

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

COMPLAINT

Dispute Number: DCA-1180-CIRA
Domain Name: hasbro.ca
Complainant: Hasbro Inc.
Registrant: 1550507 Ontario Inc.
Registrar: DomainsAtCost Corp.
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

A. THE PARTIES

1. The Complainant is Hasbro Inc. (the “Complainant”), a company incorporated in the state of Rhode Island, and whose principal office is located at 1027 Newport Avenue, Pawtucket, Rhode Island, 02862-1059, United States of America. The Complainant is represented by Bereskin & Parr LLP.
2. The Registrant is 1550507 Ontario Inc. (the “Registrant”), which is indicated as being located in Ottawa, Ontario, Canada.

B. DISPUTED DOMAIN NAME & REGISTRAR

3. The disputed domain name is hasbro.ca (the “Domain Name”).

C. PROCEDURAL HISTORY

4. This is a dispute resolution proceeding initiated pursuant to the *CIRA Domain Name Dispute Resolution Policy* (the “Policy”) and the *CIRA Policies, Rules, and Procedures - CIRA Domain Name Dispute Resolution Rules* (the “Rules”). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of this dispute pursuant to the Policy and the Rules.
5. The Complainant filed its complaint (the “Complaint”) on July 24, 2009. By way of letter dated July 28, 2009, British Columbia International Commercial Arbitration Centre (the “Provider”) found the Complaint to be in compliance with the Policy and Rules.
6. The Registrant did not file a response.
7. In light of the Registrant’s failure to file a response, the Complainant, as per paragraph 6.5 of the Rules, elected to convert the Panel from three members to a single member.

8. On September 29, 2009, the Panel was appointed. As prescribed by paragraph 7.1 of the Policy, the Panel has declared to the Provider that it can act impartially and independently in connection with this matter, and that there are no circumstances known to the Panel which would prevent it from so acting.

D. BASIS FOR DECIDING THE COMPLAINT

9. Since the Registrant has not submitted a response to the Complaint, the Panel shall decide the Proceeding on the basis of the Complaint, as provided by paragraph 5.8 of the Rules.

E. CANADIAN PRESENCE REQUIREMENTS: ELIGIBILITY OF THE COMPLAINANT

10. The Complainant is the owner of the Canadian trade-mark registration HASBRO, Registration No. TMA 128,859. Pursuant to paragraph 1.4 of the Policy, and paragraph 2.1(q) of the *CIRA Policies, Procedures and Guidelines: Canadian Presence Requirements For Registrants*, the Panel is satisfied that the Complainant is eligible to initiate these proceedings.

F. THE POSITIONS OF THE PARTIES

The Complainant's Position

11. The Complainant is a worldwide leader in children and family leisure time products. The Complainant is behind such famous products as MONOPOLY, TRIVIAL PURSUIT, MR. POTATO HEAD, TRANSFORMERS and PLAY DOH. The Complainant is known internationally, and its products are sold throughout the world, including in Canada.
12. The trade-mark HASBRO is a famous coined trade name and mark, and has been used in Canada, the United States and throughout the world for over 50 years. The mark is one of the most recognized marks.
13. The Complainant's annual sales in Canada have been in excess of \$125 Million since 2003 and have increased every year. Its Canadian sales in 2008 were in excess of \$210 Million.
14. The Complainant has strong Canadian common law rights in the trade-mark and trade name HASBRO through extensive use in Canada for over 50 years.
15. The Complainant is the owner of the following Canadian trade-mark registrations: HASBRO & Design (Reg. No. TMA248,061 dated July 18, 1980), HASBRO & SMILE Design (TMA532,547 dated September 12, 2000), HASBRO.COM & Design (TMA678,522 dated December 18, 2006) and HASBRO (TMA128,859 dated November 23, 1962) (collectively, the "HASBRO Trade-marks").

