

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

Complainant: Internet Movie Database, Inc

Complainant Counsel: Neil P. Melliship
Clark Wilson LLP
800 – 885 West Georgia Street
Vancouver. BC V6C 3H1

Registrant: 384128 Canada Inc

Disputed Domain Name: imdb.ca

Registrar: MyID.ca (Creative Pixels Inc.)

Panelists: Elizabeth Cuddihy, Q.C.
Kenneth A. Gamble
R. John Rogers

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

BCICAC File Number: DCA-873-CIRA

PROCEDURAL HISTORY

1. The BCICAC is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy of the Canadian Internet Registration Authority (CIRA).
2. On September 16, 2005, the Complainant filed a Complaint against the Registrant with the BCICAC seeking that the Registrant’s right of ownership of the domain name, imdb.ca (the “Disputed Domain Name”) be arbitrated in accordance with the CIRA’s Domain Name Dispute Resolution Rules (the “Rules”) and that an order be made pursuant to the CIRA Domain Dispute Resolution Policy (the “Policy”) that the registration of the Disputed Domain Name be transferred to the Complainant’s nominee 626664 B.C. Ltd.
3. The Complaint 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. By way of letter dated September 16, 2005, the BCICAC so advised the parties and forwarded a copy of the Complaint to the Registrant for response.

4. The Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office (“CIPO”), which mark is owned by the Complainant and accordingly the Complainant satisfies the Canadian Presence Requirements for Registrants.
5. The Registrant requested an extension for delivery of its Response to October 25, 2005 which was granted by the BCICAC. On October 25, 2004, the Registrant delivered a response which was found to be non-compliant. The Registrant was so advised and provided a further 10 day notice to remedy the instances of non-compliance. On November 4, 2005, the Registrant delivered its Response to the BCICAC in compliance with the Policy and Rules, which, following review by the BCICAC, was forwarded to the Complainant. On November 8, 2005, the Registrant informed the BCICAC that it had delivered an incorrect version of its Response and requested permission to deliver a correct version. With the agreement of the Complainant, the BCICAC accepted another (corrected) copy of the Response.
6. By letter November 14, 2005, the BCICAC, acting in accordance with paragraph 6 of the Rules, named the Panel for this proceeding.
7. As the Complaint and the Response were filed in English, English shall be the language of the proceeding.

FACTS

8. Internet Movie Database, Inc (“IMDb”) is one of the world’s best known providers of movie reviews, information and searching services, which it offers from its web site at imdb.com. This web site has been operated by IMDb and its predecessor in title, IMDb, Inc since 1996 and the trade name and trade mark IMDB has been used in association with movie reviews, information and searching services since that date worldwide including in the United States and Canada.
9. IMDB is a mark as defined in the Policy and Internet Movie Database, Inc (“IMDb”) claims rights as defined in the Policy in the mark as a common law trade mark and trade name prior to November 10, 2000, the date of registration of the disputed Domain Name (“imdb.ca”) by the Registrant and continues to have such rights.
10. On June 15, 2001, IMDb filed an application with the Canadian Intellectual Property Office (“CIPO”) for registration of the Trade mark IMDB in connection with its services which mark was approved for registration on August 29, 2003 and matured to registration as TMA602949 on February 23, 2004.
11. On August 6, 2004, on becoming aware of the registration of the Disputed Domain Name by the Registrant, a representative of IMDb’s parent company, Amazon.com emailed the then administrative contact for the Disputed Domain Name stating IMDb’s position regarding the registration of the Disputed Domain Name and

requesting transfer of the Disputed Domain Name in exchange for reimbursement of the costs of the initial registration.

