

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

Dispute Number: DCA-1364-CIRA
Domain Name : <hmvcanada.ca>
Complainants: H MV (IP) Limited and H MV Canada Inc
Registrant: Michael Mateescu
Registrar: Go Daddy Domains Canada, Inc
Panel: The Honourable Neil Anthony Brown QC
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

THE PARTIES

1. The Complainants in this proceeding are H MV (IP) Limited, Company incorporated in the United Kingdom of Shelley House, 2-4 York Road, Maidenhead, United Kingdom SL6 1SR (“H MV”) and H MV CANADA Inc., of 110-5401 Eglinton Avenue West, Toronto, Ontario, M9C 5K6, Canada, a company incorporated under the laws of Canada (“H MV Canada”).
2. The Registrant is Michael Mateescu of mmateescu@hotmail.com.

THE DOMAIN NAME AND REGISTRAR

3. The Domain Name in issue in this proceeding is <hmvcanada.ca> (“the disputed domain name”).
4. The Registrar is: Go Daddy Domains Canada, Inc.
5. The disputed domain name was registered by the Registrant on September 10, 2011.

PROCEDURAL HISTORY

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

7. According to the information provided by the BCICAC :

- (a) The Complainants filed a Complaint with respect the disputed domain name in accordance with the Policy on January 10, 2012.
- (b) The Complaint was reviewed and found to be compliant. By letter dated January 12, 2012, the BCICAC as service Provider confirmed compliance of the Complaint and commencement of the dispute resolution process;
- (c) The Complaint was sent to the Registrant by email on January 12, 2012 and delivered on that date;
- (d) The Registrant has not provided a Response;
- (e) As permitted under CIRA Domain Name Dispute Resolution Rules (“the Rules”) the Complainant elected under Rule 6.5 to convert from a panel of three to a single arbitrator.
- (f) On February 8, 2012, BCICAC named The Honourable Neil Anthony Brown QC as the Panel. On February 9, 2012, the Panel signed an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.
- (g) On February 21, 2012, BCICAC sent to the Registrant by email Exhibits 7-12 to the Complaint and informed him that he could file a Response on or before March 12, 2012. The Registrant did not reply to that communication and did not file a Response.
- (h) The Panel has reviewed all of the material submitted by the Complainants and is satisfied that the Complainant is an eligible Complainant under the Policy and the Rules.
- (i) In accordance with Rule 5.8, where, as here, no Response is submitted, the Panel shall decide the Proceeding on the basis of the Complaint.

FACTS

8. The facts set out below are taken from the Complaint.

9. HMV owns various Canadian trademark registrations comprising or containing the expression HMV which is very well known throughout the world for its association with music and associated goods and services. HMV Canada is Canada’s premier retailer of music, DVDs, headphones, books and related products and has been so for many years. It has adopted the trade name HMV Canada and, as well as its retail stores, operates websites using the domain names <hmv.ca>, <hmvcanada.com> and <hmv.com>. It is clear that it is an associated company of HMV, the owner of the trademarks referred to hereunder.

10. The first Complainant is the registered owner of a series of Canadian trademarks, collectively referred to as “the HMV trademarks” which include trademark registered number TMA351924, registered with the Canadian Intellectual Property Office on February 24, 1989 for HMV. Evidence has been submitted by the Complainants of the registration of the HMV trademarks and the Panel accepts that evidence. The HMV trademarks have been extensively and continuously used and promoted in Canada for many years and as a result they have become very well known.

11. The Registrant registered the disputed domain name on September 10, 2011. The disputed domain name resolves to a website displaying a banner featuring the first Complainant’s HMV design trademark, the HMV Canada trade name and a Canadian flag and carrying advertisements for the goods and services of the Complainants’ direct competitors and information about the Complainants.

POSITION OF THE COMPLAINANT

12. The Complainants submit that:

(a) CONFUSINGLY SIMILAR

The disputed domain name is confusingly similar with a Mark in which the Complainants had rights prior to the date of registration of the domain name and continue to have such rights.

