

**IN THE MATTER OF A COMPLAINT MADE PURSUANT TO THE CANADIAN
INTERNET REGISTRATION AUTHORITY DOMAIN NAME DISPUTE
REGISTRATION RESOLUTION POLICY (v 1.2) AND RULES (v 1.3)**

Complainant: Red Brick Pizza, Inc.
40320 Nido Court #2B
Palmdale, California 93551
USA
(the “Complainant”)

Complainant Counsel: Anne F. Bradley, Esq.
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USA
Email: udrp3@cph.com

Registrant: VMO, Inc.
c/o privacy.ca
43 Auriga Drive
Suite 5192092
Ottawa, ON K2E 7Y8
Canada
pmb5192092@privacy.ca
(the “Registrant”)

Administrative Contact: Rob Hall
Chief Privacy Officer
Privacy.ca
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Suite 5192092
Ottawa, ON K2E 7Y8
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pmb5192092@privacy.ca

Disputed Domain Name redbrickpizza.ca
(the “Domain Name”)

Registrar: DomainsAtCost Corp.

Single Member Panel: R. John Rogers

Service Provider: British Columbia International Commercial Arbitration Centre (the “BCICAC”)

BCICAC File: DCA-1186-CIRA

PROCEDURAL HISTORY

The BCICAC is a recognized service provider 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.

The Complainant filed a complaint dated August 12, 2009 (the “Complaint”) with the BCICAC seeking an order in accordance with the Policy and the Rules directing that registration of the Domain Name be transferred from the Registrant to the Complainant.

The BCICAC determined the Complaint to be in administrative compliance with the requirements of the Policy and the Rules in accordance with the provisions of Paragraph 4.1, and by letter of transmittal dated August 17, 2009 (the “Transmittal Letter”), forwarded a copy of the Complaint to the Registrant to serve as notice of the Complaint in accordance with Paragraphs 2.1 and 4.3 of the Rules. The Transmittal Letter determined the date of the commencement of proceedings in accordance with Paragraph 4.4 of the Rules to be August 17, 2009 and advised the Registrant that in accordance with the provisions of Paragraph 5 of the Rules, a Response to the Complaint was to be filed within 20 days of the date of commencement of proceedings, or September 7, 2009.

By letter dated November 13, 2009, a copy of which was sent to the Registrant, BCICAC advised the Complainant that as the BCICAC had received no response to the Transmittal Letter, pursuant to Paragraph 6.5 of the Rules, the Complainant was entitled to elect to convert from a three member panel to a single member panel. The Complainant elected a single member panel and the undersigned was appointed by the BCICAC as the Single Member Panel by letter dated November 18, 2009. The undersigned filed his Acceptance of Appointment as the Single Member Panel and Statement of Independence and Impartiality with the BCICAC on November 18, 2009 and determines that he has been properly appointed and constituted as the Single Member Panel to determine the Complaint in accordance with the Policy and the Rules.

THE REGISTRANT’S ADDRESS FOR SERVICE

The Registrant’s address for service was provided to the BCICAC by the Complainant as being the address for the Registrant above set out. The Panel has been advised that in accordance with its policy, the BCICAC confirmed with CIRA that this was in fact the Registrant’s address as listed in the Registration Information maintained by CIRA for the Registrant.

The BCICAC has advised the Panel that it couriered a hard copy of the Complaint to the Registrant at this address and received a return receipt. The BCICAC followed up this

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delivery with a confirming email to the listed email address. The BCICAC provided the Panel with a copy of the return receipt and advised that there was no response to the follow up email.

The BCICAC sent a subsequent email to the Registrant at its listed email address. This subsequent email included as an attachment an electronic copy of the letter dated November 13, 2009 advising the parties that the BCICAC had not received from the Registrant a response to the Complaint as required by the Rules. This subsequent email elicited the following response from postmaster@privacy.ca:

Thank you for your email.

The owner of this domain uses the services of Privacy.ca and has chosen not to accept your email.

For more information on Privacy.ca or to contact the domain owner, please visit www.privacy.ca for details

Paragraph 2.1 of the Rules provides that notice will be deemed to be given by BCICAC to the Registrant if the Complaint is delivered by prepaid courier service, return receipt requested, to the postal address of the administrative contact of record for the Registrant in the Registration Information for the Registrant.

The Panel finds that the BCICAC has used all reasonable efforts to contact the Registrant at its postal and email addresses listed for service. The fact that the Registrant has chosen to use a third party privacy provider to receive and filter notices being sent to these addresses is a choice the Registrant is certainly free to make. However, such a choice does not under the Rules and cannot reasonably impose an additional burden on the BCICAC to look behind this third party provider to ensure that the Registrant has in fact received the Complaint and the subsequent notices sent to it.