12. On August 7, 2004 the administrative contact Drew Bradstone denied unauthorized use of the IMDB trademark, admitted that the web site associated with the Disputed Domain Name showed advertisements that he claimed were picked by the “domainsponsor” to whose web site the Disputed Domain Name resolved at that time, and claimed that the Disputed Domain Name was “being reserved for a future project”.
13. On August 24, 2004, external counsel for IMDb wrote the Registrant demanding transfer of the Disputed Domain Name (“First Demand Letter”). No response was received.
14. The CIRA WHOIS database a few months later reflected a change in the Administrative contact for the Registrant to Ali Atif.
15. Also at some time, it is not known when, after August 24, 2004, the site to which the Disputed Domain Name resolves was modified to resolve to a site titled “Famous Quotes: Inspiration & Motivation 4 Discovery & Balance” and claimed to be a site containing “a very selective collection of famous inspirational and motivational quotes”. The only operational page of the Disputed Domain Name is its home page, which has the phrase “COMING SOON” written in large, red font. All but one of the links that appear on the left side of the home page of this web site, which initially appeared to contain the substance of the web site, resolve to a page that displays “IMDB.CA” and “ERROR MESSAGE: The Page Cannot Be Found”. The Error Message suggests that the viewer go to the QUOTATIONS.CA homepage, which is a generic portal site registered to 3824179 Canada Inc, with Ali Atif listed as the Administrative Contact. The QUOTATIONS.CA domain name was registered on November 8, 2000. The site has not materially changed since.
16. On August 30 2005 a further demand letter was sent to Ali Atif, the administrative contact of record for the Registrant (“Second Demand Letter”).
17. On September 8, 1005, an email response from a writer identified as “Ken” explained the development of the Disputed Domain Name Site but in conclusion acknowledged that its web site was not yet released and that the Registrant might be willing “by major stretch of the imagination” to discuss the potential of an amicable transfer under the following conditions:
 - that any discussion about the potential transfer of the Disputed Domain Name must be kept confidential and at no time can be used in any court of law for whatever reason and under any scenario
 - discussion would be about transfer of an asset and never about any claims of trademark
 - discussion free of any legal jargon and be in simple English

- reserve the right to withdraw from any discussion if we feel any of the above are being violated
- discussion must end on October 15

POSITION OF THE PARTIES

THE COMPLAINANT – RIGHTS IN THE MARK PRIOR TO DATE OF REGISTRATION OF DISPUTED DOMAIN NAME

18. The Complainant submits that it had rights in the mark IMDB prior to November 8, 2000, the registration date of the Disputed Domain Name. IMDB qualifies as a mark under the Policy and it had common law rights as defined in the Policy in IMDB as a common law trade-mark and trade name in connection with the provision worldwide of movie reviews, information and searching services which it has offered and continues to offer from its web site at imdb.com since 1996.
19. The Complainant further submits that it filed a trade-mark application for IMDB on June 15, 2001 with CIPO, which mark matured to registration TMA502949 on February 23, 2004 as evidenced by extract of CIPO Trade-mark database.
20. The imdb.com web site has been operated by IMDb and its predecessor in title IMDb, Inc. since 1996 and the trade name and trade-mark IMDB have been used and continues to be used in association with movie reviews, information and searching services since that date. Further evidence provided by the Complainant shows not only use of IMDB worldwide including in Canada in connection with the provision of its services but the prominence and popularity of IMDB worldwide including the US and Canada.

THE COMPLAINANT - Disputed Domain Name Confusingly similar to the Mark

21. The Complainant alleges that the Disputed Domain Name is identical to the mark and relies on the resemblance test applied by a majority of CDRP panels to date and states that based on such findings, inasmuch as the Disputed Domain Name is identical to the mark, it is clearly confusingly similar as defined in the Policy to the IMDB Mark.

THE COMPLAINANT – Bad Faith Registration

22. The Complainant relies on paragraphs (b) and (c) of 3.7 of the Policy and surrounding circumstances as evidence of bad faith registration of the Disputed Domain Name.

