

INTHE MATTEROF A COMPLAINT PURSUANT TO THE  
CANADIAN INTERNET REGISTRATION AUTHORITY  
DOMAIN NAME DISPUTE RESOLUTIONPOLICY

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Domain Name:       **Synvisc.ca**

Complainant :       Genzyme Corporation

Registrant :         Johnny Carpela

Registrar :         DomainsAtcost Corp.

Arbitrator :         Jacques Biron

Service provider :   British Columbia International Commercial Arbitration Center  
                          to be the CIRA – approved Dispute Resolution Provider

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**DECISION**

A...The preamble

1...The Registrant was notified of the complaint and commencement of the dispute resolution process on September 21, 2007 by way of letter confirming compliance of the complaint and commencement of the dispute resolution process.

2...Attempts to deliver the Complaint to the Registrant have been unsuccessful.

3...Resulting that the Registrant has not provided a Response.

4...As permitted given the absence of a Response, the Complainant may asked to be used the Rule 6.5 to convert from a panel of three to a single Arbitrator.

5...This Complaint is based on the trade-mark SYNVISC owned by the Complainant, Genzime Corporation ( "Genzime"). Genzime uses the trade-mark SYNVISC in Canada and in numerous countries throughout the world to identify its pharmaceutical treatment for osteoarthritis of the knee.

B...The Arbitrator

6...The Arbitrator hereby declares that he has no direct or indirect relation whit any of the parties to this Arbitration. The Arbitrator declares that he has instituted an ethical wall, and he did not receive any other information related to any matter involving the parties of this Arbitration.

7...The arbitration was conducted in conformity with the CIRA Policies, Rules and Procedures – CIRA Domain Name Dispute Resolution Rules in accordance with Rule 4.4 establishing the date of commencement of the proceedings as of September 21, 2007.

8...Since March 31, 2003, the Complainant is the current owner of the registered Canadian trade-mark, SYNVISIC Design, Registration No. TMA 340,261 registered on May 13, 1988 by BIOMATRIX INC. (U.S.A.) change in title on December 18, 2000 to Genzyme Biosurgery Corporation (U.S.A.).

9...It is established that the Complainant satisfies paragraph 2(q) of CIRA's Canadian Presence Requirements (CPR).

10...As submitted by the Complainant, I agree that the jurisdiction of the Superior court of the province or territory in Canada shall be established in the City of Ottawa in the Province of Ontario because the Complainant's CPR.

#### C...The parties

11...The Complainant, **GENZIME CORPORATION** is a company, whose principal place of business is 500 Kendall St., Cambridge, Massachusetts, 02142, U.S.A.

12...The Complainant's authorized representative in this administrative proceedings is Me Cynthia D. Mason from Ogilvy Renault LLP, Barristers and Solicitors whose principal place of business is Royal Bank Plaza, South Tower, suite 3800, Toronto, Ontario, M5J 2Z4.

13...The Registrant name for the domain name is Manoj Sikka (schedule B of the Complaint) is represented by the administrative contact **JOHNNY CARPELA** who has an unknown principal place of business, using as business address: VMO P.O. Box 188, Sumas, WA 98295, U.S.A.

#### D...The Domain name and Registrar

14...The dispute domain name is **SYNVISIC.CA**. The Registrar for the domain name is **DomainsAtcost Corp.**. The dispute domain name was approved on November 08, 2001 and renewed on November 08, 2007 under Domain Number 356,730.

## E...Procedural History

15...This is a proceeding under the Canadian Internet Registration Authority (CIRA) *Domain Name Resolution Policy* ( Version 1.1) (the *Policy*) and the CIRA *Domain Name Dispute Resolution Rules* (Version 1.2) ( the *Rules*).

16...The History of the proceedings, according to information provided by the dispute resolution provider, British Columbia International Commercial Arbitration Centre (BCICAC) recognized as service provider for the CIRA Domain Dispute Resolution Policy of the Internet Registration Authority (CIRA), is as follow (Rules, paras. 3.2(h) and (i)):

- The Complainant filed a complaint against the Registrant with The British Columbia International Commercial Arbitration Centre, requesting that the current registration of the Domain name – synvisc.ca – be transferred to the Complainant. The Complaint was received by BCICAC on September 21, 2007.

