



## NATIONAL ARBITRATION FORUM

### DECISION

Big Canoe Company, LLC v. Daniel J. Elliot  
Claim Number: FA0609000799382

#### PARTIES

Complainant is **Big Canoe Company, LLC** (“Complainant”), represented by **Robin L. McGrath**, of **Alston & Bird, LLP**, 1201 West Peachtree Street, Atlanta, GA 30309, USA. Respondent is **Daniel J. Elliot** (“Respondent”), represented by **W. Scott Creasman**, of **Powell Goldstein, LLP**, 1201 W. Peachtree Street, Atlanta, GA 30309.

#### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**bigcanoerealestate.net**>, registered with **Melbourne It, Ltd.** d/b/a **Internet Names Worldwide**.

#### PANEL

The undersigned certifies that she has acted independently and impartially and to the best of her knowledge has no known conflict in serving as Panelist in this proceeding.

Linda M. Byrne as Panelist.

#### PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on September 20, 2006; the National Arbitration Forum received a hard copy of the Complaint on September 22, 2006.

On September 21, 2006, Melbourne It, Ltd. d/b/a Internet Names Worldwide confirmed by e-mail to the National Arbitration Forum that the <**bigcanoerealestate.net**> domain name is registered with Melbourne It, Ltd. d/b/a Internet Names Worldwide and that the Respondent is the current registrant of the name. Melbourne It, Ltd. d/b/a Internet Names Worldwide has verified that Respondent is bound by the Melbourne It, Ltd. d/b/a Internet Names Worldwide registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On September 28, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of October 18, 2006 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts, and to postmaster@bigcanoerealestate.net by e-mail.

A timely Response was received and determined to be complete on October 18, 2006.

Complainant submitted an Additional Submission, the electronic copy of which was submitted by the deadline, while the hard copy of the Submission was received after the deadline.

Respondent submitted a response to Complainant’s Additional Submission, which was timely.

On October 30, 2006, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Linda M. Byrne as Panelist.

## RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

## PARTIES' CONTENTIONS

### A. Complainant

The Complainant argues that <**bigcanoerealestate.net**> is confusingly similar with a trademark used and registered by Complainant, Big Canoe Company, LLC.

The Complainant contends that the Respondent has no *bona fide* rights or legitimate interests in respect of the <**bigcanoerealestate.net**> domain name, because Respondent's domain name diverts computer users to Respondent's site, because Respondent is not authorized to use the BIG CANOE name by Complainant, and because Respondent's business name does not include the words "Big Canoe."

Complainant contends that Respondent's registration and use of the <**bigcanoerealestate.net**> domain name is in bad faith, because Respondent's site attracts Internet users to its commercial website based on confusion with Complainant's mark.

### B. Respondent

Respondent argues that the Complainant does not have enforceable rights in the term "Big Canoe," because it is geographically descriptive of a geographic location in Georgia.

Respondent asserts that it owns rights or legitimate business interests in the <**bigcanoerealestate.net**> domain name, because Respondent registered the domain name almost two years before being notified of the "Big Canoe" domain name dispute. Respondent also maintains that the domain name merely describes the fact that Respondent sells real estate in Big Canoe, Georgia.

Respondent maintains that its good faith is evidenced by the disclaimer on its website indicating that the Respondent is not affiliated with the Complainant. Respondent also argues that it has not acted in bad faith because of the geographically descriptive nature of "Big Canoe." Finally, Respondent argues that Complainant's attempt to "stomp out legitimate competition" by initiating this UDRP action constitutes reverse domain name hijacking.

### C. Additional Submission

Complainant submitted an additional submission arguing that Respondent has not established that "Big Canoe" is a geographically descriptive mark. The additional submission attached a trademark license agreement in which Complainant licensed the BIG CANOE trademark to Big Canoe Property Owners' Association, Inc.

Respondent submitted an additional submission arguing that "Big Canoe" is a geographic location in Georgia. Respondent cited the following decisions as involving the "exact situation presented here: *Deer Valley Resort Co. v. Intermountain Lodging*, FA 471429 (Nat. Arb. Forum June 21, 2005); and *Deer Valley Resort Co. v. Intermountain Lodging*, FA 474344 (Nat. Arb. Forum June 27, 2005). Respondent stated that the addition of the terms "real estate" in Respondent's domain name is sufficient to distinguish the domain name from Complainant's BIG CANOE mark. The additional submission attached one declaration to the effect that Complainant's real estate agents has listed a property's address as "Big Canoe, Georgia" on many occasions; and another declaration to the effect that Complainant had settled a dispute concerning the term "Big Canoe" by agreeing that a third-party real estate firm would use the term "Big Canoe, Georgia," rather than simply "Big Canoe."

