

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

Dispute Number: DCA-1358-CIRA
Domain Name: cointreau.ca
Complainant: Cointreau
Registrant: Netnic Corporation
Registrar: dot-ca-registry.ca (Burmac Business Systems Ltd.)
Panel: W.A. Derry Millar (Chair), Anton Melnyk, Patrick Flaherty
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

THE PARTIES

1. The Complainant is Cointreau (un société par actions simplifié) Carrefour Moilière, 49124 St. Barthélémy d'Anjou, France. Cointreau is represented in this proceeding by its agent Nameshield and Laurent Becker.

2. The Registrant is Netnic Corporation whose contact person is Daniel Mullen and his address is P.O. Box 1900, Charlottetown, Prince Edward Island, C1A 7N5.

THE DOMAIN NAME AND REGISTRAR

3. The Domain Name in issue ("**Domain Name**") in this proceeding is: cointreau.ca.

4. The Registrar is: dot-ca-registry.ca (Burmac Business Systems Ltd.).

5. The Domain Name was registered by the Registrant on March 18, 2011.

PROCEDURAL HISTORY

6. The British Columbia International Commercial Arbitration Centre (“**BCICAC**”) is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (“**Policy**”) of the Canadian Internet Registration Authority (“**CIRA**”).

7. The Complainant filed a Complaint with respect to the Domain Name in accordance with the Policy on December 9, 2011.

8. The Complaint was reviewed and found to be compliant by a letter and e-mail dated December 12, 2011, BCICAC as Service Provider confirmed compliance of the Complaint and forwarded a copy of the Complaint to the Registrant.

9. The Registrant requested an extension of time for delivery of its Response to January 10, 2012, and the extension was granted by the BCICAC under Rule 5.4.

10. The Registrant delivered its response, in compliance with the Policy and Rules to the BCICAC on January 10, 2012.

11. On January 20, 2012, the BCICAC named W. A. Derry Millar as Chair of the Panel and Anton Melnyk and Patrick Flaherty as Panelists.

12. The Panel has reviewed all of the material submitted by the Complainant and is satisfied that the Complainant is an eligible Complainant under the Policy and Rules.

13. The Complainant as noted below is the owner of a trademark registered in Canada and therefore meets the Canadian Presence Requirements.

FACTS

14. The Complainant is part of the Rémy Cointreau Group, whose origins date from 1724. The Rémy Cointreau Group is the result of the merger in 1990 of the holding companies of the Hériard Dubreuil and Cointreau families that controlled E. Rémy Martin & Co SA and Cointreau & Cie SA respectively. The main activities of the Rémy Cointreau Group are the

production of cognacs, liquors, rums and spirits. Ninety-five per cent of the production is sold outside France. Among its brands, the best known are: Rémy Martin, Cointreau, Mount Gay, Metaxa and Passoa.

15. The Complainant owns a number of trademarks which include "COINTREAU" in word or in word/logo including the following:

Country	Trademark	Registration Number	Registration Date
Canada	COINTREAU E. COINTREAU & DESSIN	No LMC520161	1999/12/01
Canada	COINTREAU	No LMC768907	2010/06/07
Canada	COINTREAU & LACET	No LMC603053	2004/02/24
Canada	E. COINTREAU	No LMC605530	2004/03/17
Canada	COINTREAU & DESSIN	No LMC433509	1994/09/16
Canada	COINTREAU & DESSIN	No LMC180337	1971/12/31
Canada	COINTREAU	No LCD31772	1948/10/18
Canada	COINTREAU (& DESSIN Banderole version 2004)	No LMC642878	2005/06/23
International	COINTREAU	1089525	2011/08/01

16. The Complainant's evidence is that Cointreau owns and communicates on the Internet through various websites worldwide. The main website being www.remy-cointreau.com which was registered on July 10, 1996. The Complainant has also registered the following domain names which include its trademark "COINTREAU" including:

cointreau.com registered on 1995/10/11

cointreau.net	registered on 2001/12/11
cointreau.fr	registered on 2007/12/21
cointreau.co.uk	registered on 1999/10/25
cointreau.eu	registered on 2006/03/08
cointreau.hk	registered on 2006/09/21
cointreau.us	registered on 2002/04/19
cointreau.co	registered on 2010/07/21

17. The Complainant submits that the Domain Name is identical to its prior trademark "COINTREAU".

18. The trademark COINTREAU was registered on October 18, 1948 in the Canadian Intellectual Property Office as Registration No. LCD31772 in relation to liqueurs and was first used in Canada in 1910 according to the registration.

