

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number: BCICAC: DCA-855-CIRA

Domain Names: froogle.ca

Complainant: Google Inc.

Registrant: Glynis Fraser

Registrar: Internic.ca Corp.

Panelist(s): Cecil O. D.Branson, Q.C., Derry Millar, Denis Sauvé, Chair.

Service Provider: British Columbia International Commercial Arbitration Centre

Decision

1. The following represents the opinion of the Chair only.

The Parties

2. The **Claimant**, Google Inc., is a corporation in Mountain View, California, United States of America.

3. The **Respondent** is a Canadian individual in the name of Ms. Glynis Fraser, St. Catherines , Ontario, Canada.

The Domain Name and Registrar

4. The disputed name <froogle.ca> is registered with Internic.ca Corp.

Procedural History

5. The British Columbia International Commercial Arbitration Centre (BCICAC) is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy of the Canadian Internet Registration Authority (CIRA).

6. On May 27, 2005, the Complainant filed a Complaint pursuant to the Policy and the Rules.

7. By way of letter dated May 30, 2005, the BCICAC as Service Provider confirmed compliance of the Complaint and commencement of the dispute resolution process.

8. The Provider served notice of the Complaint to the Registrant as required by paragraph 4.3 of the *CIRA Domain Name Dispute Resolution Rules* ["Rules"]. The Respondent filed a response on July 11, 2005 after a delay was granted to her to do so and as she asked for.

9. According to Rule 6 a panel of three members was appointed by the Provider

10. The Provider selected a panel of three: Mr. Cecil Branson Q.C from the list submitted by the Respondent; Mr. Derry Millar from the list submitted by the Complainant and appointed Denis Sauvé, as Chair.

11. The Administrative Panel has considered all of the material delivered by the Complainant, Respondent and the BCICAC. An examination of the material confirms that all technical requirements for the prosecution of this proceeding were met; the fact that the Respondent did not include in her Response the Certification required at Annexe B does not invalidate the process.

Panel Member Impartiality and Independence Statement

12. As required by paragraph 7.1 of the Rules, all three Panellists declared to the Provider that they could act impartially and independently in this matter as there are no circumstances known to each of them which would prevent them from so acting.

Factual Background

13. The facts of this dispute are relatively straightforward.
The Complainant is a business corporation that operates worldwide and is well known for its online search engine called Google.

14. The Respondent is an individual who claims registration of the disputed domain name for her personal use (par. 41 of Response).

15. On December 12, 2002 the Respondent registered the said domain name and she activated a public website in late April of 2003. (Par.42 of Response).

16. The Respondent argues that she `` *uses the Domain name as her private start page, which is not publicly accessible, since April of 2003.* `` (Par. 45 of Response).

17. The Claimant disputes this statement and argues that he is the only one that have rights in this Froogle name and that fact is and was well known to the Respondent who was aware of this and decided to register the said domain name in fraud of the rights of the Claimant.

18. Prior to this complaint an in house representative of the Complainant wrote to the Respondent informing her that she was infringing the Complainant rights by having and maintaining the registration of the disputed domain name.

19. An outside law firm, acting on behalf of the Complainant, wrote the Respondent to reiterate that she was infringing the Complainant rights.

20. The Respondent answered all interlocutors that she was acting in good faith and in her good right; she confirmed the offer made on her behalf to the Complainant to the effect that she was willing to sell it her rights in the domain name Froogle.ca for the price of 25,000 {USD}.

CIRA Domain Name Dispute Resolution Policy Requirements

21. The *CIRA Domain Name Dispute Resolution Policy* [“Policy”] sets out at paragraph 3.1 the basis for a complaint:

3.1 Applicable Disputes. A Registrant must submit to a Proceeding if a Complainant asserts in a Complaint submitted in compliance with the Policy and the Resolution Rules 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 no legitimate interest in the domain name as described in paragraph 3.6; and
- (c) the Registrant has registered the domain name in bad faith as described in paragraph 3.7.

For the purposes of this Policy, the date of registration of a domain name is the date on which the domain name was first registered in the Registry or the predecessor registry operated by the University of British Columbia.

