

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

Domain Names: <rfrk.ca>, <realfoodforkids.ca > and <realfoodlunchclub.ca>

Complainant: Real Food for Real Kids Inc.

Registrant: Boaden Catering Ltd. c/o Louie Tassone

Registrar: Network Solutions Canada ULC

Panelist: Hugues G. Richard

Service Provider: Resolution Canada Inc.

## DECISION

### THE PARTIES

1. The Complainant in this proceeding is Real Food For Real Kids Inc., 41 Dovercourt Road, Toronto, Ontario, Canada, c/o Zak A. Muscovitch, Muscovitch Law P.C., 446 Eglinton Avenue West, Toronto, Ontario, Canada M5N 1A5 ("the Complainant").
2. The Registrant is Boaden Catering Ltd. c/o Louie Tassone, 505 Queensway Ave. E., Unit #12, Mississauga, Ontario, Canada, L5A 484 ("the Registrant").

### THE DOMAIN NAME AND REGISTRAR

3. The disputed domain names in this proceeding are <rfrk.ca>, <realfoodforkids.ca > and <realfoodlunchclub.ca > ("the Domain Names").
4. The Registrar is: Network Solutions Canada ULC
5. The Domain Names were registered by the Registrant on the following dates:

<rfrk.ca> and <realfoodforkids.ca > on July fifth, 2014

<realfoodlunchclub.ca > December eight, 2014

## PROCEDURAL HISTORY

6. This is a proceeding under the Canadian Internet Registration Authority ("CIRA") Domain Name Dispute Resolution Policy (Version 1.3) (the "Policy") and the CIRA Domain Name Dispute Resolution Rules (Version 1.5) (the "Rules").
7. The Complainant filed a complaint with Resolution Canada, Inc. ("the Center") against the Registrant. The purpose of the said Complaint is to demand the transfer of the registration for the disputed domain names <rfrk.ca>, <realffoodforkids.ca > and <realfoodlunchclub.ca > from the Registrant to the Complainant.
8. In respect with paragraph 4.3 of the Rules, the Center served notice of the Complaint to the Registrant on May 13, 2015.
9. The Registrant has failed to deliver any Response to the Center.
10. On June 16, 2015, the Center named Hugues G. Richard as the sole Panelist to adjudicate the present dispute.
11. In light of the material submitted by the Complainant, the Panel concludes that the Complainant is eligible to the present proceeding according to the Policy and the Rules. The Complainant is a Canadian federal corporation and hence meets the Canadian Presence Requirements under paragraph 1.4 of the Policy and paragraph 2(d) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3.
12. The Panel is required to deliver its decision to the Center on July 8, 2015.

## FACTUAL BACKGROUND

13. The factual background was provided by the Complainant.
14. The Complainant founders, Lulu Cohen-Farnell and David Farnell have started doing business under the mark "REAL FOOD FOR REAL KIDS" on May 10, 2004.

15. The Complainant's founders incorporated their business under the name of Real Food For Real Kids Inc. on July 25, 2005.
16. Since its incorporation, the Complainant carries a business in the field of children's food service and catering in the greater Toronto area.
17. On August 9, 2006, the trademark REAL FOOD FOR REAL KIDS was registered with CIPO by the Complainant's founder Lulu Cohen-Farnell with a claimed date of first use as of May 10, 2004.
18. Previously licensed by Lulu Cohen-Farnell to the Complainant, the registered trademark "REAL FOOD FOR REAL KIDS" was transferred to the Complainant on the date of November 11, 2012 (nunc pro tunc July 25, 2005, date of the incorporation of the Complainant).
19. Having also used its acronym "RFRK" interchangeably with its original trademark "REAL FOOD FOR REAL KIDS" for a long time, the Complainant has become extensively known by this name, notably through acclaims by different media reports such as The Globe & Mail, the National Post, The Toronto Star and Macleans Magazine.
20. The Complainant is currently waiting after two pending "RFRK" trademarks registration applications (one word and one design marks) that have been filed with CIPO on February 25, 2015.
21. In the same manner, as for "RFRK", the Complainant has also become known under its sub-brand "REAL FOOD LUNCH CLUB", a program under which 2000 kids are currently enrolled.
22. "REAL FOOD FOR REAL KIDS", "RFRK" and "REAL FOOD LUNCH CLUB" brands have been used by the Complainant many years prior to the registration of the disputed domain names in relation with thousands of parents, children and school administrators through the distribution of menus and recipes and also in communications with dozens of food and equipment suppliers.

