

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

Domain Name: THEDECKSTORE.CA
Complainant: The Deck Store Inc.
Registrant: The Deck Store Ltd
Registrar: Go Daddy Domains Canada Inc.
Panellist(s): Myra J. Tawfik
Service Provider: Resolution Canada

DECISION

1. The Parties:

The Complainant is The Deck Store Inc, a legal person incorporated under the *Ontario Business Corporations Act* with its registered office at 454 South Service Road West, Oakville Ontario L6K 2H4. Its administrative contact and authorized representative is Nelia Dutra, Senior Law Clerk.

The Registrant is The Deck Store Ltd, a legal person incorporated under the *Business Corporations Act* of Alberta with its registered office at 11140 154 St. NW, Edmonton, Alberta T5M 3M9 and its administrative contact is Jim Slater. The Registrant is represented by David Schnurr, Miller, Thomson LLP, 295 Hagey Blvd., Suite 200. Waterloo, Ontario N2L 6R5

2. The Domain Name and Registrar

The disputed domain name is THEDECKSTORE.CA and the Registrar is Go Daddy Domains Canada Inc.

3. Procedural History

On March 18, 2014, the Complainant initiated a complaint with Resolution Canada under the Canadian Internet Registration Authority (CIRA) Dispute Resolution Policy (CDRP) and the CIRA Domain Name Dispute Resolution Rules (the Rules). It filed an Amended Complaint on March 27, 2014. Both Complaint and Amended Complaint shall be referred to as The Complaint.

Resolution Canada is an approved Dispute Resolution Service Provider under the CDRP.

Pursuant to Rule 5.1, the Registrant was notified by Resolution Canada that it had 20 days to file 5 copies of a Response to the Complaint.

The Registrant did not file a Response within the stipulated delay.

On May 1st, 2014, further to Rule 6.5, Resolution Canada appointed Myra J. Tawfik as sole panelist on the Complaint after having received from her a declaration of impartiality and independence. A notice of selection of panelist was sent to all parties at that date.

On May 2nd, 2014, the legal representative of the Registrant sent an email message to Resolution Canada claiming that the Registrant had not been properly served and had not received any email communication from Resolution Canada other than the notice of appointment of the Panel. He requested an additional 20 days to provide a Response to the Complaint.

On May 5th, 2014, the Panel granted the Registrant's request pursuant to Rules 1.3 and 1.4. The Registrant was given until May 26th, 2014 to file its Response.

On May 26, 2014, the Registrant filed its Response and requested costs pursuant to s. 4.6 of the CDRP claiming reverse domain name hijacking.

On June 4, 2014, the Complainant submitted a Reply to the Response of the Complainant in respect of the request for costs. (the "Reply")

4. Eligible Complainant

The Complainant is a legal person under the *Ontario Business Corporations Act* and therefore meets the Canadian Presence Requirements for Registrants at s. 2(d).

5. Parties' Contentions

A. The Complainant:

The Complainant alleges the following:

It is an Ontario company incorporated under the name The Deck Store Inc. since January 28, 2008. It claims to be the "largest, independent deck design, supplier and builder company with the only substantial indoor showrooms for Toronto, Oakville, Oshawa and Milton" (Complaint at paragraph 3). It conducts a considerable amount of its business online through its website. It currently holds the domain name registration DECKSTORE.CA.

In 2008, it registered the disputed domain name THEDECKSTORE.CA but inadvertently failed to renew it.

In seeking to re-register the domain name THEDECKSTORE.CA, the Complainant discovered that it had been registered by a competitor carrying on business in Ontario under the name Deck Masters of Canada.

The Complainant alleges that Deck Masters of Canada registered the domain name THEDECKSTORE.CA in order to redirect Complainant's customers to its website. The Complainant also alleges that Deck Masters of Canada also registered THEDECKSTOREINC.CA, this being the Complainant's corporate name, thereby evidencing a pattern of use of the Complainant's corporate name and Mark in bad faith.

The Complainant tried to reach a settlement with Deck Masters of Canada in respect of the disputed domain name including having sent a registered letter and an email on April 8, 2013 advising that it would take legal action.

The Complainant then learned that Deck Masters of Canada had sold the disputed domain name to the Registrant, The Deck Store Ltd., a company incorporated under the laws of Alberta.

The Complainant alleges that the Registrant is a competitor and acquired the disputed primarily for the purpose of selling, renting, licensing or otherwise transferring the domain name to the Complainant. It also alleges that the Registrant registered the domain name to prevent the Complainant from doing so and for the purpose of disrupting the Complainant's business. Finally, it alleges that the Registrant has intentionally attempted to attract, for commercial gain, internet users by creating a likelihood of confusion between the Complainant and the Registrant such that customers of the Complainant would be diverted to the Registrant's website.

