

**CANADIAN INTERNET REGISTRATION AUTHORITY**

**DOMAIN NAME DISPUTE RESOLUTION POLICY**

**COMPLAINT**

Dispute Number: 00009  
Domain Name: saveonfoods.ca  
Complainant: Great Pacific Industries Inc.  
Registrant: Ghalib Dhalla  
Registrar: Domain People  
Panelists: W.A. Derry Millar, Elizabeth Cuddihy, Q.C. and R. John Rogers  
Service Provider: British Columbia International Commercial Arbitration Centre

**DECISION**

**THE PARTIES**

1. The Complainant is Great Pacific Industries Inc., 19855-92A Avenue, Langley, British Columbia.
2. The Registrant is Ghalib Dhalla of #37-795 Noons Creek Drive, Port Moody, British Columbia.

**THE DOMAIN NAME AND REGISTRAR**

3. The domain name in issue in this proceeding is: "saveonfoods.ca".
4. The Registrar is: Domain People.
5. The domain name was registered by the Registrant on November 8, 2000.
6. The Complainant registered the domain name "saveonfoods.com" on January 16, 1997.

## PROCEDURAL HISTORY

7. The British Columbia International Commercial Arbitration Centre ("BCICAC") is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy ("Policy") of the Canadian Internet Registration Authority ("CIRA").

8. The Complainant filed a Complaint with respect to the domain name in issue in accordance with the Policy on February 13, 2003. The Complainant was reviewed and found to be compliant. By letter and email dated February 13, 2003, the BCICAC as Service Provider so advised the parties and forwarded a copy of the Complaint to the Registrant.

9. The Registrant requested an extension for delivery of its Response and an extension was granted by the BCICAC as Service Provider as permitted under Paragraph 5.4 of the CIRA Dispute Resolution Rules ("Rules"). The Registrant delivered its Response, in compliance with the Policy and Rules, to the Centre on March 10, 2003.

10. As the Complaint and the Responses were filed in English, it is the language of the proceeding.

11. In accordance with Paragraph 6 of the Rules, the Service Provider appointed a three-person Panel, Ms. Elizabeth Cuddihy and Mr. R. John Rogers as party-nominated panelists and Mr. Derry Millar was named as Chair of the Panel.

12. By email dated April 1, 2003, the Panel was advised that each member of the Panel had delivered to BCICAC a statement of acceptance of appointment.

13. Pursuant to Paragraph 11.1 of the Rules,, the Panel posed three questions to the Complainant by email dated April 3, 2003 as set out in paragraph 14 below.

14. In accordance with Paragraph 11.1 of the Rules, the Panel requests that the Complainant answer the following factual questions:

- (a) The date when the saveonfoods.com web site was registered;

- (b) The relationship between the Complainant and the Overwaitea Food Group (referred to in Schedule D of the Complainant's material) and Save-On-Food Stores;
- (c) The date the Complainant began operating its Save-on-Foods supermarkets. The material discloses that the Complainant was incorporated on April 17, 1990 and that the trademarks referred to in Schedule B of the Complainant's material were assigned by Jim Pattison Industries Limited to Great Pacific Industries Inc. effective January 1, 1992.

15. The Panel also requested a response to the question: "What effect, if any, does the existence of "saveonfoods.net" have on the Complainant".

16. The Panel directed that:

- (a) The Complainant's response be delivered to the Panel and the Registrant by the 6:00 p.m. Pacific time on April 8, 2003; and
- (b) The Registrant shall deliver his response, if any, to the Complainant's response by 6:00 p.m. Pacific time on April 10, 2003.

17. In accordance with Paragraph 12.2 of the Rules, the Panel extended the time for the delivery of its decision to April 22, 2003.

18. A response was received from the Complainant by email dated April 8, 2003. No reply was received from the Registrant.

## **FACTS**

19. The facts as disclosed by the material submitted by the Complainant and the Registrant are set out below.

20. The Complainant was incorporated on April 17, 1990.

21. The Complainant or its predecessor has operated Save-on-Food Stores since 1982. The Complainant operates 39 Save-On-Food Stores across British Columbia and 14 Save-on-Food stores in Alberta. Save-on-Food is the third largest retailer of groceries in British

Columbia and the fifth largest in Alberta. The Complainant advertises its Save-on-Foods stores in a variety of media, including newspapers, magazines and other print media, flyers, television, radio and the Internet, across British Columbia and Alberta. The Complainant states that its annual advertising expenditures are very large.

