

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

Dispute Number: DCA- 1428– CIRA
Domain(s) in Dispute: GBING.CA
Complainant: Microsoft Corporation
Registrant: Sripaskaran Ratansothy
Registrar: Go Daddy Domains Canada Inc..
Service Provider: British Columbia International Commercial Arbitration Centre
Panel: The Hon. Neil Brown, Melvyn J. Simburg and Elizabeth Cuddihy (Chair)

DECISION

The Parties

1. The Complainant is Microsoft Corporation of One Microsoft Way, Redmond, Washington 98052-6399, United States of America, (the “Complainant”).
2. The Registrant is Sripaskaran Ratansothy of 86 Hisey Crescent, Toronto, Ontario M3N 1V1 (the “Registrant”).

The Disputed Domain Name and Registrar

3. The Domain name at issue is GBING.CA, (the “Disputed Domain Name”).
4. The Registrar on the date of the Complaint is Go Daddy Domains Canada Inc.
5. The Disputed Domain Name was registered on August 4, 2009.

Procedural History

6. The British Columbia International Commercial Arbitration Centre (“BCICAC”) is a recognized service provider to the Domain Name Dispute Resolution Policy (the “Policy”) and Rules (the “Rules”) of the Canadian Internet Registration Authority (“CIRA”).
7. The Complainant filed a complaint dated September 28, 2012, (the “Complaint”) with the BCICAC seeking an order in accordance with the Policy and the Rules directing that the registration of the Disputed Domain Name be transferred to the Complainant forthwith.

8. The BCICAC determined the Complaint to be in administrative compliance with the requirement of the Rules, and, by letter and email dated October 1, 2012 so advised the parties and forwarded a copy of the Complaint to the Registrant by email and courier.

9. The Registrant failed to submit a Response within the timeframe provided pursuant to the Rules and by letter dated October 30, 2012, the Complainant elected to proceed with a three person panel to determine the matter.

10. By letter dated November 15, 2012, the BCICAC appointed the above-named persons as a three-person panel (the "Panel").

11. Relying on the BCICAC, the Panel deems that it has been properly constituted as the three member panel to determine the Complaint in accordance with the Rules.

12. The Registrant, having not provided any Response to the Complaint, the Panel shall determine the matter on the basis of the Complaint.

Canadian Presence Requirements

13. The Canadian Presence Requirements for Registrants (the "Presence Requirements") require that in order for a Registrant to be permitted to apply for registration of, and to hold and maintain the registration of a dot ca domain name, the applicant must meet at least one of the criteria listed as establishing a Canadian presence. Section 2(q) of the Presence Requirements specifies that a Person which does not meet any of the conditions specified in section 2 (a) to (p) inclusively, but which is the owner of a trade-mark which is the subject of a registration under the *Trade-marks Act (Canada)* R.S.C. 1985, c.T-13 as amended from time to time, satisfies the requirement, provided the .ca domain name consists or includes the exact word component of that registered trade-mark.

14. The Complainant is the owner of the following trade-marks, (collectively the "BING Mark"), registered in the Canadian Intellectual Property Office, ("CIPO"):

BING, filed March 3, 2009, registered April 20, 2010, registration No. TMA764,459;
BING, filed March 3, 2009, registered March 28, 2011, registration No. TMA794,019 ; and
bing
BING DESIGN, filed October 18, 2010, registered September 26, 2011, registration No
TMA807,603

Accordingly, as the Complaint relates to a Disputed Domain Name which includes the exact word component of a Mark registered in CIPO and owned by the Complainant, the Canadian Presence Requirements are satisfied.

The Position of the Parties

The Complainant's Position

15. The Complainant was founded in 1975 and is a worldwide leader in software services and solutions that help people and businesses realize their full potential. The Complainant provides, among other things, consumers and businesses with online search, news, travel, shopping and information services under the BING Mark, ("BING Services").

16. The Complainant officially introduced the BING Mark to the press and public on May 28, 2009. The BING Services were fully deployed and available to the public worldwide by June 3, 2009 and the Complainant continues to provide BING Services worldwide.

17. Thereafter, prior to the registration of the Disputed Domain Name, the BING Mark became famous and acquired secondary meaning through unprecedented global coverage.

18. The Complainant has registered the BING Mark internationally, including Canada. The Complainant generates over \$10 million in annual revenues in Canada through services provided in association with the BING Mark. The Complainant's website BING has attracted millions of users in Canada.

