

**CANADIAN INTERNET REGISTRATION AUTHORITY**

**DOMAIN NAME DISPUTE RESOLUTION POLICY COMPLAINT**

**Disputed Domain Name**     janpro.ca (the "Domain Name")  
**Complainant:**             Jan-Pro Canada Inc.  
**Registrant:**             Computerfest, c/o George Bachir  
**Registrar:**             DomainsAtCost Corp.  
**Panel:**                 Hugues G. Richard  
**Service Provider:**     Resolution Canada Inc. (the "Provider")

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**DECISION**

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**A. THE PARTIES**

1. The Complainant, Jan-Pro Canada Inc., is a company incorporated under Part 1A of the Companies Act (Québec) with its principal place of business in Quebec City, Quebec, Canada.
2. The Registrant, Computerfest, is a business with its principal place of business in Scarborough, Ontario, Canada. The Registrant's administrative contact person is George Bachir.

**B. DISPUTED DOMAIN NAME AND REGISTRAR**

3. The disputed domain name that is the subject of this arbitration is *janpro.ca* (the "Domain Name").
4. The Registrar of the Domain Name is DomainsAtCost Corp.

**C. PROCEDURAL HISTORY**

5. This is an administrative proceeding brought pursuant to the CIRA Dispute Resolution Policy, adopted by the Canadian Internet Registration Authority and posted on the CIRA website on November 29, 2001.
6. Resolution Canada Inc. (the "Provider") is a service provider recognized by the Canadian Internet Registration Authority, pursuant to the Domain Name Dispute Resolution Policy (v 1.2) (the "Policy") and Rules (v 1.3) (the "Rules") of the Canadian Internet Registration Authority.
7. The history of the proceeding, according to information provided by the dispute resolution provider, Resolution Canada Inc., is as follows:

- On December 8, 2010, the Complainant filed a complaint with the Provider seeking an order directing that the registration of the Domain Name be transferred from the Registrant to the Complainant;
  - The Provider, finding the Complaint to be in order, forwarded notice of the Complaint to the Registrant by mail, dated December 22, 2010, in accordance with section 2.1 of the Rules;
  - The Provider set the date of commencement of proceedings to be December 22, 2010 and informed the Registrant of its right to file a Response to the Complaint within 20 days;
  - The Registrant did not deliver a Response to the Complaint to Resolution Canada, Inc. within the prescribed time limit;
  - The Complaint was filed in English;
  - On January 14, 2011, considering that no response was submitted by the Registrant, the Complainant opted to have this matter adjudicated by a sole panellist. The Provider announced the selection of Mr. Hugues G. Richard as the sole Panellist to adjudicate the dispute, pursuant to section 6.5 of the Rules.
8. The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Rules. Based upon the information provided by the Provider, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding were met. The Complainant was represented by legal counsel throughout this proceeding. The Registrant, having not responded, was not represented by legal counsel before the Panel.

**D. PANELIST IMPARTIALITY AND INDEPENDENCE**

9. As required by section 7 of the Rules, the Panel has submitted to the Provider a declaration of impartiality and independence in relation to this dispute.

10. The Registrant did not submit a Response.

**E. EFFECT OF FAILURE OF REGISTRANT TO FILE A RESPONSE**

11. Section 5.8 of the Rules provides that when no Response is submitted, "the Panel shall decide the Proceeding on the basis of the Complaint...".

12. It must be stated however, as in *Browne & Co. Ltd. V. Bluebird Industries* (CIRA Decision No 00002), that:

- "The requirement does not preclude the Panel from assessing the integrity and credibility of the evidence as disclosed in the Complaint".

13. In the present case, the Panel does not see any reason to question the integrity

and credibility of the Complainant's evidence.

#### **F. REMEDY SOUGHT**

14. The Complainant requests that the Panel order that the ownership of the domain name be transferred from the Registrant to the Complainant.

#### **G. APPLICABLE LAW**

15. Pursuant to section 12.1 of the Rules, the Panel shall apply the laws of Ontario and the laws of Canada applicable therein.

#### **H. JURISDICTION OVER THE PARTIES: ELIGIBILITY OF THE COMPLAINANT**

16. Pursuant to section 1.4 of the Policy, a Complaint is eligible for arbitration only if the person submitting it satisfies the Canadian Presence Requirements (the "CPR") at the time of submission. The CPR states that to be permitted to apply for the registration of, and to hold and maintain the registration of a .ca domain name, the applicant (i.e. the Complainant) must meet at least one of the criteria listed as establishing a Canadian presence.

