

## CANADIAN INTERNET REGISTRATION AUTHORITY

### DOMAIN NAME DISPUTE RESOLUTION POLICY

#### COMPLAINT

Dispute Number: DCA-1137-CIRA  
Domain Names: eponink.ca; eponcartridge.ca; eponinkjet.ca  
Complainant: Seiko Epson Corporation  
Registrant: Zokool Technologies, Inc.  
Registrar: DomainsAtCost Corp.  
Arbitrator: Peter Cooke  
  
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, by 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 Seiko Epson Corporation, situated at 3-3-5 Owa, Suwa, Nagano 392-8502, Japan.
6. The Registrant is Zokool Technologies, Inc., situated at 300 John St., P.O. Box # 87575, Thornhill, ON L3T 7R3.

##### **THE DOMAIN NAMES AND REGISTRAR**

7. The Domain Names that are the subject of this proceeding are eponink.ca, eponcartridge.ca, and eponinkjet.ca.
8. The Registrar of the Domain Names is DomainsAtCost Corp.

9. The Domain Names `epsonink.ca` and `epsoninkjet.ca` were registered by the Registrant on November 14, 2000; the Domain Name `epsoncartridge.ca` was registered by the Registrant on January 28, 2001.

#### **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 January 22, 2009, the Complainant filed a Complaint regarding the Domain Names with BCICAC.
  - (b) The Complaint was reviewed and found to be compliant the requirements of the Policy and the Rules. By letter dated January 26, 2009 the BCICAC advised the parties and forwarded a copy of the Complaint to the Registrant using the email address for the Administrative Contact of the Domain Names.
  - (c) Attempts to deliver the Complaint to the Registrant by email and courier have been unsuccessful.
  - (d) The Registrant has not provided a Response.
  - (e) Given the absence of a Response, the Complainant has elected to convert from a panel of three to a single arbitrator.
  - (f) The BCICAC named Peter Cooke as sole arbitrator. The arbitrator has delivered to the BCICAC the required Statement of Impartiality and Independence, as required by paragraph 7 of the Rules.
  - (g) Absent exceptional circumstances, the arbitrator was required to deliver his decision no later than March 19, 2009.
11. While the Registrant has not made submissions, Paragraph 4.2 of the Policy requires that the arbitrator consider all the evidence presented in the Proceeding and that the arbitrator render his decision in accordance with the Policy and the Rules.
12. The arbitrator finds that he was properly appointed in accordance with the Policy and the Rules.
13. Based upon the information provided by the BCICAC, the arbitrator finds that all technical requirements for the commencement and maintenance of this proceeding were met.
14. The Complainant was represented by legal counsel throughout this proceeding. As indicated above, the Registrant has not provided a Response.

#### **FACTUAL BACKGROUND**

15. The arbitrator proceeds on the basis of the following facts, which are established by the evidence submitted by the Complainant:
  - (a) On November 14, 2000 the Registrant registered the domain names `epsonink.ca` and `epsoninkjet.ca`. On January 28, 2001 the Registrant registered the domain name `epsoncartridge.ca`.

- (b) On July 10, 2008 the Complainant sent a demand letter regarding eponink.ca. with a second demand sent July 25, 2008. On July 15, 2008, the Complainant sent a demand letter regarding eponcartridge.ca. with a second demand on July 28, 2008. Complainant was not aware at that time of eponinkjet.ca.

16. The Complainant contends as follows:

- (a) The Complainant is the owner in Canada of the following registered trade-marks:

- EPSON, TMA289,441 registered on April 6, 1984
- EPSON, TMA314,420 registered on May 23, 1986
- EPSON, TMA399,624 registered on June 26, 1992
- EPSON, TMA401,411 registered on August 14, 1992
- EPSON, TMA416,898 registered on September 17, 1993
- EPSON, TMA494,456 registered on May 12, 1998

and that each of the Domain Names are confusingly similar to the Complainant's trade-marks in which the Complainant had rights prior to the registration of the Domain Names and in which the Complainant continues to have such rights.

- (b) The Registrant registered and is using each of the Domain Names in bad faith:
- (c) Registrant has no legitimate interest in any of the Domain Names.

17. The Registrant has not provided a Response.

### DISCUSSION AND FINDINGS

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

18. The Complainant, Seiko Epson Kabushiki Kaisha (also trading as Seiko Epson Corporation) is the registered owner in Canada of the trade-marks identified in paragraph 16(a) above, and therefore satisfies the CIRA Canadian Presence Requirement for Registrants, as stipulated in paragraph 1.4 of the Policy.

#### **APPLICABLE LAW**

19. Pursuant to Section 12.1 of the Rules, the arbitrator 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.
20. The Registrant is domiciled in Ontario. The Complainant has not stated a preference for any applicable law and therefore the arbitrator will render his 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

21. 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 Domain Names are Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the Domain Names and continues to have such Rights; and
  - (b) the Registrant has registered the Domain Names in bad faith.

