

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

Domain Name: <crownplaza.ca>

Complainant: Six Continents Hotels, Inc.

Registrant: Virgin Enterprises Limited

Registrar: Sibername Internet and Software Technologies Incorporated

Panelists: Patrick D. Flaherty, Jacques A. Léger, Q.C., and R. John Rogers

Service Provider: British Columbia International Commercial Arbitration Centre

**DECISION**

**Parties**

The Complainant is Six Continents Hotels, Inc., a company with its principal place of business in Atlanta, Georgia, USA. The Registrant is Virgin Enterprises Limited, a company with its principal place of business in Charlottetown, Prince Edward Island, Canada.

**Domain Name and Registrar**

The domain name that is the subject of this proceeding is <crownplaza.ca> (the “Domain Name”). The Registrar of the Domain Name is Sibername Internet and Software Technologies Incorporated, of Ottawa, Ontario, Canada.

**Procedural History**

This is a proceeding under the Canadian Internet Registration Authority (CIRA) Domain Name Dispute Resolution Policy (Version 1.1 - Effective Date: December 4, 2003) (the “Policy”) and the CIRA Domain Name Dispute Resolution Rules (Version 1.2 - Effective Date: December 4, 2003) (the “Rules”). Both the Policy and the Rules were posted on the CIRA website on November 4, 2003.

The history of this proceeding, according to the information provided by the dispute resolution service provider, British Columbia International Commercial Arbitration Centre (“BCICAC”), is as follows:

- (a) On May 9, 2005, the Complainant filed a complaint regarding the Domain Name with BCICAC.

- (b) On May 9, 2005, having determined that the complaint was in administrative compliance with the requirements of the Policy and the Rules, BCICAC delivered a copy of the complaint to the Registrant.
- (c) The Registrant requested an extension of time in which to deliver its Response and an extension was granted by the BCICAC to June 13, 2005, pursuant to Rule 5.4.
- (d) The Registrant delivered its Response, in compliance with the Policy and Rules, to the BCICAC on June 13, 2005 by e-mail. Hard copies of the Registrant's Response were delivered on June 22, 2005.
- (e) The Registrant's Response was reviewed by the BCICAC and forwarded to the Complainant on June 14, 2005 by e-mail and on June 22, 2005 by express post.
- (f) On June 29, 2005 the Complainant delivered a Response to the Registrant's claim for costs within the time period permitted under Rule 11.1.
- (g) Both the complaint and the response were filed in English, which is the language of this proceeding in accordance with paragraph 10.1 of the Rules.
- (h) On June 29, 2005, in accordance with paragraph 6 of the Rules and considering the nominees of the parties, the BCICAC appointed a three-person Panel comprised of Messrs. Patrick D. Flaherty, Jacques A. Léger, Q.C., and R. John Rogers. Mr. Flaherty was named as Chair of the Panel.
- (i) Each of the Panellists have delivered to the BCICAC the required Statement of Impartiality and Independence, as required by paragraph 7 of the Rules.
- (j) Absent exceptional circumstances, the Panel was required to deliver its decision on or before July 21, 2005.

The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Rules. Based upon the information provided by the BCICAC, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding have been met. The Complainant was represented by legal counsel throughout this proceeding. The Respondent was not represented by legal counsel.

### **Background**

The Panel proceeds on the basis of the following facts set forth below as established in the evidence submitted by the parties.

The Complainant uses the "CROWNE PLAZA" mark to identify 215 hotels in 40 countries globally. It owns or operates hotels under the "CROWNE PLAZA" mark in the following cities in Canada: Edmonton, AB; Montreal, QC; Ottawa, ON; Toronto, ON; and Vancouver, BC.

The Complainant is the owner of multiple trade-marks registered in Canada and elsewhere that contain or comprise the element of "CROWNE PLAZA." In Canada, its trade-marks registered in the Canadian Intellectual Property Office ("CIPO") include: "CROWNE PLAZA" (312684) registered March 28, 1986; "CROWNE PLAZA HOTELS & RESORTS logo" (TMA 617,254) registered August 20, 2004; "CROWNE PLAZA logo" (TMA 541281) registered February 16, 2001; and "HOLIDAY INN CROWNE PLAZA logo" (301220) registered March 29, 1985.

