

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

**Complainant:** 911979 Alberta Inc.

**Complainant Counsel:** Jonathan N. Auerbach  
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**Registrant:** Hank Morin

**Disputed Domain Name:** wwwshoppersdrugmart.ca

**Registrar:** Sibername Internet and Software Technologies Inc

**Panelist:** Elizabeth Cuddihy, QC

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

**BCICAC File Number:** DCA-924-CIRA

**PROCEDURAL HISTORY**

On July 17, 2006, the Complainant’s Counsel filed a Complaint against the Registrant with the BCICAC seeking that the Registrant’s right to ownership of the domain name wwwshoppersdrugmart.ca (the “Disputed Domain Name”) be arbitrated in accordance with CIRA’s Domain Name Dispute Resolution Rules (the “Rules”) and that an order be made pursuant to the CIRA Domain Name Dispute Resolution Policy (the “Policy”) that the registration of the Disputed Domain Name be transferred to the Complainant.

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

The Complainant is a corporation incorporated pursuant to the laws of Alberta as well as the owner of numerous Canadian trademark registrations for the mark “Shoppers Drug Mart” and trade-marks that consist of and/or comprise the term “Shoppers Drug Mart” and, accordingly satisfies the Canadian Presence Requirements for Registrants of paragraph 1.4 of the Policy and is an eligible complainant.

The Registrant did not respond to the Complaint within the twenty (20) day period within which a response is required to be filed pursuant to Rule 5 of the Rules. The BCICAC advised the Complainant of the lack of response by the Registrant and in accordance with Rule 6.5, the Complainant elected to convert to a single panel member Panel.

By letter dated August 17, 2005 BCICAC appointed the single member panel to arbitrate the Complaint. As the Complaint was filed in English and the Registrant has not responded, English is the designated language of the proceeding.

## **LACK OF RESPONSE**

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

Accordingly Rule 5.8. applies to the matter at hand and the Panel is determining the matter on the basis of the Complaint as filed by the Complainant.

## **FACTS**

According to the Complaint, the Complainant is the owner of the trade mark Shoppers Drug Mart and other trade marks that consist and/or comprise the term Shoppers Drug Mart the first registration of which in the Canadian Intellectual Property Office, ("CIPO") dates back to June 27, 1969. Under license, the Complainant has granted to Shoppers Drug Mart Inc and its predecessor, Shoppers Drug Mart the right to use all its trade-marks in Canada in association with the products and services for which they are registered. Shoppers Drug Mart, established in the nineteen fifty's, is a leading player in Canada's retail drugstore marketplace, (some 950 stores throughout Canada) and is the number one provider of pharmacy products and services. Annual sales are in excess of Four Billion Dollars Canadian. Its trade mark and trade name has been extensively used, advertised and promoted in Canada and continues to be so used, promoted and advertised in connection with its products and services. Shoppers Drug Mart has operated web sites at [www.shoppersdrugmart.ca](http://www.shoppersdrugmart.ca) and [www.shoppersdrugmart.com](http://www.shoppersdrugmart.com) since 1999.

According to the Complaint, the Disputed Domain Name was approved for registration July 12, 2005 as evidenced by copies of Registrant Information from CIRA's Whois database for [wwwshoppersdrugmart.ca](http://wwwshoppersdrugmart.ca). The Registrar of record for the Disputed Domain Name is Sibername Internet and Software Technologies Inc.

According to the Complaint the source code for the home page associated with the Disputed Domain Name is linked to the web site [Oingo.com](http://Oingo.com), which is owned, according to Network Solutions Inc Whois database, by Google Inc. This site redirects to [www.appliedsemantics.com](http://www.appliedsemantics.com), another site owned by Google Inc which provides a description of the services associated with the program Google AdSense. Google AdSense and [Oingo.com](http://Oingo.com) is a revenue program which

assists domain name owners to maximize revenue from their parked domain names by providing a straightforward and easy-to-use money-making system..

