

**CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

DECISION

Domain Name: tu cowsreseller.ca

Complainant: Tucows.com Co

Registrant: Interex Corporate Registration Services Inc.

Registrar: rapidregister.ca (David A. McFadden)

Service Provider: Resolution Canada Inc.

Panelists: David Allsebrook (Chair), Alessandro Colonnier, Jay Josefo

A. THE PARTIES

The Complainant is Tucows.com Co (the “Complainant”).

1. The Registrant is Interex Corporate Registration Services Inc. (the “Registrant”).

B. DISPUTED DOMAIN NAME & REGISTRAR

2. The disputed domain name is tu cowsreseller.ca (the “Domain Name”) and the Registrar is rapidregister.ca (David A. McFadden)

C. PROCEDURAL HISTORY

3. This is a dispute resolution proceeding initiated pursuant to the *CIRA Domain Name Dispute Resolution Policy* (the “Policy”) and the *CIRA Policies, Rules, and Procedures - CIRA Domain Name Dispute Resolution Rules* (the “Rules”). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of this dispute pursuant to the Policy and the Rules.
4. The Complainant filed its complaint (the “Complaint”) on February 13, 2014.
5. The Panel was not provided with a Response from the Registrant or advised of its contents.
6. The Panel has been advised by the Provider that Registrant’s Response was filed in a timely fashion but was determined by the Provider to be not in administrative compliance with the Rules. The Registrant’s representative, Daniel Mullen, was advised of all instances of non-compliance, and was given 10 days to correct all such instances of non-compliance per the Rules (Paragraph 5.6). The re-submission was not to the satisfaction of the Provider (Resolution Canada Inc.)
7. The Provider, rather than the Panel, has the responsibility of determining whether or not a Response is in compliance with the Rules (Rule 1.1(a)). The Panel notes that Mr. Mullen frequently serves as the representative to CDRP Panels on behalf of Registrants responding to CDRP complaints, and he has experience filing Responses.

8. On March 28, 2014, the Panel was appointed. As prescribed by the Policy, the Panel has declared to the Provider that it can act impartially and independently in connection with this matter, and that there are no circumstances known to the Panel which would prevent it from so acting.

D. CANADIAN PRESENCE REQUIREMENTS: ELIGIBILITY OF THE COMPLAINANT

9. In order to make a complaint under the Policy a complainant must satisfy the Canadian Presence Requirements or the complaint must relate to a registered Canadian trade mark on the day that the complaint is submitted. (Policy, ss. 1.4, 1.9). Section 2 states that only the individuals and entities meeting the criteria set out in subsections 2(a) to (r) will be permitted to apply for, hold and maintain the registration of .ca domain names.
10. The Complainant Tucows.com Co. is an Ontario Corporation having its head office in Toronto, Ontario. It is a wholly owned subsidiary of a company named in the Complaint as “Tucows A Delaware Corporation”.
11. The Complainant meets the Canadian Presence Requirements (ss. 2.(d)) in that it is a corporation under the laws of Canada or any province or territory of Canada.
12. The Panel is therefore satisfied that the Complainant is eligible to initiate these proceedings.
13. The Complainant alleges that it meets the Canadian Presence Requirements under section 2(q) of the CPR because it is the owner of registration TMA 514026 in Canada for the trade mark TUCOWS. By its terms, section 2(q) does not apply to persons who qualify under one of the previous subsections. In any event, registration TMA 514026 does not belong to the Complainant. The registered owner is Tucows.com Inc. The Complainant does not meet the criteria of section 2(q).

E. THE POSITIONS OF THE PARTIES

The Complainant’s Position

14. The Complainant has been accredited by ICANN as domain name registrar since 1999 and by CIRA since 2000. Tucows manages over fourteen million domain names and millions of value-added services through a reseller network of over 13,000 web hosts and ISPs. It operates the domain name tu cows.com.
15. The Complainant is one of the largest domain name registrars. It earns a significant portion of its revenue from its role as Registrar and the provision of domain name registration services but also offers other services including email, spam virus protection, website creation tools, the Platypus Billing System and digital certificates. Unlike most ICANN accredited registrars it primarily provides its services to its resellers for resale to the public.