The Complainant must also provide some evidence that:

- (c) the Registrant has no legitimate interest in the Domain Names .

## CONFUSING SIMILARITY BETWEEN THE DOMAIN NAMES AND COMPLAINANT'S TRADE-MARKS

22. The Complainant argues that the Domain Names are confusingly similar with its above-mentioned registered EPSON trade-marks, which the Complainant had registered prior to the date of registration of the Domain Names and in which the Complainant continues to have rights.
23. 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 *Vicom 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*, at 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 EPSON trade-marks prior to the registration of the Domain Names 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 Names are not merely similar to the Complainant’s registered EPSON trade-marks. Each Domain Name features the Complainant’s trade-mark EPSON. The fact that the whole of the Complainant’s mark EPSON is incorporated into the Domain Names is sufficient to support a finding of confusing similarity and the addition of descriptive or non-distinctive terms in the Domain Names [here, “ink”, “inkjet”, and “cartridge”] will not prevent them from being found Confusingly Similar with the Complainant’s mark. (see *General Motors Acceptance Corporation v. Bob Woods*, CIRA case No. 00051)
29. In light of the above, the arbitrator is of the view that the Complainant has met its initial burden of evidence and that there exists a confusing similarity between the Domain Names and the Complainant’s registered EPSON trade-marks.

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

30. The Complainant submits that the Registrant has no “legitimate interest” in the Domain Names, as this term is defined in paragraph 3.6 of the Policy.
31. 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."

32. The Domain Names feature the registered Canadian trade-mark EPSON, 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.
33. The Domain Names are 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 of subparagraph 3.6(b).
34. The Domain Names are not understood in Canada to be the generic name of the Registrant's wares, services or business in any language. The Registrant cannot rely on subparagraph 3.6(c) of the Policy.
35. There is no evidence before the arbitrator that would suggest that the Domain Names are used in association with any non-commercial activity, such as criticism, review or news reporting. The Registrant cannot rely on subparagraph 3.6(d) of the Policy.
36. The Domain Names are not the legal name of the Registrant, nor are they the name, surname or other reference by which the Registrant was commonly identified. The Registrant cannot rely on subparagraph 3.6(e) of the Policy.
37. The Domain Names are not the geographical name of the location of the Registrant's non-commercial activity or place of business. The Registrant cannot rely on subparagraph 3.6(f) of the Policy.
38. In light of the above, the arbitrator is of the view that there is no evidence that the Registrant has a legitimate interest in the Domain Names.

## BAD FAITH REGISTRATION

39. The Complainant submits that the Registrant has registered the Domain Names 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."

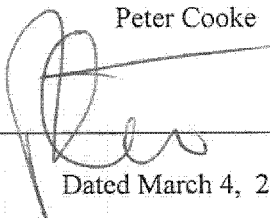
40. The Registrant has not filed a Response.
41. With respect to subparagraph 3.7(b), there is no evidence of the Complainant being prevented from registering these specific Domain Names.
42. Notwithstanding this, the Registrant has, alone or in concert with others, engaged in a pattern of registering domain names which could have the effect of preventing persons who have rights in trade-marks from registering them as Domain Names (in this case in combination with wording relevant to the Complainant's field of business). The Complainant submitted a list of six domain names including the Domain Names at issue which are directly or indirectly controlled by the Registrant and which feature trade-marks that are registered in the name of the Complainant or third parties.
43. 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, *Allergan Inc. v. Hiebert Net Inc.*, BCICAC Case No. 00058).
44. The Complainant has established on a *prima facie* basis that the Domain Names were 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 six (6) registrations are certainly proof of same.
45. With respect to subparagraph 3.7(c), the Complainant must demonstrate that the Registrant registered the Domain Names primarily for the purpose of disrupting the business of the Complainant, who is a competitor of the Registrant.

46. As it has been argued by the Registrant, the parties appear to offer competitive inkjet and laser printer toner cartridge products. In the absence of evidence to the contrary, the arbitrator is inclined to arrive at the conclusion that the parties are competitors.
47. The arbitrator is of the view that the Registrant (i) registered the Domain Names having the effect of preventing the Complainant from registering its EPSON trade-marks as domain names and has engaged in a pattern of registering Domain Names in order to prevent other persons who have rights in marks from registering their marks as Domain Names, and that it (ii) registered the Domain Names primarily for the purpose of disrupting the business of the Complainant who is a competitor of the Registrant.
48. Consequently, the arbitrator is of the view that the Complainant has met its third and final evidential burden.

### CONCLUSION AND DECISION

49. The Complainant has proven, on a balance of probabilities, that the Domain Names are 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.
50. There is no evidence that the Registrant has a legitimate interest in the Domain Names, as described in paragraph 3.6 of the Policy.
51. The Complainant has 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.
52. For these reasons, the Complaint regarding the Domain Names is successful and the arbitrator orders and directs that the registration of the Domain Names be transferred to the Complainant.

Peter Cooke



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Dated March 4, 2009