

**CANADIAN INTERNET REGISTRATION AUTHORITY (CIRA)**

**DOMAIN NAME DISPUTE RESOLUTION POLICY**

**COMPLAINT**

Dispute Number: DCA-959-CIRA  
Domain Name: best-western.ca  
Complainant: Best Western International, Inc.  
Registrant: Daniel Montanbault  
Registrar: Tucows.com Co.  
Panel: Rodney C. Kyle  
Service Provider: British Columbia International Commercial Arbitration Centre

**DECISION**

**PARTIES**

Complainant is **Best Western International, Inc.**, of 6201 N. 24th Parkway, Phoenix, Arizona (“Complainant”).

Registrant is **Daniel Montanbault**, of 1275 Av des Gouverneurs, Quebec City, Quebec (“Registrant”).

**REGISTRAR AND CONTESTED DOMAIN NAME**

The contested domain name is <**best-western.ca**> (“the contested domain name”), and **Tucows.com Co.** 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 6 November 2006.

On 9 November 2006, apparently in a effort to behave

- (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 27 November 2006 by which Registrant could file a Response to the Complaint.

The BCICAC was not satisfied with what Registrant then provided and so the BCICAC found that Registrant had not filed a Response. (The BCICAC apparently was not satisfied because Registrant did not provide all copies required by Resolution Rules ¶ 5 within the time limits prescribed by Resolution Rules ¶ 5.) Given that finding of an absence of a Response, and as permitted under Resolution Rules ¶ 6.5, Complainant elected to convert from a three-person panel to a sole panelist.

On 5 December 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 6 December 2006 the Panel provided the BCICAC with his declaration of his independence and impartiality.

On 7 December 2006 and 13 December 2006, Registrant apparently emailed solely the Panel. The Panel then forwarded each of those emails to the BCICAC. In turn, on 7 December 2006, the BCICAC forwarded the first of those emails to Complainant (with a copy to Registrant and to CIRA), informed both Parties (and CIRA) that the Panel had received and forwarded the first of those emails to the BCICAC, and drew the attention of both Parties to Resolution Rules ¶ 2.3. Other than email system date and time data, the 13 December 2006 email had the same content as the 7 December 2006 email and apparently was not forwarded by the BCICAC.

## **RELIEF SOUGHT**

Complainant requests that in accordance with Policy ¶ 4.3, the contested domain name be transferred from Registrant to Complainant.

## **PARTIES' CONTENTIONS**

### **A. Complainant**

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

### **FIRST MAIN SET**

In the first main set of contentions, Complainant basically contends by three points that Complainant is eligible to initiate the Proceeding. More particularly, Complainant's contentions include that

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<sup>1</sup> That notice also states 28 December 2006 as the date by which the Panel is to forward its decision in the Proceeding to the BCICAC. On 20 December 2006, in accordance with Policy ¶ 4.2 and Resolution Rules ¶¶ 9.1(c) and 1.4, that date of 28 December 2006 was extended to 18 January 2007; on 21 December 2006, the BCICAC notified the Parties thereof. Likewise, on 18 January 2007 the Panel extended that forwarding date to 22 January 2007; the BCICAC promptly notified the parties of that extension as well. Similarly, on 22 January 2007, the Panel extended that forwarding date to 23 January 2007 and the BCICAC promptly notified the parties of that extension.

- (i) Complainant satisfies Policy ¶ 1.4 by satisfying CIRA's Canadian Presence Requirements For Registrants Version 1.3 ("CPR") ¶ 2(q);
- (ii) Exhibit B of each of Complaint Schedules 1 and 2, is a copy of a Canadian Intellectual Property Office ("CIPO") registration TMA407630, evidencing that Complainant is the owner of the CIPO-registered trade-mark BEST WESTERN; and
- (iii) the contested domain name consists of or includes the exact word component of that CIPO-registered trade-mark.

## 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 2 April 2006, and that each of Exhibit A of Complaint Schedule 1 and Exhibit I of Complaint Schedule 2 is a copy of a domain name registration record evidencing that registration.

The second point is that within the meaning of "Mark" as defined by Policy ¶¶ 3.2(c) and 3.2(a), there is a Mark consisting of BEST WESTERN 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, as to Policy ¶ 3.2(c), Complainant contends that since 5 February 1993 Complainant was and is the owner of a CIPO-registered trade-mark of BEST WESTERN in association with "Hotel, motel and resort services, and group advertising, promotion and reservation services for hotels, motels and resorts", and that Exhibit B of Complaint Schedule 2 is a copy of a registration evidencing that ownership. Also more particularly, but instead as to Policy ¶ 3.2(a), Complainant contends that Complainant has used BEST WESTERN extensively in Canada as a trade-mark since at least as early as November 1964, and that paragraphs 3 and 6 to 10 (as well as Exhibits A and C to H) of Complaint Schedule 2 are evidence thereof.