19. The Registrant registered the Disputed Domain Name on August 4, 2009. The Disputed Domain Name web site provides Internet search services which directly compete with the Complainant's BING Services.

20. The Complainant is in no way associated or affiliated with the Registrant and has not licensed or authorized the use of the BING Mark on the Registrant's web site.

21. Further the Complainant alleges that it has no control over the use of the BING Mark by the Registrant as part of the Disputed Domain Name, nor of the Registrant's web site. Accordingly, any issues or concerns users have with the Registrant's search services will cause harm to the Complainant.

22. The Complainant, as owner of the BING Mark registered in CIPO, which Mark was well known to the public prior to the registration of the Disputed Domain Name by the Registrant, claims that the Disputed

Domain Name is confusingly similar to the Complainant's Mark, in which the Complainant had rights prior to the registration of the Disputed Domain Name, that the Registrant registered the Disputed Domain Name in bad faith and that the Registrant has no interest in the Disputed Domain Name. Accordingly the Complainant requests an Order transferring the Disputed Domain Name to the Complainant forthwith.

The Registrant's Position

23. The Registrant did not file a Response.

Analysis and Findings

24. The purpose of the Policy as stated in paragraph 1.1 of the Policy is to provide a forum by which cases of bad faith registration of dot-ca domain names can be dealt with relatively inexpensively and quickly. The Policy does not apply to other types of differences between owners of trade-marks and Registrants of Domain names.

Relevant provisions of the Policy are provided below

25. Paragraph 4.1 of the Policy provides

4.1 **Onus.** To succeed in a 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 3.5; 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.

26. Paragraph 3.2 of the Policy provides in part

3.2 **Mark.** A "Mark" is

(a) A trademark, including the word elements of a design mark, or a trade name that has been used in Canada by a person, or a 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 for the wares, services or business of another person;

27. Paragraph 3.3 provides

3.3 **Confusingly Similar.** 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.

28. Paragraph 3.4 provides:

3.4 **Legitimate Interest.** For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in the domain name:

(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 registered 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 Registrant includes, but is not limited to, use to identify a web site.

29. Paragraph 3.5 provides:

3.5 **Registration in Bad Faith.** For the purposes of paragraph 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:

(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 Registrants’ 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 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;

(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; or

(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.

30. In summary, to succeed in a proceeding, the Complainant must prove on a balance of probabilities that:

1. The dot-ca domain name is confusingly similar to a Mark in which the Complainant had rights prior to the registration of the domain name and continues to have such rights;
2. The Registrant has registered the domain name in bad faith; and
3. The Complainant must provide some evidence that the Registrant has no legitimate interest in the domain name.

Notwithstanding the above, the Registrant will succeed if the Registrant proves on a balance of probabilities that he has a legitimate interest in the domain name.

Confusingly Similar

31. Founded in 1975, the Complainant is a worldwide leader in software services and solutions and provides consumers and businesses with online search, news, travel, shopping and information services under the BING Mark.

32. Evidence shows that the Complainant is the owner of the marks BING and BING Design as registered in CIPO April 20, 2010, March 28, 2011 and September 26, 2011 respectively and internationally as early as November 2008. The Complainant filed two applications for registration at CIPO for the word mark BING on March 3, 2009. Evidence further shows that prior to April 20, 2010, on May 28, 2009 the Complainant's BING Mark was officially introduced to the press and public and by June 3, 2009, BING Services were fully deployed and available worldwide. Evidence further shows that the Complainant continues to provide BING Services worldwide. Accordingly BING is a Mark in accordance with the Policy in which the Complainant had rights at least as early as May 28, 2009.

33. In accordance with Paragraph 3.3 of the Policy, 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 mistaken for the Mark.

34. In assessing similarity, Paragraph 1.2 of the Policy provides that the dot-ca suffix of the domain name is ignored. It is the narrow resemblance test that is applied.

35. The Disputed Domain Name simply adds the letter "G" to the Complainant's well-known BING Mark. The BING Mark is clearly seen in the Disputed Domain Name GBING.CA.

36. Accordingly for the reasons noted above, the Disputed Domain Name is confusingly similar to the Complainant's BING Mark.

