

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number: DCA-893-CIRA
Domain Name: houseofblues.ca
Complainant: House of Blues Brands Corp.
Registrant: Artbravo Inc.
Registrar: MyReg.ca
Panel: Rodney C. Kyle (Chairperson), Pierre-Emmanuel Moyse, Michel D. Manson
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

PARTIES

Complainant is **House of Blues Brands Corp.**, of 6255 Sunset Boulevard, 16th Floor, Hollywood, California (“Complainant”), represented by Donna G. White and Samantha J. Gervais, of Osler, Hoskin & Harcourt LLP, of Ottawa Ontario.

Registrant is **Artbravo Inc.**, of 18 Marcel Place, Hamilton, Ontario (“Registrant”).

REGISTRAR AND CONTESTED DOMAIN NAME

The contested domain name is <**houseofblues.ca**> (“the contested domain name”), registered with **MyReg.ca**.

PANEL

Rodney C. Kyle as Panel Chairperson, Michael D. Manson and Pierre-Emmanuel Moyse as Co-Panelists. Chairperson Kyle writes for the Panel.

Each of the Panelists certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as a Panelist in this proceeding (“the Proceeding”).

PROCEDURAL HISTORY

Complainant submitted a Complaint to the British Columbia International Commercial Arbitration Centre (“the BCICAC”) electronically, and by hard copy, on 23 December 2005.

On 23 December 2005,

- (i) in accordance with CIRA Dispute Resolution Rules Version 1.2 (“Resolution Rules”) ¶ 4.3 made under CIRA Dispute Resolution Policy Version 1.1 (the

- “Policy”), and in the manner prescribed by Resolution Rules ¶ 2.1, the BCICAC sent the Complaint to Registrant; and
- (ii) in accordance with Resolution Rules ¶ 4.4 and pursuant to Resolution Rules ¶ 2.6, the BCICAC sent a notice of the commencement of the Proceeding to Registrant, setting a deadline of 16 January 2006 by which Registrant could file a Response to the Complaint.

Registrant requested a 20-day extension of that deadline. On 11 and 12 January 2006, in accordance with Resolution Rules ¶ 5.4, the BCICAC granted that request, setting a deadline of 6 February 2006.

On 3 February 2006, a timely Response was received and determined to be complete.

On 15 February 2006, a Further Submission was received from Complainant.

On 16 February 2006, in accordance with Resolution Rules ¶ 6, the BCICAC appointed the above-named Panelists in their above-mentioned capacities, gave at least the Parties and the Panel notice of those appointments, and forwarded the file for the Proceeding to the Panel.¹ In accordance with Resolution Rules ¶¶ 7.1 and 7.2, prior to accepting appointment each Panelist provided the BCICAC with his declaration of his independence and impartiality.

On 8 March 2006, on behalf of the Panel, the BCICAC put the following request to the Parties:

- In accordance with Resolution Rules ¶ 11.1, the Panel hereby requests that
- (i) Complainant provide through the BCICAC, to both Registrant and the Panel, within five calendar days of the date of delivery of this request to the Parties,
 - (a) the name of a nominee of Complainant, that Complainant contends satisfies the CPR in respect of the contested domain name and
 - (b) submissions as to how that named nominee satisfies the CPR in respect of the contested domain name; and
 - (ii) Respondent provide through the BCICAC, to both Complainant and the Panel, within five calendar days of the date of delivery of submissions (i)(a) and (b) of this list to Respondent, submissions as to whether that named nominee does not satisfy the CPR in respect of the contested domain name.

(The above-referenced “CPR” is CIRA’s Canadian Presence Requirements For Registrants Version 1.3.)

¹ That notice also stated 9 March 2006 as the date by which the Panel is to forward its decision in the Proceeding to the BCICAC. On 7 March 2006, in accordance with Policy ¶ 4.2 and Resolution Rules ¶¶ 9.1(c) and 1.4, the date of 9 March 2006 was extended to 29 March 2006; on 8 March 2006, the BCICAC notified the Parties thereof.

On 13 March 2006, Complainant submitted a timely response to the Panel's request and, on 17 March 2006, Registrant submitted a timely response thereto.

RELIEF SOUGHT

Complainant requests that the Panel order the transfer of the contested domain name from Registrant to Complainant or to HOB Concerts Canada Ltd. ("Complainant's Nominee").

Registrant requests

- (i) dismissal of the Complaint;
- (ii) a declaration that the Complaint was commenced by Complainant for the purpose of attempting, unfairly and without colour of right, to cancel or obtain a transfer of the contested domain name;
- (iii) an order that Complainant pay the BCICAC \$5,000 in trust for Registrant to defray the costs incurred by Registrant in preparing for, and filing material in, the Proceeding; and
- (iv) an order that Complainant pay Registrant \$10,000 in punitive damages, if the Panel finds Complainant or Complainant's counsel acted in bad faith and purposely misled the Panel.

PARTIES' CONTENTIONS

A. Complainant

Basically, in the Complaint, Complainant makes four main sets of contentions.

FIRST MAIN SET

In the first main set of contentions, Complainant at least contends that Complainant is eligible to initiate the Proceeding. More particularly, Complainant makes two separate main contentions, the second of which depends on the first. First, Complainant contends that as evidenced by Canadian trade-mark registration documents in Complaint Schedule A, at the time of submitting the Complaint, Complainant is the owner of four trade-marks registered in the Canadian Intellectual Property Office:

- (i) HOUSE OF BLUES registration 492,084 filed 11 March 1993 and registered 30 March 1998;
- (ii) HOUSE OF BLUES registration 538,754 filed 11 September 1992 and registered 15 December 2000;
- (iii) HOUSE OF BLUES & Design registration 621,356 filed 14 April 1999 and registered on 1 October 2004; and
- (iv) HOUSE OF BLUES & Design registration 648,431 filed 16 June 1999 and registered 19 September 2005.

Second, Complainant contends that, as a result of being the owner of those registrations, Complainant satisfies CIRA's Canadian Presence Requirements.

SECOND MAIN SET

In the second main set of contentions, Complainant basically makes contentions by way of three points.

The first point is that as evidenced by Complaint Schedule F the contested domain name became registered to Registrant immediately upon expiry of a grace period (i.e. 29 October 2005) and continues to be registered to Registrant.

The second point is that, in view of what is set out in the remainder of this paragraph, there are several instances of a “Mark” (within the meaning of that expression as defined by Policy ¶ 3.2) comprising HOUSE OF BLUES and in which Complainant, prior to the date of registration of the contested domain name, had, and continues to have, “Rights” (within the meaning of that expression as defined by Policy ¶ 3.3). In addition to the above-contended four trade-mark registrations, Complainant also contends that as evidenced respectively by Complaint Schedule B, and by Complaint Schedule C, there are other Complainant-owned Canadian applications and registrations for trade-marks, and Complainant-owned United States trademark registrations, comprised of or containing HOUSE OF BLUES. Complainant further contends that as evidenced in Complaint Schedule D, entities named in the Complaint as being related to Complainant own various domain name registrations listed in the Complaint and which include “houseofblues” or its acronym. Still further, Complainant contends that Complainant runs a website resolving through one of those domain names (as evidenced by the Complaint Schedule E print-outs of information from that website) and that Complainant uses the rest of those domain names to direct internet traffic to that website. Moreover, Complainant contends that

- (i) the HOUSE OF BLUES trade-marks have been used in Canada under license continuously since 1999 by one of those named related entities;
- (ii) said named related entity registered the contested domain name on 17 October 2000;
- (iii) through administrative inadvertence, said registration expired on 27 September 2005;
- (iv) the expiry was not noticed by Complainant until early November 2005, which was after a 30-day grace period for renewal had expired; and
- (v) between that registration date and that expiry date, Complainant used the contested domain name to direct internet traffic to Complainant’s website.

