

**IN THE MATTER OF A COMPLAINT PURSUANT TO THE
CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

Domain Name: WARRENMILLER.CA

Complainant: Warren Miller Entertainment, Inc.
Registrant: Willi Vogl & Associates, LTD
Registrar: Webnames.ca, Inc.
Panelist: David Lametti
Service Provider: Resolution Canada

DECISION

A. The Parties

1. The Complainant is Warren Miller Entertainment, Inc. Its registered business address is 2540 Frontier Avenue, Suite 104, Boulder, Colorado, 80301. The Complainant's representative in this matter is Joseph Englander, Esq., Shutts & Bowen, LLP, 200 East Broward Boulevard, Suite 2001, Fort Lauderdale, Florida, 33301.
2. The Registrant is Willi Vogl, with a mailing address of PO Box 92059, STN West Vancouver, West Vancouver, V7V 4X4. His email is wvogl@skitheworld.com.
3. A second person named as Registrant is Mike James, with a mailing address of 9-1155 Melville Street, Vancouver, BC, V6E 4C4. His email is mjames@skitheworld.com.

B. The Domain Name and Registrar

4. The domain name at issue is < WARRENMILLER.CA >. The domain name is registered with Webnames.ca, Inc. of Vancouver, BC.

C. Procedural History

5. The Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, Resolution Canada, on 22 September 2010.
6. The Provider attempted to serve notice of the Complaint to the Registrant as required by paragraphs 4.3 and 2.1 of the Rules by email on 27 September 2010, with no response as evidenced in the documentation. The Provider then attempted to serve notice by courier on the same date, and the package of materials was eventually delivered to Mr Mike James, again as documented. Thus the Registrant was effectively served, as the Provider has met the requirements of paragraph 2.1 of the Rules.
7. No response was received by the Registrant.

8. The Complainant opted for a single Panelist and the Provider selected a single panelist according to the process outlined in the Rules.

D. Panel Member's Impartiality and Independence Statement

9. As required by paragraph 7.1 of the Rules, the Panelist has declared to the Provider that he can act impartially and independently in this matter as there are no circumstances known to him which would prevent him from so acting.

E. Residence Requirements

10. The Complainant is the registered owner the owner of the registered trade-mark WARREN MILLER in Canada and thus satisfies Canadian Presence Requirement under paragraph 1.4 of the Policy.

F. Factual Background

11. The facts of this dispute are as follows. The Complainant, Warren Miller Entertainment, is effectively based on the persona of Warren Miller, and has built a business over the past 50 years around Miller's talents as a ski filmmaker. It is a multimedia company that produces magazines, websites, feature films and other video, television and radio, events and exhibitions. Warren Miller the person is one of the most well-known names in the skiing industry, and the Complainant, now in other hands, is the corporate embodiment of that fame, holding marks that incorporate the Warren Miller name. WARREN MILLER is thus a strong mark in the sense of embodied goodwill.

12. On 17 July 2001, the Complainant entered into a film distribution agreement with the Registrant Vogl. Vogl would be the distributor of Warren Miller feature films in Canada. An addendum expanded the purview of the license to home video, television and a magazine. The license was to last through to 1 August 2007.

13. The Complainant filed for the trade-mark WARREN MILLER in Canada on 1 February 2006, and the mark was perfected on 9 June 2008.

14. As evidenced by whois.ca, the Registrant registered the domain name in question on 23 January 2002. This was near the beginning of the period in which the Registrant was the Complainant's licensee; as the Complainant forthrightly notes in its materials, the Registrant effectively registered on behalf of the Complainant.

15. The Complainant sent an email requesting transfer of the domain names in an email exchange with the Registrant between 8 and 10 June 2010. The Registrant declined to transfer, maintaining that it would only transfer all domain names to the Complainant once outstanding financial issues were settled.

16. It is clear from the documentation that the dispute over the domain name is part of a larger, more complex set of disputes between the Complainant and the Registrant.