22. On June 8, 1982, a trade-mark application was filed by Jim Pattison International Limited for the trade-mark: Save-on-Foods and was registered on July 5, 1985. The trade-mark registration indicates that the trade-mark was used with respect to the "operation of a food supermarket, and indicates that it was used in Canada since at least as early as June 1, 1982". The Registration was assigned to the Complainant by Jim Pattison Industries Limited effective January 1, 1982.

23. A second trade-mark Save-on-Foods using block letters in orange on a blue background was filed on July 18, 1985 and registered on December 5, 1986 in the name of Jim Pattison Industries Limited. This Registration again relates to the operation of a food supermarket and indicates that it was "used in Canada since as early as June 2, 1982". This trade-mark was assigned by Jim Pattison Industries Limited to the Complainant effective January 1, 1982.

24. In the material supplied by the Complainant, there are a number of advertisements for Save-on-Foods which refer to Overwaitea Food Group. In response to one of the questions noted above, the Complainant indicated that Save-on-Foods is a division of Overwaitea Food Group, which in turn is a division of Great Pacific Industries Inc., the Complainant. Save-On-Food Stores and Overwaitea Food Group are not separate operating companies, but merely administrated divisions of the Complainant.

25. On April 26, 2001, the Complainant filed a Registration for a trade-mark SAVE ON FOODS with respect to supermarket services in Canada. The trade-mark was allowed on November 11, 2002. In addition, on April 26, 2001, the Complainant filed a trade-mark for the words Save-on-Foods and design in lower case block letters with respect to supermarket services.

26. As noted above, the Complainant's web site was registered on January 16, 1997. The Complainant's web site receives an average of 700,000 unique visitors per year.

27. The home page for the web site saveonfoods.com brings up a web page advertising save on foods in block lower case letters and design as noted in the trade-mark application dated April, 2001 and has areas for: our stores; cookbook; bright life; pharmacy; kid zone; and search. In addition there are links to other parts of the web site including employment, and questions of a nutritionist.

28. The Registrant's web site was registered on November 8, 2000. The web page for "saveonfoods.ca" as submitted by the Complainant as Schedule F to the Complainant's material states as follows:

**Save On Foods Portal**

Under Construction

Future site for savings on food - groceries, restaurants, organic food delivery,  
bulk purchase...

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**Contact Information**

G. Dhalla  
GKAD@aol.com  
(phone)  
(fax)

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**Domain People™**

29. The Complainant wrote the Registrant two letters. The first dated November 20, 2000 from Overwaitea Food Group states as follows:

"It has come to our attention that you have obtained registration of the internet domain name known as "saveonfoods.ca". We wish to advise that

the trade-mark "Save-On-Foods" is owned by our Company, Great Pacific Industries Inc. As the owner of the trade-mark "Save-On-Foods", we are entitled to legal protection for the "Save-On-Foods" name. In this regard, your use of the "saveonfoods.ca" internet domain name would be considered confusingly similar to our trade-mark and an infringement of our trade-mark. In this regard, we would ask that the internet domain name "saveonfoods.ca" which you have registered, be de-registered or in the alternative, assigned to our Company, which as indicated above is the registered owner of the trade-mark "Save-On-Foods".

We would ask that you contact Baden Smith at our Information Technology Department to discuss the above. Baden Smith may be contacted at 888-2079 extension 2100. We thank you in advance for your co-operation on this matter."

30. A second demand letter was written by the solicitors for the Complainant dated February 19, 2001 to the Registrant at the same address as the letter dated November 20, 2000. The Registrant acknowledges receiving the second letter but denies receiving the first letter. The Registrant did not respond to the letter he acknowledged receiving.

31. The Registrant states that the business plan for the website calls for a portal to savings on foods - groceries, restaurants, organic food delivery, bulk purchases etc. The site will offer saving coupons for customers and feature advertisements to generate revenue - similar to saveonfoods.net.

32. The Registrant states that he has registered six domain names (three .ca and three .com) as follows: "the-best-in-the-city.com" which he described as a portal allowing restaurants and entertainment venues to pitch specifically visitors to the city; "who-wants-to-marry-a-canadian.com" and "who-wants-to-marry-an-american.com" are described as geared to connecting singles from different countries. He has registered as well the "saveonfoods.ca" and "hockeynightincanada.ca". The Registrant states that he registered the "hockeynightincanada.ca" web site because he "heard CBC had dropped the Hockey Night In Canada theme from their Saturday telecast. "Hockey Night In Canada" is a trade-mark filed on October 6, 1972 and registered on May 12, 1978 by Canadian Sports Network Limited. It is currently owned by the Canadian Broadcasting Corporation.

33. The Registrant states that his intention from the outset with the six domain names was to establish a joint business venture with his son in the coming future. He states that he has the business and financial acumen, and his son is developing his computer application skills. Future in this case is 3-5 years from now when he retires and when his son has graduated. His son has already gained some web skills and has developed two sites: "hdhalla.tripod.com", and "hafeeztheman14.tripod.ca" which was de-activated in December 2002.

