

**IN THE MATTER OF A COMPLAINT PURSUANT TO THE
CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

Domain Name: westinghouse.ca
Complainant: Westinghouse Electric Corporation
Registrant: Daniel Mullen
Registrar: Bare Metal.com Inc.
Panelists: Peter Cooke, Elizabeth Cuddihy, Anton M.S. Melnyk (Chair)
Service Provider: British Columbia International Commercial Arbitration Centre
BCICAC File No.: DCA-991-CIRA

DECISION

The Parties

The Complainant is Westinghouse Electric Corporation, 51 West 52 Street, New York, New York, U.S.A. 110019 - 6119.

The Complainant is represented by Mr. Eric Macramalla of Gowling Lafleur LLP, 160 Elgin Street, Suite 2600, Ottawa, Ontario, Canada K1P 1C3.

The Registrant is Daniel Mullen, 13647 St. Peters Road, Box 1900, Charlottetown, P.E.I., Canada C1A 7N5.

The Domain Name and Registrar

The Domain Name at issue is westinghouse.ca.

The Registrar is Bare Metal .com Inc.

Procedural History

This is a proceeding under the Canadian Internet Registration Authority (CIRA) Domain Name Dispute Resolution Policy (Version 1.1 Effective December 4, 2003) ("the Policy") and the CIRA Domain Name Dispute Resolution Rules (Version 1.2 Effective Date December 4, 2003) ("the Rules"). Both the Policy and Rules

were posted on the CIRA website on November 4, 2003. The British Columbia International Commercial Arbitration Centre ("the Centre") is an approved Service Provider for CIRA.

On April 30, 2007 the above-named Complainant filed a Complaint pursuant to the Policy and the Rules.

By way of letter dated May 1, 2007 the Centre confirmed compliance of the Complaint and commencement of the dispute resolution process.

The Centre's commencement letter together with the Complaint was sent to the Registrant by e-mail on May 1, 2007. The Centre did not receive a message that the above e-mail had been rejected. The Registrant was notified of the 20-day time period within which the Response is to be filed under Rule 5. In accordance with Paragraph 1.3(c) the deadline to file the response was May 22, 2007.

The Centre received a letter from the Registrant requesting a 20-day extension to file the Response on May 23, 2007.

Pursuant to Rule 5.4 of the Rules, "at the written request of the Registrant and made before the Response is due to be submitted the Provider may, in exceptional cases, extend the period of time for filing of the Response".

The Centre took the position that the Registrant failed to provide any exceptional circumstances in order to receive the time extension for filing the response. At that time the Registrant was told he could apply to the arbitration panel for an opportunity to respond.

As permitted, given the absence of a Response, the Complainant elected under Rule 6.5 to convert from a panel of three to a single arbitrator, the Centre then appointed Anton M.S. Melnyk, Q.C., C.Arb. as sole arbitrator.

On June 4, 2007 the Registrant's representative requested a stay of proceedings to give him an opportunity to review the material. On June 6, 2007 the Registrant's representative sent an e-mail to the arbitrator with his arguments for an extension.

The arbitrator responded by calling a telephone conference of the parties and the Centre on June 7, 2007. The parties submitted written documents to the arbitrator before the hearing. After the hearing, in the "interests of justice", the arbitrator granted the Registrant an extension of time to file his Response.

The Registrant submitted his Response on July 19, 2007. After checking the Response it was found non-compliant and the Registrant, as per the rules, was given 10 days to file a complainant response. A complainant response was received

by the Centre on August 6, 2007.

The Centre appointed Elizabeth Cuddihy, John Lee and Anton M.S. Melnyk to the Panel in this proceeding with Anton M.S. Melnyk as Chair, and by letter dated August 27, 2007 forwarded to each of the Panelists the materials that were submitted to the Centre by the parties.

Subsequent to August 27, 2007 the Centre realized that the Registrant's exhibits had not been forwarded and made arrangements with the Registrant to deliver the exhibits directly to the Panelists, which did take place but which necessitated ultimately an extension of the time lines for this Proceeding.

Subsequent to August 28, 2007 John Lee withdrew as a Panelist.

On September 7, 2007 the Centre advised that Mr. Peter Cooke would be the third Panelist.

The Panel believes it now has the complete Complaint and its exhibits and the Response and its exhibits.

On October 19, 2007 the Panel ordered that the time for rendering the Decision be extended to November 1, 2007.

Panel's Jurisdiction

In the Response the Registrant put in issue the fact that the counsel for the Complainant is himself on the Centre's list of approved Panelists and that the Centre was rather quick under the Rules in denying the Registrant the right to adequately respond to the Complaint. An inference was also raised in the Registrant's Response that the aforesaid conduct of the Centre may be to encourage complainant parties to use it as CIRA's Service Provider in these types of disputes. No preliminary objections however were raised to this Panel's composition or its jurisdiction to hear this matter.

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.

In the circumstances, irrespective of the merits of the Registrant's allegations in respect of the Centre, we view ourselves as independent and impartial from the Centre and the parties, and having received the Complaint and the Response which dealt with the merits of the proceeding, we hold that we have jurisdiction to hear this matter but solely in accordance with the Policy.

