

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

Complainant: David Cohen, Montreal QC

Complainant’s Representative: Frederick Pinto & Nathalie Proulx
Spiegel Sohmer
Montreal QC

Registrant: 3824152 Canada Inc., Toronto ON

Registrant’s Representative: Zak Muscovitch
The Muscovitch Law Firm
Toronto ON

Disputed Domain Name: <canadavisa.ca>

Registrar: MyID.ca. (Creative Pixels Inc.)

Panel: Paul W. Donovan, Sharon Groom, Denis N. Magnusson (Chair)

Service Provider: Resolution Canada

DECISION

Parties

The Complainant is David Cohen, a lawyer in practice with the firm of Campbell Cohen in Montreal Quebec. The Registrant is 3824152 Canada Inc. of Toronto Ontario.

Disputed Domain Name and Registrar

The disputed domain name is <canadavisa.ca>, which was registered January 9, 2008. The current Registrar is MyID.ca (Creative Pixels Inc.)

Procedural History

The Complainant filed this Complaint with the Provider Resolution Canada on May 5, 2008. The Registrant asked the Provider for an extension to the time to file a Response and was granted a 20 day extension to June 10, 2008 as permitted by CIRA Dispute Resolution Rules Version 1.2, paragraph 5.4. A Response was filed with the Provider on June 10, 2008. The Provider appointed Paul W. Donovan, Sharon Groom, Denis N. Magnusson (Chair) as the Panel to decide this matter.

Relief Requested

The Complainant requested that the Panel order that the domain name registration be transferred from the Registrant to the Complainant.

Background Facts

The Complainant

The Complainant is a lawyer whose practice, located in Montreal, is focused on immigration law. He registered the domain name <canadavisa.com> in 1997. Since that date he has “extensively used [canadavisa.com] to operate a website dedicated to providing immigration law services and information to people seeking to immigrate to Canada”.

If an Internet user goes to the website at the domain name <canadavisa.com>, the user will arrive at a page with the heading “CANADAVISA.COM” prominently displayed at the top left of the page, followed by the image of a maple leaf and under which is the heading “Canada Immigration Lawyers”. At the top right of the page are the words “CAMPBELL COHEN” (the Complainant is a member of the Campbell Cohen law firm).

The Complaint states that the number of recorded page views for this webpage in the years 2006 – 2008 have averaged “several million per month”. The Complaint also states that from 1998 to date the Complainant has spent more than \$1 million on advertising for his immigration services website at <canadavisa.com>.

This advertising was placed primarily with Internet search services such as Google and Yahoo. A recent search for the terms “Canada visa immigration” in each of Google and Yahoo yielded search results, each of which had several “Sponsored Links” at the top of, and/or in a column to the right of, the first search results page. Both the Google and the Yahoo search results featured a Sponsored Link for the Complainant (the Complaint states that \$18,000 per month is currently being spent by the Complainant on advertising his website with Google and Yahoo). Both the Google and the Yahoo search results featured several Sponsored Links in addition to the Sponsored Link featuring the Complainant.

The Google search results page featured this Sponsored Link entry for the Complainant:

[Canada Immigration Visa](#)

Free assessment, 24-hour reply.

Lawyer over 25 years of experience.

www.CanadaVisa.com

If this link was clicked, the Internet user would be taken directly to the Complainant’s web page at <canadavisa.com>, where the Internet user would see the prominent display of “CANADAVISA.COM” at the top left of that web page.

The Sponsored Link entry for the Complainant appeared with other Sponsored Links such as:

[CANADA IMMIGRATION VISA](#)

One-stop for all **Canadian** visas!

Free assessment & expert advice

migrationexpert.com/Canada

The Yahoo search results page featured this Sponsored Link entry for the Complainant:

[Canada Immigration Visa Application](#) www.canadavisa.com - Free assessment, 24-hour reply. Lawyer with over 25 years of...

If this link was clicked, the Internet user would be taken directly to the Complainant’s web page at <canadavisa.com>, where the Internet user would see the prominent display of “CANADAVISA.COM” at the top left of that web page.

The Sponsored Link entry for the Complainant appeared with other Sponsored Links such as:

[Canadian Visa Services](#) migrationexpert.com/canada - One-stop for Canadian **visas!** Free assessment & expert advice.

The Registrant

The Registrant acquired and registered the disputed domain name <canadavisa.ca> in January, 2008 in a purchase of the domain name in an auction run by Sibername. The domain name had been first registered by some third party about November 10, 2000. The registered owner of the domain name prior to the present Registrant let that registration expire about December 1, 2007. Sibername acquired the registration of the domain name and offered it in the auction in which it was acquired by the current Registrant.

