragraph 3.1 of the *Policy* requires the Complainant to establish 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.

16. According to paragraph 4.1 of the *Policy*, the Complainant must establish elements (a) and (c) above on a balance of probabilities. The Complainant must also provide "some evidence" that the Registrant has no legitimate interest in the domain name.

H. Analysis

Confusingly Similar to a Mark in which the Complainant had Rights

17. In order to succeed with the Complaint, the Complainant must first establish that "the Registrant's dot-ca domain name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such rights." (*Policy*, sub-para. 3.1) The *Policy* contains definitions of each of the terms "Mark", "Rights" and "Confusingly Similar."

18. The definition of "Mark" is found in sub-paragraph 3.2 of the *Policy*. Sub-paragraph 3.2(c) provides:

3.2 Mark. A "Mark" is:

...

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

19. The definition of "Rights" is found in sub-paragraph 3.3. Sub-paragraph 3.3(b) provides that a person has Rights in a Mark if:

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;

20. The panel finds that the Complainant has rights in the registered trade-mark CANASA. The Mark is registered with CIPO, and the Complainant is listed as the owner of the Mark.

21. The Complainant has established that its rights in the mark CANASA predate the registration by the Registrant of the disputed domain name. CANASA was registered on

November 3, 1998 (TMA 503598). The disputed domain name was registered on June 1, 2005.

22. The Complainant must establish on a balance of probabilities that the disputed domain name is “Confusingly Similar” to the Mark in which the Complainant has rights. According to para. 3.4 of the *Policy*, a domain name is confusingly similar to a Mark when it “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.”

23. The *Policy* defines “domain name” as “the domain name excluding the “dot-ca” suffix and the suffixes associated with all third and fourth level domain names accepted for registration by CIRA”. In determining whether the domain name CANASA.CA is confusingly similar to the Complainant’s Mark CANASA, one must therefore consider only the CANASA portion. If this is done, it is clear that the domain name is identical to the Complainant’s registered trade-mark. Since CANASA is a coined word that has been used by the Complainant since 1977, the Registrant’s use of an identical mark in its domain name is likely to be mistaken for the Complainant’s Mark. (*priceline.com Inc. v. Malaker*, 2005 CIRA Decision #00045)

Registrant has No Legitimate Interest in the Mark

24. Under sub-paragraph 4.1(c) of the *Policy*, the Complainant must provide some evidence that “the Registrant has no legitimate interest in the domain name”. Paragraph 3.6 identifies six circumstances in which a legitimate interest may arise. These are:

- (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.*

25. The Complainant submits that the Registrant has never been licenced or authorized to use the CANASA trademark in any form or for any purpose. It also maintains that it never consented to the Registrant registering CANASA as a domain name. The Complainant argues that this establishes that the Registrant had no rights to the Mark and did not use the Mark in good faith (*Policy, 3.6(a)*).

26. The Complainant further argues that the disputed domain name resolved to a website that appeared to be associated with a pay-per-click service. It is of the view that this type of use cannot be considered a good faith use of the Mark. Further, the Complainant maintains that this demonstrates that the only interest of the Registrant in the Mark was to generate a profit by "attempting to capitalize on consumer confusion."

27. Even if the disputed domain name did not resolve to a pay-per-click site, or if the site to which it resolved were not actually a pay-per-click site, the Complainant maintains that there is no evidence of use of the domain name in good faith, as is required in each of sub-paragraphs 3.6(a)-(d).

28. The Complainant also notes that CANASA is not a term that is descriptive of any characteristic of its wares, service or business, as required by sub-paragraph 3.6(b), that it is not a generic name as required by sub-paragraph 3.6(c), and that the Registrant, by virtue of the pay-per-click site, was not engaged in a non-commercial activity as required by sub-paragraph 3.6(d).

29. The Complainant submits that the Registrant cannot demonstrate a legitimate interest under subparagraphs 3.6(e) or (f) because CANASA is not the Registrant's name or surname, nor is it a geographical name of the Registrant's activity or place of business.