The third point is that the contested domain name is “Confusingly Similar” (within the meaning of that expression as defined by Policy ¶ 3.4) to that Mark. More particularly, Complainant contends by two sub-points that the contested domain name so nearly resembles one or more of Complainant’s HOUSE OF BLUES trade-marks and, in particular, Complainant’s trade-mark HOUSE OF BLUES, in appearance, sound and idea as to be likely to be mistaken for one or more of those trade-marks:

- (i) in appearance and sound, the contested domain name is not only confusingly similar but, in view of Policy ¶ 1.2, is identical; and
- (ii) in idea, the contested domain name is confusingly similar because the Mark was coined to identify a business concept associated especially with music generally and with blues music particularly, has no generally understood meaning other than to identify Complainant and Complainant’s wares and services and related

entities, and does not have any descriptive capacity of the sort contended by Registrant in correspondence with Complainant (i.e. correspondence on 28 November 2005, and evidenced in Complaint Schedule I, to the effect that the contested domain name was registered along with two other specified domain names with the intended use of promoting what is commonly referred to as Pablo Picasso's blue period).

(Complainant also contends that Registrant's registration of those two other specified domain names occurred on 31 October 2005 and 28 November 2005 respectively, and that such registration is evidenced by Complaint Schedule J.)

THIRD MAIN SET

In the third main set of contentions, Complainant basically contends that Registrant has no "legitimate interest" (within the meaning of that expression as defined by Policy ¶ 3.6) in the contested domain name.

More particularly, by six main sub-points, Complainant contends that Registrant's use of the contested domain name does not satisfy Policy ¶ 3.6:

- (i) as to Policy ¶ 3.6(a), that the contested domain name is comprised of a Mark in which Registrant had no rights and which Registrant did not use in good faith, in that
 - (a) as evidenced by the website printout that is Complaint Schedule G, at least as early as 16 November 2005, Registrant was using the contested domain name as part of a revenue generating business conducted by re-directing the contested domain name (as part of a multitude of domain names) to a third-party website expressly referring especially to music generally and to blues music particularly, and at which referral fees were to be generated,
 - (b) as evidenced by Complaint Schedule H, on 21 November 2005, by registered mail, Registrant received an 18 November 2005 notice from Complainant's counsel, asserting the above-mentioned trade-marks and requesting Registrant transfer the contested domain name to Complainant, and
 - (c) as evidenced by Complaint Schedule K, at least as early as 6 December 2005, after Registrant's receipt of that notice, Registrant's use of the contested domain name to re-direct internet traffic in that way ended and was replaced by re-directing internet traffic to a picture of a painting;
- (ii) as to Policy ¶ 3.6(b), Registrant has never been commonly known by the name "HOUSE OF BLUES" or by the contested domain name, and Registrant has neither acquired nor applied for a trade-mark in such name or used such name in association with any wares, services or business;
- (iii) as to Policy ¶¶ 3.6(c) and (f), the mark HOUSE OF BLUES does not have any generic meaning in Canada (as it is exclusively associated with Complainant and with Complainant's related entities) and is neither a known geographical name of a location nor, to Complainant's knowledge, in use by Registrant either to carry out any non-commercial activity or to have any place of business in, a geographical entity called "House of Blues";

- (iv) as to Policy ¶ 3.6(d), there is no evidence that Registrant has used the contested domain name in good faith in association with a non-commercial activity;
- (v) as to Policy ¶ 3.6(e), the contested domain name is neither Registrant's legal name nor the name by which Registrant is commonly identified; and
- (vi) Complainant has not licensed or otherwise permitted Registrant either to use any of the above-mentioned Complainant's trade-marks or to apply for or use any domain name incorporating those marks.

FOURTH MAIN SET

In the fourth main set of contentions, Complainant basically contends that Registrant has registered the contested domain name in "bad faith" (within the meaning of that expression as defined by Policy ¶ 3.7).

More particularly, by two main sub-points, Complainant contends that Registrant has registered the contested domain name contrary to Policy ¶ 3.7:

- (i) as to Policy ¶ 3.7(b), by way of five specific contentions, basically that Registrant has registered the contested domain name for the purpose of preventing Complainant from registering the mark HOUSE of BLUES as the contested domain name and Registrant 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, in that
 - (a) Registrant owns a further domain name, as evidenced by the WHOIS information that is Complaint Schedule N,
 - (b) Registrant uses that further domain name to resolve a web site, as evidenced by the website print out that is Complaint Schedule L,
 - (c) Registrant carries on business through that website, as evidenced by the user agreement that is Complaint Schedule M,
 - (d) the business Registrant carries on through that website includes that Registrant engages in buying and selling domain names (a number of which correspond to trade-marks), as evidenced by the WHOIS information (and the corresponding website print outs) that are Complaint Schedule O, and
 - (e) the business Registrant carries on through that website more particularly includes that Registrant or its director own 1,741 ".ca" domain names, as evidenced by the Complaint Schedule P request to and search report from CIRA, and a number of those domain names correspond to well-known Canadian trade-mark registrations, as evidenced by the examples provided by the WHOIS information (and the print outs from the corresponding websites and from the Canadian Intellectual Property Office on-line database entries) that are Complaint Schedule Q; and
- (ii) as to Policy ¶ 3.7(c), by way of three specific contentions, that Registrant is a competitor of Complainant and has registered the contested domain name primarily for the purpose of disrupting the business of Complainant, in that as evidenced by the website printout that is Complaint Schedule G, prior to the above-mentioned 18 November 2005 notice from Complainant's counsel,

- (a) Registrant was using the contested domain name as part of a revenue generating business conducted by re-directing the contested domain name (as part of a multitude of domain names) to a third-party website which expressly referred especially to music generally and to blues music particularly, and which included links to various music-related entities that offer wares and services in competition with Complainant,
- (b) Registrant was clearly competing with Complainant for internet traffic in that Registrant was engaged in a revenue earning operation since referral fees were to be generated through use of those links or of other links on that website, and
- (c) since Registrant chose the contested domain name so as to match a famous trade-mark and well known business operation, and to match a domain name which, until inadvertent expiry, directed extensive internet traffic to Complainant's website, Registrant was profiting from misdirected internet traffic that never meant to visit that Registrant-related website and, in view of that Registrant-related website expressly referring especially to music generally and to blues music particularly, Registrant clearly knew of (and attempted to trade on the goodwill and fame of) Complainant's trade-marks and business operations associated especially with music generally and with blues music particularly.

B. Registrant

Basically, in the Response, Registrant makes (or does not make) contentions as to five main sets of points.

FIRST MAIN SET

In response to Complainant's first main set of contentions, Registrant does not dispute any of the Complaint's general or specific contentions as to Complainant eligibility to initiate the Proceeding.

SECOND MAIN SET

In response to Complainant's second main set of contentions, Registrant does not dispute any of the Complaint's general or specific contentions as to

- (i) the contested domain name being registered to Registrant and the contended date on which the contested domain name became registered to Registrant;
- (ii) there being a "Mark" (within the meaning of that expression as defined by Policy ¶ 3.2) comprising HOUSE OF BLUES and in which Complainant, prior to the date of registration of the domain name, had, and continues to have, "Rights" (within the meaning of that expression as defined by Policy ¶ 3.3); or
- (iii) the contested domain name being "Confusingly Similar" (within the meaning of that expression as defined by Policy ¶ 3.4) to that Mark.

Registrant does, however, contend that "House of" and "houseof" are common elements of many trade indicia (evidenced by the copies of directory extracts and of search engine results that respectively are Response Schedule O and Response Schedule P) and that

“blue” and “blues” are common words (evidenced by Response Schedule H, i.e. the copies of dictionary extracts regarding those words).

THIRD MAIN SET

In response to Complainant’s third main set of contentions, Registrant basically contends that Registrant has a “legitimate interest” (within the meaning of that expression as defined by Policy ¶ 3.6) in the contested domain name. However, aside from what is set out in the next paragraph hereof, Registrant does not dispute Complaint’s contentions to the contrary.

More particularly, Registrant’s contention has two main parts “i” and “ii”:

- (i)
 - (a) Registrant disputes whether, at least as early as 16 November 2005, Registrant was using the contested domain name as part of a revenue generating business conducted by re-directing the contested domain name (as part of a multitude of domain names) to a third-party website expressly referring especially to music generally and to blues music particularly, and at which referral fees were to be generated, and, Registrant contends, Response Schedule J (comprising an 18 November 2005 letter from Complainant to Registrant as well as internet archive results and a newly constructed web page) evidence that such use did not occur and
 - (b) instead, Registrant contends that Registrant has used the contested domain name in good faith in association with a non-commercial activity, specifically that the contested domain name was registered along with two other specified domain names with the intended use of promoting what is commonly referred to as Pablo Picasso’s blue period and that, immediately after the 29 October 2005 registration of the contested domain name, Registrant instructed its web designer to have the contested domain name direct internet traffic to a picture of a painting from that period (as evidenced by the copy of the painting that is Response Schedule I); and
- (ii) Registrant is the owner of trade-mark registration application 1284735 submitted on 30 December 2005 for HOUSEOFBLUES.CA and, Registrant contends, as a result, pursuant to Policy ¶ 3.1(a), Registrant has continuous rights under sections 35 and 39(1) of Canada’s *Trade-marks Act*, and, Registrant further contends, Response Schedule H (comprising sections of that statute, Collins English Dictionary extracts regarding the words “blue” and “blues”, and Canadian trade-mark registration documents regarding that application and regarding one of Complainant’s registrations) evidences those rights.