The Complainant HMV is the owner of the HMV Trade-marks and has rights in those marks in accordance with paragraph 3.2(c) of the Policy. Further, the Complainant HMV Canada has rights in the HMV Canada Trade Name dating back decades, and continues to have such rights as per paragraph 3.2(a).

The Registrant registered the disputed domain name on September 10, 2011. All the HMV trade-marks matured to registration well before the registration date of the disputed domain name, the earliest of which, Registration No. TMA351924, matured to registration on February 24, 1989. Further, the HMV Canada Trade Name has been used in Canada for decades and well before the September 10, 2011 domain name registration date.

The disputed domain name is confusingly similar with the trademarks and trade name as they so nearly resembles same in appearance, sound or in the ideas suggested so as to be likely to be mistaken for the mark.

(b) REGISTRATION OF HMVCANADA.CA IN BAD FAITH

Disrupt A Competitor - Paragraph 3.5(c)

The Registrant registered the disputed domain name primarily for the purpose of disrupting the business of the Complainants.

Within the meaning of paragraph 3.5(c) of the Policy, the use of the disputed domain name is likely to result in potential consumers being confused or misled into believing that the Registrant is somehow affiliated with, or endorsed by, the Complainants. The disputed domain name has been made to resolve to a website that creates the overall commercial impression that it is affiliated with, or otherwise endorsed by the Complainants. The website is heavily populated with advertisements that resolve to websites that promote the sale of various wares and services of competitors of the Complainants.

The Registrant not only knew the diversion of internet users to the Registrant's website would be disruptive, but also intended it to be so.

Intentionally Attract Traffic For Commercial Gain - Paragraph 3.5(d)

The Complainants also rely on paragraph 3.5(d) and submit that the Registrant intentionally attempted to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainants' marks and trade name 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.

It is also submitted that numerous UDRP Panels have held that directing a domain name that is confusing with a third party trade-mark to a website designed to derive revenue by way of advertisements constitutes bad faith as per paragraph 4(b)(iv) ; See : *Research In Motion Limited v. International Domain Names Inc./Moniker Privacy Services*, WIPO Case No. D2008-0780; *Lowen Corporation d/b/a Lowen Sign Company v. Henry Chan*, WIPO Case No. D2004-0430.

Moreover, a registrant is responsible for the content of any webpage hosted at the disputed domain name: *Port Aventura, S.A. v. Fred McCaw c/o Chelsey McCaw Publishing, Inc.*, WIPO Case No. D2008-0177; *Villeroy & Boch AG v. Mario Pingerna*, WIPO Case No. D2007-1912; *Ogden Publications, Inc. v. Motheearthnews.Com c/o Whois IDentity Shield/Ogden Publications Inc., Administrator, Domain*, WIPO Case No. D2007-1373.

Presence of a Disclaimer

As per the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition, the consensus view is that "the existence of a disclaimer cannot by itself cure bad

faith, when bad faith has been established by other factors". See : (*AARC Inc. v. Jayashankar Balaraman*, WIPO Case No. D2007-0578).

In this case, the presence of a disclaimer does not cure bad faith, particularly in light of the gross misappropriation of the Complainants' intellectual property together with the other bad faith factors referred to herein.

General

Given its wholesale incorporation of the HVM trade-mark and the HVM Canada Trade Name in the disputed domain name together with the content on the Registrant's Website, the only reasonable conclusion is that the Registrant had actual knowledge of the HVM Trade-marks, thereby supporting a finding of bad faith.

(C) NO LEGITIMATE INTEREST IN THE DOMAIN NAME

The Registrant has no legitimate interest in the disputed domain name as described in paragraph 3.4

No Relationship Between the Parties

There has never been any relationship between the Complainants and the Registrant, and the Registrant has never been licensed, or otherwise authorized to register or use, the HVM Trade-marks and the HVM Canada Trade Name in any manner whatsoever, including in, or as part of, a domain name.