34. The Registrant states that although under construction, the "saveonfoods.ca" site has an email address - GKAD@aol.com for correspondence. For the two years the site has been in operation, it only generated one email from a customer of Save-On-Foods and Drugs who was informed that the site was not affiliated with Save-On-Foods and Drugs. The Registrant indicates that there is a Registration "saveonfoods.net". The Complainant indicates that the web site located at the domain name "saveonfoods.net" is clearly associated with the GroceryGetter.com business.

## **POSITION OF THE PARTIES**

### **THE COMPLAINANT - RIGHTS OF COMPLAINANT IN THE MARK**

35. The Complainant submits that it has the rights to the trade-mark "Save-on-Foods" (the "Mark") prior to the registration date of November 8, 2000 of the Domain Name "saveonfoods.ca" on the following grounds:

- (a) in accordance with subparagraph 3.3(a) of the Policy, the Mark has been used in Canada by the Complainant in connection with the operation of food supermarkets since at least June 1, 1982; and
- (b) in accordance with subparagraph 3.3(c) of the Policy, the Mark was registered as a trade-mark on July 5, 1985 in connection with the "operation of a food supermarket".

36. The Complainant submits that it also filed a trade-mark application for "Save on Foods" on April 26, 2001, which application was allowed on November 11, 2002.

37. The Complainant submits that in British Columbia, where the Registrant is located, and Alberta the Complainant has established a reputation and goodwill in association with its Mark through the use of the Mark in connection with its business such as the Mark has become distinctive and identified in the public mind with the Complainant as the source of goods and services related to the operation of food supermarkets and sale of groceries.

38. The Complainant submits that for the purposes of subparagraph 4.1(a) of the Policy, the Domain Name registered by the Registrant is identical to and hence "confusingly similar" to the Complainant's Mark.

39. The Complainant submits that the comparison of the look and sound of and ideas suggested by, the Complainant's Mark with the look and sound of and ideas suggested by, the Domain Name leads to the conclusion that the Domain Name is likely to be mistaken for the Mark. The difference is in capitalization of certain letters between the Mark and the Domain Name are minor and not material in light of the fact that Internet Protocol Addresses do not require or recognize capitalized letters in URLs and the presence of hyphenations in the Complainant's Mark and their absence in the Domain Name is also not material.

40. The Complainant submits that the web site located at the address associated with the Domain Name contains a notice that the web site intends to be a "Future site for savings on food - groceries, restaurants, organic food delivery, bulk purchase ...". The Complainant submits that in light of (a) the food supermarket business operated by the Complainant in relation to the Mark since at least 1982, (b) the fact that the Domain Name is identical to the Mark, and (c) and the famous and distinctive nature of the Complainant's Mark, the Domain Name is likely to lead Internet users who are customers or would be customers of the Complainant and familiar with the Complainant's Mark to be confused into believing that the Domain Name "saveonfoods.ca" would connect them with the web site of the Complainant. Accordingly, the Domain Name is "confusingly similar" to the Mark within the meaning of paragraph 3.4 of the Policy.

41. The Complainant submits that the test of confusing similarity does not take into account the top level domain name extension, such as ".net" (TLDs) (see *Baccarat S.A. v.*



*Priority Software Inc.*, Case No. DBIZ2002-00081). The test is whether the average Internet user with an imperfect recollection of the Mark accessing the domain name "saveonfoods.ca" either by entering such domain name into the address bar of an Internet browser or entering the key terms of the domain name into an Internet search engine would likely be confused given the acquired distinctiveness of the Mark as a business in Canada as a matter of first impression (see *Browne & Co. Ltd./Ltee. v. Bluebird Industries*, Case No. 0002). Further, it is not necessary that actual confusion be proven in order to establish a likelihood of confusion (see Section 6(5) of the *Trade-marks Act*, R.S.C. 1985, c.T-13 s.20).

42. Although in theory it may be advantageous for the Complainant, as for any owner of a famous trade-mark, to control the use of its Mark in conjunction with all TLDs, this is simply not practical in light of the ever growing number of such TLDs. As a result, the Complainant has focused on the two TLDs that are of greatest relevance to its business, namely ".com" and ".ca".

43. The ".com" TLD is the most widely used extension in the world. It represents the word "commercial" and is a highly recognized symbol for having a business presence on the Internet.

44. The ".ca" TLD is a country TLD representing Canada and is by regulation restricted to companies, organizations and institutions that meet Canadian presence requirements.

