

# CANADIAN INTERNET REGISTRATION AUTHORITY (CIRA)

## DOMAIN NAME DISPUTE RESOLUTION POLICY

### COMPLAINT

Dispute Number: DCA-922-CIRA  
Domain Name: combigan.ca  
Complainant: Allergan Inc.  
Registrant: Hiebert Net Inc.  
Registrar: DomainPeople Inc.  
Panel: Rodney C. Kyle  
Service Provider: British Columbia International Commercial Arbitration Centre

### DECISION

#### PARTIES

Complainant is **Allergan Inc.**, of 110 Cochrane Drive, Markham, Ontario (“Complainant”), represented by Eric Macramalla of Gowling Lafleur Henderson LLP, of Ottawa, Ontario.

Registrant is **Hiebert Net Inc.**, of 8181, 120 A Street Suite #2, Surrey, British Columbia (“Registrant”).

#### REGISTRAR AND CONTESTED DOMAIN NAME

The contested domain name is <**combigan.ca**> (“the contested domain name”), and **DomainPeople Inc.** is its registrar.

#### PANEL

Rodney C. Kyle is the Panel and certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as the Panel 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 4 July 2006.

On 4 July 2006,

- (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 24 July 2006 by which Registrant could file a Response to the Complaint.

Those attempts by the BCICAC were unsuccessful.

Registrant did not submit a Response. As permitted given the absence of a Response, on 25 July 2006 Complainant elected under Resolution Rules ¶ 6.5 to convert from a three-person panel to a sole panelist.

On 26 July 2006, in accordance with Resolution Rules ¶ 6, the BCICAC appointed the Panel, gave the Parties as well as CIRA and the Panel notice of that appointment, and forwarded the file for the Proceeding to the Panel.<sup>1</sup> In accordance with Resolution Rules ¶¶ 7.1 and 7.2, prior to accepting appointment on 27 July 2006 the Panel provided the BCICAC with his declaration of his independence and impartiality.

## **RELIEF SOUGHT**

Complainant requests that the contested domain name be transferred from Registrant to Complainant.

## **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 basically contends that Complainant is eligible to initiate the Proceeding. More particularly, Complainant's contentions include that Complainant is a corporation incorporated under the laws of the province of Ontario (and therefore that Complainant satisfies Policy ¶ 1.4 by satisfying CIRA's Canadian Presence Requirements For Registrants Version 1.3 ("CPR") ¶ 2(d)), and that Complaint Exhibit 1 is a copy of a corporate report evidencing such incorporation.

#### **SECOND MAIN SET**

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

The first point is that the contested domain name became registered to Registrant on 21 January 2004, and that Complaint Exhibit 4 includes a copy of domain name registration information evidencing that registration of the contested domain.

The second point is that within the meaning of "Mark" as defined by Policy ¶ 3.2(c), there is a Mark consisting of COMBIGAN 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(b). More particularly,

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<sup>1</sup> That notice also stated 16 August 2006 as the date by which the Panel is to forward its decision in the Proceeding to the BCICAC.

Complainant contends that since 29 May 2003 Complainant was and is the owner of a CIPO-registered trade-mark of COMBIGAN, and that Complaint Exhibit 2 is a copy thereof, evidencing that ownership.

The third point is that within the meaning of “Confusingly Similar” as defined by Policy ¶ 3.4, the contested domain name is Confusingly Similar to that Mark. More particularly, Complainant basically contends that in view of the second sentence of Policy ¶ 1.2, the contested domain name is identical to the Mark and therefore so nearly resembles the Mark (in appearance, sound, and the ideas suggested by the Mark) as to be likely to be mistaken for the Mark.

### THIRD MAIN SET

In the third main set of contentions, Complainant basically makes contentions that include six points. Those six points are to the effect that within the meaning of “legitimate interest” as defined by Policy ¶ 3.6, Registrant has no legitimate interest in the contested domain name.

