

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number: DCA-1207-CIRA
Domain Name: www.americanidol.ca
Complainant: FreemantleMedia North America Inc.
Registrant: Dave Leather, aka Dave Vanstone
Arbitrator: David Wotherspoon
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

A. THE PARTIES

1. The Complainant is FreemantleMedia North America Inc. (the "Complainant."). The Complainant is a company with a principal office at 4000 West Alameda Avenue, 3rd Floor, Burbank, California 91505 in the United States of America.
2. The Registrant is Dave Leather, an individual.

B. THE DOMAIN NAME

3. The Domain at issue is www.americanidol.ca (the "Domain").
4. The Domain was registered on January 9, 2003.

C. PROCEDURAL HISTORY

5. The British Columbia International Commercial Arbitration Centre ("BCICAC") is a recognized service provider pursuant to paragraph 1.5 of the CIRA Domain Name Dispute Resolution Policy v. 1.2 (the "Policy") of the Canadian Internet Registration Authority ("CIRA").
6. The Complainant filed a complaint in relation to the Domain pursuant to the Policy on December 18, 2009 ("the Complaint").
7. In a letter dated December 21, 2009, BCICAC as Service Provider, confirmed compliance of the Complaint and commencement of the dispute resolution process.
8. The BCICAC made attempts to contact the Registrant pursuant to paragraph 2.1 of the CIRA Domain Name Dispute Resolution Rules v. 1.3 ("the Rules"), but neither the BCICAC nor I have received any response from the Registrant.
9. As a result, and as permitted under Rule 6.5, the Complainant has elected to convert from a panel of three to a single arbitrator. I have been appointed as the sole arbitrator

pursuant to Rule 6.5. The process followed in appointing an arbitrator complied with the requirements of Rules 6.5 and 6.8.

10. I have reviewed the material submitted by the Complainant and I am satisfied that it is an eligible Complainant under paragraph 1.4 of the Policy and the Rules.
11. I have received no further submissions from either party since my appointment as arbitrator.
12. Pursuant to Rule 12.2, in the absence of any exceptional circumstances, I am required to submit my decision to BCICAC by February 25, 2010.
13. I am not aware of any other legal proceeding or other arbitration in relation to the Domain which would give rise, under Rule 13.2, to a need to alter the progress of these proceedings.

D. FACTS

14. The Complainant's submissions set out the following facts.

The American Idol Program

15. The Complainant is a related company of FreemantleMedia Limited ("FreemantleMedia"). FreemantleMedia is a leading international creator, producer, and distributor of television entertainment. FreemantleMedia's programs include the Idol franchise of programs, which first attained success with the UK program, Pop Idol.
16. In early 2002, the Complainant and Simon Fuller's 19 Television Company entered into an agreement with US TV network Fox Broadcasting Company ("Fox") whereby Fox obtained the rights to broadcast an American version of the Pop Idol program. The Complainant's evidence establishes that Fox had issued media releases promoting the program, entitled "American Idol: The Search for a Superstar", by as early as April 25, 2002. (Exhibit #4).
17. The American Idol program (the "Program") premiered on June 11, 2002. By September 2002, the Program's "talent show finale" and related special episodes attracted 5.5 million and 4.5 million Canadian viewers on September 4th and September 24th, respectively.
18. The Program has also had extensive coverage on the Canadian website www.ctv.ca beginning in September of 2002.
19. The Complainant also operates the website www.americanidol.com to promote the Program.

The Complainant's Trade-Marks

20. The Complainant owns two Canadian trade-mark registrations relevant to this proceeding:
 - (a) American Idol Design, TMA 656609, registered January 16, 2006; and
 - (b) American Idol & Design, TMA 694765, registered August 24, 2007(collectively, the "Marks").
21. TMA 656609 mark consists of the two words "AMERICAN IDOL" (the "Word Mark"). TMA 694765 is the Design Mark featuring the words "American Idol" in a light-coloured handwritten script located inside a dark oval border (the "Design Mark").
22. The Complainant has used the Design Mark and Word Mark continuously since 2002 while promoting and broadcasting the Program as described above.