19. The Complainant submits that the Registrant has registered the Domain Name "cointreau.ca" with the knowledge of its trademark "COINTREAU" and has used the Domain Name to divert Internet users to obtain a financial gain with the commercial links on the webpage. The website cointreau.ca resolves to a webpage that displays commercial links on a pay per click service. The Complainant submits that the Registrant has registered the Domain Name with the knowledge of its trademark "COINTREAU" and has used the Domain Name to divert Internet users to obtain a financial gain with the commercial links on the webpage.

20. On November 28, 2011, Mr. Becker on the behalf of the Complainant wrote to domain.services@netnic.ca with respect to the registration of the Domain Name. He pointed out in his letter the trademark registrations held by the Remy Cointreau. By e-mail dated November 29, 2011 at 13:25:04, Mr. Daniel Mullen, Europe Agent, NETNIC CORPORATION, responded that he would like to have a telephone call with Mr. Becker that day. Mr. Becker and Mr. Mullen spoke on November 29, 2011.

21. Mr. Mullen referred to the telephone call in his e-mail dated November 29, 2011 sent at 15:04:19. Mr. Mullen asked in the e-mail "Please tell me what you have to propose as 'an amicable settlement' then we can call for discussion so that then I will be able to inform our customer today."

22. Mr. Becker responded to Mr. Mullen by an e-mail dated November 29, 2011 sent at 15:58:19 and stated the following with respect to settlement: "however, I prefer to avoid a legal action regarding this case. I can find a solution in offering an amount of \$350 to pay the costs of this registration."

23. Mr. Mullen responded by e-mail dated November 29, 2011 at 16:54:13, as follows the with respect to the \$350:

I think that 350 would not even pay the costs to have a lawyer investigate the matter for our customer!

Here I must advise you that you should look to about 2500 Euros in your currency as the correct amount, as even if you have no legal fees at all for this, which is to say your lawyer will work for free, then your client must pay at least so much just to form a panel to determine the position of the trademark to the domain, and this procedure will take about three months. Even then the customer would have the ability to go to civil court, and your client as well, so this could take much longer.

In this situation I can say that it may seem high but fair considering the situation from both sides. If I call the customer and say I have good news and bad news, then it would be obvious that they should accept what I have suggested. Your suggestion would not, I think, as I mentioned already it would not even cover the costs related to the issue.

24. Mr. Becker responded on November 29, 2011 at 17:29:46 as follows:

My last offer is \$350 for this domain name. (\$2,500 would be a grossly excessive price over the customer's out-of-pocket expenses.). If you are not the real registrant as you said, send this information to the registrant. At the moment, the registrant is NETNIC CORPORATION - cointreau-ca.

25. Mr. Mullen responded on November 29, 2011 at 18:02:38 and said:

I am not in a position to negotiate with you. My suggestion is a suggestion to you, and will be my recommendation to our customer. Your offer of \$350 would not be something to recommend, as stated earlier, it would not cover the expenses related to the issue. NETNIC will already charge the customer more than this.

We will ensure the domain is transferred to the account of our customer so that they may do as they what they want with the domain.

26. The Registrant states in its Response that it is holding the Domain Name for a customer and has not transferred it to the customer because the customer has not paid NETNIC's account. The Registrant does not identify the customer.

27. The Registrant submits that the Complainant Cointreau has no standing to make this Complaint. The panel does not accept this submission for the following reasons:

- (a) Cointreau is the owner of the word mark COINTREAU registered in CIPO as LCD31772 on October 18, 1948.
- (b) The fact the Complainant that does not use the phrase “(une société par actions simplifiée)” after its name in the Complaint does not mean that the Complainant does not have standing to bring the Complaint. It is clear from the Complaint that Cointreau refers to Cointreau (une société par actions simplifiée).
- (c) The fact that Nameshield is acting as the agent for Cointreau in filing the Complaint has no bearing on the issues in this proceeding.

28. The Complainant submits that the trademark "COINTREAU" is well known worldwide, especially in North America. The products of the Remy Cointreau Group have been marketed and sold in Canada where the Registrant is located. The Registrant submits that Cointreau is an obscure brand relative to the global alcoholic beverage industry.

ANALYSIS AND FINDINGS

APPLICABLE DISPUTES

29. A Registrant must submit to a Proceeding if a Complainant asserts in a Complaint submitted in compliance with the Policy and the Resolution Rules 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;
- (b) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4; and
- (c) the Registrant has registered the domain name in bad faith as described in paragraph 3.5.