The Panel therefore determines that the Registrant has been properly notified of the Complaint by the BCICAC in accordance with the Rules.

CANADIAN PRESENCE REQUIREMENTS

The Canadian Presence Requirements for Registrants v 1.3 (“Presence Requirements”) require that to be permitted to apply for registration of, and to hold and maintain the registration of, a .ca domain name, the applicant must meet at least one of the criteria listed as establishing a Canadian presence. Section 2(q) of the Presence Requirements specifies that an owner of a trade-mark which is the subject of a registration under the *Trade-marks Act* of Canada satisfies one of the criteria; provided that the disputed domain name consists of or includes the exact word component of that registered trade-mark

The Complainant is the owner of the Canadian trademark REDBRICK PIZZA. The disputed domain name is redbrickpizza.ca. The Panel finds that in accordance with the

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provisions of Section 2(q) of the Presence Requirements, the Disputed Domain name includes the exact word component of the Complainant's registered trademark and that the Complainant, therefore, meets the Canadian presence requirement.

ALL TECHNICAL REQUIREMENTS MET

Based upon the information provided by BCICAC, the Panel finds that all technical requirements for the prosecution of this proceeding have been met, and, no Response to the Complaint having been filed by the Registrant, the Panel finds that pursuant paragraph 5.8 of the Rules the Panel is to decide this proceeding on the basis of the contents of the Complaint.

FACTS

As the Registrant has chosen not to respond to the Complaint, the facts put forward by the Complainant are summarized as follows:

1. Founded in 2000, the Complainant's Red Brick Pizza brand has grown from a single pizza restaurant to a multi-national pizza chain with restaurants across the United States and Canada..
2. As a result of millions of dollars in advertising and promotions the Complainant has acquired extremely valuable goodwill and an excellent reputation among consumers and professionals in the restaurant industry.
3. The Complainant reaches hundreds of thousands of customers via its website at www.redbrickpizza.com.
4. There are several United States trademark registrations owned by the Complainant, including:
 - i. U.S. Trademark Reg. No. 2679301 for the REDBRICK PIZZA mark; and
 - ii. U.S. Trademark Reg. Nos. 39999542, and 3003199 for two REDBRICKPIZZA word and design marks.
5. The Complainant owns Canadian Trademarks Reg. No. TMA734791 for its REDBRICK PIZZA mark (the "Redbrick Mark").
6. These trademarks have been continuously and exclusively used by the Complainant and its associated franchisees since 2000 in the United States and since 2007 in Canada.
7. The Registrant registered the Domain Name on September 8, 2008.
8. The Domain Name does not resolve to a website.

REMEDY SOUGHT

The Complainant seeks an order from the Panel that as the Domain Name is confusingly similar to the Redbrick Mark, that as the Registrant has no legitimate interest in the Domain Name, and that as the Registrant has registered the Domain Name in bad faith, the Panel instruct the Registrar of the Domain Name to transfer the Domain Name to the Complainant.

THE POLICY

As stated in Paragraph 1.1 of the Policy, the purpose of the Policy is to provide a forum in which cases of bad faith registration of .ca domain names can be dealt with relatively inexpensively and quickly.

Paragraph 4.1 of the Policy puts the onus on the Complainant to demonstrate this “bad faith registration” by proving on a balance of probabilities that:

1. the Redbrick Mark qualifies as a “Mark” as defined in Paragraph 3.2 of the Policy;
2. the Complainant had “Rights” (as “Rights” are defined in Paragraph 3.3 of the Policy) in the Redbrick Mark prior to the date of registration of the Domain Name and continues to have “Rights” in the Redbrick Mark,
3. the Domain Name is “Confusingly Similar” to the Redbrick Mark as the concept of “Confusingly Similar” is defined in Paragraph 3.4 of the Policy;
4. the Registrant has registered the domain name in “bad faith” in accordance with the definition of “bad faith” contained in Paragraph 3.4 of the Policy; and
5. the Registrant has no “legitimate interest” in the Domain Name as the concept of “legitimate interest” is defined in Paragraph 3.6 of the Policy.

If the Complainant is unable to satisfy this onus, bad faith registration is not demonstrated and the Complaint fails.

MARK

The relevant portion of Paragraph 3.2 of the Policy states that for the purpose of the Policy 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;

The Complainant has used the Redbrick Mark in Canada since 2007 to distinguish its provision of restaurant services from another provider of such services. The Complainant continues to use the Redbrick Mark in a similar capacity.

The Redbrick Mark clearly qualifies as a “Mark” within the provisions of Paragraph 3.2 (a) of the Policy.

