

**CANADIAN INTERNET REGISTRATION AUTHORITY**  
**DOMAIN NAME DISPUTE RESOLUTION POLICY**

**COMPLAINT**

Dispute Number: DCA-1039-CIRA  
Domain Name: formica.ca  
Complainant: The Diller Corporation c/o Formica Corporation  
Registrant: Lorenzo Salvalaggio  
Registrar: Aloak Domains Inc.  
Panel: Stefan Martin (Chair)  
Peter Cooke  
Hugues Richard  
Service Provider: British Columbia International Commercial Arbitration Centre

**DECISION**

**PREAMBLE**

1. The Canadian Internet Registration Authority (“CIRA”) is responsible for operating the dot-ca Internet country code Top Level Domain (“ccTLD”).
2. This is an administrative proceeding pursuant to the CIRA Domain Name Dispute Resolution Policy, adopted by CIRA and in effect as of December 4, 2003 (the “Policy”) and the CIRA Domain Name Dispute Resolution Rules, version 1.1 (the “Rules”).
3. The CIRA Registration Agreement governing dot-ca domain names requires, in virtue of section 3.1 (a)(iv), that the Registrant comply with the Policy throughout the term of the registration agreement. Paragraph 3.1 of the Policy requires that the Registrant submit to this dispute resolution proceeding.
4. The British Columbia International Commercial Arbitration Centre (“BCICAC”) is a recognized service provider pursuant to the Policy.

**THE PARTIES**

5. The Complainant is the Diller Corporation c/o Formica Corporation, situated at Chemed Center, 255 East Fifth Street, Cincinnati, Ohio 45202, USA.
6. The Registrant is Lorenzo Salvalaggio, situated at 4 Tortoise Crt., Brampton, Ontario, L6P 0A1 Canada.

## **THE DOMAIN NAME AND REGISTRAR**

7. The Domain Name that is the subject of this proceeding is “formica.ca”.
8. The Registrar of the Domain Name is Aloak Domains Inc.
9. The Domain Name was registered by the Registrant on November 22, 2006.

## **PROCEDURAL HISTORY**

10. According to the information provided by BCICAC, the dispute resolution service provider, the history of this proceeding is as follows:
  - (a) On November 26, 2007, the Complainant filed a complaint regarding the Domain Name with BCICAC.
  - (b) On that same date, after having determined that the complaint was in administrative compliance with the requirements of the Policy and the Rules, the BCICAC commenced the dispute resolution process and served notice of the complaint to the Registrant.
  - (c) On December 19, 2007, the Registrant delivered its response in compliance with the Policy and the Rules.
  - (d) On that same date, after having determined that the response was in administrative compliance with the requirements of the Policy and the Rules, the BCICAC sent it to the Complainant.
  - (e) The complaint and the response were filed in English, which shall be the language of this proceeding, in accordance with Paragraph 10.1. of the Rules.
  - (f) In accordance with Paragraph 6 of the Rules, the BCICAC has appointed a three-person Panel and selected a Chair, with consideration to the nominees of the parties.
  - (g) Accordingly, the BCICAC has appointed Hugues Richard, Peter Cooke and Stefan Martin as panellists. Stefan Martin has been also been appointed Chair of the Panel.
  - (h) All three panellists have delivered to the BCICAC the required Statement of Impartiality and Independence, as required by Paragraph 7 of the Rules.
  - (i) Absent exceptional circumstances, the Panel was required to deliver its decision by January 23, 2008.

- (j) On January 3, 2008, the Complainant requested leave to file additional submissions alleging that, following the filing of the complaint, the Registrant raised certain new issues which needed to be addressed.
  - (k) On January 8, 2008, the Panel asked the Complainant to identify and to describe the nature of the new issues which were raised by the Registrant, and which were not addressed in the complaint, and to explain how they were relevant for the Panel to render its decision.
  - (l) On that same date, the Complainant specified that the Registrant had recently changed the content of the Internet site related to the Domain Name in a manner which was relevant to the motives of the complaint.
  - (m) On that same date, the Registrant objected to the filing of said additional submissions, alleging that the Complainant's allegations as to a change in the content of the Internet site related to the Domain Name were inaccurate.
  - (n) On that same date, the Panel granted the Complainant until January 11, 2008, at 17:00 ET, to file said additional submissions, and granted the Registrant until January 15, 2008, at 17:00 to file a reply to said additional submissions.
  - (o) On January 11, 2008, at 14:34, the Complainant filed said additional submissions.
  - (p) On January 11, 2008, at 16:50, the Registrant filed its reply to said additional submissions.
- 11. The Panel finds that it was properly appointed in accordance with the Policy and the Rules.
  - 12. Based upon the information provided by the BCICAC, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding were met.
  - 13. The Complainant was represented by legal counsel throughout this proceeding. The Registrant does not appear to have been represented by legal counsel.

