

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

BETWEEN:

NOVA VERTA INTERNATIONAL S.P.A

Complainant

– and –

ITAL/CAN AUTOMOTIVE LTD

Registrant

A. DECISION

The Parties

1. The Complainant, Nova Verta International S.p.a. is a company incorporated under the laws of Italy.
2. The Registrant, ITAL/CAN AUTOMOTIVE LTD, is a company incorporated under the laws of Canada.

B. The domain Name and Registrar

3. The disputed domain name that is the subject of this arbitration is:

- novaverta.ca

4. The Registrar of the Domain Name is Tucows.com Co

C. Procedural history

5. This matter is arbitrated under the CIRA Domain Name Dispute Resolution Policy (the Policy) and the CIRA Domain Name Dispute Resolution Rules (the Rules). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of certain disputes under the Policy and Rules.
6. Based on information from the Dispute Resolution Service Provider – Resolution Canada Inc. – the history of this proceeding can be summarized as follows:

- (a) On March 27, 2008, the Complainant filed with Resolution Canada Inc. a Complaint regarding the Domain Name.
- (b) The Complaint was reviewed by Resolution Canada Inc. and found to be compliant with administrative requirements.
- (c) Resolution Canada Inc. sent a notice of Complaint to the Registrant on April 18, 2008.
- (d) The Registrant failed to provide a Response in the time allowed under Rule 5.1 and did not seek an extension. Therefore, Rule 5.8 requires the arbitral panel to decide the matter based on the Complaint alone.
- (e) The Complainant elected to proceed with a one member panel. The Resolution Canada Inc. named such a panellist, namely, Hugues G. Richard (the “**Panel**”).
- (f) M. Richard delivered to Resolution Canada Inc. a required Statement of Impartiality and Independence, according to Rule 7.2.

D. Preliminary Determinations

7. The Panel was properly constituted and appointed in accordance with the Policy and the Rules.

E. Factual Background

8. Based on the Complaint in this uncontested dispute, a summary of facts is set below.
9. The Complainant is the owner of the following Canadian trademark registered on the date noted.
 - Nova Verta, August 16, 1996, registration number TMA461,209, copy of the registration certificate of Trademark provided as Schedule A of the Complaint.
10. On January 14th, 2003, the Registrant has registered in the CIRA registry and renewed said registration until January 14, 2009 for the disputed novaverta.ca domain name (“**Domain Name**”).
11. On September 4, 2007 and on February 28, 2008, the Complainant’s lawyers sent cease and desist letters to the Registrant regarding the Domain Name, copies of which are provided as Schedule C of the Complaint.

F. Discussion and Conclusions

Eligibility of the Complainant

12. As the owner of the registered Trademark “Nova Verta” with the CIPO office since August 16, 1996 and before the registration of the Domain Name

novaverta.ca by the Registrant effective January 14, 2003, the Complainant is eligible to make this Complaint under the CIRA Policy 1.4.

Confusingly Similar to the Marks

13. The Complainant's burden of proof under paragraph 4.1(a) of the Policy is to establish that "the Registrant's dot ca 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.

First Sub-Element

14. Paragraph 4.1(a) of the Policy contains a number of sub-elements. The first relevant sub-element is whether the Complainant had Rights in the Mark, as defined in paragraph 32 of the Policy, before the registration date of the Domain Name.
15. The Complainant did so. Not only was the Trademark registered, as previously stated, on August 16, 1996 with the CIPO and before the registration of the Domain Name, but it was used even earlier in Canada (since 1983) for the purpose of distinguishing the wares and services of the Complainant's business from others.

Second Sub-Element

16. The second sub-element of paragraph 4.1(a) of the Policy is whether the Domain Name is confusingly similar to the Nova Verta Trademark. Under paragraph 3.4 of the Policy, this would be so if the Domain Name was to resemble the applicable Mark so nearly in appearance, sound or in the ideas suggested by the Mark as to be likely to be mistaken for the Mark.
17. In assessing similarity, the dot ca suffix of the domain name must be ignored. The registered Trademark upon which the Complainant bases its complaint is "Nova Verta" and the Domain Name without the dot ca suffix is "novaverta". The only difference between the Trademark and the Domain Name is the space between the two words. Thus, the Domain Name and the Trademark are identical and therefore risks causing confusion with the latter.

Registration in Bad Faith

18. Under paragraph 4.1(b) of the Policy, the Complainant must prove that the Registrant has registered the domain name in bad faith as described in paragraph 3.7.
19. The Complainant has proven that Registrant registered the Domain Name in bad faith pursuant to section 3.7 (c) which states that "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."

20. The Registrant claims to be the exclusive distributor in Canada of Nova Verta products as stated on Registrant's Website, extracts of which was provided by Complainant as Schedule B of his Complaint.
21. Furthermore, Complainant provides as Schedule D of his Complaint an agreement of exclusive distribution of its products with another distributor in Canada which contradict Registrant's claim of exclusive distribution of Complainant's products.
22. The Registrant and the Complainant are competitors as both sell spray booths.
23. For the above reasons, the Panel holds that the Registrant registered the Domain Name in bad faith.

No Legitimate Interest

24. Under paragraph 4.1(c) of the Policy, the onus is on the Complainant to show at least some evidence that the Registrant has no legitimate interest in the Domain Name. Upon discharging that onus, it then shifts to the Registrant to prove that it has a legitimate interest in the Domain Name.
25. In this uncontested arbitration, Registrant has provided no evidence, so it remains only for the Complainant to show at least some evidence that the Registrant has no legitimate interest in the Domain Name.
26. For the Registrant's use of the Domain Name to be legitimate, that use must fall under one of the sub-paragraphs 3.6(a) – (f).
27. The Complainant states that the Registrant has no rights in the Trademark since Registrant is not a distributor nor has Complainant granted a trademark license pursuant to Section 3.6(a) of the Policy.
28. The Domain Name is not descriptive of the character or quality of the wares or the conditions of or the persons employed in the production of the wares or the places of origin of the wares, be it in the English or French language pursuant to Section 3.6(b) of the Policy.
29. The Domain Name is not understood in Canada as the generic name of wares or services pursuant to Section 3.6(c) of the Policy.
30. The Registrant did not use the Domain Name in Canada in good faith in association with a non-commercial activity pursuant to Section 3.6(d) of the Policy.
31. The Domain Name does not comprise the legal name of the Registrant and is not the name, surname or other reference by which the Registrant is commonly identified pursuant to Section 3.6(e) of the Policy.
32. The Domain Name is not a geographical name of the location of the Registrant's place of business pursuant to Section 3.6(f) of the Policy.

33. The Complainant has satisfied its onus in providing some evidence that the Registrant has no legitimate interest in the Domain Name.

Decision

34. The Panel has decided as follows:

- (a) The Complainant is an eligible complainant.
- (b) The Registrant's Domain Name is Confusingly Similar to the Nova Verta Mark, in which the Complainant had rights before the Registration of the Domain Name, and continues to have such Rights.
- (c) The Registrant has registered the Domain Name in bad faith.
- (d) The Registrant has no legitimate interest in the Domain Name.
- (e) The Complainant has satisfied its onus obligations under paragraph 4.1 of the Policy.

Order

Based on these conclusions, the Panel decides these proceedings in favour of the Complainant and orders that the Registration of the following Domain Name be transferred to the Complainant:

- novaverta.ca

Made this 15th day of May, 2008



Hugues G. Richard
Sole Panelist