30. The Panel finds that the Complainant has met its burden of producing some evidence that the Registrant has no legitimate interest in the domain name.

31. The domain name is clearly a Mark of the Complainant. The Complainant did not consent to or licence any use of this Mark by the Registrant.

32. The domain name consists of a coined word. As such, it is not clearly descriptive of any characteristic of any wares or services with which it might have been used by the Registrant. By the same token, the Mark is not the generic name of any wares or services with which it might have been used by the Registrant.

33. There is nothing to indicate that the Registrant has used the domain name “in good faith in association with a non-commercial activity” as set out in paragraph 3.6(d). On the contrary, the Complainant has produced some evidence that indicates that the domain name was used to divert internet users searching for the Complainant’s web site to the Registrant’s site. Such activity is not a good faith use of a mark. (*RGIS Inventory Specialists v. AccuTrak Inventory*, 2006 CIRA Decision #00053).

34. The domain name is not a legal or other name of the Registrant, nor is it a geographical name of the place of any non-commercial activity or business carried on by the Registrant. There is therefore no legitimate interest within the meaning of Paragraph 3.6(e) or (f) of the Policy.

35. The panel is satisfied that the Complainant has met the “some evidence” threshold for establishing that the Registrant had no legitimate interest in the domain name.

Registration in Bad Faith

36. The exclusive bases for a finding of bad faith registration are set out in subparagraph 3.7 of the *Policy*. They are:

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 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*

In this case, the Complainant alleges bad faith under Paragraphs 3.7(b) and (c).

Paragraph 3.7(b)

37. The Complainant argues that bad faith under Paragraph 3.7(b) is made out because the Registrant registered the domain name in order to prevent the Complainant from registering its Mark as a domain name, and that the Registrant has engaged in a pattern of registering domain names in order to prevent persons who have rights in trade-marks from doing so.

38. In this case, the registration of CANASA.CA certainly has the effect of preventing the Complainant from registering its CANASA mark as a domain name in the .CA domain. However, it must also be shown that the Registrant has engaged in “a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names”.

39. The Complainant has provided evidence that the Registrant company is also listed as the registrant of a large number of domain names in the .CA domain. Many of these domain names incorporate the well known trade-marks of third parties. Just a few examples include: antiqueroadshow.ca, aiginsurance.ca, domtex.ca, eatons.ca, and computerdepot.ca.

40. The Complainant has also provided evidence that the contact person for the Registrant, Mr. Carmine Joseph Lofaro, was the director and founder of Artbravo Inc. when that company, represented by Mr. Lofaro, was found to have engaged in the practice of registering the trademarks of others as domain names in bad faith in 2006. (*The Co-Operators Group Ltd. v. Artbravo Inc.*, 2006 CIRA Decision #00055.) Although the Registrant in this case is a separate corporate entity from Artbravo Inc., Mr. Lofaro is a director and the president of the Registrant.

41. The panel is of the view that the Complainant has clearly demonstrated that the Registrant has engaged in a pattern of registering the Marks of others as domain names so as to effectively prevent those companies or individuals from registering their Marks as domain names.

Paragraph 3.7(c)

42. The Complainant argues that the registration of the domain name CANASA.CA was also in bad faith because it was done “primarily for the purpose of disrupting the business of the Complainant . . . who is a competitor of the Registrant”. To satisfy this element of the policy, it is necessary to show, on a balance of probabilities, first that the registration was primarily for the purpose of disrupting the business of the Complainant, and second that the Complainant is a competitor of the Registrant.