Rights in the Mark prior to the registration of the Disputed Domain Name and continuing rights

37. As noted in paragraphs 31 and 32 above, the Complainant was founded in 1975 and provides BING Services worldwide under the BING Mark since as early as June 3, 2009. The Complainant's applications for registration for the word mark BING at CIPO were filed on March 3, 2009.

38. Since its launch, the BING web site has attracted millions of users in Canada. Approximately 8.5 million unique users visit the BING web site per month and the Complainant generates over \$10 million in annual revenues through services provided in association with the BING Mark.

39. As noted in a hearing relating to another top level domain name, the panel recognized the global scale of the launch of the BING services and was satisfied that the word BING had acquired secondary meaning through the Complainant's use of it by May 28, 2009, the launch date of the Complainant's search engine. (*Microsoft Corp. v. None a/k/a Prakash Prasad Timilsina*, FA0906001271165 Nat. Arb. Forum, July 30, 2009, page 8).

40. Another dispute resolution panel noted that the press began speculating as to the Complainant's likely adoption of the BING trade-mark as early as August 1, 2008 and that by March 2009, the Complainant's BING trade-mark would have been known to a significant section of the public. (*Microsoft Corp. v. Patrick McAuliffe*, FA0912001297333 Nat. Arb. Forum, December 29, 2009, page 6)

41. The Registrant registered the Disputed Domain Name on August 4, 2009.

42. Accordingly the Panel is satisfied that the Complainant had rights in the BING Mark as detailed above both on the basis of registration of the BING Mark in CIPO and the advertisement and use of the BING Mark. Furthermore, although the BING Mark was registered in CIPO after the registration of the Disputed Domain Name, the application for registration at CIPO was filed March 3, 2009 and the BING Mark was widely used and advertised prior to the date of registration of the Disputed Domain Name. At the present time the Complainant continues to have such rights. The Panel is accordingly satisfied that the Complainant has met its burden of proof in that regard.

Was the Disputed Domain Name registered in bad faith?

43. The Complainant relies on Paragraphs 3.5 (d), (a), (b) and (c) of the Policy in support of its claim.

Paragraph 3.5(d)

44. Referring to Paragraph 3.5 (d) of the Policy, the Complainant argues that the Registrant registered the Disputed Domain Name in an intentional attempt to attract, for commercial gain, Internet users to

the Registrant's web site or other on-line location, by creating a likelihood of confusion with the Complainant's BING Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product.

45. Evidence shows that the Registrant registered the Disputed Domain Name shortly after the global launch of the Complainant's BING web site and services. Further the Registrant's web site, GBING provides a competing Internet search service using the whole of the Complainant's BING Mark. The Registrant's home page GBING.CA has a large representation of the mark GBING which appears to be a combination of the first letter of Google, another popular Internet search engine, and the whole of the Complainant's BING Mark. Further the Registrant's home page appears to copy Google's use of different colours for each of the letters in GBING. Evidence further shows that the Registrant's web site uses Google Custom Search and AdSense for Search. This is a free product from Google that lets an owner of a web site place a Custom Search Engine on the web site to provide users with web searches. The owner of the web site earns revenue from relevant ads on the search results pages viewed by users. The Registrant's home page for GBING.CA also has a number of click-through advertisements for some of Canada's largest banks and financial institutions. A search of the CIPO database does not reveal any trade-mark registrations or applications for GBING or for GBING.CA.

46. It has been held that directing a domain name that is confusing with a third party trade-mark to a web site designed to derive revenue by way of advertisements constitutes bad faith. (*HMV(IP) LTD. v. Mateescu*, CIRA Dispute Resolution Case 00185, March 25, 2012, paragraph 15) The Panel agrees with that finding.

47. It is the view of the Panel that the Complainant has satisfied its burden of proof of bad faith as required pursuant to Paragraph 3.5(d) of the Policy.

Paragraph 3.5 (a)

48. Referring to Paragraph 3.5(a), of the Policy, the Complainant alleges that the Registrant registered the Disputed Domain Name primarily for the purpose of selling, renting or 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.

49. Evidence shows that following a request to the Registrant to cease use of the Complainant's BING Mark, the Registrant requested an offer to buy the Disputed Domain Name provided the offer was good enough. In response, the Complainant offered the Registrant's out of pocket expenses. There was no further response from the Registrant. As determined in *FNAC v. Fizbin Consultants, LLC*, D2005-0017, WIPO Arbitration and Mediation Center, February 25, 2005, page 8, the natural conclusion from the lack

of response to the Complainant's offer was that the Registrant was only prepared to enter an agreement to transfer the disputed domain name on the basis that more than out of pocket expenses would be paid.