The Complainant is the registrant of the domain name <crowneplaza.com> and operates a website at the URL <www.crowneplaza.com>, at which website the Complainant provides hotel reservation services for all of its "CROWNE PLAZA" hotels worldwide. This website received more than 3.1 million visits in 2004. The Complainant is also the registrant of the domain name <crownplaza.com> (without the letter "e").

The Complainant also asserts that its Canadian "affiliate", InterContinental Hotels Group (Canada) Inc., is the registrant of the domain name <crowneplaza.ca>. No details as to the nature of this "affiliation" were provided by the Complainant. However, this absence of any evidentiary detail is not material to the Panel's decision. The relationship between the Complainant and Intercontinental Hotels Group does not influence the decision.

Daniel Mullen is the administrative contact for the Registrant, a company engaged in the business of registering lapsed domain names. The Registrant manages several thousand domain registrations for over one hundred clients, and monitors at any given time over 13,000 dot-ca registrations. It offers fully serviced domain management for non-commercial use by individuals of non-infringing domain names, hosting services, brand protection and alerting, and domain recoveries.

The Registrant registered the disputed Domain Name on July 3, 2004. The Registrant is using the Domain Name in connection with a website that contains the text "Atlanta Universal" along with banner and text advertisements linking to affiliate marketing services.

By letter dated April 5, 2005 (received April 5, 2005), the Complainant gave notice to the Registrant of the Complainant's objection to the registration of <crowneplaza.ca>, asserting that it infringed upon the Complainant's trade-marks and demanding that the Registrant transfer the Domain Name to it. The Registrant denied that allegation and among other things offered to transfer the Domain Name to the Complainant, ultimately in exchange for payment of \$1,460 and other consideration.

There is no connection between the Complainant and the Registrant. Further, the Registrant has not been licensed to use or been otherwise authorized to use the Complainant's mark "CROWNE PLAZA."

### **Positions of the Parties**

The Complainant seeks an order requiring the Domain Name to be transferred to it on the following bases:

- (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.
  - (i) The Complainant is the owner of trade-marks registered in the CIPO containing or comprised of the element "CROWNE PLAZA."
  - (ii) Such marks were obtained by the Complainant in advance of the registration of the Domain Name.
  - (iii) The Domain Name incorporates the registered and famous "CROWNE PLAZA" mark in its entirety, absent the silent letter "e." The Domain Name so nearly resembles (and is a common misspelling of) Complainant's "CROWNE PLAZA" mark and sounds identical to Complainant's "CROWNE PLAZA" mark, that it is confusingly similar.
- (b) The Registrant has no legitimate interest in the Domain Name.
  - (i) Registrant has no rights or legitimate interests in respect of the domain name <crownpalaza.ca>, as there is no connection between Complainant and Registrant.
  - (ii) The Registrant has not satisfied any of the requirements set forth in paragraph 3.6 of the Policy, namely that: the Domain Name does not contain a mark which the Registrant has used in good faith, but rather, any use of the Domain Name has in fact been a contrived attempt to legitimize an otherwise illegitimate registration; (ii) the Registrant has not used the Domain Name in good faith in association with wares, services or businesses in respect of which the Domain Name is descriptive of or is the generic name thereof; (iii) the Domain Name does not constitute the Registrant's legal or other names; and (iv) the Domain Name does not constitute geographic names or the location of the Registrant's non-commercial activity or business.
- (c) The Registrant registered the Domain Name in bad faith as described in paragraph 3.7.
  - (i) The Registrant registered the domain name primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration, as described in 3.7(a).
  - (ii) The Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern of registering domain names in

order to prevent persons who have Rights in Marks from registering the Marks as domain names, as described in 3.7(b).

The Registrant seeks to have the complaint dismissed on the following bases:

(a) No Standing

The Complainant has no standing to bring the complaint because it does not satisfy the CIRA Canadian Presence Requirements for Registrants (Version 1.3 - Effective Date: June 5, 2003) (CPR).

(b) The defense of laches

- (i) The Registrant asserts that at no time since November 8, 2000, the date on which any person or entity that qualifies under CIRA policies may register any number of domains, did the Complainant attempt to register or request a transfer of the Registration. Furthermore, the Registrant asserts that the Complainant has never had a domain name registration in the form of <crowmplaza.ca>. In addition, the Registrant asserts that the Complainant is not the registrant of <crowneplaza.ca>, <crowneplazatoronto.ca>, or <holidayinn.ca>.