Paragraph 3.4(a)

The disputed domain name has not been used as a Mark as defined by the Policy, namely "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". It follows that the Registrant cannot claim Rights in the disputed domain name. In any event, the disputed domain name was not acquired in good faith or for a *bona fide* purpose.

Paragraph 3.4(b)

The Registrant has not used the disputed domain name in good faith in association with any wares, services or business, and the Domain Name is not clearly descriptive in any of the senses stipulated by this paragraph.

Paragraph 3.4(c)

The Registrant cannot claim a legitimate interest in the disputed domain name, as hmvcanada.ca is not generic of any wares, services or business, nor has the disputed domain name been used in good faith or for a *bona fide* purpose.

Paragraph 3.4(d)

The Registrant has never used the disputed domain name in association with a non-commercial activity, and therefore cannot invoke paragraph 3.4(d) of the Policy.

Paragraph 3.4(e)

The disputed domain name is not a legal name, surname, or other reference, by which the Registrant is commonly identified, and accordingly, the Registrant cannot rely on paragraph 3.4(e) of the Policy.

Paragraph 3.4(f)

The disputed domain name is not the geographical name of the location of the Registrant's non-commercial activity or place of business.

The Registrant does not have a legitimate interest in the disputed domain name, and is therefore removed from the application of paragraph 3.4 of the Policy.

CONCLUSION

The factual matrix demonstrates that the disputed domain name was registered in bad faith and that the Registrant has no entitlement to it. In particular, the Complainants note as follows:

- (a) The disputed domain name is confusingly similar with the HVM Trade-marks and the HVM Canada Trade Name, in which the Complainants had rights prior to the registration date of the disputed domain name, and continue to have such rights.
- (b) The Registrant registered the disputed domain name for the purpose of disrupting the business of the Complainants.
- (c) The Registrant intentionally attempted to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainants' marks and trade name as to the source, sponsorship, affiliation, or endorsement.
- (d) The Registrant does not have a legitimate interest in the disputed domain name, as he has not brought himself within any of the circumstances specified by paragraph 3.4.

On or about November 10, 2011 the Complainants attorneys sent a cease and desist letter to the Registrant, which was delivered, as the Registrant replied to the effect that he offered to “modify” the website so as to reduce the likelihood of confusion. However, the Registrant, despite further representations, has failed to transfer the disputed domain name to the Complainants.

DISCUSSION

CONFUSINGLY SIMILAR

13. Under paragraph 4.1 of the Policy the Complainant must prove on the 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.

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.”

The Registrant has filed no response to the Complaint and, accordingly, the Registrant has provided no evidence of legitimate use.

The panel finds that the disputed domain name is confusingly similar to the Complainants’ HMV mark, being, within the meaning of paragraph 4.1 of the Policy, “a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights”. That is so for the following reasons.

The Complainants have adduced evidence, which the panel accepts, that HMV is the owner of the HMV trademarks and accordingly, as the two companies are associated, the Panel finds that the Complainants have rights in the HMV Trade-marks and continue to

have such rights. Further, the Complainant HMV Canada has rights in the HMV Canada Trade Name dating back decades and, together with HMV, continues to have such rights.

The test of whether a domain name is confusingly similar with a mark or trade name, pursuant to paragraph 3.3 of the Policy is if it so nearly resembles same in appearance, sound or in the ideas suggested so as to be likely to be mistaken for the mark. In undertaking that exercise, Paragraph 1.2 of the Policy provides that a domain name is defined so as to exclude the “dot-ca” suffix; see: *Coca-Cola Ltd. v. Amos B. Heman*, BCICAC Case No. 00014.