23. Employing 78 full-time employees, and serving 20 schools, 120 daycares and 110 snack clubs on a daily basis, it can be said that the Complainant is an active company.
24. The Complainant has operated a website located at <rfrk.com> for almost ten years, displaying the trademarks "REAL FOOD FOR REAL KIDS", "RFRK" and "REAL FOOD LUNCH CLUB". The website seems to have received a significant number of visitors.
25. The complainant has also operated the domain <realfoodforrealkids.com> as a redirecting link to <rfrk.com> page since 2007.
26. The Registrant operates a business named "Organic Kids Catering" which is in competition with the Complainant's business in the greater Toronto area.
27. The registrant has used the domains <rfrk.ca> and <realfoodforkids.ca> since July 5, 2014 and <realfoodlunchclub.ca > since around December 9, 2014.
28. It is only subsequently to a request made to CIRA that the Complainant learned the identity of the Registrant of the disputed domain names.
29. Until notice of dispute was made to the Registrant the domain names <rfrk.ca> and <realfoodforkids.ca> were redirecting their visitors to the Registrant's competing business "Organic Kids Catering" website.
30. During the same period, the domain name <realfoodlunchclub.ca > was redirecting its visitors to a pay-per-click advertising page hosted by its own registrar.
31. On May 5, 2015, the Registrant was found to have used and registered the domain name <realfoodforrealkidss.com > in bad faith by a panel of the National Arbitration Forum, under the UDRP rules. Particularly concerned by the Registrant's demand to sell the domain at the price of 42,000.00\$ to the Complainant, the panel was satisfied that there had been cybersquatting and transferred the domain name to the Complainant. The Registrant did not submit any defence to the complaint.

32. The Registrant displayed the Complainant's trademarks "REAL FOOD FOR REAL KIDS" and "RFRK" on its website <organickidscatering.com>, opposing its own products and services to those offered by Complainant as a mean of marketing.

33. On its same website, the Registrant uses the following metatags: "RFRK", "Real food for real kids", "Real food", "RFRK.com" and "RFRK Menu".

34. On March 2, 2015, the Complainant sent a letter to the Registrant asking it to cease the infringement of its intellectual property rights by using misleading domain names and to transfer these domains to the Complainant.

35. On March 17, the Registrant accepted in a response letter, to "take down the websites that are mere spoonerisms or not real words; namely, <RealFFoodforKids.ca> and <RealFoodforRealKidss.com>" in exchange for the following requests: The Registrant asked the Complainant to cease any comments or written material defaming or slandering the Registrant. Furthermore, the Registrant asked the Complainant to acknowledge that the Complainant used written material of the Registrant and accordingly asked the Complainant to cease using this material and destroy it. In addition, the Registrant asked the Complainant to pay 42,000.00\$ to the Registrant. The Registrant depicts the situation as if there was a broader conflict between the Registrant and the Complainant than only a dispute concerning domain names.

36. At the time the complaint was sent, the disputed domain names redirected their visitors to a pay-per-click holding page that seemingly was hosted by the registrar.

## PARTIES' CONTENTIONS

37. The Complainant alleges that:

- a) The Complainant had and continues to have three valid marks that predate the registration of the disputed domain names.

