

CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number: DCA-944-CIRA
Domain Name: blackanddecker.ca
Complainant: The Black & Decker Corporation
Registrant: J. Chapnik Trust – (100%)
Registrar: Domainer Inc.
Panel: Stefan Martin
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

PREAMBLE

1. The Canadian Internet Registration Authority (“CIRA”) is responsible for operating the dot-ca Internet country code Top Level Domain (“ccTLD”).
2. This is an administrative proceeding pursuant to the CIRA Domain Name Dispute Resolution Policy, adopted by CIRA and in effect as of December 4, 2003 (the “Policy”) and the CIRA Domain Name Dispute Resolution Rules, version 1.1 (the “Rules”).
3. The CIRA Registration Agreement governing dot-ca domain names requires, in virtue of section 3.1 (a)(iv), that the Registrant comply with the Policy throughout the term of the registration agreement. Paragraph 3.1 of the Policy requires that the Registrant submit to this dispute resolution proceeding.
4. The British Columbia International Commercial Arbitration Centre (“BCICAC”) is a recognized service provider pursuant to the Policy.

THE PARTIES

5. The Complainant is The Black & Decker Corporation, situated at 701 East Joppa Road, Towson, Maryland, U.S.A., 21286.
6. The Registrant is J. Chapnik Trust – (100%), situated in Toronto, Ontario, Canada, M5R 2E4. The Registrant’s complete address has not been provided.

THE DOMAIN NAME AND REGISTRAR

7. The Domain Name that is the subject of this proceeding is “blackanddecker.ca”.
8. The Registrar of the Domain Name is Domainer Inc.
9. The Domain Name was registered by the Registrant on December 26, 2004.

PROCEDURAL HISTORY

10. According to the information provided by BCICAC, the dispute resolution service provider, the history of this proceeding is as follows:
 - (a) On September 12, 2006 the Complainant filed a complaint regarding the Domain Name with BCICAC.
 - (b) On September 13, 2006, after having determined that the complaint was in administrative compliance with the requirements of the Policy and the Rules, the BCICAC commenced the dispute resolution process and served notice of the complaint to the Registrant.
 - (c) The Registrant requested and the BCICAC granted an extension for the delivery of its Response to October 23, 2006.
 - (d) The Registrant failed to provide a timely response to the complaint as set out in Paragraph 5 of the Rules but rather offered to transfer the Domain Name to the Complainant.
 - (e) The Complainant has decided to proceed with the arbitration.
 - (f) The complaint was filed in English, which is the language of this proceeding in accordance with Paragraph 10.1. of the Rules.
 - (g) In the absence of a response, the Complainant has elected, under Paragraph 6.5 of the Rules, to convert from a panel of three arbitrators to a single Panel.
 - (h) Mtre Stefan Martin has been appointed as sole panellist and has delivered to the BCICAC the required Statement of Impartiality and Independence, as required by Paragraph 7 of the Rules.
 - (i) Absent exceptional circumstances, the Panel was required to deliver its decision by November 15, 2006.

11. The Panel finds that it was properly appointed in accordance with the Policy and the Rules.
12. Based upon the information provided by the BCICAC, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding were met.
13. The Complainant was represented by legal counsel throughout this proceeding. The Respondent was not represented by legal counsel.

FACTUAL BACKGROUND

14. The Panel proceeds on the basis of the following facts, which are established by the evidence submitted by the Complainant:
 - (a) The Complainant is The Black & Decker Corporation.
 - (b) The Registrant is J. Chapnik Trust – (100%), situated in Toronto, Ontario, Canada.
 - (c) On December 26, 2004, the Registrant registered the domain name blackanddecker.ca.
 - (d) By letters dated June 21, 2006 and July 6, 2006, the Complainant gave notice to the Registrant of the Complainant's objection to the registration of the Domain Name blackanddecker.ca.
15. The Complainant contends as follows:
 - (a) The Complainant is the owner in Canada of the following registered trademarks:
 - BLACK & DECKER, UCA 22068;
 - BLACK & DECKER, TMA 201904;
 - BLACK & DECKER & DESIGN, TMA332876;
 - BLACK & DECKER & DESIGN, TMA381091;
 - BLACK & DECKER & HEXAGON DESIGN, TMA413400;
 - THE POWER OF BLACK & DECKER, TMA391927;and the Domain Name is confusingly similar to the Complainant's trademarks, in which the Complainant had rights prior to the registration of the Domain Name and in which the Complainant continues to have such rights.
 - (b) The Registrant has no legitimate interest in the Domain Name because:

- (i) the Registrant has not used the Domain Name in good faith and has no rights in the Complainant's said registered trade-marks;
 - (ii) the Domain Name is not clearly descriptive;
 - (iii) the Domain Name is not a generic name;
 - (iv) the Domain Name has not been used in association with a non-commercial activity;
 - (v) the Domain Name is not the name or surname of the Registrant; and
 - (vi) the Domain Name is not a geographical name.
- (c) The Registrant registered and is using the Domain Name in bad faith because:
- i) the Registrant registered the Domain Name to prevent the Complainant from registering its trade-marks as domain names, and has engaged in a pattern of doing so;
 - ii) the Registrant registered the Domain Name primarily for the purpose of disrupting the business of the Complainant, who is a competitor of the Registrant.