The first point is as to Policy ¶ 3.6(a), that the contested domain name consists of a Mark in which Registrant had no Rights and which Registrant did not use in good faith, including that

- (i) Registrant attempted to sell the contested domain name to Complainant for \$1,800, that \$1,800 far exceeds Registrant’s registration fee, and that the attempt is evidenced by copies of correspondence between Complainant and Registrant, Complaint Exhibits 5 to 9;
- (ii) Registrant is not using the contested domain name and has not used it since registering it 2 ½ years ago, and that the pertinent non-use is evidenced by a copy of the website that resolves through the contested domain name, in Complaint Exhibit 4;
- (iii) Registrant had constructive notice of the above-contended Complainant Rights in the Mark, as a result of the above-contended CIPO-registration of the Mark contended to be evidenced by Complaint Exhibit 2;
- (iv) Registrant had actual notice of the above-contended Complainant Rights in the Mark, as a result of the Mark being a coined (and therefore inherently distinctive) term used by Complainant as a trade-mark on wares sold by means that are controlled or managed by an individual who controls or manages Registrant, and that such Complainant use and such individual’s control or management are evidenced by the copies (of website printouts, corporate reports, and domain name registration information) that are Complaint Exhibits 10 to 17; and
- (v) by a telephone call to Complainant, after the emails referred to in item “(i)” of this list, the individual who controls or manages Registrant stated that “Combigan” was the name of that individual’s dog.

The second point is as to Policy ¶ 3.6(b), that Registrant has not used the contested domain name in good faith in association with any wares, services, or business, and that

the contested domain name is not clearly descriptive in any of the senses stipulated in that paragraph.

The third point is as to Policy ¶ 3.6(c), that the contested domain name is neither generic of any wares, services, or business nor used by Registrant in good faith.

The fourth point is as to Policy ¶ 3.6(d), that Registrant has never used the contested domain name in association with a non-commercial activity in good faith.

The fifth point is as to Policy ¶ 3.6(e), that the contested domain name is not a legal name, surname, or other reference by which Registrant is commonly identified.

The sixth point is as to Policy ¶ 3.6(f), that the contested domain name “is [not] the geographical name of the location of the Registrant’s non-commercial activity or place of business.”

#### FOURTH MAIN SET

In the fourth main set of contentions, Complainant basically contends by way of three points that Registrant has registered the contested domain name in “bad faith” within the meaning of that expression as defined by Policy ¶ 3.7.

The first point is as to Policy ¶ 3.7(a), that Registrant registered or acquired the contested domain name primarily for the purpose of selling, renting, licensing or otherwise transferring it to Complainant, for valuable consideration in excess of Registrant’s actual costs in registering or acquiring the contested domain name, in that

- (i) by correspondence dated 31 March 2006 (presumably within the above-mentioned Complaint Exhibits 5 to 9), Registrant demanded \$1,800 in exchange for the transfer of the contested domain and of another domain name which includes the mark COMBIGAN, and that the demand’s being at least *prima facie* evidence of bad faith registration is bolstered by a suggestion Registrant made to Complainant that \$1,800 was competitive with the cost of filing domain name complaints;
- (ii) prior to that demand, Registrant solicited offers from Complainant, for Complainant to purchase those domain names (by asking, presumably within those same exhibits, “what is this amount that [you] are prepared to pay?” for expenses associated with those domain names);
- (iii) there is the constructive and actual notice contended in points “(iii)” and “(iv)” of Complainant’s third main set of contentions;
- (iv) there is the domain name non-use contended in point “(ii)” of Complainant’s third main set of contentions; and
- (v) there is the Registrant’s statement of a dog named Combigan, contended in point “(v)” of Complainant’s third main set of contentions.

The second point is as to Policy ¶ 3.7(b), that Registrant has registered the contested domain name for the purpose of preventing Complainant from registering the mark

COMBIGAN 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. More specifically, Complainant contends that the pattern requirement is met by the ownership or control of a further domain name which includes the mark COMBIGAN (as contended in the immediately preceding paragraph hereof), combined with the common control or management contended in point “(iv)” of Complainant’s third main set of contentions.

The third point is as to Policy ¶ 3.7(c), that Registrant is a competitor of Complainant and has registered the contested domain name primarily for the purpose of disrupting the business of Complainant. More specifically, Complainant contends that the mark COMBIGAN is inherently distinctive, that if the contested domain name were ever put to use (and especially if the use were to be through the means referred to above as being under common control or management) then such use would be likely to cause confusion among internet users as to affiliation or sponsorship, and therefore that Registrant registered the contested domain name primarily for the purpose of disrupting the business of Complainant.

#### B. Registrant

Since Registrant did not submit a Response, there are no contentions by Registrant.