17. A "corporation under the laws of Canada or any province or territory of Canada" satisfies the CPR (paragraph 2(d)). From the uncontested allegations contained in the Complaint, it appears that the Complainant, Jan-Pro Canada Inc. meets the CPR as it is a provincial corporation under the laws of Quebec.

18. Therefore, the Complainant satisfies the CPR and is eligible to hold the registration of a .ca domain name.

#### **I. FACTUAL BACKGROUND BASED ON THE COMPLAINANT'S CONTENTIONS**

19. Based on the uncontested allegations contained in the Complaint and in the Affidavit of Mr. Jean Roberge, a summary of the facts is set forth below and are accepted as being true.

20. The JAN-PRO trade-mark was registered under Number TMA 463899 on September 27, 1996. This trade-mark will be referred to hereinafter as the "JAN-PRO MARK".

21. The JAN-PRO MARK was registered by Jan-Pro Franchise Systems International, Inc. ("JAN-PRO SYSTEMS").

22. JAN-PRO SYSTEMS assigned, transferred, and conveyed to Jan-Pro Franchising International, Inc. ("JAN-PRO INTERNATIONAL") all of its rights, titles and interest in the JAN-PRO MARK and its associated goodwill, effective as of September 27, 1996.

23. JAN-PRO INTERNATIONAL is a franchisor of businesses that perform commercial, industrial and institutional cleaning and maintenance services under

the name "JAN-PRO".

24. Pursuant to a franchise agreement that the Complainant entered into with JAN-PRO INTERNATIONAL, the Complainant is the exclusive "Country Master Franchisee" of JAN-PRO INTERNATIONAL and is a licensee of the JAN-PRO MARK in Canada. The franchise agreement grants the Complainant the exclusive right to (i) grant licences to regional franchisees in Canada and (ii) defend the interest of the JAN-PRO MARK in Canada.
25. The Complainant has rights in the JAN-PRO MARK on the basis of its use by the Complainant as a trade name for the provision of cleaning services since at least as early as August 18, 1995.
26. The Complainant and JAN-PRO INTERNATIONAL have no relationship with the Registrant; neither entity has even licensed or otherwise permitted the Registrant to use the JAN-PRO MARK or to register or use any domain name incorporating the JAN-PRO MARK.

#### **J. OVERVIEW OF APPLICABLE LAW AND REQUIREMENTS**

27. The purpose of the Policy as stated in its section 1.1 is to provide a forum in which cases of bad faith registration of .ca domain names can be dealt with relatively inexpensively and quickly.
28. In order to succeed, the Complainant must prove, on a balance of probabilities, that (section 4.1 of the Policy):

*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*

*a) The Registrant has registered the domain name in bad faith as described in paragraph 3.7;*

*And the Complainant must provide some evidence that:*

*b) The Registrant has no legitimate interest in the domain name as described in paragraph 3.6.*

*Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in paragraph 3.6.*

[Emphases added]

29. To be successful, the Complainant has to win with respect to all three elements.

#### **K. DISCUSSION AND FINDINGS**

**1. 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 - Section 3.4 of the Policy.**

**1.1 Trade-mark and trade name as a Mark**

30. The policy defines "Mark" as follows:

*3.2.(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;*

*3.2.(c) A trade-mark, including the word elements of a design mark, that is registered in CIPO.*

31. A person has "rights" in a Mark if:

*3.3.(a) In case of paragraphs 3.2(a) and 3.2(b), the Mark has been used in Canada by that person, that person's predecessor in title or a licensor of that person; or predecessor.*

*3.3.(b) In 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.*

32. The uncontested allegations of facts indicate that the Complainant has been providing cleaning services to its customers using the JAN-PRO MARK and the JAN-PRO trade name as early as August 18, 1995.

33. The Complainant is a licensee of the JAN-PRO MARK in Canada.

34. The use by the Complainant as a licensee is deemed to be a use by JAN-PRO INTERNATIONAL as the owner/franchisor.

35. The Registrant registered the Domain Name on March 21, 2008, long after the Complainant first used and first had rights in the JAN-PRO MARK in Canada.

36. The Panel concludes that the Complainant has rights in the JAN-PRO MARK and had rights in that mark prior to the date of registration of the disputed domain name.