45. The ".net" TLD, on the other hand, represents the word "network", and is most commonly used by Internet service providers, Web-hosting companies or other businesses that are directly involved in the infrastructure of the Internet. Additionally, some businesses choose domain names in the a .net extension for their internet web sites (see <http://www.networksolutions.com/en.US/name.it/popup-extensions.jhtml>). For that reason, the Complainant has not considered and isolated the effect of the "saveonfoods.net" domain name on its Mark or business.

46. Finally, it should be noted that the web site located at the domain name "saveonfoods.net" is clearly associated with the "GroceryGetter.com" business. This situation is

not an analogous to that in the present Complaint since the Registrant here has failed to make any use of the Domain Name.

### **THE COMPLAINANT - NO LEGITIMATE INTEREST IN REGISTRANT IN DOMAIN NAME**

47. The Complainant submits that, under any paragraph 3.6 of the Policy, the Registrant has no legitimate interest in the Domain Name for the following reasons:

- (a) Domain Name is a Mark in which Registrant has Rights. For the purposes of subparagraph 3.6(a) of the Policy, the Domain Name is a trade-mark, one form of which ("Save-on-Foods") was registered on July 5, 1985, and one form of which ("Save on Foods") was allowed on November 29, 2002. The Complainant has been using the Mark in commerce continuously since at least 1982. The Registrant has no Rights in the Mark as the Complainant has at no time granted any license or other permission to the Registrant to use the Mark. As well, a search of the trade-marks database of the Canadian Intellectual Property office has revealed no application or registration similar to the Mark or otherwise by the Registrant. Finally, as submitted below (see "Bad Faith"), the Registrant registered the Domain Name in bad faith and therefore has not been using the Mark in good faith as required by subparagraph 3.6(a) of the Policy. Use of the Domain Name is likely to cause confusion (see "Domain Name Confusingly Similar to Trade-Mark") with the Complainant's Mark and, therefore, the trade name under ordinary passing off jurisprudence (see *Browne & Co. Ltd./Ltee. v. Bluebird Industries* Case Bi, 00002, October 22, 2002).
- (b) Use of Clearly Descriptive Name. For the purposes of subparagraph 3.6(b) of the Policy, the Registrant has not used the Domain Name in Canada in good faith in association with any wares, services or business and the Domain Name is not clearly descriptive in Canada in the English language of (i) the character or quality of any wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of services or operation of a business; or (iii) the place of origin of any wares, services or business.

The web site located at the address associated with the Domain Name (see Schedule F) indicates that the web site is "Under Construction" and no active business is being pursued by the Registrant in connection with the Domain Name (see *Grundfos A/S v. Yilmaz Ozgur*, Case No. D2002-0252).

- (c) Use of Generic Name. For the purposes of subparagraph 3.6(c) of the Policy, for the reasons set forth in clause (b) above the Registrant has not used the Domain Name in Canada in good faith in association with any wares, services or business.
- (d) Use for Non-Commercial Criticism. For the purposes of subparagraph 3.6(d) of the Policy, the Registrant has not 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) Use of Registrant's Name or Surname. For the purposes of subparagraph 3.6(e) of the Policy, the Domain Name does not comprise the legal name of the Registrant or is not a name, surname or other reference by which the Registrant is commonly identified. The Registrant is not known, either as a business or other organization by the name "Save On Foods".
- (f) Use of Name of Geographic Location. For the purposes of subparagraph 3.6(f) of the Policy, the Domain Name is not the geographical name of the location of the Registrant's non-commercial activity or place of business.
- (g) Finally, at no time has the Complainant licensed or otherwise permitted the Registrant to use its Mark or to apply for or use any domain names incorporating the Mark (see *The Toronto-Dominion Bank v. Boris Karpachev*, Case No. D2000-1571).

## THE COMPLAINANT - BAD FAITH

48. The Complainant submits that, under paragraph 3.7 of the Policy, the Registrant has registered the Domain Name in bad faith for the following reasons:

- (a) In accordance with paragraph 3.7(b) of the Policy, the Registrant has registered the Domain Name in order to prevent the Complainant from registering the Mark as a domain name and the Registrant has engaged in a pattern of registering domain names in order [to] prevent persons who have Rights in marks from registering the trade marks as domain names.

Not only has the Registrant registered the Complainant's Mark as the Domain Name, but the Registrant has also registered the domain name "hockeynightincanada.ca" (see **Schedule G**). "Hockey Night In Canada" is a trade-mark registered in the name of Canadian Sports Network Limited (see **Schedule H**).