FOURTH MAIN SET

In response to Complainant’s fourth main set of contentions, Registrant basically contends that Registrant has not registered the contested domain name in “bad faith” (within the meaning of that expression as defined by Policy ¶ 3.7). However, aside from what is set out as item “i” in the immediately preceding paragraph hereof, Registrant does not dispute the Complaint’s contentions to the contrary.

FIFTH MAIN SET

The fifth main set of contentions in the Response basically is that in view of what is set out as item “i” in the third main set of Registrant’s contentions,

- (i) the Complaint was commenced by Complainant for the purpose of attempting, unfairly and without colour of right, to cancel or obtain a transfer of the contested domain name, and that such unfairness and lack of colour of right are especially evidenced by contended inconsistencies within the Complaint (i.e. Complaint Schedules G and H) and between the Complaint and the Response (i.e. those Complaint Schedules as compared to Response Schedules J and K);
- (ii) the costs claimed as incurred by Registrant in preparing for, and filing material in, the Proceeding are \$5,000, and that such a costs are evidenced by expense-related documents comprising Response Schedule Q; and
- (iii) \$10,000 in punitive damages should be awarded to Registrant, if the Panel finds Complainant or Complainant’s counsel acted in bad faith and purposely misled the Panel.

C. Further Submissions

In view of the Panel’s disposition of the Complaint, the Panel finds it need not summarize, or even consider, Complainant’s non-requested Further Submission.

In response to the Panel’s request for Further Submissions, Complainant’s contentions refer expressly to CPR ¶¶ 2(d) and 2(q) and to Policy ¶ 1.4, but not to Policy ¶ 4.3, and include that Complainant’s Nominee

- (i) is a company incorporated under the laws of the province of Ontario in 1999;
- (ii) has Ontario corporation number 1375127;
- (iii) subsists under the laws of the province of Ontario; and
- (iv) satisfies CPR ¶ 2(d).

In response, Registrant does not dispute any of contentions “(i)” through “(iv)” of this paragraph, and instead basically makes two contentions likewise referring expressly to Policy ¶ 1.4 but not to Policy ¶ 4.3. First, that the trade-mark registrations submitted by Complainant indicate that Complainant, and not Complainant’s Nominee, is the owner thereof. Second, as a result of that first contention, Complainant’s Nominee “should not be admitted or allowed for consideration in these proceedings.”

FINDINGS

The Panel finds

- (i) Complainant is eligible to initiate the Proceeding in that, as required by Policy ¶ 1.4, at the time of submitting the Complaint, the Complaint relates to at least one trade-mark registered in the Canadian Intellectual Property Office and Complainant is the owner of that at least one trade-mark;
- (ii) Registrant is required to submit to the Proceeding in that, as required by Policy ¶ 3.1, the Complaint is substantially “submitted in compliance with the Policy and the Resolution Rules” and contains assertions of each of the Policy ¶ 3.1 elements “(a)”, “(b)”, and “(c)” and that in any event Registrant has submitted to the Proceeding;

- (iii) the Panel decides in favour of Complainant in that, in accordance with Policy ¶ 4.1,
 - (a) the contested domain name is registered to Registrant, from 29 October 2005,
 - (b) there is a “Mark” (within the meaning of that expression as defined by Policy ¶ 3.2) comprising HOUSE OF BLUES and in which Complainant had “Rights” (within the meaning of that expression as defined by Policy ¶ 3.3) prior to the date of registration of the contested domain name and continues to have such Rights,
 - (c) the contested domain name is “Confusingly Similar” thereto (within the meaning of that expression as defined by Policy ¶ 3.4),
 - (d) Registrant has no “legitimate interest” (within the meaning of that expression as defined by Policy ¶ 3.6) in the contested domain name, and
 - (e) Registrant has registered the contested domain name in “bad faith” (within the meaning of that expression as defined by Policy ¶ 3.7); and
- (iv) the contested domain name should be transferred to Complainant in that, the Panel has unanimously decided in favour of Complainant and a majority of the Panel finds Complainant satisfies the CPR in respect of the contested domain name as a result of any of the four above-mentioned Complainant-owned CIPO-registered trade-marks, whereas a minority of the Panel would find that the contested domain name should be transferred to Complainant’s Nominee in that, in accordance with Policy ¶ 4.3, Complainant does not satisfy the CPR in respect of the contested domain name but
 - (a) the Panel has decided in favour of Complainant,
 - (b) Complainant has named Complainant’s Nominee, and
 - (c) Complainant’s Nominee satisfies the CPR in respect of the contested domain name.

DISCUSSION

Introduction

Policy ¶ 4.2 and Resolution Rules ¶¶ 9.1(a), 11.2, and 12.1 respectively instruct this Panel to “render its decision in accordance with the Policy and the Resolution Rules,” “conduct the Proceeding in such manner as it considers appropriate in accordance with the Policy and the Resolution Rules,” treat “[t]he Complaint, the Response and any additional evidence and argument submitted pursuant to [Resolution Rules ¶ 11.1 as constituting] the complete record to be considered by the Panel in the Proceeding,” and “render a decision in a Proceeding on the basis of the evidence and argument submitted and in accordance with the Policy, the Resolution Rules and any rules and principles of the laws of Ontario, or, if the Registrant is domiciled in Quebec, the laws of Quebec, or, if a preference for the laws of another province or territory has been indicated by both parties, the laws of the other province or territory and, in any event, the laws of Canada applicable therein.”

In view especially of the immediately preceding paragraph hereof, the Panel notes four rules and principles of law that it especially considers to be generally appropriate for ascertaining whether provisions of the Policy and Resolution Rules are satisfied. First, that

Both [dispositive] and evidential facts must, under the law, be *ascertained* in some one or more of four possible modes: 1. By judicial admission (what is not disputed); 2. By judicial notice, or knowledge (what is known or easily knowable); 3. By judicial perception (what is ascertained directly through the senses; *cf.* “real evidence”); 4. By judicial inference (what is ascertained by reasoning from facts already ascertained by one or more of the four methods here outlined).²

Second, especially as to mode “3,” that Policy ¶ 4.2 and Resolution Rules ¶ 9.1(d) respectively provide that the Panel shall “consider all the evidence presented in the Proceeding” by determining “the admissibility, relevance, materiality and weight of the evidence.”³ Third, as to construing and applying Policy ¶ 4.2 and Resolution Rules ¶ 9.1(d), especially as to whether mode “1” rather than mode “3” applies: a complainant’s pleading of fact that is not disputed (or, phrased differently, not “put in issue”) by a registrant against whom it is contended, is an admission by that registrant,⁴ so evidence tendered as being rationally probative of (i.e. as being “relevant to”) establishing that fact becomes immaterial, and hence inadmissible, as to establishing that fact.⁵ Fourth, as to

² W.N. Hohfeld, “Some Fundamental Legal Conceptions as Applied in Judicial Reasoning,” 23 *Yale L. J.*, 16, at 27, footnote 23 (emphasis in original).

³ For example, (i) where the Panel is satisfied as to the authenticity of a copy of a document or other thing, that copy may be admitted as evidence; and (ii) the Panel may admit as evidence, whether or not given or proven under oath or affirmation or admissible as evidence in a court, any document or other thing, relevant to the subject-matter of the Proceeding and may act on such evidence, but the Panel may exclude anything unduly repetitious, and (a) nothing is admissible in evidence, that is inadmissible by any statute and (b) nothing in the preamble of part “(ii)” of this sentence overrides the provisions of any Act expressly limiting the extent to or purposes for which any documents or things may be admitted or used in evidence in the Proceeding. *Cf. Arbitration Act, 1991*, S.O. 1991, c. 17, s. 21 as to *Statutory Powers Procedures Act*, R.S.O. 1990, c. S.22, ss. 15(4), 15(1)(b), 15(2)(b), and 15(3).