- **Genzyme Corporation** (Genzyme), the Complainant is the owner of the Canadian registered trade-mark: **SYNVISC** since May 13, 1988 under the Registration number TMA 340,261.

## F...Factual background of the Complainant

17...The Complainant uses SYNVISC Registered trade-mark in Canada and in numerous countries throughout the world in association with its pharmaceutical treatment for osteoarthritis of the knee. The SYNVISC trade-mark was first used October 25, 1985 and has been continuously used since that time by the Complainant.

18...The registration is now in the name of GENZIME CORPORATION and continues to be in good standing with the Canadian Intellectual Property Office (CIPO). As such, the SYNVISC trade-mark qualifies as a mark under paragraph 3.2(c) of the Policy.

19...In addition to its Canadian trade-mark registrations, the Complainant owns SYNVISC registrations in a number of countries, including those listed below:

--- Country	Registration No.	Registration Date
...United State of America	1418125	Nov. 25, 1986
...United Kingdom	1295782	Oct. 7, 1988
...Australia	457566	Nov. 1, 1988
...Benelux	427002	Oct. 1, 1987

20...The Complainant advertises and describes its SYNVISC pharmaceutical treatment at the domain name SYNVISC.COM. Genzyme registered this domain name in November 1997 and has used SYNVISC.COM since that date. This site can be accessed by any Internet user in Canada.

G...Factual background of the Registrant and other facts

21...The Registrant registered the Domain Name SYNVISIC.CA on November 8, 2001, long time after Genzyme has began using its SYNVISIC mark, and after the effective date of Genzyme's trade-mark registration in Canada and elsewhere.

22...The Registrant used the Domain Name in 2003 and 2004 for a website displaying links to third-party pharmacy websites.

23...We can belief that the Registrant receives -- click-through -- commissions when Internet users click on the links displayed on the Registrant's website.

24...From mid-2004 until the present, the web pages displaying links to third-party pharmacy websites have been removed. The Domain Name has not hosted any websites since mid-2004.

25...On April 25, 2007, the Complainant, through its undersigned counsel, sent a letter to the postal box of the Registrant notifying him of the Complainant's trade-mark rights in the SYNVISIC trade-mark and the Domain Name.

26...The Complainant also requested in the letter that the Registrant transfer the Domain Name to the Complainant.

27...To date, the Registrant has not responded.

28...The Registrant had also registered the domain names: SYNVISK.COM, SINVISIC.COM and SINVISIC.COM which are common misspelling of the Complainant's trade-mark.

29...The Registrant had used these domain names to also host websites displaying links to a third-party pharmacy websites.

30...Ultimately, these domain names were transferred to the Complainant in a recent ICANN Uniform Dispute Resolution Policy ( UDRP ) proceeding ( *Genzyme Corporation v. Johnny Carpela*, FA959633, Nat. Arb. Forum, May 22, 2007).

31...The Registrant has additionally registered numerous domain names that incorporate trade-marks owned by third parties or incorporate common misspelling of trade-marks owned by third parties that are associated with pharmaceutical products. A list of examples of such domain names is provided below:

<b>...Domain Name</b>	<b>Trade-mark</b>
AVENTYL.COM	AVENTYL
BETATREX.COM	BETATREX
BROMETANE.COM	BROMETANE DX
CARAFATE.COM	CARAFATE
DARANIDE.COM	DARANIDE
EFFEXOR.COM	EFFEXOR
FLOXMAX.NET	FLOMAX
HITINEX.COM	HISTINEX
ILOTYCIN.COM	ILOTYCIN
LAMISAL.COM	LAMISIL
LUSTRACREAM.COM	LUSTRA
MELANEX.COM	MELANEX
MEFERGAN.COM	MEFERGAN
MYAMBUTOL.COM	AMBUTOL
NALFON.COM	NALFON
NAXIUM.COM	NEXIUM
ORTHOVISC.BIZ	ORTHOVISC
ORTHOVISC.INFO	ORTHOVISC
ORTHOVISC.ORG	ORTHOVISC
ORTHOVISC.US	ORTHOVISC
PREMARIN.CA	PREMARIN
RAPIFLUX.COM	RAPIFLUX

32...Many of the above listed domain names registered by the Registrant are also used to host websites displaying links to third-party pharmacy websites. It is belief that the Registrant receives -- click-through – commissions when internet users click on the links displayed on these websites.

