

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

Domain Names: **EXPRESSFITFORWOMEN.CA**
 EXPRESSFIT4WOMEN.CA
 EXPRESSFIT.CA

Complainant: Franchizit Corporation
Registrant: 984308 Ontario Inc.
Registrar: DomainsAtCost Corporation
Panellist: David Lametti
Service Provider: Resolution Canada

DECISION

A. The Parties

1. The Complainant is Franchizit Corporation, a Canadian business corporation with its registered offices in Stoney Creek, Ontario. The Complainant is represented by Ms Helen Pelton of Martin, Martin, Evans, Husband of Hamilton, Ontario.

2. The Registrant is 984308 Ontario Inc., whose registered address is 1462 Pound Street, Fort Erie, Ontario. The contact person for the Registrant is John Fulton, and the contact address is Fulton 24 Hour Fitness, 14 James Street, St. Catharines, Ontario.

B. The Domain Name and Registrar

3. The domain names at issue are <EXPRESSFITFORWOMEN.CA>, <EXPRESSFIT4WOMEN.CA> and <EXPRESSFIT.CA >.

The domain name is registered with DomainsAtCost Corporation.

C. Procedural History

4. The Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, Resolution Canada. The Provider served notice of the Complaint to the Registrant as required by paragraph 4.3 of the *CIRA Domain Name Dispute Resolution Rules* ["Rules"]. No Response to the Complaint was received from the Registrant. The Complainant elected to have the Complaint heard by a single panellist as permitted under paragraph 6.5 of the Rules. The Provider selected me, David Lametti, as the single panel member for this Complaint.

D. Panel Member Impartiality and Independence Statement

5. As required by paragraph 7.1 of the Rules, I, David Lametti, have declared to the Provider that I can act impartially and independently this matter as there are no circumstances known to me which would prevent me from so acting.

E. Basis for Deciding the Complaint

6. The Registrant has not submitted a Response to the Complaint. However, paragraph 5.8 of the Rules allows the proceeding to be decided strictly on the basis of the Complaint, and as such I shall proceed.

F. Factual Background

7. The facts of this dispute are relatively straightforward. Fitness Link Inc. is an Ontario business corporation that operated as a franchisor of fitness facilities for women known as “Expressfit for Women”.

8. Robert Fulton is a former officer and minority shareholder of Fitness Link Inc. His brother, John Fulton, is the current minority shareholder of Fitness Link Inc. At some point prior to November 21, 2003, a change in the management direction of Fitness Link Inc. occurred, relieving Robert and John Fulton of the custody and management of the firm.

9. On November 21, 2003, Fitness Link Inc. sold the trademark EXPRESSFIT FOR WOMEN to the Complainant, Franchizit Corporation. John Fulton opposed the sale of the trademark to the Complainant. Since the acquisition of the trademark, the Complainant has carried on the business of utilizing the trademark as the exclusive franchisor of distinctive facilities designed for women.

10. Robert Fulton is currently President of the Registrant, 984308 Ontario Inc. an Ontario business corporation.

11. On January 15, 2004, the domain name <EXPRESSFIT4WOMEN.CA> was registered by 984308 Ontario Inc. and John Fulton was shown as the technical contact on the registration. On January 19, 2004, the domain name <EXPRESSFITFORWOMEN.CA> was registered by 984308 Ontario Inc. and John Fulton was shown as the technical contact. On February 16, 2004, the domain name <EXPRESSFIT.CA> was registered by 984308 Ontario Inc. and John Fulton was shown as the technical contact.

G. CIRA Domain Name Dispute Resolution Policy Requirements

12. The *CIRA Domain Name Dispute Resolution Policy* [“Policy”] sets out at paragraph 4.1 what the Complainant must establish in order to successfully prove the complaint:

To succeed in the Proceeding, the Complainant must 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; and

(b) the Registrant has registered the domain name in bad faith as described in paragraph 3.7;
and the Complainant must provide some evidence that:
(c) 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 . . .