The third point is basically 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 the contested domain name is the Mark with a hyphen added to it and so that the contested domain name 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), and is to the effect that the contested domain name consists of a Mark in which Registrant had no Rights and which Registrant did not use in good faith. More particularly, Complainant's contentions include that

- (i) Registrant is not licensed or otherwise authorized to use Complainant's above-mentioned Mark;
- (ii) the text covered by Complainant's above-mentioned Mark, is not the subject of any trade-mark registration or application in which Registrant has Rights;
- (iii) the contested domain name is neither a legitimate name of any business belonging to Registrant nor in any other way identified with Registrant;
- (iv) as of on or about 31 July 2006, the contested domain name is not associated with any valid internet address; and
- (v) some or all of what listed in this paragraph is evidenced by paragraph 5, and Exhibit C, of Complaint Schedule 1.

The second point is as to Policy ¶ 3.6(b), and is to the effect that the contested domain name is not clearly descriptive in any of the senses enumerated in that paragraph.

The third point is as to Policy ¶ 3.6(c), and is to the effect that the contested domain name is not understood in Canada to be the generic name of Registrant's wares, services, or business as understood in any language.

The fourth point is as to Policy ¶ 3.6(d), and is two-fold:

- (i) the contested domain name is neither used for non-commercial criticism, review or news reporting nor "registered to promote 'best Western movies in Canada'"; and
- (ii) the absence of either or both of such use and such registration purpose, is evidenced by paragraph 12 (and Exhibit J) of Complaint Schedule 2.

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

The sixth point is as to Policy ¶ 3.6(f), and is to the effect that the contested domain name is not a geographical name of the location of 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 two 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), and is to the effect that Registrant registered 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 the contested domain name. More particularly, Complainant's contentions include that

- (i) on or about 13 July 2006, 19 July 2006, and 17 August 2006 (all as evidenced by paragraph 12, and Exhibit J, of Complaint Schedule 2), Registrant asked or represented having asked Complainant for \$US90,000 and \$US11,000, in exchange for the transfer of the contested domain;
- (ii) in the description section of the registration record of the contested domain name, Registrant refers to the contested domain name as "this major domain name" and invites offers to purchase it (all as evidenced by paragraph 3, and Exhibit A, of Complaint Schedule 1 as well as by paragraph 11, and Exhibit I, of Complaint Schedule 2);
- (iii) Registrant has registered five other ".ca" domain names in general bad faith, as evidenced by paragraphs 6 to 17 (and Exhibits D to O) of Complaint Schedule 1; and
- (iv) Registrant has registered ten other ".ca" domain names in the particular bad faith commonly known as typosquatting, as evidenced by paragraphs 18 to 34 (and Exhibits D and P to FF) of Complaint Schedule 1.

The second point is further to the first of these two points or alternatively is as to Policy ¶ 3.7(b): that Registrant has registered the contested domain name in order to prevent Complainant from registering Complainant's Mark BEST WESTERN as a domain name and that 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.

#### FIFTH MAIN SET

In the fifth main set of contentions, Complainant basically contends that domain names are registered to be used to point to a specific website and that the Complaint should be resolved in a manner consistent with Canadian trade-mark law, particularly one or more of *Trade-marks Act* sections 19, 20, and 22 as well as Complainant's CIPO trade-mark registration of BEST WESTERN.

#### B. Registrant

Registrant apparently did not file a Response.

### FINDINGS

The Panel finds

- (i) Complainant is eligible to initiate the Proceeding in that, as required by Policy ¶ 1.4, at the time of submitting the Complaint, the Complaint relates to a CIPO-registered trade-mark BEST WESTERN (being registration TMA407630) and Complainant is the owner of the trade-mark;
- (ii) Registrant
  - (a) is required to submit to the Proceeding in that, as required by Policy ¶ 3.1, the Complaint is submitted in sufficient compliance with the Policy and the Resolution Rules and contains assertions of each of the Policy ¶ 3.1 elements "(a)", "(b)", and "(c)" and

- (b) has submitted to the Proceeding;
- (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 2 April 2006,
  - (b) within the meaning of the expression “Mark” as defined by Policy ¶ 3.2, there is a Mark consisting of BEST WESTERN 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) Complainant (itself) does not satisfy the CPR in respect of the contested domain name and has not named any nominee (let alone one which satisfies the CPR in respect of the contested domain name); and
- (v) the contested domain name should be transferred to a nominee of Complainant in accordance with Policy ¶¶ 4.3 and 4.5, especially in view of points “(iii)” and “(iv)” of this list of findings.

