

**IN THE MATTER OF A COMPLAINT PURSUANT TO THE CANADIAN
INTERNET REGISTRATION AUTHORITY (“CIRA”) DOMAIN NAME DISPUTE
RESOLUTION POLICY (the “POLICY”)**

Complainant: Bell Canada

Complainant Counsel: Hugues G. Richard
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Montreal, Quebec
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Registrant: Archer Entreprises

Disputed Domain Name: belll.ca

Registrar: DomainsAtCost Corp.

Panelist: Elizabeth Cuddihy, QC

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

BCICAC File Number: DCA-860-CIRA

On June 28, 22005, the Complainant filed a complaint against the Registrant with the BCICAC seeking that the Registrant’s right to ownership of the domain name, belll.ca, (the “Disputed Domain Name”) be arbitrated in accordance with CIRA’s Domain Name Dispute Resolution Rules (the “Resolution Rules”) and that an order be made pursuant to the CIRA Domain Name Dispute Resolution Policy (the “Policy”) that the registration of the Disputed Domain Name be transferred to the Complainant.

The Complainant was reviewed by the BCICAC, as service provider and found to be in administrative compliance with the Policy and the Rules in accordance with the provisions of Rule 4.2. The BCICAC so advised the parties and forwarded a copy of the Complaint to the Registrant for response..

In accordance with paragraph 2(d) of the CIRA *Policies, Rules and Procedures, Canadian Presence Requirements for Registrants*, the Complainant is a corporation under the Canada Business Corporations Act. Accordingly the Complainant meets the Canadian Presence Requirements of paragraph 1.4 of the Policy.

The Registrant did not respond to the Complaint within the twenty (20) day period; within which the Registrant’s response is to be filed pursuant to Rule 5 of the Rules. The BCICAC

advised the Complainant of the lack of response by the Registrant and in accordance with Rule 6.5 the Complainant gave notice to the Service Provider, BCICAC to a single member Panel.

By letter dated August 17, 2005, the BCICAC acting in accordance with Paragraph 6 of the Rules named the Panel for this arbitration.

. As the Complaint was filed in English and as the Registrant has not responded, English is the designated language of the proceeding.

LACK OF RESPONSE

The Panel is advised by the BCICAC that the Complaint was communicated to the Registrant in accordance with the Rules and that no response has been received. Rule 5.8 provides that the Panel shall decide the matter on the basis of the Complaint as submitted by the Complainant in the event that the Registrant does not submit a response within the period for its submission.

Accordingly Rule 5.8 applies to the matter at hand and the Panel is determining the matter on the basis of the Complaint as filed by the Complainant and based on the applicable Quebec and Canadian laws, reference to relevant prior CIRA Policy decisions that have been referenced in the Complaint and in accordance with Canadian Trade Mark Law.

FACTS

According to the Complaint, the Complainant is the registered owner of a family of trade-marks Bell and Bell & designs, registered in the Canadian Intellectual Property Office under registration numbers TMA255,222, TMA231,071, TMA278834, TMA456,528, TMA464,814, TMA578,100, TMA578,301, TMA604,264, TMA604,265 and TMA613,483, the particulars of which including the wares and services with which they were registered, are set out in Schedule "C" attached to and forming part of the Complaint.

The Complainant is also the owner of a Mark that are trade-names; namely, Bell, Bell Canada, Bell Canada Enterprises, Bell Globemedia and Bell Mobility that are used by the Complainant and its affiliates, duly authorized licensees of the Complainant for the purpose of distinguishing its wares, services and business from those of other persons as evidenced by abstracts of the Industry Canada Strategis Database for Canadian Corporations and Quebec's Enterprise Register, a public register of enterprises incorporated or operating in Quebec.

The Complainant is also the owner of the domain name bell.ca . which has been in use by the Complainant for many years in connection with its wares and services.

The Marks are extensively used as trade-marks and trade-names in Canada in association with the Complainant's multiples wares, services and business related to telecommunications

The expression "Bell" has been part of the Complainant's trade-names and family of trade-marks since its foundation in 1880. The Complainant and its affiliates have invested

considerable amounts of money in the promotion of the “BELL” trade-marks, trade-names and domain names and have acquired considerable goodwill in them through their extensive use.

The Complainant considers its trade-marks, trade-names and domain names to be of material importance to its business and actively defends and enforces its right therein.

As evidenced from printouts from the Canadian Internet Registration Authority’s (“CIRA”) website, the Registrant registered a domain name bell.ca on April 16, 2005. The e-mail address used on the CIRA registration differs from the one used by the Registrant in dealing with the Complainant prior to the issue of the subject Complaint.

As evidenced from printouts from the Registrant’s website, the Registrant’s website resolves to the website of rogers.com, the website of a direct competitor of the Complainant.

