

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

Domain Name: agmbasements.ca and agmrenovations.ca
Complainant: Welmond Inc.
Registrant: Guy Solomon
Registrar: Go Daddy Domains Canada, Inc.
Panellist: Sharon Groom
Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant, Welmond Inc., is a company incorporated pursuant to the law of Ontario, Canada.
2. The Registrant for the domain name is Guy Solomon, from the organization Penguin Basements, located in Toronto, Ontario, Canada.

B. The Domain Name and Registrar

3. The disputed domain names are agmbasements.ca and agmrenovations.ca. The Registrar for these domain names is Go Daddy Domains Canada, Inc. The disputed domain names were both registered on October 26, 2016.

C. Procedural History

4. This is a proceeding under the Canadian Internet Registration Authority (“CIRA”) *Domain Name Dispute Resolution Policy* (Version 1.3) (the “Policy”) and the CIRA *Domain Name Dispute Resolution Rules* (Version 1.5) (the “Rules”).
5. The history of the proceeding as provided by the dispute resolution provider, Resolution Canada, Inc., is that the Complainant filed a complaint against the Registrant with Resolution

Canada, Inc. requesting that the current registrations of the domain names agmbasements.ca and agmrenovations.ca be transferred to Welmond Inc. The complaint was dated July 21, 2017.

6. Resolution Canada, Inc. served notice of the complaint on the Registrant as required by paragraph 4.3 of the Rules. Service of the complaint was made by email on July 25, 2017.

7. The Registrant was given 20 days to file a response and no response was filed. As the complaint received no response, the case was remitted to one panellist.

D. Panellist Impartiality and Independence

8. As required by paragraph 7 of the Rules, the panellist has submitted to Resolution Canada, Inc. a declaration of impartiality and independence in relation to this dispute.

E. Canadian Presence Requirements

9. The Complainant, Welmond Inc. is a Canadian company so it satisfies the Canadian Presence Requirements under paragraph 2(d) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3.

F. Factual Background

10. The Complainant provides basement renovation services and interior finishing services under the mark AGM in the greater Toronto area. The domain name agmrenovations.com was registered on September 29, 2008 by the president of the Complainant, Ivan Atanasov from the organization "AGM Renovations". The Complainant was incorporated on September 2, 2009 as AGM Renovations Inc. and changed its name on March 7, 2012 to Welmond Inc. The Complainant also registered the Ontario business names AGM RENOVATIONS on May 18, 2012 and AGM BASEMENTS on April 18, 2017. The website agmrenovations.com is used to advertise the Complainant's basement renovation services. The screen shot of the website provided by the Complainant shows the words AGM BASEMENTS on the upper left corner of the webpage in a logo format with the term AGM having greater prominence and set apart from the word "basements" in terms of font. The Complainant also provided undated copies of webpages from its website and from houzz.com showing testimonials from customers where they discuss the Complainant's renovation services and refer to the Complainant as "AGM", "AGM Basements" and AGM Renovations".

11. The Complainant filed an application to register the trademark AGM on June 6, 2017, under application no. 1840773 for use in association with "construction and renovation of buildings; home renovation; house building and repair; operation of a website in the field of home renovations." The application claims use in association with these services since August 1, 2006 yet the Complainant was not incorporated until 2009. The Complainant has not indicated that there was any reference to a predecessor in title in the application when filed. Also, I note that the name of the applicant is listed as Welmond Corporation, which is not the name of the Complainant which is Welmond Inc.. This appears to be an error since the mailing address of the applicant is the same as the Complainant's. Given these discrepancies though, and the fact that

the application was filed after the registration date of the disputed domain names in any event, I am not going to consider the trademark application in this decision.

12. The disputed domain names agmbasements.ca and agmrenovations.ca were registered on October 26, 2016 and according to the Complainant resolve to a website carried on under the brand “Penguin Basements” which features the banner “Why We’re Better”. This site also advertises basement renovation services, operates under the domain name www.basementscanada.com, and refers to the company Penguin Basements, Ltd.. The registration information for the disputed domain names indicates that the organization associated with them is Penguin Basements, and the email address provided uses basementscanada.com. Therefore it appears that the Registrant of the domain names is a competitor of the Complainant and is using the domain names to resolve to its own website.

