

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

Dispute Number: DCA 1013-CIRA
Domain Name: www.newscorp.ca
Complainant: News Holdings Limited.
Registrant: Lorenzo Salvalaggio
Registrar: Budget Names Inc.
Panellists: Barry C. Effler, C. Arb., Chair,
David R. Haigh, Q.C. and Claude Freeman, C. Med., panellists.
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

THE PARTIES

1. The Complainant is News Holdings Limited of Sydney, New South Wales, Australia.
2. The Registrant is Lorenzo Salvalaggio of Brampton, Ontario.

THE DOMAIN NAME AND REGISTRAR

3. The Domain Name in issue in this proceeding is: “newscorp.ca”.
4. The Registrar is Budget names Inc.
5. The Domain Name was registered by the Registrant on July 19, 2006.

PROCEDURAL HISTORY

6. The British Columbia International Commercial Arbitration Centre (“**BCICAC**”) is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (“**Policy**”) of the Canadian Internet Registration Authority (“**CIRA**”).
7. The Complainant filed a complaint with respect to the domain name in issue in accordance with the Policy on August 17, 2007 (the “**Complaint**”).
8. The Registrant responded to the Complaint on September 13, 2007.

9. The Complainant filed a Reply to the Registrant's Response on October 2, 2007, which the Panel permitted to be filed.

10. The Registrant filed a Further Response to the Complainant's Reply on October 4, 2007, which the Panel permitted to be filed.

11. The BCICAC named Barry Effler as Chair, and David R. Haigh and Claude Freeman as Panellists (the "**Panel**"). Some delay was occasioned by the withdrawal of one panellist who was originally appointed and withdrew on October 4, 2007 as a result of determining he was in a potential conflict of interest. Mr. Freeman was subsequently appointed as a panellist on October 9, 2007.

12. The Panel has reviewed all of the material submitted by the Complainant and the Registrant and is satisfied that the Complainant is an eligible complainant under the Policy and Rules.

BACKGROUND

13. The Complainant is News Holdings Limited, which was formerly known as The News Corporation. The Complainant is a large international company with broad holdings in the media industry and carries on business in Canada, the United States, Australia, continental Europe, the United Kingdom, Latin America, Asia, and the Pacific basin. Some of its holdings are Twentieth Century Fox Film Corporation, Fox Broadcasting Company, DirecTV, British Sky Broadcasting, the *New York Post*, and HarperCollins Publishers.

14. The Complainant has two Canadian trade-marks:

- (a) TMA502176 for the words "News Corp" in conjunction with a globe design registered October 13, 1998.
- (b) TMA503832 for the words "A News Corporation Company" registered November 9, 1998.

In both marks the right to the exclusive use of the words NEWS and CORP is disclaimed apart from the trade-mark. For the terms of the disclaimers and otherwise, the panel relies on the actual Canadian Intellectual Property Office Trade Mark Data attached as Schedule C of the Complaint in preference to the data quoted by the Registrant in the body of his Response.

15. The Complainant has had a significant on-line presence since at least 1996 and uses the website www.newscorp.com as its primary website.

16. The Complainant meets the Canadian Presence Requirements of the Canadian Internet Registry Authority because it owns the "News Corp and design" Canadian trade-mark.

17. The Registrant operates a series of news related websites. In 2001, the Registrant launched "www.news4teachers.com". This is intended to be part of a network of 40 websites

aimed at K-12 teachers. A second site was launched in 2004, “www.BramptonNews.com”. The Registrant states these sites receive about 25,000 unique visitors per month and act as legitimate news sources using free lance journalists, local group content and material from local elected officials.

18. Registered and pending websites for the Registrant include kidsnews.ca, news247.ca, shoppingnews.ca and justnews.ca. The Registrant lists over 40 launched sites for teachers and as many as 70 more in development.

19. The Registrant has parked the domain name “newscorp.ca” and states he intends to use the domain as the administrative site for the full network of news sites that he is currently developing.

20. The Registrant has parked the domain name and it resolved to the domain www.CanuckDomains.ca until at least April 2, 2007. On that site is a listing of dozens of domain names that are parked and resolve to that domain. The Complainant first contacted the Registrant by email and letter dated October 25, 2006 advising of the Complainant’s trade-marks and requesting that the Registrant transfer the disputed domain name to the Complainant.

21. Until at least October 26, 2006, the wording at CanuckDomains.ca offered “Domain Name Consulting Services” and “Negotiation and Purchase of Existing .ca”. On April 2, 2007 the site deleted reference to both those services. The Registrant states the listing of domain names was hidden from the casual visitor by the words being in white text. Further, the Registrant claims that in December, 2006 the reference to the services stated earlier in this paragraph were deleted when the site was “fully launched”. The site list is visible by running the cursor over the location of the text.

POSITION OF THE COMPLAINANT

22. The Complainant submitted that:

(a) The Domain Name newscorp.ca is Confusingly Similar to the Marks in which 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 of the Policy; and

(c) The Registrant has registered the Domain Name in bad faith as described in paragraph 3.7 of the Policy.