The Registration

23. The Registrant is an individual. According to the Domain's CIRA registration, the Registrant's mailing address is 180 Eaglemere Drive, Winnipeg, Manitoba, Canada. The Registrant registered the Domain on January 9, 2003 without the Complainant's permission.
24. As of February 14, 2008, the Domain resolved to a pay-per-click website which contained links to rival networks (for example, the Canadian Broadcasting Corporation, or "CBC") and rival programs (for example, "Jpod"), among other things.
25. In a letter dated February 14, 2008, the Complainant, through counsel, informed the Registrant of its prior rights in the Marks and requested that the Registrant cease and desist from all unauthorized use or display of the Marks, including use of the Domain.
26. In an email dated February 19, 2009, the Registrant agreed to transfer the Domain to the Complainant upon the Complainant's request of transfer.
27. The Registrant never finalized the transfer of the Domain name to the Complainant.

E. COMPLAINANT'S SUBMISSIONS

(I) Confusingly Similar

Rights

28. The Complainant contends that, as owner of the Marks, the Complainant has and continues to have Rights in the Marks under paragraph 3.3(b) of the Policy.
29. The Complainant also submits that the Complainant has used the Marks as defined under paragraph 3.3(a) beginning in 2002 and prior to the registration of the Domain in 2003,

and that the Complainant's rights in the Marks therefore predates the 2003 registration as required under the Policy.

Confusingly Similar

30. The Complainant asserts that the Domain is confusingly similar to the Marks.
31. The Complainant cites the previous Panel decision *Government of Canada, on behalf of Her Majesty the Queen in Right of Canada v. David Bedford*, BCICAC Case No. 00011 to argue that the test for "confusingly similar" is "one of first impression and imperfect recollection." An Internet user who has knowledge or recollection of the Mark might easily mistake the Domain as being somehow affiliated to or owned by the Complainant: *Canadian Broadcasting Corporation/Société Radio-Canada v. William Quon*, BCICAC Case No. 00006 ("Quon").
32. The Complainant also contends that the Registrant cannot avoid confusion by appropriating the Complainant's entire mark in the Domain: *Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)*, BCICAC Case No. 00020 ("Glaxo").
33. The Complainant submits that the Domain should be considered in exclusion of the "dot-ca" suffix, pursuant to paragraph 1.2 of the Policy. Accordingly, the Complainant asserts that, under paragraphs 3.4 and 3.2 of the Policy, the Domain is identical to the Word Mark, and thus meets the standard to be considered confusingly similar. Furthermore, the Complainant submits that the Domain is identical to the Design Mark notwithstanding that the Domain does not incorporate the design element of the Design Mark, which is of no practical significance: *The Black and Decker Corporation v. J. Chapnik Trust - (100%)*, BCICAC Case No. 00069 ("Black and Decker").

(II) Bad Faith

34. The Complainant further asserts that the Domain was registered in bad faith, in line with paragraph 3.1(c) of the Policy, which states:
 - (c) the Registrant has registered the domain name in bad faith as described in paragraph 3.7.
35. The Complainant cites paragraph 3.7 of the Policy to argue that the Registrant registered the Domain primarily for the purpose of disrupting the Complainant's business, the Complainant can be considered a competitor of the Registrant, and therefore the Registrant registered the Domain in bad faith.

Confusion and Diversion of Internet Traffic

36. The Complainant argues that the Domain is identical to the Complainant's Marks and is therefore likely to cause confusion among Internet users as to affiliation or sponsorship (*Bell Canada v. Archer Enterprises*, BCICAC Case No. 00038) which therefore puts the Complainant's business reputation at risk: *Glaxo*, supra.

