

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

Domain Name: COOPERATOR.CA

Complainant: The Co-operators Group Ltd.
Registrant: Artbravo Inc.
Registrar: 10 Dollar Domain Names, Inc.
Panelists: David Allsebrook
Pat Flaherty
Barry C. Effler, Chair
Service Provider: British Columbia International Commercial Arbitration
Centre

DECISION

A. The Parties

1. The Complainant is The Co-operators Group Ltd., a business corporation presently incorporated under the laws of Canada with its headquarters in Guelph, Ontario. The Group is represented by legal counsel Diane E. Cornish and Samantha J. Gervais of Osler, Hoskin and Harcourt. The Group satisfies Canadian Presence requirements under s. 2(q) of the Policy.

2. The Registrant is Artbravo Inc., a business corporation presently incorporated under the laws of Ontario with its headquarters in Hamilton, Ontario. Submissions on behalf of Artbravo were filed by its director and founder, Carmine Lofaro. Artbravo was not represented by counsel.

B. The Domain Name and Registrar

3. The domain name at issue is “cooperator.ca”. The domain name is registered with 10 Dollar Domain Names, Inc. of Toronto, Ontario. The registration is subject to the CIRA Domain Name Dispute Resolution Policy and Rules.

C. Procedural History

4. The Group submitted a Complaint under the Policy to the Domain Name Dispute Resolution Provider, British Columbia International Commercial Arbitration Centre. The Provider served notice of the Complaint to Artbravo as required by paragraph 4.3 of the *CIRA Domain Name Dispute Resolution Rules* [“Rules”]. A Response to the Complaint was received from Artbravo. The Provider selected the panel of three and appointed the Chair according to the process outlined in the Rules.

D. Panel Members' Impartiality and Independence Statements

5. As required by paragraph 7.1 of the Rules, all three panelists have declared to the Provider that they can act impartially and independently in this matter, as there are no circumstances known to any of us which would prevent us from acting.

E. Factual Background

6. **The Co-operators Group Ltd.** is a Canadian owned multi-product insurance company operating in all regions of Canada. In 1994 it had \$6 billion in capital and \$2.6 billion in revenue. In that year its insurance services protected 840,000 homes, over 1 million vehicles and over 120,000 businesses.

7. The Co-operators Group Ltd. is the registered owner of Canadian trade mark registration number T MA429776, registered in 1994 for the trade mark **THE CO-OPERATORS** for use in association with:

Wares: (1) Clothing, namely, hats, ties, scarves; accessories, namely, crests, gym bags, key rings, lapel pins, coin purses; posters, banners, balloons, stickers, sew on labels, matches, sugar packets, jar openers, paper hats, hard hats, clocks, clock faces, pocket mirrors, golf balls, golf tees, magnets, pens, pencils, note pads, game score cards, metric converter cards, greeting cards, counter card holders, time planning calendars, books, name tags, lapel labels, pamphlet racks, insurance policy wallets, insurance policy and certificate holders, inventory folders, labels, insurance policy wallet calculation pages and fact sheets, invisible markers, first aid kits, flashlights, windshield scrapers and litter bags.

Services:

- (1) Fire, casualty and life insurance services.
- (2) Actuarial and pension consulting services.
- (3) Property management and acquisition services.
- (4) Data processing services.

8. The trade mark **LES COOPERATEURS** was registered by The Co-operators Group Ltd. in 1997 for the same wares and services. Three other trade marks have been registered by The Co-operators Group Ltd. which include "THE COOPERATORS", including "**CO-OPERATORS HERITAGE FUNDS**" in 2003 for use in association with "mutual fund services, namely mutual fund investment". Marketing surveys have shown that, as of 2005, the Group has the number one unaided (top of mind) brand awareness of any insurance company in Canada.

9. Based upon the scope of business and advertising described by it, The Co-operators Group Ltd. is very well known in Canada for its insurance services, and has Rights in The Cooperators family of trade marks for the purposes of the Policy prior to registration of the disputed domain name.

10. The Co-operators Group owns the domain name “cooperators.ca” and 20 other domain names beginning with “cooperators”. “Cooperators.ca” resolves to a web site describing the Group and has been in continuous use since its registration in 2000. The Group uses “cooperators.ca” in its email addresses.