The Complainant maintains that the disputed domain name “bell.ca” is confusingly similar to one of the Complainant’s marks, that the Registrant has registered the domain name bell.ca in bad faith as described in paragraph 3.7 of the Policy and the Registrant has no legitimate interest in the domain name bell.ca as described in paragraph 3.7 of the Policy.

As evidenced by copies of correspondence provided by the Complainant, exchanged between June 8, 2005 and June 21, 2007, the Complainant, through its in-house and external legal counsel attempted to resolve the alleged misuse of the BELL family of trade-marks, logos and names and the transfer to the Complainant of the Disputed Domain Name without success.

REASONS

Paragraph 4.1 of the Policy places the onus on the Complainant to prove on a balance of probabilities that the Disputed Domain Name is confusingly similar to the Complainant’s Mark (BELL family of trade-marks) and the Registrant has registered the Disputed Domain Name in bad faith. In addition the Complainant must adduce some evidence that the Registrant has no legitimate interest in the Disputed Domain Name.

Confusingly Similar

To deal first with the issue that the Disputed Domain Name is confusingly similar to the BELL family of trade-marks, logos and names in which the Complainant had rights prior to the date of registration of the Disputed Domain Name.

Prior Rights

The evidence shows that the Complainant is the owner of a family of trade-marks, namely the registered trade-marks Bell and Bell & designs, registered in the Canadian Intellectual Property Office and bearing the following registration numbers TMA255,222, TMA231,071, TMA278834, TMA456,528, TMA464,814, TMA578,100 TMA578,301, TMA604,264,

TMA604,265 and TMA613,483 all of which have been registered and in use for many years prior April 16, 2005 and continues to have such rights in accordance with subparagraph 3.3(b) of the Policy. The Disputed Domain Name was registered April 16, 2005 as evidenced by printout of the CIRA registry database filed with the Complaint.

Accordingly the registration of the Complainant's family of marks predates the registration of the Disputed Domain Name.

Reference is made to decision of the Panel in *Government of Canada on behalf of Her Majesty the Queen in Right of Canada v. David Bedford*, British Columbia International Commercial Arbitration Centre, Case No 00011 which held that where a Complainant relies upon a trade-mark registered prior to the domain name registration date, the Policy does not require or permit a Panel to go beyond the registration to determine whether the mark is valid or invalid based upon lack of distinctiveness or non-use.

This principle was confirmed in *Viacom International Inc. v. Harvey Ross Enterprises Ltd*, BCICAC, Case No. 00015, wherein the Panel held as follows:

For purposes of construing “confusingly similarity” between the domain name and the complainant’s mark, the Policy draws a distinction between rights in a mark registered in CIPO before the date the domain name was registered and common law rights in a mark acquired through use by the complainant. With the former, a complainant need not demonstrate distinctiveness or use to establish “rights” in a mark which is alleged to be confusingly similar to the domain name. The registration of the mark in CIPO is sufficient in and of itself to establish such “rights” within the meaning of the Policy.

The date of registration of the Disputed Domain Name, April 16, 2005, is clearly subsequent to the Claimant’s rights associated with the Bell family of marks as evidenced by the printouts respecting the Complainant’s marks.

To deal now with the issue of confusingly similar to the mark, paragraph 3.4 of the Policy provides 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 trade-marks as to be likely to be mistaken for the mark.

In applying the confusion analysis, paragraph 1.2 of the Policy provides that a domain name is defined as follows: (*Coca-Cola Ltd v. Amos B. Henman*, British Columbia International Arbitration Centre, Case No 00014):

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

As held by the Panel in *Government of Canada on behalf of Her Majesty the Queen in Right of Canada v David Bedford*, the test to be applied when considering “confusingly similar” is one of first impression and imperfect recollection:

Accordingly, 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 the Complainant’s corresponding mark based upon appearance, sound or the ideas suggested by the Mark.

In other words, the test is whether the average Internet user with an imperfect recollection of the Bell mark who wishes to access a website operated by the Complainant either by entering a domain name including the Bell mark into the address bar of an Internet browser, or by entering the key terms of the domain name into an Internet search engine, would likely be confused as a matter of first impression with the Disputed Domain Name (see *Great Pacific Industries v. Ghalib Dhalla* CIRA Dispute Number 00009, April 21, 2003, pp.20-21)

In addition it has been held that a registrant may not avoid confusion by accompanying another’s entire mark in a domain name (*Canadian Broadcasting Corporation/Société Radio-Canada v. William Quan*, British Columbia International Commercial Arbitration Centre, Case No 00006)

In *Glaxo Group Limited v WWW Zban c/o David Glenmore, NAF*, Case No. FAO310000203164, a case where a Registrant had registered WWWZYBAN.COM and pointed to a website selling pharmaceutical products, the Panel held that WWWZYBAN.COM was confusingly similar to the Complainant’s Trade-mark ZYBAN.