See also *Black’s Law Dictionary*, 5th ed. (St. Paul, Minnesota: West Publishing Co., 1979), at 277 (“Consider. To fix the mind on, with a view to careful examination; to examine; to inspect. To deliberate about and ponder over. To entertain or give heed to. See also Considered.”) and at 278 (“Considered. ... For example, evidence may be said to have been ‘considered’ when it has been reviewed by a court to determine whether any probative force should be given to it.”).

⁴ See, e.g., Resolution Rules ¶¶ 5.2(C)(d), 5.2(C)(i), and 11.5: Resolution Rules ¶ 5.2(C)(d) includes that “The Response will ... respond ... specifically to the evidence and the arguments in the Complaint and include reference to any and all bases for the Registrant to maintain the Registration of each domain name in issue, including in particular why the Registrant should be considered as having a legitimate interest in the domain name as described in paragraph 3.6 of the Policy”; Resolution Rules ¶ 5.2(C)(i) includes that “The response will ... have any Schedules, together with an index thereto, annexed”—“Schedule” being defined by Resolution Rules ¶ 1.1(j) as meaning “documentary or other evidence, including without limitation a copy of any trade-mark registration, articles of incorporation or trade name registration, upon which a Party relies annexed to a Complaint, a Response or a written request, as the case may be”; and Resolution Rules ¶ 11.5 includes that “If a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Resolution Rules ... the Panel shall draw such inferences therefrom as it considers appropriate.” Resolution Rules ¶¶ 5.2(C)(d) and 5.2(C)(i) are each clearly a “provision of, or requirement under, the Resolution Rules” within the meaning of that expression as it appears in Resolution Rules ¶ 11.5.

⁵ Compare Hohfeld, *supra* note 2 (mode “1”) with Ronald Joseph Delisle, *Evidence Principles and Problems* 5, (1st ed. 1984):

The concept of relevancy is simply dictated by our own present insistence on a rational method of

whether mode “2” rather than either of mode “1” or mode “3” applies, a canvassing of law and commentary shows that

It was not desirable, nor indeed possible, to foreclose the trier’s use of background information but should the matter noticed be in the forefront of the controversy, should the fact be determinative, the law protected the adversary by insisting that the matter be so commonly known, and hence indisputable, that its notice could not prejudice the opponent.⁶

and that “The party who has the burden of proof on the issue may have to call on the trier to judicially notice the fact when it comes time to analyze the question.”⁷

Complainant Eligibility to Initiate the Proceeding

Policy ¶ 1.4 has first and second parts,⁸ and the first of the two separate main contentions of Complainant’s first main set of contentions can reasonably be taken to amount to contentions that Complainant is eligible under the second part of Policy ¶ 1.4 to initiate the Proceeding.

In this regard, Complainant is eligible to initiate the Proceeding. More specifically, the second part of Policy ¶ 1.4 is proven as to Complainant, in that, as required by Policy ¶

fact-finding.

However, not only must the evidence tendered be rationally probative of the fact sought to be established; the fact sought to be established must concern a matter in issue between the parties, i.e. it must be material. ...

The law of evidence then principally consists of the study of canons of exclusion, rules regarding admissibility, which deny receipt into evidence of information [that] is rationally probative of a matter in issue between the parties.

Therefore, evidence that is immaterial, or is material but irrelevant, is inadmissible, and even evidence that is material and relevant may still be inadmissible in view of further inadmissibility rules of evidence law.

⁶ Delisle, *supra* note 5, at 94. See e.g. *R. v. Find* [2001] 1 S.C.R. 863 at para. 48 that a court “may properly take judicial notice of facts that are either: (1) so notorious or generally accepted as not to be the subject of debate among reasonable persons; or (2) capable of immediate and accurate demonstration by resort to readily accessible sources of indisputable accuracy.” See also e.g. *R. v. Malmo-Levine*; *R. v. Caine* [2003] 3 S.C.R. 571 at para. 28 and *Public School Boards’ Assn. of Alberta v. Alberta (Attorney General)* [2000] 1 S.C.R. 44 at para. 5.

Similarly, the Panel may take notice of facts that may be judicially noticed and of any generally recognized scientific or technical facts, information or opinions within its scientific or specialized knowledge; *cf. Arbitration Act, 1991*, S.O. 1991, c. 17, s. 21 as to *Statutory Powers Procedures Act*, R.S.O. 1990, c. S.22, s. 16.

⁷ Delisle, *supra* note 5, at 91. *Cf. Levesque v. Levesque*; *Birmingham v. Birmingham* (1994), 116 D.L.R. (4th) 314 at 324-325 (Alta. C.A.).

⁸ Policy ¶ 1.4 is as follows:

1.4 Eligible Complainants. 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**”) (currently available at http://www.cira.ca/en/cat_Registration.html) 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.

1.4, the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office (“CIPO”) and Complainant is the owner of the trade-mark; indeed, it relates to four such registered trade-marks of Complainant.

Registrant’s not disputing Complainant’s contentions relating to this topic results in the third of the four rules and principles of law set out above in the last paragraph of the “Introduction” portion of this discussion applying: those Complainant contentions are admitted by Registrant, such that as to establishing those facts Complaint Schedule A is immaterial and hence inadmissible.

Having found, that under the second part of Policy ¶ 1.4, Complainant is eligible to initiate the Proceeding, the Panel need not address the following in connection with the topic of Complainant eligibility to initiate the Proceeding: the second of the Complaint’s two separate main contentions (set out above) that can reasonably be construed as relating to initiating the Proceeding. (That second contention is that as a result of those four Complainant-owned CIPO-registered trade-marks, Complainant satisfies CIRA’s Canadian Presence Requirements.)

Complaint Compliance

Policy ¶ 3.1 (preamble) includes that Registrant must submit to the Proceeding if the Complaint is “submitted in compliance with the Policy and the Resolution Rules.”⁹ The Complaint basically includes an assertion of Complaint compliance with Policy ¶ 3.1: the Complaint asserts generally that the Complaint is submitted for decision in accordance with the Policy and the Resolution Rules, and asserts particularly each of what amounts to the Policy ¶ 3.1 elements “(a)”, “(b)”, and “(c)”. In any event, Registrant has in turn submitted to the Proceeding.

Confusing Similarity

The context in which this part of this discussion occurs includes Policy ¶¶ 3.2,¹⁰ 3.3,¹¹ and 3.4¹² (which respectively define the expressions “Mark,” “Rights,” and “Confusingly

⁹ Policy ¶ 3.1 is as follows:

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.

Similar” that appear in Policy ¶ 4.1(a) and 3.5¹³ (which defines “use” and “used,” which appear in Policy ¶¶ 3.2 and 3.3).

¹⁰ Policy ¶ 3.2 is as follows:

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).

¹¹ Policy ¶ 3.3 is as follows:

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.

¹² Policy ¶ 3.4 is as follows:

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.

¹³ Policy ¶ 3.5 is as follows:

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

Complainant's second main set of contentions amounts to a contention that Complainant satisfies the Policy ¶ 4.1(a) onus. Even if Registrant is construed as having contended that "HOUSE OF" and "BLUES" are incapable of being part of satisfying Policy ¶ 4.1(a), Registrant has not contended that same thing of "HOUSE OF BLUES". Instead, in any event, the following three paragraphs set out that Complainant does indeed satisfy the Policy ¶ 4.1(a) onus.

Contested Domain Name Registered to Registrant

Registrant's not disputing Complainant's contentions relating to this topic results in the third of the four rules and principles of law set out above in the last paragraph of the "Introduction" portion of this discussion applying: those Complainant contentions are admitted by Registrant, such that as to establishing those facts Complaint Schedule F is immaterial and hence inadmissible as to the contested domain name being registered to Registrant. Indeed, in the Response, Registrant expressly admits that the date of such registration was 29 October 2005.

Complainant "Rights" in One or More "Marks"

Registrant's not disputing Complainant's contentions relating to this topic results in the third of the four rules and principles of law set out above in the last paragraph of the "Introduction" portion of this discussion applying: those Complainant contentions are admitted by Registrant, such that as to establishing those facts Complaint Schedules A to E are immaterial and hence inadmissible as to Complainant having "Rights" in one or more "Marks".