G. CIRA Domain Name Dispute Resolution Policy

13. Paragraph 4.1 of the Policy requires that the Complainant establish 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;

(b) the Registrant has registered the domain name in bad faith as described in section 3.5; and

(c) the Registrant has no legitimate interest in the domain name as described in section 3.4.

14. The Complainant must establish points (a) and (b) above on the balance of probabilities and for point (c) it must provide some evidence that the Registrant has no legitimate interest in the domain name. 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 section 3.4.

H. Analysis

Rights to a Mark

15. Under paragraph 3.1(a) of the Policy, the Complainant has to show that it had rights (and continues to have these rights) in a Mark that was confusingly similar to the domain name, prior to the date of registration of the disputed domain name.

16. The domain names were registered on October 26, 2016, therefore this is the relevant date for this analysis.

17. A “Mark” is defined in paragraph 3.2(a) of the Policy as:

(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;

18. The Complainant has submitted evidence of its registration of the domain name agmrenovations.com as of Sept 26, 2008 but there is no evidence that it was used as of this date or that the terms AGM or AGM RENOVATIONS appeared on an active website prior to 2016. The Complainant was incorporated as AGM Renovations Inc. on September 2, 2009 and registered the Ontario business name AGM RENOVATIONS on May 18, 2012. In the written submissions the Complainant indicates that "that trading name [AGM Renovations] has been in use well before the registration of the domain names in dispute." The Complainant refers to the incorporation date of AGM Renovations Inc. as evidence of this. I am prepared to take the combination of evidence of: i) registration of the domain name agmrenovations.com in 2008; ii) incorporation of a company called AGM Renovations Inc. in 2009; and iii) registration of a business name AGM RENOVATIONS in 2012; all of which took place well prior to the registration date of the disputed domain names in 2016, as demonstrating, on the balance of probabilities, that the Complainant was operating a basement renovation business under the trade name AGM RENOVATIONS prior to the date that the disputed domain names were registered.

19. The Complainant alleges that the distinctive portion of its trade names is AGM and I agree that this is the distinctive element of the trade names as the word "renovations" merely describes the Complainant's renovation services and the word "basements" describes the subject matter of the renovation. I also note that on the screen shot of its website which the Complainant provided, the term AGM is shown in large font with a logo, whereas "basements" is in a less prominent font. The customers in the testimonials also referred to the Complainant as AGM from time to time. Therefore I find that the Complainant has established that it has rights in a Mark AGM that predate the registration date of the domain names, and that the Complainant has submitted evidence from its website indicating that it continues to use the Mark AGM in Canada.

20. The question then becomes whether this Mark is confusingly similar to the domain names agmbasements.ca and agmrenovations.ca. The test for this is whether the domain names in question so nearly resemble the Mark in appearance, sound or in the ideas suggested by them as to be likely to be mistaken for the Mark.

21. In this case the domain names consist of the entire mark AGM, combined with the descriptive words "basements" or "renovations". As referred to in *mVisible Technologies, Inc. v. Navigation Catalyst Systems, Inc.*, WIPO Case No. D2007-1141, when the Complainant's Mark is reproduced in the disputed domain names in full, the addition of terms that are generic for the services at issue do not serve to distinguish the domain names from the Complainant's Mark. I therefore find that the domain names do so nearly resemble the Mark AGM in appearance, sound and in the idea suggested by them so as to be likely to be mistaken for the Complainant's Mark. Therefore the Complainant has established, on a balance of probabilities, the facts required to support the requirements of paragraph 4.1(a) of the Policy.

Bad Faith

22. The Complainant has to show, on the balance of probabilities, that the domain name was registered in bad faith. Paragraph 3.5 deals with the grounds which constitute bad faith and it must be noted that these are not exhaustive; it is open to the panellist to find other grounds which lead to a conclusion of bad faith conduct.