16. The Complainant states that it owns the trade mark TUCOWS which was registered in Canada in 1999. However the provided printout of the registration page in the database maintained by the Registrar of Trade-Marks shows that the registration belongs to a different corporation, Tucows.com Inc., and its wares and services pertain to software and not to the registration of domain names (Annex 5). The registration is not relevant.
17. The Complainant cites three trade mark registrations in the United States, but as foreign trade mark registrations have no effect in Canada, and these registrations name a different owner, Tucows Interactive Limited, they are also irrelevant. (Annexes 6,7, and 8)
18. The domain name tu cowsreseller.ca was registered by the Registrant in April 2012 as demonstrated by a printout of the WHOIS information. (Annex 9)
19. The Complainant alleges that the domain name tu cowsreseller.ca is confusingly similar to a common law trade mark TUCOWS in which it has rights.
20. The Complainant alleges “upon information and belief” that the Registrant has no legitimate interest in the domain name. It is not used for any wares, services, or for business or personal or non-commercial purpose. The domain name is not descriptive, generic or reflective of the Registrant’s legal name or geographical location. The domain name is for sale.
21. The Complaint further alleges that the domain name was registered in bad faith, specifically that it was intended to disrupt the business of the applicant.
22. In support of this allegation the Complaint relies partly upon correspondence between the parties. The correspondence is marked “without prejudice” and is directed to resolving the issues between the parties by agreement. Accordingly the correspondence is privileged and its contents are inadmissible in evidence in Courts. The goal of this privilege is to encourage parties to resolve their differences by permitting candour and compromise without the risk of having their concessions held against them if no settlement can be reached. This Panel respects that policy and has not considered the contents of the correspondence.
23. The bad faith allegation also rests upon the submission that the tu cowsreseller.ca is for sale, that its web page pertains to the sale of domain names, which is the business of the Complainant, and that it has links to pages of sponsored advertising which feature ads for services of the complainant’s direct competitors Godaddy, Network Solutions, register.com and others. (Annex 12)
24. The Complainant is seeking the transfer of the Domain Name to it.

The Registrant’s Position

25. The Registrant, having failed to file a response in acceptable form, has made no submissions.

F. DISCUSSION & REASONS

26. In accordance with paragraph 4.1 of the Policy, to succeed in this proceeding, the Complainant must prove, on a balance of probabilities, that:

(a) the Registrant's 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 3.5 of the Policy;

and the Complainant must provide some evidence that:

(c) the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.4 of the Policy.

G. CONFUSINGLY SIMILAR - PARAGRAPH 3.3

27. In order to satisfy this branch of the test, the Complainant must demonstrate (i) that it has rights in a mark, (ii) that the rights in its mark predate the registration date of the Domain Name, and (iii) that the Domain Name is confusingly similar with the disputed domain name.

28. The Complainant's use of the domain name Tucows.com and of its corporate name Tucows.com Co. are sufficient to give it common law trade mark rights in the name TUCOWS. These rights date to the year 1999 and predate the registration of the domain name in 2012.

29. As per paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if the domain name so nearly resembles the mark in appearance, sound or in the ideas suggested by the mark so as to be likely to be mistaken for the mark.

30. Pursuant to paragraph 1.2 of the Policy, a domain name is defined as the second level domain (the portion that immediately precedes the dot-ca suffix).

31. The test to be applied when considering "confusingly similar" is one of first impression and imperfect recollection. The Complainant must prove, on a balance of probabilities, that a person, as a matter of first impression, knowing the Complainant's corresponding marks only, and having an imperfect recollection of the marks, would likely mistake the Domain Name for the Complainant's marks based upon the appearance, sound or the ideas suggested by the mark.