### 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, Complainant satisfies CPR ¶ 2(d);
- (ii) Registrant is required to submit to the Proceeding in that, as required by Policy ¶ 3.1, the Complaint is 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)”;
- (iii) that 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 21 January 2004,
  - (b) within the meaning of the expression “Mark” as defined by Policy ¶ 3.2, there is a Mark consisting of COMBIGAN 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) within the meaning of the expression “Confusingly Similar” as defined by Policy ¶ 3.4, the contested domain name is Confusingly Similar to the Mark,
  - (d) within the meaning of the expression “legitimate interest” as defined by Policy ¶ 3.6, Registrant has no legitimate interest in the contested domain name, and
  - (e) within the meaning of the expression “bad faith” as defined by Policy ¶ 3.7, Registrant has registered the contested domain name in bad faith; and
- (iv) the contested domain name should be transferred to Complainant in accordance

with Policy ¶ 4.3, in that the Panel has decided in favour of Complainant and the Panel has found Complainant satisfies CPR ¶ 2(d) 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).<sup>2</sup>

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.”<sup>3</sup> Third, as to construing and applying Policy ¶ 4.2 and Resolution Rules ¶

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

<sup>3</sup> 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

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,<sup>4</sup> 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.<sup>5</sup> Fourth, as to 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.<sup>6</sup>

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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.”).

<sup>4</sup> 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.

<sup>5</sup> 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 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.

<sup>6</sup> 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.

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.”<sup>7</sup>

However, the fact that a Response was not received makes for some exceptions to the otherwise generally appropriate four rules and principles of law set out in the immediately preceding paragraph. Those exceptions are as to materiality and as to judicial admission. Resolution Rules ¶¶ 5.8 and 11.4 respectively include that “If a Registrant does not submit a Response within the period for submission of a Response ..., the Panel shall decide the Proceeding on the basis of the Complaint” and that “After the Date of Commencement of a Proceeding, in the event that a Party, in the absence of exceptional circumstances, does not comply with any time period established by the Resolution Rules ..., the Panel shall proceed to a decision on the Complaint”. (“Date of Commencement of a Proceeding” is defined by Resolution Rules ¶¶ 1.1(c) and 1.6 as meaning “the date on which the Provider gives the Parties notice of the Proceeding pursuant to [Resolution Rules ¶] 4.4.”)

In this proceeding, (i) the “Date of Commencement of [this] Proceeding” is 4 July 2006, and the twenty-day time period established by Resolution Rules ¶ 5.1 within which Registrant was to “respond to the Complaint by filing with [the BCICAC] a Response in accordance with the Policy and the Resolution Rules” has apparently ended without Registrant having complied therewith; (ii) there do not appear to be “exceptional circumstances” within the meaning of that expression as it occurs in Resolution Rules ¶ 11.4; and (iii) in accordance with Resolution Rules ¶¶ 11.4 and 5.8 respectively, the Panel shall therefore “proceed to a decision on the Complaint” and “decide the Proceeding on the basis of the Complaint.” In doing so, as also accords with Resolution Rules ¶¶ 5.8 and 11.4, the Panel shall not treat the failure to submit a Response as an admission of Complainant’s allegations<sup>8</sup> and shall make a decision on the evidence before the Panel,<sup>9</sup> all of which is an approach that also accords with all the default decisions the Panel is aware of having been made under the Policy. Indeed, it apparently accords with general principles of arbitral decision-making in cases of respondent default:

If ... it is the respondent who is absent, the arbitrator ... cannot properly make an award unless the claimant has proved his case ... [and in a documents-only arbitration] the tribunal ... can simply proceed to an award on the basis of what is found in the available documents ... [and] must properly address himself to the question of whether the claimant’s evidence proves his case. This requires him not only to make sure that the evidence bears out the claimant’s assertion, but also that it has the appearance of being true, and is internally consistent.<sup>10</sup>

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<sup>7</sup> 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.).

<sup>8</sup> *Cf. Arbitration Act, 1991*, S.O. 1991, c. 17, s. 27(2).

<sup>9</sup> *Cf. Arbitration Act, 1991*, S.O. 1991, c. 17, s. 27(3).

<sup>10</sup> Sir Michael J. Mustill and Stewart C. Boyd, *Commercial Arbitration*, 2nd ed. (Toronto, Ontario: Butterworths, 1989) at 538 (footnote omitted).