RIGHTS

Sub-paragraph (a) of Paragraph 3.3 of the Policy states that for the purpose of the Policy the Complainant has “Rights” in the Redbrick Mark if:

(a) in the 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;

As noted above in the examination of the qualification of the Redbrick Mark as a "Mark", Paragraph 3.2(a) of the Policy applies and the Complainant has used the Redbrick Mark in Canada both prior to and following the registration of the Domain Name.

The Complainant, therefore, has "Rights" in the Redbrick Mark.

CONFUSINGLY SIMILAR

Policy Paragraph 3.4 provides that the Domain Name will be "Confusingly Similar" to the Redbrick Mark if the Domain Name so nearly resembles the Redbrick Mark in appearance, sound or the ideas suggested by the Redbrick Mark as to be likely to be mistaken for the Redbrick Mark.

In the matter at hand, the Domain Name consists of the Redbrick Mark, REDBRICK PIZZA, followed by the .ca suffix. As Paragraph 1.2 of the Policy defines the Domain Name for the purpose of this proceeding to exclude the .ca suffix, the portion of the Domain Name consisting of "REDBRICK PIZZA" is relevant.

Therefore, to satisfy the onus placed upon it by the Policy, the Complainant must demonstrate that "REDBRICK PIZZA" so nearly resembles the Redbrick Mark in appearance, sound or the ideas suggested by the Redbrick Mark as to be likely to be mistaken for the Redbrick Mark.

Other panels have considered the situation where, as here, the disputed domain name has incorporated a Mark. These panels have determined that the omission of a space is not sufficient to distinguish that domain name so as to make it *not* confusingly similar to the trademark for the purpose of the Policy. For example, in *Sleep Country Canada Inc. v. Pitfold Ventures Inc.* (CIRA Dispute Resolution Decision #00027), even though the domain name "sleepcountycanada.ca" omitted the two spaces included in the trademark "SLEEP COUNTRY CANADA", the panel determined that the confusingly similar test had been met. Similarly panels found this test to have been met despite there being a single space found in the trademark which space was not contained in the domain name. (See *Discovery Toys, Inc. v. Ebenezer Therasagayam* (CIRA Dispute Resolution Decision #00118) and *Extreme Fitness Inc. v. Gutam Relan* (CIRA Dispute Resolution Decision #00119) where the domain names were "discoverytoys.ca" and "extremefitness.ca" and the trademarks DISCOVERY TOYS and EXTREME FITNESS, respectively.)

This Panel finds that the omission of a space is not sufficient to distinguish the Domain Name from the Redbrick Mark and finds that the Complainant has satisfied the onus of demonstrating that the Domain Name is "Confusingly Similar" to the Redbrick Mark in accordance with Paragraph 3.4 of the Policy.

BAD FAITH

Under Paragraph 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 form of intention contained in Paragraph 3.7(b) is the one most applicable to the matter at hand.

Paragraph 3.7(b) provides as follows:

(b) the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names;

Paragraph 3.7(b) imposes upon the Complainant the obligation to demonstrate two things. Firstly, that the Registrant registered or acquired the Domain Name in order to prevent the Complainant from registering the Mark as a domain name. And, secondly, that the Registrant has engaged in a pattern of this type of activity.

There is before the Panel no direct evidence of the Registrant's motivation in registering the Domain Name. Such motivation must therefore be based upon a common sense inference from the evidence before the Panel of the activities of the Registrant both before and after the date of registration of the Domain Name, including reference to the website to which the Domain Name resolves and the Registrant's use of this website.

In the matter at hand, the evidence before the Panel is that the Domain Name does not resolve to a website. This in itself does not indicate an intention on the part of the Registrant to prevent the Complainant from registering the Redbrick Mark. However, one would have thought that if the Registrant has gone to the trouble and expense of registering the Domain Name with the intention to use the Domain Name for the purpose of identifying a website, that in the intervening twelve month period between the registering of the Domain Name and the filing of the Complaint, it would have posted a notice specifying that intention.

Similarly, if the Registrant had the intention of having the Domain Name resolve to a website, one would have thought that the Registrant would have at least filed a response to the Complaint expressing this intention or indicating its intention of using the Domain Name in another manner.

To meet the second leg of its obligation, the Complainant has placed before the Panel evidence of the Registrant in concert with other parties engaging in a pattern of registering domain names in order to prevent owners of trademarks from registering domain names which include these trademarks.

As the Registrant has employed a privacy shield to prevent access to the balance of information relative to its identity, the Complainant is somewhat hampered in providing evidence of the Registrant engaging in activities similar to that alleged by the Complainant in this instance.