#### **FACTUAL BACKGROUND**

- 14. The Panel proceeds on the basis of the following facts, which are established by the evidence submitted by the Complainant:
  - (a) The Complainant is The Diller Corporation c/o Formica Corporation.

- (b) The Registrant is Lorenzo Salvalaggio.
- (c) On November 22, 2006, the Registrant registered the domain name “formica.ca”.
- (d) On March 1, 2007, the Complainant, through its legal counsel, sent a demand letter to the Registrant, requiring the transfer of the registration of the Domain Name.
- (e) On that same date, the Registrant replied by e-mail that he had no intention of relinquishing the registration of the Domain Name and that he intended to launch an educational Internet site dedicated to “ants”.

15. The Complainant contends as follows:

- (a) The Complainant is the owner in Canada of the following registered trade-marks:
  - FORMICA, TMA 115,862, registered on November 6, 1959;
  - FORMICA, TMA 218,171, registered on January 7, 1977;
  - FORMICA & Design, TMA 140,332, registered on May 21, 1965;

and the Domain Name is confusingly similar to the Complainant’s trade-marks in which the Complainant had rights prior to the registration of the Domain Name and in which the Complainant continues to have such rights.

- (b) The Registrant has no legitimate interest in the Domain Name because:
  - (i) the Registrant has not used the Domain Name in good faith and has no rights in the Complainant’s said registered trade-marks;
  - (ii) the Domain Name is not clearly descriptive;
  - (iii) the Domain Name is not a generic name;
  - (iv) the Domain Name has not been used in association with a non-commercial activity;
  - (v) the Domain Name is not the name or surname of the Registrant; and
  - (vi) the Domain Name is not a geographical name.
- (c) The Registrant registered and is using the Domain Name in bad faith because:

- i) the Registrant registered the Domain Name to prevent the Complainant from registering its trade-marks as domain names, and has engaged in a pattern of doing so;
  - ii) the Registrant registered the Domain Name primarily for the purpose of disrupting the business of the Complainant.
16. The Registrant contends as follows:
- (a) The Domain Name is not confusingly similar with the Complainant's family of registered FORMICA trade-marks, since the wares and services at issue are different;
  - (b) He has a legitimate interest in the Domain Name, as it is used for educational purposes;
  - (c) The Domain Name was not registered and is not being used in bad faith because:
    - (i) the Domain Name was not registered to prevent the Complainant from registering its family of FORMICA trade-marks as domain names, and the Registrant has not engaged in a pattern of doing so;
    - (ii) the Domain Name was not registered primarily for the purpose of disrupting the business of the Complainant.

### **DISCUSSION AND FINDINGS**

#### **JURISDICTION OVER THE PARTIES**

17. The Complainant is the registered owner in Canada of the trade-marks identified at paragraph 15(a) hereof and therefore satisfies the CIRA Canadian Presence Requirement for Registrants, as stipulated in paragraph 1.4 of the Policy.

#### **APPLICABLE LAW**

18. Pursuant to Section 12.1 of the Rules, the Panel shall apply the laws of Ontario, or if the Registrant is domiciled in Quebec, the laws of Quebec, or, if a preference for the laws of another province or territory has been indicated by both parties, the laws of the other province or territory and, in any event, the laws of Canada applicable therein.
19. The Registrant is domiciled in Ontario. The Complainant has not stated a preference for any applicable law and therefore the Panel will render its decision

in accordance with the Policy, the Rules and any rules and principles of law applicable in the Province of Ontario and the laws of Canada applicable therein.