11. **Artbravo’s** primary focus is on web development for the arts community. Until now it has been a non-profit venture. It is in the process of developing web sites for several ventures including:

DomainDealer.ca	-an online marketplace for generic domain names
DomainEscrow.ca	-safeguard services for transfers of domain names
Domains-in-trust.ca	-domain name and domain portfolio acquisitions
Domainappraisal.ca	-domain name and web site appraisals
Domainauctions.ca	-domain name auction site
Companybuilder.ca	-building companies with turnkey web sites, starting from generic domain names

12. Artbravo operates a web site at “domaindealer.ca”. At the date the printouts were made, January 11, 2006, it lists approximately 514 domain names for sale. They are almost all generic terms. Prices range from \$200 for names such as “diamondmine.ca” to \$549,000 for “apartmentforrent.ca”. “Domaindealer.ca” was registered by in October 2004, and the sophisticated commercial end user agreement is stated to have been updated on January 1, 2005. All of the domain names listed for sale appear to belong to Artbravo. Artbravo advises that it has not yet sold one.

13. The Group’s evidence shows that included in the lists of domain names for sale at “domaindealer.ca” are domain names reflecting trade marks, trade names or names of famous individuals. These are said to include “madtv.ca” for \$24,000, steelers.ca for \$1200, and montessorischool.ca for \$31,000. All are registered by Artbravo. No identification or documentation of the owners of the rights referred to, was provided by the Group.

14. The panel takes notice from its own knowledge that MADTV is a comedy television program likely produced by Mad Magazine, that the Pittsburgh Steelers are a professional football team in the United States, and that Montessori schools are private schools which teach children according to the Montessori method.

15. The web pages to which these domain names resolve are “landing” pages provided by a third party, Domain Sponsor. Domain Sponsor landing pages take a common format. There is no artwork or pictures. The domain name used to reach them, such as “madtv”, appears on the top left hand side of the page, in letters two or three times the size of any other writing on the page. Underneath the forwarding domain name in small italic letters is the phrase “What you need, when you need it”. Underneath that, are arrays of hyperlinks.

16. The Group filed a search prepared by CIRA showing that Artbravo owns hundreds of mostly descriptive domain names. In addition, Artbravo or its principal Mr. Lofaro own multiple other domain names that include trademarks and trade names of third parties with whom they have no association including: rollsroyce.ca, jackdaniels.ca, trumptower.ca, lexis.ca, mizuno.ca, weyerhauser.ca, bunsmaster.ca, supercycle.ca and unitedfurniture.ca. Artbravo also holds other domain names of famous entertainers, bands and movies etc. including kidsinthehall.ca, antiquesroadshow.ca, oasis.ca, weezer.ca, nellyfurtado.ca, damiellanois.ca, thekillers.ca, and coldplay.ca.

17. The disputed domain name “cooperator.ca” was registered by Artbravo on July 15, 2005. The registration is valid until July 15, 2006. The Group learned of Artbravo’s registration of cooperator.ca in October, 2005. In a letter from it received by Artbravo on October 25, 2005, the Group requested that the domain name be transferred to it. Artbravo declined, and redirected the domain name to resolve to the Artbravo web site, consisting entirely of works of art by Mr. Lofaro.

18. According to Artbravo, at the time of its registration, “cooperator.ca” pointed to a Domain Sponsor landing page in which the “Popular Links” relate to arts topics and do not mention insurance topics. A similar page is provided by it for October 25, 2005, the day Artbravo received the initial demand letter from the Group. The Group provided a copy of the landing page as on October 9, 2005, between the dates of the samples provided by Artbravo. On it, the “Popular Links” do not mention the arts but include five links relating to insurance. One link, which appears once in the middle of the page, is called “Cooperators”. The other link names are descriptive— no link names an insurer or trade mark.

19. Artbravo states that the October 9 landing page produced by the Group is “completely manipulated and manufactured by the Complainant, for the sole purpose of **hijacking** the domain name...”. Its only evidence in support of this assertion is the two pages dated before and after October 9.

20. The Group’s submissions do not mention the “Cooperators” link or show what happens when any link is used. A second page from the site, apparently reached by typing “car insurance” in the search box on the first page, presented a list of “Sponsored Links” and “Top Sites” all pertaining to car insurance. Two links included references to named insurance companies –neither was the Group.

