CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number:	DCA-1246-CIRA
Domain Names:	ENGADGET.ca, LUXIST.ca, WEBLOGSINC.ca
Complainant:	AOL Canada Inc.
Registrant:	L. Jason Anderson, Liam Grouse
Registrar:	DomainsAtCost Corp.
Panel:	Michael D. Manson
Service Provided:	British Columbia International Commercial Arbitration Centre

DECISION

A. THE PARTIES

1. The Complainant is AOL Canada Inc., 55 St. Claire Avenue West, 7th Floor, Toronto, Ontario, M4V 2Y7, Canada.

2. The Registrant is two individuals, L. Jason Anderson and Liam Grouse, who have an e-mail address at lgrouse@gmail.com. Otherwise, their address is unknown. Attempts to deliver the complaint to the Registrant have been unsuccessful, notwithstanding attempts by courier and e-mail. No response to the Complaint was filed or served by the Registrant.

B. THE DOMAIN NAMES AND REGISTRAR

3. The domain names at issue are ENGADGET.ca, LUXIST.ca, and WEBLOGSINC.ca. The domain names are registered with DomainsAtCost Corp.

C. PROCEDURAL HISTORY

4. The Complainant submitted this complaint to the British Columbia International Commercial Arbitration Centre as service provider in respect of the *CIRA Domain Name Dispute Resolution Policy* of the Canadian Internet Registration Authority (CIRA). The Service provider attempted to serve notice of the Complaint to the Registrant, as required by the *CIRA Rules*, paragraph 4.3. No response to the complaint was received from the Registrant. The Complainant elected to have the complaint heard by a single panelist as permitted under paragraph 6.5 of the *CIRA Rules*. The Service Provider elected Michael Manson as the single panel member for this complaint.

D. PANEL MEMBER IMPARTIALITY AND INDEPENDENCE STATEMENT

5. As required by the *CIRA Rules*, paragraph 7.1, I, Michael Manson, have declared to the Provider that I can act impartially and independently in respect of this matter as there are no circumstances known to me which would prevent me from so acting.

E. BASIS FOR DECIDING THE COMPLAINT

6. Since the Registrant has not submitted a Response to the Complaint, paragraph 5.8 of the *CIRA Domain Name Dispute Resolution Rules* applies, namely that the panel shall decide the proceeding on the basis of the Complaint filed.

F. FACTUAL BACKGROUND

7. The BCICAC has certified that the Complainant has complied with the formal requirements of the CDRP under the Resolution Rules.

8. The BCICAC has certified and I accept that it has complied with the provisions of the CDRP and the Resolution Rules in attempting to deliver the complaint to the Registrant by courier and e-mail. Pursuant to paragraph 2.6 of the Resolution Rules, the Registrant is deemed to have received the Complaint and has failed to respond to the Complaint.

9. Materials submitted by the Complainant shows that the Complainant satisfies *CIRA's* Canadian presence requirement for registrants, being a Canadian corporation incorporated under the laws of Canada, as set out in paragraphs 1 and 5 of the Complaint.

10. The Materials submitted by the Complainant include a Complaint, together with Annexes to the Complaint, as evidence in support of representations made in the Complaint. Complainant does not have registered trade-marks in Canada upon which it relies, but rather relies on its exclusive licensed rights in Canada to the trade-marks ENGADGET, LUXIST, and WEBLOGS INC ("the marks"), owned by the Complainant's parent company, AOL Inc. and AOL Inc.'s subsidiary, Weblogs, Inc. LLC (ENGADGET and LUXIST owned by AOL Inc. and WEBLOGS INC owned by Weblogs, Inc. LLC). The particulars of the trade-mark registrations in the United States and in other countries attached as exhibits F and G to the Annex in fact appear to show that the ENGADGET and LUXIST marks are owned by a predecessor to AOL Inc., namely AOL LLC Limited. As there are no registered rights in Canada for the trade-marks being relied upon, the Complainant has exclusively relied on common-law rights in the trade-marks in this country, pursuant to Section 7(b) of the Canadian *Trade-marks Act*.