H. Is the Registrant’s Domain Name Confusingly Similar to the Complainant’s Mark?

1) The Complainant’s Mark

13. Paragraph 3.2 of the Policy includes the following in the definition of what constitutes a “mark” for the purposes the Policy:

A “Mark” is:

- (a) a trade-mark . . . or a trade name that has been used in Canada . . . for the purpose of distinguishing the wares, services or business of that person . . . from the wares, services or business of another person; [and]
- (c) a trade-mark . . . that is registered in CIPO . . .

14. The Complainant has shown evidence of its current ownership of the mark EXPRESSFIT FOR WOMEN, including both the transfer of the mark on November 21, 2003 from Fitness Link Inc. to the Complainant, as well as the recognition by the CIPO of the Complainant as the current owner of the mark. The Complainant continues to use this trade name and therefore continues to have rights in the trade name.

15. As the mark was transferred prior to the date of registration of the domain name, the Complainant has established that it had rights in the mark prior to the domain name registrations, and registration being still in force establishes that the Complainant continues to have such rights in the mark.

2) “Confusingly Similar”

- a) The scope of “Confusingly Similar”

16. Paragraph 3.4 of the Policy defines “confusingly similar” in the following terms:

A domain name is “Confusingly Similar” to a Mark if the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark.

17. I note that this definition of “confusingly similar” in the Policy is susceptible to a narrow, non-contextual interpretation, based on the similarities of this definition to the definition of Confusingly Similar derived from s. 9(1) of the Trade-Marks Act on “official marks” [“s. 9(1)”] and to only one criterion from the larger confusion test applicable to trademarks and trade names found in s. 6(5)(e) of the Trade-Marks Act. On this view, the test in the Policy does not incorporate what one might call the full “confusion” standard which has informed Canadian trademark and trade name law, but rather focuses more strictly on similarities in appearance, sound or meaning between the official mark and domain name. [See *I.O.F. v. Norendu Enterprises Canada Inc.* (*Forester College of Technology*) CIRA Dispute Resolution Case 00017, May 25, 2004 at paras. 18ff.]

18. I note as well that a number of cases under the Policy have interpreted “Confusingly Similar” in a larger fashion, incorporating the classic trademark and trade name law confusion standard, allowing for a contextual analysis that goes beyond mere comparison of the mark and domain name, and including the various other indicia of confusion listed in s. 6(5) of the Trade-Marks Act.

19. It is fair to conclude that the narrower reading of the definition of “confusingly similar” will by and large favour Respondants, while the larger reading will by and large favour Complainants (and thus trademark owners).

20. As the Complaint points to facts and makes submissions which rely almost exclusively on the similarity between the domain names and the mark in question, I may apply the narrower standard without taking a position on the matter. (Contextual considerations, revolving around the acquisition of the mark will have a bearing on bad faith and legitimate interest, however.) In the end, the use of the narrower standard for interpretation will have no bearing on the outcome in this case.

b) “Confusingly Similar”

21. As inferred above, under the narrower, s. 9(1) approach to confusingly similar, the focus must, in the first instance, be exclusively on the appearance, sound and ideas suggested by the Complainant’s mark.

22. In this instance, discounting as one should the .ca portion of the domain name and spacing between words, the mark EXPRESSFIT FOR WOMEN is identical to the domain name <EXPRESSFITFORWOMEN.CA>, and virtually identical in sound to the domain name <EXPRESSFIT4WOMEN.CA>. This is a clear-cut case of “confusingly similar” under the Policy and I have no trouble finding that the Complainant has met the most stringent standard set out in the Policy.

23. The domain name <EXPRESSFIT.CA> presents a more difficult issue. Here the element “for women”, present in the mark, is not present in the domain name. While it is true that “Expressfit” is an important part of the mark, being a coined term and the first word of the mark, it is equally true that the element “for women” is of a similar

importance the overall appearance, sound and meaning of the mark. The idea suggested that this service is “for women” is at least as important to the distinguishing power of the trademark. The missing element in the domain name is therefore of sufficient importance to differentiate the domain name from the mark. As such, it is much harder to believe that the average person “familiar with the mark and searching the web” for the Complainant would automatically associate the one with the other, even though part of the phrase is coined, distinguishing this case from the decision under the Policy in *Biogen Inc. v. Xcalibur Communication*, CIRA Dispute Resolution Case 00003, November 29, 2002 (where the coined word “Biogen” constituted the *whole* of the mark BIOGEN, and thus allowed for the finding that the domain name <BIOGEN.CA> was “confusingly similar”). On the narrower test of “confusingly similar” under the CIRA Policy, the Complainant has not met its burden regarding this domain name.

