

IN THE MATTER OF THE ARBITRATION OF A COMPLAINT PURSUANT TO THE
CANADIAN INTERNET REGISTRATION AUTHORITY (CIRA) DOMAIN NAME
DISPUTE RESOLUTION POLICY (CDRP)

Domain in Dispute: mtvjerseyshore.ca
Complainant: Viacom International Inc.
Registrant: W. Ryan Sutherland
Registrar: Go Daddy Domains Canada, Inc.
BCICAC File: DCA-1424-CIRA

DECISION

1. The Parties

Complainant is Viacom International Inc. of New York, New York, USA, represented by Eric Macramalla of Gowling Lafleur Henderson LLP of Ottawa, Ontario, Canada.

Registrant is W. Ryan Sutherland of Victoria, British Columbia, Canada. The Registrant did not file a Response.

2. The Domain Name and Registrar

The disputed domain name is <mtvjerseyshore.ca> (the “Disputed Domain Name”), which was created on October 25, 2011.

3. Governing Policy and Rules

This is a proceeding under the CIRA Domain Name Dispute Resolution Policy, Version 1.3 (August 22, 2011) (“Policy”) and the CIRA Domain Name Dispute Resolution Rules, Version 1.4 (August 22, 2011) (“Resolution Rules”). Paragraph 1.8 of the Policy states: “The version of the Policy in effect at the time a Proceeding is initiated will apply to the Proceeding.” And, paragraph 1.2 of the Rules states: “The version of the Resolution Rules in effect at the time a Proceeding is initiated will apply to that Proceeding.” Accordingly, because the British Columbia International Commercial Arbitration Centre (“BCICAC”) states that the Complaint was filed on September 21, 2012, this Decision is based upon Version 1.3 of the Policy and Version 1.4 of the Resolution Rules.

4. Procedural History

The history of this proceeding, according to the information provided by BCICAC, is as follows:

- a. On September 21, 2012, Complainant filed a Complaint pursuant to the Policy and the Resolution Rules.

- b. In a letter dated September 21, 2012, BCICAC confirmed compliance of the Complaint and commencement of the dispute resolution process. BCICAC forwarded a copy of the Complaint to the Registrant.
- c. The Registrant has not provided a Response. The Complainant has elected to convert from a panel of three to a single arbitrator.
- d. BCICAC appointed Douglas M. Isenberg as sole arbitrator on October 16, 2012. The undersigned has executed a document titled "Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality."
- e. Absent exceptional circumstances, and pursuant to Rule 12.2, the Panel's decision is to be delivered to BCICAC by November 6, 2012.

The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Resolution Rules. Based upon the information provided by the BCICAC, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding, unless otherwise noted, have been met.

5. Canadian Presence Requirement

Paragraph 1.4 of the Policy states: "The person initiating a Proceeding (the 'Complainant') must, at the time of submitting a complaint (the 'Complaint'), satisfy the Canadian Presence Requirements for Registrants (the 'CPR') in respect of the domain name that is the subject of the Proceeding unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office ('CIPO') and the Complainant is the owner of the trade-mark." Here, as discussed below, it is evident that the Complainant is the owner of numerous relevant trade-marks at CIPO, including Reg. No. TMA398119 for the trade-mark MTV. As a result, the Panel is satisfied that the Complainant meets the Canadian Presence Requirements and is eligible to initiate this proceeding.

6. Factual Background and Parties' Contentions

Complainant states that it is "a leading global media company, with preeminent positions in broadcast and cable television, radio and on the Internet", whose brands include MTV – which has been in operation since 1981 and is "the world's most watched television network, reaching over 600 million households worldwide, in 150 countries, through 58 localized television channels and 40 websites."

Complainant further states, and has provided evidence in support thereof, that it is the owner of the following trade-mark registrations at CIPO:

Trade-mark	Reg. No.	Registration Date
MUSIC TELEVISION & Design	TMA332870	October 9, 1987
MTV Design	TMA348656	December 2, 1998
MTV	TMA398119	May 15, 1992
MTV/MUSIC TELEVISION Design	TMA398120	May 15, 1992
MTV2	TMA582871	April 6, 2001
MTV OVERDRIVE Design	TMA692713	July 24, 2007
MTV Design	TMA720096	July 31, 2008
MTV2 & Design	TMA796437	May 2, 2011

These trade-marks are referred to hereafter collectively as the “MTV Trade-mark.”

