

**IN THE MATTER OF A COMPLAINT MADE PURSUANT TO THE CANADIAN
INTERNET REGISTRATION AUTHORITY DOMAIN NAME DISPUTE
REGISTRATION RESOLUTION POLICY (v 1.3) AND RULES (v 1.5)**

Complainants: Cathay Pacific Airways Limited
550 West 6th, Unit 500
Vancouver, B.C., V5Z 4S2
Canada
Telephone: 415-982-3242
("Cathay Canada")

and

Cathay Pacific Airways Limited
33th Floor One Pacific Place
88 Queensway
Hong Kong
Telephone: +852.28408869
("Cathay Hong Kong")

(collectively the "Complainants")

**Complainants' Authorized
Representative:**

CSC Digital Brand Services AB
UDRP Coordinator
Saltmatargatan 7
113 59 Stockholm
Sweden
Attention: Amy L.
Tel: 302-636-5401 x60555
Fax: 302-636-5454
Email: udrp@cscglobal.com

Registrant:

John Dieleman
Rue Pasteur
Cabourg, 14390
France
Attention: John Dieleman
Email: johndieleman1@outlook.com

(the "Registrant")

Disputed Domain Name:

cathaydragon.ca
(the "Domain Name")

Registrar: HEXONET Services Inc.

Single Member Panel: R. John Rogers

Service Provider: British Columbia International
Commercial Arbitration Centre (the “BCICAC”)

BCICAC File: DCA-1841-CIRA

PROCEDURAL HISTORY

The BCICAC is a recognized service provider pursuant to the Domain Name Dispute Resolution Policy (v 1.3) (the “Policy”) and Rules (v 1.5) (the “Rules”) of the Canadian Internet Registration Authority.

On July 5, 2016, Cathay Canada filed a complaint (the “Previous Complaint”) with the service provider Resolution Canada Inc. seeking to have the Domain Name transferred from the Registrant to it. In a decision dated August 15, 2016, the panel appointed to hear the Previous Complaint dismissed it on the grounds that the Domain Name was not confusingly similar to a Mark in which Cathay Canada had rights prior to the date of the registration of the Domain Name. However, in arriving at its decision, this panel specified that its decision was made without prejudice to Cathay Canada seeking further relief under the Policy by way of alleging rights in a Mark based on a trade name rather than upon trademarks in which it claimed to have rights.

The Complainants filed a subsequent complaint dated January 4, 2017 (the “Complaint”) with the BCICAC seeking an order in accordance with the Policy and the Rules directing that registration of the Domain Name be transferred from the Registrant to Cathay Canada.

The BCICAC determined the Complaint to be in administrative compliance with the requirements of Rule 4.2 and, by letter of transmittal dated January 5, 2017 (the “Transmittal Letter”), forwarded a copy of the Complaint to the Registrant to serve as notice of the Complaint in accordance with Rules 2.1 and 4.3. The Transmittal Letter determined the date of the commencement of proceedings in accordance with Rule 4.4 to be January 5, 2017. The Transmittal Letter advised the Registrant that in accordance with the provisions of Rule 5, a Response to the Complaint was to be filed within 20 days of the date of commencement of proceedings, or January 25, 2017.

The Transmittal Letter was sent to the Registrant by email to the email address johndieleman1@outlook.com.

By a letter dated January 27, 2017 delivered by email, with a copy sent to the Registrant by email, the BCICAC advised the Complainants that as the BCICAC had not received a Response to the Transmittal Letter by January 25, 2017 as required by Rule 5.1, that pursuant to Rule 6.5 the Complainants had the right to elect that the panel in this matter be converted from a three member panel to a single member panel.

The Complainants so elected and the undersigned was appointed by the BCICAC as the Single Member Panel by letter dated January 30, 2017, copies of which letter were sent by email to both the Complainants and to the Registrant. The undersigned has confirmed to the BCICAC that he can act impartially and independently as the Single Member Panel in this matter.

The undersigned determines that he has been properly appointed and constituted as the Single Member Panel to determine the Complaint in accordance with the Rules.

CANADIAN PRESENCE REQUIREMENTS

The Canadian Presence Requirements for Registrants v 1.3 (“Presence Requirements”) require that to be permitted to apply for registration of, and to hold and maintain the registration of, a .ca domain name, the applicant must meet at least one of the criteria listed as establishing a Canadian presence. Section 2(d) of the Presence Requirements specifies that a corporation incorporated under the laws of Canada or any province or territory of Canada has the requisite Canadian presence.

Cathay Canada is a Canadian corporation with a Canadian address. Cathay Canada therefore meets the Canadian presence requirements and is, therefore, an eligible complainant pursuant to section 1.4 of the Policy.