(c) The Complainant comes before the Panel without clean hands

- (i) The Registrant states that the Complainant has acted in bad faith by effecting several domain name registrations in violation of the CIRA policies as outlined in the first section of the Response, registering the domains <canadahotelreservations.ca>, <dealsonhotels.ca> and <discounthotelreservations.ca> with disregard for any trade-mark filing with CIPO in the absence of qualifying under the CIRA framework.

(d) The Registrant did not register the Domain Name in bad faith

- (i) Registrant registered the domain name primarily for the purpose of potentially transferring the Registration to the previous registrant, and not to the Complainant. As known by Complainant, the prior registrant did not want to recover the domain name. Complainant approached Registrant and offered to pay the fee that Registrant normally charges for its services once it learned that the prior registrant had no interest in recovering the Registration.
- (ii) Registrant did not prevent the Complainant from registering the Mark as a domain name as it notes that a third party unrelated to either Complainant or Respondent was the original registrant of the domain name, and that Complainant has therefore through its own dilatory behaviour not already acted against the prior registrant, suggesting that it does not have a

sustainable basis under CIPO for trade-mark infringement, even if the trade-mark were to be of such sufficient quality to merit such a claim.

- (iii) Registrant did not register the domain name for the purpose of disrupting the business of the Complainant, and instead was directed to sustaining the business of the original registrant, which was not the Complainant.

In addition, the Registrant has requested that the panel award it costs pursuant to Policy paragraph 4.6, namely that:

the Complaint was commenced by the Complainant for the purpose of attempting, unfairly and without colour of right, to cancel or obtain a transfer of any Registration which is the subject of the Proceeding.

## Discussions and Findings

### 2. Procedural and Other Matters - Standing

Policy paragraph 1.4, subtitled “eligible complainants”, provides as follows:

The person initiating a Proceeding (the “Complainant”) must, at the time of submitting a complaint (the “Complaint”), satisfy the Canadian Presence Requirements for Registrants (the “CPR”)...in respect of the domain name that is the subject of the Proceeding unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office (“CIPO”) and the Complainant is the owner of the trade-mark.

Paragraphs 2(a) through (p) and 2(r) of the CPR clearly have no application to the Complainant. The only possibly applicable section of the CPR is 2(q). It provides as follows:

**Trade-mark registered in Canada.** A Person which does not meet any of the foregoing conditions, but which is the owner of a trade-mark which is the subject of a registration under the *Trade-marks Act* (Canada) R.S.C. 1985, c.T-13 as amended from time to time, but in this case such permission is limited to an application to register *a .ca domain name consisting of or including the exact word component of that registered trade-mark* [emphasis added]

The reference to “consisting of or including the exact word component”, as opposed to simply consisting of the exact words, requires an analysis of the Domain Name and mark, both as a whole. Further, when considering a trademark registered in Canada, the CPR must be interpreted in a manner that is consistent with the scope of rights granted to the trade-mark holder under Canadian law. It would therefore be inconsistent to interpret paragraph 2(q) of the CPR in an overly restrictive and literal manner as suggested by the Registrant. The Complainant owns the “CROWNE PLAZA” trademark registration in Canada. The application in question deals with

the registration of <crownpalaza.ca> . While the Domain Name is missing the silent “e” contained in the Mark, it includes the “exact” word components of the Mark (“CROWNE PLAZA”).

In any event, even if the Complainant had failed to satisfy the CPR, the Complainant would still be entitled to avail itself of the CIRA Policy. As noted above, paragraph 1.4 of the Policy provides that if the Complaint relates to a trade-mark registered in CIPO and the Complainant is the owner of the trade-mark, then the Complainant need not satisfy the CPR in respect of the domain name that is the subject of the Proceeding.

The Complaint relates to the trade-mark “CROWNE PLAZA.” This trade-mark is registered in CIPO (Registration No. 312684, Registration Date March 28, 1986). The Complainant is the owner of the trade-mark “CROWNE PLAZA.”

Having satisfied the requirements of paragraph 1.4 of the Policy, the Panel finds that the Complainant is entitled to avail itself of the CIRA Policy.