## OVERVIEW OF THE POLICY

20. Paragraph 4.1 of the Policy sets forth the Complainant's burden of proof in order to succeed in the proceeding. The onus is on the Complainant to 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.

The Complainant must also provide some evidence that:

- (c) the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.6.

## CONFUSING SIMILARITY BETWEEN DOMAIN NAME AND COMPLAINANT'S MARKS

21. The Complainant argues that the Domain Name "formica.ca" is confusingly similar with its above-mentioned family of registered FORMICA trade-marks, which the Complainant had registered prior to the date of registration of the Domain Name and in which the Complainant continues to have rights.
22. As for the Registrant, he essentially argues that there is no such confusing similarity because (i) the wares and services at issue are different, (ii) the Registrant had no intention of interfering with the Complainant's registered trade-marks, and (iii) the Domain Name is an Italian term for "ants", and many other common Latin, Italian and scientific terms coexist as registered domain names and trade-marks in the name of different entities.
23. Firstly, as it was held in *Government of Canada, on behalf of Her Majesty the Queen in Right of Canada v. David Bedford*, BCICAC Case No. 00011, where a complainant relies upon a trade-mark registered prior to the domain name registration date, the Policy does not require or permit the Panel to go behind the registration to determine whether the trade-mark is valid or invalid based upon lack of distinctiveness or non-use. This principle was confirmed in *Viacom International Inc. v. Harvey Ross Enterprises, Ltd.*, BCICAC Case No. 00015:

“For the purpose of construing “confusing similarity” between the domain name and the complainant’s mark, the Policy draws a distinction between rights in a mark registered in CIPO before the date the domain name was registered and common law rights in a mark acquired through use by the complainant. With the former, a complainant need not demonstrate distinctiveness or use to establish “rights” in a mark which is alleged to be confusingly similar to the domain name. The registration of the mark in CIPO is sufficient in and of itself to establish such “rights” within the meaning of the Policy.”

24. Secondly, paragraph 3.4 of the Policy defines the term “Confusingly Similar” as follows:

“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.”

25. Thirdly, in applying this definition, it is important to note paragraph 1.2 of the Policy which stipulates that:

“[...] For the purposes of this Policy, “**domain name**” means the domain name excluding the “dot-ca” suffix and the suffixes associated with all third and fourth level domain names accepted for registration by CIRA.”

26. Finally, the test to be applied is one of first impression and imperfect recollection (*Government of Canada v. Bedford*, May 27, 2003, p. 15) :

“Accordingly, for each Domain Name the Complainant must prove on a balance of probabilities that a person, on a first impression, knowing the Complainant’s corresponding mark only and having an imperfect recollection of it, would likely mistake the Domain Name (without the .ca suffix) for Complainant’s corresponding mark based upon the appearance, sound or the ideas suggested by the Mark.”

27. The Complainant has established that it registered its family of FORMICA trade-marks prior to the registration of the Domain Name and that it continues to have rights therein. The registrations of these trade-marks must be presumed valid for the purposes of this arbitration.

28. Moreover, the Domain Name is not merely similar to the Complainant's family of registered FORMICA trade-marks. It is actually identical to them, as the "dot-ca" suffix must not be taken into account.
29. The Registrant alleges that the Domain Name is not confusingly similar to the Complainant's registered trade-marks because the wares and services at issue are different. However, in determining whether there exists a confusing similarity, the Panel must only consider whether a person, on a first impression, knowing the Complainant's trade-marks only and having an imperfect recollection of them, would likely mistake the Domain Name for Complainant's trade-marks, based only upon their appearance, sound or ideas suggested by them. The wares and services at issue do not need to be taken into account.
30. The Registrant also alleges that there is no confusing similarity because he never intended to interfere with the Complainant's family of registered FORMICA trade-marks. He contends that the word FORMICA is an Italian term for "ants" and takes position that many other common Latin, Italian and scientific terms coexist as registered domain names and trade-marks in the name of different entities. However, an absence of intention to interfere with the Complainant's trade-marks does not imply that there is no confusing similarity. Moreover, if other trade-mark owners have knowingly or unknowingly decided not to enforce their trade-mark rights on the Internet, that does not imply that there is no confusing similarity in the case at hand.
31. In light of the above, the Panel is of the view that the Complainant has met its first burden of evidence and that there exists a confusing similarity between the Domain Name and the Complainant's family of registered FORMICA trade-marks.