Section 1.4 of the Policy requires a complainant to satisfy the Presence Requirements unless the complaint relates to a trade-mark registered in the Canadian Intellectual Property Office (“CIPO”) and the complainant is the owner of that trade-mark. As is set out below, the Complaint relates to trade-marks registered in the CIPO and owned by Cathay Hong Kong.

Therefore, Cathay Hong Kong is, as well, an eligible complainant.

ALL TECHNICAL REQUIREMENTS MET

Based upon the information provided by the BCICAC, I find that all technical requirements for the prosecution of this proceeding have been met.

FACTS OFFERED BY THE COMPLAINANTS

The facts put forward by the Complainants might be summarized as follows:

1. Founded in 1946 Cathay Hong Kong is a Hong Kong based airline with 23,000 employees offering scheduled passenger and cargo services to 173 destinations in Asia, North America, Australia, Europe and Africa using a fleet of more than 140 wide body aircraft. With 2015 revenues totaling HK\$102,342 million, Cathay Hong carried 34,065,0000 passengers and 1,798,000 tons of cargo.

2. Cathay Canada is a wholly owned subsidiary of Cathay Hong Kong and is the vehicle through which Cathay Hong Kong carries on its business in Canada.
3. Hong Kong Dragon Airlines Limited (“Dragonair”), is, as well, a wholly owned subsidiary of Cathay Hong Kong and was established in 1985 as a vehicle to enable Cathay Hong Kong to specifically service the Asia Pacific region.
4. Cathay Hong Kong is the owner of the trade-mark CATHAY PACIFIC registered in Hong Kong, China, the EU and the US; and in Canada with the CIPO under No. TMA291165 and No. TMA445392. Under this trade-mark, Cathay Hong Kong has since 1946 offered a wide range of products and services related to air passenger and cargo air transport.
5. Dragonair is the owner of the trade-mark DRAGONAIR registered in Hong Kong and the US; and in Canada with the CIPO under No. TMA753633.
6. Cathay Hong Kong is the owner of the domain names “cathaypacific.com” and “cathaydragon.com”. The website “cathaypacific.com” in March 2016 received an average of almost 300,000 unique visitors.
7. As Cathay Hong Kong’s Canadian office, Cathay Canada is authorized to use and enforce in Canada the trade-marks CATHAY PACIFIC and DRAGONAIR (collectively “the Trade-Marks”) together with any trade names used by Cathay Hong Kong or Dragonair.
8. In addition, the domain name “cathaypacific.ca” is registered in the name of Cathay Canada.
9. On January 28, 2016, Cathay Hong Kong announced that Dragonair would be rebranded as CATHAY DRAGON and would continue to operate as an airline under its own license separate to that airline operated by Cathay Hong Kong.
10. On January 28, 2016, Cathay Hong Kong made application to the CIPO under application #1765478 to file the trade-mark CATHAY DRAGON and the accompanying brush wing design. As well on that date, Cathay Hong Kong has applied for registration for this trade-mark in Hong Kong, China, the EU and the US.
11. On January 30, 2016, the Domain Name was registered by the Registrant.

FACTS OFFERED BY THE REGISTRANT

As was noted above, the Registrant has not responded to the Complaint.

REMEDIES SOUGHT

The Complainants seek an order from the Panel in accordance with paragraph 4.3 of the Policy instructing the Registrar of the Domain Name to transfer the Domain Name to Cathay Canada.

THE POLICY

The purpose of the Policy as stated in paragraph 1.1 of the Policy is to provide a forum in which cases of bad faith registration of .ca domain names can be dealt with relatively inexpensively and quickly.

Paragraph 4.1 of the Policy puts the onus on the Complainants to demonstrate this “bad faith registration” by proving on a balance of probabilities that:

1. a trade-mark or trade name owned by the Complainants qualifies as a “Mark” as this term is defined in paragraph 3.2 of the Policy;
2. the Complainants had “Rights” in the Mark prior to the date of registration of the Domain Name and continues to have “Rights” in the Mark,
3. the Domain Name is “Confusingly Similar” to the Mark as the concept of “Confusingly Similar” is defined in paragraph 3.3 of the Policy;
4. the Registrant has no “legitimate interest” in the Domain Name as the concept of “legitimate interest” is defined in paragraph 3.4 of the Policy; and
5. the Registrant has registered the Domain Name in “bad faith” in accordance with the definition of “bad faith” contained in paragraph 3.5 of the Policy.

If the Complainants are unable to satisfy this onus, bad faith registration is not demonstrated and the Complaint fails.