**1.2 Confusingly similar**

37. Section 3.4 of the Policy sets out the test for "Confusingly Similar":

*"A domain name is confusingly similar to a Mark if the domain name so nearly resembles the Mark in appearance, sound or ideas suggested by the Mark as to be likely to be mistaken for the Mark".*

[Emphasis added].

38. Section 1.2 of the Policy states *inter alia* that:

*"For the purposes of this Policy, "domain name" means 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".*

39. In the Domain Name, only the absence of a hyphen between "JAN" and "PRO" differentiates the domain name from the JAN-PRO MARK.

40. Previous Panels have ruled that "capitalization, spacing and punctuation in the Complainant's Mark should generally have little or no weight in assessing confusingly similar" (See: *Mabel's Labels Inc. v. Layer 227 Inc.*, (March 28, 2010), *Resolution Canada, CIRA Dispute No. 00147, Tab 5, page 3*).

41. The Panel finds that the Domain Name is nearly identical to the JAN-PRO MARK, is likely to be mistaken for the JAN-PRO MARK, and is consequently confusingly similar to the JAN-PRO MARK within the meaning of section 3.4 of the Policy.

42. The Panel concludes that the Complainant had "rights" in the JAN-PRO MARK within the meaning of section 3.3 of version 1.2 of the CIRA Policy, as a licensed user of the JAN-PRO MARK prior to the date of registration of the similar Domain Name and continues to have such rights.

## **2. Registration of the Domain Name in Bad Faith – Section 3.7 of the Policy**

43. Section 4.1(b) of the Policy requires the Complainant to establish on the balance of probabilities that the Registrant has registered the domain name in bad faith, as defined in the Policy at section 3.7.

44. Under section 3.7 of the Policy, the Registrant will be considered to have registered the Domain Name in bad faith if, and only if, the Complainant can demonstrate that the Registrant in effecting the registration of the Domain Name was motivated by any one of the three general intentions set out in paragraph 3.7. Of these intentions, the Complainant has focused on that form of intention contained in paragraph 3.7(c) as being the one most applicable to the matter at hand.

45. Section 3.7(c) of the Policy reads as follows:

*"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: (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".*

46. Other Panels have 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". (See: *Netfirms, Inc. v. Dinesh Meriston*,

(January 27, 2009) Resolution Canada, CIRA Dispute No. 00121, Tab 6, page 3).

47. The Domain Name resolves to a website that displays of a headings "janpro.ca" and contains the following list of topics:
  - Office Cleaning Business
  - Janitorial Business
  - Office Building Cleaning
  - Contract Cleaning
  - Office Cleaning jobs
  - Office Cleaning Rates
  - Office Carpet Cleaning
  - Chemical Cleaning
  - Industrial Cleaning
  - Non Toxic Cleaning
  - Maid Cleaning
48. The above topics contain links directing users to various websites, including third-party providers of cleaning services.
49. These third-party providers of cleaning services are not affiliated with the Complainant and provide services competing with the Complainant.
50. The Complainant submits and this submission is uncontested, that the heading "janpro.ca" and the above topics suggest that the cleaning services are being provided by the Complainant.
51. The Complainant further submits and this submission is uncontested, that the unauthorized incorporation of the JAN-PRO MARK in the domain name disrupts the business of the Complainant because it causes confusion among Complainant's customers when searching the Internet.
52. The Complainant also submits and this submission is uncontested, that people coming across the Registrant's website are likely to assume that it sponsored or endorsed by the Complainant (See: *LEGO Juris A/S v. James Carswell*, (May 7, 2010), Resolution Canada, CIRA Dispute No. 00150, Tab 9, para. 26).
53. It has been decided by other Panels that where a Registrant uses a confusingly similar domain name with the effect of misleading customers or potential customers of a Complainant and directs them, not to a website of the Complainant, but to the websites of the Complainant's competitors, it is reasonable inference that the Registrant acquired the domain name registration primarily for the purposes of disrupting the business of the Complainant, as set out in paragraph 3.7(c) of the Policy (See: *LEGO Juris A/S v. James Carswell* (May 7, 2010), Resolution Canada, CIRA Dispute No 00150, Tab 9, para.26); (See also: *JTH Tax, Inc. v. Prem Lata Dhir* (April 23, 2009), Resolution Canada, CIRA Dispute No. 00125, Tab 10, para.67).
54. The Complainant submits and this submission is uncontested, that the Registrant

is acting as a competitor to the Complainant because the Registrant is directing the Complainant's potential customers to, and inducing the sale of competitor's cleaning services. Every time an Internet user who was looking for the Complainant's site on the Internet is redirected to the Registrant's website and purchases cleaning services from a seller listed on that website, the Complainant loses a potential customer (See: *DKH Retail Limited t/a Laundry Athletics and Laundry Athletics LLP v. Jason Facciolo* (August 17, 2010), *Resolution Canada, CIRA Dispute No. 00155, Tab 11, para. 40*).