16. The Registrant, as previously mentioned, did not respond to the complaint.

DISCUSSION AND FINDINGS

JURISDICTION OVER THE PARTIES

17. The Complainant, The Black & Decker Corporation, is the registered owner in Canada of the trade-marks identified at paragraph 15(a) hereof and therefore satisfies the CIRA Canadian Presence Requirement for Registrants, as stipulated in paragraph 1.4 of the Policy.

EFFECT OF FAILURE OF REGISTRANT TO FILE A RESPONSE

18. Section 5.8 of the Rules provides that:

“If a Registrant does not submit a Response within the period for submission of a Response or any period extended pursuant to paragraph 5.4 or 5.6, the Panel shall decide the Proceeding on the basis of the Complaint [...].”

19. However, as stated in *Browne & Co. Ltd. v. Bluebird Industries* (CIRA Decision N° 00002):

“This requirement does not preclude the Panel from assessing the integrity and credibility of the evidence as disclosed in the Complaint.”

20. In the present case, the Panel does not see any reason to question the integrity and credibility of Complainant’s evidence.

APPLICABLE LAW

21. Pursuant to Section 12.1 of the Rules, the Panel shall apply 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.
22. The Registrant is domiciled in Ontario. The Complainant has not stated a preference for any applicable law and therefore the Panel will render its decision in accordance with the Policy, the Rules and any rules and principles of law applicable in the Province of Ontario and the laws of Canada applicable therein.

OVERVIEW OF THE POLICY

23. Paragraph 4.1 of the Policy sets forth the Complainant’s burden of proof in order to succeed in the proceeding. The onus is on the Complainant to 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.

The Complainant must also provide some evidence that:

- (c) the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.6.

CONFUSING SIMILARITY BETWEEN DOMAIN NAME AND COMPLAINANT'S MARKS

24. As it was held by the Panel in *Government of Canada, on behalf of Her Majesty the Queen in Right of Canada v. David Bedford*, BCICAC Case No. 00011, where a complainant relies upon a trade-mark registered prior to the domain name registration date, the Policy does not require or permit the Panel to go behind the registration to determine whether the trade-mark is valid or invalid based upon lack of distinctiveness or non- use. This principle was confirmed in *Viacom International Inc. v. Harvey Ross Enterprises, Ltd.*, BCICAC Case No. 00015:

“For the purpose of construing “confusing similarity” 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 in and of itself to establish such “rights” within the meaning of the Policy.”

25. The Complainant submits that the Domain Name is “confusingly similar” to the following trade-marks which the Complainant had registered prior to the date of registration of the Domain Name and in which the Complainant continues to have rights:

- BLACK & DECKER, UCA 22068;
- BLACK & DECKER, TMA 201904;
- BLACK & DECKER & DESIGN, TMA332876;
- BLACK & DECKER & DESIGN, TMA381091;
- BLACK & DECKER & HEXAGON DESIGN, TMA413400;
- THE POWER OF BLACK & DECKER, TMA391927;

26. Paragraph 3.4 of the Policy defines the term “Confusingly Similar” as follows:

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

27. In applying this definition, it is important to note paragraph 1.2 of the Policy which stipulates 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.”

28. Moreover, as noted in *AT&T Corp. v. ATandT.com* (WIPO Case No. D2002-1178):

“The absence of an ampersand in domain names is dictated by the fact that such a character may not be included in domain names. For that reason domain names are expected to exclude that character. An ampersand is the character or sign representing the word “and”. Internet users expect an ampersand to be replaced with an equivalent, or ignored, in domain names.”

29. In this context, the test to be applied is one of first impression and imperfect recollection (*Government of Canada v. Bedford*, May 27, 2003, p. 15) :

“Accordingly, for each Domain Name the Complainant must prove on a balance of probabilities that a person, on a first impression, knowing the Complainant’s corresponding mark only and having an imperfect recollection of it, would likely mistake the Domain Name (without the .ca suffix) for Complainant’s corresponding mark based upon the appearance, sound or the ideas suggested by the Mark.”

30. Considering these principles, the Panel notes that the Domain Name is identical to the Complainant’s registered trade-marks and therefore that the Domain Name is indeed confusingly similar.

31. The Complainant has also provided sufficient evidence to demonstrate that it had registered its trade-marks in Canada prior to the date of registration of the Domain Name, that is December 26, 2004, and that it is still their registered owner.

32. In light of all the above, the Panel is of the view that the Complainant has met its first burden of proof.

NO LEGITIMATE INTEREST IN THE DOMAIN NAME

33. The Complainant submits that the Registrant has no “legitimate interest” in the Domain Name, as this term is defined in paragraph 3.6 of the Policy.
34. Paragraph 3.6 of the Policy sets forth an exhaustive list of criteria for determining whether a registrant has a legitimate interest in a domain name. It reads as follows:

“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.