In the matter at hand, the evidence shows that the Complainant’s trade-marks were registered prior to the date of registration of the Disputed Domain Name, the Disputed Domain Name is identical to the Mark except for the additional “L” to the word elements of the Complainant’s Marks, the disputed Domain Name greatly resembles the Complainant’s Marks that are trade-names, such as Bell Canada, Bell Mobility, Bell Globemedia and Bell Canada Enterprises in appearance, sound and the idea suggested by it. Inasmuch as the site resolves to a website of rogers.com, a direct competitor of the Complainant, it would appear that the purpose for the Disputed Domain Name was to attract potential customers of the Complainant who were attempting to access websites whose name included the BELL mark.

For the reasons stated above I find that the Complainant has proven on a balance of probabilities that the Disputed Domain Name is confusingly similar to the BELL mark, in which the Complainant had rights prior to the date of registration of the Disputed Domain Name and continues to have such rights and that the Complainant therefore satisfies the onus placed on it by clause (a) of Paragraph 4.1 of the Policy.

Bad Faith Registration

The second onus of proof that the Complainant must address is to demonstrate that the Registrant has registered the Disputed Domain Name in bad faith. Paragraph 3.7 of the Policy provides that “if, and only if” any one of the three tests set forth in the paragraph is met will the Registrant be considered to have registered a domain in bad faith.

Registration Primarily for Alienation

The first of these test is whether a Registrant registered the domain name primarily for the purpose of generating revenue from the domain name by means of selling or otherwise alienating to the Complainant or a competitor of the Complainant at a cost in excess of the Registrant’s actual costs to acquire or acquire the domain name.

The evidence shows that on or about June 8, 2005, a letter was sent, e-mail, from the Complainant’s in-house counsel to the Registrant explaining that Bell is a Mark of the Complainant and requesting transfer of the disputed domain name to the Complainant. The letter also informed the Registrant that if the Registrant failed to comply with the Complainant’s request that the issue would be referred to the Complainant’s trade-mark lawyers for further action. The Registrant responded that if Bell was interested in leasing the website yearly or buying it outright, the Complainant should provide an offer or alternatively not to contact the Registrant again. On June 31, 2005, the Complainant’s trade-mark lawyer again wrote to the Registrant advising him of the trade-mark infringement and requesting that the Registrant transfer the Disputed Domain Name to the Complainant. There is no evidence of any response to that communication. On August 19, 2005, the Registrant addressed an e-mail to the Complainant advising that the site no longer resolves to the rogers.com site and requested that the Complainant make him an offer to purchase the site.

In determining whether the Registrant’s actions are captured by paragraph 3.7, the Registrant’s purpose in registering a domain name may be determined by common sense inference from the Registrant’s conduct and other surrounding circumstances (see *Canadian Broadcasting Corporation/Soci t  RadioCanada v. William Quan, supra*)

Evidence shows that the Registrant’s use of the bell.ca domain name is a commercial endeavour. It has been held that an offer by a Registrant to sell a domain name to the trade-mark owner for an amount which exceeds the Registrant’s out-of-pocket expenses constitutes evidence of bad faith registration (see *Government of Canada, on behalf of Her Majesty the Queen in Right of Canada v. David Bedford, supra*). While the Registrant did not specify the amount he was prepared to accept for the transfer of the Disputed Domain Name, it is reasonable to conclude that a yearly lease or outright buy ought would represent an amount in excess of the Registrant’s out-of pocket expenses.

Based on the foregoing, it is reasonable to conclude that generating revenue from selling or otherwise alienating the Disputed Domain Name to the Complainant, the owner of the Mark, was the Registrant’s primary purpose in registering the Disputed Domain Name.

Registration to Prevent registration – providing the Registrant has engaged in a pattern.

The second test is whether the Registrant registered the Disputed Domain Name in order to prevent the Complainant or its licensees from registering the Bell mark as a domain name.

There is no evidence to this effect in the case at hand.

Registration to Disrupt Business

The third test is whether the Registrant registered the Disputed Domain Name primarily to disrupt the business of the Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant.

A narrow interpretation of this test holds that a Registrant disrupts the business of a competitor if it offers goods or services that can compete with or rival the goods or services offered by the trade-mark owner. A broader interpretation has also been considered; namely that a competitor is someone who acts in opposition to another, including competing for Internet users and that there is no requirement that the Registrant be a commercial business competitor or someone that sells competing products.