Policy ¶ 3.4: "Confusingly Similar"

Registrant's not disputing Complainant's contentions relating to this topic results in the third of the four rules and principles of law set out above in the last paragraph of the "Introduction" portion of this discussion applying: those Complainant contentions are admitted by Registrant, such that as to establishing those facts Complaint Schedules I and J are immaterial and hence inadmissible as to the contested domain name being "Confusingly Similar" to one or more of the "Marks" in which Complainant has "Rights".

Legitimate Interests

The context in which this part of this discussion occurs includes Policy ¶¶ 3.5 (which defines "use" and "used," and is set out above in the "Confusing Similarity" part of this discussion) and 3.6 (which is expressly referred to in Policy ¶ 4.1(c), refers to "use" and "used," and defines domain-name registrant legitimate interests in a disputed domain name).¹⁴

(c) promoting or advertising of the non-commercial activity.

¹⁴ Policy ¶ 3.6 is as follows:

Complainant's third main set of contentions amounts to a contention that Complainant satisfies the Policy ¶ 4.1(c) onus (by a pleading of Policy ¶ 4.1(c) and of negatives of Policy ¶¶ 3.6(a) to 3.6(f), together with the corresponding Complaint Schedules G, H, and K).

As indicated by the next four paragraphs of this decision, Complainant's contentions of the negatives of Policy ¶¶ 3.6(a) to 3.6(f) are proven. More specifically, Complainant's contentions of the negatives of Policy ¶¶ 3.6(e) and 3.6(f) are not disputed by Registrant, and are therefore admitted by Registrant, and Complainant's contentions of the negatives of Policy ¶¶ 3.6(a) to 3.6(d) are put in issue by two sets of Registrant's contentions but are nonetheless proven by Complainant.

One of those two sets of Registrant's contentions disputes whether, at least as early as 16 November 2005, Registrant was using the contested domain name as part of a revenue generating business conducted by re-directing the contested domain name (as part of a multitude of domain names) to a third-party website expressly referring especially to music generally and to blues music particularly, and at which referral fees were to be generated; Registrant relies on Response Schedule J as being evidence that such use did

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, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;
- (d) 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;
- (e) 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;
- (f) 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
- (g) 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.

not occur. That same set of contentions also includes the contention that Registrant has used the contested domain name in good faith in association with a non-commercial activity, specifically that the contested domain name was registered along with two other specified domain names with the intended use of promoting what is commonly referred to as Pablo Picasso's blue period and that, immediately after the 29 October 2005 registration of the contested domain name, Registrant instructed its web designer to have the contested domain name direct internet traffic to a picture of a painting from that period (as evidenced by the copy of the painting that is Response Schedule I).

The other of those two sets of Registrant's contentions is that Registrant is the owner of trade-mark registration application 1284735 submitted on 30 December 2005 for HOUSEOFBLUES.CA and, Registrant contends, as a result, pursuant to Policy ¶ 3.1(a), Registrant has continuous rights under sections 35 and 39(1) of Canada's *Trade-marks Act*, and, Registrant further contends, Response Schedule H (comprising sections of that statute, Collins English Dictionary extracts regarding the words "blue" and "blues", and Canadian trade-mark registration documents regarding that application and regarding one of Complainant's registrations) evidences those rights.

As a result of the first of those two sets of Registrant's contentions, Complaint Schedules G, H, and K, as well as Response Schedules I and J, are material, relevant, and admissible.¹⁵ The Panel has considered them and finds that Complaint Schedules G, H, and K are of sufficient weight to prove exactly the Policy ¶ 4.1(c) contentions Complainant contends they prove, as to Registrant not having a legitimate interest in the contested domain name, whereas Response Schedules I and J are not of sufficient weight to prove what Registrant contends they prove: there is no good faith use of the contested domain name by Registrant within any of the provisions of Policy ¶ 3.6. More specifically, at least as early as 16 November 2005, Registrant was using the contested domain name as part of a revenue generating business conducted by re-directing the contested domain name (as part of a multitude of domain names) to a third-party website expressly referring especially to music generally and to blues music particularly, and at which referral fees were to be generated. Registrant's contention that instead Registrant has used the contested domain name in good faith in association with a non-commercial activity, specifically that the contested domain name was registered along with two other

¹⁵ The Panel takes this opportunity to state an observation of general applicability regarding material and relevant evidence proffered in the Complaint Schedules and Response Schedules: as to the contended facts, whether or not to any extent any of the Complaint Schedule and Response Schedule documents are hearsay, they appear to be admissible either as a result of one or more statutory provisions or under the "business records" exception to the hearsay rule. (As to such statutory provisions, see e.g. (i) item "(i)" of the first para. of *supra* note 3; and (ii) *Evidence Act*, R.S.O. 1990, c. E.23, ss. 1, 2, 25.) As for the hearsay rule, in this Proceeding, hearsay is evidence, by an intermediary, of an extrajudicial testimonial assertion, where the assertor does not give evidence in this Proceeding. (See e.g., Delisle, *supra* note 5, at 203.) As for the "business records" exception to the hearsay rule, "business" is meant to include every kind of business, profession, occupation, calling, operation or activity, whether carried on for profit or otherwise, "record" is meant to include any information that is recorded or stored by means of any device, and "business record" is meant to include a record made in the usual and ordinary course of business. (See e.g., Delisle, *supra* note 5, at 237-243 and *Ares v. Venner* [1970] S.C.R. 608; and *cf. Evidence Act*, R.S.O. 1990, c. E.23, s. 35.)

specified domain names with the intended use of promoting what is commonly referred to as Pablo Picasso's blue period and that, immediately after the 29 October 2005 registration of the contested domain name, Registrant instructed its web designer to have the contested domain name direct internet traffic to a picture of a painting from that period, is not proven.

As a result of the second of those two sets of Registrant's contentions, Response Schedule H is also material. However, Response Schedule H is as to a "Proposed Use" trade-mark registration application filed in CIPO on 30 December 2005 (i.e. after the 23 December 2005 receipt by Registrant of notice from or on behalf of Complainant that the Complaint was submitted), so Response Schedule H is outside the scope of the preamble of Policy ¶ 3.6, and therefore is irrelevant and inadmissible or, in any event, of no weight.

Registration in Bad Faith

The context in which this part of this discussion occurs includes Policy ¶ 3.7, which is expressly referred to in Policy ¶ 4.1(b) and defines bad-faith registration of a disputed domain name.¹⁶

Complainant's fourth main set of contentions amounts to a contention that Complainant satisfies the Policy ¶ 4.1(b) onus, by a pleading of Policy ¶ 4.1(b) together with Policy ¶ 3.7(b) (with Complaint Schedules L to Q) and Policy ¶ 3.7(c) (with Complaint Schedule G).

Complainant's Policy ¶ 4(1)(b) contentions regarding Policy ¶¶ 3.7(c) and 3.7(b) are proven. More specifically, Complainant's contentions of Policy ¶ 3.7(c) bad faith registration (i.e. that Registrant is a competitor of Complainant and has registered the contested domain name primarily for the purpose of disrupting the business of

¹⁶ Policy ¶ 3.7 is as follows:

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.

Complainant) are put in issue by Registrant's contentions but are nonetheless proven by Complainant. Much of the same evidence the Panel considered under the heading of "Legitimate Interests" (such as Complaint Schedule G and Response Schedules I and J) is proffered by each of the Parties under this heading, and it is material, relevant, and admissible. Likewise, as under the heading of "Legitimate Interests", Complainant's evidence in that regard is of sufficient weight to prove Complainant's contentions, this time being Policy ¶ 4(1)(b) contentions regarding at least Policy ¶ 3.7(c), whereas Registrant's contentions and Registrant's proffered evidence no more avail Registrant in this context than they do regarding "Legitimate Interests". Moreover, Complainant's contention basically of Policy ¶ 3.7(b) (i.e. that Registrant has registered the contested domain name for the purpose of preventing Complainant from registering the mark HOUSE of BLUES as the contested domain name and Registrant 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), is also proven: Complainant's contentions contended to be evidenced by Complaint Schedules L to Q are proven and Registrant contentions to the contrary are not proven.