## DISCUSSION

### Summary and Introduction

In summary, the Proceeding is substantively straightforward but basically raises three procedural points. The first two of those procedural points are apparently of a sort not raised in earlier proceedings under the Policy, and an aspect of the third procedural point has to some extent arisen in such earlier proceedings but has been dealt with in depth in only one of those proceedings. Those three procedural points (“(i)” to “(iii)”) are the following:

- (i)
  - (a) if a complaint specifies only the first and second of the three courts referred to in paragraph 5 of Resolution Rules Appendix A, is the complaint noncompliant with Resolution Rules ¶ 3.2(D)(p) and
  - (b) if such a complaint is noncompliant in that way, then in this case does the nature and extent of that noncompliance amount to noncompliance with Policy ¶ 3.1 such that Registrant was not required to submit to the Proceeding;
- (ii)
  - (a) what are the bilingualism requirements of Resolution Rules ¶¶ 2.1, 4.3, and 4.4 regarding notice of commencement of a proceeding under the Policy, and were those requirements met in this case and
  - (b) if those requirements were not met in this case, then did Registrant have any powers to waive them and did Registrant use such powers; and
- (iii) if a panel decides in favour of a complainant in a response-default proceeding under the Policy and finds not only that the complainant (itself) does not satisfy the CPR in respect of the domain name contested by the proceeding but also that

the complainant has not named any nominee (let alone one which satisfies the CPR in respect of that domain name), then is the complainant entitled to have the panel find, that as part of implementing the panel's decision, the complainant is entitled to name a nominee to CIRA and that CIRA is to determine whether that nominee satisfies the CPR in respect of that domain name.

Resolution Rules ¶ 4.5 is that "The Administrator may provide administrative assistance to the Panel or a Panellist, but shall have no authority to decide matters of a substantive nature in the Proceeding." (By Resolution Rules ¶ 1.1(a), the expression "Administrator" means, "with respect to a Proceeding, the case administrator appointed by [a 'Provider' such as the BCICAC] to be responsible for all administrative matters relating to the Proceeding.") A person's substantive legal interests include not only that person's legal interests as to remedies for themselves or their nominees but also that person's legal interests as to submitting disputes for resolution.<sup>1bis</sup> In a proceeding under the Policy, matters of a substantive nature (as contrasted with matters of a solely administrative nature) include complainant eligibility under Policy ¶¶ 1.4 and 4.6 (last sentence),<sup>2</sup> complaint compliance with Policy ¶ 3.1,<sup>3</sup> whether the Policy ¶ 4.1 onus is satisfied,<sup>4</sup>

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<sup>1bis</sup> Such substantive legal interests of parties under the Policy include legal interests as to remedies for themselves or their nominees (as in Policy ¶¶ 4.1, 4.6 (complainant bad-faith), and 4.3 set out in *infra* notes 4, 2, and 5) and as to submitting disputes for resolution (as in Policy ¶¶ 1.4, 4.6 (last sentence), and 3.1 set out in *infra* notes 2 and 3). See e.g., Robert M. Nelson, *Nelson on ADR*, (Toronto, Ontario: Thomson Canada Limited, 2003), at 161 citing *Huras v. Primerica Financial Services* (2001), 55 O.R. (3d) 449 (Ont. C.A.) for the proposition that "[w]hen a judge declares that an arbitration agreement is invalid and inapplicable, he or she affects the party's right to submit disputes to arbitration which is a substantive right, thereby making an order that is final."

<sup>2</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.

Policy ¶ 4.6 is as follows:

**4.6 Bad Faith of Complainant.** If the Registrant is successful, and the Registrant proves, on a balance of probabilities, that the Complaint was commenced by the Complainant for the purpose of attempting, unfairly and without colour of right, to cancel or obtain a transfer of any Registration which is the subject of the Proceeding, then the Panel may order the Complainant to pay to the Provider in trust for the Registrant an amount of up to five thousand dollars (\$5000) to defray the costs incurred by the Registrant in preparing for, and filing material in the Proceeding. The Complainant will be ineligible to file another Complaint in respect of any Registration with any Provider until the amount owing is paid in full to the Provider.