The Panel has undertaken the comparison between the disputed domain name and the HMV trademarks and trade name and finds that, as the dominant feature of the domain name is the HMV element, it so nearly resembles the trademark and trade name in appearance, sound and the ideas suggested as to be likely to be mistaken for the mark. The HMV name is so well established and so prestigious as one of the most famous marks and names in the world, that the objective bystander would naturally assume that the HMV of the domain name was invoking the HMV of the trademark and trade name and that it was an official HMV domain name leading to an official HMV website. Moreover, it has been widely held that when a trademark is incorporated in a domain name and there is added to it a generic word or expression or, as in the present case, a geographic indicator, internet users would naturally assume that the domain name was referring to the activities of the trademark owner with the ambit described by the addition; in the present case, they would take the domain name to be referring to the activities of the Complainants specifically in Canada.

Moreover, as the Complainants point out, if the trademark is included in the disputed domain name, this will not benefit the Registrant as he cannot avoid a finding of confusion by appropriating another’s entire mark in a domain name: *RGIS Inventory Specialists v. AccuTrak Inventory*, BCICAC Case No. 00053; *Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)*, BCICAC Case No. 00020. Applying that principle to the present case, the disputed domain name incorporates the whole of the registered HMV trade-mark and the whole of the distinctive HMV element of the HMV Trade-marks is incorporated in the disputed domain name. Accordingly, the Panel finds that the Registrant cannot avoid a finding of confusion as he has misappropriated the entirety of the HMV trade-mark.

In addition, the disputed domain name is identical to the HMV Canada Trade Name.

Accordingly, the Panel finds that the disputed domain name is confusingly similar with the HMV Trade-marks and the HMV Canada Trade Name in which the Complainants had rights prior to its registration date and continue to have such rights.

REGISTRATION OF HMVCANADA.CA IN BAD FAITH

14. The Panel now turns to the second issue which is whether the disputed domain name was registered in bad faith. The Panel finds that, on each of the grounds relied on by the Complainants, the Registrant registered the disputed domain name in bad faith. The Panel will consider each of those grounds in turn.

Disrupt A Competitor - Paragraph 3.5(c)

The Complainants have submitted that the Registrant registered the domain name <hmvcanada.ca> primarily for the purpose of disrupting the business of the Complainants. The Panel accepts that submission and finds accordingly. This finding is directly in point with the decision cited by the Complainants, *Credit Counselling Society of British Columbia v. Solutions Credit Counselling Service Inc.*, BCICAC Case No. 00031, where the panel observed :

We infer that the Registrant was aware of the Use by the Complainant. Indeed, the Registrant has not denied this knowledge and, as noted above, in a fashion admitted it. The Registrant has failed to provide any explanation for its registration of the Domain Name. We therefore infer that it registered the Domain Name with a view to attract to itself business from those who had come to recognize the Complainant's Mark, that is primarily for the purpose of disrupting the business of the Complainant.

Applying that principle to the present case, the Panel concludes that, as the disputed domain name is identical to the HVM Canada Trade Name and incorporates the whole of the HVM registered trade-mark, the use of the disputed domain name in the manner shown by the Complainants must result in internet users thinking that the Registrant is by some means affiliated with, or endorsed by, the Complainants. That must surely be so in a case such as this where HVM is truly a famous mark and has been so for many years. When a Registrant takes a famous name and, without permission or authority, uses it as the basis for a domain name and then a website that promotes competing goods and services, the only rational conclusion that can be reached is that this was being done by the Registrant to disrupt the Complainants' business and divert that business to the Registrant.

It is also true, as the Complainants submit, that the unauthorized diversion of Internet traffic harms the valuable goodwill subsisting in the HVM Trade-marks and that is a further disruption to the Complainants.

The Panel also agrees with the conclusion of the Complainants that this diversion must have been known to the Registrant to be disruptive of the Complainants' business and was intended by him to be so. It must be inferred that the purpose of the registration of the disputed domain name was to piggyback on the tremendous goodwill built up over

the years by the Complainants and associated with the HMV Trade-marks and the HMV Canada Trade Name in an attempt to divert Internet traffic destined for the Complainants.

All of those factors go to show a very bad case of registration of a domain name in bad faith.

For these reasons the Panel finds that the Registrant registered the domain name <hmvcanada.ca> primarily for the purpose of disrupting the business of the Complainants.

