

**IN THE MATTER OF A COMPLAINT MADE PURSUANT TO THE CANADIAN
INTERNET REGISTRATION AUTHORITY DOMAIN NAME DISPUTE
REGISTRATION RESOLUTION POLICY (v 1.3) AND RULES (v 1.4)**

Complainant: Glaxo Group Limited
Glaxo Wellcome House
Berkeley Avenue
Greenford
Middlesex UB6 0NN
United Kingdom
(the “Complainant”)

Complainant Counsel: Eric Macramalla
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Registrant: Steven Black
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(the “Registrant”)

Disputed Domain Name flovent.ca
(the “Domain Name”)

Registrar: The Registrar of record is 10 Dollar Domain Names Inc.

Single Member Panel: R. John Rogers

Service Provider: British Columbia International Commercial Arbitration
Centre (the “BCICAC”)

BCICAC File: DCA-1367- CIRA

PROCEDURAL HISTORY

The BCICAC is a recognized service provider pursuant to the Domain Name Dispute Resolution Policy (v 1.3) (the “Policy”) and Rules (v 1.4) (the “Rules”) of the Canadian Internet Registration Authority.

The Complainant filed a complaint dated January 17, 2012 (the “Complaint”) with the BCICAC seeking an order in accordance with the Policy and the Rules directing that registration of the Domain Name be transferred from the Registrant to the Complainant.

The BCICAC determined the Complaint to be in administrative compliance with the requirements of Rule 4.2 and, by letter of transmittal and email dated January 19, 2012 (collectively the “Transmittal Letter”), forwarded a copy of the Complaint to the Registrant to serve as notice of the Complaint in accordance with Rules 2.1 and 4.3. The Transmittal Letter determined the date of the commencement of proceedings in accordance with Rule 4.4 to be January 19, 2012 and advised the Registrant that in accordance with the provisions of Rule 5 a response to the Complaint (“Response”) was to be filed within 20 days of the date of commencement of proceedings, or February 8, 2012.

The Registrant contacted the BCICAC via email on January 19, 2012 inquiring into the possible ways to file a request for deferral of his Response until March 28, 2012. The BCICAC responded to the Registrant on January 19, 2012 drawing the Registrant’s attention to Paragraph 5.4 of the CIRA Rules dealing with a party’s request for an extension of time.

The Registrant provided his Response to BCICAC via email on February 7, 2012. As the Response was not in administrative compliance with the Rules, BCICAC gave the Registrant an additional 10 days to remedy all instances of non-compliance with the Rules with respect to the Response. The Registrant did not file a Response in accordance with the Rules by February 18, 2012, the extended deadline granted to him by BCICAC.

The BCICAC advised the Complainant that as the BCICAC had not received a Response from the Registrant in administrative compliance with the Rules by the extended deadline, that pursuant to Rule 6.5 the Complainant was entitled to elect to convert the tribunal for this matter from a three member panel to a single member panel. The Complainant elected a single member panel and the undersigned was appointed by the BCICAC as the Single Member Panel by letter dated February 24, 2012. The undersigned filed his Acceptance of Appointment as the Single Member Panel and Statement of Independence and Impartiality with the BCICAC on February 27, 2012 and determines that he has been properly appointed and constituted as the Single Member Panel to determine the Complaint in accordance with the Rules.

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CANADIAN PRESENCE REQUIREMENTS

The Canadian Presence Requirements for Registrants v 1.3 (“Presence Requirements”) require that to be permitted to apply for registration of, and to hold and maintain the registration of, a .ca domain name, the applicant must meet at least one of the criteria listed in Section 2 of the Presence Requirements as establishing a Canadian presence. Section 2(q) of the Presence Requirements specifies that a person which is the owner of a trade-mark which is the subject of a registration under the *Trade-marks Act* of Canada has the requisite Canadian presence, provided that the .ca domain name consists of or includes the exact word component of that registered trade-mark.

The Complainant is the registered owner of the registered Canadian trade-mark FLOVENT, Registration No. TMA451403 (the “Trade-mark”). The Domain Name, apart from the .ca component, consists of only the word “flovent”, the exact word component as that contained in the Canadian trade-mark owned by the Complainant. The Complainant, therefore, would be entitled to have the Domain Name registered in its name and therefore meets the Canadian presence requirement.