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

35. Since the Registrant has failed to provide a Response to the complaint, the Panel is therefore limited to reviewing the evidence and arguments submitted by the Complainant.
36. The evidence demonstrates that the Registrant has never used the Domain Name in connection with or in relation to any wares, services or business. Therefore, the Registrant cannot rely on any of the “legitimate interests” listed in subparagraphs 3.6(a), (b) or (c) of the Policy.
37. In this regard, the evidence demonstrates that the Domain Name was simply “parked” at a customized Internet portal in order for the Registrant to benefit from Internet traffic and become eligible for a referral fee. With respect to such cases, it is stated in *Lowen Corporation d/b/a Lowen Sign Company v. Henry Chan* (WIPO Case No. D2004-0430) that:

“The use of the domain in such a way does not constitute a bona fide offering of goods or services giving rise to any right or legitimate interest.”
38. Furthermore, “blackanddecker” is not the legal name of the Registrant, nor is there any evidence to suggest that it is the name, surname or other reference by which the Registrant was commonly identified, thus eliminating subparagraph 3.6(e) of the Policy.
39. Finally, there is no evidence to suggest that the Registrant has never used the Domain Name in association with a non-commercial activity, and therefore subparagraphs 3.6(d) and (f) of the Policy are also eliminated.
40. In light of all the above, the Panel is of the view that the Complainant has met its second burden of proof.

BAD FAITH REGISTRATION

41. The Complainant submits that the Registrant has registered the Domain Name in “bad faith” as this term is defined in paragraph 3.7 of the Policy.
42. Paragraph 3.7 of the Policy sets forth the following exhaustive list of criteria for determining whether a Registrant registered a domain name 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.”

43. The evidence demonstrated that:

- (a) the Registrant had “parked” the Domain Name in order to obtain referral fees;
- (b) the Internet site linked to the Domain Name contained the following statement: “Welcome to blackenddecker.ca: For resources and information on Black And Decker Parts”;
- (c) provided sponsored links to competitors of the Complainant; and
- (d) provided means by which end users could conduct searches and access links to competitors of the Complainant.

44. The Complainant refers to subparagraph 3.7(b) of the Policy and submits that the Registrant registered the Domain Name in bad faith because it was registered in order to prevent the Complainant from registering its family of trade-marks as domain names, and because the Registrant has engaged in such a pattern with others as well.

45. Clearly, the registration by the Registrant of the Domain Name has prevented the Complainant from registering the “.ca” domain name for its trade-marks.

46. As for the Complainant’s obligation to also demonstrate that the Registrant has engaged in such a pattern with others as well, the Complainant demonstrated that the Registrant has registered at least six (6) other domain names which correspond to trade-marks of others. In this context, it is pertinent to cite *Viacom International Inc. v. Harvey Ross Enterprises, Ltd.* (BCICAC Case No. 00015), which stated the following:

“Moreover, the Registrant has failed to provide any tenable, explanation as to its numerous registrations of other domain names which are comprised of third parties marks. The clear inference to be drawn from that conduct, coupled with the registration of the Domain Name in issue, is that it was done so in bad faith with a view to preventing the Complainant from registering its trade-marks as a domain name.”

47. The Complainant also refers to subparagraph 3.7(c) of the Policy and submits that the Registrant registered the Domain Name in bad faith because it registered the Domain Name primarily for the purpose of disrupting the business of the Complainant, who is a competitor of the Registrant.

48. In order to determine whether the Registrant could in fact be qualified as a “competitor” of the Complainant whose actions “disrupted” the business of the Complainant, it is pertinent to cite *Amazon.com Inc. v. David Abraham* (BCICAC Case No. 00018), as the activities of the registrant in that case were similar to the Registrant’s activities:

“His business is to attract Internet traffic to his websites and by referring this traffic on to websites such as those owned by the Complainant, to generate referral fees. By carrying on this business through the websites named with the Disputed Domain Names, the Registrant was clearly competing with the Complainant and disrupting its business” [emphasis added].

49. In light of the above, the Panel is of the view that the Registrant (i) registered the Domain Name in order to prevent the Complainant from registering its family of trade-marks as domain names and has engaged in such a pattern with others, and that it (ii) registered the Domain Name primarily for the purpose of disrupting the business of the Complainant, its competitor.

50. Consequently, the Panel is of the view that the Complainant has met its third and final burden of evidence.

CONCLUSION AND DECISION

51. The Complainant has proven, on a balance of probabilities, that the Domain Name is Confusingly Similar to Marks in which the Complainant had Rights prior to the date of registration of the Domain Name and in which the Complainant continues to have such Rights, as such terms are defined in the Policy.
52. The Complainant has adduced evidence that the Registrant has no legitimate interest in the Domain Name, as described in paragraph 3.6 of the Policy. Furthermore, the Registrant, having decided not to file a response, has obviously not proven, on a balance of probabilities, that he has a legitimate interest in the Domain Name, as described in paragraph 3.6 of the Policy.
53. Finally, the Complainant has also proven, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith as described in Paragraph 3.7 of the Policy.
54. For these reasons, the complaint regarding the Domain Name is successful and the Panel orders and directs that the registration of the domain name "blackanddecker.ca" be transferred to the Complainant.



Stefan Martin

Date: November 15, 2006