33...The Registrant has been forced to transfer several domain names incorporating the trade-marks owned by third parties to the owners of trade-marks under the orders of various UDRP Panels as listed below. All of the domain names transferred hosted websites containing links to third-party pharmacy websites.

...Decision Citation

Trade-mark

<i>CVS Pharmacy, Inc. v. Johnny Carpela</i> Case No. D2004-0038, WIPO March 31, 2004	CVS PHARMACY (an online pharmacy service)
<i>AstraZeneca AB v. Johnny Carpela</i> Case No.D2005-0352, WIPO May 23, 2005	ASTROZENECA (pharmaceutical company)
<i>Procter &amp; Gamble Pharmaceuticals, Inc. v. Johnny Carpela</i> , FA625591, Nat. Arb. Forum Feb. 20, 2006.	ACTONEL (pharmaceutical product)
<i>Ivax Research, Inc. v. Johnny Carpela</i> Case No. D2007-0624, WIPO July 13, 2007	PROGLYCEM (pharmaceutical product)

34...As of the date of submitting the Complaint, the Domain Name **Synvisc.ca** was still operable and listed to the Registrant.

H...CIRA Domain Name Dispute Resolution Policy Requirements

35...Paragraph 3.1 of the *Policy* requires the complainant to establish 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 Continues to have such Rights;*

(b) *the Registrant has no legitimate interest in the domain name as describe in paragraph 3.6; and*

(c) *the Registrant has registered the domain name in bad faith as describe in paragraph 3.7.*

36...According to paragraph 4.1 of the *Policy*, the Complainant must establish element (a) and (c) above on a balance of probabilities.

37...The Complainant must also provide -- some evidence -- that the Registrant has no legitimate interest in the domain name.

## I...Analysis

### Confusing Similar to a Mark in which the Complainant had rights

38...In order to succeed with the Complaint, the Complainant must first establish that: *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 ha such rights, (Policy, sub-para.3.1)*. The *Policy* contains definitions of each of the terms -- Mark --, Rights -- and Confusingly Similar.

39...The definition of a -- Mark -- is found in subparagraph 3.2 of the *Policy*. Sub-paragraph 3.2 (c) provides:

...3.2 *Mark. A --Mark- is:*

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

40...The definition of - Rights -- is found in sub-paragraph 3.3, Sub-paragraph 3.3(b) provides that the person, predecessor in title or a licensor of that person;

41...The Arbitrator finds that the Complainant has rights in the registered trade-mark **Synvisc.ca** and finds that the Complainant has established its rights in the mark SYNVISIC, having registered the trade-mark, nearly 13 years before in Canada and having used it, 16 years before the Registrant.

42...Further, the Domain Name SYNVISIC.CA was registered 4 years after the Complainant had establish an online presence for its SYNVISIC pharmaceutical products via the SYNVISIC.COM domain name.

43...The Complainant clearly has prior Rights in accordance with paragraph 3.3 of the *Policy* and continues to have such Rights.

44...It cannot be dispute that a person, on a first impression, knowing the Complainant's corresponding mark and having an imperfect recollection of it, it would likely mistake the Domain Name, without the .ca suffix, for the Complainant's corresponding mark based upon the appearance, sound and ideas suggested by the mark, *Government o Canada v. Bedford* (CIRA Decision My 2007, 2003, p. 15).