37. In addition, the Complainant also cites *Amazon.com Inc. v. David Abraham*, BCICAC Case No. 00018 (“*Abraham*”) to argue that the Registrant has engaged in the requisite competition and disruption of business because the Registrant has “competed” for Internet traffic by capitalizing on the “consumer confusion” described above.
38. The Complainant cites *Credit Counselling Society of British Columbia v. Solutions Credit Counselling Service Inc.*, BCICAC Case No. 00031, to argue that the Panel can infer the requisite bad faith intent where the Registrant fails to explain its registration of the Domain.
39. Therefore, the Complainant submits that this potential consumer confusion as to affiliation or endorsement is sufficient to establish bad faith under the Policy.

Pay-Per-Click Websites

40. The Complainant cites numerous awards¹ decided under the Policy and the Uniform Domain Name Dispute Resolution Policy (“UDRP”) to argue that the pointing of domain names to pay-per-click websites constitutes *prima facie* evidence of bad faith under paragraph 3.7(c) of the Policy.
41. The Complainant argues that the Registrant is a deemed competitor by virtue of the pay-per-click website at the Domain, and that, as in *Sleep Country Canada Inc. v. Pilfold Ventures Inc.*, CDRP Number 00027 (“*Sleep Country*”) the Registrant’s pay-per-click website links to websites offering goods and services that “rival and compete with the Complainant.” The Complainant also points to the search engine located on the website, which “allows users to search for links to competitor sites.” The Complainant says that this therefore satisfies the competition requirement under s. 3.7(c).

Surrounding Circumstances

42. The Complainant also reinforces its bad faith arguments by arguing that the Panel may infer the Registrant’s purpose from the surrounding circumstances: *Quon*, supra.
43. In summary, the Complainant argues that the Complainant’s trade-mark registrations, the Mark’s popularity, and the Registrant’s “wholesale incorporation” of the said Marks in the Domain name all reinforce a finding of bad faith.
44. Finally, the Complainant submits that the Registrant’s agreement to transfer the Domain “demonstrates that the Registrant knew that the [Domain] was unauthorized”.

¹ *Sleep Country Canada Inc. v. Pilfold Ventures Inc.*, supra; *Lee Valleys Tools Limited v. Pilfold Ventures Inc.*, Resolution Canada Case No. 00040; *Reitmans Canada Limited/Reitmans Canada Limitee v. Pilfold Ventures Inc.*, BCICAC Case No. 00032; *The Men’s Warehouse Inc. v. Wade Traversy*, Resolution Canada Case No. 00023; *Fresh Intellectual Properties Inc. v. Sweets and Treats*, BCICAC Case No. 00033; *Canada Post Corporation v. Marco Ferro*, BCICAC Case No. 00042.

(III) No Legitimate Interest

45. The Complainant finally asserts that the Registrant has no legitimate interest in the Domain. To demonstrate this, the Complainant contends that it must only demonstrate some evidence that the Registrant has no legitimate interest.
46. The Complainant argues that there is no evidence that the Registrant meets any of the criteria for demonstrating legitimate interest set out in paragraph 3.6 of the Policy.
47. The Complainant first asserts that the Registrant has not used the Domain as a Mark “for the purpose of distinguishing wares, services or business of [the] person or predecessor or a licensor of that person or predecessor from the wares, services, or businesses of another person” as set out in paragraph 3.6(a) of the Policy, and therefore the Registrant does not have rights in the Domain. The Complainant also argues that the Registrant did not act in good faith or for a *bona fide* purpose, and that it is difficult to conceive of any plausible use of the Domain that would be legitimate.
48. Second, the Complainant claims that the Domain is neither used in good faith association with any wares, services of business, nor is it clearly descriptive in any relevant sense, as per paragraph 3.6(b) of the Policy.
49. Third, the Claimant argues that the name is not generic of any wares, services, or businesses, nor has the Registrant used it in good faith or for a *bona fide* purpose, as set out in paragraph 3.6(c) of the Policy.
50. Fourth, the Claimant argues that paragraph 3.6(d) of the Policy does not apply, as the Registrant has not used the Domain in association with a non-commercial activity, nor in good faith.
51. Fifth, the Complainant contends that the Domain is not a name, surname or reference by which the Registrant is commonly identified, and as such does not qualify under paragraph 3.6(e).
52. Sixth, the Complainant concludes that the Domain “American Idol” is neither a geographical name nor location where the Registrant carries on business, and hence the Registrant cannot claim the benefit of paragraph 3.6(f).
53. Given these six arguments, the Complainant submits that it has demonstrated, to the standard required under the Policy—“some evidence”—that the Registrant has no legitimate interest in the Domain.