- i) According to paragraph 3.2(c) of the policy, because it has registered the trademark "REAL FOOD FOR REAL KIDS" with CIPO, and because the words elements of it are easily distinguishable, it shall be considered a mark for the purpose of this case.
  - ii) According to paragraph 3.2(b) (sic) of the policy, because it has proven by the deposit of substantive evidence that all three marks ("REAL FOOD FOR REAL KIDS", "RFRK" and "REAL FOOD LUNCH CLUB") have been used as trademarks in Canada for the purpose of distinguishing the Complainant's wares services or business, they shall be considered to be marks for the purpose of this case.
  - iii) As confirmed in the decision Canadian Employers Council / Conseil Canadian des Employeurs v. Walker Johnson, CIRA Case No. 00256 (March 20, 2014), unregistered common law rights are sufficient in these proceedings and so there ought to be no problem with the recognition of the Complainant's Marks.
  - iv) The Complainant's "REAL FOOD FOR REAL KIDS" trademark was registered with CIPO before the disputed domain names were registered.
  - v) All of the Complainant's Marks ("REAL FOOD FOR REAL KIDS", "RFRK" and "REAL FOOD LUNCH CLUB") had acquired the necessary reputation as demonstrated in the submitted substantial evidence, long before the disputed domain names were registered.
- b) The disputed domain names are confusingly similar to the Complainant's Marks.
- i) It is clear that the disputed domain <RealFFoodforKids.ca> is only a "typo squat" confusing with the Complainant's mark "REAL FOOD FOR REAL KIOS" by adding an extra "F" and the oblivion of the second "Real" in the same manner as the Registrant had registered <RealFoodforRealKidss.com > with two "s", only a week before, which

domain name has been transferred to the Complainant subsequently to the decision of the National Arbitration Forum on May 5, 2015.

- ii) Omitting the suffix ".ca", the disputed domain name <rfrk.ca> is identical to the Complainant's mark "RFRK", which is to say the least, confusingly similar.
  - iii) Omitting the suffix ".ca", the disputed domain name <Realfoodlunchclub.ca> is identical to the Complainant's mark "REAL FOOD LUNCH CLUB", which is again confusingly similar.
- c) The Registrant has no legitimate interest in any of the disputed domain names.
- i) In respect to Paragraph 3.1(b) of the policy, the registrant meets none of the six circumstances enumerated at Paragraph 3.4
  - ii) The Registrant has no other legitimate interest; the only interest the Registrant had was to mislead the visitors of the disputed domain names pages by redirecting them to its own website and when it got caught, to redirect them to pay-per-click advertisements pages hosted by the registrar.
  - iii) The intention to make financial gain by misleadingly attract the Complainant's customers, which is to say a competitor's customers or potential customers, consists of trading off the Complainant's Marks and is in no way a legitimate interest.
  - iv) The activity of directing Internet users to revenue-generating advertisements or links is not a legitimate interest.
  - v) The Registrant is not commonly identified by any of the marks used in the disputed domain names. The fact the Registrant paid 65\$ to register RFRK.CA as a business name with the government of Ontario is only part of a bad faith strategy to elaborate a bogus legitimate interest.

Furthermore, the domain name in itself cannot be seen as the commonly used identification name because it is itself confusing with the Complainant's Marks. The Registrant has never made business under "RFRK.ca", thus making it impossible to commonly identify it this way.

- vi) The fact that the Registrant has already been found responsible of cybersquatting activities against the Complainant, the fact that the theory of a coincidence does not make sense because of the Registrant knew the Complainant was its competitor, the fact the Registrant used the mark "RFRK" in its own website as metatags to mislead the Complainant's clients or potential clients, the fact that the Registrant had implicitly admitted its registrations were part of a "retribution" and finally the fact that it would make no sense for the Registrant to offer the sale of the domain name to the Complainant altogether prove the Registrant had no legitimate interest in the domain name <rfrk.ca>.
- d) The Registrant has registered the disputed domain names in bad faith.
- i) It is obvious that the registration of the disputed domain names by the Registrant was intended to disrupt the Complainant's competing business. The fact that the Registrant subsequently used the websites to redirect visitors to competing businesses only supports this assertion.
  - ii) The registration of the disputed domain names was clearly organized in order to create confusion with the Complainant's Marks, attempting to reach for commercial gains by attracting mislead customers. If not, the Registrant at the very least registered the disputed domain names with the intention to prevent the Complainant from registering them.
  - iii) The fact that the Registrant proposed the transfer of the disputed domain names in exchange of 42,000.00\$ to the Complainant, which is the owner of the marks, is a direct proof of bad faith. Moreover, the price asked by

the Registrant to the Complainant is clearly in excess of the Registrant's out of pocket expense.

