

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

**Complainant: Bank of Montreal**

**Registrant: Chris Bartello**

**Disputed Domain Name: bmofield.ca**

**Registrar: Namespro Solutions Inc.**

**Panellists: Cecil O.D. Branson (Chair), Jacques Biron, Pierre-Emmanuel Moyse**

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

**BCICAC FILE NUMBER: DCA- -CIRA**

**I - The Parties**

1. The Complainant is the Bank of Montreal, a chartered bank established in Canada since 1817, having its principal place of business at P.O. Box 1, First Canadian Place, Toronto, Ontario, M5X 1A1, Canada.
2. The Registrant is Chris Bartello.

**II – Procedural History**

3. Complainant Bank of Montreal seeks resolution by arbitration of a dispute which has arisen between the parties from the registration by the Registrant of the domain name « bmofield.ca », (the “Domain Name”). It elected to file its Complaint with the British Columbia International Commercial Arbitration Centre (BCICAC), a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (CDRP) of the Canadian Internet Registration Authority (CIRA).
4. The Complainant filed its Complaint with respect to the domain name in accordance with the CDRP on November 28, 2007.
5. The Complaint was reviewed and found to be compliant by BCICAC. By letter and email dated November 28, 2007 the BCICAC so advised the parties and forwarded a copy of the Complaint to the Registrant.
6. The Registrant has not provided a Response. As permitted given the absence of a Response, the Complainant has elected under Rule 6.5 to stay with a panel of three arbitrators.
7. The Complainant complies with Rule 1.4 of the CIRA Domain Name Dispute

Resolution Policy (hereinafter, the "CIRA Policy") which sets forth the Canadian presence requirement. The Complainant is a Canadian corporation and chartered bank pursuant to the Canadian *Bank Act*. The Complainant filed under Exhibit I of the Complaint the relevant part of the Canadian Bank Act, 1991, c. 46 which expressly refers to the Banque of Montreal. The panel recognizes the sufficiency as well as the probative value of such evidence.

### ***III – Statement of Facts***

8. It appears from the evidence filed with the Complaint that the Registrant registered the domain name "bmofield" on September 22, 2006 two days after the Complainant's public announcement of the opening in 2007 of the "BMO Field", a stadium named after the Bank's acronym and trademark which opening was anticipated for 2007. The Toronto FC soccer club posted on its website the communication reproduced under Exhibit 7 and refers more specifically to a "10-year naming rights agreement with BMO Financial Group.
9. The domain name "bmofield.ca" hosts a web page where the sign "For Sale" is prominently displayed. It also contains the following text : "This domain is for sale. If you are interested, please contact the owner [chriscario@hotmail.com](mailto:chriscario@hotmail.com) to make an offer". Exhibit 9 is a print-out of the web page.
10. On November 20, 2006, through its legal representative the Complainant sends to the Registrant a cease and desist letter seeking the transfer of the domain name "bmofield.ca" and notifying the recipient of its "numerous Canadian trade-mark registrations comprised of, or containing, the element BMO". Said cease and desist letter is filed under Exhibit 10 of the Complaint.
11. The cease and desist letter will remain unanswered. A follow-up letter was subsequently sent December 7, 2006.
12. On January 16, 2007, the Registrant sent an email to the representative of the Complainant Eric Macramalia. This correspondence seems to have followed a telephone conversation between the two protagonists. In any event, the substance of the Registrant's is accurately summarized in this excerpt : "Eric, You and I know that if I do not hand over my domain name, bmofield.ca, This will go to court, And take up lot's of time and money, if you mind or not, What my suggestion, and what I'am asking, that I can get what I have payed for to have my doman (sic). Year season tickets to the toronto's mis soccer" (Extract of email sent to Eric Macramalia on January 16, 2007, Exhibit 12)

### ***IV – The Complainant's Contention***

13. The Complainant contends that it is the owner of the following trademarks registered prior to the registration of the domain name bmofield.ca :

- BMO (TMA524145)
- BMO & M LOGO DESIGN (TMA541840)
- BMO FINANCIAL GROUP & DESIGN (TMA589212)
- BMO GROUPE FINANCIER & DESIGN (TMA589156)
- BMO BANQUE PRIVÉE HARRIS & DESIGN (TMA587259)
- BMO HARRIS PRIVATE BANKING & DESIGN (TMA5777779)
- BMO FINANCIAL GROUP VOLUNTEER CHAMPIONS (TMA629154)
- BMO LIFE PREFERRED ACCIDENT PROTECTION (TMA594064)
- BMO ASSURANCE-VIE STRATEGIA (TMA594441)
- BMO LIFE STRATEGEM (TMA595051)
- BMO LIFE DIRECTTERM (TMA594509)
- BMO BOATS (TMA563835)
- BMO INVESTORLINE 5 STARS PROGRAM (TMA669402)
- PROGRAMME 5 ÉTOILES DE BMO LIGNE D'ACTION (TMA671115)

14. The Complainant has also filed with CIPO three trademarks applications on May 11<sup>th</sup>, 2007 for the marks BMO FIELD, BMO FIELD & DESIGN (2). These application are posterior to the registration of the domain name bmofield.ca.