<sup>3</sup> Policy ¶ 3.1 is as follows:

**3.1 Applicable Disputes.** A Registrant must submit to a Proceeding if a Complainant asserts in a Complaint submitted in compliance with the Policy and the Resolution Rules that:

remedy eligibility under Policy ¶ 4.3,<sup>5</sup> and complainant bad faith under Policy ¶ 4.6.<sup>6</sup> The Panel therefore has authority to decide not only matters such as compliance with Policy ¶ 4.1 but also matters such as compliance with Policy ¶¶ 1.4, 3.1, and 4.3. That is so, even though, as to Policy ¶ 3.1, under Resolution Rules ¶ 4.3 the BCICAC (i) apparently was satisfied that the Complaint is in administrative compliance with the Policy and the Resolution Rules and that Complainant appears to be eligible to commence the Proceeding in accordance with Policy ¶¶ 1.4 and 4.6; and (ii) as a result, apparently sent the Complaint to Registrant in the manner prescribed by Resolution Rules ¶ 2.1.

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- (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>4</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 [as defined by Policy ¶ 3.4] to a Mark [as defined by Policy ¶ 3.2] in which the Complainant had Rights [as defined by Policy ¶ 3.3] 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 [Policy ¶] 3.7; and the Complainant must provide some evidence that:
- (c) the Registrant has no legitimate interest in the domain name as described in [Policy ¶] 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>5</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>6</sup> *Supra* note 2.



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 of that last-quoted passage, as well as Registrant’s being domiciled in Quebec and there not being any preference indicated by both parties for the laws of any other province or territory, it is rules and principles of the laws of Quebec (and of Canada applicable in Quebec) that are applicable to the Proceeding. Therefore, Complainant’s fifth main set of contentions (i.e. that domain names are registered to be used to point to a specific website and that the Complaint should be resolved in a manner consistent with Canadian trade-mark law, particularly one or more of *Trade-marks Act* sections 19, 20, and 22 as well as Complainant’s contended CIPO trade-mark registration of BEST WESTERN) pertains but is not determinative. It pertains but is not determinative because what is at the core of the Policy, the Resolution Rules, and the CPR and what ought to be at the core of decisions made in proceedings that construe those rules, is the interface between, on the one hand, principles of trademark law and the interests of persons with trademark-related legal interests, and, on the other hand, domain name registration principles such as first-come-first-served and the interests of domain name registrants. “Construing [domain dispute resolution policies] is an activity separate from, but informed by, construing law (such as trademark law and contract law).”<sup>7</sup>

Also, in view especially of the two immediately preceding paragraphs 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>8</sup>

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<sup>7</sup> Rodney C. Kyle, “[Are Canadian and Other Domain Name Dispute Resolution Processes Arbitrations?](#)” In *The Proceedings of the Thirteenth Annual Conflict Resolution Symposium: 2004*, (Ottawa: Carleton University, 2005), at footnote 20 [66KB PDF: crs\_2004\_kyle].

<sup>8</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).

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>9</sup> Third, as to construing and applying Policy ¶ 4.2 and Resolution Rules ¶ 9.1(d), especially as to whether mode “1” rather than mode “3” applies: a complainant’s pleading of fact that is not disputed (or, phrased differently, not “put in issue”) by a registrant against whom it is contended, is an admission by that registrant,<sup>10</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>11</sup> Fourth, as to

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<sup>9</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 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>10</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>11</sup> Compare Hohfeld, *supra* note 8 (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.

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>12</sup>

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>13</sup>

However, the fact that a Response was apparently not filed, 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 6 November 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

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<sup>12</sup> Delisle, *supra* note 11, 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.

<sup>13</sup> Delisle, *supra* note 11, at 91. *Cf. Levesque v. Levesque*; *Birmingham v. Birmingham* (1994), 116 D.L.R. (4th) 314 at 324-325 (Alta. C.A.).

Complainant's allegations<sup>14</sup> and shall make a decision on the evidence before the Panel,<sup>15</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>16</sup>

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

Policy ¶ 1.4 has first and second parts.<sup>17</sup> Complainant's first main set of contentions includes contentions (as what are set out above as its points "(ii)" and "(iii)") that amount to contentions under the second part of Policy ¶ 1.4: that the Complaint relates to a CIPO-registered trade-mark and that Complainant is the owner of the trade-mark. Specifically, each of those two points of that set of contentions is proven on the balance of probabilities: the Panel has stated the two points of that set of contentions above and each of those two points of that set of contentions basically proves what it contends to prove, so the Panel need not say more.