32. The Domain Name begins with "tucows", which is a coined word, and which is inherently distinctive. The wholesale inclusion of the trade mark in the domain

name is sufficient to establish confusing similarity. *Carey International, Inc. v. Fabio Simonetti*, 2013 CIRA-241 <careymontreal.ca>. The presence of the additional generic word “reseller” will not lessen the likelihood of confusion.

33. The Panel finds that the Domain Name is confusingly similar with the TUCOWS Trade-mark in which the Complainant had rights prior to the registration date of the Domain Name, and continues to have such rights.

H. BAD FAITH REGISTRATION

34. To succeed the complainant must prove on a balance of probabilities that the domain name was registered in bad faith. Section 3.5 of the Policy sets out a non-exhaustive list of criteria which may establish bad faith registration. The Complainant relies of subsection 3.5(a) which applies when

“ 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;” (Policy, ss.3.5(a))

35. The domain name resolves to a page having a hyperlink labeled “tuowsreseller.ca may be for sale”. Headings that are apparently hyperlinks arranged across the top of the page read “Reseller”, “Low Cost Web Site Hosting”, “Domain Names” and “Build a Web Site”. Other headings that are apparently hyperlinks on the page also all pertain to web site creation and hosting. (Annex 11)

36. The tuowsreseller.ca web site “in one instance” redirects to a parking page having several links pertaining to the availability of the domain name for sale such as “How do I buy tuowsreseller.ca?” The page invites the viewer to “Join today” and provides login information to become a member and purchase the domain name. The parking page identifies its operator as ParkLogic and its location as ParkLogic Marketplace. (Annex 11)

37. The parking page says in part:

“Parklogic’s Marketplace Members can buy tuowsreseller.ca by negotiating directly with the current owner. Parklogic makes the introduction between the Buyer and the Seller and does not take any commission in the event of a sale.” (Annex 11)

38. The page appears to be a generic page for trading in domain names which has the name of the domain name the user was attempting to reach, or last visited, inserted into the text.

39. The Panel concludes that the domain name is for sale and it is reasonable to assume that it was registered for that purpose.
40. The domain name includes the word 'reseller'. The Complainant's business model is to operate through 13,000 resellers. These resellers form a target market in which the Registrant seeks a purchaser of the domain name, which is adapted to their businesses.
41. It would be truthful and lawful for Tucows resellers to identify themselves as "Tucows resellers" and in this sense they may be considered licensees or analogous to licensees of the mark TUCOWS for the purposes of subsection 3.5(a).
42. In light of the foregoing, the Panel finds that the Complainant has established bad faith per paragraph 3.5(a).

I. LEGITIMATE INTEREST

43. The final element to determine is whether the Registrant has a legitimate interest in the Domain Name.
44. Paragraph 4.1 of the Policy requires the Complainant to provide "some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.6".
45. Once this onus has been discharged by the Complainant, the Registrant may still succeed if it can show, on a balance of probabilities, that it has a legitimate interest in the Domain Name pursuant to paragraph 3.4.
44. The Panel finds that the registrant has no legitimate interest in the domain name. The Complainant has shown that the domain name was registered only for resale, it incorporates the distinctive element Tucows of the Complainant's previously used name and domain name, it adds a descriptor implying a connection to the Complainant, and to the extent it has been used while exhibited for sale, it has served to promote the services of the Complainant's competitors. Accordingly, the Panel finds that the Registrant does not have a legitimate interest in the Domain Name.

J. DECISION & ORDER

45. For the reasons set out above, the Panel decides this dispute in favour of the Complainant.
46. Pursuant to paragraph 4.3 of the Policy, the Panel orders the transfer of the domain name `tucowsreseller.ca` to the Complainant.

Dated at Toronto, Ontario, Canada, this 11th day of April, 2013.

David Allsebrook (Chair), Alessandro Colonnier, Jay Josefo

A handwritten signature in blue ink that reads "David Allsebrook".

per David G. Allsebrook (Chair) for the Panel