The home page that the Registrant operates in association with the Disputed Domain Name is headed by the term “wwwshoppersdrugmart.ca” in large print. Below this heading is another heading, which reads: “Here are related web sites for wwwshoppersdrugmart.ca”. Below this heading is a search portal for Internet users to conduct Internet searches. Underneath the search portal is a column with a heading at the top reading “Sponsored Links” followed by a series of links to sites. One of these links is for the Complainant’s web site “www.shoppersdrugmart.ca”. All other links direct to third party web sites, one of which is a competitor of the Complainant; namely, Dugstore.com. Searches conducted through the search portal on the Registrant’s web site provide links to competitors of the Complainant; namely; reliable-on-line-drug.com, usamedonline.com, ivfmeds.com , betterhealthcx.com, supercheaprx.com, drugstore.com, ActiveandAble.com.

The Complainant maintains that there is no relationship between the Complainant and the Registrant, nor has the Registrant been licensed nor authorized to use the Shoppers Drug Mart Mark in Canada or otherwise, in any manner, including in, or as part of, a domain name.

## **REASONS**

Paragraph 4.1 of the Policy places the onus on the Complainant to prove on a balance of probabilities that the Disputed Domain Name is confusingly similar to the Shoppers Drug Mart mark and that the Registrant has registered the Disputed Domain Name in bad faith. In addition the Complainant must adduce some evidence that the Registrant has no legitimate interest in the Disputed Domain Name.

## **CONFUSINGLY SIMILAR**

To deal first with the issue of the Disputed Domain Name being confusingly similar to the Shopper Drug Mart mark in which the Complainant had rights prior to the date of registration of the Disputed Domain Name.

### **Prior Rights**

Evidence shows that the Complainant is the owner and continues to have rights of ownership in accordance with subparagraph 3.3(b) of the Policy of a number of active trade-marks that incorporate the trade mark Shoppers Drug Mart which are registered in CIPO. The earliest date of registration of the mark in that office is June 27, 1969 and the latest May 19, 2005. The disputed Domain Name was registered July 2, 2005.

Accordingly, the Shoppers Drug Mart mark registration predates the registration of the Disputed Domain Name.

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

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

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

The date of registration of the Disputed Domain Name is clearly subsequent to the Claimant’s rights associated with the Shoppers Drug Mart mark.

To deal now with the issue of “confusingly similar” to the mark, paragraph 3.4 of the Policy provides that a domain name is confusingly similar to a mark, if the domain name so nearly resembles the mark in appearance, sound or the ideas suggested by the trade-mark as to be likely to be mistaken for the mark.

In other words, the test is whether the average internet user with an imperfect recollection of the Shoppers Drug Mart mark who wishes to access a web site operated by the Complainant either by entering a domain name including the Shoppers Drug Mart mark into the address search engine, would likely be confused as a matter of first impression with the Disputed Domain Name (See *Amazon Com Inc v David Abraham*, CIRA Dispute No 00018 at p. 4)

In addition it has been held that a Registrant may not avoid confusion by appropriating another’s entire mark in a domain name (See *Canadian Broadcasting Corporation/Soci t  Radio-Canada v. William Quan*, BCICAC Case No 00006)

The only difference between the Shoppers Drug Mart mark and the Disputed Domain Name is the addition of the letters “www “ in front of the Shoppers Drug Mart mark without the addition of a period after the “www”. This issue was addressed in *Thrifty, Inc v Supriyo Malakar o/a DotCrafter*, CIRA Case No 00050) where the panel accepted the submission by the complainant that the omission of the period after “www” and before the mark was a typing error which does not constitute a marked difference in terms of appearance, sound and ideas suggested by the portion after “www”.