Remedy-Eligibility

Summary

The Panel unanimously finds the following Registrant contention on the topic of remedy eligibility is irrelevant: that the four above-mentioned Complainant-owned CIPO-registered trade-marks being Complainant's, rather than being Complainant's Nominee's, make for Complainant's Nominee not being "admitted or allowed for consideration in these proceedings". Complainant's Nominee not being the owner is irrelevant both to Complainant eligibility under Policy ¶ 1.4 to initiate the Proceeding and to Complainant's Nominee's eligibility under Policy ¶ 4.3 to be named in the Proceeding as an entity to whom the contested domain name would be transferred.

The Panel also unanimously finds that apparently neither the majority's approach nor the minority's approach prejudices Registrant: either way, in this case, the contested domain name would apparently no longer be registered to Registrant.

A majority of the Panel finds that the contested domain name should be transferred to Complainant, in view of two facts. First, the Panel has unanimously decided in favour of Complainant. Second, the majority finds Complainant satisfies the CPR in respect of the contested domain name as a result of any of the four above-mentioned Complainant-owned CIPO-registered trade-marks.

In contrast, a minority of the Panel would find that the contested domain name should be transferred to Complainant's Nominee in that, in accordance with Policy ¶ 4.3, Complainant does not satisfy the CPR in respect of the contested domain name but three further requirements are met. First, the Panel has unanimously decided in favour of Complainant. Second, Complainant has named Complainant's Nominee. Third, Complainant's Nominee satisfies the CPR in respect of the contested domain name, since Complainant's four-point contention of fact (set out above) regarding CPR-compliance of

Complainant's Nominee has not been disputed by Registrant and therefore has been admitted by Registrant.

Procedural Background

Policy ¶ 4.3 has two parts.¹⁷ Neither the Complaint nor Complainant's Further Submission in response to the Panel's request, includes any contentions expressly referring to either part. However, the Complaint implicitly relies on the first part of Policy ¶ 4.3. That implicit reliance is indicated by two aspects of the Complaint:

- (i) the second of the Complaint's two separate main contentions (set out above) that can reasonably be construed as at least regarding Policy ¶ 1.4 Complainant eligibility to initiate the Proceeding (i.e. the contention that as a result of the four above-mentioned Complainant-owned CIPO-registered trade-marks, Complainant satisfies the CPR); and
- (ii) the Complaint's request for transfer of the contested domain name to Complainant (rather than to a nominee).

Within the Panel, the minority is of the view that such implicit reliance was a procedural error whereas the majority is of the view that it was what Complainant was entitled to do.

On the one hand, a majority in the Panel is of the view that the Complaint's request for transfer of the contested domain name to Complainant (rather than to a nominee) was not any sort of error by Complainant, because any of those four Complainant-owned CIPO-registered trade-marks makes Complainant satisfy the CPR in respect of the contested domain name, such that, if the Panel decides in favour of Complainant, Complainant has a right to a decision from the Panel that the contested domain name should be transferred to Complainant.

On the other hand, a minority in the Panel is of the view that the Complaint's reliance on the first part of Policy ¶ 4.3 is apparently a procedural error resulting from Complainant having inadvertently confused two processes. The two processes are

- (i) the process referred to in the preamble and body of CPR ¶ 2(q), which is a process for applying to CIRA (through a CIRA certified registrar) for registration of particular ".ca" domain names— a process which the wording of the body of CPR ¶ 2(q)
 - (a) expressly provides is applicable to such applications,
 - (b) expressly provides is limited to such applications, and
 - (c) implicitly provides is inapplicable to other processes; and
- (ii) the process referred to in the Policy, for entering a dispute resolution agreement and carrying out a dispute resolution proceeding, wherein the remedy of cancellation or

¹⁷ Policy ¶ 4.3 is as follows:

4.3 Remedies. If the Panel decides in favour of the Complainant, the Panel will decide whether the Registration should be cancelled or transferred to the Complainant or in the case where the Complainant does not satisfy the CPR in respect of the domain name that is subject of the Proceeding, a nominee of the Complainant that satisfies the CPR in respect of the domain name that is subject of the Proceeding (the "**Nominee**").

transfer of a “.ca” domain name can be sought by a complainant.

Unanimous Framework on Policy ¶ 4.3: Task, Type, Text, & Context

The Panel is unanimous that

- (i) in this case, the Panel has to interpret, construe, and apply Policy ¶ 4.3;
- (ii) Policy ¶ 4.3 is not law and instead is part of a specific type of contract between the Parties, a dispute resolution agreement;¹⁸
- (iii) the contract between the Parties comprises the following instruments:
 - (a) instruments incorporated by reference directly or indirectly into Registrant’s “.ca” domain name registration agreement regarding the contested domain name, being the Policy, the Resolution Rules, and the CPR and
 - (b) the Complaint submitted substantially, as put by Policy ¶ 3.1, “in compliance with the Policy and the Resolution Rules”, including to contain assertions of each of the Policy ¶ 3.1 elements “(a)”, “(b)”, and “(c)”;¹⁹ and
- (iv) the context in which the Panel is to interpret, construe, and apply Policy ¶ 4.3 includes those instruments and the law regarding interpretation, construction, and application of such instruments, including that adjudicators in a proceeding are not bound by the fact that, in that proceeding, contentions of law have been implied or expressed by a complainant and not disputed by a respondent.

Unanimous Framework on Interpreting, Construing, & Applying Contracts

The Panel is also unanimous that the law regarding interpreting, construing, and applying contract instruments includes

- (i) that “the process of determining the meaning to be given to words in a document is governed by the same principles regardless of whether the process is engaged in the context of a contract claim or a tort claim and is captured in the following question: Bearing in mind the relevant background, the purpose of the document, and considering the entirety of the document, what would the parties to the document reasonably have understood the contested words to mean?”;²⁰

¹⁸ See e.g. Rodney C. Kyle, “[Are Canadian and Other Domain Name Dispute Resolution Processes Arbitrations?](#)” In *The Proceedings of the Thirteenth Annual Conflict Resolution Symposium: 2004*, (Ottawa: Carleton University, 2005), 111 at 129 to 131[66KB PDF: crs_2004_kyle].

¹⁹ See e.g. Kyle, *supra* note 18 at 114 to 119 and *ITO v. Miida Electronics Ltd.* [1986] 1 S.C.R. 752, following *New Zealand Shipping Co. Ltd. v. A.M. Satterthwaite & Co. Ltd.*, [1974] 1 All E.R. 1015 (P.C.) which applies *Carlill v. Carbolic Smoke Ball Company*, [1893] 1 Q.B. 256 (C.A.); and *cf.* (1) *Civil Code of Quebec*, C. c. Q., arts. 1444 and 1445 basically with “stipulator” replaced by “CIRA”, “third person beneficiary” replaced by “[actual or] prospective Complainant”, and “promisor” replaced by “Registrant” and (2) *Restatement of Contracts* (Second), American Law Institute, 1981, sections 302(1)(b) and 304 with “promisor” replaced by “Registrant”, “promisee” replaced by “CIRA” and “beneficiary” replaced by “Complainant”. As for interpreting such C. c. Q. contracts, see e.g. arts. 1425 to 1431.

²⁰ *Eli Lily and Co. v. Novopharm Ltd.* [1998] 2 S.C.R. 129 (S.C.C.) at 166-67, 161 D.L.R. (4th) 1 as applied in *Toronto-Dominion Bank v. Leigh Instruments Ltd. (Trustee of)* 45 O.R. (3d) 417 (Ont. C.A.) at 419h-420a.

- (ii) “as a whole, giving effect to everything in it if at all possible. No word should be superfluous (unless of course ... it is truly meaningless and can be ignored)”,²¹ although an expression might not necessarily have the same meaning throughout the whole instrument;²²
- (iii) that in “cases of repugnancy within the contract ... if the dissonant clauses can be read harmoniously this must be done. If not, then the repugnant part must be rejected in order to give effect to the general intent of the parties as evidenced by the contract as a whole, rather than any particular, and jarring language. If there is a conflict between two parts of the document, the dominating purpose must prevail, as indicating the real intentions of the parties”²³ but “the question of whether there is repugnancy must first be answered”;²⁴
- (iv) that the acceptance of reading an implied provision into an agreement “‘is a matter of law, arising where the parties would have intended the stipulation in question’. Such an implication can be made only if the parties intended to imply the term in question, *e.g.*, for the purposes of business efficiency. A term cannot be implied simply on the ground of ‘fairness’”²⁵ and “requires more than a court might think it reasonable to make such an implication. It is firmly based on the idea that courts are seeking to discover what the parties intended, not what the court thinks reasonable”²⁶ so “there can be no implication of a term contrary to an express intention of the parties”;²⁷
- (v) that “only what is necessary may be implied, not what is reasonable in the eyes of the court”²⁸ and “[t]here has to be strong evidence to support the conclusion that the implication of a term is permissible in the circumstances”²⁹ — “[t]o be implied, a term must be (1) reasonable and equitable; (2) necessary to give business efficacy; (3) so obvious that it goes without saying; (4) capable of clear expression; and (5) not contradictory of an express term in the contract”³⁰

²¹ *The Law of Contract in Canada*, G.H.L. Fridman, Carswell, 3rd edition, Toronto, 1999 at 494; hereinafter, footnotes omitted, unless otherwise stated.