22. The *CIRA Domain Name Dispute Resolution Policy* [“Policy”] sets out at paragraph 4.1 what the Complainant must establish in order to successfully prove the complaint:

4.1 Onus. 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; and
- (b) the Registrant has registered the domain name in bad faith as described in 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 paragraph 3.6.

Even if the 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 paragraph 3.6.

23. My understanding of the apparent discrepancy that I read between 3.1 and 4.1 is to the effect that in 3.1 the first motive alone, if proven, is sufficient ground to rule in favour of a Complainant and the test of bad faith only applies if the second motive of 3.1 is the basis for the complaint.

Other wise the first motive of 3.1 based on the Mark, which is defined as below, would be irrelevant for it could lead to permit the unauthorized use of the property of another by a non owner:

3.2 Mark. 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;
- (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).

24. I reproduce the following for convenience purposes:

3.3 Rights. 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.

3.4 “Confusingly Similar”. 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.

3.5 Use. A Mark is deemed 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.

3.6 Legitimate Interests. 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 was 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,

Google vs Fraser
DCA-855-CIRA

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 Registrants includes, but is not limited to, use to identify a web site.

3.7 Registration 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 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.

Identical or confusingly similar.

25. According to the **Complainant** *"The contested domain name is identical in appearance, sound and ideas suggested to the Complainant's FROOGLE Canadian Trade mark, used in Canada since December 11, 2002, prior to the Respondent's registration of the Domain Name on December 12, 2002, and tot which the Complainant*

continues to have rights, pursuant to paragraph 3.1 of the Policy `` (par. 12 of the Complaint).

26. The Complainant argues that it has a Canadian trade mark application for Froogle (No. 1, 174, 791) which has a priority filing date of November 22, 2002, based on its corresponding application for FROOGLE in the United States (No. 78, 187, 946).

27. The Complainant also gave evidence that it's the owner of the Canadian trade mark registration for GOOGLE (TMA539,576) since January 12, 2001 (based on the priority filing date, September 16, 1998, of the USA application No. 75, 554,461).

28. The Complainant as also adduced evidence that it's the owner of various international trade mark registrations for the marks GOOGLE and FROOGLE and that it has a strong presence on the world wide web in association with the GOOGLE and FROOGLE marks and that the name GOOGLE. CA was registered on October 3, 2000 and the name FROOGLE. COM was registered on September 11, 2001 and that an active website since the site's official launch on December 11, 2002.

29 The Complainant also gave evidence that this site has attracted and serviced hundreds of thousands of Canadians since its debut.

30. The Complainant stresses that : `` *Since December 2002, the Complainant's FROOGLE mark too has become internationally recognized, in part owing to its immediate association with the famous GOOGLE mark in the mind of the public. In particular, the Complainant's GOOGLE and FROOGLE marks have gained increasing international exposure through the websites <GOOGLE.COM>, <GOOGLE.CA>, and <FROOGLE.COM>, which were registered over 5 years, 2 years, and 1 year, respectively, prior to the Respondent's registration of the Domain Name.* ``

31. On her part the **Respondent** submits that there can be no confusion for:

`` *... someone who can operate a computer would not confuse the Complainant's GOOGLE.COM or GOOGLE.CA websites with the Registrant's FROOGLE.CA website*`` (par.24 of Response; see also par.35).

32. The Respondent also argues that *the Complainant did not have rights to the mark, Froogle, prior to the Registrant's registration o the Domain Name.* (Par.27 of Response) adding at paragraph 30 that:

``*The Domain Name was registered by the Registrant on December 12, 2002. The Complainant did not have Canadian mark rights to Froogle before the registration and still does not have rights in the mark.* ``

33. At paragraph 41 of her Response, the Respondent reiterates that:

“ The Registrant did not register the Domain Name in order to prevent the Complainant from registering the Domain Name. The Registrant registered the Domain Name for personal use.” (underlying by the Panel).

34. The Registrant adds at paragraph 43 of her Response:

“The Registrant did not register the Domain Name primarily for he purpose of disrupting the Complainant’s business. ”

27. At paragraph 47 the Respondent wrote:

“ The Complainant corporation, on the other hand, registered the domain name of FROOGLE.COM on September 11, 2002. ”

35. The Respondent adds at paragraph 48 of her Response:

“ According to ARCHIVE. ORG the Complainant’s FROOGLE.COM website was inoperative and merely “parked” until February 4, 2003. ”

36. I opine that the test to be decided on this ground of the complaint is to answer the following question: is the disputed domain name confusingly similar to a mark of the Complainant? In this particular case, the domain name FROOGLE.CA is without a doubt confusingly similar to a mark of the Complainant; and I find that the Complainant has met the requirements of the Policy.