30. Under paragraph 4.1 of the Policy, 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 3.5;

and the Complainant must provide some evidence that

- (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

31. Paragraph 4.1 of the Policy also provides that:

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 3.4.

CONFUSINGLY SIMILAR - PARAGRAPH 4.1 (a) OF THE POLICY

32. COINTREAU is a trademark registered by the Complainant or its predecessors on October 18, 1948 in the Canadian Intellectual Property Office as Registration No. LCD31772 in relation to liqueurs. COINTREAU is a "Mark" as defined in paragraph 3.2(c) of the Policy. The trademark was registered many years prior to the registration of the Domain Name on March 18, 2011.

33. The Complainant has established that the Registrant's Domain Name "cointreau.ca" is confusingly similar to the Complainant's Mark.

34. Paragraph 3.3 of the Policy defines "confusingly similar" as follows:

In determining whether a domain name is '**Confusingly Similar**' to a Mark, the Panel shall only consider whether the domain name so nearly resembles the Mark in appearance, sound or ideas suggested by the Mark as to be likely to be mistaken for the Mark.

35. The test to be applied in determining the issue of "confusingly similar" is set out in paragraph 66 of the decision in *Government of Canada v. David Bedford, c.o.b. Abundance Computer Consulting*¹:

The test for "Confusingly Similar" under Policy paragraph 3.4 is one of resemblance based on first impression and imperfect recollection. Accordingly,

¹ BCICAC Case No. 00011 (May 27, 2003)

for each domain name the Complainant must prove on a balance of the 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 the Complainant's corresponding mark based upon the appearance, sound or ideas suggested by the Mark.

36. While there has been a minor change in the wording of what is now Paragraph 3.3 of the Policy, the test as set out in *Government of Canada* case is still applicable. In the Panel's view, a person knowing the Complainant's Mark "COINTREAU" only and "having an imperfect recollection of" it "would likely mistake the Domain Name" "cointreau.ca" "for the Complainant's corresponding mark based upon the appearance, sound or ideas suggested by the Mark."

BAD FAITH - PARAGRAPH 4.1(b) OF THE POLICY

37. In order to establish bad faith, the Complainants must establish on the balance of probabilities, one of paragraphs 3.5(a), (b), (c) or (d) of the Policy. The Complainants have provided evidence in relation to paragraphs (a), (b) and (d).

38. Paragraph 3.5 defines "registration in bad faith" for the purposes of the Policy as follows:

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 is engaged in a pattern of registering domain names in order to prevent persons

who have rights and Marks from registering the Marks as domain names.

(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."

(d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

39. The Panel finds that the Complainant has satisfied the requirements of paragraphs 3.5 (a), (b) and (d) of the Policy and is entitled to a finding that the Registrant has registered the Domain Name "cointreau.ca" in bad faith.

Bad Faith – Paragraph 3.5(a) of the Policy

40. Under paragraph 3.5(a), the Complainant must establish that:

(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;

41. The Complainant submits that the trademark "COINTREAU" is well known worldwide, especially in North America. The products of the Remy Cointreau Group have been marketed and sold in Canada where the Registrant is located.

42. The Registrant submits that Cointreau is an obscure brand relative to the global alcoholic beverage industry.

43. The exchange of e-mails between Mr. Becker and Mr. Mullen on November 29, 2011, demonstrates that Mr. Mullen was prepared "to recommend to" his customer the sale of the Domain Name for 2,500 Euros.

44. The amount requested by Mr. Mullen was rejected by Mr. Becker as "\$2,500 would be a grossly excessive price over the customer's out-of-pocket expenses."

45. We find that Netnic Corporation registered the Domain Name primarily for the purpose of "selling, renting, licensing or otherwise transferring the Registration to the Complainant or to a competitor of the Complainant for valuable consideration in excess of the Registrant's actual costs in registering the domain name." The Panel is of the view that if the "customer" did not intend to do this, the "customer" would have been identified and evidence provided from the "customer."

Bad Faith – Paragraph 3.5(b) of the Policy

46. Under paragraph 3.5(b), the Complainant must establish that:

(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 is engaged in a pattern of registering domain names in order to prevent persons who have rights and Marks from registering the Marks as domain names.

47. In the Panel's view, the registration of the domain name "cointreau.ca " on March 18, 2011, in the face of the registration by the Complainant of its trademark COINTREAU in 1948 and the use by the Complainant of the COINTREAU trademark since 1910 leads only to the conclusion that "the Registrant registered the domain name ... to prevent the Complainant or the Complainants' licensor or licensee of the Mark, from registering the Mark as a domain name." The Registrant states that it is holding the Domain Name for a customer who owes it money. There is no evidence as to why the customer sought the registration of the Domain Name. In the absence of any such evidence, we make the inference noted above.