ALL TECHNICAL REQUIREMENTS MET

Based upon the information provided by BCICAC, the Panel finds that all technical requirements for the prosecution of this proceeding have been met, and, no Response to the Complaint having been filed by the Registrant, the Panel finds that pursuant Rule 5.8 the Panel is to decide this proceeding on the basis of the Complaint.

FACTS

As the Registrant has chosen not to respond to the Complaint, the facts put forward by the Complainant are summarized as follows:

1. The Complainant is a subsidiary of GlaxoSmithKline plc (“GlaxoSmithKline”), a research based pharmaceutical company and a worldwide leader in the pharmaceutical and healthcare field.
2. GlaxoSmithKline employs 96,500 people in over 100 countries and enjoys a 5% share of the world’s pharmaceutical market.
3. The Trade-mark is used in the marketing of a product called “Flovent”. Flovent is a corticosteroid used in association with the treatment and alleviation of respiratory diseases and ailments.
4. On September 15, 2010, without the permission of the Complainant, the Registrant registered the Domain Name.
5. The Domain Name was made to resolve to a website comprised of a single page advertising the sale of the Domain Name for \$500.00 and containing, among other items, the following wording:

flovent.ca is for sale.
A corticosteroid. \$500
Contact steveb@stevenblack.com or (+1) 613-542-3293
Show other domains for sale

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6. The the Complainant's counsel issued a cease and desist letter to the Registrant dated November 21, 2011 and forwarded a copy of this letter to the Registrant by email.
7. Following the issuance of the Complainant's counsel's cease and desist letter, the Registrant modified this website removing the word "corticosteroid" and the reference to \$500.00 and included the words "\$ inquire". After this modification, this website included the following wording:

flovent.ca is for sale.
 \$ inquire.
 Contact steveb@stevenblack.com or (+1) 613-542-3293
 Show other domains for sale

8. The words "Show other domains for sale" on this website were included on a tab. By clicking on the tab, the end user is provided with a list of 41 domain names for sale. All domain names listed, save for the Domain Name, indicated a specific sale price.
9. Following receipt of the cease and desist letter, the Registrant on November 21, 2011 responded by email to Complainant's counsel, such email including the following wording:

I therefore await a purchase offer for the domain "flovent.ca" from your client. You may address the purchase offer to me personally.

10. By email correspondence to the Registrant dated December 1, 2011, the Complainant through its counsel offered to purchase the Domain Name for \$500.00.
11. The Registrant replied the same day by email to Complainant's counsel with wording including the following:

Please inform your client that \$500 an insufficient offer.

12. When Complainant's counsel emailed the Registrant inquiring as to what price the Registrant was asking for the Domain Name, the Registrant replied by an email which included the following wording:

To broach your question, as a point of comparison I recently sold the rights to the notable.ca domain to Mr Julian Brass of Notable-TV (<http://notabletv.com>) for \$C3,000 which was a fair price for a small enterprise, which weighed heavily on the negotiations. Another factor was Mr Brass is a genuine nice guy, evidently a fine young man, a young entrepreneur with no discernible pretences, and Mr Brass was a genuine pleasure to liaise-with. Mr Brass and I parted friends, and we still occasionally converse together about Internet and domain-related things.

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Therefore, like "flovent", "notable" is a 7-letter .ca domain; thus the comparison holds, but only to a point.

With that in mind, would you please convey to your client that I am very happy and conducive to transferring "flovent.ca" but, that said, I seek a fair price for flovent.ca, and \$500 is clearly insufficient.

13. When Complainant's counsel by email inquired if the Registrant was seeking the sum of \$3,000 to transfer the Domain Name to the Complainant, the Registrant responded with an email including the following words:

No, \$3000 is not my ask.

\$3,000 is what an individual paid me for a 7-letter domain that compares, only to a point, with flovent. It serves to show, in a polite and quantitative way, that \$500 isn't close to a serious proposition for flovent (in my opinion and experience).