Such action by the Registrant constitutes a pattern for the purposes of the Policy, particularly in light of the Registrant's stated intention at the web sit associated with the Domain Name to provide food sale services. The

Complainant has attempted to determine whether the Registrant has registered any trade-marks under other top level domains ("TLDs") such as ".com". This information is not provided by Verisign, the relevant Internet registration authority.

- (b) In accordance with subparagraph 3.7(c) of the Policy, the Registrant has registered the Domain Name to disrupt the business of the Complainant, who is a competitor of the Registrant. The web page corresponding to the Domain Name (see **Schedule F**) clearly reveals the Registrant's intention to provide goods and services in the food sales industry, which would compete with the Complainant (see *Bartercard Ltd. & Bartercard International Pty. Ltd. v. Ashton - Hall Computer Services*, Case No. D2000-0177). Alternatively, users will be confused into believing that there is a connection of source, sponsorship, affiliation or enforcement to the Complainant by this use of the Domain Name (see *Focus Do It All Group and others v. Athanasios Sermbizis*, Case No. D2000-0923).

In addition, even though the Registrant is not at this time actively pursuing a business that is in competition with the Complainant, the Complainant submits that the definition of the term "competitor" for the purposes of the Policy is not restricted and may mean one who acts in opposition to another and the context does not imply or demand any restricted meaning such as commercial or business competitor (see *The Toronto-Dominion Bank v. Boris Karpachev*, Case No. D2000-1571 and the decisions cited therein).

The Mark is used by the Complainant in connection with the ".com" TLD. The Complainant also has the right to use the Mark in connection with the ".ca" TLD. Given that the Complainant's "Save-on-Foods" supermarkets are located in Canada, information about the services offered by the Complainant should be available to customers and would-be customers searching under the ".ca" TLD. The Complainant is entitled to reflect the Mark in all domain names that are confusingly similar to the Mark (see *Focus Do It All Group and others v. Athanasios Sermbizis*, Case No. D2000-0923).

In light of (a) the food supermarket business operated by the Complainant in relation to the Mark since at least 1982, (b) the fact that the Domain Name is identical to the Mark, and (c) the famous and distinctive nature of the Complainant's Mark in Canada, particularly British Columbia and Alberta (see "Rights of Complainant in the Mark" above), the Complainant submits that the Domain Name is likely to lead Internet users who are customers or would-be customers of the Complainant and familiar with the Complainant's Mark to be confused into believing that the Domain Name "saveonfoods.ca" would connect them with a web site of the Complainant. The effect would be to disrupt the business of the Complainant who is a competitor of the Registrant.

49. The Complainant has on two occasions sent correspondence to the Registrant's address as indicated on the WHOIS search page for the Domain Name (see **Schedule I**). The Registrant has refused to acknowledge receipt and has not responded to the Complainant's correspondence or offered any justification of good faith registration of the Domain Name. The only reasonable inference is that, having been given the opportunity to explain the existence of a legitimate interest in the Domain Name, the Registrant has not done so. In the Complainant's submission, this constitutes bad faith (see *Red Robin International, Inc. v. Greg Tieu*, Dispute No. 00001, October 7, 2002 and *Grunfos A/S v. Yilmaz Ozgur IPO* Case No. D2002-0252).

50. Further, it is submitted that the Registrant's failure to make a bona fide use of a domain name during for more than two years following registration constitutes bad faith (see *Chernow Communications, Inc. v. Jonathan D. Kimball*, Case No. D2000-0119).

51. Finally, the fact that the Registrant is located in the same geographical area where the Mark is distinctive is of significance in establishing actual or constructive notice of the Mark and bad faith as the Registrant must have known at the time of the registration about the distinctive and well-known character of the Complainant's Mark (see *Cortefiel, S.A. v. The Gallery Group*, Case No. D2000-0162).

**THE REGISTRANT'S POSITION IS AS FOLLOWS**  
**THE REGISTRANT - DOMAIN NAME CONFUSINGLY SIMILAR TO TRADE-MARK**

52. Although under construction, the "saveonfoods.ca" site has an email address (GKAD@aol.com) for correspondence. In the two years this site has only generated ONE email from a customer of Save On Foods and Drugs. The customer was informed the site was not affiliated with Save on Foods and Drugs. This suggests the "Mark" is distinctive from "saveonfoods.ca". (see *Cheap Tickets and Travel Inc v. Email.ca Inc*, Case No. 00004)

