

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number: DCA - 1898 - CIRA
Domain Names: cheapoairs.ca
Complainant: Fareportal, Inc
Registrant: Raha Marouf
Panel: Elizabeth Cuddihy
Service Provider: British Columbia International Commercial Arbitration
Centre

DECISION

The Parties

1. The complainant is Fareportal, Inc. of 135 West 50th Street, Suite 500, New York, New York 10020, United States of America, (the Complainant).
2. The Registrant is Raha Marouf of 6115 Yonge Street, Toronto, Ontario, Canada M2M 3W2, (the Registrant).

The Disputed Domain Name and Registrar

3. The Domain Name at issue is cheapoairs.ca, (the Disputed Domain Name).
4. The Registrar for the Disputed Domain Name is Namespro Solutions Inc.
5. The Disputed Domain Name was registered on January 18, 2016.

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 the Rules, (the Rules) of the Canadian Internet Registration Authority, (CIRA).
7. The Complainant filed a complaint on July 17, 2017, (the Complaint) with the BCICAC seeking an order in accordance with the Policy and the Rules that the Disputed Domain Name be transferred to the Complainant.

8. BCICAC confirmed the Complaint to be in administrative compliance with the Rules and the commencement of the dispute resolution process and forwarded copy of the Complaint to the Registrant in accordance with the Rules.
9. The Registrant did not provide a response within the timeframe required by the Rules.
10. The Complainant elected to convert to a single arbitrator in accordance with Rule 6.5 and the BCICAC nominated Elizabeth Cuddihy to act as sole arbitrator to determine the matter.
11. As prescribed by the Policy, the Panel has declared that it can act impartially and independently and that there are no circumstances known to the Panel which would prevent it from so doing.
12. As there was no Response to the Complaint, the Panel shall, in accordance with Rule 5.8, decide the Proceeding on the basis of the Complaint.

Canadian Presence Requirements

13. 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 Canadian Presence Requirements for Registrants, (the Presence Requirements) require that the applicant meet at least one of the criteria listed as establishing a Canadian presence.
14. The Complainant is the owner of Canadian Trade-mark registrations for CHEAPOAIR and CHEAPOAIR.CA registered in the Canadian Intellectual Property Office (CIPO) on July 19, 2011 and March 27, 2014 respectively as registration Numbers TMA041658 and TMA874324 respectively, (the Complainant's Mark).
15. The Complaint relates to a Disputed Domain Name, which includes the whole of the exact word component of the Complainant's Mark registered in CIPO, except for a single letter "s" added to the end of "cheapoair". Accordingly, the Presence Requirements are satisfied.

The Position of the Parties

The Position of the Complainant

16. The Complainant is a technology company that develops computer software used to power travel-related websites, including the highly successful, multi-national Internet-based travel agencies www.cheapoair.com and www.onetravel.com.
17. The Complainant owns both United States trademarks as well as the Complainant's Mark noted in paragraph 14 above all of which contain the same word mark cheapoair and all of which were registered prior to the date of registration of the Disputed Domain. For nearly

the past decade, the Complainant has provided its travel-related services to the public, including to Canadians, using the Complainant's Mark in order to distinguish its services from those offered by others. The Complainant has invested hundreds of millions of dollars, and had expended substantial time and other resources in developing, advertising and promoting its Internet-based travel agencies under the Complainant's Mark. As a result of these efforts, the Complainant has developed considerable goodwill, which in turn increases the value of the Complainant's business.

18. The Complainant submits that the Disputed Domain Name, the pluralizing of the Complainant's Mark; namely, by the addition of the "s" at the end of the word mark is confusingly similar to the Complainant's Mark in which the Complainant had rights prior to the registration of the Disputed Domain Name and continues to have such rights, and further that the Registrant has no legitimate interest in the Disputed Domain Name and that the Disputed Domain Name was registered in bad faith in accordance with paragraph 3.5 of the Policy.

19. Accordingly, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

The Position of the Registrant

20. The Registrant did not file a Response.

Analysis and Findings

21. The purpose of the Policy as stated in paragraph 3.3 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

22. 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.

23. Paragraph 3.2 of the Policy provides in part:
- 3.2 Mark. A "Mark" is**
- (a) a trade-mark, including the word elements of a design mark, or a tradename 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;
 - (b) a certification mark, including the word elements of a design mark that has been used in Canada by a person or that person's predecessor in title, for the purpose of distinguishing the wares or services that are of a defined standard;
 - (c) a trade-mark, including the word elements of a design mark, that is registered in CIPO; or
 - (d) the alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of which the Registrar of Trade-marks has given public notice of adoption and use pursuant to paragraph 9(1)(n) of the *Trade-marks Act* (Canada).
24. 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.
25. 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 the 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 registered the domain name in Canada in good faith in association with 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 paragraph 3.4(d) "use" by the Registrant includes, but is not limited to, use to identify a website.

26. 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 licensor or licensee 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 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 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.

27. 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 Disputed Domain Name and continues to have such Rights;
2. The Registrant has registered the Disputed Domain Name in bad faith; and
3. The Complainant must provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Name.

Notwithstanding the evidence presented that the Registrant has no legitimate in the Disputed Domain Name, the Registrant will succeed if the Registrant proves on a balance of probabilities that he has a legitimate interest in the Disputed Domain Name.

Confusingly Similar to a Mark

28. Evidence shows that the Complainant is the owner of the Complainant's Mark, and the Complainant's Mark was registered in CIPO as No TMA941658 on July 19, 2011 and as No. TMA874324 on March 27, 2014.