F. CIRA Domain Name Dispute Resolution Policy Requirements

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

To succeed in the Proceeding, the Complainant must prove, on a balance of probabilities, that:

(a) the Registrant’s dot-ca domain name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights; and

(b) the Registrant has registered the domain name in bad faith as described in paragraph 3.7;

and the Complainant must provide some evidence that:

(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6.

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name . . .

G. Is the Registrant’s Domain Name Confusingly Similar to the Complainant’s Mark?

1) The Complainant’s Marks

23. Paragraph 3.2 of the Policy includes the following in the definition of what constitutes a “mark” for the purposes of the Policy:

A “Mark” is:

(a) a trade-mark . . . or a trade name that has been used in Canada . . . for the purpose of distinguishing the wares, services or business of that person . . . from the wares, services or business of another person; [and]

(c) a trade-mark . . . that is registered in CIPO . . .

24. The Complainant has shown evidence of its current ownership of the registration for the trade mark THE CO-OPERATORS in Canada. It is registered for use in association with fire, casualty and life insurance services, among other things.

2) “Confusingly Similar”

a) “Confusingly Similar”

25. Paragraph 3.4 of the Policy defines “confusingly similar” in the following terms:

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.

26. The domain name “cooperator.ca” differs from “the cooperators” only in incidental ways that do not distinguish it from the Group’s mark. A person, on a first impression, knowing the Group’s mark and having an imperfect recollection of it, would likely mistake the domain name for the Group’s mark. Further, even if one considered “Cooperator” to be a generic term, the manner in which it has been used by the Registrant creates confusing similarity within the meaning of the Policy.

27. Here, the Registrant permitted the mark to be reached through Domain Sponsor. At least part of the time, the Domain Sponsor landing page provided links referring to insurance services. The identity and nature of those services is not in evidence. We have only the complainant’s statement that these links led to “third party sites that offer goods and services in competition with the Complainant.” This statement is corroborated to some extent by the web site pages provided and is sufficient, absent an explanation by the Registrant, to establish confusing similarity for the purposes of the Policy.

28. The Registrant did not explain the nature of the insurance links, but alleged that the page provided by the Complainant was fabricated. However the Registrant does not know or chooses not to say what pages were posted on the day the Complainant says it printed the Domain Sponsor landing page. Since the web page content is provided by a third party, under contract with the Registrant, the onus is on the Registrant to explain how the content of the page is determined, and to show what the content was at the time in question. The Registrant chose not to.

29. The Panel finds that the domain name cooperator.ca is confusingly similar to the Complainant’s mark “The Cooperators”.

H. Was the Registration of the Domain Name Made in Bad Faith?

30. In order to succeed, the Complainant must show, on the balance of probabilities, that the Registrant registered the domain name in bad faith. The Registrant will be considered to have registered the domain name in bad faith, if 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.

31. Any intention by the Registrant to prevent the Complainant from registering the Domain Name must be inferred from its actions. Immediately upon obtaining the registration, the domain name was set to a landing page provided by a third party. The contents of the landing page referred to insurance services, which is the Complainant’s

business but not the business of the Registrant. The Registrant has not seen fit to provide evidence of how the contents the Domain Source landing page was determined. Again, as this information was within its knowledge, the Registrant had the onus of providing this information. By registering the domain name to take a free ride on the Complainant's good will, the Registrant has registered the name so as to deny it to the Complainant. Even if Artbravo intended the use of the landing pages as a temporary measure while it developed a legitimate web site, the temporary use was intentional.

32. The Complainant has also shown that the Registrant has a pattern of registering domain names which correspond to trade marks of third parties. Such names include "rollsroyce.ca, jackdaniels.ca, trumptower.ca, lexis.ca, mizuno.ca, Weyerhaeuser.ca, steelers.ca, and bunsmaster.ca. The Registrant's explanation is that "Artbravo has a good faith policy with regards to the transfer of Domain Names that **may** have a registered trade mark and that were registered (acquired) **in error**." This is insufficient to explain its conduct, such as the "error" which led it to register these domain names.

33. The Group has presented sufficient evidence that gives rise to an inference that the domain name was registered in bad faith within the meaning of the Policy. The Complainant was obliged to respond and present evidence that it is in fact dealing in good faith. For the reasons expressed above, it has not done so. Accordingly, the Panel concludes that the Registrant registered the domain name "cooperator.ca" in bad faith.