23. The Complainant’s submissions will be dealt with in the Analysis portion of this decision.

Relief Sought

24. The Complainant requested that newscorp.ca be transferred from the Registrant to the Complainant.

POSITION OF THE REGISTRANT

Direct competition between the Registrant and the Complainant

25. The Registrant says that it is not a competitor of the Complainant stating the question: “how can a small web developer be a competitor to a \$65 Billion multinational Fortune 500 company?”

The Complainant’s rights in the Mark

26. The Registrant argues that because the Complainant disclaimed any exclusive rights to the words “News” and “Corp” in the design Trade-Mark, that the Complainant is going beyond the intended protections of the Trade-Mark. The Registrant pointed out that there are other Canadian Businesses which include the words “News” and “Corp”, an example of which is Canada KCR News Corp.

27. The Registrant says that the Complainant has failed to show

Bad faith on the part of the Registrant

28. The Registrant says that there is no evidence of bad faith on its part.

29. The Registrant says that the fact that there has been no development of the newscorp.ca site does not indicate bad faith. The Registrant says it has not profited from the domain and has made no predatory use of it.

30. The Registrant says there is no evidence that it registered the domain name “primarily for the purposes of disrupting the Complainant and its business,” nor that it registered the domain name “primarily for the purpose of selling the domain name to the Complainant or to any competitor of the Complainant” for valuable consideration.

31. The Registrant says: “The site referenced most often by the complainant as a site selling domains, namely Canuckdomains.ca is not and never has been a domain brokerage; the domains listed on the site are parked as described above, during the time prior to development of a project. The screenshots taken by the Complainant and forwarded as part of their documentation do not contain any reference to selling of domains. In fact, the October 2006 Screenshot provided by the Complainant was taken only a few week after the site was initially soft-launched, and the images were of a site that had not been officially completed or launched. Upon launch in December of 2006, all references to buying and brokering were removed, as these were not part of the intended use of the site, and the text was placed as a “holder”, much as Latin text is often used during a late stage of site development. Canuckdomains.ca has only served one purpose, and that is to provide a non commercial home for domains that are

temporarily awaiting development. Any reference by the complainant to it's (sic) use as a site for selling domains is false and misleading. To add to the deception by the complainant, the screenshot they provided makes it appear as though the domains are actually visible in blue on the site. The domains were in fact camouflaged in white text so that none of the parked names could be seen to the visible eye. This same practice has continued to this day."

The Registrant's interest in the domain name

32. The Registrant says that it has a legitimate interest in the domain name, specifically the development of a commercial website in due course which will use the domain newscorp.ca as part of the Registrant's business of a network of "news" related sites catering to small niche markets. The newscorp.ca domain would be used as the administrative homepage for a series of news related sites.

33. The Registrant says: "The domain name "newscorp.ca" is currently in a development stage, and will act as an administrative site for the full network of news sites we are currently developing. The Registrant has never demonstrated any illegitimate use of the domain. The fact that we have demonstrated a history of registering and launching legitimate sites in our news network is strong evidence of our future intentions."

ANALYSIS AND FINDINGS

The Complaint

34. Paragraph 4.1 of the *CIRA Domain Name Dispute Resolution Policy* sets out that, to succeed, the Complainant must establish 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.

35. In other words, once the Complainant has met its evidentiary burden under subparagraphs 4.1 (a) and (b), either by positive or negative evidence, the onus is shifted to the

Registrant who must then prove, on a balance of probabilities, that he is making legitimate use of the domain name.

36. It is the view of the Panel that, for the reasons that follow, the Complainant has met its burden under paragraph 4.1. The Complainant has established that it has a Mark according to the definition in paragraph 3.2(c). It has established that the domain name registered by the Registrant is confusingly similar to that mark. The Complainant has established that the Registrant registered the domain name in bad faith according to paragraph 3.7. The Complainant has also provided some evidence that the Registrant has no legitimate interest in the subject domain name.

Paragraph 4.1(a)

37. To succeed in meeting its onus under paragraph 4.1(a), the Complainant has to show that it has rights, in a Mark, and that the disputed domain name is confusingly similar to that Mark.

Rights of the Complainant in the NEWS CORP trade-marks

38. The Complainant is the owner of the NEWS CORP trade-marks since at least October 13, 1998, and that therefore the Complainant has rights in the NEWS CORP trade-marks in accordance with paragraph 3.3(c) of the Policy.

39. The domain name newscorp.ca was registered on July 19, 2006, so the Complainant's rights in the NEWS CORP trade-marks predate the registration of newscorp.ca.

40. As per paragraph 3.2(c) of the Policy, a "Mark" includes:

(c) a trade-mark, including the word elements of a design mark, that is registered in CIPO...

The Panel finds that the NEWSCORP name is such a Mark.

41. The Panel finds that the Complainant has established the requisite rights in the Mark.

42. Paragraph 3.4 of the Policy provides a definition of the term 'Confusingly Similar'. The Policy requires a finding that the Mark at issue is likely to be mistaken for the domain name at issue because of the resemblance in "appearance, sound or the ideas suggested by the Mark". As such, the test is not one of confusion, as is normally found in Canadian trade-mark jurisprudence, but of resemblance.

