

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

Complainant: Craigslist, Inc.

Complainant Counsel: Neil P. Melliship
Clark Wilson LLP
800 – 885 West Georgia Street
Vancouver. BC V6C 3H1

Registrant: Daniel Cox

Disputed Domain Name: craigslist.ca

Registrar: DomainsAtCost Corp.

Panelists: Elizabeth Cuddihy, Q.C., I.C.A. (Chair)
Anton M.S. Melnyk, Q.C.
R. John Rogers

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

BCICAC File Number: DCA-962-CIRA

1. The Parties

The Complainant is Craigslist, Inc, a corporation with principal place of business located at 1381 9th Avenue, San Francisco, California, 94122, U.S.A.

The Registrant is Daniel Cox whose address is 14036 Parkland Blvd. S.E., Calgary, Alberta, T2J 3X5.

2. The Domain Name and Registrar

The Disputed Domain Name is craigslist.ca. The Registrar with which the Disputed Domain Name is registered is DomainsAtCost Corp. The Disputed Domain Name was registered on August 4, 2004

3. Procedural History

On December 5, 2006, the Complainant filed a Complaint against the Registrant with the BCICAC seeking that the Registrant’s right of ownership of the domain name, craigslist.ca (the “Disputed Domain Name”) be arbitrated in accordance with the CIRA’s Domain Name Dispute Resolution Rules (the “Rules”) and that an order be made pursuant to the CIRA

Domain Dispute Resolution Policy (the “Policy”) that the registration of the Disputed Domain Name be transferred to the Complainant.

The Complaint was reviewed by the BCICAC, as service provider and found to be in administrative compliance with the Policy and the Rules in accordance with the provisions of Rule 4.2.

By way of letter and email dated December 6, 2006, the BCICAC so advised the parties and forwarded copy of the Complaint by email and courier to the Registrant for Response.

On January 2, 2007, the Registrant requested an extension for delivery of its Response.. As this request was made outside the timeframe required to provide a Response, the request was denied by the BCICAC.

Notwithstanding the availability to convert to a single member panel due to the lack of Response by the Registrant, the Complainant wished the matter proceed with a three member panel.

By letter January 10, 2007, the BCICAC, acting in accordance with the Rules, appointed a panel of three arbitrators, Elizabeth Cuddihy, QC, as Chair, Anton M. S. Melnyk, QC, and R. John Rogers (collectively “the Panel”).

Each member of the Panel has delivered to the Service Provider an Acceptance of Appointment as an Arbitrator and Statement of Independence and Impartiality, in conformity with the Rules.

As the Complaint was filed in English, English shall be the language of the proceeding.

The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Rules and that based upon the information provided by the Service Provider, all procedural requirements for the commencement and maintenance of this proceeding were met.

4. Background Facts

Craigslist operates a very popular online community bulletin board with classified ads and discussion forums, hosted from its website CRAIGSLIST.ORG.

The website has been operated by Craigslist since 1995; the trade name and trade mark CRAIGSLIST has been used in association with local classified and bulletin board services since that date through the CRAIGSLIST.ORG website; and the over 300 CRAIGSLIST community websites have been linked to that site representing communities in over 50 countries, including Canada.

Craigslist also owns the CRAIGSLIST.COM domain name, which resolves to the CRAIGSLIST.ORG website.

In Canada, CRAIGSLIST has 29 customized community websites representing all 10 provinces all of which are accessible through the CRAIGSLIST.ORG website. The Vancouver, Toronto, and Montreal CRAIGSLIST.ORG sites were launched in April 2001, April 2003 and January 2004 respectively.

On November 7, 2003, the Complainant filed an application with the Canadian Intellectual Property Office ("CIPO") for registration of the Trade- mark CRAIGSLIST in connection with its services which application matured to registration as Mark TMA671414, on August 29, 2006 as evidenced by extract of CIPO Trade-mark database provided by the Complainant.

The Disputed Domain Name was registered by the Registrant August 6, 2004.

There is no evidence of communication between the parties in respect of the Disputed Domain Name.