F. DISCUSSION AND FINDINGS

54. In considering the substance of the Complaint, it is necessary to review the standard set out in the Policy. At paragraph 4.1 of the Policy, it states 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.

55. I will consider each of these factors, in turn.

(I) Confusingly Similar

56. A paragraph 3.4 the Policy states that:

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.

57. Under paragraph 3.2 of the Policy, a "Mark" is defined as:

3.2 Mark. A "Mark" is:

- (a) a trade-mark, including the word elements of a design mark, or a trade name that has been used in Canada by a person, or the person's predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person;

...

- (c) a trade-mark, including the word elements of a Design Mark, that is registered in CIPO;

58. Paragraph 3.3 of the Policy establishes what is considered a right, stating:

3.3 Rights. A person has "Rights" in a Mark if:

- (a) in the case of paragraphs 3.2 (a) and 3.2(b), the Mark has been used in Canada by that person, that person's predecessor in title or a licensor of that person or predecessor;
- (b) in the case of paragraph 3.2(c), the Mark is registered in CIPO in the name of that person, that person's predecessor in title or a licensor of that person . . .

59. Paragraph 3.5 of the Policy defines the terms "use" or "used" for the purposes of establishing rights in a Mark:

(a) wares:

- (i) if, at the time of the transfer of the property in or possession of the wares in the normal course of trade, the Mark is marked on the wares themselves or on the packages in which they are distributed or the Mark is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred; or

- (ii) at the time the wares are exported from Canada, if the Mark was marked in Canada on the wares or on the packages in which they are contained and the wares or packages are still marked when exported;
 - (b) services, if the Mark is used or displayed in the performance or advertising of those services;
 - (c) a business, if the Mark is displayed in the operating, advertising or promoting of the business . . .
60. Additionally, paragraph 1.2 of the policy indicates that:
- 2.2 ... 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.
61. Given the evidence presented by the Complainant, I find that it has established that the Marks are each a "Mark" under the definition in paragraphs 3.2(a) and 3.2(c) of the Policy. I have further concluded that the Domain www.americanidol.ca, considered without its suffix, is identical to, and hence confusingly similar with the Word Mark. Finally, I have also concluded that the Domain has incorporated the word element of the Design Mark, and is therefore confusingly similar with the Design Mark.
62. I find that the Complainant first acquired the requisite rights in the Marks by June 18, 2002, when Fox affiliate HUTV began broadcasting the Program "American Idol: the Search for a Superstar" to Canadian audiences, as evidenced by the Complainant's Exhibit #5. I find that these broadcasts constituted use of the Marks under paragraph 3.5(b) of the Policy. Therefore, the Complainant's Rights in the Marks arose on June 18th, 2002, and predate the the Registrant's registration of the Domain on January 9, 2003.
63. I therefore find that the Complainant has met its burden under paragraph 4.1(a), and that the Registrant's Domain 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.
- (II) Bad Faith Registration**
64. Pursuant to paragraph 4.1 of the Policy, the Complainant must also demonstrate, on a balance of probabilities that:
- (b) the Registrant has registered the domain name in bad faith as described in paragraph 3.7;
65. Paragraph 3.7 of the Policy enumerates the three indicia of bad faith:
- 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:
- (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;

- (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.

66. The above list is exhaustive. Thus, if the Complainant cannot establish bad faith within the bounds of one of these three sub-paragraphs, then a finding of bad faith is not open to me. However, if the Complainant establishes any one of the three, that is sufficient.