11. In order to be able to rely on Section 7(b) of the *Trade-marks Act*, an owner of the trade-marks or exclusive licensee there under must be able to establish three criteria:

(a) That the owner has established a reputation for the trade-mark(s) in Canada, as used in association with wares and/or services by the owner or a licensee of the owner;

(b) That the alleged infringer has used the trade-mark or a trade-mark likely to be confusing therewith in such a manner as to be likely to deceive the relevant public as to the source of those wares and/or services;

(c) That damage has been caused by the alleged infringer's activities.

Ciba Geigy Canada Ltd. v. *Apotex Inc.,* (1992) 44 C.P.R. (3d) 289, @ 296-297 (S.C.C.)

12. Some case law in Canada has suggested that if the first two criteria have been established in a passing off case, then damage will be presumed to flow as a result of the first two elements having been proven. In the circumstances of this proceeding, I need not decide whether or not damage should be presumed or not, for the reasons set forth below.

13. I accept the AOL is a well known global internet services and media company, and that global web services are provided by AOL through its online "blog" services. Further, the evidence shows that AOL has made use of the ENGADGET.com website in Canada since March, 2004. and the website LUXIST.com in Canada since December, 2004, which has focused on upscale goods and services, including information, commentary and opinions on lifestyle items and services. Further, I also accept that Weblogs, Inc. has operated WEBLOGSINC.com since September, 2003 and that AOL Inc.'s predecessor, AOL LLC, acquired Weblogs, Inc. in October, 2005.

14. It is important to note that with respect to the evidence provided, much of that evidence relates to alleged use of the websites and alleged trade-marks ENGADGET, LUXIST and WEBLOGSINC since 2006 (paragraph 11 of the complaint), which is subsequent to the February, 2005 registration by the Registrant of the domain names in issue in this proceeding.

15. It is also important that certain statements made in the Complaint do not provide any evidence in support of those statements, including allegations in paragraph 11 of the Complaint, as well as the following:

(i) With respect to Annex C, there is nothing specific to Canada referred to therein and only two or three incidences of use for ENGADGET.com from 2004 to February 2005, all other materials being either current or after February, 2005.

(ii) With respect to paragraph 13 of the Complaint, again there is little evidence submitted in support of the allegations of Canadians using the ENGADGET.com website prior to February, 2005.

(iii) With respect to paragraph 16 of the Complaint, the representation is that the LUXIST trade-mark has been in continuous use in Canada by AOL and its predecessor-in-interest since December, 2004 when the LUXIST.com site was first launched. However, there is no evidence of use by Canadians filed in support of the allegations, and the fact that the LUXIST.com site was only launched in December, 2004 shows that it was only available for a short period of time before the Registrant registered the LUXIST.ca domain name, on February 22, 2005.

(iv) When one refers to the Annexes used to support the LUXIST and WEBLOGSINC usage by Canadians, while there are mentions of Canada in separate postings, the postings merely speak about Canada, with nothing to indicate that the postings are written or read by Canadians.

(v) With respect to paragraph 24 of the Complaint, it is merely speculation that AOL intends to "further target" Canadians for its online services, notwithstanding it has never applied for trade-mark protection in this country for either the LUXIST or WEBLOGSINC trade-marks, and the pending application for ENGADGET was only filed in December, 2008.

16. In order for the Complainant to succeed, the Complainant must prove, on a balance of probabilities, that:

(a) The Registrant's dot-ca domain name is confusingly similar to a trade-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 of *CIRA Domain Name Dispute Resolution Policy* ("the Policy"); and there must be some evidence that

(c) The Registrant has no legitimate interest in the domain name as described in paragraph 3.6 of the Policy.

17. Even if the Complainant proves (a) and (b) above, 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 of the Policy.

18. Given that the Registrant provided no evidence, there is nothing before me to support a showing that that Registrant has a legitimate interest in the domain name as described in paragraph 3.6, and no evidence in the Complainant's materials to suggest any legitimate interest by the Registrant.