Eligible Complaint

Pursuant to Paragraph 1.4 of the Policy and Paragraph 2(q) of the CIRA Policies, Procedures and Guidelines, Canadian Presence Requirements for Registrants, the disputed Domain Name, westinghouse.ca, which was registered on May 9, 2004 includes the exact word component of the Complainant's Canadian registered trade mark, WESTINGHOUSE, registration No. TMA 486,143 registered on November 24, 1997 and WESTINGHOUSE registration No. TMDA 31,119 registered on May 12, 1922 (collectively "the Mark"). Accordingly, the Complainant satisfies the Canadian Presence Requirements for Registrants as prescribed by the Policy.

Relief Requested

The Complainant requests that the Panel order the transfer of the Domain Name from the Registrant to the Complainant.

Analysis and Findings

It is necessary to consider the parties evidence and submissions in the context of the Policy. Paragraph 4.1 of the Policy 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 (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."

We propose to consider the evidence of the parties as it relates to each of the sub-paragraphs of 4.1.

4.1(a) - Confusingly Similar

"Domain Name" for purposes of the Policy excludes the "dot.ca" suffix (paragraph 1.2).

Paragraph 3.4 defines "confusingly similar" for purposes of the Policy as:

"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."

The Domain Name for purposes of the Policy is identical to the Mark.

We find that the Domain Name is confusingly similar to the Mark.

We further find that, pursuant to Paragraphs 3.2(c) and 3.3(b) of the Policy, the Complainant had rights prior to the registration of the Domain Name which took place on May 9, 2004 and the evidence is that it continues to have such rights. The evidence of the Registrant that the Complainant's share ownership may have changed does not alter the result.

The Registrant argued that confusion already existed as to the "westinghouse" name as there were other trade marks and companies bearing this name. That is not the issue before us as we are limited solely to applying the definition of "Confusingly Similar" as provided by Paragraph 3.4 of the Policy.

4.1(b) - Bad Faith

The analysis of this sub-paragraph requires consideration of Paragraph 3.7 of the Policy which provides:

"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"

We propose to consider each sub-paragraph of 3.7 in turn.

3.7(a)

The Complainant did not rely on this sub-paragraph.

3.7(b)

To satisfy this sub-paragraph the Complainant must prove, firstly, that the purpose of the registration of the Domain Name was to prevent the Complainant from registering the Mark as a Domain Name and, secondly, 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.

The evidence presented by the Complainant and Registrant shows that the Registrant, in addition to registering the Domain Name in dispute, also registered, as per Registrant's Exhibit 4 of his Response, the domain name florinal.ca, which is shown in Tab 37A of the Complaint, to be a Mark registered as UCA 43301 by Novartis Pharma Canada Ltd.

The Registrant also acknowledged in Exhibit 4 of his Response to have registered ispe.ca , which is shown in Tab 37B of the Complaint to be a Mark registered as TMA 677938 by the International Society of Pharmaceutical Engineering Inc.

The Registrant, in his Response, in referring to his Exhibit 4, in effect acknowledges that some (though not "most") domain names registered by him incorporate third party marks by stating:

"Registrant has, according to CIRA records, a total of only one RANT account for Daniel Mullen, which holds a total of just 39 domain names; far fewer than the alleged "over 140 domain names" and most not containing third party marks of any kind."

Based on the evidence, we hold that sub-paragraph 3(b) has been satisfied by the Complainant.

The Complainant referred to other entities which it claimed were in concert with the Registrant in registering domain names. This was disputed by the Registrant. In view of our holding above, it is not necessary to further consider the

evidence in this regard although it appears to support the Complainant.

3.7(c)

The Complainant also relied on this sub-paragraph to show "bad faith". To succeed the Complainant has to show, firstly, that the registration of the Domain Name was "primarily for the purpose of disrupting the business of the Complainant" and, secondly, that the Complainant is a "competitor" of the Registrant.

The issue in interpreting this sub-paragraph is whether the mere registration of a domain name which totally incorporates a mark is sufficient without further evidence to meet both of the requirements of this sub-paragraph or whether more evidence is required of "disruption" and actual "competition".

Cases are divided on this issue. See for example Amazon.com Inc. V. David Abraham CIRA #00018, as submitted by the Complainant in Paragraph 71 of its Complaint:

"71. The Panel in *Amazon.com Inc. V. David Abraham* BCICAC Case No. 00018, attached as **Exhibit 62**, held that it is not necessary that a registrant compete with a complainant by attempting to sell goods or services that are similar to those offered by the complainant; the fact that a registrant "competes" with the complainant "for Internet traffic" by capitalizing on consumer confusion, makes the registrant a competitor, and causes a disruption to the business of the complainant."

Microsoft Corporation v. Microscience Corporation CIRA #00034, submitted by the Registrant, is for the proposition that evidence of economic competition is required. Thus it is stated at page 6:

"... To succeed in showing the Registrant's bad faith under this heading, the Complainant must prove two things: 1) that the Registrant and the Complainant are "competitors", and 2) that the Registrant registered the domain name primarily for the purpose of disrupting the business of such Complainant-competitor.

