

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

Complainant: Netfirms, Inc., North York ON
Complainant’s Representative: Pain & Ceballos LLP, Vaughan ON
Registrant: Dinesh Meriston, Scarborough ON
Disputed Domain Name: <netfirm.ca>
Registrar: Expert.ca
Panel: Denis N. Magnusson (Sole member)
Service Provider: Resolution Canada

DECISION

Parties

The Complainant is Netfirms, Inc, an Ontario corporation with its head office in North York Ontario. The Registrant is Dinesh Meriston of Scarborough Ontario.

Disputed Domain Name and Registrar

The domain name in dispute is <netfirm.ca> which was registered January 21, 2006. The Registrar is Expert.ca.

Eligible Complainant

The Complainant is the owner of the Canadian trademark registration NETFIRMS (TMA606,470) registered for use in association with web-hosting services, electronic services namely the development of web sites for the Internet, and other related services. Given the similarity of the registered trademark and the domain name, the Complainant qualifies as an Eligible Complainant under CIRA Domain Name Dispute Resolution Policy [“Policy”] 1.4, as 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.

Procedural History

The Complainant filed this Complaint with the Provider Resolution Canada on or about December 15, 2008. The Provider, finding the Complaint to be in order under the Policy, transmitted the Complaint to the Registrant. The Registrant did not submit a Response. The Complainant opted to have the Complaint decided by a sole panel member and the Provider appointed Denis N. Magnusson as sole panel member to decide this Complaint.

Relief Requested

The Complainant requested that the Panel order that the domain name registration be transferred from the Registrant to the Complainant.

Background Facts

The Complainant carries on the business of a provider of web hosting, domain name, e-commerce, e-mail, e-marketing services and technology solutions. It registered the trademark

<NETFIRMS> for “Web hosting services; electronic commerce services namely development of web sites . . .” in the CIPO effective March 29, 2003.

The Registrant registered the disputed domain name <netfirm.ca> effective December 6, 2006. Currently, the Registrant’s domain name, <netfirm.ca> resolves to a web page headed “Web Hosting”. On that page there are entries under headings such as “Web Hosting”, “Business Web Hosting”, “Web Design”, and “Business Web Design”. Under these headings are entries which perform as links to various sites offering web hosting and web page design services.

Onus on Complainant

Policy 4.1 requires that:

the Complainant must prove, on a balance of probabilities, that:

- (a) the Registrant’s dot-ca domain name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights; and
- (b) the Registrant has registered the domain name in Bad Faith as described in paragraph 3.7;

and the Complainant must provide some evidence that:

- (c) the Registrant has no Legitimate Interest in the domain name as described in paragraph 3.6.

[emphases added]

(a) Confusingly Similar

Mark in Which Complainant Had and Has Rights

The domain name in dispute was registered on December 6, 2006. Under Policy 4.1(a) the Complainant must show that it had Rights in a Confusingly Similar Mark prior to that date of the registration of the domain name.

Policy 3.2(c) defines “Mark” to include a trademark registered in the CIPO. The Complainant has such a Mark, <NETFIRMS>, which was registered in the CIPO effective March 29, 2003. That registration is still held in the name of the Complainant.

Thus, the Complainant had Rights in the Mark, the trademark <NETFIRMS>, prior to the date of the registration of the disputed domain name, and it still has those Rights.

Confusingly Similar

Policy 3.4 defines “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.”

In assessing similarity, the dot-ca suffix of the domain name is ignored, Policy 1.2. The Complainant’s Mark is its registered trademark <NETFIRMS>. Apart from capitalization and pluralisation, that Mark is the same as the disputed domain name <netfirm.ca>. The domain name is Confusingly Similar to the Complainant’s Mark.

b) Bad Faith

The Complainant has the burden of proving that the domain name was registered in Bad Faith as defined in Policy 3.7

Policy 3.7 has a restrictive definition of what can constitute the Registrant's necessary Bad Faith in registering the domain name. There is Bad Faith, "*if, and only if*" one or more of three specific circumstances obtain. The Complainant submitted that the Registrant had registered the domain names in Bad Faith under several parts of Policy 3.7, including Policy 3.7(c):

"(c) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant . . . who is a competitor of the Registrant."

The Complaint notes that the

"Registrant is not an actual web host, but instead generates revenue by search engine referrals [from its web page located at the disputed domain name <netfirm.ca>] to web hosts (all of which are Complainant's competitors)."

The Registrant's use of the domain name which is Confusingly Similar to the Complainant's Mark to resolve to a web site which links to competitors of the Complainant is "disrupting the business of the Complainant", Policy 3,7(c). Past decisions under the Policy have ruled that where a Registrant does not compete with the Complainant by the Registrant's itself offering services the same as or substitutable for the services of the Complainant, but the Registrant mounts a web site which directs people to competitors of the Complainant, the Registrant is effectively functioning as a competitor of the Complainant for the purposes of Policy 3.7(c).

Past decisions under the Policy have also ruled that the Registrant's purposes in registering the domain name can fairly be inferred from the uses to which the Registrant puts the domain name after registration.

Thus, the Panel concludes that the Registrant did register the domain name in Bad Faith as defined in Policy 3.7(c).

c) No Legitimate Interest

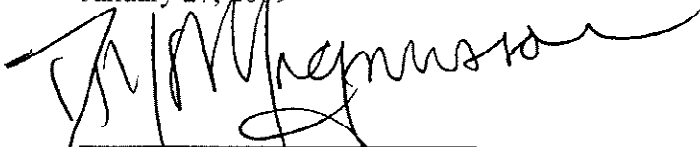
The Complainant must submit some evidence that the Registrant has no Legitimate Interest in the domain name as defined in Policy 3.6. The Complainant has submitted ample evidence that the beneficial owner of the domain name cannot satisfy any of the six heads of Legitimate Interest in Policy 3.6

Conclusion and Order

The Complainant has satisfied the Complainant's burden under the Policy of establishing Confusing Similarity, Bad Faith, and some evidence that the Registrant does not have a Legitimate Interest in the domain name.

For the reasons set out above, the Panel grants the relief requested by the Complainant and orders that the domain name registration <netfirm.ca> be transferred to the Complainant.

January 27, 2009



Denis N. Magnusson
Sole Panel Member