MARK

In the matter at hand, the relevant portion of paragraph 3.2 of the Policy states that for the purpose of the Policy a “Mark” is:

- (a) a trade-mark, including the word elements of a design mark, or a trade name that has been used in Canada by a person, or the person’s predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person;

According to the Canadian Foreign Air Operator Certificate issued by the Canadian Department of Transport, Cathay Hong Kong has been operating in Canada since at least October 10, 1996, a date well before the registration of the Domain Name. In the course of this operation, the Complainants have used one or more of the Trade-Marks in Canada to distinguish their provision of wares, services or business from another provider of similar wares, services or business.

The Complainants continue to use the Trade-Marks.

The Trade-Marks clearly qualify as a “Mark” pursuant to paragraph 3.2(a) of the Policy.

As was announced by Cathay Hong Kong on January 28, 2016, Dragonair was being rebranded as “CATHAY DRAGON”. From that date, the Complainants were carrying on the business formerly carried on in Canada under the name “Dragonair” under the new trade name of “CATHAY DRAGON” (the “Trade-Name”).

Therefore, from at least January 28, 2016, the Trade-Name, as well, qualifies as a “Mark” pursuant to paragraph 3.2(a) of the Policy.

RIGHTS

Paragraph 3.1(a) of the Policy requires that the Complainants have “Rights” in the Trade-Marks and Trade-Name and that these “Rights” existed prior to the date of registration of the Domain Name and continue to the present date. Unfortunately, this term “Rights” is not defined in the Policy.

Given the evidence before me of Cathay Hong Kong’s ownership and the use by both Cathay Hong Kong and Cathay Canada of the Trade-Marks and the Trade-Name (collective the “Brands”) in Canada, I find that for the purpose of paragraph 3.1(a) of the Policy, the Complainants had Rights in the Brands prior to registration of the Domain Name and that these Rights continue to the present date.

CONFUSINGLY SIMILAR

Policy paragraph 3.3 provides that the Domain Name will be found to be “Confusingly Similar” to the Brands only if the Domain Name so nearly resembles the Brands in appearance, sound or the ideas suggested by the Brands as to be likely to be mistaken for the Brands.

The Domain Name consists of some of the words contained in the Trade-Marks and consists of the same words included in the Trade-Name. The Domain Name, as well, includes the .ca suffix. As paragraph 1.2 of the Policy defines the Domain Name for the purpose of this proceeding to exclude the .ca suffix, the portion of the Domain Name consisting of “cathaydragon” is the portion relevant for consideration.

Therefore, to satisfy the onus placed upon it by the Policy, the Complainants must demonstrate that the “cathaydragon” portion of the Domain Name so nearly resembles one or more of the Brands in appearance, sound or the ideas suggested by the Brands so as to be likely to be mistaken for this identifier.

Even with the exclusion of the .ca suffix, a direct comparison with the Trade-Marks is a challenge. Firstly, the Domain Name is not a direct copy of one of the Trade-Marks, but rather is a combination of words of which the Trade-Marks consist. Secondly, the trade-mark DRAGONAIR is a combination of two words, only one of which, the word “dragon” is used in the Domain Name.

With respect to the Trade-Name, the Domain Name is not an exact copy as the Trade-Name includes a space between the words “cathay” and “dragon”. However, it is clear from decisions of other panels that where, apart from the omission of a space, a trade-name uses the same words as the domain name under consideration, the domain name and the trade name are considered “identical”. See for example, *Discovery Toys, Inc. v. Ebenezer Therasagayam* (CIRA Dispute

Resolution Decision # 00118), and *Extreme Fitness Inc. v. Gutam Relan* (CIRA Dispute Resolution Decision # 0019).

As other panels have determined, the test for “Confusingly Similar” in paragraph 3.3 of the Policy is not one requiring that the Trade-Marks are exactly the same as the Domain Name. Rather, the test is one of resemblance based upon first impression and imperfect recollection. Similarly, other decisions have determined that the inclusion of additional words will not prevent a domain name to be confusingly similar to a trade-mark. See for example, *Re: governmentofcanada.ca et al.* CDRP 00011 (BCICAC 27 May 2003) and *Re: nationalcarhire.ca* CIRA-CDRP 00288 (BCICAC 27 July 2015).

The Complainants submit that the Domain Name can be considered to combine the dominant elements of the Trade-Marks, namely “Cathay” and “Dragon”, and suggest that where the Domain Name combines these two dominant elements, the Domain Name can be found to be confusingly similar to the Trade-Marks. Similarly, the Complainants submit that as the Domain Name consists of a mere combination of the Trade-Marks, that the Domain Name must be found confusingly similar to the Trade-Marks.