### 3. **The Policy**

The Policy applies only to disputes involving alleged bad faith registration of domain names in the dot-ca country code top level domain, and is limited to situations in which a complainant asserts that:

- (a) The registrant's dot-ca domain name is “Confusingly Similar” (as defined in Policy (paragraph 3.4) to a “Mark” (as defined in Policy paragraph 3.2) in which the complainant had “Rights” (as defined in Policy paragraph 3.3) prior to the date of registration of the domain name and continues to have such “Rights”;
- (b) The registrant has no legitimate interest in the domain name as described in Policy paragraph 3.6; and
- (c) The registrant has registered the domain name in bad faith as described in Policy paragraph 3.7.5

In order 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”;
- (b) The registrant has registered the domain name in bad faith as described in Policy paragraph 3.7;

And the Complainant must provide some evidence that:

- (c) The registrant has no legitimate interest in the domain name as described in Policy paragraph 3.6.

Even if a 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 Policy paragraph 3.6.

#### 4. Confusing Similarity Between Domain Name and The Complainant's Marks

The Complainant must prove, on a balance of probabilities, that the 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" within the meaning of the Policy.

Policy paragraph 3.2 defines "Mark" as:

- (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 licensor of that person or predecessor from the wares, services or business of another person.*
- (b) *A certification mark, including the word elements of a design mark, that has been used in Canada by a person or the person's predecessor in title, for the purpose of distinguishing wares or services that are of a defined standard;*
- (c) *A trade-mark, including the word elements of a design mark, that is registered in CIPO; or*
- (d) *The alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of which the Registrar of Trade-marks has given public notice of adoption and use pursuant to paragraph 9(1)(n) of the Trade-marks Act (Canada).*

Policy paragraph 3.5 deems a "Mark" to be in "use" or "used" in association with:

- (a) *Wares: (i) if, at the time of the transfer of the property in or possession of the wares in the normal course of trade, the Mark is marked on the wares themselves or on the packages in which they are distributed or the Mark is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred; or (ii) at the time the wares are exported from Canada, if the Mark was marked in Canada on the wares or on the packages in which they are contained and the wares or packages are still marked when exported;*
- (b) *Services, if the Mark is used or displayed in the performance or advertising of those services;*



- (c) *A business, if the Mark is displayed in the operating, advertising or promoting of the business; or*
- (d) *A non-commercial activity, if the Mark is displayed in the carrying out, promoting or advertising of the non-commercial activity.*

Policy paragraph 3.3 provides that a person has “Rights” in a Mark if:

- (a) *In the case of paragraphs 3.2 (a) and 3.2(b), the Mark has been used in Canada by that person, that person’s predecessor in title or a licensor of that person or predecessor;*
- (b) *In the case of paragraph 3.2(c), the Mark is registered in CIPO in the name of that person, that person’s predecessor in title or a licensor of that person; or*
- (c) *In the case of paragraph 3.2(d), public notice of adoption and use was given at the request of that person.*

The Complainant has Rights in the Mark “CROWNE PLAZA”, as “CROWNE PLAZA” is a trade-mark registered in CIPO in the name of the Complainant prior to the Domain Name registration date.

The Complainant asserts that the Domain Name <crownpalaza.ca> is “Confusingly Similar” to the Complainant’s Mark “CROWNE PLAZA.”

Paragraph 3.4 of the Policy provides a definition of “Confusingly Similar”, which states that:

A domain name is “Confusingly Similar” to a Mark if 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.

In applying Policy paragraph 3.4, it is important to note that Policy paragraph 1.2 states that for the purposes of the Policy, a domain name means:

For the purposes of this Policy, “domain name” means the domain name excluding the “dot-ca” suffix and the suffixes associated with all third and fourth level domain names accepted for registration by CIRA.

The test to be applied in order to determine if a Domain Name is “Confusingly Similar” is one of resemblance based on first impression and imperfect recollection (*Government of Canada v. David Bedford* (May 27, 2003) BCICAC). As stated by the Panel in that decision:

For each Domain Name the Complainant must prove on a balance of probabilities that a person, on a first impression, knowing the Complainant’s corresponding mark only and having an imperfect

recollection of it, would likely mistake the Domain Name (without the .ca suffix) for Complainant's corresponding mark based upon the appearance, sound or the ideas suggested by the Mark.