²² Fridman, *supra* note 21, at 494 (i.e. included in the footnote of the passage quoted in *supra* note 21) and at 498.

²³ Fridman, *supra* note 21, at 494 to 495.

²⁴ Fridman, *supra* note 21, at 495 (i.e. included in the footnote of the passage quoted in *supra* note 23).

²⁵ Fridman, *supra* note 21, at 501.

²⁶ Fridman, *supra* note 21, at 500.

²⁷ Fridman, *supra* note 21, at 495 (i.e. included in the footnote of the passage quoted in *supra* note 26).

²⁸ Fridman, *supra* note 21, at 509.

²⁹ Fridman, *supra* note 21, at 501.

³⁰ Fridman, *supra* note 21, at 501 (i.e. included in the footnote of the passage quoted in *supra* note 29).

- and “[i]t would seem that there are three main instances when this may be done: (i) when it is reasonably necessary, having regard to the surrounding circumstances, and in particular the previous course of dealing between the parties, if any; (ii) when there is an operative trade or business usage or custom that may be said to govern the relationship between the parties; and (iii) when some statute of its own motion implies a term into the kind of contract that is in question”;³¹ and
- (vi) “[i]n cases of doubt, as a last resort, ... against the grantor or promisor under the contract ... [i.e.] *contra proferentum*”³² in which case “it is necessary to find the ambiguity in the contract first, before applying the [*contra proferentum*] rule, not after”.³³

Unanimous Framework on Interpreting, Construing, & Applying the DR Agreement

When it comes to law regarding interpreting, construing, and applying the dispute resolution agreement, as a starting point the Panel is unanimous that the dispute resolution agreement is neither so ambiguous nor so unclear as to “be considered invalid and fail ... [for being] too vague and unclear in its wording”.³⁴ That said, the Panel is also of the view that the scope and interaction of instruments that become part of dispute resolution agreements (such as the Policy, the Resolution Rules, and the CPR) could perhaps usefully be clarified by CIRA.

Furthermore, the Panel is also unanimous that the law regarding interpreting, construing, and applying the dispute resolution agreement includes that the agreement is to be interpreted, construed, and applied

- (i) “according to its language and in light of the circumstances in which it was made”;³⁵
- (ii) through “a search for the ‘intentions of the parties whose document it is’”;³⁶
- (iii) through applying the applicable law rather than on the basis of the Panel’s own notion of fairness.³⁷

³¹ Fridman, *supra* note 21, at 501.

³² Fridman, *supra* note 21, at 495.

³³ Fridman, *supra* note 21, at 495.

³⁴ Robert M. Nelson, *Nelson on ADR*, (Toronto, Ontario: Thomson Canada Limited, 2003), at 161 citing *Benner & Associates Ltd. v. Northern Lights Distribution Inc.* (1995), 22 B.L.R. (2d) 79 (Ont. Gen. Div.).

³⁵ Nelson, *supra* note 34, at 151 citing *Heyman v. Darwins* [1942] A.C. 356 (H.L.) at 370 to 371.

³⁶ Nelson, *supra* note 34, at 155 quoting C.L. Elderkin and J.S. Shin Doi (i.e. Behind the Boilerplate: Drafting Commercial Agreements, Toronto: Carswell, 1998, at 120 to 121) which cites and quotes *Onex Corp. v. Ball Corp.* (1994), 12B.L.R. (2d) 151, [1994] O.J. No. 98 (Gen. Div.).

³⁷ Nelson, *supra* note 34, at 162 citing *Faubert v. Temagami Mining Co.* (1959), 17 D.L.R. (2d) 246 (Ont. C.A.) at 257, affirmed [1960] S.C.R. 235.

- (iv) by giving it “a large, liberal and remedial interpretation to effectuate the dispute resolution goals of the parties”;³⁸ and
- (v) in such a way that “does not overly distort the ordinary meaning of the words used and simultaneously avoids practical, legal and jurisdictional problems.”³⁹

Unanimous Framework on Effecting Justice Through and in Accordance with Law

Within the Panel, both the majority and the minority

- (i) view their decision-making in the Proceeding as requiring a balancing, in accordance with law, of the formal realizability of justice through law (i.e. legal rule stability, legal rule certainty, and legal rule predictability) against the substantive realizability of justice (i.e. flexibility, and fairness, in an individual instance of legal decision-making); and
- (ii) recognize that each of those two end-members is inherently opposed to one another, and would often, on its own, tend to not effect completely just results.⁴⁰

Divergence

Where the Panel’s majority and minority diverge is as to how, and at what point, a balance between those two end-members for effecting justice through and in accordance with law is to be struck, when it comes to whether a complainant is required to name a nominee to receive a transfer of a contested domain name.

On the one hand, the Panel’s majority is of the view that Complainant is not required to name a nominee because the CPR 2(q) limitation regarding applications to CIRA through CIRA certified registrars should be *either read out, or should be read such that the words “... but in this case ...” and following in 2(q) relate only to the limitation of the trade-mark owner being able to apply for a .ca domain name that is the same as the registered trade-mark, and does not otherwise qualify the right of a trade-mark owner to both bring a complaint and own a .ca domain name in the trade-mark owner’s own right.*

On the other hand, the Panel’s minority is of the view that in Resolution Rules ¶ 3.2(D)(f), immediately after “Complainant”, the following should be *read in*: “or Complainant’s Nominee”.

Some Reasons in Common

³⁸ Nelson, *supra* note 34, at 155 citing *Cityscape Richmond Corp. v. Vanbots Construction Corp.* [2001] O.J. No. 638, 2001 CarswellOnt 517 (S.C.J.) at para. 19. Liberal construction expands the meaning of an instrument to include cases clearly within the spirit of the instrument, or within the evil it was designed to remedy, provided the interpretation is not inconsistent with the language used: *Black’s Law Dictionary*, *supra* note 3, at 283.

³⁹ Nelson, *supra* note 34, at 155 citing *Islamic Foundation of Toronto Trust (Trustees of) v. Islamic Foundation of Toronto*, [1997] O.J. No. 2787, 1997 CarswellOnt 3060 (Gen. Div.).

⁴⁰ See, for example, J.M. Balkin, “The Crystalline Structure of Legal Thought” (1986), 39 *Rutgers Law Rev.* 1, at 43-45 and “The Hohfeldian Approach to Law and Semiotics” (1990), 44 *U. of Miami Law Rev.* 1119, at 1131.

The Panel’s majority and the minority have some reasons in common for their respective approaches.

The view of both the majority and the minority in the Panel is that, for three reasons, the Policy ¶ 1.4 occurrence of “relates to” should be construed as having greater scope, rather than the same or lesser scope, as compared to CPR ¶ 2(q) or 2(r). First, in general, whether or not a complaint about a domain name is a complaint under the Policy, a complaint about a domain name can *relate to* a trade-mark even if *only part of* the text of the trade-mark *is, or is included in*, the character string of the domain name (rather than that necessarily *all of* the text of the trade-mark *is, or is included in*, the character string of the domain name). Second, in Policy ¶ 1.4, the wording from “unless” onwards is apparently to make an exception to CPR applicability, and if the Policy ¶ 1.4 occurrence of “relates to” were to be construed as having the same or lesser scope than the scope of CPR ¶ 2(q) or 2(r) then that exception would be nullified. Third, the Policy ¶ 4.3 possibility for a complainant to name a CPR-compliant nominee makes it clear that the Policy ¶ 1.4 exception is deliberately, rather than inadvertently, a means for an owner of a CIPO-registered trade-mark (who is not CPR-compliant) to do *indirectly* (i.e. by a *complaint* under the Policy) what that owner could not do *directly* (i.e. by an *application* for registration of the domain name): their *complaint* can be based on *only part of* the text of the trade-mark *being, or being included in*, the character string of the domain name, whereas their *application* would have to be based on *all of* the text of the trade-mark *being, or being included in*, the character string of the domain name.