The domain name had been advertised for sale by at least one of the prior owners of the domain name. The present Registrant offered, by email dated April 29, 2008, to sell the domain name registration to the Complainant for a price of \$75,000.

The Response states that the Registrant, after acquiring the domain name registration in January, 2008, retained a “professional web site development company” to create a web site to be used in association with the domain name. The Response states that payments of \$2,525 and of \$2,100 were made to this developer on March 25, 2008 and April 15, 2008 respectively. The Response included exhibits of exchanges between the Registrant and the developer concerning immigration-related content that might appear on such web site.

Eligible Complainant

The Complainant, as a Canadian citizen of the age of majority in Quebec where the Complainant resides, meets the Canadian Presence requirements for a Complainant in CIRA Policy 1.4.

Onus on Complainant

CIRA Policy 4.1 requires that:

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.

[emphases added]

(a) Confusingly Similar

Mark in Which Complainant Had and Has Rights

The Complainant claims Rights in a Mark pursuant to Policy 3.2(a)

“ . . . a trade-mark . . . trade name *that has been used in Canada* by a person for the purpose of distinguishing the . . . services or business of that person from the wares, services or business of another person” [emphasis added].

The Marks in which the Complaint claims Rights are <Canada Visa> and<canadavisa.com>

Use of the Marks

To establish that he had Rights in his claimed Marks, the Complainant must prove that he has used the Marks in Canada as a trademark or trade name.

The evidence submitted by the Complainant does not show that he has used a mark in the form <CANADA VISA> as a trademark or trade name. Thus, the Complainant cannot show that he has Rights in a mark of that form, and the Panel will not consider this form of Complainant's mark further in these reasons.

The evidence submitted by the Complainant does show that he has used a mark in the form <canadavisa.com> as a trademark for his legal services of assisting in securing visas to enter Canada and as a trade name for his specialized immigration and visa legal practice business. These reasons address whether the Complainant has successfully proved that he has Rights in a Mark of this form.

Use of the Mark in Canada

The Response raises a question of whether the Complainant's claimed Mark <canadavisa.com> had been used by him in Canada as required by Policy 3.2(a).

The Complainant's business and services are directed at persons outside Canada seeking to enter Canada. For a Mark to be used *in Canada*, not only must the user's message embodying the Mark emanate from Canada, but the message must reach recipients located in Canada. While the Complainant's business, and so his website using the Mark, were primarily directed outside Canada, there can be no doubt that some viewers of his website were in Canada, e.g., Canadian residents interested in helping family members outside Canada to immigrate to or to visit Canada. The Complainant would respond to and render services to such Canadian residents. The Complainant has used his Mark *in Canada*.

Descriptiveness of the Mark

The Mark which the Complainant has used and in which he claims rights is <canadavisa.com> used by him in relation to his legal services business for securing Canadian visas and immigration to Canada.

The Mark is composed of three elements, "visa", "Canada" and ".com", each of which is descriptive of a business offering legal services for securing visas to enter Canada. The Response points to Canadian Trade-mark Registration TMA413202, for the mark VISA IMMIGRATION EXPRESS CANADA registered for Services including professional legal services concerning immigration including requests for visas for permanent residence in Canada etc.. The Trade-mark Office, applying the test and registration exclusion of "clearly descriptive" in the Trade-marks Act, s. 12(1)(b), required the applicant to disclaim the exclusive right to the use of each of the terms "visa", "Canada" and "immigration" –i.e., such terms were found to be clearly descriptive in relation to Canadian immigration / visa services. The Trade-marks Act standards are largely a codification of the common law standards – what is clearly descriptive under the Act, is clearly descriptive when used as a common law mark. Thus, two of the three elements in the Complainant's Mark, "visa" and "Canada" are clearly descriptive of the Complainant's business and services.

Also, the Trade-marks Office has issued a Policy statement regarding the registration of marks containing domain name suffixes such as “.com”¹. The Office considers “com” to mean commercial entity and so “.com” is a clearly descriptive term for any business. The Policy states “[t]herefore, the addition of one of these terms [such as “.com”] to a clearly descriptive mark will not make it [not clearly descriptive and so] registrable.” This same logic is applicable to common law (unregistered) trademarks such as the Complainant’s <canadavisa.com> Mark.

Therefore, the Complainant’s Mark <canadavisa.com>, comprising the descriptive elements “Canada”, “visa” and “.com”, is clearly descriptive of the business and services with which he has used that Mark.