Complainant further states that it has used and continues to use the trademark JERSEY SHORE (the “JERSEY SHORE Trade-mark”) in Canada since at least as early as December 2009, in connection with a reality television series. Complainant states that this television series “prominently features” the JERSEY SHORE Trade-mark, which, as shown in an exhibit provided by Complainant, is also used on Complainant’s website and in its promotional materials. Complainant filed on April 19, 2010, a trademark application at CIPO for the JERSEY SHORE Trade-mark, App. No. 1,477,472.

Complainant further states, and has provided evidence in support thereof, that the Disputed Domain Name “makes unauthorized use of the Complainant’s trade-marks and images, and is heavily populated with advertisements,” including an advertisement that “offers rebates for various products.” As shown in a printout provided by Complainant, this website contains photographs of cast members of Complainant’s “Jersey Shore” television show along with blog entries about the show. Complainant further states: “Disguised as a fan or information website, the Registrant’s website is actually designed to generate revenue by infringing the Complainant’s very valuable intellectual property.”

Complainant states that it sent two demand letters to the Registrant about the Disputed Domain Name, on March 1, 2012, and March 23, 2012, copies of which were provided as exhibits to the Complaint, but that the Registrant has never responded to these letters.

Complainant further states, and has provided evidence in support thereof, that the Registrant “operates a network of similar commercial websites in the field of entertainment that have misappropriated third party intellectual property with a view to extracting a financial benefit,” including those containing trade-marks owned by, among others, Britney Spears; Home Box Office, Inc.; and the National Hockey League.

Complainant contends that the Disputed Domain Name is confusingly similar to the MTV Trade-mark and the JERSEY SHORE Trade-mark; and that Complainant has rights in these trade-marks that pre-date the registration date of the Disputed Domain Name and that Complainant continues to have such rights.

Complainant further contends that Registrant has no legitimate interest in the Disputed Domain Name because, *inter alia*, (1) “[t]here has never been any relationship between the Complainant and the Registrant, and the Registrant has never been licensed, or otherwise authorized to register or use, the [MTV Trade-mark or the JERSEY SHORE Trade-mark] in any manner whatsoever, including in, or as part of, a domain name”; (2) “[t]he Registrant has not used mtvjerseyshore.ca in good faith in association with any wares, services or business, and the Domain Name is not clearly descriptive”; (3) “[t]he Registrant cannot claim a legitimate interest in the disputed domain name, as mtvjerseyshore.ca is not generic of any wares, services or business, nor has the Domain Name been used in good faith or for a *bona fide* purpose”; (4) “[t]he Registrant has never used the Domain Name in association with a non-commercial activity”; (5) “MTV JERSEY SHORE is not a legal name, surname, or other reference, by which the Registrant is commonly identified”; and (6) “[t]he Domain Name is not the geographical name of the location of the Registrant’s non-commercial activity or place of business.”

Complainant further contends that the Registrant should be considered as having registered the Disputed Domain Name in bad faith because, *inter alia*, (1) “the Registrant has engaged in an unauthorized pattern of domain name registrations, having registered at least 19 domain names to which he is not entitled, and has prevented the Complainant from registering the disputed domain name”; (2) “the Registrant’s use is disruptive to the Complainant, as potential consumers are likely to be confused into believing that the Registrant’s website is somehow affiliated with, or sponsored by, the Complainant”; and (3) “the Registrant intentionally attempted to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the [MTV Trade-mark or the JERSEY SHORE Trade-mark] as to the source, sponsorship, affiliation or endorsement.”

Complainant requests that the Disputed Domain Name be transferred from the Registrant to the Complainant.

The Respondent did not file a Response.

7. Discussion and Findings

To obtain a transfer of the Disputed Domain Name, Complainant must, as set forth in paragraph 4.1 of the Policy, 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.

Confusingly Similar

With respect to paragraph 3.1(a) of the Policy, regarding confusing similarity, the Panel finds that, based upon Complainant's representations, including printouts from the CIPO website, Complainant has rights in the MTV Trade-mark, which was first registered in Canada on October 9, 1987, and that these rights pre-date creation of the Disputed Domain Name, which occurred on October 25, 2011. With respect to the JERSEY SHORE Trade-mark, the Panel finds that Complainant has established common law rights sufficient for purposes of the Policy. See, e.g., *Ontario Physical And Health Education Association v. Jump-Aerobics Inc.*, CIRA Case No. 00197 (transfer of <ophea.ca>); and *The Governing Council of the University of Toronto v. MetCap Living Management Inc.*, CIRA Case No. 00127 (transfer of <utorontohousing.ca>).