5. Eligible Complainant

Pursuant to paragraphs 1.4 and 3.4 of the Policy, and paragraph 2 (q) of the *CIRA Policies Procedures and Guidelines: Canadian Presence Requirements for Registrants*, the Disputed Domain Name is identical to the trademark CRAIGSLIST owned by the Complainant and registered at the Canadian Intellectual Property Office (CIPO) as number TMA671414.

Accordingly, the Complainant satisfies the Canadian Presence Requirements for Registrants as prescribed by the Policy.

6. Analysis of CIRA Policy Provisions

Policy Paragraph 4 provides:

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

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.

(a) Confusingly Similar 4.1(a) test

The application for registration of the CRAIGSLIST Mark was filed November 11, 2003 and did not mature to registration until August 29, 2006. The Disputed Domain Name was registered August 4, 2004.

Policy Paragraph 3.2 defines Mark under 4 categories including:

- (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 a person's predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person.

Policy Paragraph 3.3 provides that 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;

The Complaint claimed that it had rights as defined in the Policy in CRAIGSLIST as a trade-mark and trade name in connection with the provision worldwide, including in Canada of a popular online community bulletin board with classified ads and discussion forums, hosted from its website CRAIGSLIST.ORG which site has been in operation since 1995.

The Complainant filed a trade-mark application for CRAIGSLIST on November 7, 2003 with CIPO, which application matured to registration TMA671414 on August 29, 2006 as evidenced by the submitted extract of the CIPO Trade-mark database.

The evidence shows that the Complainant is the owner of the CRAIGSLIST Mark, which matured to registration August 29, 2006 and that the Complainant continues to be the owner of the mark.

The CRAIGSLIST.ORG website has been operated by the Complainant since 1995 and the trade name and trade-mark CRAIGSLIST have been used in association with local classified and bulletin board services since that date through the CRAIGSLIST.ORG website. Vancouver, Toronto and Montreal CRAIGSLIST.ORG sites were launched in April 2001, April 2003 and January 2004 respectively.

Further evidence provided by the Complainant shows not only the prominence of CRAIGSLIST for provision of its services but also its popularity on the net worldwide, including in Canada well before the registration of the Disputed Domain Name.

While the Panel recognizes that the filing of an application for a Mark does not of itself establish that a person has service Mark rights until an application matures into a registration, the evidence on record supports the Complainant's assertion of rights in the Mark, and that the Mark was used in Canada and worldwide well before the date that the application for the Mark with CIPO matured to registration and well before the registration of the Disputed Domain Name, on August 4, 2004.

In support of this view, the Panel refers to *Spencer Douglass MGA v. Absolute Bonding Corporation* WIPO Case No D2001-0904 where the Panel stated at page 5 "where the evidence of record supports the Complainant's assertion of common law service mark rights, the Panel can conclude that the Complainant has such rights."

The Disputed Domain Name is virtually identical to the Complainant's Mark. The presence of the "ca" suffix does not alleviate the potential confusion as the Policy at paragraph 1.2 specifically deals with this point.

In applying the confusion analysis, paragraph 1.2 of the Policy provides that a domain name is defined as follows: (see *Coca-Cola Ltd v. Amos B Henman*, CIRA Case No 00014)

"...For the purposes of this Policy, "domain name" means the domain name excluding the 'dot-ca' suffix associated with all third and fourth level domain names accepted for registration by CIRA."

As held by the Panel in *Government of Canada on behalf of Her Majesty the Queen in Right of Canada v. David Bedford*, the test to be applied when considering "confusingly similar" is one of first impression and imperfect recollection.

In simple terms, the test is, whether the average internet user with an imperfect recollection of the CRAIGSLIST mark, who wishes to access a website operated by the Complainant, either by entering a domain name including the CRAIGSLIST Mark into the address bar of an Internet browser, or by entering the key terms of the domain name into an Internet search engine, would likely be confused as a matter of first impression with the Disputed Domain Name (see *Great Pacific Industries v. Ghalib Dhala* CIRA Case No 00009, April 21, 2003, pp.20-21).

In the matter at hand, the Disputed Domain Name (excluding the dot-ca suffix) is identical to the CRAIGSLIST Mark and trade name of the Complainant.