### **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>18</sup> The

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<sup>14</sup> Cf. *Arbitration Act, 1991*, S.O. 1991, c. 17, s. 27(2).

<sup>15</sup> Cf. *Arbitration Act, 1991*, S.O. 1991, c. 17, s. 27(3).

<sup>16</sup> Sir Michael J. Mustill and Stewart C. Boyd, *Commercial Arbitration*, 2nd ed. (Toronto, Ontario: Butterworths, 1989) at 538 (footnote omitted).

<sup>17</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>18</sup> Policy ¶ 3.1 is as follows:

**3.1 Applicable Disputes.** A Registrant must submit to a Proceeding if a Complainant asserts in a Complaint submitted in compliance with the Policy and the Resolution Rules that:

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

Complaint basically includes assertions of Complaint compliance with Policy ¶ 3.1 in two ways. Firstly, the Complaint asserts generally that the Complaint is submitted for decision in accordance with the Policy and the Resolution Rules. (The Complaint does so to greater or lesser extents through using wording largely along those lines in such things as its cover page, the paragraph immediately before its main body’s signature block, and paragraph 1 of its “Certification” section.) Secondly, the Complaint also asserts more particularly each of what amounts to the Policy ¶ 3.1 elements “(a)”, “(b)”, and “(c)”; the Complaint does so in its “Conclusion” section.

However, is the Complaint actually submitted in compliance with the Policy and the Resolution Rules, such that Policy ¶ 3.1 is therefore satisfied, and such that Registrant must therefore submit to the Proceeding? (As elaborated on below, the Panel answers that first question by finding, that in a narrower sense, the Complaint was not submitted in compliance with the Policy and the Resolution Rules.) If there is noncompliance with the Policy and the Resolution Rules, then in this case is the nature and extent of the noncompliance sufficient for Registrant to not have to submit to the Proceeding? (As elaborated on below, the Panel answers that second question by finding that in this case, the nature and extent of the noncompliance is not sufficient for Registrant to not have to submit to the Proceeding.)

The first of those two questions arises especially because there is a difference between the certification paragraph 5 prescribed by Resolution Rules ¶ 3.2(D)(p) and the Complaint’s “Certification” paragraph 5. Specifically, Resolution Rules ¶ 3.2(D)(p) provides that “The Complaint shall: ... (D) ... (p) conclude with the certification of the Complainant in the form set out in Appendix A, followed by the signature of the Complainant or its authorized representative.” More specifically, paragraph 5 of Resolution Rules Appendix A specifies jurisdiction of three prospective courts for challenges to a decision in the Proceeding, as follows:

The Complainant will submit, with respect to any challenge to a decision in the Proceeding, to the jurisdiction of a superior court of a province or territory of Canada having jurisdiction over the Registrant pursuant to the rules of such court or, if no such court has jurisdiction pursuant to its rules, to the jurisdiction of the superior court of the province or territory in Canada in the city in which the Provider has its principal place of business in Canada, as posted on the Provider’s website, or the jurisdiction of the superior court in the City of Ottawa in the Province of Ontario.

(Emphasis added. Also, Resolution Rules ¶ 5.2(C)(j), which prescribes the Resolution Rules Appendix B form for use by registrants, is identical to Resolution Rules ¶

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- (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.

3.2(D)(p), except by replacing “The Complaint shall” by “The Response will”, replacing each occurrence of “the Complainant” by “the Registrant”, and replacing “Appendix A” by “Appendix B”. Likewise, paragraph 2 of the Appendix B form prescribed for use by registrants is identical to paragraph 5 of the Appendix A form prescribed for use by complainants, except that the one occurrence of “The Complainant”, which is at the very beginning of form A’s paragraph 5, is replaced by “The Registrant”.) In contrast, the Complaint’s “Certification” paragraph 5 is identical to paragraph 5 of the Appendix A form, except by replacing “Ottawa” by “Vancouver” and replacing “Ontario” by “British Columbia”. At least in a narrower sense, that difference between the Complaint’s “Certification” paragraph 5 and the Appendix A form’s paragraph 5, clearly amounts to noncompliance with what Resolution Rules ¶ 3.2(D)(p) refers to as “the form set out in Appendix A”.