Rights in Descriptive Marks

We have drawn attention to the inherent descriptive character of the Complainant’s Mark because of CIRA’s stated position that the CIRA Policy does not create new trademark rights *vis à vis* domain name Registrants, but only recognizes trademark rights already established under Canadian law. For example, the CIRA website FAQ has this question and answer:

16 - Does CIRA's dispute resolution policy create new rights for trade-mark owners?

No. The purpose of this policy is to provide [trademark owners] with a relatively inexpensive and low cost, means of obtaining quick out-of-court decisions over disputes [over the registration of a dot-ca domain name] that infringe their trade-mark rights protected by Canadian law. [emphasis added]

An unregistered trademark or trade name used in Canada in association with a particular business or product can be protected under the common law tort of passing off (and a similar right under the Quebec Civil Code) and under s. 7(b) of the Trade-marks Act. However, when the Mark is clearly descriptive of the business or products with which the Mark is used, mere use of such a Mark does not generate legal Rights in such Mark. The law requires proof that the Mark has acquired “secondary meaning”, that is, a trademark meaning of pointing the consuming public to a particular business or to a particular business source of the products in association with which the Mark is used. A Mark which has so acquired secondary meaning is also said in trademark terminology to have become “distinctive” of the Mark owner and his business or products.

Under the Policy can the Complainant establish that he has rights in his inherently descriptive Mark simply by showing he has used that Mark in Canada, or must he offer some evidence that the Mark has acquired secondary meaning?

This Panel concludes that since the Policy was not intended to recognize new legal rights in Marks, but only to recognize those Rights which exist in Canadian law apart from the Policy, the Complainant must offer some evidence that his inherently descriptive Mark has acquired secondary meaning in Canada. We are further encouraged in this conclusion by the fact that the Policy paragraph (3.3(a)) relied upon by the Complainant states that the Complainant has Rights only in a “trade-mark” or “trade name” which has been used in Canada. While a Mark used with *the intent* that it distinguish a particular business or product business source may be within a definition of a “trade-mark” or “trade name”, when the Mark is inherently descriptive it will not

¹ <http://www.cipo.ic.gc.ca/epic/site/cipointernet-internetopic.nsf/en/wr00198e.html>

be a legally protectable trade-mark or trade name, that is, it will not be a trade-mark or trade name in any meaningful sense, unless secondary meaning for such Mark has been proved.²

Proof of Secondary Meaning in This Case

The burden of proof that his inherently descriptive Mark has acquired secondary meaning is on the Complainant. As well the courts have stated that the onus is a heavy one

“There are various authorities to the effect that where one must prove that a normally descriptive word has acquired a secondary meaning so as to make it descriptive of a particular product, the onus is indeed heavy: see, for example, *The Canadian Shredded Wheat Co., Ltd. v. Kellogg Co. of Canada Ltd. et al* (1938), 55 R.P.C. 125, at page 142 (P.C.); *J.H. Munro Limited v. Neaman Fur Company Limited*, [1946] Ex.C.R. 1, at pages 14-15;” : *Carling Breweries Ltd. v. Molson Cos.* [1984] 2 F.C. 920, 1 C.P.R. (3d) 191 at 928, aff’d (1998). 19 CPR(3d) 129 (FCA).

There are two modes of proof for showing that a Mark has acquired secondary meaning.

One mode is “direct” proof in which evidence of the actual understanding of the Mark among the relevant consumer group (do those consumers regard the mark as identifying one particular trade source for the relevant type of product?) is produced. Such evidence can be submitted anecdotally, e.g., the testimony of a few individual consumers as to their understanding of the Mark. While relevant, such anecdotal evidence has often been viewed as of limited value as the fact-finder cannot know to what extent the understanding of those few consumers accurately reflects the views of the relevant consumers as whole. Consequently, it has become common to submit direct evidence in the form of statistically valid surveys of a sample of such consumers.

In this case the Complainant submits some direct evidence in the form of a few emails from clients and suppliers who identify the Complainant’s business by using <canadavisa.com>, <canadavisa>, or <Canada Visa>.

However, the evidence submitted to prove secondary meaning by the Complainant is largely of the second, “indirect”, variety -- evidence of the period of use of the Mark as a domain name, evidence of the appearance of the Mark as a logo on the web page at that domain name and of the millions of hits on that page yearly in recent years, and evidence of the substantial Google and Yahoo Sponsored Link advertising (in excess of \$1 million cost since domain registration in 1997) using the Mark as a domain name location. The Complainant invites us to infer that such extensive use was likely to have caused the relevant consuming public to regard the Mark as indicating a particular business and Canadian visa services source, despite the inherent descriptive nature of the Mark.

