IN THE MATTER OF A COMPLAINT PURSUANT TO

THE CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

Dispute Number: DCA-1763-CIRA
Domain Name: <creativeartistsagency.ca>
Complainant: OMH, Inc.
Registrant: Nicolas Todt.
Registrar: Domain Robot Enterprises Inc.
Panel: The Honourable Neil Anthony Brown QC
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

THE PARTIES

1. The Complainant in this proceeding is OHM, Inc, of c/o Dentons Canada LLP, 99 Bank Street, Suite 1420, Ottawa, ON K1P 1H4, Canada, Attention: John Lee ("The Complainant").

2. The Registrant in this proceeding is Nicolas Todt of 2877 Boul Laurier, Quebec, QC H9R, 5N3, Canada ("the Registrant").

THE DOMAIN NAME AND REGISTRAR

3. The Domain Name in issue in this proceeding is <creativeartistsagency.ca> ("the Disputed Domain Name").

4. The Registrar is Domain Robot Enterprises Inc. The Disputed Domain Name was registered by or on behalf of the Registrant on July 31, 2015.

PROCEDURAL HISTORY

5. 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").

6. According to the information provided by the BCICAC:

(a) The Complainant filed a Complaint with respect to the Disputed Domain Name in accordance with the Policy on March 7, 2016.

(b) The Complaint was reviewed and found to be administratively compliant. By letter and email dated March 9, 2016 the BCICAC as service Provider confirmed to the parties administrative compliance of the Complaint and commencement of the proceeding in the dispute resolution process on March 9, 2016.

(c) The Complaint together with the schedules thereto was sent by BCICAC as service provider to the Registrant by email on March 9, 2016 and delivered on that date; a successful mail delivery report was subsequently furnished, enabling the Panel to conclude that the Complaint and its schedules were duly delivered to the Registrant. By the same communication the Registrant was informed that it could file a Response in the proceeding on or before March 29, 2016.

(d) The Registrant did not reply to that communication and did not provide a Response.

(e) Under Rule 6.5 of CIRA Domain Name Dispute Resolution Rules ("the Rules") the Complainant was entitled to elect to convert from a panel of three to a single arbitrator which it elected to do, whereupon BCICAC proceeded to appoint a single arbitrator.

(f) On April 12, 2016, BCICAC named The Honourable Neil Anthony Brown QC as sole arbitrator. The sole arbitrator has signed an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.

(g) The Panel has reviewed all of the material submitted by the Complainant and is satisfied that the Complainant is an eligible Complainant under the Policy and the Rules.

(h) 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

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

8. The Complainant is a United States company incorporated in Delaware with headquarters in Los Angeles and clients in Canada and worldwide.

9. The Complainant operates in Canada under its CREATIVE ARTISTS AGENCY trademark and has done so since at least as early as July 5, 2010, the date on which its application for the trademark was made. The CREATIVE ARTISTS AGENCY trademark was registered in Canada on January 4, 2013. The Complainant uses the CREATIVE ARTISTS AGENCY trademark and name and also its CAA Design trademark in its business as a well known talent and sports agency and for the provision of related services.

10. Without the permission of the Complainant, the Registrant registered the Disputed Domain name on July 31, 2015. It is alleged that being aware of the Complainant's trademark and the operation of its Creative Artists Agency business, the Registrant registered the Disputed Domain Name in the Canadian extension ".ca" and used it to operate a website featuring information on the representation of artists and also to advertise that it represents over 200 artists in all fields. Moreover, it is alleged that the Registrant has used the website to impersonate the Complainant by using its trademark design and by advertising services that are identical to those provided by the Complainant. Accordingly, the Complainant asks that the Disputed Domain Name be transferred to it.