Several WIPO panels have held in Uniform Dispute Resolution Policy (URDP) proceedings that “www” is the well-known acronym for the world wide web and thus has no distinguishing capacity in a domain name context. In addition, use of “www” at the beginning of a domain name causes confusion whenever a very common and well-known typing error occurs, i.e. the typist omits the period “.” which would normally separate a domain name from the “www” field. In fact, WIPO Panels have held that:

In the context of domain names, the letters “www” have the effect of focusing particular attention on the word succeeding them. This is because a casual reader of the domain name may wrongly think that there is a period between the “www” and the succeeding word and so wrongly assume that the domain name is in fact comprised only of the succeeding word. (See *Scania CV AB (Publ) v. Unacl, Inc*, WIPO Case No D2005, at p. 3 and *Reuters Limited v Global Nel 2000, Inc*, WIPO Case No D2000-0441 at p. 6)

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

## **BAD FAITH REGISTRATION**

The second onus of proof that the Complainant must address is to demonstrate that the Registrant has registered the Disputed Domain Name in bad faith. Paragraph 3.7 of the Policy enumerates three tests to determine whether or not such bad faith exists. The wording of Paragraph 3.7 is exhaustive providing “if” and “only if”, a Panel finds that the action of a registrant meets any one of these tests that the registrant will be considered to have registered a domain name in bad faith.

### **Registration Primarily for Alienation**

The first of these tests is whether a registrant registered the domain name primarily for the purpose of generating revenue from the domain name by means of selling or otherwise alienating to the complainant or a competitor of the complainant at a cost in excess of the registrant’s actual costs in registering or acquiring the domain name.. Based on the evidence this test does not apply in the case at hand.

### **Registration to Prevent Registration providing the Registrant has engaged in a pattern**

The second test is whether the Registrant registered the Disputed Domain Name in order to prevent the Complainant or its licensees from registering the Shoppers Drug Mart mark as a domain name. To meet this test the Complainant must show that the 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. While evidence has been adduced that the registrant has engaged in a pattern of registering other well-known trade marks as domain names and has

already been the subject of at least one CIRA dispute involving such misuse, this test does not apply to the case at hand as the Complainant has registered the domain name shoppersdrugmart.ca.

### **Registration to Disrupt Business**

The third test is whether the Registrant registered the Disputed Domain Name primarily to disrupt the business of the Complainant who is a competitor of the Registrant.

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

The phrase “disrupting the business of the Complainant” as per the Policy has been held to be satisfied where the use of the domain name creates a likelihood of confusion among end users as to affiliation or sponsorship, and includes trade-mark infringement and passing off (See *Great Pacific Foods Industries Inc v Ghalib Dhalla* CIRA Dispute No 0009, pp.20-21)

In *The Standard Life Assurance Company of Canada v Hank Morin*, CIRA Case No 00046, a case involving the Registrant, Hank Morin, the Panel referred to the purpose of the Policy to assist in interpreting “disrupting” as it relates to the business of trade mark owners and stated:

Further, the purpose of the Policy is to protect the owners of established trademarks and trade names against unfair and unreasonable predation by others’ registrations of domain names Confusingly similar with those trademarks or trade names. Five hundred years of legal consideration of the misuse of trademarks and trade names has focused on causing confusion as the paradigm instance of such misuse. Thus, though the Policy may be clumsily drafted in this regard, the Panel must interpret “disrupting” as including the causing of trademark and trade name confusion.”

The home page of the web site that the Registrant operates in association with the Disputed Domain Name is headed by the term “wwwshoppersdrugmart.ca” in large print. Below this heading is another heading; which reads “Here are some related web sites for: wwwshoppersdrugmart.ca”. Below this heading is a search portal for Internet users to conduct Internet searches. Underneath the search portal is a column with a heading at the top reading “Sponsored Links” followed by a series of links to sites. One of these links is for the Complainant’s web site “www.shoppersdrugmart.ca”. All other links direct to third party web sites, one of which is a competitor of the Complainant, namely, Drugstore.com. Searches conducted through the search portal on the Registrant’s web site provide links to competitors of the Complainant; namely, reliable-online-drugs.com, usamedsonline.com, ivfmeds.com, betterhealthrx.com, supercheaprx.com, drugstore.com, ActiveandAble.com.