**THE REGISTRANT - NO LEGITIMATE INTEREST OF**  
**REGISTRANT IN DOMAIN NAME**

53. The Registrant submits:

- (a) Confusingly similar: The complainant offers jurisprudence (*see Browne & Co Ltd v. Bluebird Industries*, Case 00002, October 22, 2002). However, the two cases, this and 00002 are very different. In case 00002 the complainant and respondent are competitors in the same business, and the allegation was the domain name was registered by the respondent primarily to disrupt the “business of the complainant”. That does not apply in this case. Save on Foods and Drugs is in the business of selling groceries and drugs and not in the business of issuing coupons (as is the business of “saveonfoods.ca”). So, “saveonfoods.ca” would not be trading off the recognition of the complainant's mark.
- (b) Clearly Descriptive Name: Quite clearly an argument cannot be made that the domain name is not being used in good faith in association with any wares, services, or business since the site isn't even up and running. And, contrary to the complainant's assertion, the domain name is very clear and descriptive on it's future business - to save money on foods. The case referred to by the complainant (*see Grundfos A/S v. Yilmaz Ozgur*, Case No. D2002-0252) has no relevance to this case. In D2002-0252 the respondent (who didn't provide a response) was a Turkish gentleman registering the domain name under false pretence - using a false address and telephone number, and there was no website indicating the purpose of the website. In addition, the domain name grundfos.info is not clearly descriptive of the service, wares or business.
- (c) Use of Generic Name: The name in question is generic under the policy, subparagraph 3.6(c). SAVE and FOODS are common terms used widely to describe objects, ideas, situations (*see Warm Things Inc v. Adam S. Weiss*, Case No. D2002-0085).

A search on search engine Google.com found 955 sites with both the words SAVE ON (i.e. Save-on-stuff.com, save-on-hotels.com, save-on-tv.com....)

Thus, the Registrant submits that he has a legitimate interest in using this domain name.

## **THE REGISTRANT - BAD FAITH**

54. The Registrant submits:

- (a) The complainant provides no evidence that he registered the domain name “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” (subparagraph 3.7 (a) of the policy). He has never solicited nor advertised for sale any of my six registrations of domain names. There is no pattern to suggest “cybersquatting”. All the domain names registered by me are clearly generic names (described earlier - “thebestinthecity.com”; “whowantstomarrya canadian.com”...). There is no name squatting - all the domain names are generic; and no attempt has been made to sell any of them. In time (as set out in the introduction) all sites will be developed to their full potential.

The only domain name that could, arguably, be a contentious one is “Hockeynightincanada.ca”. He registered this one when he heard the title was being dropped by CBC from it's Saturday night hockey telecasts. His assumption was the CBC no longer had any use for “Hockey night in Canada”. He will be contacting CBC to sort this matter out once this case is resolved.

- (b) The complainant states that in accordance with subparagraph 3.7 (c) of the Policy, that he has registered the domain name to disrupt the business of the complainant, who is a competitor to the registrant. That's absolutely not true. The complainant is in the business of selling groceries and drugs. “Saveonfoods.ca” is not a competitor - it's in the business of giving away coupons to attract visitors to the site. Advertisements from the businesses featured on the website will generate revenue. There will be separate links for each major city in Canada.

The complainant states because it owns the registration for Save-on-Foods.com, it's also entitled to the .ca extension. Does that then extend to all the other extensions - i.e. .net and .org? Saveonfoods.net (not owned by the complainant, but by a company in Victoria, B.C.) has been in operation for quite a while, and saveonfoods.org has not even been registered by anyone - not even the complainant.

When he registered “saveonfoods.ca”, the complainant's “Save-on-Foods.com” site was not operational. The complainant's assertion that it's customers would mistake the domain name in question with their grocery store chain is also unfounded - the “saveonfoods.ca” website clearly states (and has so from day one) the business it's in. In the past two years, he has received one email that should have been addressed to the complainant.

55. The Registrant submits that while the Complainant does submit two separate correspondences as exhibits (November 20, 2000 and February 19, 2001), he only received the latter one. On the February 19, 2001 correspondence, no reference was made to the earlier correspondence, so he was not aware of it at all. Not responding to something that was never

received can't be constituted in bad faith. He did receive the February 19, 2001 correspondence but he chose to ignore it because it was insulting, accusatory, and heavy handed.

56. The Registrant submits that the Complainant states that failure to make bona fide use of a domain name for more than 2 years constitutes bad faith. The Registrant states that it is “No(t) so.” He has a registered company DPM Investment that he has not used in 5 years - no one would accuse him of setting the company up in bad faith. Oil companies purchase rights to oil fields for exploratory/production work to commence many years in the future. (*see Chernow Communications Inc. v. Jonathan D. Kimball*, Case No. D2000-0119) - panelist David E. Sorkin states “passively holding or 'parking' a domain name for an extended period may well be relevant to bad faith use, but does nothing to show that the name was originally registered in bad faith”.

