



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE

DOMAIN NAME DISPUTE

ADMINISTRATIVE PANEL DECISION

CIIDRC case number:	20091-CDRP	Decision date: March 13, 2023
Domain Name:	anytimefitness.ca	
Panel:	Leslie E. Maerov, FCI Arb., Q. Arb., sole panelist	
Complainant:	Anytime Fitness Franchisor LLC	
Complainant's representatives:	Ismaël Coulibaly c/o BENOÎT & CÔTÉ INC.	
Registrant:	Stefan Witt	
Registrar:	Namespro Solutions Inc.	

THE PARTIES:

1. The Complainant is Anytime Fitness Franchisor LLC, a company with its address in Woodbury, Minnesota, United States of America, and is represented by Ismaël Coulibaly, of BENOÎT & CÔTÉ INC. in Montréal, Canada. The Registrant is Stefan Witt, of Hamilton, ON, who has not responded to the Complaint and is not represented.

THE DISPUTED DOMAIN NAME AND REGISTRAR:

2. The Disputed Domain Name in issue is <anytimefitness.ca> which was registered on April 14, 2010, and expires April 14, 2023. The expiration date has been updated at least once, on March 19, 2021. The Registrar is Namespro Solutions Inc. (“Registrar”). Prior to the registration by the Registrant, the Complainant was the former registrant of the Disputed Domain Name, but by administrative error did not renew it upon its expiration on March 9, 2010, resulting in the subsequent release of the disputed domain name on April 14, 2010.

PROCEDURAL HISTORY:

3. This complaint (“**Complaint**”) was filed with Canadian International Internet Dispute Resolution Centre (the “**Provider**”) as recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (“**Policy**”), in accordance with the CIRA Dispute Resolution Rules (“**Resolution Rules**”) on January 17, 2023. The Complaint was determined to be in administrative compliance with the Resolution Rules and this proceeding was deemed commenced on January 17, 2023.

4. The Registrant’s identity is not published in the public WHOIS database, and within the time limited by Rule 4.3 of the Resolution Rules, on November 18, 2022, the Provider sent a request for registrar verification to the Registrar to determine the identity, including the mailing address and contact email of the Registrant, together with a request that the Disputed Domain Name be put on a Registrar lock. On January 17, 2023, the Registrar confirmed the identity of the Registrant and his mailing address and contact email, and confirmed that the Disputed Domain Name was placed on a Registrar lock.

5. Pursuant to Rule 4.4 of the Resolution Rules, on January 17, 2023, the Provider notified the Registrant at the email address for the administrative contact of record in the Registrant Information at stefangwitt@gmail.com and also at postmaster@anytimefitness.ca of the commencement of this proceeding, and advised the parties of the name and contact details of the Provider. On January 17, 2023, the Provider gave notice to the Registrant that he was required to respond to the Complaint not later than February 6, 2023, in accordance with the Policy and Resolution Rules.

6. The Registrant has not responded to the Complaint within the time limited, and the Complainant elected under Rule 6.5 to convert to a single member panel. Prior to my appointment I submitted a Statement of Independence and Impartiality to the Provider, declaring that there are no circumstances that would give rise to justifiable doubts as to my independence and impartiality, as required by the Resolution Rules. On February 15, 2023, after clearing for any potential conflicts, the Provider appointed me as a single member Panel.

7. When the Registrant does not respond to the Complaint, the Panel is required to decide the proceeding for the resolution of this dispute on the basis of the Complaint.

JURISDICTION:

8. By obtaining registration of a domain name in the dot-ca country code top level domain name registry operated by CIRA, the Registrant agreed to the resolution of certain disputes pursuant to the Policy and Resolution Rules. This is an administrative proceeding pursuant to the Policy and Resolution Rules.

9. In order to bring a proceeding under the Policy, a complainant must satisfy the Canadian Presence Requirements for Registrants contained in CIRA Policies, Rules and Procedures, which require that the applicant must meet at least one of the listed requirements.