24. A contextual approach would not necessarily save the Complainant. While the Complainant asserts that “Expressfit” is a coined word, the inherent distinctiveness implied by that contextual consideration must be proven with other facts. In particular, that analysis would have to show that that people would associate “Expressfit” with “Expressfit For Women”. And even if this could be shown, interpreters of the Policy must take care not to accord to domain name holders rights which would in effect create trademark rights or infringe upon the rights of other trademark holders. Thus, in my view, the analysis would also have to show that the domain name holder was not being accorded a right which would automatically create a right in a trademark. Here, the intrinsic and developed strength of the mark, the nature of the service industry in which it is used, etc., might all be relevant considerations. Moreover, in such a contextual analysis, the evidence would have to show not only a strong link between “Expressfit” and “Expressfit for Women”, but also that in giving a right in <EXPRESSFIT.CA> one was not granting a trademark right or infringing a trademark right in EXPRESSFIT. Not enough evidence has been adduced in this matter to allow me to make such a conclusion with any confidence. To put it colloquially, absent further evidence, this would be tantamount to giving the Complainant a right in another trademark which it may not have paid for.

c) Conclusion on Confusingly Similar

25. Under the either interpretation of “confusingly similar” under the Policy, the Panel finds that the Registrant’s domain names <EXPRESSFITFORWOMEN.CA> and <EXPRESSFIT4WOMEN.CA> are confusingly similar to the Complainant’s registered mark.

26. However, based on a comparative analysis of the similarity of the trademark EXPRESSFIT FOR WOMEN and the domain name <EXPRESSFIT.CA>, the Panel finds that the mark and the domain name are not “confusingly similar”. Insufficient contextual evidence was adduced by the Complainant to support such a finding using a larger, more expansive test for confusingly similar.

I. Was the Registration of the Domain Name Made in Bad Faith?

27. In order to succeed, the Complainant must show, on the balance of probabilities, that the Registrant registered the domain name in bad faith. The Policy, unlike the UDRP, has expressly and purposely adopted a restricted definition of “bad faith”. Paragraph 3.7 of the Policy states that the Registrant will be considered to have registered the domain name in bad faith, if and only if one of the following three conditions is met:

(a) the Registrant registered the domain name . . . primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant [or others related to or competing with the Complainant] for valuable consideration in excess of the Registrant’s actual costs in registering the domain name . . . ;

(b) the Registrant registered the domain name . . . in order to prevent the Complainant [or others related to the Complainant] 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; or

(c) the Registrant registered the domain name . . . 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.

28. On the facts of and evidence adduced in this dispute the only one of these three tests of bad faith that might apply is the third, (c), a registration “primarily for the purpose of disrupting the business of the Complainant”. It has been stated that “[t]his disruption could occur only in the sense that persons encountering the domain name might conclude that the Registrant’s business, associated with the domain name, was a business of the Complainant or was at least endorsed, sponsored or approved by the Complainant. Thus, the Complainant’s business reputation would be put at risk by the Registrant’s business conduct, over which the Complainant had no control.” [*I.O.F. v. Norendu Enterprises Canada Inc. (Forester College of Technology)* CIRA Dispute Resolution Case 00017, May 25, 2004 at paras. 36.] This disruption is not the normal disruption that one associates with the usual dictates of business practice in a competitive market; rather, it is a disruption whose effects are the primary purpose of the Registrant. While the former might have been caught under paragraph 4(b)(iv) of the ICANN UDRP Policy, this provision was expressly omitted from this Policy.