### **Complainant Eligibility to Initiate the Proceeding**

Policy ¶ 1.4 has first and second parts.<sup>11</sup> Complainant's first main set of contentions amount to contentions under the first part of Policy ¶ 1.4: that Complaint Exhibit 1 is a corporate report that proves Complainant is a corporation incorporated under the laws of the province of Ontario and that Complainant thereby satisfies CPR ¶ 2(d),<sup>12</sup> therefore satisfies Policy ¶ 1.4, and therefore is eligible to initiate the Proceeding.

Complainant's first main set of contentions is proven. More particularly, Complaint Exhibit 1 is apparently a copy of an electronic database Corporation Profile Report, the issuance of which in electronic form is authorized by the Director of Companies and Personal Property Security Branch of the Ontario Ministry of Consumer and Business Services. The report expressly provides that it was produced on 29 June 2006 and that it sets out the most recent information filed by the corporation and recorded in the Ontario Business Information System as at the date of printing. The report also names Complainant as an Ontario business corporation, for which the most recent entry is that its 2004 annual return was filed electronically on 17 August 2005. Since the date of commencement of the Proceeding is 4 July 2006, the report itself is sufficiently contemporaneous but the circumstances would have been clearer if what the report proves was more recent than that electronic filing; through service providers listed at <[www.cbs.gov.on.ca/mcbs/english/useful\\_numbers.htm](http://www.cbs.gov.on.ca/mcbs/english/useful_numbers.htm)>, it apparently is possible to obtain certificates of corporate status. That said, on the balance of probabilities the Panel finds that at the time of submitting the complaint, Complainant is a corporation incorporated under the laws of the province of Ontario, thereby satisfies CPR ¶ 2(d), therefore satisfies Policy ¶ 1.4, and therefore is eligible to initiate the Proceeding.

### **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."<sup>13</sup> The

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<sup>11</sup> 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](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.

<sup>12</sup> CPR ¶ 2(d) is as follows:

**2. Canadian Presence Requirements.** On and after November 8, 2000 only the following individuals and entities will be 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: ...  
**(d) Corporation.** A corporation under the laws of Canada or any province or territory of Canada ...

<sup>13</sup> Policy ¶ 3.1 is as follows:

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)”. The Complaint is indeed submitted in compliance with the Policy and the Resolution Rules, Policy ¶ 3.1 is therefore satisfied, and Registrant must submit to the Proceeding.

### **Confusing Similarity**

The context in which this part of this discussion occurs includes Policy ¶¶ 3.2,<sup>14</sup> 3.3,<sup>15</sup> and 3.4,<sup>16</sup> which respectively define the expressions “Mark,” “Rights,” and “Confusingly

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**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.

<sup>14</sup> 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).

<sup>15</sup> 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;

Similar” which appear in Policy ¶ 4.1(a),<sup>17</sup> and 3.5,<sup>18</sup> which defines “use” and “used,” which appear in Policy ¶¶ 3.2 and 3.3.

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- (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.

<sup>16</sup> 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.

<sup>17</sup> Policy ¶ 4.1 is as follows:

- 4.1** **Onus.** To succeed in the Proceeding, the Complainant must prove, on a balance of probabilities, that:

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

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

and the Complainant must provide some evidence that:

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

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in paragraph 3.6.

<sup>18</sup> 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

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

Complainant's second main set of contentions proves that Complainant satisfies the Policy ¶ 4.1(a) onus. Specifically, each of the three points of that set of contentions is proven on the balance of probabilities.

### **Contested Domain Name Registered to Registrant**

Firstly, Complaint Exhibit 4 includes what apparently is a copy of CIRA domain name registration database information regarding the contested domain name, available through <<http://whois.cira.ca/public>>. That copy expressly provides that it was produced on 27 March 2006 and names Registrant as the registrant of the contested domain name since 21 January 2004.

### **Complainant "Rights" in One or More "Marks"**

Secondly, Complaint Exhibit 2 is apparently a copy of CIPO-registered trade-marks information regarding the Mark COMBIGAN, available through a database of which the Panel takes notice and which is at <<http://secure.onscope.com>>. That copy expressly provides that it was produced on 29 June 2006 and names Complainant as the owner of that registration since 29 May 2003.

### **Policy ¶ 3.4: "Confusingly Similar"**

Thirdly, within the meaning of "Confusingly Similar" as defined by Policy ¶ 3.4, the contested domain name is Confusingly Similar to that Mark. More particularly, in view of the second sentence of Policy ¶ 1.2,<sup>19</sup> the contested domain name is identical to the Mark and therefore so nearly resembles the Mark (in appearance, sound, and the ideas suggested by the Mark) as to be likely to be mistaken for the Mark.