43. It is the Panel's view that a person knowing the Complainant's mark, NEWSCORP, would certainly mistake the domain name for the Complainant's corresponding mark. Here, there is no difference between the newscorp.ca domain name and the NEWSCORP mark. The second-level part of the domain name, 'NEWSCORP' is phonetically identical to the

Complainant's mark. Further, the main domain name used by the Complainant is newscorp.com, which potentially leads to further confusion.

44. An Internet user who has knowledge of the name NEWSCORP might easily mistake the domain newscorp.ca as being somehow affiliated with or owned by the Complainant. This is sufficient to conclude that the domain name is confusingly similar to the Complainant's mark, NEWSCORP: *Glaxo Group Ltd. v. Defining Presence Marketing*, CIRA Dispute Number 00020; *Great Pacific Industries. v. Ghalib Dhalla* CIRA Dispute Number 00009 ("*Great Pacific*"); *Government of Canada v. David Bedford, c.o.b. Abundance Computer Consulting*, BCICAC Case No. 00011; *CBC/SRC*, supra.

Paragraph 4.1(b) – Registration in Bad Faith

45. The Complainant asserts that the Registrant registered the domain name newscorp.ca in bad faith, according to all three subsections of Paragraph 3.7.

46. Paragraph 3.7 says:

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.

47. The Complainant must prove bad faith under at least one sub-paragraphs of paragraph 3.7 on a balance of probabilities. The Panel finds that there is insufficient evidence to make a finding under sub-paragraphs (a) and (b). The Panel has found bad faith under paragraph 3.7(c), for the reasons set out below.

48. The Panel agrees with the Complainant that the Registrant and the Complainant are in direct competition, as they both are involved in the distribution of news information. It does not matter that one is a much larger business than the other.

49. Given the finding that the use of newscorp.ca by the Registrant would be likely to cause confusion among Internet users, and that the Complainant and Registrant are competitors, the Panel finds that, on the balance of probabilities, the Complainant has shown that the Registrant registered newscorp.ca in bad faith. The Panel finds that it is a reasonable inference to be made in this case that the Registrant acquired the domain name primarily for the purpose of disrupting the business of the Complainant. Accordingly, the Complainant has met the test in paragraph 3.7 (c).

50. The fact that the website is not currently running does not preclude this conclusion. Were the Registrant to operate newscorp.ca it would cause confusion among users and would potentially disrupt the Complainant's business.

51. The Panel finds that the Complainant has made out its case under paragraph 4.1(b), that on the balance of probabilities, the Registrant registered the domain name newscorp.ca in bad faith.

Paragraph 4.1(c) – Legitimate Interest in the Domain Name

52. The Complainant asserts that the Registrant has no legitimate interest in the domain name newscorp.ca. This assertion rests on the assumption that the Registrant knew of the NEWS CORP trade-mark and newscorp.com and set out to capitalize upon its similarity to newscorp.ca.

53. The Complainant has succeeded in showing "some evidence" of this. As such, it falls to the Registrant to show that it has a legitimate interest.

54. The Policy states that a Registrant has a legitimate interest in a domain if, prior to notice of a complaint, it is able to demonstrate that it had any of the indicia of legitimate interest listed in paragraph 3.6 (a-f). The Panel finds that the Registrant did not succeed in doing so.

55. There has never been any business relationship between the Complainant and the Registrant, and the Registrant has never been licensed or authorized to use the NEWS CORP marks for any purpose [paragraph 3.6(a, b)]. The NEWS CORP name has not been used for the purpose of distinguishing the business or products of the Registrant [paragraph 3.6(c)].

56. The NEWSCORP name is not generic when the two words are used together [paragraph 3.6(c)], nor is it the geographical name of the location of the Registrant's non-commercial activity or its place of business [paragraph 3.6(f)]. The Registrant has not used the NEWS CORP name for non-commercial activity [paragraph 3.6(d)], nor is it a reference by which the Registrant is commonly identified [paragraph 3.6(e)].

57. The Registrant has not adduced any evidence that counters the assertions about its lack of legitimate interest, and fails to make any positive claim to rights in the Mark. The

Registrant does not provide a plausible explanation of how it would employ the domain name in a legitimate business fashion if it were to do so. The Panel does not find the explanation that the Registrant plans to use the domain name for an administrative site to be plausible as the name would have little connection to the other sites owned by the Registrant using “news4” as the linking feature. The only reasonable inference is that the use of the site by the Registrant, a direct competitor, would be disruptive to the Complainant’s business.

58. Applying the definition in paragraph 3.6 of the Policy, the Registrant does not have a legitimate interest in the domain name newscorp.ca.

ORDER

59. The Panel finds that the Complainant has met the requirements of paragraph 4.1 of the Policy.

60. For the above reasons, the Panel orders that the domain name “newscorp.ca” be transferred to the Complainant.

David R. Haigh, Q.C.

Barry C. Effler, C. Arb., Chair Claude Freeman, C. Med.

*Original signed by Barry
Effler for the Panel*

Per: Barry C. Effler, Chair

Date November 22, 2007