The Panel concludes that the Complainant has not met the heavy onus on him to prove that his inherently descriptive claimed Mark <canadavisa.com> had acquired secondary meaning. In particular, while the Panel was persuaded that there were sufficient Canadian-resident recipients of the Complainant’s Internet site to establish that the Complainant had *used* the Mark in Canada, that there was some use *in Canada* does not in itself establish acquired distinctiveness or secondary meaning *in Canada*. The evidence in the form of a few anecdotal e-mail reports of customers and suppliers, strongly suggest that most of the e-mailers were located outside

² This interpretation of Policy 3.3(a) is consistent with that in the earlier CDRP case of *Cheap Tickets and Travel Inc. v. Email.ca Inc.* (Dispute #0004)

Canada. The Complainant does not assist us in identifying the location of the e-mailers. The Complainant's indirect evidence of acquired distinctiveness points to the 10-year plus period of use of the <canadavisa.com> domain name and his web page at that location which had enjoyed several millions of hits each month in recent years. However, the very nature of the Complainant's business is that it is directed at persons who are outside Canada seeking to enter Canada, for which entry they need a visa. Thus, it is a reasonable *prima facie* inference that the great preponderance of the people represented by the domain name / webpage hits were persons outside Canada. The Complainant has submitted no evidence which rebuts this inference or helps the Panel understand where the persons accessing the Complainant's web page were located.

Conclusion on Confusingly Similar

As the Complainant has failed to meet the burden of proving that the mark he claims, <canadavisa.com> has acquired secondary meaning, that mark cannot satisfy the definition of "Mark" in Policy 3.3(a), as it has not been proved to be a legally effective trademark or trade name.

"... a *trade-mark* . or . . . *trade name* that has been used in Canada by a person for the purpose of distinguishing the . . . services or business of that person from the wares, services or business of another person" [emphasis added].

Policy 3.3(a) states that a Complainant can have Rights in a Mark if "the *Mark* has been used in Canada [by the Complainant]" [emphasis added]. Since the Complainant has failed to establish that he has a "Mark" within the meaning of the Policy, there is no possibility of finding Rights in such non-Mark.

Policy 3.4 defines "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*. [emphases added]

The Complainant having failed to establish that he has a "Mark" under the Policy, there is no scope for applying this provision to any mark / domain name comparison.

Having found that the Complainant has no Mark, and thus there can be no finding of Confusingly Similar, this determines the dispute in the domain name Registrant's favour.

However, the Complaint and Response did make submissions on the further issues of Bad Faith and Legitimate Interest. While in the light of our finding of no Mark, it is unnecessary for the Panel to address those issues to resolve this dispute, the Panel offers the following comments on each of these further issues.

b) Bad Faith

Policy, 3.7 has a restrictive definition of what can constitute the Registrant's necessary Bad Faith in registering the domain name. There is Bad Faith, "if, and only if" one or more of three specific circumstances obtain. The Complainant submitted that the Registrant had registered the domain names in Bad Faith under Policy 3.7(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;

The Complainant submitted evidence of an unsolicited e-mail he received from the Registrant dated April 28, 2008 to support this finding of Bad Faith. To quote the Complaint:

In said e-mail, a representative of Registrant's states that the Domain Name would "complement" the domain owned by the Complainant, that it receives much traffic seeking "immigration info", the Complainant would not want this Domain to fall in the "hands of competing law firms", and that they were placing the domain on auction. Registrant then states its price for selling the Domain Name to the Complainant, namely at a price of \$75,000, which is far in excess of its price of acquisition of said Domain Name.

The Response states that the Registrant acquired the registration of the domain name at issue on or about January 9, 2008. The Response notes that the test of Bad Faith under Policy 3.7(a) requires that the Registrant have the necessary intention (to sell the domain to the Complainant) *at the time* of registration of the domain name. The e-mail noted by the Complaint was dated April 28, 2008, nearly four months after the registration of the domain name by the Registrant.

