

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

Complainant: Canadian Broadcasting Corporation/Société Radio-Canada
Registrant: Ghalib Dhalla
Disputed Domain Name: hockeynightincanada.ca
Registrar: DomainPeople, Inc.
Panellist: Pierre-Emmanuel Moyse
Service Provider: British Columbia International Commercial Arbitration Centre
(the “BCICAC”)

BCICAC FILE NUMBER: DCA-964-CIRA

I - The Parties

1. The Complainant is the Canadian Broadcasting Corporation/Société Radio-Canada (hereinafter, “CBC”), a federal crown corporation, having its principal place of business at 250 Front Street West, Toronto, Ontario, M5V 3G5.
2. The Registrant is Ghalib Dhalla.

II - Proceedings and Facts

A – Proceedings

3. CBC seeks resolution by arbitration of a dispute which has arisen between the parties from the registration by the Registrant of the domain name « hockeynightincanada.ca », (the “Domain Name”).

4. CBC filed a complaint on December 13, 2006, with the British Columbia International Arbitration Center (“BCICAC”) pursuant to the CIRA’s Domain Name Dispute Resolution Rules (the “Rules”).
5. The Complaint was forwarded to the Registrant on December 14, 2006.
6. The Registrant has not provided a response.
7. The Complainant has elected under paragraph 6.5 of the Rules to convert from a panel of three to a single arbitrator.
8. By letter dated January 9, 2007, BCICAC has appointed the undersigned as sole arbitrator in the present matter.

B – Context

1 – The Domain Name

9. The Domain Name at issue is “hockeynightincanada.ca”.

2 – The facts

10. It appears from the evidence filed with the procedure (*Exhibit E*) that the Registrant registered the domain name “hockeynightincanada.ca” on November 8, 2000. The name G. Dhalla appears both as the administrative and technical contact. On May 26, 2003, the Registrant initiated correspondence with CBC’s representatives and employees regarding the Domain Name, which ultimately triggered the sending of a cease and desist letter, from the CBC to the Registrant, on September 11, 2006.

11. The first email from the Registrant, dated May 26, 2003, was sent to Nancy Lee, Executive Director of CBC Sports. Its content deals with the possibility of transferring the Domain Name to CBC. This email shows that the intentions of the Registrant were to speculate on the value of the Domain Name as an electronic anchor or a platform to host a hockey-related website or redirect traffic from it. The following edited excerpt of the email sent by the Registrant would suffice to set the record straight: “I’ve had the registration for “hockeynightincanada.ca” for some time now. Initially my plans were to create a website for hockey pools, however it doesn’t seem to be a viable option now that officepools.com has quite a head start. (...) In any case, if you are interested, I can transfer the site to CBC. My other option is to ask the other hockey pool sites if they are interested in a redirection of traffic using my registration. (...)”. And the email ends with a clear indication concerning the purpose of the Registrant’s initial contact: “...any consideration would be much appreciated”.

12. Following this first email, the parties entered into negotiation. The exchange of emails documented under *Exhibits F to L* demonstrates the ambiguous position of the Registrant with respect to the transfer of the Domain Name. The reason for the hesitations on the part of the Registrant to transfer the Domain Name to CBC may be found in the Registrant’s email sent to CBC on June 24, 2003. The retention of the Domain Name by the Registrant is clearly an intent to speculate, the Registrant mentioning moreover that “I would appreciate a reasonable offering (considering the costs of filing a dispute resolution claim starts at \$4K without taking into account your legal costs)”.

13. As indicated previously in my opinion, CBC put an end to the negotiations by sending the Registrant a cease and desist letter to the Registrant on September 11, 2006, demanding that the Domain Name be assigned immediately, failing which CBC would commence dispute resolution proceedings with the Canadian Internet Registration Authority.

14. I should add here that, as in many cybersquatting cases, the domain name “hockeynightincanada.ca” has been registered (parked) with a micropayment Internet service. Said services exploit parked domain names by redirecting the traffic they attract toward paid web sites (see, for example, *Canada Post Corporation v. Marco Ferro*, DCA-871-CIRA, “candapost.ca”). The Panel, in *AADAC v. Akshay Solutions*, DCA-933-CIRA, “aadac.ca”, commented on this practice and noted that “[i]t has become increasingly popular practice among registrants to park their domain names at websites that operate revenue programs whereby domain name holders who redirect Internet users to these websites are eligible for referral fee. Registrants only see an upside to doing so, as in many cases, the alternative would be to park the domain names at inactive sites, which of course is a less attractive proposition as it does not generate revenue for registrants”.
15. The Domain Name was under construction for some time and was placed, at an indeterminate date, under the auspices of a pay-per-click service. Without having to undergo a complete study of such commercial exploitation it is useful to understand how it works: the Registrant, as is the case in the present situation, registers with a so-called on-line sponsor – a company that has its presence on the Internet and proposes to generate revenue by increasing traffic toward other registered web sites, the system then generates a generic page on which selected links appear (in our case: « Ice Hockey Equipment », « Ice Hockey Coaching », « Las Vegas Night Clubs » (*Exhibit N*)). The software of the so-called sponsor takes care of the rest to nurture the attraction power of the domain name.
16. I should add that those services are business models and I will not pronounce myself on their legality. However, the use or parking of a domain name representing the trade-mark of someone else may constitute an additional element in the determination of bad faith pursuant to paragraph 3.7 CIRA Policy.