10. The Complainant satisfies one of those requirements by being the owner of a trademark which is the subject of a registration at the Canadian Intellectual Property Office (“CIPO”) under the *Trademarks Act* (Canada), R.S.C. 1985, c. T-13. Satisfaction of this requirement limits permission to register a dot-ca domain name consisting of or including the exact word component of that registered trademark. The Complainant is the owner of the following trademark (“**Complainant’s Mark**”) which was registered in 2007 with CIPO:

Trademark	Registration No.	Registration Date	Expiry Date	Services
ANYTIME FITNESS	TMA 698,714	October 17, 2007	October 17, 2032	Health and fitness club services.

11. By being the owner of a registered Canadian trademark and satisfying the Canadian Presence Requirements for Registrants, the Complainant is therefore an eligible complainant.

FACTUAL BACKGROUND:

Background facts as submitted by the Claimant, and accepted by me as probative are summarized as follows:

12. The Complainant is a U.S.-based company founded in 2002. It is and has been the exclusive franchisor of the Anytime Fitness health and fitness club system since 2002. There are over 5,000 Anytime Fitness gyms serving approximately 4,000,000 members in nearly 35 countries, with global revenue of almost \$1.5B USD. In 2005, the Complainant opened its first Anytime Fitness club in Canada, whose number has now increased to more that 230 locations. It has received numerous awards since that date, including being named the #1 Global Franchisor by *Entrepreneur*

Magazine for two consecutive years. As a result the Complainant enjoys a substantial reputation through the Complainant's Mark in association with health and fitness club services, and significant goodwill is attached to the Complainant's Mark.

13. The Complainant owns the domain name <anytimefitness.com> which has been registered and active since 2002. The Disputed Domain Name <anytimefitness.ca> was registered by the Registrant on April 14, 2010, as it appears from the printout of the *Whois* database search results. It is important to note that prior to that date, the Complainant was the former registrant of the Disputed Domain Name, but by administrative error did not renew it upon expiration on March 9, 2010, resulting in a suspension of the Disputed Domain Name, and the subsequent release of the Disputed Domain Name on April 14, 2010, as shown in the historical *Whois* records of *Domain Tools*.

14. The Disputed Domain Name "anytimefitness.ca" was first registered by the Registrant on April 14, 2010, and expires on April 14, 2023. It resolves to a website that states "this domain is under construction". This is the same webpage that has displayed the disputed domain name since at least as early as 2012.

15. As set out below, the Complainant alleges that the Registrant is a competitor to the Complainant and has registered the Disputed Domain Name for the purpose of preventing the Complainant from registering the name itself.

REMEDY SOUGHT:

16. The Complainant requests that the ownership of the Disputed Domain Name be transferred to the Complainant.

APPLICABLE LAW:

17. As directed by Rule 12.1, my decision is made on the basis of the evidence and argument submitted, in accordance with the Policy, the Resolution Rules and any rules and principles of the laws of Ontario, Canada. Rule 12.1 provides that unless both parties indicate the same preference, that the decision must be rendered on the basis of the laws of Ontario. The Respondent, not having responded to this Complaint, has not indicated a preference of the applicable law.

DISCUSSION & ANALYSIS:

18. In accordance with par. 3.1 of the Policy, in order to succeed in this proceeding, the Complainant is required to prove three things on a balance of probabilities, which are that:

- (a) The Disputed Domain Name is Confusingly Similar to the Complainant's Mark in which the Complainant had rights prior to the date of registration of the Disputed Domain Name, and continues to have such rights, as set out in par. 3.1(a) of the Policy;
- (b) The Registrant has no legitimate interest in the Disputed Domain Name, as described in par. 3.4 of the Policy; and
- (c) The Registrant has registered the Disputed Domain Name in bad faith, as described in par. 3.5 of the Policy.

(a) Is the Disputed Domain Name Confusingly Similar to the Complainant's Mark?