Intentionally Attract Traffic For Commercial Gain - Paragraph 3.5(d)

15. The Panel also finds that within the meaning of paragraph 3.5(d) of the Policy, the Registrant intentionally attempted to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainants' marks and trade name 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. That is so because it has been held by past UDRP Panels that directing a domain name that is confusing with a third party trade-mark to a website designed to derive revenue by way of advertisements constitutes bad faith as per paragraph 4(b)(iv) of the UDRP. See: *Research In Motion Limited v. International Domain Names Inc. /Moniker Privacy Services*, WIPO Case No. D2008-0780; *Lowen Corporation d/b/a Lowen Sign Company v. Henry Chan*, WIPO Case No. D2004-0430.

Applying that principle to the present case, it is plain that as the disputed domain name contains the whole of the HMV registered trade-mark, it is confusing with the HMV Trade-marks and is identical to the HMV Canada Trade Name. That being so, the disputed domain name is, within the meaning of paragraph 3.5(d), being used in an attempt intentionally to attract, for commercial gain, Internet users to the Registrant's Website by creating a likelihood of confusion with the subject marks and trade name as to source, sponsorship, affiliation or endorsement.

It must also be inferred from the evidence that the Registrant had actual knowledge of the HMV Trade-marks, thereby supporting a finding of bad faith. This actual knowledge was indeed confirmed by the Registrant in his exchange of communications with the Complainants, referred to above.

Nor does the disclaimer prevent such a finding of bad faith.

Accordingly, the Panel finds that the Registrant registered the disputed domain name in bad faith within the meaning of paragraph 3.5(d) of the Policy.

NO LEGITIMATE INTEREST IN THE DOMAIN NAME

16. Paragraph 4.1 (c) of the Policy requires the Complainant to provide some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

The Panel finds that the Complainants have provided such evidence. The evidence has already been mentioned above, but in essence it is as follows:

- (a) The registration and use by the Registrant of the disputed domain name has been without the permission of the Complainants and there is no relationship between them and the Registrant;
- (b) A disclaimer on the website cannot legitimize an illegitimate domain name registration and the registration of the domain name in this proceeding was wholly illegitimate; see: *Estée Lauder Inc. v. estelauder.com, estelauder.net and Jeff Hanna*, WIPO Case No. D2000-0869.
- (c) The disputed domain name domain name has not been used as a Mark “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”.
- (d) The disputed domain name was not acquired in good faith or for a *bona fide* purpose because it is confusing with the Complainants’ HVM Trade-marks and the HVM Canada Trade Name to which the Registrant has no entitlement and the presence of advertisements for the goods and services of competitors of the Complainants shows that the registration and use of the domain name has been for illegitimate purposes.
- (e) The Registrant has not use the disputed domain name in good faith in association with any wares, services or business, and the Domain Name is not clearly descriptive.
- (f) The disputed domain name is not generic of any wares, services or business, nor has it been used in good faith or for a *bona fide* purpose.
- (g) The Registrant has never used the disputed domain name in association with a non-commercial activity.
- (h) HVM Canada is not a legal name, surname, or other reference, by which the Registrant is commonly identified.

- (i) The disputed domain name is not the geographical name of the location of the Registrant's non-commercial activity or place of business.

The Panel accepts the submission of the Complainants that the above matters constitute evidence that the Registrant has no legitimate interest in the disputed domain name and makes a finding to that effect.

As the Registrant has not filed a response to the Complaint or sought to rebut the above evidence, he has provided no evidence of legitimate use.

DECISION

The Panel finds that the Complainants have satisfied the requirements of Paragraph 4.1 of the Policy and that they are entitled to the remedy they seek.

ORDER

The Panel directs that the registration of the Domain Name <**hmvcanda.ca**> be transferred from the Registrant to the first named Complainant HMV (IP) Limited.

Date: March 25, 2012

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

The Honourable Neil Anthony Brown QC