16. The Complainant's HASBRO toys and games are extensively promoted and advertised in Canada through print advertising, television commercials, websites, and through displays and point-of-purchase material at retail locations.
17. The Complainant and its Canadian subsidiary Hasbro Canada Corporation have spent annually well in excess of \$20 Million CDN on advertising and promoting its wares in association with the HASBRO trade-mark in Canada since 2003, with such spending exceeding \$35 Million CDN in 2008.
18. The Complainant also has a strong presence on the Internet in association with the HASBRO mark. It owns the domain name hasbro.com, which was registered in November 1994. The site averages over 1,000,000 visitors per month.
19. The Respondent registered the Domain Name on January 9, 2003, according to CIRA WHOIS records, and thereafter began to operate a corresponding website in association with the Domain Name.
20. The Respondent operates a pay-per-click website with link titles such as Hasbro Toys Canada, Hasbro Toys, Games, Nerf, Fur Real Friends, Littlest Pet Shop, Indiana Jones, Star Wars and Toys.
21. The Complainant offers goods in connection with the trade-marks NERF, FURREAL FRIENDS, INDIANA JONES, and STAR WARS, and is the owner of the trade-marks NERF, LITTLEST PET SHOP and FURREAL FRIENDS. Hasbro is the exclusive licensee of the INDIANA JONES and STAR WARS trade-marks for toy products.
22. The Respondent's website includes sponsored links to websites promoting the sale of the Complainant's goods, as well as goods and services that compete with, or rival, those goods offered by the Complainant.
23. The Domain Name is confusingly similar with the HASBRO Trade-marks in which the Complainant had rights prior to the registration date of the Domain Name, and continues to have such rights.
24. The Registrant has no legitimate interest in the disputed domain name.
25. The Registrant registered the Domain Name in bad faith in that it registered the Domain Name primarily for the purpose of disrupting the business of the Complainant, a competitor. The Respondent has also engaged in a pattern of unauthorized domain name registrations, having registered domain names such as ctvsports.ca, famousplayer.ca and jcpenny.ca.
26. The Complainant has requested the transfer of the Domain Name.
27. As previously noted, the Registrant did not file a response.

G. DISCUSSION & REASONS

28. In accordance with paragraph 4.1 of the Policy, to succeed in this proceeding, the Complainant must prove, on a balance of probabilities, that:

- (a) the Registrant's 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 Rights¹; and
- (b) the Registrant has registered the Domain Name in bad faith as described in paragraph 3.7 of the Policy;

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 of the Policy.

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 - PARAGRAPH 3.4

29. In order to satisfy this branch of the test, the Complainant must demonstrate (i) that it has rights in a mark, (ii) that the rights in its mark predate the registration date of the Domain Name, and (iii) that the Domain Name is confusingly similar with the disputed domain name.

Rights in a Mark

30. The Complainant is the owner of the HASBRO Trade-marks. Accordingly, as per paragraph 3.2(c) of the Policy, the Complainant has rights in these marks.

Prior Rights

31. The Domain Name was registered on January 8, 2003.

32. Save for Registration No. TMA678,522, the HASBRO Trade-marks all matured to registration prior to the registration date of the Domain Name.

¹ The terms "Rights", "Mark" and "Confusingly Similar" are defined terms under the Policy.

33. Where a complainant relies upon a trade-mark registered prior to the domain name registration date, the Policy does not require or permit a Panel to go behind the registration to determine whether the mark is valid or invalid based upon lack of distinctiveness or non-use.
34. The Panel concludes that the Complainant's rights in its marks predate the registration date of the Domain Name. Therefore, the Complainant has, to the satisfaction of the Panel, established rights that precede the domain name registration date. Given that the Panel has made its finding of prior rights, it will not consider whether the Complainant has demonstrated prior common law rights in connection with the mark that is the subject of Registration No. TMA678,522.