The second question, of the two questions set out above, therefore arises. (That question is, if there is noncompliance with the Policy and the Resolution Rules then, in this case is the nature and extent of the noncompliance sufficient for Registrant to not have to submit to the Proceeding.) The question requires the Panel to construe paragraph 5 of Resolution Rules Appendix A, and then ascertain whether, in this case, the nature and extent of the noncompliance amounts to noncompliance sufficient for Registrant to not have to submit to the Proceeding. In this case, the nature and extent of the noncompliance is not sufficient for Registrant to not have to submit to the Proceeding. That is because

- (i) the three underlined passages in the above-quoted Resolution Rules Appendix A paragraph 5, indicate (by “to” occurring in each of the first two passages but not in the third passage) that
  - (a) the second-listed and third-listed of the three prospective courts are to be submitted to only if there is not a first-listed court (i.e. “a superior court of a province or territory of Canada having jurisdiction over the Registrant pursuant to the rules of such court”) that “has jurisdiction pursuant to its rules” and
  - (b) if there is no such first-listed court, then, to submit their complaints under the Policy, complainants are to have agreed to have left themselves open to what is basically the challenging party’s choice regarding the second-listed court and the third-listed court—a choice that a complainant would not be entitled to preclude by doing such things as conflating the second-listed and third-listed courts when making its Resolution Rules Appendix A paragraph 5 certification,<sup>19</sup> but

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<sup>19</sup> The following three points are consistent with, but apparently not necessary for, that construction of Resolution Rules Appendix A paragraph 5: (1) CIRA apparently has not publicly disclosed, and apparently does not publicly disclose, where the “.ca” registry server is located, even as to what city or what province; (2) the Panel assumes that the server for the “.ca” ccTLD domain name registry is in Ottawa (rather than elsewhere in Canada and rather than someplace outside of Canada such as somewhere in the United States), because, for example, Ottawa is where CIRA is headquartered and Ottawa is the location of the third-listed court; and (3) an analysis completely analogous to what is set out in part “(i)” of this paragraph, regarding complainants (as well as complaints and Resolution Rules Appendix A paragraph 5), applies to registrants (as well as to responses and Resolution Rules Appendix B paragraph 2) and likewise does not depend on either or both of points “(1)” and “(2)” of this note.

- (ii) in this case, although Complainant has conflated the second-listed and third-listed courts, there apparently is a superior court of a province or territory of Canada having jurisdiction over Registrant pursuant to the rules of such court— that court and rules are apparently the Superior Court of Québec and the rules by which it has such jurisdiction (pursuant to *Courts of Justice Act*, R.S.Q., chapter T-16, sections such as sections 2 and 22; *Code of Civil Procedure*, R.S.Q. c. C-25 sections such as sections 20, 22, 23, 31, 33, and 46 to 48; *Rules of practice of the Superior Court of Québec in civil matters*, R.Q. c. C-25, r.8; and *Rules of practice in civil matters of the Superior Court (District of Québec)*, R.Q. c. C-25, r.1.02).

**Notice of Commencement of the Proceeding: Actual, Formal, and Waiver**

In any event, Registrant submitted to the Proceeding. An actual notice, solely in English, was apparently sent to Registrant regarding commencement of the Proceeding; apparently that notice was received and understood by Registrant. Moreover, Registrant had powers to waive the bilingualism requirements of Resolution Rules ¶¶ 2.1, 4.3, and 4.4 regarding notice of commencement of a proceeding under the Policy, and there are two aspects of Registrant use of those powers. Firstly, Registrant did not object to what was apparently the BCICAC’s noncompliance with the bilingualism aspects of the formal notice requirements of Resolution Rules ¶¶ 2.1, 4.3 and 4.4.<sup>20</sup> Secondly, Registrant

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<sup>20</sup> Those three Resolution Rules include the following:

- 2.1 Notice.** *When sending a Complaint to the Registrant, the Provider shall communicate in both English and French and shall use whatever reasonably available means are likely to give actual notice to the Registrant. ...*
- 4.3 Notice to the Registrant.** *As soon as the Provider is satisfied that the Complaint is in administrative compliance with the Policy and the Resolution Rules and that the Complainant appears to be eligible to commence the Proceeding in accordance with paragraphs 1.4 or 4.6 of the Policy, the Provider shall promptly send the Complaint to the Registrant, in the manner prescribed by paragraph 2.1.*
- 4.4 Notice of Commencement of Proceeding.** *Upon the actual or deemed receipt of the Complaint by the Registrant pursuant to paragraph 2.6, the Provider shall immediately give notice to the Parties, the relevant Registrar(s) and CIRA of the commencement of the Proceeding and advise the Parties of the name and contact details of the Administrator.*

(Italics, and underlining, added.) Perhaps the BCICAC is of the view that if a complaint under the Policy is filed in English, then all correspondence is to be in English. However, such a view would seem to not be the best construction of the Resolution Rules generally and of Resolution Rules ¶¶ 2.1 and 4.4 particularly: the languages (i.e. “both English and French”) required for a notice of commencement of a proceeding under the Policy is one matter, whereas the language (or languages) of other aspects of such a proceeding are quite another matter.