Applying the resemblance test, the Panel finds, on a balance of probabilities, that a person, on a first impression, knowing the Complainant's "CROWNE PLAZA" mark only and having an imperfect recollection of it, would likely mistake the <crownpalaza.ca> domain name (without the .ca suffix) for the Complainant's "CROWNE PLAZA" mark based upon the appearance, sound or the ideas suggested by the Mark. In this regard, the absence of the silent letter "e" from the word "crowne" is not sufficient to distinguish the Disputed Domain Name <crownpalaza.ca> in appearance, sound or idea suggested from the "CROWNE PLAZA" Mark.<sup>1</sup>

Accordingly, the Panel is of the view that on a balance of probabilities, the 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" within the meaning of the Policy.

## 5. **Bad Faith Registration**

Policy paragraph 3.1(c) requires the Complainant to prove, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith, as described in Policy paragraph 3.7. As noted in *Viacom International Inc. v. Harvey Ross Enterprises, Ltd.*, (October 15, 2003) BCICAC, "'bad faith' within the meaning of the Policy is a term of art, and is not intended to apply to distasteful conduct that might constitute bad faith in the ordinary sense of the term."

The Policy (paragraph 3.7) sets forth an exhaustive list of criteria for determining whether a registrant registered a domain name in "bad faith":

*For the purposes of paragraph 3.1(c), a Registrant will be considered to have registered a domain name in bad faith if, and only if:*

- (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;*
- (b) *The Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern*

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<sup>1</sup> The Panel notes that in *AMAZON.Com Inc. v. Abraham* (July 28, 2004) BCICAC, the addition of the letter "s" to the word "amazon" was not sufficient to distinguish the Disputed Domain Name <AMAZONS.CA> in appearance, sound or idea suggested from the AMAZON Marks

*of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names; or*

- (c) *The Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant.*

As has been previously observed, a complainant will rarely have direct evidence of the purpose for registration. The registrant's purpose in registering a domain name may be determined by common sense inferences from the registrant's conduct and other surrounding circumstances.<sup>2</sup>

The Complainant relies upon Policy paragraph 3.7 (a) and (b) in support of its assertion that the Registrant has acted in bad faith in registering the Domain Name. It points to the following as evidence that lead to the inference of bad faith:

- (a) With respect to section (a) of Paragraph 3.7 of the Policy, the Registrant offered to transfer the Domain Name to the Complainant in exchange for payment of \$1,460.00, a fee considerably in excess of the actual cost of registering a dot-ca domain name, or a lifetime membership in Complainant's "Ambassador Club" program. The Registrant asserts that the latter request was made in jest.
- (b) The Registrant registered the Domain Name in bad faith as defined by Paragraph 3.7(b) of the Policy by preventing the Complainant from registering crown plaza as a domain name in the dot-ca top-level domain and by engaging in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names. Daniel Mullen, the administrative contact for the Domain Name that is the subject of this Complaint and the contact for the Registrant in this proceeding, had registered (alone or in concert with others), as of April 26, 2005, more than 500 dot-ca domain names, including numerous domain names that contain trademarks of third parties. These are set out in Exhibit Q.

In response, the Registrant asserts that it did not act in bad faith in registering the Domain Name in that:

- (a) The Registrant registered the domain name primarily for the purpose of potentially transferring the Registration to the previous registrant, and not to the Complainant, and therefore Paragraph 3.7(a) has no application. As known by Complainant, the prior registrant did not want to recover the domain name. Complainant approached Registrant and offered to pay the fee that Registrant normally charges for its services once it learned that the prior registrant had no interest in recovering the Registration.

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<sup>2</sup> *CBC v. William Quon*, (April 8, 2003) BCICAC DCA 681-CIRA

- (b) Registrant did not prevent the Complainant from registering the Mark as a domain name as it notes that a third party unrelated to either Complainant or Respondent was the original registrant of the domain, and that Complainant has therefore through its own dilatory behaviour not already acted against the prior registrant, suggesting that it does not have a sustainable basis under CIPO for trade-mark infringement, even if the trade-mark were to be of such sufficient quality to merit such a claim.

The Registrant's assertion that neither of 3.7(a) or (b) of the policy applies because it registered the domain name primarily for the purpose of potentially transferring the Registration to the previous registrant, and not to the Complainant, is not persuasive. Rather, that submission is premised on an overly narrow interpretation of the relevant subsections of the Policy. The Policy is intended to prevent parties from registering domain names to which they have no legitimate interest and where the registrant intends to interfere with or frustrate those with rights in a confusingly similar mark. Limiting "bad faith" as defined in the Policy to situations in which the registrant has targeted specifically the actual ultimate complainant (as suggested by the Registrant here) as opposed to a rights holder in a mark that is confusingly similar, is inconsistent with the purpose of the Policy. The fact that the Registrant claims not to have intended to interfere with the rights of this particular Complainant, but some other prior registrant of the domain name, therefore, does not take the Registrant outside of the conduct construed by paragraphs 3.7(a) or (b).