29. In this case, it is reasonable to conclude that the intent of the Registrant was more than simply trying to promote its own business by falsely associating it with the Complainant’s business reputation. The Complainant has shown anecdotal evidence of the Respondent either not replying at all to inquiries directed at the Complainant’s services by potential franchisees, thus damaging the Complainant’s goodwill and causing a loss of potential franchisees or replying with disparaging comments. In all cases, the purpose was uniquely and directly to hurt the Complainant’s goodwill without advancing what one might consider some other legitimate business interest. Moreover, this behaviour does not appear to be part of what might consider a legitimate critical website.

30. The Panel therefore concludes that the Respondent did register the domain names <EXPRESSFITFORWOMEN.CA> and <EXPRESSFIT4WOMEN.CA> in bad faith under paragraph 3.7 (c) of the Policy for the primary purpose of disrupting the business of a competitor. No finding on the domain name <EXPRESSFIT.CA> was necessary, given the finding above on “confusing similar”.

J. Does the Registrant Have a “Legitimate Interest” In the Domain Name?

31. The final element of the test set out in the Policy is to determine whether or not the Registrant had a legitimate interest in the domain name. Paragraph 3.6 of the Policy states:

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.

32. Once again, this definition is restrictive – only the interests listed in subparagraphs (a) – (f) below can be considered legitimate interests. In terms of procedure the Complainant must provide some evidence that none of these interests applied to the Registrant. The burden would then shift to the Registrant to show that it had, on the balance of probabilities, any one of these legitimate interest as defined under these subparagraphs.

33. The Complainant has introduced some evidence of the Registrant having no legitimate interest. While it has not addressed the six criteria directly, it has shown that

the Registrant was a former officer and former minority shareholder of Fitness Link Inc, who not only knew of the sale of the trademark to the Complainant, but opposed it. This knowledge and opposition, coupled with the evidence of the legitimate transfer of the mark, is sufficient for the Complainant to show some evidence of no legitimate interest in the domain name on the part of the Registrant.

34. The Registrant has not replied to the Complaint, and has thus failed to meet the burden of showing some legitimate interest in the domain name according to the criteria set out in the Policy.

35. The Panel therefore concludes that the Respondent did not have a legitimate interest in the domain names <EXPRESSFITFORWOMEN.CA> and <EXPRESSFIT4WOMEN.CA> under paragraph 3.6 of the Policy. No finding on the domain name <EXPRESSFIT.CA> was necessary, given the finding above on “confusing similar”.

K. Conclusion and Decision

36. The Complainant has established on the balance of probabilities that the Registrant’s domain names <EXPRESSFITFORWOMEN.CA> and <EXPRESSFIT4WOMEN.CA> were confusingly similar to the Complainant Marks under any interpretation of “Confusingly Similar” in the CIRA Dispute Resolution cases decided to date.

37. The Complainant has failed to establish on the balance of probabilities that the Registrant’s domain name <EXPRESSFIT.CA> was confusingly similar to the Complainant Marks under any interpretation of “Confusingly Similar” in the CIRA Dispute Resolution cases decided to date.

38. The Complainant has established on the balance of probabilities that the Registrant had registered the domain names <EXPRESSFITFORWOMEN.CA> and <EXPRESSFIT4WOMEN.CA> in bad faith, as defined in the Policy.

39. The Registrant has not shown a legitimate interest in the domain names <EXPRESSFITFORWOMEN.CA> and <EXPRESSFIT4WOMEN.CA>.

40. No finding was made with regard to either bad faith registration or no legitimate interest on the part of Registrant with respect to the domain name <EXPRESSFIT.CA>, given the initial finding on “confusingly similar”.

41. For these reasons, the complaints regarding the domain names <EXPRESSFITFORWOMEN.CA> and <EXPRESSFIT4WOMEN.CA> and <EXPRESSFIT.CA > are successful. The Panel orders that the domain names <EXPRESSFITFORWOMEN.CA> and <EXPRESSFIT4WOMEN.CA> be transferred to the Complainant as requested.

42. For these reasons, the complaint regarding the domain name <EXPRESSFIT.CA > is not successful. The Panel makes no order in this regard.

David Lametti
Sole Panel Member

David Lametti
5 August 2004