Moreover, Resolution Rules ¶¶ 2.4 and 10 would apparently provide context (but not support) for such a view as might be taken by the BCICAC; however, they also support the Panel’s view. Those two Resolution Rules are as follows:

- 2.4 Language.** *All communications will be made in the language prescribed in paragraphs 2.1 and 10. Email communications should, if practicable, be sent in plaintext.*

...

acknowledged that the Panel has jurisdiction in the Proceeding and that the Policy and the Resolution Rules apply to the Proceeding. Such non-objection and such acknowledgement occurred because, although Registrant apparently did not file a Response, Registrant's emails to the Panel dated 7 and 13 December 2006

- (i) are solely in English;
- (ii) are unequivocally addressed to "the panel", in the Panel's character as the Panel in the Proceeding;
- (iii) unequivocally refer to Complainant as "the Complainant" in the Proceeding; and
- (iv) refer to Registrant as "the Registrant" and attempt to avail himself of the Policy and the Resolution Rules by contending solely
  - (a) that particular Complainant behavior had occurred prior to the Proceeding and
  - (b) that such contended Complainant behaviour avails Registrant under Resolution Rules ¶ 12.6.<sup>21</sup>

### **Confusing Similarity**

The context in which this part of this discussion occurs includes Policy ¶¶ 3.2,<sup>22</sup> 3.3,<sup>23</sup> and 3.4,<sup>24</sup> which respectively define the expressions "Mark," "Rights," and "Confusingly

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**10.1 Language.** The Proceeding and all documents submitted in the Proceeding must be in English or French or a combination of the two languages. Unless otherwise agreed by the Parties and the Panel:

- (a) if the Complaint and the Response are in the same language, both Parties must use that language throughout the Proceeding; and
- (b) if the Complaint and the Response are in different languages, the Parties are free to use either language during the Proceeding.

The overview provided at <<http://www.wipo.int/amc/en/domains/search/overview/index.html#43>> regarding proceedings under the UDRP, likewise provides only background. It includes the following in answer to the question "What is the proper language of the proceeding?":

The language of the proceeding is the language of the registration agreement, unless both parties agree otherwise.

but that

[i]n certain situations, where the respondent can clearly understand the language of the complaint, and the complainant would be disadvantaged by being forced to translate, the language of proceedings can remain the language of the complaint, even if it is different to the language of the registration agreement.

<sup>21</sup> That Resolution Rule includes the following:

**12.6 Bad Faith of Complainant.** If the Panel finds that the Complaint was commenced for the purpose of attempting, unfairly and without colour of right, to cancel or obtain transfer of any Registration which is the subject of the Proceeding, the Panel shall so declare in its decision and support with reasons that the Complaint was brought for such purpose.

<sup>22</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



Similar” which appear in Policy ¶ 4.1(a),<sup>25</sup> and 3.5,<sup>26</sup> which defines “use” and “used,” which appear in Policy ¶¶ 3.2 and 3.3.

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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>23</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;
- (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>24</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>25</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>26</sup> Policy ¶ 3.5 is as follows:

**3.5 Use.** A Mark is deemed to be in “**use**” or “**used**” in association with:

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 (relating to Policy ¶¶ 3.2 to 3.5 and 4.1(a)) is proven on the balance of probabilities: the Panel has stated that set of contentions above and each of the three points of that set of contentions does indeed prove what it contends to prove, so the Panel need not say more.

### **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>27</sup>

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- (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.

<sup>27</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;
- (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;

Complainant's third main set of contentions proves that Complainant satisfies the Policy ¶ 4.1(c) onus. Specifically, each of the six points of that set of contentions (respectively as to Policy ¶¶ 3.6(a) to 3.6(f)) is proven on the balance of probabilities: the Panel has stated that set of contentions above and each of the six points of that set of contentions basically proves what it contends to prove, so the Panel need not say more

### **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>28</sup>

Complainant's fourth main set of contentions proves that Complainant satisfies the Policy ¶ 4.1(b) onus. Specifically, each of the two points of that set of contentions (one point being as to Policy ¶ 3.7(a) and the other point being as to Policy ¶ 3.7(b)) is proven on the balance of probabilities: the Panel has stated that set of contentions above and each of the two points of that set of contentions basically proves what it contends to prove, so the Panel need not say more.