### **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).<sup>20</sup>

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<sup>19</sup> The second sentence of Policy ¶ 1.2 is that "For the purposes of this Policy, 'domain name' means the domain name excluding the 'dot-ca' suffix and the suffixes associated with all third and fourth level domain names accepted for registration by CIRA."

<sup>20</sup> Policy ¶ 3.6 is as follows:

**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;

Complainant's third main set of contentions amounts to a contention that Complainant satisfies the Policy ¶ 4.1(c) onus (by a pleading of what amounts to Policy ¶ 4.1(c) and of negatives of Policy ¶¶ 3.6(a) to 3.6(f), together with the corresponding Complaint Exhibits 2 and 4 to 17).

Complainant's second main set of contentions proves that Complainant satisfies the Policy ¶ 4.1(a) onus. Specifically, the six points of that set of contentions is proven on the balance of probabilities.

As for Complainant's five contentions of the negative of Policy ¶¶ 3.6(a), the first four are substantially proven. Complaint Exhibits 2 and 4 to 17 are material, relevant, and admissible<sup>21</sup> and, aside from some inconsequential deviations from those four contentions, they are of sufficient weight; the fifth is not supported by evidence and the

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- (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.

In paragraphs 3.6 (b), (c), and (d) "use" by the Registrants includes, but is not limited to, use to identify a web site.

<sup>21</sup> The Panel takes this opportunity to state an observation of general applicability regarding material and relevant evidence proffered in the Complaint Exhibits: as to the contended facts, whether or not to any extent any of the Complaint 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.)

Panel need not ascertain whether it is true. More specifically, as to the first four of Complainant's third main set of contentions, the contested domain name consists of a Mark in which Registrant had no Rights and which Registrant did not use in good faith, in that

- (i) Complaint Exhibits 5 to 9 apparently are copies of a letter, and emails, from 3 to March 2006 to 3 April 2006 between Complainant and two persons apparently controlled or managed by an individual who apparently controls or manages Registrant— those two persons attempted to sell the contested domain name (together with another domain name which includes the Mark COMBIGAN) to Complainant for \$1,800 and the Panel takes notice that \$1,800 exceeds Registrant's registration fee for either or both of those domain names;
- (ii) Complaint Exhibit 4 apparently includes a copy of the website that resolves through the contested domain name— that website is apparently an “under construction” sort of website automatically created by default when the contested domain name was registered, and there is no indication that any website that has resolved through the contested domain name was ever other than of that sort of website;
- (iii) Complaint Exhibit 4 also includes registration information regarding the contested domain name,<sup>22</sup> including Canadian address and telephone contact information showing that Registrant is in Canada, and, as already found by the Panel,<sup>23</sup> Complaint Exhibits 2 and 4 prove Complainant is the owner of the CIPO registration of the Mark COMBIGAN since 29 May 2003, i.e. prior to the 21 January 2004 date on which the contested domain name was registered— beginning from before when the registration of the contested domain name occurred, Registrant therefore had constructive notice of Complainant's Rights in the Mark COMBIGAN;<sup>24</sup> and
- (iv) Complaint Exhibits 10 to 17 apparently are copies of website printouts and corporate reports and domain name registration information, and they show the Mark COMBIGAN is a term used by Complainant as a trade-mark on wares sold by means (such as corporations and websites) that are controlled or managed by an individual who apparently controls or manages Registrant— at all pertinent times, Registrant had and has actual notice of Complainant's Rights in the apparently coined (and therefore apparently inherently distinctive) Mark COMBIGAN.

Points “(i)” and “(iv)” of this paragraph refer to an individual who apparently controls or manages Registrant and who apparently controls or manages other persons and other means such as websites. For example, Complaint Exhibits pertaining to either or both of points “(i)” and “(iv)” include copies of June 2006 WHOIS information and

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<sup>22</sup> See above, under the heading of “Contested Domain Name Registered to Registrant”.

<sup>23</sup> See above, under the heading of “Complainant ‘Rights’ in One or More ‘Marks’”.

