

BCICAC FILE NO. DCA-1089-CIRA

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

**BETWEEN:**

CISCO SYSTEMS, INC., CISCO TECHNOLOGY, INC. and CISCO SYSTEMS CANADA  
CO. (collectively “Cisco”)

Complainant

– and –

ALLEN MICHAEL SWARYCHEWSKI, aka “CISCOANADA”

Registrant

**DECISION**

**A. The Parties**

1. The Complainant, Cisco is a company incorporated under the laws of California.
2. The Registrant, is an individual doing business under name “CISCOANADA”.

**B. The Domain Name and Registrar**

3. The disputed domain name that is the subject of this arbitration is:

- cisco.ca (the “Domain Name”)

4. The Registrar of the Domain Name is CanHost Inc.

**C. Procedural history**

5. This matter is arbitrated under the *CIRA Domain Name Dispute Resolution Policy* (the “Policy”) and the *CIRA Domain Name Dispute Resolution Rules* (the “Rules”). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of certain disputes under the Policy and Rules.
6. Based on information from the Dispute Resolution Service Provider – the *British Columbia International Commercial Arbitration* (the “BCICAC”) – the history of this proceeding can be summarized as follows:
  - (a) On June 4, 2008, the Complainant filed with BCICAC a Complaint regarding the Domain Name.

- (b) The Complaint was reviewed by BCICAC and found to be compliant with administrative requirements.
- (c) The BCICAC sent a notice of Complaint to the Registrant on June 4, 2008.
- (d) The Registrant requested an extension for delivery of its Response to July 3, 2008 and the extension was granted by the BCICAC as permitted under Rule 5.4.
- (e) The Registrant delivered its Response, in compliance with the Policy and Rules, to the Centre on July 3, 2008.
- (f) The Registrant's Response contains a claim for costs (paragraph 4.6 of the Policy); therefore.
- (g) The Registrant's Response was sent to the Complainant on July 7, 2008.
- (h) The Complainant responded to the claim for cost within 5 days after receipt of the Response, on July 15, 2008 in compliance with the paragraph 4.6 of the Policy and rule 11.1 of the Rules.
- (i) The BCICAC named Barry Effler and Michael Manson as panellists. Hugues G. Richard was named as Chair of the Panel.
- (j) In accordance with the CIRA Rules, paragraph 7.1 and 7.2, prior to accepting appointment, each panellist provided the BCICAC with his declaration of independence and impartiality.

#### **D. Eligible Complainant**

- 7. An eligible Complainant under the Policy, paragraph 1.4, includes any person who is the owner of a trade-mark registered in the *Canadian Intellectual Property Office* ("CIPO"), to which trade-mark the dispute relates. The Complainant noted six such trademark registrations of which the Complainant was the owner. Two of these trade-marks consist only of the word "CISCO", two of "CISCO & SYSTEMS" & design and two of these trade-marks consist of the word "CISCO IOS" and "CISCO IOS & Design". Thus, a dispute over the Domain Name *cisco.ca* "relates to" each of these registered trade-marks, qualifying the Complainant as eligible complainant.

#### **E. CIRA Canadian Presence Requirements**

- 8. The Panel finds that the Complainant has met the CIRA Canadian Presence requirements in that the Complainant is the registered owner of Canadian trade-mark registration numbers 481,696, 501,412, 501,413, 520,923, 577,771 for the trade-marks CISCO, CISCO SYSTEMS and CISCO IOS and therefore complies with paragraph 1.9(b) of the Policy.

#### **F. Relief Sought**

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

## G. Background Facts

10. The Cisco trade-marks have been in continuous use in Canada since at least as early as 1987 by Complainant. During that time, they have acquired significant goodwill and enjoy a strong reputation in Canada in association with a variety of computer products and services.
11. In February of 2001, Registrant proceeded to register the Domain Name cisco.ca for his business named CISCOANADA.

## H. Analysis of the Complaint and Response by the Panel

12. Paragraph 4.1 of the Policy requires that:

“**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.”

### (a) Confusingly Similar

#### Marks in Which Complainant Had and Has Rights

13. Policy, para. 3.2 states a “Mark” includes a trade-mark registered in the CIPO. The Complaint listed the following trade-mark registrations owned by the Complainant as related to the Complaint:

<b>Trademark</b>	<b>Reg. No.</b>	<b>Date Registered</b>
CISCO SYSTEMS & Design	481,696	registered on August 27, 1997 for use in association with various computer hardware and software products and related services.
CISCO IOS & Design	501,412	registered on September 28, 1998 for use in association with computer software for networking.

CISCO IOS	501,413	registered on September 28, 1998 for use in association with computer software for networking.
CISCO	520,923	registered on December 23, 1999 for use in association with financial services for the lease of computer hardware and software products.
CISCO	577,771	registered on March 20, 2003 for use in association with various computer hardware and software products and related services.
CISCO SYSTEMS & Design	577,923	registered on March 21, 2003 for use in association with various computer hardware and software products and related services.

14. All of the above registered trade-marks are “Marks” in which the Complainant had Rights prior to the date of registration of the disputed domain name February 1, 2001.

15. *Policy*, para. 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.”

#### **Conclusion on the “confusingly similar”**

16. In assessing similarity, the “dot-ca” suffix of the domain name is ignored. Thus, two of the Complainant’s trade-mark, each composed of the word “CISCO”, are identical to the “CISCO” element of the **cisco.ca** domain name. Such identity clearly qualifies as near resemblance likely to cause the domain name to be mistaken for the trade-mark. In fact, the Registrant’s **cisco.ca** domain name is not only confusingly similar to the senior CISCO trade-marks, it is identical.