I. Does the Registrant Have a "Legitimate Interest" In the Domain Name?

34. The final element of the test set out in the Policy is to determine whether or not the Registrant has a legitimate interest in the domain name. Paragraph 3.6 of the Policy provides an exhaustive list of tests of legitimacy. The Complainant must show some evidence that none of these tests applies, which it has done. The burden then shifts to the Registrant to show that it has, on the balance of probabilities, any one of these legitimate interests as defined under these subparagraphs.

3.6 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;

- (c) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;
- (d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;
- (e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or
- (f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

35. The Complainant has asserted that the Registrant has no legitimate interest. The Complainant's assertion rests on the assumption that the Registrant knew of the "the Co-operators" trade mark and set out to capitalize upon its similarity to "cooperators.ca". The complainant has shown "some evidence" of this, and has thus shifted the onus of proof to Artbravo.

36. Artbravo asserts that its intention was always to use "cooperator.ca" in connection with a web site to promote the arts, and provides logo designs it commissioned from 905 Media Inc., together with an invoice from 905Media Inc, for the artwork dated July 29, 2005. However this activity does not amount to use of the domain name under section 3.6. Artbravo has failed to show that its use of the domain name complies with any of paragraphs 2.6 (a) to (d), and does not allege that it meets the remaining paragraphs (e) and (f). On the contrary, the unexplained use of the domain name to relate to a third party landing page referencing insurance services rebuts Artbravo's claim to good faith use. This, coupled with the evidence that the registration was made in bad faith, meets the requirements of paragraph 3.6 of the Policy.

37. The Panel therefore concludes that the Artbravo did not have a legitimate interest in the domain name cooperators.ca.

J. Remedies sought by Artbravo

38. Artbravo asks for payment to it by the Group of \$5,000 of its costs of preparing its response, and \$500,000 in punitive damages. In view of our conclusions we need not address these claims. .

K. Conclusion and Decision

39. The panel finds that Artbravo has registered the confusingly similar domain name “cooperator.ca” in bad faith and that Artbravo has no legitimate interest in it.

40. The Co-operators Group has asked that the domain name be transferred to it. One panelist, David Allsebrook, feels that the appropriate disposition in this case is cancellation of the registration rather than its transfer to The Co-operators Group. He feels that the domain name is a generic term capable of being used innocently by a third party. The Ontario Superior Court of Justice in *Black v. Molson Canada*, decided that in like circumstances under the UDRP "...unless there is some evidence that use of the domain name infringes on the use of the trademark name, a person other than the owner of the trademark should be able to continue to use the domain name." (No. 02-CV-231-828CM3, July 18, 2002 per Blenus Wright, J. at paragraph 32). There is a public interest in having as large pool of available trade marks and domain names as possible, which militates against having unused names held unavailable. This policy is reflected, for example, in sections 44 and 45 of the *Trade Marks Act*. The potential that the next registrant of the domain name may abuse it is not sufficient, in Mr. Allsebrook's judgment, to create a presumption that the name will be abused unless registered by The Co-operators Group. The Co-operators Group has not shown a pattern of registering typographical variants of its name as domain names, and has heretofore been content to leave the ownership of such names to chance. If the domain name happens to again be taken up in bad faith, The Co-operators Group may again avail itself of the inexpensive and expedient process offered the CDRP.

41. The majority, Mr. Effler and Mr. Flaherty, are of the opinion that the appropriate remedy in this case is to transfer the domain name to the Complainant. The Complainant has established its case and there are no other complainants who have filed a competing claim. The Complainant uses the domain name cooperators.ca as its main operating domain name for its business and for the reasons set out above will more likely than not be able to establish that another user will be confusingly similar. Whether the Complainant could establish bad faith would have to be determined on the facts of usage. In the majority opinion, the equities of this case support transfer of the domain name to the Complainant.

42. For these reasons, the panel orders that the domain name “cooperator.ca” be transferred to the Complainant.

Dated April 6, 2006

David Allsebrook, Patrick Flaherty, Barry C. Effler (Chair)

Original signed by Barry C. Effler

Barry C. Effler C. Arb.