#### **NO LEGITIMATE INTEREST IN THE DOMAIN NAME**

32. The Complainant submits that the Registrant has no "legitimate interest" in the Domain Name, as this term is exhaustively defined in paragraph 3.6 of the Policy.
33. As for the Registrant, he submits that he does indeed have a "legitimate interest" in the Domain Name, because it is used for educational purposes, an area in which the Registrant says he has been involved for many years.
34. Paragraph 3.6 of the Policy sets forth an exhaustive list of criteria for determining whether a registrant has a legitimate interest in a domain name. It reads as follows:

"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 Registrant includes, but is not limited to, use to identify a web site.”

35. The Domain Name is a trade-mark but it is the Complainant, not the Registrant, that owns the exclusive rights in that trade-mark. The Registrant can therefore not rely on subparagraph 3.6(a) of the Policy.
36. Despite the Registrant’s submissions regarding the Domain Name being the Italian word for “ants”, the Domain Name is not 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 Registrant can therefore not rely on subparagraph 3.6(b).

37. The Domain Name is not used in association with any wares. Moreover, should the Registrant's current "use" of the Domain Name constitute actual "use" in association with services or a business, the Domain Name would nevertheless not be understood in Canada to be the generic name of such services or business. The work FORMICA would rather at most only be suggestive as to the field of such services or business. The Registrant can not rely on subparagraph 3.6(c) of the Policy.
38. The Registrant alleges that the Internet site linked to the Domain Name is an educational site for children to learn about "ants". However, following the Panel's review of said Internet site, the Panel is of the view that it is not used in association with any non-commercial activity, such as criticism, review or news reporting. It primarily provides hyperlinks to other sites, thus essentially redirecting Internet traffic, quite possibly for a commercial gain. The Registrant can not rely on subparagraph 3.6(d) of the Policy.
39. The Domain Name is not the legal name of the Registrant, nor is it the name, surname or other reference by which the Registrant was commonly identified. The Registrant can not rely on subparagraph 3.6(e) of the Policy.
40. The Domain Name is not the geographical name of the location of the Registrant's non-commercial activity or place of business. The Registrant can not rely on subparagraph 3.6(f) of the Policy.
41. In light of the above, the Panel is of the view that the Registrant has no legitimate interest in the Domain Name and is satisfied that the Complainant has met its second burden of evidence.

#### **BAD FAITH REGISTRATION**

42. The Complainant submits that the Registrant has registered the Domain Name in "bad faith", as this term is defined in subparagraphs 3.7(b) and 3.7(c) of the Policy:

**"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:

[...]

(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.”

43. As for the Registrant, he alleges that:

- (a) the Domain Name was not acquired in order to prevent the Complainant from registering its family of trade-marks as a domain name and the Registrant has never engaged in a pattern of such behaviour;
- (b) he did not acquire the Domain Name primarily for the purpose of disrupting the business of the Complainant.

### **The Complaint and the Response**

- 44. With respect to subparagraph 3.7(b), the registration by the Registrant of the Domain Name has clearly prevented the Complainant from registering the “.ca” domain name for its family of registered FORMICA trade-marks.
- 45. As for the requirement to show that the Registrant has also, alone or in concert with others, engaged in a pattern of registering domain names in order to prevent persons who have rights in marks from registering them as domain names, the Complainant submitted a list of 206 domain names which are directly or indirectly controlled by the Registrant and which are composed of trade-marks that are registered in the name of third parties. This list is too lengthy to be reproduced in this decision.
- 46. The Registrant has attempted to justify some of these domain name registrations by alleging that they are or will be used for educational purposes, and that permission from the trade-mark owners will be sought prior to launching their corresponding Internet sites.
- 47. The Registrant’s explanation regarding its 206 registrations of domain names which are composed of trade-marks that are registered in the name of third parties

is somewhat vague and unconvincing. In this context, it is pertinent to cite *Viacom International Inc. v. Harvey Ross Enterprises, Ltd.* (BCICAC Case No. 00015), which stated the following:

“Moreover, the Registrant has failed to provide any tenable, explanation as to its numerous registrations of other domain names which are comprised of third parties marks. The clear inference to be drawn from that conduct, coupled with the registration of the Domain Name in issue, is that it was done so in bad faith with a view to preventing the Complainant from registering its trade-marks as a domain name.”