In this case, as in *The Sun Life Assurance Company of Canada* case, supra, the Panel finds that the Registrant's use of its Confusingly Similar domain name with web sites featuring links to sites offering products in competition with the Complainant constitutes "disrupting" the Complainant's business in the form of classic trademark or trade name confusion.

To succeed in showing the Registrant's Bad Faith, however, the Complainant must also establish that the Registrant is a competitor of the Complainant.

There is no evidence to suggest that the Registrant is itself a direct business competitor of the Complainant (the Registrant is not in the business of selling the products and providing the services that the Complainant provides). However, the Registrant does use the Disputed Domain Name which is a Confusingly Similar domain name to the Mark on a site which contains links directly to the web sites of competitors of the Complainant where the competitors are offering products and services in competition with the Complainant. The web site associated with the Disputed Domain Name, which the Registrant operates features these links under the heading "Sponsored Links". As found in *The Sun Life Assurance Company of Canada* case, supra:

...a reasonable inference is that the Registrant receives compensation for featuring these links on its web site. The Registrant is a joint venturer in selling competing products with the enterprises located at the links on the Registrant's web site. The Registrant is acting as a competitor of the Complainant for the purposes of Policy paragraph 3.7 (c).

For the reasons stated above, the Panel finds that the Complainant has satisfied the onus required of it by clause (b) of paragraph 4.1 of the Policy that the Registrant registered the Disputed Domain Name in bad faith as described in paragraph 3.7 (c) of the Policy.

## **LEGITIMATE INTEREST OF THE REGISTRANT**

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

In Paragraph 3.6 an exhaustive list is applied which provides that a registrant has a "legitimate interest" in a domain name "if, and only" before a complaint is filed, the domain name in question meets the criteria of one or more of sic test.

### **Use of a Mark**

The Disputed Domain Name is a Mark owned by the Complainant. The Registrant has never been licensed or authorized to use the Shoppers Drug Mart mark in any manner in Canada or otherwise including in, or as part of a domain name, nor has the Complainant provided its consent to the Registrant to register the [www.shoppersdrugmart.ca](http://www.shoppersdrugmart.ca). The Registrant is not entitled to register and use the Shoppers Drug Mart mark as a domain name even if it is selling the Shoppers Drug Mart product. Such use constitutes an infringement of the Complainant's

rights in the mark and accordingly the use does not constitute a good faith or bona fide use.. The Registrant cannot therefore rely on the application of this test.

#### **Use of Clearly Descriptive Name or Generic Name**

The trade mark and trade name Shoppers Drug Mart is not clearly descriptive or a generic name and therefore these grounds does not apply

#### **Use of Domain Name for Non-commercial Activity**

The inference to be drawn from the evidence is that the Registrant is generating revenue from the use of the Disputed Domain Name. There is no evidence to show that it is being used in association with a non-commercial activity as described in 3.6(d) of the Policy.

#### **Use of Legal Name of the Registrant**

According to the CIRA WHOIS particulars for the Disputed Domain Name, the Registrant is listed as Hank Morin. This test accordingly does not apply.

#### **Geographical Name**

The Disputed Domain Name is not a geographical name. Accordingly, this test does not apply

On examination of the evidence and the tests to be applied the Panel concludes that none have been satisfied so as to justify a legitimate interest of the Registrant in the use of the Disputed Domain Name.

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

#### **Balance of Probabilities**

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

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

### **DECISION AND ORDER**

The Panel finds that the Complainant has succeeded in this proceeding initiated under the Policy.

For the reasons stated herein, the Panel grants the relief requested by the Complainant, and orders and directs that the registration of the Disputed Domain Name, namely, [wwwshoppersdrugmart.ca](http://wwwshoppersdrugmart.ca) be transferred to the Complainant.

Dated, this 25<sup>th</sup> day of August 2006

(sgd) Elizabeth Cuddihy

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Elizabeth Cuddihy, QC  
Sole Panelist