29. 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. In assessing the domain name, the dot-ca suffix is ignored. It is the narrow resemblance that is applied.

30. The Disputed Domain Name incorporates the entire word of the Complainant's Mark, with the addition of an "s" at the end of the word mark CHEAPOAIR. The Complainant submits that as numerous administrative panels have recognized that "the incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the complainant's registered mark (*Rolex Watch U.S.A., Inc. v. Spider Webs, Ltd.*, WIPO Case No. D2001-0398, July 2, 2001). The Complainant also referred to *OMH, Inc. v. Nicolas Todt*, DCA-1763-CIRA, dated April 14, 2016 at page 20 where the Panel held that creativeartisagency.ca is confusingly similar to complainant's mark because it "consists of the entirety of the CREATIVE ARTISTS AGENCY mark". Also, the Complainant submits, that the fact that the word mark CHEAPOAIR is followed by the letter "s" does not preclude a finding of confusing similarity. The Complainant also referred to *AMAZON.com Inc v. David Abraham*, DCA-784-CIRA dated July 28, 2004 at page 6 where the Panel, ordered the transfer of the domain name, amazons.ca to Amazon.com finding that typo-squatting is intended to cause confusion for Internet users in order to lure them to the registrant's website.

31. The Panel agrees and accordingly for the reason stated above, the Disputed Domain Name is confusingly similar to the Complainant's Mark.

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

32. The Disputed domain Name was registered on January 18, 2016.

33. As noted in paragraph 28 above, the Complainant owns trademarks registered in Canada in CIPO issued on July 19, 2011 and March 27, 2014 respectively. In addition evidence shows that the Complainant's common law rights and statutory rights to the Complainant's Mark based on use and registered rights date back to 2009, years prior to the registration of the Disputed Domain Name and continues to have such rights.

34. The Panel is satisfied that the Complainant's Mark was registered well before the registration of the Disputed Domain Name and accordingly had Rights in the Complainant's Mark well before the registration of the Disputed Domain Name and as the evidence shows that the Complainant's rights are active, the Complainant continues to have such Rights.

Was the Disputed Domain Name registered in bad faith?

35. The Complainant relies on paragraphs (a), (c) and (d) of 3.5 of the Policy in support of bad faith registration of the Disputed Domain Name by the Registrant. The Panel notes that the Policy provides that "if any of the 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".

36. The Complainant alleges that the Registrant registered the Disputed Domain Name for the purpose of confusing the Complainant's customers into believing that the Registrant is affiliated with the Complainant and for the purpose of selling or otherwise transferring the Disputed Domain Name to the Complainant, the Complainant's licensor or licensee, or to a competitor of the Complainant for valuable consideration in excess of the Registrant's actual cost in registering the Disputed Domain Name.

37. Further, the Complainant submits that the Registrant has never been licensed to, nor has it ever authorized the use of, the Complainant's Mark in any manner, in Canada or otherwise, including in, or as part of a domain name or the Disputed Domain Name, nor has the Complainant provided consent to the use or display of the Complainant's Mark at the website of the Disputed Domain Name. Further, the Complainant submits that based on the online presence of the Complainant's Mark, the Registrant could not plausibly assert that the Complainant's Mark was unknown to the Registrant when the Registrant registered the Disputed Domain Name.

38. Evidence shows that further to written notification to the Registrant to cease and desist from the infringement of the Complainant's Mark, the Registrant responded that the Disputed Domain Name was for sale. Following an offer by the Complainant to purchase the Disputed Domain Name from the Registrant for the reasonable cost involved in the registration and transfer thereof, the Registrant provided no response. Evidence further shows that the Disputed Domain Name now resolves to a generic page that states: "This domain is for sale. If you are interested, please contact the owner Rahamarouf@yahoo.ca to make an offer."

39. The Complainant further submits that the Registrant, without authority to do so, has intentionally attempted to attract, for commercial gain, internet users to the Registrant's own competing website by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement.

40. Evidence shows that, prior to the cease and desist notification noted in paragraph 38 above, the Disputed Domain Name redirected Internet users to the Registrant's own, directly competing website; namely, "Bestflight.ca", which appears to host a company named "Famous Travel & Tours" and offers nearly identical travel-related services as those offered by the Complainant under the Complainant's Mark, such as, flight, hotel and rental car booking.

41. Based on all the circumstances demonstrated in the material and all the evidence provided by the Complainant, the Panel is satisfied that the Complainant has proven bad faith registration of the Disputed Domain Name as required by the Policy.

Legitimate Interest of the Registrant

42. Paragraph 3.4 of the Policy sets out a non-exhaustive list of criteria upon which the Panel may find, based on all the evidence, that the Registrant has a legitimate interest in the Disputed Domain Name. Paragraph 4.1 of the Policy places the onus on the Complainant to provide “some evidence” that the Registrant did not have a legitimate interest in the Disputed Domain Name. Although “some evidence” is not defined, it imposes, in the Panel’s view, a lower threshold than on a balance of probabilities. The onus on the Complainant is to provide “some evidence” of a negative.

43. The Complainant has provided evidence in respect of the non-exhaustive list contained in paragraph 3.4 of the Policy that the Registrant has no legitimate interest in the Disputed Domain Name. The Registrant did not provide a Response and accordingly the Complainant’s evidence is not refuted.

44. Based on the evidence provided which is not refuted by the Registrant, the Panel is satisfied that the Registrant has no legitimate interest in the Disputed Domain Name.

Decision

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

Dated August 29, 2017


Elizabeth Cuddihy (Sole Panelist)