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- (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>28</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**

If a panel decides in favour of a complainant in a response-default proceeding under the Policy and finds not only that the complainant (itself) does not satisfy the CPR in respect of the domain name contested by the proceeding but also that the complainant has not named any nominee (let alone one which satisfies the CPR in respect of that domain name), then is the complainant entitled to have the panel find, that as part of implementing the panel's decision, the complainant is entitled to name a nominee to CIRA and that CIRA is to determine whether that nominee satisfies the CPR in respect of that domain name? Yes.

In view of three sets of facts that satisfy either or both of Policy ¶¶ 4.3 and 4.5,<sup>29</sup> the contested domain name should be transferred to a nominee of Complainant which satisfies the CPR in respect of the contested domain name. First, in view of all of what is stated above (before the heading of "Remedy-Eligibility"), the Panel decides in favour of Complainant. Second, Complainant (itself) does not satisfy the CPR in respect of the contested domain name and has not named any nominee (let alone one which satisfies the CPR in respect of the contested domain name). Third, despite the second of these three sets of facts, Complainant is entitled, as part of implementing the Panel's decision, to name to CIRA a nominee of Complainant which CIRA determines satisfies the CPR in respect of the contested domain name.

The basis for the second set of facts is three-fold:

- (i) the facts of this case are highly similar to the initial facts of the decision in *House of Blues Brands Corp. v. Artbravo Inc.*, CIRA Dispute No. 00054 (that is, the facts prior to when the panel in that case asked the complainant in that case to name a nominee);
- (ii) the Panel is persuaded by that decision's minority view (and especially that minority view as expressed at pages 25 to 27 of that decision), about satisfying

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<sup>29</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**").

Policy ¶ 4.5 is as follows:

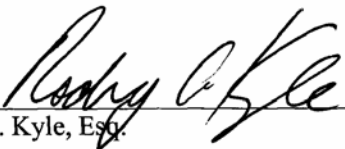
**4.5 Implementation of Decision.** If a Panel decides in a Proceeding by way of its decision that a Registration is to be canceled or transferred, and CIRA is satisfied that the Complainant, or Nominee, then satisfies the CPR in respect of the domain name that is subject of the Proceeding, CIRA will implement the decision as soon as practicable but no sooner than sixty (60) days after the date on which CIRA is notified by the Provider that the Complainant, the Registrant, the Registrant's Registrar have been notified by the Provider of the Panel's decision. If the Panel decides that the Registration should be transferred, CIRA is not required to effect the transfer until the Complainant or Nominee, enters into a Registrant Agreement with CIRA.

- the CPR in respect of a domain name that is in dispute in any proceeding under the Policy; and
- (iii) the Panel finds it desirable to add only two points:
- (a) that it is not uncommon for one person to be entitled to commence a proceeding in which the person who is to receive the benefit of the proceeding's decision is someone else— examples are trustees for beneficiaries, and litigation guardians for persons with disabilities and
  - (b) since the Proceeding is a response-default proceeding, the Panel is precluded from asking Complainant to name a nominee.

The basis for the third set of facts is basically Policy ¶¶ 4.3 and 4.5.<sup>30</sup> More specifically, the Panel does not construe Complainant's request for relief as being limited to a request for transfer of the contested domain name to Complainant (itself), pursuant solely to Policy ¶ 4.3. Instead, the Panel construes Complainant's request for relief as a request for transfer to Complainant (itself or as represented by a nominee of Complainant), pursuant to Policy ¶¶ 4.3 and 4.5 and in accordance with Policy ¶ 4.3.

## DECISION

Policy ¶¶ 1.4, 3.1, and 4.1 having been satisfied, and Policy ¶ 4.3 having been satisfied in part, the Panel concludes that the relief requested by Complainant shall be **GRANTED**, provided that, as part of implementing the Panel's decision, Complainant names to CIRA a nominee of Complainant which CIRA determines satisfies the CPR in respect of the contested domain name.

  
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Rodney C. Kyle, Esq.  
Arbitrator

Rodney C. Kyle, B.Sc., LL.B.  
Sole Panelist  
Ottawa, Ontario Canada  
Dated: 23 January 2007

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<sup>30</sup> *Supra* note 29.