17. The Complainant lodged this Complaint with Resolution Canada on 22 September 2010.

G. CIRA Domain Name Dispute Resolution Policy Requirements

18. As has been already observed, the domain name dispute at issue appears to be one element of a wider set of largely contractual disputes between the parties. A Panel constituted under the *CIRA Domain Name Dispute Resolution Policy* [“Policy”] must decide only on matter of the .ca domain name at issue, strictly according to the Policy and Rules. In a case such as this one, the Policy’s limited scope will obviously not be sufficient to regulate all questions in dispute between the parties. It may also be the case that the domain name issue is intricately tied to other questions in a larger dispute. It is precisely for this reason that parties in a CIRA proceeding thus do not forfeit any legal rights to pursue their dispute before appropriate courts.

19. This observation made, we turn to the requirements of the Policy. It sets out at paragraph 4.1 what the Complainant must establish in order to successfully prove the complaint:

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.

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 . . .

20. The Registrant has not filed a response. The Policy and Rules nevertheless allow this Complaint to proceed, and the Panel must proceed by holding the Complainant to the usual burdens of proof and argument incumbent on it in such cases. The Panel is entitled to make legitimate inferences regarding the Registrant, as a result of non-filing.

H. Is the Registrant’s Domain Name Confusingly Similar to the Complainant’s Mark?

21. Paragraph 3.2 of the Policy includes the following in the definition of what constitutes a “mark” for the purposes of the Policy:

A “Mark” is:

- (a) a trade-mark . . . or a trade name that has been used in Canada . . . for the purpose of distinguishing the wares, services or business of that person . . . from the wares, services or business of another person; [and]
- (c) a trade-mark . . . that is registered in CIPO . . .

22. The Complainant is now the owner of a Canadian trade-mark registration for the trade-mark WARREN MILLER. However, the registration of the trade-mark was affected after the registration of the domain name. Nevertheless, it is clear on the evidence submitted that the Complainant held a well-known unregistered mark which was used widely in Canada to distinguish the wares of the Complainant. Hence prior to the registration of the mark in Canada – and this is the relevant period for the purposes of this case – the Complainant had rights in the mark under the Policy.

23. The Complainant has thus established rights in the mark in Canada.

24. Turning to the question of confusion and similarity, paragraph 3.4 of the Policy defines “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. At the time the domain name was registered WARREN MILLER was a non-registered mark (and is now a registered mark) that had been used in Canada and internationally. As stated, it is used in association with a wide variety of goods and services in skiing promotion industry. It is the name of Mr Miller himself, a well-known figure in the skiing entertainment industry for over fifty years, and thus has a high degree of inherent distinctiveness.

26. The substance of the domain name, that is the part of the domain name that precedes the “dot” and TLD, is identical to the Complainant's registered trade-mark. This identity is sufficient for a finding of "confusingly similar."

27. Interpreting “confusingly similar” under the Policy, the Panel finds the Registrant’s domain name < WARRENMILLER.CA > to be confusingly similar to the Complainant’s mark.

I. Was the Registration of the Domain Name Made in Bad Faith?

28. In order to succeed, the Complainant must show, on the balance of probabilities, that the Registrant *registered* the domain name in bad faith. The Panel notes that the clear intent of the Policy, evidenced by its wording, is to discern the state of the motives of the Registrant *at the time of registration*.

29. Paragraph 3.7 of the Policy states that the Registrant will be considered to have registered the domain name in bad faith if and only if one of the following three conditions is met:

(a) the Registrant *registered* the domain name . . . primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant [or others related to or competing with the Complainant] for valuable consideration in excess of the Registrant's actual costs in registering the domain name . . . ;

(b) the Registrant *registered* the domain name . . . in order to prevent the Complainant [or others related to the Complainant] 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 . . . 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. [Emphasis mine.]

30. The Registrant registered the domain names as a licensee of the Complainant, and, as the Complainant has stated in its materials, effectively on behalf of the Complainant. As such, the registration in this case simply did not (and cannot) fall into any of the above categories of bad faith. Licensees have been considered legitimate Registrants (and Complainants) in numerous domain name cases. At the time of registration, the Registrant was acting with the full approval of the Complainant, and was registering for legitimate, good faith purposes. The Registrant did not register to re-sell to the Complainant, to extort, to divert, to confuse or to prevent legitimate registration. It was indeed a legitimate registrant acting on agreement with the Complainant to promote its products in Canada.