Thereafter, the reasons of the Panel’s majority and minority diverge.

Reasons Specific to the Panel’s Majority

The reasons specific to the Panel’s majority are that the majority’s approach is necessary to avoid what amounts to an absurd result. More specifically, the majority’s view is that

- (i) the reference in the preamble of CPR ¶ 2 to prospective “.ca” domain name registrants being “permitted to apply to CIRA (through a CIRA certified registrar) for the registration of, and to hold and maintain the registration of, a .ca domain name” is not fully included in the limitation in each of CPR ¶¶ 2(q) and 2(r) that “such permission is limited to an application to register a .ca domain name consisting of or including the exact word component”; and
- (ii) because that quoted expressed limitation in each of CPR ¶¶ 2(q) and 2(r) does not include any reference to holding and maintaining such a domain name registration, it is necessary that the limitation be either read out, or be read such that the words “... but in this case ...” and following in 2(q) relate only to the limitation of the trade-mark owner being able to apply for a .ca domain name that is the same as the registered trade-mark, and does not otherwise qualify the right of a trade-mark owner to both bring a complaint and own a .ca domain name in the trade-mark owner’s own right.

Reasons Specific to the Panel’s Minority

The reasons specific to the Panel’s minority are that

- (i) its approach accords with the provisions of law, and of justice, unanimously set out above by the Panel regarding interpreting, construing, and applying contract instruments generally and the dispute resolution agreement particularly;
- (ii) its approach accords with all of the present Policy, all of the present Resolution Rules, all of the present CPR— including but not limited to Policy ¶¶ 1.4, 1.9(b), 4.3, and 4.5 as well as CPR ¶¶ 2(q) and 2(r)— and all of the present form for “.ca” registration agreements, as well as with the earlier versions of all those instruments, and with CIRA comments on them, available through the CIRA website’s archive;
- (iii) its approach accords with the Resolution Rules being basically made under, or at least being construed and applied so as to supplement and carry out and accord with, the Policy;⁴¹
- (iv) by permissibly reading wording into Resolution Rules ¶ 3.2(D)(f), its approach accords with the rule of law that the Panel is “not permitted to act in a manner that flies in the face of the express provisions of a rule”;⁴² and
- (v) unlike the Panel minority’s approach, the Panel majority’s approach flies in the face of the express provisions of a rule that is part of the dispute resolution agreement between the Parties by impermissibly reading wording out of CPR ¶¶ 2(q) and 2(r).

Moreover, contends the Panel minority, for either or both of two reasons the Panel majority’s contention of avoiding an absurd result is not well-founded. First, there is apparently no application process for holding and maintaining a “.ca” domain name (as contrasted with applying to a CIRA certified registrar to register such a domain name); therefore, the limitation in each of CPR ¶¶ 2(q) and 2(r) (i.e. that the permission referred to in the preamble of CPR ¶ 2 is limited to an application to register a “.ca” domain name “consisting of or including the exact word component”) is a limitation that is applicable to applications to such registrars, and is a limitation that requires that the domain name consist of or include the exact word component, but is not a limitation as to holding and maintaining such a registration. Second, absurd results are to be distinguished from results that are less convenient than might be desired by some prospective “.ca” domain name registrants:⁴³ the lessened convenience is apparently part of CIRA’s objective of

⁴¹ The preamble of the Resolution Rules includes that “Proceedings for the resolution of disputes *under* the [Policy] ... shall be governed by ...[the] Resolution Rules”. (Emphasis added.)

⁴² *Reekie v. Messervey*, [1990] 1 S.C.R. 219 at 222. See also *Haylock et al v. Norwegian Cruise Lines Limited et al.*, 2003 FC 932, at para. 10, citing and quoting *Reekie*, “as a general principle, the Rules of procedure should be a servant of substantive rights and not the master.”

⁴³ Regarding “absurd” results see e.g. *Vandekerkhove v. Township of Middleton*, [1962] S.C.R. 75, at 78-79, per Cartwright J.; *Banque de Montreal v. Dufour*, [1995] R.J.Q. 1334, at 1339 (C.A.), per LaBel J. (translation); *Commissioner of Patents v. Winthrop Chemical Co. Inc.*, [1948] S.C.R. 46, at 54-55, per Rand J.; and *Rizzo & Rizzo Shoes Ltd. (Re)*, [1998] 1 S.C.R. 27, at 45-46, per Iacobucci J. at para. 27.

See also e.g. what was being called for in (now on-line CIRA-archived) comments that were made to CIRA in response to CIRA’s 7 September 2001 draft of the Policy and of the Resolution Rules. CIRA made changes to the draft Policy and draft Resolution Rules after the public provided comments, but there is apparently no indication

having Canadian presence requirements anyway (as indicated by e.g. CPR ¶ 1), the second part of Policy ¶ 1.4 makes an exception to having to meet those presence requirements when it comes to initiating a proceeding under the Policy, and Policy ¶ 4.3 is consistent therewith by allowing for CPR-compliant nominees to receive domain name transfers pursuant to the Policy.

Summary Regarding Complainant-Requested Relief

In view of all of the above, the Panel

- (i) unanimously decides in favour of Complainant; and
- (ii) as a majority,
 - (a) finds Complainant satisfies the CPR in respect of the contested domain name; and
 - (b) decides that the contested domain name should be transferred to Complainant.

Registrant-Requested Relief

In view of the immediately preceding paragraph hereof, the first form of relief requested by Registrant (i.e. dismissal of the Complaint) is obviated.

The second and third forms of relief requested by Registrant are apparently an attempt by Registrant to avail itself of Policy ¶ 4.6⁴⁴ and Resolution Rules ¶ 12.6.⁴⁵ In view of the above discussion, and contrary to the opening wording of Policy ¶ 4.6, Registrant is not successful in the Proceeding, so, as to those second and third forms of relief, neither Policy ¶ 4.6 nor Resolution Rules ¶ 12.6 can avail Registrant.

from CIRA that CIRA fully agreed with or considered itself to have fully implemented those requested changes, or in any event that the Panel majority's view is correct.

⁴⁴ Policy ¶ 4.6 is as follows:

4.6 Bad Faith of Complainant. If the Registrant is successful, and the Registrant proves, on a balance of probabilities, 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, then the Panel may order the Complainant to pay to the Provider in trust for the Registrant an amount of up to five thousand dollars (\$5000) to defray the costs incurred by the Registrant in preparing for, and filing material in the Proceeding. The Complainant will be ineligible to file another Complaint in respect of any Registration with any Provider until the amount owing is paid in full to the Provider.

⁴⁵ Resolution Rules 12.6 is as follows:

12.6 Bad Faith of Complainant. If the Panel finds that the Complaint was commenced for the purpose of attempting, unfairly and without colour of right, to cancel or obtain transfer of any Registration which is the subject of the Proceeding, the Panel shall so declare in its decision and support with reasons that the Complaint was brought for such purpose. If the Panel makes such a finding, the Panel shall order the Complainant to pay to the Provider in trust for the Registrant an amount of up to five thousand dollars (\$5000) to defray the costs incurred by the Registrant in preparing for, and filing material in, the Proceeding.

As for the fourth form of relief requested by Registrant (i.e. an order that Complainant pay Registrant \$10,000 in punitive damages), the Panel is of the view that whether or not the types of relief available from a panel in a proceeding under the Policy are exhaustively set out by Policy ¶¶ 4.3 and 4.6 (and by the Resolution Rules), the above discussion precludes Registrant's damages claim.

DECISION

Policy ¶¶ 1.4, 3.1, 4.1, and 4.3 having been satisfied, the Panel concludes that the relief requested by Complainant shall be **GRANTED** in that the contested domain name <houseofblues.ca> should be **TRANSFERRED** to Complainant.



Rodney C. Kyle, Esq.
Arbitrator

Rodney C. Kyle, Panel Chairperson, on Behalf of the Panel
Ottawa, Ontario Canada
Dated: 29 March 2006