Registrant has No Legitimate Interest in the Mark or in respect to the Domain Name

45...Under sub-paragraph 4.1(c) of the *Policy*, the Complainant must provide some evidence that – the Registrant has no legitimate interest in the domain name --. Paragraph 3.6 identifies six circumstances in which a legitimate interest may arise. These are:

- ...(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 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 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.*

46...The Complainant submitted that the Registrant has no legitimate interest in the Domain Name as defined in Paragraph 3.6 of the *Policy*. The Registrant's use of the Domain Name does not satisfy any of the criteria set out Paragraph 3.6 of the *Policy*.

47...In particular, the Registrant has not been using the Domain Name in good faith, as the Domain Name links Internet visitors who seek to visit the website of the Complainant (but who enter the Domain Name Synvisc.ca) to its own competing business and website located at *DomainsAtCost Corp.*

48...By choosing to register a domain name which corresponds to a well-established trademark had a highly visited corresponding dot com website (SYNVISC.COM), the Registrant is profiting from the visitors seeking information about the Complainant. (*Policy*, paragraph 3.6 (a)).

49...The Complainant had already submitted that the Domain Name is confusingly similar to the SYNVISC Registered Mark and the domain name SYNVISC.COM of which the Complainant is the sole and exclusive owner.



50...According to paragraph 1.2 of the *Policy*, the Domain Name is to be compared without reference to the dot-ca suffix. Thus for the purposes of the *Policy*, the Domain Name is -- identical -- to the SYNVISIC Registered Mark. It is also -- identical -- to the SYNVISIC.COM domain name.

The Registrant Registered and is using the Domain Name in bad faith

51...The exclusive bases for a finding of bad faith registration are set out in sub-paragraph 3.7 of the *Policy*. They are:

...3.7...**Registration in bad faith.** *For the purposes of a paragraph 3.1 (c), a Registrant Will 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 of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee on the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual cost in registering the domain name, or acquiring the Registration;*

(b) *the Registrant registered the domain name or acquire the Registration in order to prevent the Complaint, or the Complainant's licensor or licensee of Mark, from registering the Mark as a domain name, provide 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.*

52...The Complainant submitted that the Registrant has registered the Domain Name in bad faith, as set forth in paragraph 3.7 of the *Policy*. The evidence establishes that the Registrant registered the Domain Name primarily for the purpose of disrupting the business of the Complainant, who is a competitor of the Registrant. (*Policy*, paragraph 3.7 (c)).

53...Further, bad faith may be established by taking into consideration all surrounding circumstances and drawing common sense inferences from those circumstances (see *CBC v. Quon*, CIRA Dispute 00006, April 8, 2003; and *Coca-Cola v. Hennan*, CIRA Dispute 00014, October 23, 2003).

54...The Registrant, by registering a domain name identical to the Complainant's mark in linking the Domain Name to a business that offers goods and services of the Complainant, is disrupting his business. See (*Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)*) (CIRA Decision No. 00020).

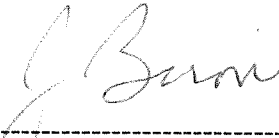
55...Finally, previous CIRA Panels have also held that where a Domain Name bears no connection to a Registrant, it is reasonable to infer that the Domain Name was acquired primarily for the purpose of disrupting the business of the Complainant. (See *Sam Ash Music Corporation v. LAMUSIC*, CIRA Dispute 00067, October 15, 2006, at 8); and (*Browne & Co. Ltd v. Bluebird industries*, CIRA Dispute 00002, October 22, 2002 at 19).

56...In any event, the Arbitrator finds that the Complainant has met the requirements to satisfy the balance of probability that the Domain Name was registered by the Registrant in bad faith under paragraph 3.7 (b) and as per paragraph 3.7 (c) of the *Policy*.

J...Conclusion

57...It is established that the Complainant had its rights in the Mark SYNVISIC which predated the registration of the disputed Domain Name. Considering that the Registrant has no legitimate interest in the Domain Name, the Complainant has been able to establish that registration of the disputed Domain Name was in bad faith within the meaning of paragraph 3.7 of the *Policy*.

58...Considering that proof of bad faith registration is an essential requirement under the *Policy*, I agree with the Complainant and order the transfer of the Domain Name **Synvisic.ca** to the Complainant.



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Jacques Biron, Arbitrator

November 9, 2007