Based on the foregoing, the Panel finds that the Complainant has proven on a balance of probabilities that the Disputed Domain Name is confusingly similar to the CRAIGSLIST Mark, in which the Complainant had Rights prior to the date of registration of the Disputed Domain Name and continues to have such Rights and that the Complainant therefore satisfies the onus placed on it by clause (a) of Paragraph 4.1 of the Policy,

(b) Bad Faith test 4.1 (b) as set out in paragraph 3.7 requirements

To meet the requirement, to establish Bad Faith on the part of the Registrant, the Complainant must meet one of the three possible tests set out in Paragraph 3.7 of the Policy.

To prove that the Disputed Domain Name had been registered in bad faith, the Complainant submitted it met the tests provided in subparagraphs (b) and (c) of paragraph 3.7 of the Policy.

Policy Paragraph 3.7 (b) provides:

- (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

The record indicates that the Disputed Domain Name resolves to a customized internet portal hosted by DomainSponsor.com. DomainSponsor.com operates a revenue program whereby domain name holders who redirect internet users to its website are eligible for a referral fee. The Disputed Domain Name website displays "craigslist.ca" at the top of the page and includes numerous sponsored links. The links on the Disputed Domain Name website also trigger various pop-up ads, which have further potential revenue for the Registrant.

The CIRA records indicate, the Registrant has registered almost 300 other dot-ca domain names, the majority of which dot-ca domain names are or include famous trade-marks or misspelling of famous trade-marks (including AIRMILES, BEST BUY, FUTURE.SHOP, GOOGLE, SNOPE, SHAW, SCOTIA BANK, ROYAL BANK, MONSTER, CANWEST GLOBAL, BELL).

The term "pattern" is not defined in the Policy. Cases decided under the Policy do not suggest any steadfast rule as to what constitutes a "pattern". Rather, examination is had to the surrounding circumstances to determine if a particular domain name registration is part of a pattern of bad faith registration. (see *Canadian Broadcasting Corporation/Societe Radio – Canada v. William Quon*, CIRA Case No 00006, pp. 13-24; *Great Pacific Industries Inc. v. Ghalib Dhalla*, CIRA Case No 00009, pp.20-21)

It has been determined that evidence showing that a Registrant owns multiple domain names which correspond to third party trade-marks constituted prima facie evidence of bad faith registration (See *Viacom International Inc v. Harvey Ross Enterprises, Ltd.* CIRA Case No 00015)

In *Choice Hotels International, Inc and Choice Hotels Canada Inc. v. Daniel Cox*, CIRA Case No 00061, of recent date, September 18, 2006, the same Registrant (Daniel Cox) was found to have registered a domain name in bad faith, and to have engaged in a pattern of such bad faith registration:

We are also of the opinion that the second part of paragraph 3.7 (b) has been satisfied by the evidence of the registration by the Registrant of at least 11 dot-ca domain names composed of, or containing, third party marks, or intentional misspellings of same. Of the 111 domain names, the Complainants have provided evidence that 102 of the domain names are comprised of, or contain, marks that are the subject of Canadian trade-mark registrations, or which are intentional misspellings of those marks.

Such an extensive portfolio of registrations incorporating the marks of third parties satisfies the test of a “pattern” as contemplated by the Policy.

The Panel is satisfied that the Complainant has met the onus of proof required by 3.7(b) by finding that the Registrant has registered the Disputed Domain Name to prevent the Complainant from registering its Mark as a domain name and that the Registrant has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names.

Policy Paragraph 3.7(c)

The Complainant further relied on Paragraph 3.7 (c) of the Policy to demonstrate bad faith on the part of the Registrant, which paragraph provides:

- (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.

It has been established clearly by the Complainant that the Registrant and itself are direct competitors; the Panel does not need to adapt its analysis to a broader definition of competitor, since the commonly used definition is sufficient in the present case and the evidence presented to the Panel supports this thesis sufficiently.(see *TransUnion LLC v. 1491070 Ontario Inc.*, Resolution Canada Case No.00008).