<sup>24</sup> *Trade-marks Act*, R.S.C. 1985, c. T-13, ss. 19 and 29(1) respectively include that “the registration of a trade-mark in respect of any wares or services ... gives to the owner of the trade-mark the exclusive right to the use throughout Canada of the trade-mark in respect of those wares or services” and that such registrations are “open to public inspection”

Registrant-connected or independent third-party business website printouts as well as 29 May 2006 B.C. Ministry of Finance Corporate and Personal Property Registries search results. The exhibits pertaining to either or both of points “(i)” and “(iv)” are replete with specific information in common between one or more of websites, Registrant, other corporations, and that individual, as to such things as the following, at pertinent times: telephone numbers, license numbers, email addresses, virtually identical addresses, and that individual’s name and capacities as one or more of manager and officer and director.

As for Complainant’s five contentions of the negatives of Policy ¶¶ 3.6(b) to 3.6(f), they too, are proven. Whatever else is required under Policy ¶¶ 3.6(b) to 3.6(d), the immediately preceding paragraph hereof precludes meeting the “good faith” requirements of those provisions. Furthermore, as to Policy ¶¶ 3.6(e) and 3.6(f), there is no indication that those provisions can avail Registrant.

### **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 contested domain name.<sup>25</sup>

Complainant’s fourth main set of contentions amounts to a contention that Complainant satisfies the Policy ¶ 4.1(b) onus.

Complainant’s Policy ¶ 4(1)(b) evidence-supported contentions regarding at least Policy ¶¶ 3.7(a), 3.7(b), and 3.7(c) are proven. The same evidence proffered by Complainant under the heading of “Legitimate Interests” is likewise material, relevant, admissible and of sufficient weight under this heading.

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<sup>25</sup> 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:

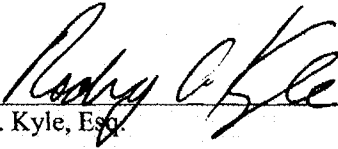
- (a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant’s licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee 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.

### **Remedy-Eligibility**

The Panel finds that the contested domain name should be transferred to Complainant, in view of two facts that satisfy Policy ¶ 4.3.<sup>26</sup> First, in view of all of the above, the Panel decides in favour of Complainant. Second, the Panel has found Complainant satisfies CPR ¶ 2(d) in respect of the contested domain name.<sup>27</sup>

### **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 <combigan.ca> should be **TRANSFERRED** to Complainant.

  
Rodney C. Kyle, Esq.  
Arbitrator

Rodney C. Kyle, Sole Panelist  
Ottawa, Ontario Canada  
Dated: 16 August 2006

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<sup>26</sup> 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**”).

<sup>27</sup> See above, under the heading of “Complainant Eligibility to Initiate the Proceeding”.



**CANADIAN INTERNET REGISTRATION AUTHORITY (CIRA)**

**DOMAIN NAME DISPUTE RESOLUTION POLICY**

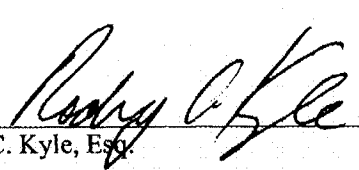
**COMPLAINT**

Dispute Number: DCA-922-CIRA  
Domain Name: combigan.ca  
Complainant: Allergan Inc.  
Registrant: Hiebert Net Inc.  
Registrar: DomainPeople Inc.  
Panel: Rodney C. Kyle  
Service Provider: British Columbia International Commercial Arbitration Centre

***CORRIGENDUM TO DECISION***

In accordance with CIRA Dispute Resolution Policy Version 1.1, ¶ 4.2, and CIRA Dispute Resolution Rules Version 1.2, ¶ 12.9, the Panel hereby amends its decision of 16 August 2006 by correcting the following five errors:

- (1) on page 13/16, in the second full paragraph on that page,
  - (i) in the first line of that paragraph, “second” is replaced by “third”,
  - (ii) in the second line of that paragraph, “4.1(a)” is replaced by “4.1(c)” and
  - (iii) in the second line of that paragraph, “is” is replaced by “are”; and
- (2) on page 14/16,
  - (i) in the first line on that page, “four” is replaced by “four points ‘(i)’ to ‘(iv)’” and
  - (ii) in point “(ii)” on that page, in the second-last line of that point, “of” (first occurrence on that line) is deleted.

  
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Rodney C. Kyle, Esq.  
Arbitrator

Rodney C. Kyle, Sole Panelist  
Ottawa, Ontario Canada  
Dated: 17 August 2006