48. As it was decided once again in *Viacom International Inc. v. Harvey Ross Enterprises, Ltd.*, evidence indicating that a registrant owns multiple domain names which correspond to third party marks constitutes *prima facie* evidence of bad faith registration.
49. Moreover, as argued by the Complainant, it has been held that as few as two (2) domain name registrations is sufficient to establish that a registrant has engaged in a “pattern” of abusive registrations (*Great Pacific Industries Inc. v. Ghalib Dhalla*, BCICAC Case No. 00009, *Canadian Broadcasting Corporation/Société Radio-Canada v. William Quon, supra*; *Allergan Inc. v. Hiebert Net Inc.*, BCICAC Case No. 00058).
50. The Complainant has established on a *prima facie* basis that the Domain Name was registered abusively and the Registrant has failed to prove otherwise. If two (2) domain name registrations are sufficient to establish that a registrant has engaged in a pattern of abusive registrations then, *a fortiori*, the Registrant’s hundreds of registrations are certainly proof of same.
51. With respect to subparagraph 3.7(c), the Complainant must demonstrate 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.
52. As it has been argued by the Registrant, the parties do not appear to offer competitive products or services. One might therefore be inclined arrive to the conclusion that the parties are not competitors.
53. However, in order to determine whether the Registrant could in fact be qualified as a “competitor” of the Complainant whose actions “disrupted” the business of the Complainant, it is pertinent to consider the decision of *Amazon.com Inc. v. David Abraham* (BCICAC Case No. 00018). That decision explained that a registrant is not a competitor of a complainant only when the wares and services at issue are similar. The mere fact that a registrant “competes” with a complainant for Internet

traffic makes that registrant a competitor, and causes a disruption to the business of the complainant.

### **The additional submissions and the reply**

54. In its additional submissions, the Complainant alleged that the Internet site related to the Domain Name included links to other sites containing links and listings of businesses which offered services similar to those of the Complainant, while also maintaining the Domain Name in the web address window. Although the Complainant specified that the Registrant had ceased this activity upon being notified of the Complainant's intention to file additional submissions, the Complainant alleged that this conduct nevertheless created confusion among Internet users.
55. In its reply to said additional submissions, the Registrant denied the Complainant's allegations and reiterated that no Internet user could possibly believe that the Registrant is a competitor of the Complainant.

### **Decision regarding bad faith registration**

56. In light of the complaint and the response, the Panel is of the view that the Registrant (i) registered the Domain Name in order to prevent the Complainant from registering its family of trade-marks as domain names and has engaged in such a pattern with others, and that he (ii) registered the Domain Name primarily for the purpose of disrupting the business of the Complainant.
57. As for the additional submissions and the reply thereto, the Panel is satisfied that the Complainant has provided an additional demonstration that the Registrant registered the Domain Name primarily for the purpose of disrupting the business of the Complainant. The Domain Name clearly appears in the web address window of Internet sites which seem to provide information about entities that appear to offer services which are competitive with those of the Complainant.
58. Consequently, the Panel is of the view that the Complainant has met its third and final burden of evidence.

### **CONCLUSION AND DECISION**

59. The Complainant has proven, on a balance of probabilities, that the Domain Name is Confusingly Similar to Marks in which the Complainant had Rights prior to the date of registration of the Domain Name and in which the Complainant continues to have such Rights, as such terms are defined in the Policy.

60. The Complainant has adduced evidence that the Registrant has no legitimate interest in the Domain Name, as described in paragraph 3.6 of the Policy.
61. Finally, the Complainant has also proven, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith as described in Paragraph 3.7 of the Policy.
62. For these reasons, the complaint regarding the Domain Name is successful and the Panel orders and directs that the registration of the domain name "formica.ca" be transferred to the Complainant.

Hugues Richard, Peter Cooke and Stefan Martin



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Stefan Martin  
Chair

Dated January 23 2008