

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

Domain Names: SURFTURF.CA

Complainant: Surf and Turf Instant Shelters Inc.
Registrant: Anonymous individual
Registrar: PublicDomainRegistry.com Inc.

Panel: David Allsebrook
Service Provider: ResolutionCanada Inc.

DECISION

A. The Parties

1. The Complainant **Surf and Turf Instant Shelters Inc.** is located in Stoney Creek, Ontario. Its authorized representative in this dispute is Mark Lunt.
2. The Registrant was identified by CIRA as an individual having a postal address in Germany. I have omitted her name from these reasons as she opted for privacy when making her domain name registration.

B. The Domain Name and Registrar

3. The domain name at issue is **SURFTURF.CA**.
4. The domain name is registered with **PublicDomainRegistry.com Inc.**

C. Panel Member Impartiality and Independence Statement

5. As required by paragraph 7 of the Rules, the undersigned has declared to the Provider that he can act impartially and independently in this matter, as there are no circumstances known to him that would prevent him from so acting.

D. Canadian Presence Requirement

6. The Complainant is a Canadian federal corporation incorporated on August 14, 2012. A scan of a Certificate of Incorporation establishing these facts was

provided with the Complaint. The Complainant therefore complies with the Canadian presence requirements which qualify it to hold .ca domain name registration and to lodge complaints under the CIRA Dispute Resolution Policy (CDRP).

E. Factual Background

7. Notice of the Complaint and copies of the pertinent documents were given to the Registrant on May 6, 2019 by email. The email requested a response by May 27. No response has been received from the Registrant.
8. Surf and Turf Instant Shelters Inc. supplies instant shelters such as awnings and canopies and various branded accessories. Its sales literature, stationery, sales material such as trade show banners, and its delivery van prominently promote the domain name surfturf.ca. The company's products are labelled with the domain name. It presently has \$975,584 worth of product so labelled in stock.
9. In 2011 an individual at a company in the UK related to the Complainant registered the domain name surfturf.ca. The Complainant has been using the domain name since then. The individual died last year without renewing the domain name registration, which expired on December 17, 2018. Attempts to forestall the expiration and thereafter to reclaim the registration were unavailing, and it was deleted on February 28, 2019. Despite having placed a backorder on the domain name to re-acquire it upon its deletion, the domain name was acquired by the Registrant.
10. The Complaint characterizes the acquisition thus: "A fraudulent company purchased the domain on the same day to advertise Training/sports equipment." "The Scam Company who registered surfturf.ca has no vested interest in the domain. They have no company name and have never been associated with the brand or name Surf & Turf. The website they set up had no contact details. We believe this was purely done to obtain free web traffic of customers who were in fact searching for our company, surf & turf instant shelters Canada Inc. "
11. No sample of a web page to which the domain name resolves was provided with the Complaint. No other information was provided by the Claimant to substantiate the allegations in the previous paragraph or by the Registrant to rebut them.

F. Analysis

12. . To succeed, a CDRP complainant must demonstrate the three factors specified in paragraph 4.1 of the CDRP, namely:

“4.1 Onus. 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 3.5; and the Complainant must provide some evidence that: (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

13. “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 3.4”

Confusing Similarity issue

14. The domain names are confusingly similar. They are identical. The Claimant had rights in surfturf.ca beginning in at least 2010, before the Registrant registered it in 2019, which was the first known activity of the Registrant in connection with the term “surfturf.ca”.

Bad Faith Issue

15. The second test is whether the trade mark has been registered in bad faith. Section 3.5 of the Policy begins:

“Registration in Bad Faith. For the purposes of paragraphs 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:”

16. The Complaint does not establish that the registration was obtained in bad faith. It does not know the motives of Registrant. It surmises that the Registrant’s intention was to obtain the Complainant’s web traffic. No information is given as to how much traffic the Complainant had. No copy of the Registrant’s web site was provided. It is said to advertise “Training/sports equipment”. No explanation is offered as to how such advertising would amount to bad faith. It is not alleged or shown that consumers seeing advertising for “Training/sports equipment” on a web site reached at surfturf.ca would connect it to the Complainant. The fact that a newly acquired domain name had established traffic does not by itself establish bad faith in acquiring it.

Legitimate Interest Issue

17. The third test under the policy is whether the Registrant has no legitimate interest in the domain name as described in paragraph 3.4. Paragraph 3.4 reads as follows:

“3.4 Legitimate Interests. For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in a domain name: (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. In paragraph 3.4(d) “use” by the Registrants includes, but is not limited to, use to identify a web site.”

18. Paragraph 4.1 deals with the issue of onus of proof:

“...the Complainant must provide some evidence that: (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4. 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 3.4.”

19. On the evidence provided by the Claimant, the Registrant may have a legitimate interest in the domain name. It is not selling competing goods or services to those of the Complainant. The term “surfturf.ca” is not so famous that any use of it in any field, including sports equipment advertising, would necessarily be associated in the minds of consumers with the Complainant. The Registrant’s use of surfturf.ca may produce trade mark rights in favour of the Registrant.

G. Conclusion and Decision

20. I find that Complaint has established that the domain name is Confusingly Similar with the Complainant's prior owned trade mark; that the domain name surfturf.ca was not registered in bad faith for the limited purposes of the CDRP; and that the Complaint does not impose a burden on the Registrant to establish that the Registrant has a legitimate interest in the domain name.

21. The Complaint is dismissed and the domain name surfturf.ca will not be cancelled or transferred to the Complainant.

July 10, 2019

Panelist



David Allsebrook