19. To be confusingly similar, the Disputed Domain Name must so nearly resemble the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark. A Mark is defined in s.3.2 of the Policy as, in part: a trademark, including the word elements of a design mark, that has been used in Canada by a person, for the purpose of distinguishing the wares, services or business of that person from the wares, services or business of another person. The Complainant has established that, as the owner of the Complainant's Mark, and by providing evidence that it markets its services on its web site visible in Canada using the Complainant's Mark, it is the owner of a trademark that has been used in Canada for the purpose of distinguishing its wares from the wares of another person.

20. The Complainant must have had rights in the Mark prior to the date of registration of the Disputed Domain Name and continue to have such rights. The Complainant satisfies this requirement by way of its ownership rights to the Complainant's Mark and having used that Mark in Canada for the purpose of distinguishing its wares from the wares of another person. The Complainant's rights to the trademark significantly preceded the registration of the Disputed Domain Name, as the Complainant's Mark has been used in Canada as early as 2005, and the Complainant's Mark was registered as a trademark in 2007, while the Disputed

Domain Name was not registered until April 14, 2010. That Mark continues to be valid and in effect at least until its present expiry date.

21. Pursuant to par. 1.2 of the Policy, the Disputed Domain Name means the domain name excluding the dot-ca suffix. Pursuant to par. 3.3 of the Policy, a domain name will be found to be confusingly similar with a Mark if it so nearly resembles the same in appearance, sound or in the ideas suggested so as to be likely to be mistaken for the Mark. The test to be applied when considering “confusingly similar” is one of first impression and imperfect recollection (*Coca-Cola v. Amos B. Herman*, BCICAC Case No. 00014, (October 28, 2003)).

22. Where a domain name is identical and wholly incorporates a Complainant’s registered Mark, this is sufficient to establish identity or confusing similarity for the purposes of the Policy: *Nikon Inc. v. Technilab, Inc.* Case D2000-1774 (WIPO) March 7, 2001. Identity or near identity to the Complainant’s mark will always be sufficient to find that a domain name is confusingly similar to a complainant’s mark: *Sleep Country Canada Inc. v. Pilfold Ventures Inc.* Case 00027 (CIRA) March 14, 2005. Since the Disputed Domain Name contains the exact wording of the Complainant’s Mark, namely the use of the words “Anytime Fitness”, there could be no doubt that it is confusingly similar to the Complainant’s Mark. An Internet user who has knowledge or recollection of the Mark might easily mistake the Disputed Domain Name as being somehow affiliated with or owned by the Complainant. The Complainant did not authorize the registration, and use of the Disputed Domain Name is likely to mislead the public into believing that the Registrant is affiliated with or authorized by the Complainant.

23. In conclusion, by incorporating the whole of the Complainant’s well known, widely used and publicized Mark, the Disputed Domain Name is likely to lead persons visiting the website of the Registrant to conclude that it is associated with the Complainant, and it is therefore confusingly similar to the Complainant’s Mark.

(b) Does the Registrant have a legitimate interest in the Disputed Domain Name?

24. The Registrant operates two local gyms in the City of Hamilton, Ontario, under the trade name “Get Your Gym On 24/7”, as it appears from different pages of the website www.getyourgymon247.com. Anytime Fitness is the legal name of the Complainant, and “Anytime Fitness” is not a reference by which the Registrant is commonly identified. In more

than 12 years, the Registrant has made no use of the Disputed Domain name beyond having it resolve to a parked site “under construction”.

25. The Disputed Domain Name is not understood in Canada to be a generic name associated to health and fitness activities in any language, which could have reasonably explained or justified a potential legitimate interest. Conversely, it is an original and distinctive mark of the Complainant which has significant goodwill throughout Canada.

26. The Complainant has prior rights in Canada through the used of its registered Mark and its registered <anytimefitness.com> domain name many years before the Registrant registered the Disputed Domain Name in 2010. The Complainant has been carrying on business under that name in Canada since the expansion of the Anytime Fitness franchise into Canada in 2005.

27. Not only is there no evidence that the Registrant has a legitimate interest in the Disputed Domain name, to the contrary, there is sufficient evidence that only the Complainant has a legitimate interest in the Disputed Domain Name.