50. The Panel agrees with that conclusion and is satisfied that the Complainant had shown bad faith by the Registrant in accordance with Paragraph 3.5(a) of the Policy.

Paragraph 3.5(b)

51. Referring to Paragraph 3.5(b) of the Policy, the Complainant alleges that the Registrant has registered the Disputed Domain Name in order to prevent the Complainant from registering the domain Name provided that the Registrant has engaged alone or in concert with others in a pattern of registering Third Party trade-marks. Evidence shows that the Registrant has registered at least two other domain names; namely, bestbuy4u.ca and mcaffecoffee.ca which contain famous trade-marks belonging to two other legal entities. In *Canadian Broadcasting Corporation v. Quan*, CIRA Dispute Resolution Case 00006, April 8, 2003, page 14, the Panel ruled that as few as two domain name registrations were sufficient to establish that a Registrant had engaged in a pattern of registering domain names that incorporate third party trade-marks.

52. The Panel agrees with that determination and is satisfied that the Complainant has satisfied its burden of proof in respect of Paragraph 3.5(b).

Paragraph 3.5(c)

53. Referring to Paragraph 3.5(c) of the Policy, the Complainant alleges that the Registrant registered the Disputed Domain Name primarily for the purpose of disrupting the business of the Complainant, who is a competitor of the Registrant.

54. Evidence shows that the Registrant who provides competing Internet search services registered a domain name which contains the whole of the Complainant's BING Mark, which is specifically used for Internet search services. This is likely to cause consumers to believe that the Registrant's Disputed Domain Name is endorsed, sponsored or approved by the Complainant, which is not the case.

55. The phrase "disrupting the business of the Complainant" has been interpreted as follows:

"[t]his disruption could occur only in the sense that persons encountering the domain name might conclude that the Registrant's business, associated with the domain name, was a business of the Complainant or was at least endorsed, sponsored or approved by the Complainant. Thus, the Complainant's business reputation would be put at risk by the Registrant's business conduct, over which the Complainant had no control."

Independent Order of Foresters v. Noredu Enterprises, o.a. Forester College of Technology (CIRA Dispute Resolution Case 00017, May 25, 2005, paragraph 26

56. The Complainant referred to *ABELSoft Corp. v. Nissanov* (CIRA Dispute Resolution Case 00082, September 25, 2007, page 4) where the Panel concluded that using a domain name confusingly similar to a Complainant's trade-mark with the effect of diverting potential customers to a web site of a competitor of the Complainant constituted disrupting the business of the Complainant.

57. The Panel agrees that the use of the domain name GBING, which is confusingly similar to the Complainant's BING Mark for the sole purpose of diverting users to a competing Internet search service leads to the conclusion that the Registrant registered the Disputed Domain Name primarily for the purpose of disrupting the business of the Complainant.

58. For the reasons noted above, the Panel is satisfied that the Complainant has met the burden of proof that the Registrant registered the Disputed Domain Name in bad faith as required by the Policy.

59. Legitimate Interest of the Registrant

60. The Panel is satisfied that the Complainant has provided some evidence that the Registrant does not have a legitimate interest in the Disputed Domain Name as required by paragraphs 3.4 and 4.1(c). The Registrant has provided no Response to the Complaint.

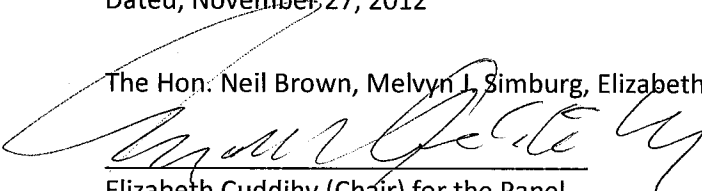
61. Accordingly the Panel concludes that the Registrant has no legitimate interest in the Disputed Domain Name.

Decision

62. For the reasons set out herein, the Panel decides in favour of the Complainant and orders the transfer of the Disputed Domain Name to the Complainant forthwith.

Dated, November 27, 2012

The Hon. Neil Brown, Melvyn J. Simburg, Elizabeth Cuddihy (Chair)


Elizabeth Cuddihy (Chair) for the Panel