31. While the Complainant has provided some evidence in its documentation to show that the Registrant has continued to use the domain name after the expiry of the license in order to divert internet traffic to its website offering competing services, there is nothing in the Policy which takes post-registration activity in and of itself into account, especially during the term of the original domain name registration. The question is whether *registration itself* was done in bad faith. While events subsequent to registration – an offer to re-sell at a higher price, for example – may be considered, these are relevant insofar as they point backwards to the motives of the registrant at the time of registration. Whether this is a gap or an oversight in the Policy, or whether this is a matter of good domain name governance, is beyond the purview of a Panel: the wording and intent of the Policy are clear.

32. Finally, that the Registrant ignored the transfer request from the Complainant appears to be grounded in the larger contractual dispute between the parties.

33. The Panel therefore concludes that the Registrant did not in fact register the domain name < WARRENMILLER.CA > in bad faith under paragraph 3.7 of the Policy. This is sufficient to make a final ruling in favour of the Registrant in this dispute, as the CIRA Policy requires the burden of proving all three criteria to have been met by the Complainant.

J. Does the Registrant Have a “Legitimate Interest” In the Domain Name?

34. 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. Paragraph 3.6 of the Policy states:

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.

35. This definition, unlike that of bad faith, does not appear to be as focused on the act of registration, but rather seems to envisage a period between registration and notice by a Complainant. That being said, it is hard to see the CIRA governance regime, given its contractual foundation created at the time of registration, as a regime that can fully monitor domain name uses during the term of a validly registered domain name.

36. The terms themselves are restrictive – only the interests listed in subparagraphs (a) through (f) below can be considered legitimate interests. These all point to some legitimate activity and objective link in assessing the relationship between the domain

name and the Registrant. In terms of procedure the Complainant must provide some evidence that none of these interests applied to the Registrant. The burden would then shift to the Registrant to show that it has, on the balance of probabilities, any one of these legitimate interests as defined under these subparagraphs.

37. As stated above, the Complainant has provided evidence that the Registrant was a licensee of the Complainant at the time of registration, and for a time thereafter, would have qualified as having had a legitimate interest under subparagraph (a). How long the Registrant had – or indeed possibly even continues to have – a legitimate interest in the domain name will be determined by the proper interpretation of the contract.

38. Whether the continued use of the domain name ceased to be legitimate during its term, notwithstanding its valid registration, is a consideration that can only be determined as part of a larger inquiry into the interpretation of the license agreement and its termination or non-termination. These are factual and interpretive legal considerations that a CIRA Panel, not having access to the usual judicial and procedural tools for evidence gathering and evaluation, and lacking in that interpretive experience and expertise, cannot possibly decide. A CIRA Panel must decide only on the criteria established in the CIRA Policy and Rules, and evidence pertinent to those criteria.

39. As it stands, there is at least some evidence offered by the Complainant that the Registrant did have a legitimate interest at registration and for a period of time afterwards.

40. The Panel therefore concludes that the Registrant indeed had a legitimate interest in the domain name < WARRENMILLER.CA >, and this was particularly true at the time of registration. Thus the Complainant has failed to meet the initial burden under paragraph 3.6 of the Policy of showing the contrary.

K. Conclusion and Decision

41. The Complainant has established on the balance of probabilities that the Registrant's domain name < WARRENMILLER.CA > is confusingly similar to the Complainant's mark.

42. However, the Complainant has failed to establish on the balance of probabilities that the Registrant had *registered* the domain name < WARRENMILLER.CA > in bad faith.

43. Finally, the Complainant has also provided some evidence that the Registrant did have a legitimate interest at the time of registration and for an as yet undetermined period thereafter, as defined in the Policy, in the domain name < WARRENMILLER.CA >.

44. For these reasons, the Complaint regarding < WARRENMILLER.CA > is not successful.

L. Remedy

45. The Complainant has asked that the domain name at issue be transferred to it. The Panel denies the request.

Dated 15 November 2010,

David Lametti (Sole Panelist)

A handwritten signature in black ink, appearing to read "David Lametti", with a stylized flourish at the end.

David Lametti