28. Accordingly I find that the Complainant has satisfied the requirement that the Registrant has no legitimate interest in the Disputed Domain Name.

(c) Has the Registrant registered the Disputed Domain Name in bad faith?

29. Evidence of any of the non-exhaustive circumstances described in par. 3.5 of the Policy is evidence that a Registrant has registered a domain name in bad faith. The Registrant is a competitor of the Complainant and operates local gyms in the same geographical area as the Complainant. One of the Complainant’s gyms is located 8 km. from one of the Registrant’s gyms and 15 km. from the other of its gyms. The Registrant presents himself on his website as a “veteran of the health and fitness industry, having been in it for over 30 years” who, “after working with large fitness chains for many years, ... became dissatisfied with the direction that most fitness clubs had taken”. It is unlikely, and not plausible that the Registrant was unaware of the Complainant’s gyms when he registered the Disputed Domain Name.

30. The Disputed Domain Name was not a mark in which the Registrant ever had rights, and is not in any way similar to the trade name under which the Registrant operates, namely “Get Your Gym On 24/7”. The Registrant has apparently made no use of the Disputed

Domain Name in 12 years other than to have it resolve to a parked site “under construction”.

31. Previous ownership by the Claimant and quick registration immediately after the expiration is also a factor that can be considered in making a finding of bad faith registration. It can reasonably be inferred that the Registrant was closely monitoring the Disputed Domain Name and registered it to prevent the Claimant from discovering its administrative error allowing its registration to lapse and then re-register the name.

32. The Registrant has demonstrated no legitimate purpose or possible legitimate uses of its registration of the Disputed Domain Name.

33. The only reasonable inference to be drawn from the registration of a domain name that incorporates the whole of the Complainant’s well known, widely used and publicized Mark, in the absence of an explanation from the Registrant, is that it was done to prevent the Complainant from re-registering the Disputed Domain Name for use in connection with its own business. These facts are sufficient to demonstrate the Registrant’s bad faith.

34. Finally, the Registrant is deemed to have known of the Complainant’s Mark by virtue of its public registration at the CIPO, and as the Disputed Domain Name was registered many years after the Complainant acquired rights to the Complainant’s Mark in Canada, the registration of the Disputed Domain Name must be considered to have been made in bad faith.

35. The Registrant did not register the Disputed Domain Name with the consent or approval of the Complainant and the Registrant has not been licensed or otherwise permitted to use the Complainant’s Mark within the Disputed Domain Name or the website to which it resolves. The Registrant has no business relationship with the Complainant and has made no effort to establish that it has any rights in or authority to use the name “Anytime Fitness”. There is no evidence that the Disputed Domain Name was used for any legitimate non-commercial or fair use.

36. There is no evidence before me that indicates that the Registrant satisfies any of the circumstances outlined in par. 3.5 of the Policy, nor is there any other evidence that would indicate that the Registrant has any legitimate interest in the Disputed Domain Name. To the contrary, the Complainant has provided evidence that it is the sole owner of the Complainant’s Mark, and submits that it has not authorized the use of that Mark to the Registrant, nor has it authorized the use of the word “Anytime Fitness” to the Registrant for

use in the Disputed Domain Name. The activity that supports a finding of registration in bad faith cannot at the same time reflect a legitimate interest on the part of the Registrant.

37. I find that the use of the Mark “ANYTIME FITNESS” in the Registrant’s domain name and on the Registrant’s commercial website meets the circumstances outlined for bad faith.

DECISION AND ORDER:

38. For the reasons set out in this decision, I have found that the Complainant has satisfied all the requirements under the Policy in order to be successful in this proceeding and to be entitled to the remedy sought. As previously indicated, the Complainant is in compliance with the Canadian Presence Requirements for Registrants contained in CIRA Policies, Rules and Procedures which would allow it to be the registrant of a dot-ca domain name containing the exact words of the Complainant’s Mark.

39. I order that the Disputed Domain Name <anytimefitness.ca> be transferred to the Complainant.

This order is made as of March 13, 2023.



LESLIE E. MAEROV
Single member panel