Confusingly Similar

35. As per paragraph 3.4 of the Policy, a domain name will be found to be confusingly similar with a mark if the domain name so nearly resembles the mark in appearance, sound or in the ideas suggested by the mark so as to be likely to be mistaken for the mark.
36. Pursuant to paragraph 1.2 of the Policy, a domain name is defined as the second level domain (the portion that immediately precedes the dot-ca suffix).
37. The test to be applied when considering "confusingly similar" is one of first impression and imperfect recollection. The Complainant must prove, on a balance of probabilities, that a person, as a matter of first impression, knowing the Complainant's corresponding marks only, and having an imperfect recollection of the marks, would likely confuse the Domain Name for the Complainant's marks based upon the appearance, sound or the ideas suggested by the mark (*Government of Canada, on behalf of Her Majesty the Queen in Right of Canada v. David Bedford*, BCICAC Case No. 00011).
38. It should be noted that the test for confusion under the Policy is not the same test for confusion set out under the Canadian *Trade-marks Act*. Under the Section 6(5) of the *Trade-mark Act*, when assessing the likelihood of confusion between marks, the factors to consider are as follows: (a) the inherent distinctiveness of the marks and the extent to which they have become known; (b) the length of time the marks have been in use; (c) the nature of the wares, services, or businesses; (d) the nature of the trade; (e) the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them; and (f) the surrounding circumstances.
39. In contrast, the Policy provides that confusion is established if a domain name so nearly resembles a mark in appearance, sound or in the ideas suggested. This is similar to the test set out under Section 6(5)(e) of the *Trade-marks Act*. However, the remaining factors as set out under the *Trade-marks Act* do not apply to the assessment of confusion under the Policy. The Policy's summary proceedings are ill-suited for the in-depth and traditional confusion analysis contemplated by the *Trade-marks Act*.

40. The domain name hasbro.ca is identical to HASBRO, Registration No. TMA 128,859 as the second level domain is comprised exclusively of this mark. Further, the disputed domain name incorporates the whole of the formative element of the remaining HASBRO Trade-marks. Further enhancing a likelihood of confusion is the highly distinctive nature of the HASBRO trade-mark, which is a coined mark that has been used so extensively that it has become very well known if not famous.
41. The Panel therefore concludes that the Domain Name is confusingly similar with the Complainant's marks, given that hasbro.ca so nearly resembles the HASBRO Trade-marks in appearance, sound and in the ideas suggested so as to be likely to be mistaken for these marks.

Conclusion - Confusion

42. The Panel finds that the Domain Name is confusingly similar with the HASBRO Trade-marks in which the Complainant had rights prior to the registration date of hasbro.ca, and continues to have such rights.

BAD FAITH REGISTRATION

Paragraph 3.7(c) - Disrupt A Competitor

43. The Complainant has alleged that the Domain Name was registered in bad faith pursuant to paragraph 3.7(c) of the Policy.
44. As per paragraph 3.7(c) of the Policy, the Complainant must establish the following:

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.
45. Accordingly, the Complainant must establish (i) that the Registrant and the Complainant are competitors, and (ii) that the Registrant's use of the Domain Name is disrupting the Complainant.

The Registrant's Website

46. A respondent's pointing of a domain name to a pay-per-click website that displays links to websites of businesses that offer goods and services that compete with, or rival, those goods and services offered by a complainant may constitute evidence of bad faith. In this case, however, the Domain Name resolves to the Registrar's default page and not a website specifically designated by the Respondent. The issue, then, is whether the pointing of a domain name to the Registrar's default page is sufficient to establish bad faith as per

paragraph 3.7(c).

47. The Panel is of the view that a respondent is responsible for the content of any webpage hosted at the disputed domain name. The Respondent cannot evade this responsibility by means of its contractual relationship with the Registrar. The relationship between the Respondent and the Registrar does not affect the rights of the Complainant under the Policy. The Respondent controls the Domain Name and therefore had the power to instruct the Registrar to remove the parking page. To conclude otherwise would provide a domain name owner with an opportunity to legitimize what is an unauthorized domain name registration.
48. Therefore, the Panel concludes that for the sake of the Policy, the Respondent is a competitor of the Complainant. Further, given that the Domain Name resolves to a website that includes links to competitor sites of the Complainant, and in light of the unauthorized use of the Complainant's mark, which results in consumers being misled as to source or sponsorship, the Panel concludes that the use of the Domain Name is disruptive to the Complainant.
49. Notwithstanding the foregoing, the Panel notes that bad faith can be established by demonstrating that the mere use of a domain name is likely to cause confusion among Internet users as to affiliation or sponsorship. The Panel is of the view that the use of hasbro.ca is likely to confuse consumers as it is confusing with the HASBRO Trade-marks and resolves to a website with links related to the Complainant's offering of goods. On this basis alone, the Panel finds bad faith.
50. As per paragraph 3.7(c) of the Policy, the Panel finds that the Registrant registered the Domain Name for the purpose of disrupting the business of the Complainant, a competitor.