Given the Registrant's offer to transfer the Domain Name to the Complainant for \$1,460.00, the Panel finds that the Registrant registered the Domain Name primarily for the purpose of transferring the Registration to the party owning the rights to the "CROWNE PLAZA" Mark, thus acting in bad faith in accordance with subsection (a) of Policy paragraph 3.7. The fact that the Registrant was not aware that the Complainant was the owner of the trade-marks does not avoid a finding of bad faith.

Given the Panel's finding, there is no need to deal with the Complainant's assertion that the requirements of bad faith as construed by paragraph 3.7(b) are also made out.

As a result, the Panel is of the opinion that the Complainant has met its burden of proving, on the balance of probabilities, that the Registrant has acted in bad faith.

#### **6. No Legitimate Interest in the Domain Name**

The Complainant must provide "some evidence" that the Registrant has no legitimate interest in the Domain Name, as described in Policy paragraph 3.6. If the Complainant satisfies this evidentiary burden, the onus shifts to the Registrant to prove on a balance of probabilities that the Registrant has a legitimate interest in the challenged domain name.

Policy paragraph 3.6 sets forth an exhaustive list of criteria for determining whether a registrant has a legitimate interest in a domain name. It provides as follows:

*The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint as submitted:*

- (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 paragraphs 3.6 (b), (c), and (d) "use" by the Registrant includes, but is not limited to, use to identify a web site.*

The legitimate interest criteria set forth in Policy paragraphs 3.6(a), (b), (c), and (d) are satisfied only if the registrant's use was in "good faith", a term which is not defined by the Policy. The Complainant states that the Registrant has not satisfied any of the legitimate interest criteria set forth in Paragraph 3.6 of the Policy, namely that:

- (a) The Registrant has no rights in the Mark "CROWN PLAZA." By its own admission, the Registrant is engaged in the business of registering lapsed domain names. Further, the Registrant is using the Domain Name in connection with a website that contains the text "Atlanta Universal" along with banner and text advertisements. The Complainant contends that this use is not in good faith.
- (b) The Domain Name is not "clearly descriptive in Canada in the English or French language of" the character, condition or place of origin of any "wares, services or business", as the only content on the Registrant's Website is the text "Atlanta Universal" along with banner and text advertisements for downloadable movies and the Netscape Internet browser - wares, services or a business that have nothing to do with "CROWN PLAZA."

- (c) The Domain name is not “understood in Canada to be the generic name” of any “wares, services or business.” Rather, it is a common misspelling of the Complainant’s Mark, which identifies only lodging services offered by the Complainant.
- (d) By posting banner and text advertisements on the Registrant’s Website (see Exhibit I), the Registrant is using the Domain Name in association with a commercial activity.
- (e) The Domain Name does not “comprise the legal name of the Registrant” nor is it a “name, surname or other reference by which the Registrant was commonly identified.” The Registrant’s name, as identified in the Whois record contained in Exhibit A, is “Virgin Enterprises Limited,” not Crown Plaza.
- (f) The Domain Name is not “the geographical name of the location of the Registrant’s non-commercial activity or place of business,” because the Registrant is engaged in a commercial activity, and Crown Plaza is not a geographical name.

The Panel is of the opinion that the Complainant, by providing some evidence that the Registrant does not satisfy any criteria listed in Policy paragraph 3.6, has satisfied its burden pursuant to Policy paragraph 4.1(c).

Thus, the onus shifts to the Registrant to prove, on a balance of probabilities, that the Registrant has a legitimate interest in the challenged domain name.

The Registrant carries on the business of, among other things, registering lapsed domain names. As a result, the question of whether the Registrant’s actions in carrying on this business constitute a legitimate interest in the context of Policy paragraph 3.6(a), merits discussion by the Panel.