48. *Viacom International Inc. v. Harvey Ross Enterprises. Ltd.*² decided that evidence indicating that a registrant owns multiple domain names which correspond to third party trademarks constitutes *prima facie* evidence of bad faith registration. In *Great Pacific Industries Inc. v. Ghalib Dhalla*³ and *Volvo Trademark Holding AB v. Cup International Limited*,⁴ the

² BCICAC Case No. 00015 (October 15, 2003).

³ BCICAC Case No. 00009 (April 21, 2003).

Panels held that as few as two (2) domain name registrations, which include the domain name in dispute, is sufficient to establish that a registrant has engaged in a pattern of abusive registrations.⁵

49. David Mullen is the public face of Netnic Corporation. While the Registrant states in the response that David Mullen is not an officer, director or shareholder of Netnic Corporation, he clearly represents Netnic Corporation. He signed the Response on behalf of Netnic Corporation. He is the administrative contact for Netnic Corporation. He spoke to Mr. Becker on the telephone and he corresponded with Mr. Becker.

50. It is clear from the cases cited by the Complainant that David Mullen has registered third party marks as domain names on a number of occasions. Such a finding was been made in Canada in *Burberry Ltd. v. Daniel Mullen*⁶ in which the disputed domain name was burberry.ca and in *Westinghouse Electric Corporation v. Daniel Mullen*⁷ in which the disputed domain name was Westinghouse.ca. Mr. Mullen has also been involved in WIPO cases unsuccessfully where he has been found to have registered domain names in bad faith and been ordered to transfer them. We find that there is bad faith under this subparagraph.

51. The Panel finds that the registration of the domain name cointreau.ca. Westinghouse.ca and burberry.ca by the David Mullen who is the alter ego of the Registrant constitutes a pattern of abusive registrations within 3.5(b) of the Policy.

REGISTRATION IN BAD FAITH - PARAGRAPH 3.5(d) OF THE POLICY

52. Under paragraph 3.5(d), the Complainant must establish that:

(d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

⁴ WIPO Case No. D2000-0338 (June 12, 2000).

⁵ See also: Alberta Treasury Branches v. Jim Yoon, CIRA Case No. 00052 (February 13, 2006).

⁶ BCICAC No. DCA-100-CIRA

⁷ BICAC No. DCA-991-CIRA

53. The Complainant submits that the registrant has “intentionally attempted to attract, for commercial gain, Internet users to the Registrant’s website or other on-line location, by creating a likelihood of confusion with the Complainant’s Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant’s website or location or of a product or service on the Registrant’s website or location.”

54. The Complainant submits that the trademark “COINTREAU” is well known worldwide especially in North America and that the Complainant’s products have been marketed and sold in Canada where the Respondent is located.

55. We agree with the Complainant that the activities of the Registrant amount to bad faith under this paragraph. Notwithstanding that the Registrant submits that Cointreau is not a well known liqueur and is not in the top rank of alcoholic products sold, we accept the evidence of the Complainant that its trademark is well known.

**LEGITIMATE INTEREST IN DOMAIN NAME 4.1(c) OF THE POLICY –
LEGITIMATE INTEREST, PARAGRAPH 3.4 OF THE POLICY**

56. The Panel finds that the Complainant has met its burden under paragraph 4.1(c) of the Policy to provide some evidence that the Registrant does not have a legitimate interest in the Domain Name.

57. The Complainant submits that the Domain Name is identical to its COINTREAU trademark, the Registrant has no connection with the Complainant, and the Registrant has no rights or legitimate interest in respect of the use of the trademark for the Domain Name. There is no evidence from the “customer: about its “interest” in the Domain Name. Mr. Mullen for the Registrant does not provide any evidence for Netnic Corporation or the “customer” of any legitimate interest under paragraph 3.4 of the Policy.

ORDER

58. The Complainant has met the requirements of paragraph 4.1 of the Policy. The Panel directs that the registration of the Domain Name “cointreau.ca” be transferred from the Registrant to the Complainant.

Dated: February 8, 2012.

W. A. Derry Millar (Chair), Anton Melnyk, Patrick Flaherty

A handwritten signature in blue ink, appearing to read 'W. A. Derry Millar', with a long horizontal flourish extending to the right.

W. A. Derry Millar (Chair) for the Panel