- iv) The fact that the Registrant has already been found cybersquatting another Complainant's mark should be taken in consideration, leaning in favour of the recognition of the Registrant's bad faith.
- v) Finally, the use of a confusing domain name in order to redirect visitors to a pay-per-click site in itself creates confusion with the Complainant's Marks as to the source sponsorship, affiliation, or endorsement of the Registrant's website which is also in itself a circumstance proving bad faith.

38. The Registrant has not submitted any response to the Complainant's allegations.

#### RELIEF SOUGHT

39. The Complainant requests that the domain names be transferred from the Registrant to the Complainant.

#### CIRA DOMAIN NAME DISPUTE RESOLUTION POLICY

40. According to paragraph 4.1 of the Policy, in order to be successful, the Complainant must establish 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 section 3.5; and

(c) the Registrant has no legitimate interest in the domain name as described in section 3.4.

41. The Complainant must prove points (a) and (b) above on the balance of probabilities and for point (c) it must provide some evidence that the Registrant has no legitimate interest in the domain name.

42. Even if a Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the proceeding if he proves, on a balance of probabilities, that he has a legitimate interest in the Domain Name as described in paragraph 3.4 of the Policy.

43. The three elements in paragraph 4.1 are cumulative. They are considered below.

#### **A. Confusing Similarity**

44. For the request of the Complainant to be granted, the Complainant must first demonstrate that the Domain Names are confusingly similar to a mark in which the complainant had rights prior to the date of registration of the Domain Name and in which it continues to have such rights.

45. The Complainant has shown that it has registered the design trademark "REAL FOOD FOR REAL KIDS" with CIPO on August 9, 2006, in accordance with Paragraph 3.2 (c) of the Policy. Since all of the disputed domain names were registered in 2014, it is thus established that "REAL FOOD FOR REAL KIDS" trademark precedes the Domain Names registration date.

46. Even though the marks "REAL FOOD FOR REAL KIDS" (as a word mark), "RFRK" and "REAL FOOD LUNCH CLUB" are not registered trademarks, the Complainant has proven that they are marks under Paragraph 3.2 (a) since they have been used in Canada for the purpose of distinguishing the wares or services of the Complainant from those of others.

47. The Complainant has submitted extensive evidence not only as to the use of the three claimed marks, but also about their reputation and their recognition through different media reporter such as The Globe & Mail, the National Post, The Toronto Star and Macleans Magazine which seemingly acclaimed the quality of goods and services associated with the said marks . The usage of the brands "REAL FOOD FOR REAL KIDS", "RFRK" and "REAL FOOD LUNCH CLUB" in the Complainant's everyday business such as communication with clients, distribution of menus and recipe, and also on its websites <realfoodforrealkids.com> and <rfrk.com> demonstrates that the marks have been used in Canada for the purposes of distinguishing the wares and services offered by the Complainant's business. They still are: the Complainant has 78 full-time employees, and serves 20 schools, 120 daycares and 110 snack clubs on a daily basis. All three marks "REAL FOOD FOR REAL KIDS", "RFRK" and "REAL FOOD LUNCH CLUB" claimed by the Complainant shall accordingly be so recognized for the purpose of this decision in respect with Paragraph 3.2(a) of the Policy.

48. Paragraph 3.3 of the Policy states that in determining whether a domain name is "Confusingly Similar" to a Mark, the Panel shall only consider whether 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.

49. The applicable test to establish confusing similarity is based on a first impression and imperfect recollection.<sup>1</sup> In respect with subparagraph 1.2 of the Policy, the ".ca" suffix should be taken off the analysis. In the present case, the disputed domain names <rfrk.ca> and <realfoodlunchclub.ca> are precisely and exclusively composed of the marks "RFRK" and "REAL FOOD FOR LUNCH". Hence, <rfrk.ca> and <realfoodlunchclub.ca> are confusingly similar to the Complainant's "RFRK" and "REAL FOOD FOR LUNCH" marks.