Bad Faith under sub-paragraph (b) of 3.7 of the Policy

23. Relying on paragraph (b) of 3.7, the Complainant asserts that the Registrant registered or otherwise acquired the Disputed Domain Name to prevent IMDb from registering the Disputed Domain Name and the Registrant has engaged in a pattern of registering domain names that are well-known marks to prevent those who have Rights in the marks from registering such domain names.
24. The Complainant submits, that to claim, some three years following registration that a “future project” that the Registrant had in mind when the Disputed Domain Name was registered would not have materialized within that timeframe, is implausible. A more likely reason is that the Registrant intended to reap the benefits of the goodwill attached to the IMDB mark through attracting users to the Disputed Domain Name web site in order to generate advertising revenue and/or referral fees through posting links to third-party sites on that web site and through the attached “pop-under” links to departmentstore.ca (a generic portal site containing links to numerous e-commerce sites).
25. It further submits that the modification to the Disputed Domain Name web site following the August 24, 2004 demand letter from IMDb’s external counsel, to nothing other than a rudimentary web site without any real content, the lack of development of any of its approximately 200 .ca other domain name registrations, including its registrations of famous trade-marks and personalities (except the NHL.CA site which seems to have had the same kind of development as that of Disputed Domain Name) supports the assertion that the belated creation of a web site beyond a generic portal around the Disputed Domain Name is an attempt to give a colour of right or create an appearance of legitimacy to its registration of the Disputed Domain Name in order to prevent IMDb from obtaining such registration.
26. In addition, the Registrant’s record of .ca registrations clearly indicates that it has engaged in a pattern of registering well-known trade-marks as domain names. Many of these Domain Names are famous entertainment or sports related trade-marks or personality names including NHL.CA, NBABASBETBALL.CA, NFLFOOTBALL.CA, TRAGICALLYHIP.CA, and BOBMARLEY.CA. The web sites that each of the foregoing domain names link to are all generic portal sites which contain links to a number of e-commerce web sites (with the exception of NHL.CA as stated earlier). The only logical conclusion, it is submitted for registering all the domain names (through the Registrant and other related companies) and building similar portals around them is to generate referral fees from the Internet commerce web sites to which such portals link. To maximize such referral fees, the Registrant needs to generate as much traffic to its portals as possible. It is submitted that the tactic employed by the Registrant to create traffic is to exploit the reputation of famous trade-marks and personality names, such as IMDB. The number of such registrations and the reputation of the Marks that the Registrant and its related companies have exploited leaves very little doubt as to the business model of the Registrant.

Bad Faith under sub- paragraph (c) of 3.7 of the Policy

27. The Complainant also relies on paragraph (c) of 3.7 and asserts that the Registrant registered or otherwise acquired the Disputed Domain Name primarily for the purpose of disrupting the business of IMDb and the Registrant is a competitor of IMDb.
28. The registration and use of the Disputed Domain Name by the Registrant is causing IMDb to miss a portion of the Internet traffic that it would otherwise receive if IMDb were the registrant of imdb.ca. IMDb is an inherently distinctive mark, and the reputation of IMDb and its predecessor in title as pioneers and leaders in the field of movie related web sites and its commercial success have resulted in IMDb obtaining further distinctiveness. IMDb is a very well known trade-mark and trade name to Internet users throughout the world and in Canada. Because IMDb is a well-known trade-mark, users will often try to access the IMDb web site by typing imdb with a gTLD or ccTLD directly unto their web browser. If a user who intends to reach the IMDb website types imdb.ca and ends up accessing the Registrant's web site, the user will likely be confused into thinking that the Registrant's web site is associated or affiliated with IMDb. In particular, the Registrant's web site in its new form, claiming to be a web site dedicated to famous quotations, has a strong potential for creating confusion in the minds of users who are hoping to reach a web site with commentary of movies. The Complainant asserts that the Registrant is clearly competing with IMDb for the Internet traffic that is intended to reach IMDb's web site even though the Registrant does not provide the exact same services as those offered by IMDb. This form of competition has been clearly recognized in previous CDRP decisions as making a registrant a "competitor" of the complainant within the meaning of section 3.7 (c) of the Policy. (See *Amazon.com, Inc v. David Abraham*, CIRA Dispute Number 00018 (July 28, 2004), pp.6-7).