## FINDINGS

Complainant is the developer and owner of a private residential community called BIG CANOE. Development of the BIG CANOE community began in 1972, when Complainant's predecessor purchased undeveloped land on which the community was to be built. The land on which the community was developed had never been known as BIG CANOE before 1972.

BIG CANOE is a private community and not a city or incorporated municipality. The BIG CANOE community is "governed" by the Big Canoe Property Owners Association ("POA"), which uses the BIG CANOE mark pursuant to a written license agreement with Complainant. For a period of time, the U.S. Postal Service agreed to recognize mail addressed to "Big Canoe, Georgia," and thereafter began issuing Big Canoe, Georgia addresses to the residents of the BIG CANOE community. More recently, the Post Office has since stopped this practice, apparently in response to Complainant's notification of its trademark rights in the term BIG CANOE. Today, new addresses in the Big Canoe community are issued as Jasper, Georgia, rather than as Big Canoe, Georgia.

Complainant's business involves the sale of real estate within the gates of BIG CANOE development. Since at least as early as 1993, Complainant's real estate arm has used the service marks BIG CANOE and BIG CANOE REALTY in connection with the real estate services it provides. Complainant has invested millions of dollars advertising its development and real estate services through billboards, television, radio, direct mail, newspaper inserts, magazines, shows and fairs. For the past three years, Complainant's advertising budget has exceeded 1 million dollars annually. Complainant owns the domain names <bigcanoe.com>, <bigcanoe.net>, <bigcanoerealty.net>, <bigcanoerealty.com>, <lifeatbigcanoe.com>, and <housesatbigcanoe.com>.

Complainant owns federal registrations for the BIG CANOE mark, including U.S. Reg. No. 1,521,251 for BIG CANOE & Design, issued on January 17, 1989, in connection with "development services, namely planning and laying out residential and commercial communities." That registration, in which the words BIG CANOE are not disclaimed, is incontestable thereby preventing third parties from challenging this mark as geographically descriptive. Complainant also owns U.S. Reg. No. 2,886,872 for the mark BIG CANOE. ABSOLUTE PROOF THAT WHERE YOU LIVE CAN MAKE A DIFFERENCE IN HOW YOU LIVE in connection with "real estate brokerage services." On August 4, 2006, Complainant filed two federal applications for the marks BIG CANOE (Serial No. 78945130) and BIG CANOE REALTY (Serial No. 78945141). The BIG CANOE application claims a 1972 date of first use, and the BIG CANOE REALTY application claims a 1993 date of first use.

Respondent is the owner of Independent Broker Associates ("IBA"), a real estate company that directly competes with Complainant in the offering of real estate within the BIG CANOE community. Respondent registered <**bigcanoerealestate.net**> on November 22, 2004, and uses that Domain Name in connection with a website selling real estate both in the BIG CANOE community and communities other than BIG CANOE.

On July 24, 2006, Complainant's counsel sent a letter to Respondent explaining its rights and requesting a transfer of the Domain Name. Respondent replied on August 7, 2006, asserting that BIG CANOE was geographically descriptive and refusing to transfer the domain name. By letter dated August 18, 2006, Complainant communicated that BIG CANOE was not geographically descriptive, that Respondent's use of the mark was likely to cause consumer confusion, and once again requested a transfer. In response, Respondent stated that BIG CANOE is a "recognized city in Georgia" and again refused to transfer the domain name.

## DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) instructs this Panel to “decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) (2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) (3) the domain name has been registered and is being used in bad faith.

### **Identical and/or Confusingly Similar**

In view of Complainant’s U.S. registrations for BIG CANOE and related marks, this Panel finds that Complainant has demonstrated rights pursuant to Policy ¶ 4(a)(i). *See Innomed Techs., Inc. v. DRP Servs.*, FA 221171 (Nat. Arb. Forum Feb. 18, 2004) (“Registration of the NASAL-AIRE mark with the USPTO establishes Complainant’s rights in the mark.”); *see also Vivendi Universal Games v. XBNetVentures Inc.*, FA 198803 (Nat. Arb. Forum Nov. 11, 2003) (“Complainant’s federal trademark registrations establish Complainant’s rights in the BLIZZARD mark.”).