The panel finds that the meaning of "competitor" is, in substance, that from business or economic theory. For the Registrant and the Complainant to be competitors they would each have to offer in a marketplace, a good or a service, that could be at least imperfect substitutes for each other - such that in the right conditions of relative prices, etc., some consumers would consider buying the Registrant's good or service instead of the Complainant's good or service.³

Since the Registrant and Complainant cannot be found to be competitors, it becomes unnecessary to consider whether the Registrant registered the domain name primarily for the purpose of disrupting the business of the Complainant. Thus, the Panel cannot find bad faith under this heading..."

Notwithstanding the submissions of the Parties on this issue, as we have found "Bad Faith" under 3.7(b) we do not need to decide the interpretation issue in Paragraph 3.7(c).

4.1(c)

This is an interesting sub-paragraph. It requires that the Complainant provide some evidence that the Registrant has no legitimate interest in the Domain Name as described in Paragraph 3.6. Even if the Complainant proves the requirements of 4.1 (a) and (b) and provides some evidence that the Registrant has no legitimate interest, the Registrant will succeed in the Proceeding if the Registrant proves on a balance of probabilities that he does have a "legitimate interest" in the Domain Name.

As the Policy requires that the Complaint and Response be provided to the Panel without an intervening submission point, the practical effect is that the Panel is presented with evidence on this issue by both parties before it comes to its conclusion.

Thus, we need to consider Paragraph 3.6 along with Paragraph 4.1(c).

Paragraph 3.6 provides

"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;

- (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."

We propose to consider each sub-paragraph of 3.6 in turn.

3.6(a)

There was no evidence that the Domain Name was a Mark in which the Registrant had rights. This sub-paragraph cannot be relied on by the Registrant.

3.6(b)

From the Domain Name and evidence, it is clear that the Domain Name, in relation to the Registrant, is not descriptive in Canada 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

This sub-paragraph cannot be relied on by the Registrant. The simple assertion in this regard by the Registrant in his Response is insufficient.

3.6(c)

The Domain Name is not a generic name of the wares, services or business of the Registrant in Canada. This sub-paragraph cannot be relied on by the Registrant. A simple assertion in this regard by the Registrant in his Response is insufficient.

3.6(d)

This sub-paragraph might apply to the Registrant if he can show that the Domain Name was used in association with a non-commercial activity of his (not that of his customers).

In the Response, the Registrant stated:

"No Parking
Registrant is not a "competitor" of the Complainant, as it has not offered any means by which end users may access links to businesses that compete with the Complainant.

E-Mail and Vanity Sites

Registrant has set up and managed a number of vanity sites, including westinghouse.ca, for clients for over a decade.

Users are required to ensure compliance with CIRA Policy and Rules with proper photo identification and are not permitted to use the subscriber site for commercial activity unless by agreement. EX-17

Along with acquiring common place names and surnames in Canada, such as listed on the sales site, Registrant has acted as on behalf of or with a number of organizations to acquire domain name registrations, and has arranged for the surrender and management domain names, some of which have been listed by Complainant as being offending to third parties. EX-18, EX-19

For instance, the domain Jimmy The Greek.ca is one such domain registration where there exists an old Administrative Contact but the domain itself resolves to the web site of Jimmy The Greek as agreed with the representatives of Jimmy the Greek. EX-20

Registrant used the westinghouse.ca 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;

The Westinghouse surname is not a coined word and as demonstrated already, has been registered as a trade mark by multiple unrelated parties at CIPO while continuing to be used by real people as their family name. These people are the customers targeted by Registrant with respect to use of the westinghouse.ca domain and has been so since 2004.

Registrant used the Domain Name in Canada in good faith in association with services or business and the domain name was understood in Canada to be the generic name thereof in any language for its end users. The number of users, while small, still constitutes a viable activity and there are people throughout Canada who may be interested to also take up the services. EX-21, EX-22"

From the Registrant's submission, it is not clear that he is carrying on a non-commercial activity.

We find that the Registrant has not proven that he satisfies sub-paragraph 3.6(d).

3.6(e)

The Registrant's last name or identifier is not included in the Domain Name. The Registrant cannot rely on this sub-paragraph.

3.6(f)

There is no geographic name in the Domain Name. Clearly the Registrant cannot rely on this sub-paragraph.

Conclusion Regarding 3.6

The Registrant has not shown on a balance of probabilities that he has a legitimate interest in the Domain Name.

Conclusion

Based on the evidence, we find that the Complainant satisfied the requirements of Paragraph 4.1 of the Policy and the Registrant has no legitimate interest in the Domain Name and we rule in favour of the Complainant.

Order

We direct that the registration of the Domain Name "westinghouse.ca" be transferred to the Complainant.

Elizabeth Cuddihy and Peter Cooke concur.



Anton M.S. Melnyk, Q.C., Chair

Dated: November 1, 2007.