As noted above, subsection (a) of Policy paragraph 3.6 states that:

The Registrant has a legitimate interest in a domain name if...before the receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint as submitted:

- (a) The domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;

In *Acrobat Construction v. 1550507 Ontario Inc.*, (June 16, 2003) BCICAC, the Panel there considered whether a superficially similar business to that operated by the Registrant here comprised a “legitimate interest” within the meaning of the Policy. In *Acrobat* the Registrant’s business was described as follows:

The Registrant carried on the business of operating a web site on the Internet under the domain name “pool.com” which provides up-to-date information to Internet users on current affairs as well as a search engine which enables users to locate and access other

web sites containing information of interest to them. As part of its business, the Registrant registers domain names that are released by administrators of top level and country code domain names and that have traffic generated to them, which are detected automatically by multiple queries conducted by its search engines.

The Registrant used the domain name “acrobat.ca”...[the subject of the dispute] to direct Internet users to results of a search of the word “acrobat” using its “pool.com” search engine for commercial purposes.

In *Acrobat*, the Panel determined that the Registrant did not register the domain name in bad faith, as, for among other reasons, it did not register the domain name primarily for the purpose of selling or otherwise transferring the domain name to the Complainant or other rights holder. Rather, it registered the domain name in conjunction with its business directing internet traffic to its pool.com site and was not offering the domain for sale. This was found to be a legitimate interest in the domain name within the meaning of the Policy.

The nature of the domain use in *Acrobat* is materially different than that of the Registrant. While the Registrant carries on the business of registering lapsed domain names, it did so in this case with the intention of selling the Disputed Domain Name and in fact attempted to do so. The Registrant does not use the disputed domain name to direct traffic to a site which it operates such as in *Acrobat*. The Domain Name is not descriptive of any business or services offered by the Registrant. Finally, the Registrant, for the reasons set forth above, has acted in bad faith.

Accordingly, the Panel is of the opinion that the Registrant has not proven, on a balance of probabilities, that the Registrant has a legitimate interest in the challenged domain name.

#### **7. Defenses Asserted by the Registrant**

The Registrant asserts, by way of defense, laches and the absence of clean hands on the part of the Complainant. Equitable defenses are not expressly provided for in the Policy or the Rules, though similar concepts do underlie Policy paragraph 4.6 (under which an award of up to \$5,000 may be made against the Complainant who has brought the complaint in bad faith). Policy paragraph 2.2 notes that the Provider will administer the Proceeding in accordance with the Policy and the Resolution Rules. Whether or not equitable defenses comprise a basis on which to defend a complaint under the Policy or Rules outside the application of the provisions of paragraph 4.6 is a moot point. In the matter at hand, we find that neither of these defenses are available to the Respondent. There is no evidence before us of delay on the part of the Complainant once the Complainant became aware of the registration of the Domain Name by the Registrant. Nor do we accept that that Complainant comes before us without clean hands. We find no evidence of any improper conduct on the part of the Complainant in its proceedings on this complaint

## Conclusion and Decision

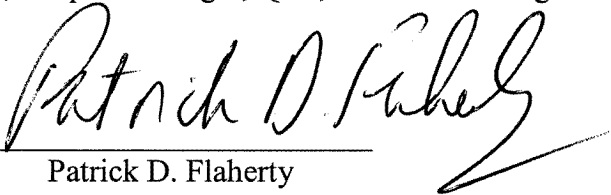
The Complainant has proven, on a balance of probabilities, that the Domain Name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the Domain Name and continues to have such Rights, as those terms are defined in the Policy. The Complainant has proven, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith as described in paragraph 3.7 of the Policy.

The Complainant has adduced some evidence that the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.6. The Registrant has not proven, on a balance of probabilities, that it has a legitimate interest in the Domain Name, as described in paragraph 3.6. Further, the defenses of laches and the absence of clean hands on the part of the Complainant, as asserted by the Registrant, have no merit in this complaint.

For these reasons, the complaint is successful and the Panel orders and directs that the registration of <crownpalaza.ca> be transferred to the Complainant's Canadian nominee, InterContinental Hotels Group (Canada) Inc., by the Registrar, Sibernet Internet and Software Technologies Incorporated.

Given the Panel's determination, it is unnecessary to deal with the Registrant's assertion that the Complainant acted with bad faith in filing the Complaint. Accordingly, the Registrant's claim for costs is denied.

Patrick D. Flaherty, Jacques A. Léger, Q.C., and R. John Rogers



Patrick D. Flaherty  
Chair

Date: July 20, 2005