17. I will now review the criteria that the CBC must meet in order to be granted the transfer of the Domain Name.

III – Criteria under CIRA dispute resolution rules

18. CBC is an eligible complainant under paragraph 1.4 of the CIRA Policy and meets the presence requirement rules set out by CIRA. CBC is a government entity within the meaning of paragraph 2(p) of the Canadian Presence Requirement Policy.

19. CBC has the burden to prove under the preponderance of probability test that the Domain Name “hockeynightincanada.ca” is (1) similar with a trade-mark in which it has a right and that right predates the registration date of the Domain Name, (2) that the Registrant has registered the Domain Name in bad faith, and (3) the Registrant does not have a legitimate interest in the Domain Name (paragraphs 3 and 4 CIRA Policy).

20. The evidence brought forward and introduced by CBC is convincing for each and all branches of the test set out by CIRA. The right of CBC in the trade-mark should prevail.

A – The right of CBC in the trade-mark and similarity with the Domain Name

1 – The right in the trade-mark

21. There would have been little ground to oppose CBC’s trade-mark rights in this cause of action even if the Registrant decided to reply. CBC has a clear right in the trade-mark “Hockey Night In Canada”.

22. This nominal trade-mark has been used by CBC since the 1950’s. Documented evidence, including copies of registration certificates, indicates that the slogan or

expression “Hockey Night In Canada” was registered in Canada in May 1978 with the Canadian Intellectual Property Office. Such documentation identifies CBC as the actual owner of the trade-mark (*Exhibit A*). The evidence filed by CBC also demonstrates that the trade-mark is used in connection with television and radio programs, services for which it was initially registered, as well as promotional material such as hockey pucks, T-shirts, golf balls, etc. CBC made the expression “Hockey Night In Canada” its own. CBC’s constant use of it made the expression so distinctive amongst Canadians that I have no difficulty whatsoever to conclude that “Hockey Night In Canada” identifies CBC, and one might even venture, is CBC. Our law recognizes the principle whereby a rather weak sign may become unique and distinctive. The extensive use of a sign by its owner can remedy its inherent lack of distinctiveness (see, Section 12(2) *Trade-marks Act* (R.S., 1985, c. T-13)).

23. CBC’s trade-mark “Hockey Night In Canada” is also registered as an official trade-mark since 1998 (Section 9(1)(n)(iii) *Trade-marks Act* (R.S., 1985, c. T-13)).
24. In any event, the right in the trade-mark existed previously to the registration by the Registrant of the Domain Name at issue.

2 - Similarity

25. The Domain Name “hockeynightincanada.ca” is identical to the registered trade-marks “Hockey Night In Canada” owned by CBC within the meaning of paragraph 3 CIRA Policy, i.e. confusingly similar.
26. The present case differs from cases where only a part of an inherently weak nominal trade-mark is reproduced or where there is a variation of spelling between the domain name and the trade-mark. Those cases are often more difficult to decide for obvious reasons: the discussion is to determine if the part

reproduced or altered trade-mark is similar to the extent to be confusingly similar. For example, in *Enterprise-Rent-A-Car v. Ebenezer Thevasagayam*, CIRA, DCA-857-CIRA, the majority concluded that the generic domain name “entreprise.ca” was similar to the trade-mark “Enterprise Rent-A-Car”. I dissented. In *Canada Post Corporation v. Marco Ferro*, CIRA, “candapost.ca”, DCA-871-CIRA, the panel exposes the strategy of misspelling famous trade-marks known as “typo-piracy” in order to generate traffic. The panel found that “the domain name in dispute is confusingly similar to the trade-mark. It has no real meaning other than as a mis-spelling of the Complainant’s trade-mark”.

B – Bad faith

27. Bad faith could be inferred from the distinctive character of the trade-mark reproduced in part or in whole. In the latter case, of which the present case is a perfect example, there is a strong presumption – although rebuttable - of bad faith. But, other elements militate in favor of CBC. The evidence clearly shows the intention of the Registrant to set up a website destined to hockey matters. The Domain Name “hockeynightincanada.ca” displayed for a period of time the usual banner “under construction”, and, more interestingly, the following indications: “Hockey Pools” and “Future site for hockey pools” (*Exhibit M*). These elements corroborate the admission found in the Registrant’s email dated May 26, 2003, to which I have already referred (*Exhibit F*): “Initially my plans were to create a website for hockey pools, however it doesn’t seem to be a viable option now that officepools.com has quite a head start”.

28. The Registrant could not seriously ignore that, by registering the Domain Name, it would benefit from the notoriety of CBC’s trade-mark and interfere or disrupt CBC activities related to its use. Speculation was the main purpose of the registration and it was done in bad faith within the meaning given to that notion under CIRA Policy. Nothing in the evidence I have reviewed diverts me from this conclusion.

C – Legitimate interest

29. There is no indication or evidence that the Registrant has a legitimate interest in the name pursuant to paragraph 3.6 CIRA Policy. Its use as a traffic generator via pay-per-click services is a clear indication that the Registrant has no other interest but to gain some revenue from it and that very purpose is not legitimate given the fundamental objective of CIRA Policy to thwart cybersquatting.

30. This case, contrary to other domain name cases, gives a definition of cybersquatting and CIRA Policy should be given full application.

ORDER

31. The Domain Name “hockeynightincanada” must be transferred to the complainant CBC.

Montreal, January 26, 2007

Pierre-Emmanuel Moyse