The phrase "disrupting the business of the Complainant" as per the Policy has been held to be satisfied where the use of the domain name creates a likelihood of confusion among end users as to affiliation or sponsorship, and includes trade-mark infringement and passing off (see *Great Pacific Industries Inc v. Ghalib Dhalla, supra*);

The evidence shows that the Registrant used and uses the Disputed Domain Name to redirect Internet users automatically to the website www.rogers.com, a direct competitor of the Complainant. By using a domain name which is identical except for the addition "L". the Registrant is likely to confuse Internet users that bell.ca would connect them to the Complainant's website, or that the Registrant's website is endorsed by, or affiliated with the Complainant. Further information provided by the Service Provider indicates that, the Complainant advised that the Disputed Domain Name site now resolved to pornographic and/or obscene web pages.

It is clear that by using the Disputed Domain Name, the Registrant is competing with the Complainant and disrupting its business.

I find that the Registrant registered the Disputed Domain Name primarily for the purpose of disrupting the business of the Complainant who is a competitor of the Registrant.

Accordingly, and for the reasons stated above, the Complainant has satisfied the onus required of it by clause (b) of Paragraph 4.1 of the Policy that the Registrant registered the Disputed Domain Name in bad faith as described in Paragraph 3.7 of the Policy.

Legitimate Interest of the Registrant

The Complainant must provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Name.

In Paragraph 3.6 an exhaustive list is applied which provides that a Registrant has a “legitimate interest” in a domain name “if, and only if,” before a Complaint is filed, the domain name in question meets the criteria of one or more of the six tests.

Use of Mark

There is no evidence that the Registrant ever used the domain name as a Mark in good faith with any wares, services or business and there is no evidence to indicate that the Complainant authorized or consented to the use of its mark by the Registrant. The use of the Disputed Domain Name accordingly does not constitute a good faith or bona fide use of a Mark. The Registrant cannot rely of the application of 3.6(a).

Use of Clearly Descriptive Name or Generic Name

The second and third tests set out in paragraph 3.6(b) and 3.6(c) are that the disputed domain name was used by the registrant in Canada in good faith in association with any wares, services or business and that such domain name was clearly descriptive of such wares, services and business. There is no evidence that the Complainant ever authorized the Registrant or consented to the Registrant’s use of its mark and accordingly would be excluded from the application of 3.6(b) and 3.6(c)). Apart from not having made good faith use of the domain name, the domain name is not understood in Canada to be a generic name thereof in any language.

Use for non-commercial activity, or of a Geographical Location

The fourth and sixth tests contained in Paragraph 3.6 (d) and (e) are that the registrant used the disputed domain name in Canada in good faith in association with a non-commercial activity of the registrant or the geographical name of the location of such non-commercial activity.

There is no evidence that the Disputed Domain Name is the geographical location of the Registrant’s non-commercial activity or place of business. In fact evidence shows that the Registrant wishes to sell the Disputed Domain Name or lease it to the Complainant. This does indicate a non-commercial activity.

Use of Registrant’s Name

The fifth test contained in paragraph 3.6(e) is that the disputed domain name comprised the legal name of the registrant, or was a name, surname or other reference by which the registrant was commonly identified.

There is no evidence to that effect.

On examination of the evidence and the tests to be applied one must conclude that none have been satisfied to justify a legitimate interest of the Registrant in the use of the Disputed Domain Name.

I find that the Complainant in accordance with Paragraph 4.1 (c) of the Policy has provided sufficient evidence that the Registrant has no legitimate interest in the Disputed Domain Name as described in Paragraph 3.6 of the Policy.

Balance of Probabilities

Even if a Complainant has met the burden of proof contained in Paragraph 4.1, a complaint will be dismissed if the Registrant is able to prove on a balance of probabilities that the Registrant has a legitimate interest in the disputed domain name. Such “legitimate interest” must meet one or more of the six tests described in Paragraph 3.6 and referred to above. This balance of probabilities test deals with the situation where even though a complainant has satisfied all of the burdens of proof contained in Paragraph 4.1, a Panel believes that justice requires the registrant succeed. In finding against a registrant, the Panel is depriving that registrant with a potential property interest and accordingly should be satisfied on a balance of probabilities of a legitimate interest of the registrant before finding against the registrant.

In the case at hand, the Panel is satisfied that on a balance of probabilities, based on the evidence before it that the Registrant has no legitimate interest in the Disputed Domain Name.

DECISION AND ORDER

I find the Complainant has succeeded in this proceeding initiated under the Policy.

I therefore direct that the registration of the Disputed Domain Name; namely, bell.ca be transferred to the Complainant.

Dated, this 30th day of August, 2005.

(sgd) Elizabeth Cuddihy

Elizabeth Cuddihy, QC
Sole Panelist