19. I also find that the Complainant has established, on a balance on probabilities, that the Registrant has registered the domain names in bad faith. Not only has the Registrant registered the domain names for the purpose of directing potential customers of the Complainant to a website that advertises and offers for sale products of competitors, but the Registrant has, at least on four other occasions, registered a domain name that contains or is comprised of a registered trade-mark of another party. While some of the other domain names referred to in paragraph 46 of the Complaint either do not show third party trade-mark rights or are not relevant, I am nevertheless prepared to find a pattern of conduct that the Registrant has registered domain names for the purpose of disrupting the business of the Complainant, by directing potential customers of the Complainant to a website that advertises and offers for sale products of competitors, and I find therefore bad faith has been established.

Canadian Broadcasting Corporation/Souété Radio Canada v. William Quon, Case No. 0006

Glaxo Group Ltd. v. Defining Presence Marketing Group Inc. (Manitoba) BCICAC Case No. 00020

20. I also find that any person encountering the domain name ENGADGET would conclude that the Registrant's business, products and/or services were either a business of the Complainant, or at least endorsed, sponsored or approved by the Complainant, and that the Complainant has established sufficient evidence of use to establish a reputation in Canada for ENGADGET. Accordingly, the Complainant's business reputation would be put at risk by the Registrant's business conduct in making use of the domain name ENGADGET.ca.

I.O.F. NORENDU (Forester College of Technology), CIRA Dispute Resolution Case No 00017

21. However, I am not satisfied on the basis of the evidence before me, that the Complainant has established any reputation that would result in trade-mark protection available under 7(b) of the *Trade-marks Act,* for either the trade-mark LUXIST or WEBLOGSINC in Canada. The lack of any evidence showing adequate use by Canadians of AOL's websites located at Luxist.com and Weblogsinc.com, the fact that references provided really do not amount to trade-mark use in Canada with respect to LUXIST and WEBLOGSINC, and the relatively generic nature of WEBSLOGSINC, serve to refute any finding, on a balance of probabilities, that the Complainant has established trade-mark rights in Canada for WEBLOGSINC or LUXIST.

22. Reputation associated with the exclusive right to use a trade-mark is an independent and essential element of the tort of passing off. If this element is not established, then any rights based on such a cause of action must fail.

Kirkbi AG v. *Ritvik Holdings Inc.*, 2005 S.C.C. 65 @ para 67 (S.C.C.)

Sund v. *Beachcombers Restaurant Ltd.* (1961), 36 C.P.R.2 @p 6 (B.C.C.A.)

G. CONCLUSION/DECISION

23. The Complainant has proven, on a balance of probabilities, that the domain name ENGADGET.ca is confusingly similar to that Complainant's trade-mark ENGADGET in Canada, in which the Complainant's parent company had rights and a reputation prior to the date of registration of the domain name and that the Complainant continues to have such rights. The Complainant has also produced evidence that the Registrant had no legitimate interest in the domain name ENGADGET.ca, and has proven on a balance of probabilities that the Registrant acted in bad faith, pursuant to paragraph 3.7 of the Policy. For all these reasons, the Complainant is successful with respect to the domain name ENGADGET.ca and I hereby order that the domain name be transferred to the Complainant.

24. However, while I also find that the Complainant produced evidence that the Registrant has no legitimate interest in the domain name LUXIST.ca or WEBLOGSINC.ca, and has proven on a balance of probabilities that the Registrant acted in bad faith in registering these two domain names, I am not satisfied that the Complainant has proven the requisite reputation necessary to establish any trade-mark rights in Canada under Section 7(b) of the *Trade-marks Act* for either the trade-mark LUXIST or WEBLOGS INC and therefore I conclude that this Complaint, as it concerns the domain names LUXIST.ca and WEBLOGSINC.ca, is not successful and is dismissed.

Vancouver, British Columbia, this 5th of August 2010.

M D Manson

Michael Manson
Sole Panel Member