This Panel concludes that the term BIG CANOE is not geographically descriptive. Before the development of the Big Canoe gated community in 1972, there was no geographic location known as “Big Canoe.” Although the Post Office evidently delivers mail to “Big Canoe, Georgia” addresses, the use of these addresses is being discontinued, and any geographic significance to the term “Big Canoe” developed after Complainant began to use the term as a service mark. *See Bonaventure Assoc. v. The Flyer Publ’g Corp.*, 621 F.Supp. 107, 190 (S.D. Fla. 1985); *see also Pebble Beach Co. v. Tour 18, I, Ltd.*, 942 F.Supp. 1513, 1539 (S.D. Tex. 1996); *see also Prestwick, Inc. v. Don Kelly Bldg. Co.*, 302 F.Supp. 1121, 1124 (D. Md. 1969). Moreover, Complainant’s extensive use of the BIG CANOE mark for over thirty years has caused the term to have acquired distinctiveness. *See City of Hamina v. Paragon Int’l Projects Ltd.*, D2001-0001 (WIPO March 12, 2001) (“Port of Hamina has acquired distinctiveness and become established in the meaning of the Trademarks Act as a trademark/service mark relating to services originating from the City of Hamina/Port of Hamina.”); *see also Horseshoe Bay Resort Sales Co. v. Lake Lyndon B. Johnson Improvement Corp.*, 53 S.W.3d 799, 807 (Tex. App. 2001) (holding that the HORSESHOE BAY mark was not geographically descriptive, despite the fact that the community had its own post office, because the mark was arbitrary and was coined by the development company and was not used previously at that geographic site).

The disputed domain name is essentially identical to Complainant’s mark. The disputed domain name includes Complainant’s mark in its entirety coupled with the words “real estate,” which are clearly descriptive of Complainant’s business. *See Oki Data Ams., Inc. v. ASD, Inc.*, D2001-0903 (WIPO Nov. 6, 2001) (“[T]he fact that a domain name wholly incorporates a Complainant’s registered mark is sufficient to establish identity [sic] or confusing similarity for purposes of the Policy despite the addition of other words to such marks.”); *see also Am. Online, Inc. v. Anytime Online Traffic Sch.*, FA 146930 (Nat. Arb. Forum Apr. 11, 2003) (finding that the respondent’s domain names, which incorporated the complainant’s entire mark and merely added the descriptive terms “traffic school,” “defensive driving,” and “driver improvement” did not add any distinctive features capable of overcoming a claim of confusing similarity); *see also Space Imaging LLC v. Brownell*, AF-0298 (eResolution Sept. 22, 2000) (finding confusing similarity where the respondent’s domain name combines the complainant’s mark with a generic term that has an obvious relationship to the complainant’s business).

The *Deer Valley* cases cited by Respondent are distinguishable. In those cases, the term “Deer Valley” was determined to be geographically descriptive and diluted. Indeed, the term “Deer Valley” was a geographic area that had been identified and referred to as such by the local populace for a number of years before Complainant’s registration of the mark. In this situation, however, the Complainant’s use and registration of BIG CANOE predated the use of this term as the name of a geographical area by several years.

In the *Deer Valley* cases, each panel found that the addition of certain words (“condos” and “lodging” in the <deervalleycondos.us> and <deervalleylodging.info> domain names) was enough to distinguish the domain names from the DEER VALLEY trademark. The BIG CANOE situation is different. Here, the additional words (“real estate”) do not serve the same purpose because Complainant provides real estate services. Rather than helping to distinguish between the two parties, the words “real estate” exacerbate the likelihood of confusion. In the DEER VALLEY cases, the Complainant did not provide condo or lodging services; in this situation, the Complainant provides real estate services.

This Panel finds that the <**bigcanoerealestate.net**> domain name is confusingly similar to Complainant’s BIG CANOE mark. This Panel therefore concludes that Complainant has satisfied Policy ¶ 4(a)(i).

### **Rights or Legitimate Interests**

The evidence on record, including Respondent’s WHOIS information, does not indicate that Respondent is commonly known by the <**bigcanoerealestate.net**> domain name. *See Brown v. Sarrault*, FA 99584 (Nat. Arb. Forum Oct. 16, 2001) (finding that the respondent was not commonly known by the <mobilitytrans.com> domain name because it was doing business as “Mobility Connections”); *see also Gallup, Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that the respondent does not have rights in a domain name when the respondent is not known by the mark).

Moreover, this Panel concludes that Respondent has not used the <**bigcanoerealestate.net**> domain name in connection with either a *bona fide* offering of goods or services in accord with Policy ¶ 4(c)(i), or a legitimate noncommercial or fair use under Policy ¶ 4(c)(iii). The disputed domain name was registered by Respondent after Complainant had used the mark “BIG CANOE” in association with its services for several decades.