55. In *LEGO Juris A/S v. James Carswell* (May 7, 2010), *Resolution Canada, CIRA Dispute No 00150, Tab 9, para.26*, the Panel has found that: "*With regard to the criteria that the Registrant be a competitor of the Complainant, the Registrant's actions make it a competitor in that it is competing for web traffic that would otherwise go to the Complainant by utilising the Complainant's well known trademark in its domain name*".
56. Other Panels have on numerous occasions ruled that a Registrant who does not compete with the Complainant by himself selling goods and services similar to those offered by a complainant, but mounts a website that directs people to competitors of the Complainant, he is effectively functioning as a competitor of the Complainant for the purposes of 3.7(c) of the Policy. (See: *Netfirms, Inc. v. Dinesh Meriston, Resolution Canada, CIRA Dispute No. 00121, Tab 6, page 3*); (See also: *JTH Tax, Inc. v. Prem Lata Dhir* (April 23, 2009), *Resolution Canada, CIRA Dispute No. 00125, Tab 10, para.74*).
57. In conclusion, the Panel finds that the Registrant has acquired the Domain Name in bad faith within the meaning of subparagraph 3.7(c) of the Policy.

### **3. No legitimate Interests in the Domain Name – Section 3.6 of the Policy**

58. The final element that the Panel must determine is whether or not the Registrant has a legitimate interest in the Domain Name.
59. Under section 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.
60. In this uncontested arbitration, the Registrant has provided no evidence.
61. The Panel is therefore limited to reviewing the evidence and arguments as submitted by the Complainant, who must provide some evidence that the Registrant has no legitimate interest in the Domain Name.
62. For the Registrant's use of the Domain Name to be legitimate, that use must fall under one of the subparagraphs 3.6(a) — (f) of the Policy. The uncontested evidence is that the Registrant does not have a legitimate interest in the Domain Name under any of those subparagraphs. Section 3.6 provides as follows:



*"The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint was submitted:*

*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; and (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".*


63. Given the use of the Domain Name as described above, the Domain Name is therefore not used as a Mark and has not been used as a Mark. Indeed, the Complainant has proven that the disputed Domain Name resolved to a website that appeared to be associated with a pay-per-click service, making it not a web host website. The Panel is of the view that this type of use cannot be considered a good faith use of a Mark under section 3.6(a) of the Policy.
64. The Complainant submits that the Domain Name and in particular the distinctive element "JAN-PRO" of the Domain Name, has no apparent connexion with the business activities of the Registrant and is not descriptive of the wares, services or business associated with the website, nor is it descriptive of the place of origin of said wares, services or business. The Panel finds that the use by the Registrant of the Domain Name does not meet the requirements of section 3.6(b) of the Policy.
65. The Complainant submits that the Domain Name is not understood to be a generic word in Canada nor is the JAN-PRO Mark the generic name of any wares or services with which it might have been used by the Registrant. Rather, "JAN-PRO" is the name that has been associated with the JAN-PRO MARK since 1995 in Canada. The Panel finds that the requirements of section 3.6(c) of the Policy have not been met.

66. The Panel finds that the Registrant is not using the Domain Name in good faith in association with criticism, review or news reporting. Nor is the Domain Name, the legal name or other identifier of the Registrant or the geographical name of the location of the Registrant's non-commercial activity or place of business. The Panel finds that the requirements of sections 3.6(d), (e) and (f) of the Policy have not been met.
67. The Panel concludes that none of the criteria of section 3.6 of the Policy have been satisfied; consequently, the Panel finds that the Registrant has no legitimate interest in the Domain Name.

**L. CONCLUSION AND ORDER**

68. Based on these findings, the Panel decides these proceedings in favour of the Complainant and orders and directs, pursuant to section 4.3 of the Policy, that the Registration of the Domain Name "janpro.ca" be transferred to the Complainant.

Dated, this January 27, 2011

A handwritten signature in black ink, appearing to read "Hugues G. Richard", written over a horizontal line.

Hugues G. Richard,  
Sole Panellist