THE COMPLAINANT - Legitimate interest of the Registrant in imdb

29. The Complainant claims that the Registrant does not meet any of the criteria set out in Section 3.6 (a) to (f) of the Policy.
30. The web site associated with the Disputed Domain Name was initially a generic portal site with links to e-commerce web sites operated by others. Shortly after the delivery of the First Demand letter from external counsel for IMDb, the web site associated with the Disputed Domain Name changed to a web site titled "Famous Quotes: Inspiration & Motivation 4 Discovery & Balance". The new web site claims to contain "a very selective collection of famous inspirational and motivational quotes"; however, the only operational page of that web site is its home page, which has the phrase "COMING SOON" written in large, red font at the top. This web site does not contain any quotations, famous or otherwise. The site has not been used by the Registrant for the purpose of distinguishing its wares, services or business. Furthermore the Disputed Domain Name is not registered by the Registrant with

CIPO as a trade-mark (in fact, that mark is registered to IMDb) or a certification mark and has not been advertised under Section 9 of the Trade-marks Act. As such, the Disputed Domain Name does not constitute a Mark in which the Registrant has Rights, as defined under the Policy. The belated attempt by the Registrant to create a web site around the Disputed Domain Name, in order to give some colour of right to the Registrant's misappropriation of the mark IMDB, is a bad faith attempt on the part of the Registrant to prevent IMDb from obtaining the registration for the Disputed Domain Name. Consequently, even if the Registrant had rights in the Disputed Domain Name as a Mark, which is denied, its use of the Disputed Domain Name as a Mark would not be in good faith. Therefore the Registrant cannot claim the benefit of Section 3.6 (a) of the Policy.

31. The Disputed Domain Name is not descriptive of any wares, services or business as to quality or character, the condition of, or the persons employed in production, performance or operation of same as the case may be, or their place of origin. Nor is the Disputed Domain Name understood in Canada to be the generic name for any ware, service or business in any language. Accordingly the Registrant cannot claim under Section 3.6 (b) or (c) of the Policy.
32. No specific non-commercial activity is carried out in connection with the Disputed Domain Name. While the web site associated with the Disputed Domain Name claims that it will one day contain famous quotations, such use has not yet commenced. Furthermore the web site currently linked to by the Disputed Domain Name was created after the delivery of the First Demand letter to the Registrant in what appears to be an attempt by the Registrant to give some colour of right to its registration of the Disputed Domain Name. Therefore, it is submitted that the Registrant cannot rely on the web site currently associated with the Disputed Domain Name for proof of non-commercial activity, as the web site was not created in good faith. It is not clear also whether such a web site, even if it were active, would constitute non-commercial activity. Accordingly the Registrant cannot claim under section 3.6 (d) of the Policy.
33. Finally the Disputed Domain Name is not the legal name of the Registrant or a name, surname or other reference by which the Registrant is commonly identified, nor is it the name of any geographical location. Therefore the Registrant cannot claim the benefit of section 3.6 (e) or (f) of the Policy.

POSITION OF THE REGISTRANT

THE REGISTRANT- Rights in imdb

34. The Registrant in its submission observes that the filing with CIPO for registration of the trade-mark IMDB did not occur until June 15, 2001. The Registrant submits that if the Complainant did indeed have a common law trade-mark in the IMDB mark, that to protect this right, the Complainant should have registered the IMDB mark with

CIRA as a domain name when CIRA opened to the public on November 8, 2000. As it did not do so, it lost its right to the domain name imdb.ca. The Registrant asserts that the subsequent registration of the trade-mark IMDB with CIPO cannot be permitted to grant the Complainant a retroactive right to the Disputed Domain Name which registration occurred 7 months earlier on November 10, 2000.