50. The situation is a little bit more complex in the case of the domain name <realffoodforkids.ca > that, in the opinion of the Complainant, is confusingly similar

<sup>1</sup> *McKee Homes Ltd. v. Ger/inde Honsek, Resolution Canada*, Dispute No.:00079, par. 41.

to its mark "REAL FOOD FOR REAL KIDS". The Complainant contends the fact the two "f" letters after the word "real" in the domain name shall be seen as a "typo squat". It is true this modification is pretty minimal but it must be looked combined with the fact the second "real" from the mark is not present in the domain name. Because the applicable test consist of first impression and imperfect recollection, it is reasonable to believe someone would confuse, under such conditions, "real food for kids" with "real food for real kids". The two combinations of words and sound look very close to the same, but moreover mean approximately the same. If it is true that the association of the word "real" in front of the word "kids" is stylistic and even humoristic, it does not provide any strong meaning. At least, it does not produce a powerful enough mental image to the Mark as to say its withdrawal from the mark would prevent the confusing similarity that can be drawn from the expression "Real food for kids". The issue of the additional "f" as a "typo squat" appears not to have a considerable impact on this, as it is much more of a simple and efficient visual trap than anything else. Hence, under first impression and imperfect recollection, the disputed domain name <realfoodforkids.ca > is confusingly similar to the Complainant's mark "REAL FOOD FOR REAL KIDS".

51. Thus, all three domain names <rfrk.ca>, <realfoodforkids.ca > and <realfoodlunchclub.ca> are confusingly similar with the marks "RFRK", "REAL FOOD FOR REAL KIDS" and " REAL FOOD LUNCH CLUB", in which the Complainant had rights prior to the date of the registration of the disputed domain names and continues to have such Rights.

#### B. Legitimate Interest

52. If found to be proved by the Panel based on all evidence presented, any circumstance listed at Paragraph 3.4 of the Policy demonstrates the Registrant's legitimate interest in a domain name.

53. It is important to remember the Registrant has not presented any defence in the present case. It has however, responded to the Complainant's cease and desist letter. This response letter does not demonstrate the existence of any of the six circumstances listed at Paragraph 3.4. Rather, the Complainant has submitted some arguments explaining why the interests of the Registrant in the disputed domain names were expressly illegitimate.

s<sup>4</sup>. The Complainant has successfully demonstrated that the registrant intended to mislead visitors with the disputed domain names in order to redirect them either on its own website or on pay-per-click advertisement pages, which is in neither case a legitimate interest. As the Complainant correctly states it, under the present circumstances, directing users to revenue generating advertisements is not a good faith commercial activity, nor, obviously a legitimate non-commercial use.<sup>2</sup>

55. It appears to be clear from the fact that because the Complainant and the Registrant know each other as competitors, this activity consisted in nothing less than trading off the Complainant's Marks in order to make financial gain. The Complainant rightfully explained that the presence of the Complainant's Marks both explicitly on the Registrant website pages, but also in the form of metatags proves without a doubt the Registrant was totally aware that the Complainant was his direct competitor. He indubitably knew or should have known the disruptive consequences the registration of the disputed domain names would cause to the Complainant.

56. In its complaint, the Complainant also addressed the alleged efforts made by the Registrant to register RFRK.CA as a business name in Ontario. Although it has been mentioned in a letter from the Registrant to the Complainant dated on March 17, 2015 (Annex U) no formal piece of record has been produced as evidence and the description made by the parties are vague on the subject. In any case, it has not been proven that the Registrant is commonly identified by any of the marks used in the disputed domain names, as no satisfying evidence has been filed accordingly.

57. It must be said that the fact the Registrant has already been recognized responsible of cybersquatting activities against the Complainant in regard to other domain names does not prove the Registrant has no legitimate interest in the registration of the domain names pertinent to the present case. However, it does establish that the Registrant is capable of cybersquatting activities.