15. The Complainant contends that (i) the domain name bmofield.ca is confusingly similar to its trademarks in which it has a right prior to the date of registration of the domain name, (ii) the Registrant has registered the domain name in bad faith and (iii) the Registrant has no legitimate interest in the domain name bmofield.ca.

#### ***V – Discussion and Findings***

16. Absent any Response from the Registrant the Panel is entitled to decide this proceedings on the basis of the Complaint (Rule 5.8 of CIRA Domain Name Dispute Resolution Rules, hereinafter referred to as the “Rules”).

17. The evaluation of proof by the Panel shall be made accordingly to the balance of probabilities test. Rule 4.1 of CIRA Policy sets the standard of proof as well as the elements that the Complainant has to establish in order to succeed in this proceeding :

**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.

*Confusingly Similar to a Mark*

18. The Panel is of the opinion that Complainant has established its prior rights in the above mentioned BMO trademarks.
19. Paragraph 3.4 of the Policy provides a definition of “Confusingly Similar” which reads as follows :

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.

20. Although there is no evidence of registration or use by the Complainant of a trademark BMO FIELD identical to the domain name prior to its registration – and therefore no established rights in such signs prior to the domain name registration, the Panel finds that the domain name is confusingly similar with the registered BMO trademarks as it reproduces the distinctive part of such trademarks comprising of the BMO acronym.
21. As it has been reiterated in *Canada v. Bedford, British Columbia International Commercial Arbitration Centre*, CIRA Dispute No. 00011 the test to be applied is one of first impression and imperfect recollection :

“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.”

22. Consequently, the Panel concludes unanimously that the domain name bmofield.ca is Confusingly Similar to the Complainant’s trademarks within the meaning of Paragraph 3.4(b) Policy.

*Registration of the domain name in bad faith*

23. The Complainant submits that the registration of the *bmofield.ca* has been made in bad faith. Relying on subsections a), b) and c) of Rule 3.7 Policy, the Complainant contends that :
- a. the Registrant registered the domain name for the purpose of transferring the registration against for valuable consideration in excess of the Registrant's actual costs in registering the domain name;
  - b. the Registrant has engaged in a pattern of registering domain names that incorporates the marks of third parties;
  - c. the Registrant registered *bmofield.ca* for the purpose of disrupting the business of the Complainant
24. Pursuant to Rule 3.7 Policy the registration of a domain name will be found to have been made in bad faith "if, and only if" one of the factors indicated under its subsections is proved. The conditions set forth under this section of the Policy are alternative and not cumulative.
25. The Panel finds that the Complainant failed to induce evidence to substantiate its claim under 3.7c). This subsection requires that the parties are competitors, even if this condition has been left to relatively loose or generous interpretations from panels. In *Sleep Country Canada Inc. v. Pilfold Ventures Inc.*, (2005) CIRA 0027 "*sleepcountrycanada.ca*" the panel finds, for instance that "the Registrant's use of the domain name in association with a web page that linked to competitors of the Registrant, constituted the Registrant a competitor of the Complainant for the purposes of CIRA Policy para. 3.7(c)". Here, the webpage of the Registrant displayed under the domain name does not contain any pointers or links to competitors or competitors' web page offering products directly competing with the Complainant.
26. As to the subsection a) and b) of Rule 3.7 Policy, the Panel is of the opinion that the Complainant succeeded in demonstrating bad faith. The evidence shows that the Registrant was willing to transfer the domain name against Toronto FC tickets whose prices range from \$ 285 to \$ 1840 (Exhibit 20), amounts that in any event probably exceed the cost to register a the dot-ca domain at issue.
27. Some weight should also be given to the contention made by the Complainant with respect to the conduct of the Registrant constituting in cybersquatting domain names comprising well-known trademarks. Exhibit 27 of the Complainant is a list of eight (8) domain names allegedly owned by the Registrant such as "*xboxlivegold.ca*", "*xboxlivearcade.ca*", "*xbox360live.ca*", "*eglintontoyota.ca*", "*toyotascioncanada.ca*", "*scioncanada.ca*", "*exhibitionplacestadium.ca*", "*bigking.ca*".

28. The timing of the registration of the domain name bmofield.ca leaves no doubt as to the abusive and opportunistic nature of the registration. On probability, the Registrant could not seriously ignore that, by registering the bmofield.ca, it would hijack the name given to the BMO stadium and illegitimately interfere with the Complainant's activity.
29. The Panel concludes that speculation was the main purpose of the registration and it was done in bad faith within the meaning given to that notion under CIRA Policy.

*Legitimate Interest*

30. The Complainant brought sufficient and satisfactory proof pertaining to the Registrant's lack of legitimate interest and absent any Response from the Registrant, the Panel is permitted to make a negative inference.
31. In the instance case the Panel finds in favour of the Complainant : the Registrant has no legitimate interest in the name in the meaning given to that expression under the Policy.

***VI – Decision and Order***

32. The Panel finds that the Complainant, having satisfactorily met its burden on all three elements, should succeed in this proceeding initiated under the Policy.
33. The Panel therefore directs that the registration of bmofield.ca be transferred to the Complainant BMO.



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Cecil O.D. Branson, Q.C.  
Chair

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Pierre Emmanuel Moyse

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Jacques Biron