THE REGISTRANT - Bad faith registration

35. The Registrant asserts that the Complainant has failed to prove that it acted in bad faith when it registered the Disputed Domain Name on November 8, 2000. The Registrant claims that imdb.ca like all its three hundred (300) .ca domain names has been parked with its registrar since the date of registration of the Disputed Domain Name. In response to the Second Demand Letter from the Complainant, it offered to give the Complainant a preview of the web site to show its legitimate development. It also advised that as its site was not yet released it was prepared to find an amicable solution and in that context set forth the conditions under which it would be prepared to discuss transferring the domain name to the Complainant for free. It contends imdb.ca will be a major resource for motivation and inspiration on the web including, but not limited to quotations. Two of its own domains, poetry.ca and canadianwriters.ca are among that series of web sites being designed as sister sites to IMDB.ca. Future plans include motivational speakers, self help workshops, and more.
36. The Registrant asserts that it is not a competitor of the Complainant and relies on the following excerpt from *Microsoft v. Microscience* CDRP 0034:
- The Panel finds that the meaning of “competitor” is, in substance, that from business or economic theory. For the Registrant and the Complainant to be competitors they would each have to offer in a marketplace, a good or a service, that could be at least imperfect substitutes for each other – such that in the right conditions of relative prices, etc, some consumers would consider buying the Registrant’s good or service instead of the Complainant’s good or service.
37. The Registrant is not offering anything that competes with the Complainant and in addition the 3 visitors a day that imdb.ca receives can under no scenario disrupt the business of a site that attracts 18 million unique visitors per month that IMDb alleges it receives.
38. The Registrant claims that it has never seen the eBay and self help ads submitted by the Complainant and accordingly cannot verify their authenticity, nor do, in the Registrant’s view, the ads submitted by the Complainant prove that they were generated upon the imdb.ca visit. The Registrant claims that the potential income would not be sufficient in any event to conclude that the Registrant used the domain commercially or banked on its traffic.

39. The Registrant claims that it has not engaged in a pattern of trademark infringement. It claims it is actively developing some 150 of its 300 domain names and asserts that the Complainant's allegations pertaining to only five of these domain names do not reflect a pattern of trademark infringement. It asserts that a trademark violation can only be made by the owner of the trademark and the Complainant's arguments about potential infringement are speculative.
40. The Registrant admits that with the exception of NHL and the Disputed Domain Name, the sites were registered in 2004 and "have been taken off our registrar free parking service...all intended for not for profit web sites". It further submits that 3.6 (c) includes as a legitimate interest "non-commercial activity including criticism, review, and news reporting" which is what these sites will be. (underlining added).
41. The Registrant further claims that it is not related to 3724144 or 3824179 Inc. The private registration service offered by its registrar purportedly explains why these companies and other have common Whois and corporate records info.

THE REGISTRANT - Legitimate interest under paragraph 4.1 (c) of the Policy

The Registrant claims an interest in the Disputed Domain Name as follows:

- 1) It registered a related domain name poetry.ca on October 28, 2000, ten days before CIRA opened its doors.
- 2) Nine days earlier on October 10, 2000, it incorporated a Canadian Company for the purpose of registering poetry.ca.
- 3) The poetry.ca site was created 10 days before imdb.ca and is still not released. It is in the same development stage as imdb.ca being ready for public beta testing.
- 4) The Registrant has not used IMDB commercially in any way. As demonstrated by the screenshots provided in evidence the Registrant was working on imdb.ca earlier than December 2002. The Registrant has numerous web sites that it aims to release together as a network of high quality Canadian web sites.
- 5) The Registrant currently has a very sophisticated and comprehensive web site now in public beta testing at imdb.ca and poetry.ca. Another related web site in the works is CanadianWriters.ca, all sister web sites that complement each other.
- 6) There was never any trademark application in CIPO at date of registration of the Disputed Domain Name and no one owned any common law rights to that mark in Canada as evidenced by the Complainant's behaviour.
- 7) The Registrant offers a different service from that of the Complainant and therefore does not compete with the Complainant.
- 8) The imdb.ca site is the best domain we can have for the project that we have worked on for more than 4 years.

DECISION

42. Paragraph 4.1 of the Policy places the onus on the Complainant to prove on a balance of probabilities that:

- (a) the Disputed Domain Name is confusingly similar to a Mark (IMDB) in which the Complainant had rights prior to the date of registration of the Disputed Domain Name and continues to have such rights;
- (b) the Registrant has registered the Disputed Domain Name in bad faith as described in paragraph 3.7; and
- (c) the Complainant must provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Name as described in paragraph 3.6.