The Complainant also alleges that the Registrant and Deck Masters of Canada conspired to divert customers away from the Complainant through the use of THEDECKMASTER.CA domain name.

The Complainant attempted unsuccessfully to resolve the matter with the Registrant.

A WHOIS search conducted by the Complainant identifies the Registrant as The Deck Store Ltd. The date of registration of the domain name is May 13, 2010.

B: The Registrant

The Registrant alleges that:

It is a company incorporated under the laws of Alberta under the name The Deck Store Ltd. It is a retailer of decking products and accessories and the vast majority of its customer base is in Alberta with some customers in British Columbia and Saskatchewan.

In 2010, it opened a retail store in Edmonton under the name THE DECK STORE. It also registered the domain name THEEDMONTONDECKSTORE.CA at around that time.

In expanding its business to Calgary in 2012, it sought to modify its domain name to better reflect its expanding market. It sought to register THEDECKSTORE.CA but discovered that the domain name was already registered to Deck Masters of Canada. In early 2013, it approached Deck Masters of Canada to purchase the domain name. Upon successful negotiations, the Registrant obtained an assignment of the domain name on June 18, 2013.

The Registrant alleges that it had no knowledge of any dispute between the Complainant and Deck Masters of Canada and that it is using the domain name in good faith and has a legitimate interest in it.

6. Findings

Under paragraph 4.1 of the CDRP, the burden is on the Complainant to prove, on a balance of probabilities, that:

- 1) 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
- 2) The Registrant has registered the domain name in bad faith

And to provide some evidence that:

- 3) The Registrant has no legitimate interest in the domain name.

Under Rule 12.1, the Panel shall render its decision based on the CDRP and Rules, the evidence and arguments submitted and any relevant rules and principles of the laws of Ontario and the laws of Canada. Further, inferences can be drawn about the Registrant's motives in registering the domain name from the Registrant's conduct or other surrounding circumstances including the uses to which the domain name is put. *See Canadian Broadcasting Corp v. Quan* CIRA Dispute #00006 (2003); *Government of Canada v. Bedford* CIRA Dispute #00011 (2003)

6.1. Is the Registrant's domain name confusingly similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and in which Complainant continues to have such Rights?

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).

The Complainant has not established that it had rights in a Mark prior to the date of registration of the Registrant's domain name. The alleged Mark is not a certification mark, nor is it an official mark. Further, contrary to what it alleges in its Complaint, but which it subsequently corrected in its Reply, the Complainant does not hold a registered trade-mark in Canada.

As a result, as per s. 3.2.(a), the Complainant must demonstrate, on a balance of probabilities, that it had a trade mark or trade name that has been *used* in Canada by the Complainant *for the purpose of distinguishing* its wares, services or business prior to the date of registration of the disputed domain name.

Under s. 3 of the CDRP, the date of registration is the date on which the domain name was registered by the Registrant or a predecessor in title of the Registrant. The Complainant must therefore show that its trade-mark, THE DECK STORE, was used for the purpose of distinguishing its wares, services or business prior to May 13, 2010, the date of registration by the Registrant's predecessor in title.

The Complainant has not adduced any evidence of use of a trade-mark or trade name prior to the date of registration of the disputed domain name. The Panel agrees with the Registrant in its assertion that the Complainant's corporate name is not evidence of trade-mark use. Further, the fact that the Complainant held the domain name THEDECKSTORE.CA prior to 2009 is not evidence that it was using THE DECK STORE as its Mark at that date.

The only evidence of use filed by the Complainant is a screenshot of the Complainant's webpage dated March 24, 2014 which features the words THE DECK STORE with the TM symbol on the page. Further, the bottom of the page shows a date of 2013 with the words THE DECK STORE accompanied by the TM symbol and the notice that all rights were reserved. These dates fall after the date of registration of the disputed domain name.

Further, use of THE DECK STORE in association with a deck construction business is inherently descriptive. Complainant has not adduced any evidence that THE DECK STORE had acquired distinctiveness so as to distinguishing the Complainant's wares, services and business from its competitors prior to the registration date. It could have done so by providing dated invoices, business cards, marketing material, sales figures, among other indicia. [*Cheap Tickets and Travel Inc. v. Emall.ca Inc* CIRA decision #00004]

In addition, according to the evidence submitted by the Registrant, in 2012, the Trade-mark Examiner refused to register the Complainant's trade-mark on the basis that THE DECK STORE was clearly descriptive or deceptively misdescriptive of the Complainant's services. While the Panel is not bound by this finding, it is certainly highly persuasive of the descriptive, non-distinctive, nature of the mark.

In conclusion, the Complainant has failed to meet its burden of proving, on a balance of probabilities, that THE DECK STORE was a Mark in which it held rights prior to the registration date of the disputed domain name.