Pattern of Unauthorized Registrations

51. As per paragraph 3.7(b) of the Policy, the Complainant must establish the following:

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.
52. The Respondent is the owner of multiple domain names that contain, or are comprised of, third party marks, including ctvsports.ca, jcpenny.ca, tigerwoods.ca, torontoraptors.ca, toronto-raptors.ca, montreallexpos.ca and exxon.ca.
53. The Respondent has not provided a response, and therefore the Panel must conclude that these registrations are not authorized.

54. The Policy does not define the term “pattern”. As few as two domain name registrations, including the disputed domain name, is sufficient to establish that the Registrant has engaged in a “pattern” of unauthorized registrations. In this case, the Complainant has established that the Respondent’s registrations constitute a pattern.
55. Further, given that the Domain Name is comprised exclusively of the HASBRO trade-mark, the Panel finds that the Complainant was prevented from registering the Domain Name.
56. The Panel, however, has difficulty with the requirement that it be shown that the Complainant was prevented from registering the disputed domain name.
57. Paragraph 3.7(b) of the Policy should be given an expansive interpretation that is consistent with the intention of the Policy to provide redress from abusive domain name registrations.
58. Cybersquatters routinely register multiple domain names that constitute intentional misspellings of owner marks (i.e., typosquatting), or register domain names that may not otherwise appeal to a mark owner. In these cases, a registrant has not sought to “prevent” a complainant mark owner from registering certain domain names, nor has a complainant been prevented from registering said domains. Rather, the registrant may be stockpiling these domains, or using them to redirect end users to unaffiliated sites with a view to reaping a commercial advantage by capitalizing on end user confusion.
59. In such a case, to conclude that a registrant could escape the reach of paragraph 3.7(b) of the Policy on the basis that an intention to deprive the mark holder of the domain name cannot strictly be shown only encourages a registrant to misappropriate third party marks as domain names that would not have otherwise been sought to be secured by a complainant.
60. This could not have been the intention of the Policy, which is designed to address clearly abusive and unauthorized domain name registrations in a cost-effective and timely manner without recourse to costly and lengthy court proceedings.
61. Of course, the Panel may consider the surrounding circumstances when considering bad faith. Nevertheless, with respect to the interpretation of paragraph 3.7(b) of the Policy, the approach should be a pragmatic one, sensitive to the practices of cybersquatters and the commercial realities related to domain name registrations.
62. Given the expansive interpretation, the Panel believes should be accorded the Policy, an intention on the part of a registrant to obstruct a mark owner together with a pattern of unauthorized domain name registrations should be sufficient to satisfy paragraph 3.7(b) of the Policy. Indeed, this has been a position taken in cases decided pursuant to the *Uniform Dispute Resolution Policy*, which incorporates similar language.
63. Accordingly, the Panel is satisfied that the Complainant has met the test prescribed by paragraph 3.7(b) of the Policy.

LEGITIMATE INTEREST - PARAGRAPHS 4.1(C) & 3.6

64. The final element of the test set out in the Policy is to determine whether or not the Registrant has a legitimate interest in the Domain Name.
65. As per paragraph 4.1 of the Policy, the Complainant must provide “some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.6”.
66. Once this onus has been discharged by the Complainant, the Registrant may still succeed if it can show, on a balance of probabilities, that it has a legitimate interest in the Domain Name pursuant to paragraph 3.6, which provides as follows:
 - (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.
67. The Panel finds that the Complainant has provided sufficient evidence that the Registrant does not have a legitimate interest in the disputed domain name as prescribed by paragraph 3.6 of the Policy.
68. As the Registrant has not replied to the Complaint, it has not proven, on a balance of probabilities, that it has a legitimate interest in the Domain Name.

69. Accordingly, the Panel finds that the Registrant does not have a legitimate interest in the Domain Name.

Decision & Order

70. For the reasons set out herein, the Panel decides this dispute in favour of the Complainant.

71. The Panel therefore orders, pursuant to paragraph 4.3 of the Policy, that the domain name hasbro.ca be transferred from the Registrant to the Complainant.

Dated at Ottawa, Ontario, Canada, this 28th day of October, 2009.



Eric Macramalla
Sole Panelist