The Response states that at the time the Registrant acquired the domain name it did not know of the Complainant and was unaware of the Complainant's claimed common law trademark. The Response noted that the claimed common law Mark was not registered as a trademark in the CIPO under the Trade-marks Act, and implicitly noted that the Registrant could not have discovered the claimed mark by a search of the trade-marks register. The Response further submits that the Registrant had no reason to suspect that the Complainant had Rights in any Canada Visa mark as those words are clearly descriptive of services for obtaining a Canadian visa. The domain name had originally been registered by a third party in November 2000. After that third party advertised the domain name registration for sale on or about June 21, 2007, and apparently failing to sell the registration, that person allowed the domain name registration to lapse (abandoned it) on or about December 1, 2007. As noted, the Registrant subsequently acquired the domain name registration in a Sibername auction around January 9, 2008. The Response noted UDRP case authority stating that:

A domain name registrant [e.g. this Registrant] who knows that a domain name has been abandoned [as the third party did for the domain name at issue here] should be more confident, not less so, that there is no competing trademark claim relating to the domain name . . .³

The burden of proving the Registrant's Bad Faith at the time of domain name registration is on the Complainant. The Panel concludes that the Complainant has not met that burden of proof and that the Panel cannot find Bad Faith on the part of the Registrant.

c) Legitimate Interest

Under Policy 4.1, the Complainant would have the burden of providing "some evidence" that "the Registrant has no Legitimate Interest in the domain name as described in [Policy] 3.6". The

³ Citing *Corbis Corporation v. Zest*, No. 98441 (NAF September 12, 2001)

Complainant made submissions which might well constitute “some evidence” that the Registrant has no Legitimate Interest in the domain name under Policy 3.6.

Policy 4.1 states that even if the Complainant has advanced some evidence that the Registrant has no Legitimate Interest in the domain name, the Registrant can still prevail 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.

The Response submits evidence with respect to the Policy 3.6(b) head of Legitimate Interest:

(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;

In paragraph 3.6 (b) . . . “use” by the Registrants includes, but is not limited to, use to identify a web site.

The Response concedes that at the date upon which this Complaint commenced, which is the critical date for assessing Legitimate Interest under Policy 3.6, the Registrant did not use the domain name to identify a web site that would meet the requirements of Policy 3(b). However the Response points to the parallel definition of Legitimate Interest in Policy 3.6(b) in the Uniform Domain Name Dispute Resolution Policy (UDRP) 4(c)(i). The UDRP definition provides that in addition to actual legitimate use of the domain name, e.g. to identify a web page offering goods or services, “demonstrable preparations to [so] use” the domain name also constituted a showing of such a Legitimate Interest. The Response offers some evidence of the Registrant’s preparations to use the domain name in association with a web page referring to Canadian visa applications.

The Panel notes that those drafting the CDRP Policy had the UDRP provision in front of them, but decided not to include “demonstrable preparations to use” in Policy 3.6(b). Policy 3.6(b) includes only “use” of the clearly descriptive domain name in association with wares, services or a business (including use via a web site) at the time the Registrant receives notice of the Complaint. The Response concedes that the Registrant was making no such use of the domain name at that time. Therefore the Registrant could not show that it has a Legitimate Interest in the domain name under Policy 3.6.

Domain Name Hijacking

The Complainant makes a claim under Policy 4.6:

4.6 Bad Faith of Complainant. If the Registrant is successful, and the Registrant proves, on a balance of probabilities, that the Complaint was commenced by the Complainant for the purpose of attempting, unfairly and without colour of right, to cancel or obtain a transfer of any Registration which is the subject of the Proceeding, then the Panel may order the Complainant to pay to the Provider in trust for the Registrant an amount of up to five thousand dollars (\$5000) to defray the costs incurred by the Registrant in preparing for, and filing material in the Proceeding. The Complainant will be ineligible to file another Complaint in respect of any Registration with any Provider until the amount owing is paid in full to the Provider.

The Complainant launched this Complaint, in the Panel's view, with an honest belief based on facts available to him that he had a legal right to the <canadavisa.com> and / or <CANADA VISA> Marks which he believed had been infringed, under the Policy, by the Registrant's registration of his domain name. This does not constitute the Complainant launching this Complaint "unfairly and without colour of right"⁴. The Panel refuses to make any monetary award under Policy 4.6.

Conclusion and Order

The Panel will not order that the domain name be transferred from the Registrant to the Complainant.

Date: July 23, 2008

Signed:

Paul W. Donovan

Sharon Groom

Denis Magnusson (Chair)

⁴ "The most commonly used definition of colour of right is "an honest belief in a state of facts which, if it existed, would be a legal justification or excuse. (See *R. v. Johnson* (1904), 8 C.C.C. 123 (Ont. C.A.)." *R. v. Watson*, (1999), 176 Nfld. & P.E.I.R. 263, 540 A.P.R. 263, 137 C.C.C. (3d) 422, 27 C.R. (5th) 139, 177 D.L.R. (4th) 403, 176 Nfld. & P.E.I.R. 263