Legitimate interest.

37. **The Respondent** contends that she has a legitimate interest in the disputed domain name because she uses it as a starting page for her own personal needs and to share recipes and keep in contact with friends and family. (Par.66 of Response).

38. The Respondent states that she was unaware that the Complainant was going to launch a web site under the web address of FROOGLE.Com (Par.72 of Response).

39. **The Complainant** argues that the Respondent has no legitimate interest in the disputed domain name for her real goal is “... to reap the benefits of the significant good will attached to the Complainant’s trade mark in order to attract users to her website, and obtain advertising revenue for posting links to other third-party sites on the <Froogle.ca> site.” (Par. 25 Complaint).

40. According to the Respondent (Par.75-76 of Response) this allegation is factually incorrect.

41. The Complainant argues that the fact the Respondent registered the said domain name the day after it launched its FROOGLE services is more than a coincidence and this is also accentuated by the fact that Respondent did not develop or activate any website until months later and that there is no evidence that the disputed registration complies with neither paragraphs d), e) or f) of subsection 3.6 of the Policy.

42. Again, I suggest that the **test** to resolve this ground of the complaint is as it was formulated in the Diners Club decision (DCA-733-CIRA “ *The issue is whether the unqualified use of mark in relation to its owner or owner’s commercial activities is legitimate.*” Again I find that the Respondent usage of the expression Froogle and what it represents and stand for is of the nature of the unauthorized use of the property of another: in this case, the Complainant.

43. In my mind the Complainant has met the requirements of the Policy and I find that the Respondent has no legitimate interest in the disputed registered domain name of FROOGLE.CA.

Bad Faith

44. While I certainly have more than doubts in the good faith of the Respondent and finds, that the fact she admitted having refused small amounts up to 1 500. \$ to sell the said domain name to unnamed parties, but on the other hand admitted to have asked 25, 000 US \$ to the Claimant to transfer said registration , to be inconsistent with her statement that she is of good faith, giving the other circumstances coloring said registration, her explanations and her doing in general. A quick look at her site clearly shows that it does not have much content; the disclaimer in my view plays against the Respondent for it does show that she is aware that users can and will be confused by said domain name and again I, for one, finds it quite disbelieving that the Respondent and the Complainant came up with the word “Froogle” at the same time. (Lighting does rarely strike simultaneously at two places at a time). I simply do not believe the Respondent when she says that she registered the disputed domain name for personal use only.

45. I do endorse the rationale that the mere fact for a Registrant to be willing and admitting to be willing to sell and does offer to sell its rights in a disputed domain name to a Complainant for an amount in excess of the Respondent’s out-of-pocket expenses in registering the domain name is not, in itself, evidence of bad faith registration. However I can not subscribe to the reasoning that evidence must be adduce by a Complainant and be clearly conclusive that “ *selling the domain name to the Complainant for an excessive sum was the Respondent’s primary purpose in registering the domain name* ” as it was relayed in the American Multi-Cinema decision (DCA-818-CIRA). (My underlying)

46. I do not think that the Panel as to decide this question on the ground that the Respondent was found not to have a legitimate interest in the disputed domain name and

no rights in it; but if it was necessary to make a finding on this issue then I would find the Respondent being of bad faith for the reasons that I mentioned in paragraph 44.

47. I keep in mind the *Christian Dior, S.A. v. Dion Neckwear Ltd.* Case A-258-00, 2002 FCA 29 decision when I find the way I do in paragraph 41; there is no doubt in my mind that the Complainant's has met the burden of proof impose upon it and that the adduced evidence and its argumentation do demonstrate on the balance of probabilities the bad faith of the Respondent.

Decision

48. Based on the above reasoning, I find that the Complainant has established its Complaint and that said Complaint is well founded.

49. The Complainant seeks the transfer to it of the subject domain name FROOGLE.CA. It is so order.

Signed this 28 day of July 2005.

Denis Sauvé, Chair.