57. The Registrant submits in conclusion that he has not used the disputed domain name on an active website to divert internet users by creating confusion to any affiliation with the Complainant, nor to divert them to the Complainant's competitors. There is no pattern or evidence to suggest that he would do so in the future. He did not undertake the initial registration with this intent, and any inference to the contrary is unfounded. He has a legitimate right to the domain names he has registered.

## **DECISION**

58. Under paragraph 4.1 of the Policy, the onus is on the Complainant to prove on a balance of probabilities 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 paragraph 3.7; and
- (c) the Complainant must provide some evidence that the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.6.

59. Paragraph 4.1 of the Policy also provides that:



“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.”

### **CONFUSINGLY SIMILAR - PARAGRAPH 4.1 (a) OF THE POLICY**

60. In our view, the Complainant has met the onus that the Registrant's Domain Name “saveonfoods.ca” is confusingly similar to the Complainant's Mark.

61. Paragraph 3.4 of the Policy defines “confusingly similar” as follows:

“(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.

62. In our view “saveonfoods.ca” is confusingly similar to the Mark “Save On Foods”.

### **BAD FAITH - PARAGRAPH 4.1 (b) OF THE POLICY**

63. In order to establish bad faith, the Complainant must establish on the balance of probabilities, one of paragraphs 3.7(a), (b) or (c) of the Policy. The Complainant has not sought to establish paragraph (a).

### **REGISTRATION IN BAD FAITH - PARAGRAPH 3.7(b) OF THE POLICY**

64. Therefore, for the issue at hand, to satisfy paragraph 3.7(b) the Complainant must on a balance of probabilities establish that the Registrant effected its registration to prevent the Complainant from registering its Mark as a domain name and that the Registrant has engaged in a pattern of registering domain names to prevent other parties from registering their Marks as domain names.

65. It is quite clear that by registering its domain name the Registrant prevented the Complainant from registering its Mark as a domain name. However, whether or not the

Registrant has engaged in a "pattern" of registering domain names to prevent other parties from registering their Marks is more difficult. The Complainant provided evidence of such a pattern with the Registrant's registration of the domain name "hockeynightincanada.ca". The Complainant also provided evidence that although it attempted to do so, it was not able to determine whether or not the Registrant had registered other domain names which might be able to demonstrate such a pattern. If the Registrant had given evidence of it having actively carried on business from the website to which the domain name was attached, we might have required greater evidence of a pattern of activity by the Complainant. However, on the facts at hand, and on the Registrant's admission that the Registrant does not intend to actively carry on business from this web site for an extended period of time, we believe that on the balance of probabilities the Complainant has established what is required of it by paragraph 3.7 (b).

66. We agree that the Registrant has registered the Domain Name in order to prevent the Complainant from registering the Mark as a domain name at the ".ca" TLD.

67. The Complainant owns the Mark "Save On Foods". The Mark is used in relation to supermarket services. The Registrant uses the Mark in its Domain Name and as the heading of its web page. Given the number of stores in British Columbia operated by the Complainant under the Save On Foods name and the extensive advertising the Complainant currently does with respect to its stores and it is reasonable to infer has done since its predecessor began operating the Save On Food Stores in 1982, it is inconceivable that the Registrant who lives in British Columbia was not aware of the Complainant and the Complainant's business. The Registrant could not have been unaware of the use of the Save On Foods chain and the use of its Marks.

68. The Registrant has registered the domain name "hockeynightincanada.ca" which is derived from the "Hockey Night In Canada" trademark registered in the name of Canadian Sports Network Limited and now owned by the Canadian Broadcasting Corporation. We simply do not accept the assertion of the Registrant that he somehow "heard the title was being dropped by CBC from its Saturday night hockey telecast".

69. We agree with the Complainant that the failure by the Registrant to make use of the web site since its registration in November, 2000, is as noted in *Chernow Communications, Inc. v. Jonathon D. Kimball*, WIPO Case Number D200-0119, at paragraph 6.15 “constitutes bad faith.” Not only has the Registrant not used the web site, but he does not intend to use it until he retires in three to five years.

### **REGISTRATION IN BAD FAITH - PARAGRAPH 3.7(C) OF THE POLICY**

70. With respect to paragraph 3.7(c), the Complainant must establish that:

“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.”

71. This is the most difficult aspect of this matter. In our view as noted above, the Registrant has no legitimate interest in the Domain Name in accordance with paragraph 3.6 of the Policy.

72. The first question that must be answered is whether the Registrant is a competitor of the Complainant.

73. The Registrant submits that “saveonfoods.ca” is not a competitor of the Complainant because “it's in the business of giving away coupons to attract visitors to the site.” The Registrant is not in business and on the evidence submitted by him, does not intend to go into business for a further three to five years.