23. The Complainant argues that the Registrant's conduct constitutes bad faith because the domain names are knowingly being used by a direct competitor to disrupt the Complainant's business, and divert customers to the Registrant's site for commercial gain. These claims fall under the scenarios set out under paragraphs 3.5(c) and 3.5(d) of the Policy reproduced below:

(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;

(d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

24. Given the fact that the Registrant's trade name is Penguin Basements, and its main website is www.basementscanada.com, I can see no other reason for the Registrant to use the distinctive term AGM in a domain name, other than to trade on the goodwill associated with the Complainant's Mark AGM. The fact that the domain name agmremovations.ca is the same as the Complainant's domain name agmrenovations.com, is likely to mislead customers searching for the Complainant's website into mistakenly arriving at the Registrant's site which offers competing services. This is likely to disrupt the business of the Complainant, and may also lead such customers to use the Registrant's services instead of the Complainant's, thus creating a likelihood of commercial gain for the Registrant. Also, the fact that the domain names both resolve to the Registrant's main site where one of the first things a potential customer sees is the phrase "Why We're Better" is evidence of an intent by the Registrant to use the Complainant's own Mark to try and take potential customers away from it.

25. This behaviour meets the criteria set out in paragraphs 3.5(c) and 3.5(d) of the Policy set out above, as it appears that the Registrant, who is a competitor of the Complainant, registered the domain names in order to disrupt the business of the Complainant (3.5(c)) and intentionally attempted to attract, for commercial gain, potential customers to the Registrant's website by creating a likelihood of confusion with the Complainant's Mark as to the source of the Registrant's website (3.5(d)).

26. I therefore find that the Complainant has demonstrated, on the balance of probabilities, that the Registrant registered the domain names in bad faith, as set out in paragraphs 3.5(c) and 3.5(d) of the Policy.

Legitimate Interest

27. In order to succeed the Complainant has to provide some evidence that the Registrant does not have a legitimate interest in the domain names. Paragraph 3.4 lists six possible ways in which a Registrant may have a legitimate interest in a domain name which are as follows:

- (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 registered 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; or (iii) the place of origin of the wares, services or business;
- (c) the Registrant registered 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.

This list is not exhaustive as it is said to be "without limitation". Therefore neither party is bound by only those criteria.

28. In addressing the subject of legitimate interest I note that the Complainant has established that it has rights in the Mark AGM, which is reproduced in these domain names, and the Registrant has not been licensed to use this Mark. Therefore there can be no legitimate interest under subsection (a). The term AGM is not clearly descriptive as referred to in subsection (b), but rather is an acronym used by the Complainant. It is not a generic term nor has the Registrant used it for a non-commercial activity including, criticism, review or news reporting, so subsections (c) and (d) are not applicable. Finally, the domain names are not the name of the Registrant nor are they the name of a geographic place, therefore subsections (e) and (f) do not apply either. I therefore find that the Complainant has provided some evidence that the Registrant does not have a legitimate interest in the domain names.

29. The Registrant has not rebutted this evidence with any evidence of its own, therefore it has not shown, on the balance of probabilities, that it has a legitimate interest in the domain names.

30. Therefore, I find that the Complainant has presented some evidence that the Registrant does not have a legitimate interest in the domain name, which has not been rebutted by the Registrant.

I. Conclusion and Decision

31. In conclusion, I find that the Complainant has rights in the Mark AGM which predate the registration of the domain names. I also find that the domain names are confusingly similar to the Complainant's Mark, that the Registrant registered the domain names in bad faith and that the Registrant has no legitimate interest in the domain names.

32. I therefore order, pursuant to paragraph 4.3 of the Policy, that the registration of the domain names agmbasements.ca and agmrenovations.ca be transferred to the Complainant, Welmond Inc.

33. The Complainant has asked for its costs in this matter on the basis that neither the Rules nor the Policy expressly forbid it. In my opinion, the fact that the Rules specifically provide for the Registrant to have the possibility of being awarded costs (paragraph 12.6 of the Rules), combined with the fact that the Rules specifically state that the fees submitted by the Complainant are non-refundable (paragraph 14.4 of the Rules), indicates that CIRA did not intend for the Complainant to be able to be awarded costs in these administrative proceedings. I therefore decline to award costs.

Dated October 13, 2017



By: Sharon Groom (Sole panellist)