However, the Complainant has provided the Panel with the following evidence:

1. that the Registrant registered the domain name “pizzafusion.ca” on the same date as it registered the Domain Name and that Canadian and United States trademarks for PIZZA FUSION were owned by Pizza Fusion Holdings, Inc. at the time of registration of “pizzafusion.ca”;
2. that an entity listed as “Vertical Markets Online (VMO) Inc.” has previously listed the name “Johnny Carpela” as its administrative contact when it registered the domain name “valtrex.ca” on March 19, 2003. The postal address for this administrative contact was listed as “VMO, PO Box 188, Sumas, WA, 98295, United States” and the email address as johnny@corcan.com;
3. that the trademark VALTRESX was registered with the Canadian Intellectual Property Office on August 30, 1996 with the current owner listed as the Glaxo Group Limited.;
4. that the domain names “effexor.ca” and “premarin.ca” were registered by Vertical Markets Online and that Canadian trademark registrations exist for EFFEXOR and PREMARIN, neither of which trademarks were owned by or licensed to Vertical Markets Online at the date of registration of the domain names;
5. that the domain names “benzac.org”, “capastat.com”, “dermalac.com”, “elipar.com”, and “flomax.net” were registered in the name of Vertical Markets Online” or Johnn Carpela with the same postal address at that set out in paragraph 2 above;
6. when the domain names listed in paragraph 5 were registered, pharmaceutical companies owned the trademarks BENZAC, CAPASTAT, DERMALAC, ELIPAR, and FLOMAX; and
7. that from 2006 to 2008, Johnny Carpela was named in eleven disputes under the Uniform Domain Name Dispute Resolution Policy before the National Arbitration Forum in the United States in which an order was made to transfer the disputed domain name to the trademark owner.

Based upon the evidence before the Panel as discussed above, the Panel finds that the Registrant registered the Domain Name to prevent the Complainant from registering the Redbrick Mark as a domain name. The Panel further finds that the Registrant alone and in concert with other parties has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names.

Based upon these findings, the Panel determines that the Complainant has met the obligation imposed upon it by Paragraph 3.7 of the Policy and has demonstrated that the Registrant has registered the Domain Name in bad faith for the purposes of Paragraph 3.1(c) of the Policy.

NO LEGITIMATE INTEREST

Paragraph 4.1 of the Policy requires that to succeed in the Complaint, the Complainant must provide some evidence that the Registrant has no legitimate interest in the Domain Name as the concept of “legitimate interest” is provided for in Paragraph 3.6 of the Policy.

Paragraph 3.6 of the Policy provides that:

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; or
 - (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.

In paragraphs 3.6 (b), (c), and (d) “use” by the Registrants includes, but is not limited to, use to identify a web site.

As noted above, the Registrant has elected not to respond to the Complaint. Therefore, the Panel must review the provisions of Paragraph 3.6 against the evidence before the Panel as provided by the Complainant.

There is no evidence before the Panel that the Domain Name is a Mark in which the Registrant has Rights and that the Registrant used the Domain Name in good faith prior to the filing of the Complaint as set out in Paragraph 3.6(a).

On the face of it, the Domain Name does not appear to be clearly descriptive of wares, services or business of the Registrant or of the people involved in or place of origin thereof as provided for in Paragraph 3.6(b). If anything, the Domain Name is descriptive of the services offered by the Complainant.

Similarly, there is no evidence that the Domain Name is understood in Canada as the generic name of wares, services, or business offered by the Registrant; that the Domain Name is used in Canada in connection with a non-commercial activity of the Registrant; that the Domain Name is a name by which the Registrant is commonly identified; or that the Domain Name is the geographical name of the location of the Registrant's non-commercial activity or place of business.

As the Domain Name does not resolve to a website, the Registrant has not "used" the Domain Name to identify a web site.

Therefore, the provisions of paragraphs 3.6(a), 3.6(b), 3.6(c), 3.6(d), 3.6(e) and 3.6(f) do not apply.

The Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name.

PARAGRAPH 4.1

However, even if the Complainant has satisfied the onus on it to prove that the Domain Name is Confusingly Similar to the Redbrick Mark, that the Registrant has registered the Domain Name in bad faith, and that the Registrant has no legitimate interest in the Domain Name, Paragraph 4.1 of the Policy grants the Registrant the opportunity still to succeed in the Complaint if the Registrant is able to prove on a balance of probabilities that it has a legitimate interest in the Domain Name as the concept of "legitimate interest" is described in Paragraph 3.6.

The Registrant, although given opportunity to do so, has chosen not to respond to the Complaint and, therefore, must be taken to have elected not to exercise this right to demonstrate to the Panel that it has such a legitimate interest in the Domain Name.

DECISION

The Panel finds that the Complainant has satisfied the onus placed upon it by Paragraph 4.1 of the Policy and is entitled to the remedy sought by it.

ORDER

The Panel orders that the domain name, <redbrickpizza.ca> be transferred to the Complainant.

Dated: November 23, 2009.

“R. John Rogers”

R. John Rogers
Single Member Panel