As to whether the Disputed Domain Name is confusingly similar to the MTV Trade-mark and/or the JERSEY SHORE Trade-mark, paragraph 3.3 of the Policy states: "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 the ideas suggested by the Mark as to be likely to be mistaken for the Mark." This Panel agrees with the decision cited by Complainant, *RGIS Inventory Specialists v. AccuTrak Inventory*, CIRA Case No. 899 (transfer of <rgis.ca>), in which the panel there found confusing similarity where the disputed domain name "misappropriated the entirety of the registered trade-mark." In the instant case, the Disputed Domain Name <mtvjerseystore.ca> not only incorporates the entirety of the registered MTV Trade-mark, but it also includes the entirety of the common law JERSEY SHORE Trade-mark.

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(a) of the Policy.

No Legitimate Interest

With respect to paragraph 3.1(b) of the Policy, regarding a lack of legitimate interests, the Panel is satisfied that the Complainant has established, on a balance of probabilities, that the Registrant does not have a legitimate interest in the Disputed Domain Name. The Registrant, by failing to submit a Response, has not made any attempt to rebut Complainant's allegations or argue that it has a legitimate interest in the Disputed Domain Name under any of the six elements described in paragraph 3.4 of the Policy. Under these circumstances, the lack of a response is fatal to the Registrant. See, e.g., *Cointreau v. Netnic Corporation*, CIRA Case No. 00180 ("[t]here is no evidence from the 'customer' about its 'interest' in the Domain Name"); and *General Motors LLC v. Tony Wilson*, CIRA Case No. 00182 ("the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name and this evidence has not been rebutted by the Registrant").

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(b) of the Policy.

Bad Faith

With respect to paragraph 3.1(c) of the Policy, regarding bad faith, the Panel notes that a Registrant will be considered to have registered a domain name in bad faith if, *inter alia*:

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.

Policy, paragraph 3.5(d).

Here, Complainant alleges that bad faith exists pursuant to this paragraph (among others) because:

The domain name *mtvjerseyshore.ca* incorporates the whole of the MTV and JERSEY SHORE trade-marks. As a result, 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 Complainant. This is particularly the case given the fame of the MTV trade-mark. As well, the postings are indicated as having been authored by "MTV Jersey Shore", which only further confuses or misleads end users as to source or sponsorship.

Further, the numerous advertisements on the Registrant's website put him in a position to reap a financial or commercial benefit.

In support thereof, Complainant cites several previous decisions under the Policy, including *Bell Canada v. Archer Entreprises*, BCICAC Case No. 00038; *Yamaha Corporation and Yamaha Motor Canada Inc. v. Jim Yoon*, BCICAC Case No. 00089; *Glaxo Group Ltd. v. Turvill Consultants*, BCICAC, Case No. 00044; and *Credit Counselling Society of British Columbia v. Solutions Credit Counselling Service Inc.*, BCICAC Case No. 00031. In the *Credit Counselling* decision, the panel there wrote:

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.

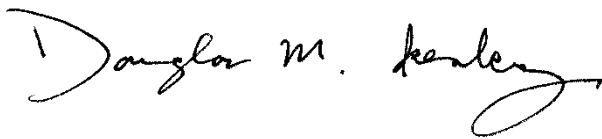
Here, the Panel finds that, by using a domain name containing both the MTV Trade-mark and the JERSEY SHORE Trade-mark, in connection with a website that contains advertisements plus

photographs and blog entries about Complainant's Jersey Shore television show, the Registrant has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trade-marks as to the source, sponsorship, affiliation, or endorsement of the Registrant's website, in violation of paragraph 3.5(d) of the Policy.

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(c) of the Policy.

8. Decision

For all the foregoing reasons, in accordance with paragraph 4.3 of the Policy, the Panel orders that the Disputed Domain Name <mtvjerseyshore.ca> be transferred to Complainant.

A handwritten signature in black ink that reads "Douglas M. Isenberg". The signature is written in a cursive style with a large, looped initial 'D' and a long, sweeping underline.

Douglas M. Isenberg, sole arbitrator

Dated: November 6, 2012