67. As has been identified in previous awards, demonstrating actual bad faith is quite difficult:

[I]t is quite difficult, usually, if not impossible, to actually show bad faith with concrete evidence. The Panel is therefore of the opinion that it can take into consideration surrounding circumstances and draw inferences to determine whether or not the Registrant's actions are captured by paragraph 3.7.

Canadian Broadcasting Corporation/Société Radio-Canada v. William Quon, CDRP
Dispute Number 00006. (*CBC v. William Quon*)

68. The Complainant argues that the Domain is identical to the Complainant's Marks and is therefore likely to cause confusion among Internet users as to affiliation or sponsorship, which therefore puts the Complainant's business reputation at risk.

69. I find it unnecessary to decide whether confusion and the alleged risk to business reputation constitutes a disruption and therefore bad faith under the Policy in this case.

70. However, the Complainant's evidence does clearly establish that the Domain and its related search result pages contained links to, among other things, the Canadian Broadcasting Corporation and its television program "Jpod" at www.cbc.ca/jpod, as well as "ABC News.com", both of which are rival networks to the Complainant's broadcast business partner Fox. As in *Sleep Country*, I find that this linking to a direct competitor of the Complainant constitutes a "disruption" of the Complainant's business.

71. In addition, I also find that the Domain competes for Internet traffic and therefore capitalizes on consumer confusion as in *Abraham*.

72. As in many cases, there is no direct evidence pointing to the Registrant's purpose for registering the Domain.

73. I do not draw any inference from the Registrant's agreement to transfer the Domain. Such an agreement, without more, does not evidence any past intent on the part of the Registrant.
74. However, I find that the popularity of the Marks, as well as the Registrant's "wholesale incorporation" of the said Marks, lead to an inference that the Registrant registered the Domain "primarily for the purpose" of disrupting the Complainant's business as set out above.
75. I therefore find that the Complainant has established, on a balance of probabilities that the Registrant registered the Domain primarily for the purpose of disrupting the business of the Complainant.
76. Thus, I find that the Complainant has established, on a balance of probabilities, in line with paragraph 3.7 of the Policy, that the Registrant registered the Domain in bad faith.

(III) No Legitimate Interest

77. Under paragraph 4.1(c) of the Policy, the Complainant must provide some evidence that the Registrant had no legitimate interest in the Domain. The six categories of legitimate interest under the Policy are laid out in paragraph 3.6, which states:

- 3.6 Legitimate Interests. 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 Registrants includes, but is not limited to, use to identify a web site.

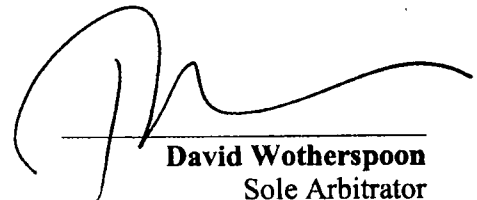
78. The evidence presented by the Complainant is sufficient to meet its burden to present some evidence that the Registrant has no legitimate interest under any of the categories of paragraph 3.6 of the Policy.
79. As the Registrant has not provided a reply, the Complainant has met the burden assigned to it under paragraph 4.1(c), and I accordingly find that the Registrant has no legitimate interest in the Domain.

G. CONCLUSION

80. I have found that the Complainant has met all of the burdens assigned it under paragraph 4.1 of the Policy. It has demonstrated, on a balance of probabilities that the Domain is confusingly similar to the Complainant's Marks, in which it had rights since before the registration, and continues to have rights. It has demonstrated, on a balance of probabilities, that the Registrant registered the Domain in bad faith. Finally, the Complainant has provided some evidence, sufficient to satisfy me that the Registrant has no legitimate interest in the Domain, and the Registrant has not presented any evidence to rebut this.
81. I accordingly find that the Complainant has established its claim, and should have the order that it seeks.

H. ORDER

82. I order, in accordance with 4.3 of this Policy that the domain www.americanidol.ca be transferred to the Complainant.



David Wotherspoon
Sole Arbitrator
February 25, 2010