REMEDY SOUGHT

The Complainant seeks an order from the Panel that as the Domain Name is confusingly similar to the Trade-mark, that as the Registrant has no legitimate interest in the Domain Name, and that as the Registrant has registered the Domain Name in bad faith, the Panel instruct the Registrar of the Domain Name to transfer ownership of the Domain Name to the Complainant.

THE POLICY

The purpose of the Policy as stated in paragraph 1.1 of the Policy is to provide a forum in which cases of bad faith registration of .ca domain names can be dealt with relatively inexpensively and quickly.

Paragraph 4.1 of the Policy puts the onus on the Complainant to demonstrate this "bad faith registration" by proving on a balance of probabilities that:

1. the Trade-mark qualifies as a "Mark" as defined in paragraph 3.2 of the Policy;
2. the Complainant had "Rights" in the Trade-mark prior to the date of registration of the Domain Name and continues to have "Rights" in the Trade-mark,
3. the Domain Name is "Confusingly Similar" to the Trade-mark as the concept of "Confusingly Similar" is defined in paragraph 3.3 of the Policy;
4. the Registrant has registered the domain name in "bad faith" in accordance with the definition of "bad faith" contained in paragraph 3.5 of the Policy; and
5. the Registrant has no "legitimate interest" in the Domain Name as the concept of "legitimate interest" is defined in paragraph 3.4 of the Policy.

If the Complainant is unable to satisfy this onus, bad faith registration is not demonstrated and the Complaint fails.

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MARK

The relevant portion of paragraph 3.2 of the Policy states that for the purpose of the Policy 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;

The Trade-mark matured to registration on December 8, 1995 and the Declaration of Use was filed on November 1, 1995. The Trade-mark is currently used in Canada for marketing the pharmaceutical Flovent.

The Trade-mark clearly qualifies as a “Mark” within the provisions of paragraph 3.2 (a) of the Policy.

RIGHTS

As noted above in the examination of the qualification of the Trade-mark as a “Mark”, paragraph 3.2(a) of the Policy applies and the Complainant has used the Trade-Mark in Canada both prior to and following the registration of the Domain Name on September 15, 2010.

The Complainant, therefore, has “Rights” in the Trade-mark

CONFUSINGLY SIMILAR

Policy paragraph 3.3 provides that the Domain Name will be “Confusingly Similar” to the Trade-mark if the Domain Name so nearly resembles the Trade-mark in appearance, sound or the ideas suggested by the Trade-mark as to be likely to be mistaken for the Trade-mark

In the matter at hand, the Domain Name consists of the Trade-mark, FLOVENT, followed by the .ca suffix. As paragraph 1.2 of the Policy defines the Domain Name for the purpose of this proceeding to exclude the .ca suffix, the portion of the Domain Name consisting of “FLOVENT” is relevant.

As the Domain Name excluding the .ca suffix is a coined word and is the same word as the Trade-mark, the Panel finds that the Complainant has satisfied the onus of demonstrating that the Domain Name is “Confusingly Similar” to the Trade-mark in accordance with paragraph 3.3 of the Policy.

BAD FAITH

Under paragraph 3.5 of the Policy, the Registrant will be considered to have registered the Domain Name in bad faith if, and only if, the Complainant can demonstrate that the Registrant in effecting the registration of the Domain Name was motivated by any one of

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the three general intentions set out in paragraph 3.5. Of these intentions, the form of intention contained in paragraph 3.5(a) is the one most applicable to the matter at hand.

Paragraph 3.5(a) provides as follows:

(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;

There is before the Panel no direct evidence of the Registrant's intention in registering the Domain Name. Such intention must therefore be based upon a common sense inference from the website to which the Registrant has caused the Domain Name to resolve, from the Registrant's use of this website, and from the Registrant's subsequent communication with Complainant's counsel.