The Complainants further submit that there is considerable risk that the public will perceive the Domain Name as being associated with the Complainants and that the Registrant is deliberately exploiting the goodwill and images of the Trade-Marks which might result in dilution and other damage to them.

I agree with the Complainants that notwithstanding the fact that the Domain Name consists of a combination of the dominant elements of the Trade-Marks that there is a strong likelihood of confusion. However, I find that I do not need to make a determination with respect to the Trade-Marks as I find that the Domain Name so nearly resembles the Trade-Name in appearance, sound or the ideas suggested by the Trade-Name as likely to be mistaken for the Trade-Name.

I therefore find that the Complainants have satisfied the onus placed upon them by paragraph 3.3 of the Policy and have demonstrated that the Domain Name so nearly resembles the Trade-Name in appearance, sound or the ideas suggested by the Trade-Name as to be likely mistaken for the Trade-Name

NO LEGITIMATE INTEREST

Paragraph 4.1 of the Policy requires that to succeed in the Complaint, the Complainants must provide some evidence that the Registrant has no legitimate interest in the Domain Name as the concept of “legitimate interest” is provided for in paragraph 3.4 of the Policy.

Paragraph 3.4 of the Policy provides that the Registrant has a legitimate interest in a domain name if:

- 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.

In paragraph 3.4(d) "use" by the Registrant includes, but is not limited to, use to identify a web site.

It is to be noted that in paragraphs 3.6(a), (b), (c), and (d), there is a requirement that the Registrant used the Domain Name "in good faith". The evidence before me, as referenced below, is that the Registrant used the Domain Name not in good faith, but rather to trade upon the goodwill of the Complainants without a license to do so. Therefore, the provisions of these paragraphs do not apply.

The Registrant's name is not included in the Domain Name, so the provisions of paragraph 3.6(e) do not apply nor do the provisions of paragraph 3.6(f) apply.

I therefore find that the Complainants have provided some evidence that the Registrant has no legitimate interest in the Domain Name.

BAD FAITH

Under paragraph 3.5 of the Policy, the Registrant will be considered to have registered the Domain Name in bad faith if, and only if, the Complainants can demonstrate that the Registrant in effecting the registration of the Domain Name was motivated by any one of the four general intentions set out in paragraph 3.5.

Of these intentions, the form of intention contained in paragraph 3.5(a) is the one most applicable to the matter at hand.

Paragraph 3.5(a) provides as follows:

- (a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the

Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration;

The evidence before me demonstrates that the Registrant registered the Domain Name primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant,. I note particularly:

1. The Domain Name was registered on January 30, 2016, exactly two days after Cathay Hong Kong announced the rebranding of Dragonair and the filing of the application with the CIPO to register the Trade-Name as a trade-mark in Canada; and
2. The Registrant on the website to which the Domain Name resolves is offering the Domain Name for sale for 7,999 EUR.

Similar to the finding of other panels with similar evidence before them, I find that both the timing of the registration of the Domain Name by the Registrant and the Registrant's offer to sell the Domain Name constitute clear evidence that the Registrant registered the Domain Name in bad faith. See for example *Bank of Montreal v. Chris Bartello*, (CIRA 0094 July 27, 2008), and *Ford Motor Company of Canada, Limited v. Canadian Model Trains Inc.*, 00036 (CIRA July 27, 2005).

I therefore find that the Complainant has satisfied the provisions of paragraph 3.5 (a) of the Policy by establishing that the Registrant registered the Domain Name primarily for the purpose of selling, renting, licensing or otherwise transferring the Domain Name to the Complainants for valuable consideration in excess of the Registrant's actual costs in registering the Domain Name.

DECISION

As was above set out, paragraph 4.1 of the Policy provides that to be successful in the Complaint the Complainants have the onus of proving on a balance of probabilities three specific items and of providing some evidence that the Registrant has no legitimate interest in the Domain Name.

I find that the Complainants have satisfied this onus with respect to all three of these items by demonstrating on a balance of probabilities that each of the Brands qualify as a Mark in accordance with paragraph 3.2 of the Policy; that the Domain Name is Confusingly Similar to the Trade-Name; and that the Registrant has registered the Domain Name in bad faith in accordance with the provisions of paragraph 3.5 of the Policy.

I have also found that the Complainants have shown some evidence that the Registrant does not have a legitimate interest in the Domain Name in accordance with the provisions of paragraph 3.4.

I therefore find that the Complainants have satisfied the onus placed upon them by paragraph 4.1 of the Policy and are entitled to the remedy sought by them.

ORDER

I order that the domain name “cathaydragon” be transferred to the Canadian corporation, Cathay Pacific Airways Limited.

Dated: February 10, 2017.

“R. John Rogers”

R. John Rogers

Single Member Panel