74. On the face of the “saveonfoods.ca” web page, there is no indication that it will be used to give away coupons to attract visitors. On its face, it states that it is a “future site for savings on food - groceries, restaurants, organic food delivery, bulk purchase.” This is the same business that the Complainant is in. The two web sites compete, or will compete, in savings on food.

75. Does the fact that the Registrant does not intend to use the web site for three to five years make him or his web site any less a competitor. In our view, it does not.

76. The Canadian Oxford Dictionary, (Oxford University Press, Toronto, Oxford, New York, 1998) defines "Competitor" as:

"1. a person who competes. 2. a rival, esp. in business or commerce."

77. Accepting that the Registrant is a competitor because it will offer savings on food including groceries, has the Complainant established that the Registrant registered the Domain Name - "for the purpose of disrupting the business of the Complainant".

78. "Disrupt" is defined in the Canadian Oxford Dictionary as:

1. interrupt the flow or continuity of (a meeting, speech, etc.); bring disorder to; 2. separate forcibly; shatter.

79. We agree with the Complainant that the Domain Name "saveonfoods.ca" is likely to lead Internet users who are customers or would-be customers of the Complainant and familiar with the Complainant's Mark, to be confused into believing that the Domain Name "saveonfoods.ca" would connect them with a web site of the Complainant. We agree that this would disrupt the business of the Complainant in that it would interrupt the flow of customers to the Complainant.

80. The Registrant's web page indicates that the Registrant's intention is to provide goods and services in the food sales industry which would compete with the Complainant. We agree with the Complainant that the heading "Save On Foods Portal - under construction - future site for savings on food - groceries, restaurants, organic food delivery, bulk purchase ..." could and probably would indicate to users that the Website has some connection with the Complainant. There is no legitimate purpose that we can see for the use of this name in connection with this web site.

81. There is no direct evidence that the Registrant registered the Domain Name primarily for the purpose of disrupting the business of the Complainant. However, from the

evidence presented by the Complainant and which the Registrant did not attempt to refute, the Complainant's Mark "Save on Foods" is very well known in British Columbia, the home of the Registrant. Therefore, prior to registering the Domain Name, there is no question that the Registrant would have knowledge of the use of the Mark by the Complainant. Indeed, the Registrant's evidence is that when he applied for registration of the Domain Name, "the complainant's "Save-on-Foods.com" site was not operational". Thus prior to registering the Domain Name, the Registrant clearly was concerned about conflict with the Complainant's Mark and yet he went ahead and registered the Domain Name. He had to know that such registration and use of the Domain Name would disrupt the business of the Complainant. The Registrant should not be permitted to use the Mark of the Complainant in its Domain Name for the purpose of guaranteeing savings on food including groceries and then simply sit on the name for three to five years or at least five to seven years including the approximately two and one half years the Domain Name has been registered. There is no legitimate purpose in registering and holding this name. As with the provisions of paragraph 3.7 (b), had the Registrant made greater use of the website, we would have placed a greater onus on the Complainant to demonstrate the requirements of paragraph 3.7 (c), however, under the circumstances, we believe that the Complainant has satisfied its onus. We find the Registrant has registered the Domain Name in bad faith.

#### **LEGITIMATE INTEREST IN DOMAIN NAME - 4.1 (c) OF THE POLICY**

#### **LEGITIMATE INTERESTS PARAGRAPH 3.6 OF THE POLICY**

82. We have found that the Complainant has satisfied the onus placed upon it pursuant to paragraphs 4.1 (a), (b) and (c) of the Policy. The remaining question is whether or not the Registrant has proven on a balance of probabilities that he has a legitimate interest in the Domain Name as such "legitimate interest" is defined in paragraph 3.6. A review of paragraph 3.6 indicates that none of the sub-paragraphs are applicable to the matter at hand except for sub-paragraph 3.6 (c). It is clear that the Registrant used the Domain Name to identify a web site. However, this is not enough. Under sub-paragraph 3.6 (c) he must use the Domain Name "in good faith in association with any wares, services or business". We believe that this phrase should be interpreted as meaning a present offering of wares, services or business and not a

future offering of these some three to five years in the future. In other words, this provision would not apply to permit a Registrant to "park" a domain name to be used for a business to be carried on some time in the future. We therefore find that the Registrant has not demonstrated a legitimate interest in the Domain Name.

## **ORDER**

83. In accordance with our decision as set out above, we direct that the registration of the Domain Name "saveonfoods.ca" be transferred to the Complainant.

Date: April 21, 2003

W.A. Derry Millar, Elizabeth Cuddihy, Q.C. and R. John Rogers

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W.A. Derry Millar  
Chair