#### **(b) Bad Faith**

17. The CIRA *Policy*, para. 3.7 has a very restrictive definition of what can constitute the Registrant’s necessary bad faith in registering the domain name. That definition states that there will be bad faith, “*if, and only if*” one or more of three specific circumstances apply.

**3.7(a) Registrant's registered the domain name primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant.**

18. Complainant submitted that the Registrant registered the Domain Name for the purpose of selling, renting, licensing or otherwise transferring the registration to the Complainant or to another party for a price in excess of its actual costs of registering or acquiring the Domain Name within the meaning of 3.7(a) of the Policy.
19. However, Complainant has failed to prove any of these allegations, simply stating that the Registrant was *de facto* in bad faith because he did not use the Domain Name for seven years, thus inferring from the non use that Registrant's only intention was to sell the Domain Name. The Respondent gave evidence that it in fact had refused to enter into negotiations to sell the Domain name. The Panel finds that the Complainant has not established bad faith under this subsection.

**3.7(b) Registrant's registered the Domain Name to prevent Complainant from registering its Mark as a domain and Registrant has engaged in a pattern of registering domain names in order to prevent others who have rights.**

20. Complainant submitted that the Registrant registered the Domain Name to prevent Complainant from registering its CISCO trade-mark as a domain, and that the Registrant has engaged in a pattern of registering domain names in order to prevent others who have rights in their trade-marks from registering them as domain names, within the meaning of s. 3.7(b) of the Policy.
21. However, Registrant responded that he registered the Domain Name cisco.ca because it is a contraction of his business name CISCOANADA. He further added that one of the other domain names registered by him, voip.ca, was an acronym for Voice Over Internet Protocol which is a generic computer term and not the name of a business. Although Registrant registered the domain name eminem.org, (*Eminem* being the stage name of a rap singer), this in and of itself should not be considered as proof of bad faith as there is no evidence of any action being taken with regard to the eminem.org domain name.
22. Furthermore, Registrant submitted in Schedule A of his response a number of trade-marks named CISCO which had no association to Complainant's business, for example *The Canadian Red Cross* has registered the trade-mark CISCO for collecting and communicating data on human blood. Additionally, Registrant submitted in Schedule C of his response a series of businesses in Canada whose names incorporate the word "CISCO" in them and have no connection to Complainant's business, for example there is a company named Cisco Data Products Ltd. and another named Cisco Computer Consulting. Therefore, the Panel concludes that Complainant does not have exclusive rights to the word "CISCO" as a trade-mark, business name or domain name.
23. It is a well known that domain name registrations are granted on a first come first serve basis. The Complainant has been using the "Cisco" trade-mark in Canada since as early as 1987 and had failed to register the Domain Name "cisco.ca" at any time prior to the

registration by the Registrant in 2001. It cannot blame the Registrant for such a failure. The Registrant proceeded to do so, others could have done so.

24. The Panel finds that the Complainant has failed to establish that Registrant registered the Domain Name in order to prevent Complainant from registering its trade-mark as a domain or that Registrant is engaged in a pattern of registering domain names in order to prevent others who have right to do so.

### **3.7(c) Registrant's Purpose of Disrupting the Business of a Competitor**

25. Policy, para. 3.7(c) sets out this circumstance of bad faith:

(c) the Registrant registered the domain name . . . *primarily* for the purpose of disrupting the business of the Complainant . . . who is a competitor of the Registrant.

26. To succeed in showing the Registrant's bad faith under this subparagraph, the Complainant must, among other things, establish that the Registrant is a *competitor* of the Complainant. The Complainant made the following submissions on this requirement:
27. Because of the renown of the Cisco Marks, the Complainant submitted that the Registrant must have known of the Complainant's rights when the Domain Name was registered. This, according to Complainant, is particularly evident given the Registrant's registration of the curious CISCOANADA business name and the fact that the Registrant seems likely to be in a computer or Internet-related business (the same class of activity as Cisco). Complainant further submitted that Registrant's prior business name was Compu-Global-Hyper-Mega-Net and was based on an episode of the television cartoon *The Simpsons* named *Das bus* where Homer Simpson proceeds to launch an Internet business under that name. Complainant stated that since Registrant had chosen to use such a name for his business, it implied he was in the Internet business and thus a *competitor* of Complainant.
28. From these allegations, the Panel cannot conclude that the Complainant has provided an evidentiary foundation to support a finding that the Registrant is a *competitor* of the Complainant. The Panel finds that many cases have preferred to adopt a narrow definition of competitor under Section 3.7 (c) and finding competition only when the Registrant was in direct competition with Complainant or when he was gaining some kind of economic benefit from the Internet traffic.
29. Thus, since Registrant has used the domain name merely for non-profit personal use, the Panel finds that Complainant has failed to establish that Registrant used the Domain Name to disrupt the Complainant's business or that he is a direct competitor of Complainant.

### **Conclusion on Bad Faith**

30. The Panel is unable to find the necessary evidence of bad faith required for the Complainant to be successful and finds that the Registrant did not, on a balance of

probabilities, register the domain name in bad faith. This conclusion is arrived at under reserve of the right of Complainant to file a new complaint should the Domain Name be used any differently in the future.

**(c) Legitimate Interest**

31. The Panel is of the view that considering its findings on the issue of bad faith, it does not need to examine the issue of Legitimate Interest.

**I. Costs**

32. The Panel is of the view that the facts of this case are not such that either party deserves to be granted costs.

**Order**

33. For all the above reasons, the complaint concerning the domain name www.cisco.ca is not successful and is dismissed.

Date: July 22, 2008

Hugues G. Richard (Chair), Barry Effler, Michael Manson

Signed



Hugues G. Richard Chair of Panel