43. Paragraph 4.1 of the Policy also provides that:

“even if the Complainant proves (a) and (b) and provides some evidence of (c), the Respondent 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”

CONFUSINGLY SIMILAR TO MARK IN WHICH COMPLAINANT HAD RIGHTS PRIOR TO REGISTRATION OF THE DISPUTED DOMAIN NAME

44. In our view, the Complainant has met the onus that the Registrant’s Domain Name imdb.ca is confusingly similar to the Complainant’s Mark IMDB and the Complainant had rights in the mark as defined in the Policy prior to the registration of the Disputed Domain Name and continues to have such rights.

45. Paragraph 3.2 of the Policy defines mark under 4 categories including:

- (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.

46. Paragraph 3.3 of the Policy 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 tile or a licensor of that person or predecessor

47. While it is accepted that the Disputed Domain Name was registered prior to the date the mark was registered in CIPO, and that popularity of a site or number of mechanical hits from a search engine does not of itself (underlining added) demonstrate rights to a mark, the Panel is satisfied that the Complainant had rights in the Mark, which was used in Canada and worldwide by the Complainant and its predecessor in title well before that date. In support of the finding, the Panel refers to

Spencer Douglass MGA v. Absolute Bonding Corporation WIPO Case No. D2001-0904 where the Panel states at p.5 “where the evidence of record supports the Complainant’s assertions of common law service mark rights, the Panel can conclude that the Complainant has such rights.”

48. In our view, the Complainant has also met the onus that the Registrant’s Domain Name is confusingly similar to the Complainant’s Mark.

49. Paragraph 3.4 of the Policy defines “confusingly similar” as follows:

“(a) domain name is “Confusingly Similar” to a Mark if the domain name so nearly resembles the Mark in appearance, sound or ideas suggested by the Mark as to be likely to be mistaken for the Mark”

50. In our view “imdb.ca “is confusingly similar to the Mark “IMDB”.

51. Based on the foregoing, the Panel finds that the Complainant has proven, on a balance of probabilities, that the Disputed Domain Name is confusingly similar to the IMDB 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 = PARAGRAPH 4.1 OF THE POLICY

52. 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 provides that “if and only if” any one of the three tests set forth in paragraphs 3.7 (a), (b), or (c) is met will the Registrant be considered to have registered a domain in bad faith. (underlining added). The Complainant has not sought to establish paragraph (a).

REGISTRATION IN BAD FAITH – PARAGRAPH 3.7 (b) OF THE POLICY

53. Therefore, for the issue at hand to satisfy paragraph 3.7 (b) the Complainant must, on a balance of probabilities, establish that the Registrant effected its registration to prevent the Complainant from registering its Mark as a domain name and that the Registrant has, alone or in concert with one or more additional persons, engaged in a pattern of registering domain names to prevent other parties from registering their Marks as domain names.

54. The Registrant admits that it has some 300 .ca domain names none of which have been released but expects to release some 150 in the near future. It submits that it has been working on its sites for some years and it is due to the complexity of their structure that they have not been released.

55. It is quite clear that by registering its domain name, the Registrant prevented the Complainant from registering its Mark as a domain name. However, whether or not the Registrant has engaged in a “pattern” of registering domain names to prevent other parties from registering their Marks is more difficult. The term “pattern” is not defined in the Policy. Cases decided under the Policy do not suggest any steadfast rule as to what constitutes a pattern. Rather, examination is had to the surrounding circumstances to determine if a particular domain name registration is part of a pattern of bad faith registration. (See *Canadian Broadcasting Corporation/Société Radio-Canada v. William Quan*, British Columbia International Commercial Arbitration Centre, Case No.00006 where the Panel held that as few as two (2) domain names was sufficient to establish a “pattern”). The Complainant provides evidence of the Registrant registering domain names, which include well known trade-marks, famous entertainment or sport related or personality names, including NHL.CA, NBABASKETBALL.CA, NFLFOOTBALL.CA, TRAGICALLYHIP.CA and BOBMARLEY.CA. The web sites to which each of the foregoing links (except for NHL.CA) are all generic portal sites which contain links to a number of e-commerce sites. In the case of NHL.CA, the same rudimentary development as the IMDB site was demonstrated. Of the 5 sites referred to by the Complainant, the Registrant submits that it has taken them off its free parking service and they are all intended for not for profit web sites. Based on the facts at hand, we believe that on the balance of probabilities the Complainant has established the pattern required of it by paragraph 3.7 (b).
56. We therefore agree that the Complainant has met the test contained in paragraph 3.7(b).