The facts before the Panel establish that:

1. The Registrant's website to which the Domain Name resolves initially featured an offer to sell the Domain Name for \$500.00;
2. Following the issuance of the Complainant's counsel's cease and desist letter, and the subsequent changes to his website, the Registrant declined the Complainant's offer of \$500.00 on the basis that it was "insufficient";
3. The Registrant noted a comparable sale price of \$3,000.00 in connection with the sale of the domain name "notable.ca" and felt that this sale price of \$3,000.00 was a "fair price for a small enterprise, which weighed heavily on the negotiations";
4. The Registrant's website to which the Domain Name resolved originally included the word "corticosteroid". The pharmaceutical marketed under the Trade-mark was a corticosteroid; and
5. By clicking on the tab with the words "Show other domains for sale" on the website to which the Domain Name resolved, the end user was taken to a site which offered 41 domain names for sale.

As the Registrant's website originally included the word "corticosteroid" and as the pharmaceutical marketed under the Trade-mark was a corticosteroid, there is a strong suggestion that the Registrant was aware of the Complainant's identity. If such were the case, the Complainant would be the most likely purchaser of the Domain Name as it was clearly for sale. Being so aware, it is most unlikely that the Registrant would categorize the Complainant as a "small enterprise". If such were the case, it is clear from the Registrant's correspondence before the Panel that Registrant's asking price to transfer the Domain Name once the identity of the Complainant was confirmed would exceed \$3,000.

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There is no evidence before the Panel to suggest that the Registrant had any use for the Domain Name other than to sell it. As the owner of the Trade-mark, the most likely purchaser would be the Complainant.

The Panel therefore finds that the Registrant registered the Domain Name primarily for the purpose of selling, renting, licensing or otherwise transferring ownership in the Domain Name to the Complainant and, based upon this finding, in accordance with the provisions of paragraph 3.5(a) the Panel finds that the Registrant has registered the Domain Name in bad faith.

NO LEGITIMATE INTEREST

Paragraph 4.1 of the Policy requires that to succeed in the Complaint, the Complainant must provide some evidence that the Registrant has no legitimate interest in the Domain Name as the concept of “legitimate interest” is provided for in paragraph 3.4.

Paragraph 3.4 of the Policy provides that:

The Registrant has a legitimate interest in a domain name if:

- (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 3.4 (d) “use” by the Registrants includes, but is not limited to, use to identify a web site.

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As noted above, the Registrant has elected not to respond to the Complaint. Therefore, the Panel must review the provisions of paragraph 3.4 against the evidence before the Panel as provided by the Complainant.

There is no evidence before the Panel that pursuant to paragraph 3.4(a) the Registrant has Rights in the Trade-mark or that the Registrant used the Domain Name in good faith prior to the filing of the Complaint. Indeed, the evidence strongly suggests cybersquatting on the part of the Registrant.

On the face of it, the Domain Name does not appear to be clearly descriptive of wares, services or business of the Registrant or of the people involved in or place of origin thereof as provided for in paragraph 3.4(b).

Similarly, there is no evidence that the Domain Name is understood in Canada as the generic name of wares, services, or business offered by the Registrant, that the Domain Name is used in Canada in connection with a non-commercial activity of the Registrant, that the Domain Name is a name by which the Registrant is commonly identified, or that the Domain Name is the geographical name of the location of the Registrant's non-commercial activity or place of business. Therefore, the provisions of paragraphs 3.4(c), 3.4(d), 3.4(e) and 3.4(f) do not apply.

Therefore, the Panel finds that the Complainant has provided ample evidence that the Registrant has no legitimate interest in the Domain Name.

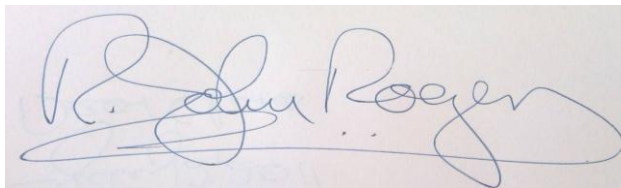
DECISION

The Panel finds that the Complainant has satisfied the onus placed upon it by paragraph 4.1 of the Policy and is entitled to the remedy sought by it.

ORDER

The Panel orders that the domain name, flovent.ca, be transferred to the Complainant.

Dated: March 12, 2012.

A handwritten signature in blue ink, appearing to read "R. John Rogers", is written over a light blue horizontal line. The signature is fluid and cursive.

R. John Rogers
Single Member Panel

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