To demonstrate a finding of bad faith as per paragraph 3.7(c) of the Policy, the Complainant cites *Choice Hotels v. Daniel Cox* supra, a virtually identical Complaint involving the same Registrant, where the Panel found at pp. 87-89:

In our opinion, the Complainants have established bad faith under this paragraph. The fact that the Registrant’s website hosted under the disputed domain “choice hotels.ca” displays links to hotel related services or categories...has the effect of disrupting or potentially disrupt the Complainant’s business, and in our opinion, meet the requirements set out in Section 3.7(c) of the CIRA Policy, thereby demonstrating the Registrant’s bad faith. It is clear to us from the manner in which the Registrant uses the domain name that he is a competitor of the Complainants. He earns fees by directing internet users to the websites of direct competitors of the Complainants.

Panels have also held that bad faith exists in cases where the use of a domain name is likely to cause confusion among Internet users as to affiliation or sponsorship and includes trade-mark infringement and passing off. This principle was confirmed in *Glaxo Group Limited v. Defining Presence Marketing Group Inc* , CIRA Case No 00020:

“The phrase ‘disrupting the business of the Complainant’ as per the Policy has been held to be satisfied where the use of the domain name creates a likelihood of confusion among end users as to affiliation or sponsorship, and includes trade-mark infringement and passing of.”

In the same way, the Panel held in its findings of bad faith in *Sotheby’s (Canada) Inc. v. PII Technologies Inc. and Keith Lihou*, CIRA Case No 00026 held as follows:

“The Registrant is using the domain name in association with services that are similar if not identical to the services offered by the Complainant. Internet users who come upon the Registrant’s website may reasonably believe that it is the Complainant’s website or is endorsed, sponsored or approved by the Complainant.”

The Registrant is clearly competing with the Complainant for the internet traffic that is intended to reach the Complainant’s website, the very traffic that is intended for CRAIGSLIST. As referenced by the Complainant, this form of competition has been clearly recognized in previous decisions as making a Registrant a “competitor” of the Complainant within the meaning of paragraph 3.7(c) of the Policy.

Based on the evidence, we are satisfied that the Complainant has, on a balance of probabilities, established what is required of it by paragraph 3.7(c) of the Policy.

We find that the Complainant has satisfied the onus placed on it by paragraph 4.1(b) of the Policy and demonstrated that the Registrant has registered the Disputed Domain Name in bad faith as described in paragraphs 3.7 (b) and (c) of the Policy.

(c) Legitimate Interest Test 4.1 (c)

Policy Paragraph 3.6 provides:

3.6 Legitimate Interest. 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 operations 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 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.

Based on the materials presented, the Complainant has provided sufficient evidence to conclude that the tests set out in paragraph 3.6 have not been met by the Registrant:

- (a) The Registrant had no rights in the Mark of the Complainant;
- (b) The Disputed Domain Name is not directly descriptive of any wares or services. It is based on the Mark controlled by the Complainant;
- (c) The Disputed Domain Name is not generic in any language;
- (d) The Disputed Domain Name is not being used for any good faith purpose by the Registrant;
- (e) The Disputed Domain Name does not comprise the legal name of the Registrant nor is it the name, surname or reference by which the registrant is identified; and
- (f) The Disputed Domain Name is not a geographical place name.

As stated earlier, the Registrant did not provide any Response and no Legitimate Interest has been established by the Registrant.

7. Conclusion

For the reasons set forth herein, the Panel finds that:

- the Complainant has met the onus placed on it by paragraph 4.1(a), (b) and (c) of the Policy; and
- on a balance of probabilities that the Registrant has no legitimate interest in the Disputed Domain Name.

and accordingly rules in favor of the Complainant.

8. ORDER

In accordance with our findings as set out above, we direct that the registration of the Disputed Domain Name “craigslist.ca” be transferred to the Complainant.

Dated January 23rd, 2007.

Elizabeth Cuddihy, Q.C., I.C.A. (Chair), Anton M.S. Melnyk, Q.C. and R. John Rogers

(sgd) Elizabeth Cuddihy

Elizabeth Cuddihy, Q.C., I.C.A.

Chair