REGISTRATION IN BAD FAITH – PARAGRAPH 3.7 (c) OF THE POLICY

57. With respect to paragraph 3.7 (c), the Complainant must establish on a balance of probabilities that:
- “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”
58. The Registrant submits that it is not a competitor of the Complainant and relies on the finding of the Panel in CDRP 00034 *Microsoft v. Microscience* as noted above. The Registrant further submits that it does not intend to provide the same kind of service as the Complainant and accordingly its site does not disrupt the business of the Complainant.
59. A narrow interpretation of the “competitor” 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 “competition” encompasses attracting users to a site as well as the marketing of specific wares or services offered by that site.

60. From the evidence presented by the Complainant its Mark “IMDB” is not generic or descriptive. It is an inherently distinctive mark and the reputation of IMDb and its predecessor in title as pioneers and leaders in the field of movie related web sites and its commercial success have resulted in the IMDB mark obtaining further distinctiveness. If a user, intending to access IMDb’s web site by typing in the Mark “IMDB” accesses the Registrant’s site (especially the site in its new form claiming to be a site dedicated to famous quotations), the user will likely be confused into thinking that the Registrant’s web site is associated or affiliated with IMDb. 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* CIRA Dispute Number 00009, April 21, 2003, pp20-21)
61. While the Registrant does not intend to provide the exact same services as those offered by IMDb, the Registrant is clearly competing directly with the Complainant for Internet traffic, the very traffic that is intended for IMDb. As referenced by the Complainant, this form of competition has been clearly recognized in previous CDRP decisions as making a registrant a “competitor” of the Complainant within the meaning of paragraph 3.7 (c) of the Policy.
62. Based on the evidence, we are satisfied that the Complainant has, on a balance of probabilities, established what is required of it by paragraph 3.7 (c) of the Policy.
63. We therefore believe that the Complainant has satisfied the onus placed upon it by paragraph 4.1(b) of the Policy and demonstrated that the Registrant has registered the domain name in bad faith as described in paragraph 3.7 of the Policy

LEGITIMATE INTEREST IN DOMAIN NAME – 4.1 (c) OF THE POLICY

LEGITIMATE INTERESTS PARAGARAPH 3.6 OF THE POLICY

64. The remaining question is whether or not the Registrant has proven on a balance of probabilities that he has a legitimate interest in the Domain Name as such “legitimate interest” as defined in paragraph 3.6. A review of paragraph 3.6 indicates that none of the sub-paragraphs are applicable in the matter at hand except for possibly (d). The Registrant has submitted that on October 10, 2000, it incorporated a Canadian corporation for the purpose of registering, on October 28, 2000 a related domain

name “poetry.ca”. Ten days later it registered IMDB.ca. While it claims it has been working on these sites for some five years, it has yet to release them.

65. It is clear that the Registrant used the Domain Name to identify a web site. However, this is not enough. Under sub-paragraph 3.6 (d) he must use the Domain Name “in good faith in association with a non-commercial activity, including without limitation, criticism, review or news”. We believe that this phrase should be interpreted as meaning a present offering of non-commercial activity and not a future offering of an activity some five years in the future. In other words, this provision would not apply to permit a Registrant to “park” a domain name to be used for a non-commercial activity to be provided some time in the future.
66. We find that the Registrant has failed to prove on a balance of probabilities that it has a legitimate interest in the Disputed Domain Name as provided in paragraph 3.6 of the Policy and based upon the Complainants’ submission, we find that the Complainant has satisfied the onus placed on it pursuant to paragraph 4.1 (c) of the Policy.

ORDER

67. In accordance with our decision as set out above, we direct that the registration of the Domain Name “IMDB.CA” be transferred to the Complainant’s nominee 626664 B.C. Ltd.

Date: December 2, 2005

Elizabeth Cuddihy, Q.C., Kenneth A. Gamble and R. John Rogers

(sgd) Elizabeth Cuddihy

Elizabeth Cuddihy, Q.C.
Chair