While Respondent’s real estate business is in and of itself legitimate, the use of Complainant’s mark in Respondent’s <**bigcanoerealestate.net**> domain name is not legitimate. Respondent bases its argument for rights or legitimate interests on the assumption that BIG CANOE is geographically descriptive. However, Respondent’s use of the disputed domain name cannot be in connection with a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i), or a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii), because the disputed domain name is confusingly similar to Complainant’s mark, thus, making any competing use by Respondent illegitimate. Respondent lacks rights or legitimate interests because Respondent is not using the disputed domain name in a manner allowed under Policy ¶ 4(c)(i) or Policy ¶ 4(c)(iii). *See Coryn Group, Inc. v. Media Insight*, FA 198959 (Nat. Arb. Forum Dec. 5, 2003) (finding that the respondent was not using the domain names for a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use because the respondent used the names to divert Internet users to a website that offered services that competed with those offered by the complainant under its marks).

### **Registration and Use in Bad Faith**

This Panel concludes that Respondent is using the disputed domain name to disrupt Complainant’s business, which is evidence of bad faith registration and use pursuant to Policy ¶ 4(b)(iii). Internet users

who are trying to find Complainant's website in order to find information about the BIG CANOE development or to engage in real estate transactions with Complainant may be directed to Respondent's website. This situation may result in lost business for Complainant. The disclaimer on Respondent's website is not sufficient to overcome the potential for the website to confuse Internet users, especially in light of the inclusion of statements such as "Visit Us in Big Canoe" and "Be Our Guest in Big Canoe."

In view of this situation, this Panel concludes that Respondent has disrupted Complainant's business, and has evidenced bad faith registration and use pursuant to Policy ¶ 4(b)(iii). *See Surface Prot. Indus., Inc. v. Webposters*, D2000-1613 (WIPO Feb. 5, 2001) (finding that, given the competitive relationship between the complainant and the respondent, the respondent likely registered the contested domain name with the intent to disrupt the complainant's business and create user confusion); *see also Toyota Jidosha Kabushiki Kaisha v. S&S Enters. Ltd.*, D2000-0802 (WIPO Sept. 9, 2000) ("Registration of a domain name [by the respondent that incorporates another's trademark] goes further than merely correctly using in an advertisement the trade mark of another in connection with that other's goods or services.").

The confusing similarity between the <**bigcanoerealestate.net**> domain name and Complainant's BIG CANOE mark makes it likely that Internet users will mistakenly believe that Complainant is in some way the sponsor of or affiliated with Respondent's website. The Panel therefore finds that Respondent's registration of the disputed domain name evidences bad faith registration and use pursuant to Policy ¶ 4(b)(iv). *See Amazon.com, Inc. v. Shafir*, FA 196119 (Nat. Arb. Forum Nov. 10, 2003) ("As Respondent is using the domain name at issue in direct competition with Complainant, and giving the impression of being affiliated with or sponsored by Complainant, this circumstance qualifies as bad faith registration and use of the domain name pursuant to Policy ¶ 4(b)(iv)."); *see also Am. Univ. v. Cook*, FA 208629 (Nat. Arb. Forum Dec. 22, 2003) ("Registration and use of a domain name that incorporates another's mark with the intent to deceive Internet users in regard to the source or affiliation of the domain name is evidence of bad faith.").

### **Reverse Domain Name Hijacking**

The Respondent charged the Complainant with reverse domain name hijacking in this case. In order to prove the existence of reverse domain name hijacking, Respondent must demonstrate that the Complainant brought the claim in bad faith despite the knowledge that the Respondent has an unassailable right or legitimate interest in the disputed domain name, or that the Respondent lacks the requisite bad faith registration and use of the disputed domain name. *Koninklijke KPN N.V. v. Telepathy Inc.*, D2001-0217 (WIPO May 7, 2001). The panel in *Verkaik v. Crownonlinemedia.com*, D2001-1502 (WIPO Mar. 19, 2002), also emphasized the necessity that the respondent prove that the complainant had knowledge of the respondent's rights in the disputed domain name to establish reverse domain name hijacking. The *Verkaik* panel stated that, "to establish reverse domain name hijacking, respondent must show knowledge on the part of the complainant of the respondent's right or legitimate interest in the Domain Name and evidence of harassment or similar conduct by the complainant in the face of such knowledge."

This Panel concludes that there is no evidence that Complainant had knowledge of Respondent's unassailable rights in the disputed domain name. This Panel therefore concludes that the Complainant did not engage in reverse domain name hijacking.

In summary, this Panel concludes that <**bigcanoerealestate.net**> is confusingly similar to Complainant's trademark BIG CANOE, that Respondent has demonstrated no legitimate rights in the domain name, and that Respondent has registered and used the domain name in bad faith.

## **DECISION**

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <**bigcanoerealestate.net**> domain name be **TRANSFERRED** from Respondent to Complainant.

Linda M. Byrne, Panelist  
Dated: November 17, 2006