58. The cumulated facts that the (1) Registrant knew its competitor in the person of the Complainant, (2) that the Registrant used the Complainant's Marks on its website, (3) that the Registrant had implicitly admitted the registration of the disputed domain names were somehow part of a "retribution" against alleged defamation, and finally (4) The sale offer of the disputed domain names made by the Registrant to the Complainant all tend to prove the Registrant actually had no legitimate interest in the registration of the disputed domain names.

59. Hence, the Complainant has proven to the Panel that the Registrant has no legitimate interest in the disputed domain names.

### **C. Bad Faith**

60. For the Complaint to be founded, the Complainant has to convince the Panel that the domain names were registered in bad faith. Any circumstance listed at Paragraph 3.5 of the Policy, if found to be proved, constitutes bad faith.

61. Sub-paragraph 3.5(a) states that bad faith is established if the Registrant registered the domain name primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant or its competitors for valuable consideration in excess of the registration and transfer costs.

62. In the present case, the Complainant has proven that the Registrant tried to exchange disputed domain names in exchange for 42,000.00\$. It is difficult though, to evaluate if the proposed sale was the primary purpose of the registration of the

domain names intended by the Registrant. The examination of the other grounds of bad faith as identified in Paragraph 3.5 will help nourish the present analysis.

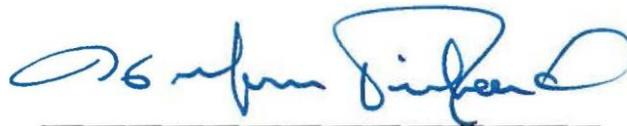
63. Sub-paragraph 3.5(c) recognizes as evidence of bad faith the registration of a domain name done primarily for the purpose of disrupting the business of the Complainant, who is a competitor of the Registrant. The Complainant contends that the fact the Registrant used the disputed domain names to redirect visitors on the Registrant's own competing businesses websites constitutes a clear intention to disrupt the Complainant's business. As it has been explained before, competition between the Registrant and the Complainant was well known to the Registrant, and the usage of the latter made of the domain names is indeed an attempt at disrupting a competitor's business and thus, strongly leans in favour of recognizing bad faith.
64. Sub-paragraph 3.5(d) of the Policy considers as evidence of bad faith a Registrant that has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website by creating a likelihood of confusion with the Complainant's Marks as to the source, sponsorship, affiliation or endorsement of the Registrant's website.
65. The use of strategies such as "typo squats", and the inclusion of the Complainant's Marks in the Registrant's website metatags directly show the Registrant had the intention to attract visitors by the confusion it has created in link with the Complainant's Marks as to the source, sponsorship, affiliation or endorsement of the Registrant's website. Indeed, all of this was made in a competitive business context and the intention to reach financial gain is self-evident. The fact that the Registrant also used the disputed domain names to redirect visitors to pay-per-click advertisements pages is another aggravating factor, as it creates confusion directly for the purpose of financial gain. The evidence submitted by the Complainant clearly demonstrates the Registrant had the intention to cause confusion with the Complainant's Marks aiming to reach financial gain by doing so. Hence it is clear the Registrant has acted in the manner described at Sub-paragraph 3.5(d) of the Policy.

66. Hence, in light of paragraph 3.5 of the Policy, the Panel concludes that the Registrant has registered the disputed domain names in bad faith.

#### CONCLUSION AND DECISION

67. In conclusion, the Panel recognizes the rights of the Complainant in the Marks "REAL FOOD FOR REAL KIDS", "RFRK" and "REAL FOOD LUNCH CLUB"; it also recognizes that those rights existed before the Registrant registered the disputed domain names. Moreover, the Panel is satisfied by the evidence (1) that the disputed domain names are confusingly similar to the Complainant's Marks, (2) that the Registrant does not have any legitimate interest in the domain names, and finally (3) that the Registrant has registered the disputed domain names in bad faith.

68. Consequently, in respect with paragraph 4.3 of the Policy, the Panel orders that the registration of the disputed domain names <frk.ca>, <realfoodforkids.ca> and <realfoodlunchclub.ca> be transferred from the Registrant to the Complainant.



Hugues G. Richard

Dated: July 8, 2015