In light of the Panel's conclusion, it is unnecessary to rule on the other elements of the CDRP, however, for the sake of completeness, the Panel will briefly address the questions of whether the Registrant had a legitimate interest in the domain name and whether the Registrant registered the domain name in bad faith.

6.2 The Registrant has registered the domain name in bad faith

The Complainant alleges that the Registrant registered the domain name in bad faith for the purposes set out in the CDRP at ss. 3.5(a) to (d) of the CDRP. The Complainant did not meet its onus of proving bad faith on a balance of probabilities.

Firstly, from the Complainant's own admission, the Registrant is not interested in transferring the domain name to it so the allegation under s. 3.5(a) is entirely unfounded. The Complainant has also adduced no evidence to show that the Registrant was engaged in a pattern of acquiring domain names in order to prevent the Complainant from registering THEDECKSTORE.CA. Nor has the Complainant satisfied the Panel that the Registrant is in fact a competitor who is attempting to disrupt the Complainant's business. The Complainant and the Registrant operate in very different markets – the Complainant is a custom deck builder and the Registrant is a retailer in deck building materials and accessories. Further, each business operates in very different parts of the country – the Complainant operates exclusively in Ontario while the Registrant carries on business primarily in Alberta with some customers in Saskatchewan and British Columbia. The fact that they are both involved in some aspect of the deck building industry does not automatically make them competitors. Finally, the Complainant has not adduced any evidence whatsoever of any intentional attempt by the Registrant to divert the Complainant's customers to its website. The Registrant's website clearly identifies its business and its locations in Edmonton and Calgary. There is no attempt to confuse or

mislead the public. A customer looking for the Complainant and finding the Registrant's website would know immediately that it was at the wrong location.

The reality is that the Complainant lost control of the disputed domain name when it allowed its registration to lapse and seems to have assumed that it could continue to exert control over the domain name in spite of the loss of the registration. There is nothing untoward about the Registrant having purchased the disputed domain name from Deck Masters of Canada. The Registrant was acting in good faith when it acquired the domain name and was not engaged in any of the activities contemplated in s. 3.5 of the CDRP.

6.3 The Registrant has no legitimate interest in the domain name

Finally, the Complainant must provide some evidence that the Registrant had no legitimate interest in the domain name. The Complainant has failed to do so. It did not even raise this element of the CDRP in its Complaint, let alone provide some evidence upon which to claim that the Registrant had no legitimate interest as set out in s. 3.4 of the CDRP.

6.4 Claim for Costs for Reverse Domain Name Hijacking

It was not clear to the Panel reviewing the Complaint whether the Complainant relied on a representative who was quite unfamiliar with trade-mark law and domain name law but who was acting in the genuine, but clearly mistaken, belief that the Complainant had a legitimate claim or whether the Complainant, through its representative, was acting 'unfairly' and 'without colour of right' under the terms of s. 4.6. The phrase 'without colour of right' has been interpreted to mean "an honest, though mistaken belief in one's right and some reasonable reasonable factual basis upon which that belief was based." [*Air Products Canada Ltd v. Index Quebec Inc* CIRA decision #00007].

Had the Complainant not filed its Reply, which redressed a number of the significant flaws in the Complaint, the Panel would have granted the request for costs based on the circumstances including the Complainant's patently false assertions as well as the gravity of its unsubstantiated allegations. These assertions include:

- 1) Falsely alleging the existence of a trade-mark registration
- 2) Making serious accusations of bad faith and malice against the Registrant without providing any evidence whatsoever to justify the allegations.

However, in its Reply, the Complainant admitted that it does not hold a registered trade-mark and acknowledged that it "did not have the benefit of legal representation when it filed its complaint". It also admitted that the Complainant may have mistakenly imputed to the Registrant the bad faith it assumed on the part of Deck Masters of Canada.

This case appears to be one of a complete failure on the part of the Complainant to fully understand the nature of the relevant law and the CDRP process rather than a case of reverse domain name hijacking. The Panel considers that the Complainant was honestly

mistaken about the legitimacy of its claim at the time it initiated these proceedings and relied on a clearly inexperienced representative who made serious errors in the prosecution of this Complaint. There was some reasonable factual basis upon which the belief in the legitimacy of the claim was based namely, the dispute with the Registrant's predecessor in title, Deck Masters of Canada.

The Panel is sympathetic to the Registrant having had to incur time, effort and legal costs in order to defend itself under these circumstances but given the extraordinary nature of a finding under s. 4.6, the Panel is not sufficiently convinced that the Complainant was acting unfairly and without colour of right when it initiated these proceedings.

7. Decision

The Complainant has failed to establish, on a balance of probabilities, the elements set out s. 4.1 of the CDRP. As a result, the Complaint is dismissed.

The Registrant's request for costs for under s. 4.6 of the CDRP is dismissed.



Myra J. Tawfik
Sole Panellist
June 16, 2014