43. The panel has already found that the domain name was registered so as to prevent the Complainant from registering its mark as a domain name. This does not prevent us from finding that the registration was primarily for the purpose of disrupting the business

of the Complainant. Indeed, preventing a party from registering its Mark as a domain name can contribute to the disruption of that party's business. Other decisions under the *CIRA Dispute Resolution Policy* have found bad faith to be established under both Paragraphs 3.7(b) and (c) (*Lee Valley Tools Ltd. v. Pilfold Ventures Inc.*, 2005 CIRA Decision #00040; *Internet Movie Database Inc. v. 384128 Canada Inc.*, 2005 CIRA Decision #00047).

44. The Complainant is a non-profit organization that promotes the interests of its members, who are part of the security industry in Canada. It provides a range of services to its membership. According to its website, these include: "high quality security education, government relations, marketing, communications, leading industry trade shows and the latest industry information and news." Membership in CANASA is not automatic. There is a membership process and compliance with a code of ethics is required.

45. The Complainant provided evidence that at one point the domain name CANASA.CA resolved to a web site that provided links with the following headings: "Home Security Systems", "Trade Show Exhibit", "Network Security", "Home Alarm System", and "Home Security". Each of these links might suggest that the web site to which the domain name resolved was operated by the Complainant Canadian Security Association. In addition, the site also featured links that might suggest to members of CANASA that they were at the Complainant's official site. These links included: "Membership Fees", "Join Canasa" and "Canasa Members". There is no question that the type of confusion that might be created by these headings and links would be disruptive to the Complainant's business.

46. The Complainant also provided evidence that some of the links on the web site resolved to the web sites of companies that provided security-related services of one kind or another. The panel finds that this too was potentially disruptive of the business of the Complainant, as it created the impression that these companies were members of CANASA, even if they had not gone through the membership process or did not comply with the code of ethics.

47. The Complainant also provided evidence that the site may have been operated as part of a pay-per-click service. The Complainant demonstrated that each of the links resolved to other links which drove traffic to other websites. The Complainant provided some evidence that the links redirected through DomainSponsor.com. The diversion of traffic from a Complainant's web site in this manner is clearly disruptive of the Complainant's business, as it is a scheme that necessarily trades upon the goodwill in the targeted company's Mark.

48. Under Paragraph 3.7(c) of the *Policy*, a Complainant must also establish that the Registrant is a competitor of the Complainant.

49. A Registrant who uses a domain name that incorporates another party's trademark to redirect web traffic to a pay-per-click service is necessarily a competitor of that

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party. (*Omer DeSerres Inc. v. Erik Maddeaux*, (2007), CIRA Decision No. 88). In such circumstances, a Registrant seeks to attract potential visitors to the trade-mark holder's web site to his own site for profit.

50. Even if the Registrant were not directly profiting from the use of the Complainant's trade-mark, the Registrant directed traffic away from the Complainant's site to web sites operated by companies in related fields of activity. This has been considered sufficient to find that it is acting as a competitor of the Complainant in other cases. (*Sleep Country Canada Inc. v. Pilfold Ventures Inc.*, (2005) CIRA Decision No. 27; *Lee Valley Tools Ltd. v. Pilfold Ventures Inc.*, 2005 CIRA Decision #00040).


51. The panel finds that the Complainant has successfully demonstrated, on a balance of probabilities, that the Registrant registered the disputed domain name "primarily for the purpose of disrupting the business of the Complainant", and that the Registrant is a competitor of the Complainant.

H. Conclusion & Order

52. To summarize our findings, the Panel is of the view that the Complainant has established that the domain name CANASA.CA is confusingly similar with its registered trade-mark CANASA, and that its rights in the Mark CANASA predate the registration of the disputed domain name. It has also satisfied the panel that the Registrant has no legitimate interest in the domain name. The Complainant has also established, on a balance of probabilities, that the registration of the disputed domain name was in bad faith within the meaning of sub-paragraphs 3.7(b) and (c) of the Policy.

53. The Panel orders pursuant to paragraph 4.3 of the CIRA Policy that the domain name CANASA.CA be transferred to the Complainant Canadian Security Association.


Sharon Groom


Jay Josefo


Teresa Scassa (Chair)

June 19, 2009