CONTENTIONS OF THE PARTIES

A. COMPLAINANT

11. The Complainant submits as follows:

1. The Complainant satisfies the Canadian Presence Requirement required by the Policy by virtue of its aforesaid trademarks being registered in Canada, making it an eligible complainant.
2. The Disputed Domain Name is registered with the Domain Robot Enterprises Inc.
3. The Registrant uses the Disputed Domain Name to operate a website featuring information on the representation of artists and advertising that it represents over 200 artists of all fields. The Registrant has used the website to impersonate the Complainant in its business by using the Complainant's trademark design on its website and by advertising services identical to those provided by the Complainant. Further, the Registrant has used the email address rmorgan@creativeartistsagency.ca to solicit goods and services under the guise of being the Complainant.
4. The Disputed Domain Name is confusingly similar to the Complainant's said trademarks and as such represents an unauthorized registration and use thereof.
5. The Complainant is a well-known talent and sports agency with a loyal following of clients worldwide.
6. The Complainant's CREATIVE ARTISTS AGENCY and its CAA Design trademarks are registered in Canada.
7. The registration of the Complainant's trademarks in Canada is sufficient in and of itself to establish "rights" within the meaning of the Policy.
8. The Complainant's trademarks have been used in Canada by the Complainant since at least as early as July 5, 2010 in association with their registered services. As such, the Complainant's trademark rights existed long before the registration of the Disputed Domain Name on July 31, 2015.
9. Having regard to these factors, the Disputed Domain Name is confusingly similar to the Complainant's trademarks as defined in the Policy.
10. The Registrant has registered the Disputed Domain Name in bad faith, as defined under paragraph 3.5 of the Policy.
11. The website to which the Disputed Domain Name resolves is operated as "Creative Artists Agency" and has carried material and titles which were intended by the Registrant to impersonate the Complainant and do so impersonate it regarding the provision of agency services and marketing and management services provided by the Complainant under its trademarks.
12. The goods and services discussed on the Registrant's website directly overlap with the services registered in association with the Complainant's trademarks, including its consultancy and business services, market research services, financial advisory services and management of brands. The Complainant's business is a business run on reputation and inside knowledge and the Registrant's website, posing as the Complainant' website and passing itself off as the Complainant, defeats the ability of the Complainant to choose how it is represented online and must lead to confusion if its current and potential clients come across the Registrant's website.

13. The Registrant's website at the Disputed Domain Name is an attempt to pass itself off as the Complainant by providing and advertising similar services offered by the Complainant, using an identical name to the Complainant's business and advertising the prestige of representing over 200 artists of all fields.
14. Moreover, the Registrant, using the email address rmorgan@creativeartistsagency.ca, has attempted to perpetrate a fraud by improperly using the Complainant's trademarks in its domain name.
15. Although the Registrant has disabled its website since receiving a cease and desist letter on behalf of the Complainant, it has retained the Disputed Domain Name and it is still possible for the Registrant to use the Disputed Domain Name for emails and other purposes to the detriment of the Complainant.
16. The Registrant registered or otherwise acquired the Disputed Domain Name primarily for the purpose of disrupting the business of the Complainant and to impersonate it to solicit goods and services from others.
17. The Registrant has no legitimate interest in the Disputed Domain Name as it has not and cannot meet the criteria set out in the Policy by which any such legitimate interest might be established.
18. The Disputed Domain Name should therefore be transferred to the Complainant.

B. THE REGISTRANT

12. The Registrant did not file a Response in this proceeding.

DISCUSSION OF THE ISSUES

1. CANADIAN PRESENCE REQUIREMENTS

13. Article 2 of CIRA's Canadian Presence Requirement for Registrants provides a list of conditions allowing entities to hold the registration of a .CA domain name. The Complainant submits that it falls within condition (q) which provides that:

"*A Person which does not meet any of the foregoing conditions [conditions (a) to (p)], 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, but in this case such permission is limited to an application to register a .ca domain name consisting of or including the exact word component of that registered trade-mark*".

The Complainant is the owner of the Canadian trade mark registrations No. TMA 839, 294 in the term CREATIVE ARTISTS AGENCY and No. TMA 839, 291 in CAA Design registered in the Canadian Intellectual Property Office ("CIPO") (collectively "the CAA trademarks"). The Complainant has adduced evidence to that effect (See Schedule E to the Complaint) which the Panel accepts. The Panel therefore finds that the Complainant has satisfied CIRA's Canadian Presence Requirement for Registrants in respect of the Disputed Domain Name.

2. DOMAIN NAME AND REGISTRAR

The domain name in dispute is <creativeartistsagency.ca> (the "Disputed Domain Name") and it is registered with the registrar Domain Robot Enterprises Inc. The Complainant has adduced in evidence which the Panel accepts the WHOIS record for the

Disputed Domain Name which shows that the record was created on July 31, 2015. (See the WHOIS record attached to the Complaint as Schedule G). The registrant information is held in the WHOIS record as private. However, the Complainant has also adduced in evidence an email dated February 24, 2016 attached as Schedule H to the Complaint and by way of response from CIRA providing Registrant information showing that the Registrant of the Disputed Domain Name is Nicolas Todt of 2877 Boul Laurier, Quebec, QC H9R, 5N3, Canada.

3. GENERAL

14. Paragraph 3.1 of the Policy provides in effect that a complainant must establish 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;

(b)the Registrant has no legitimate interest in the domain name as described in paragraph 3.4; and

(a) the Registrant has registered the domain name in bad faith as described in paragraph 3.5."

It is clear that all three of those requirements must be established and on the balance of probabilities.

The Panel will now deal with each of those three elements.

CONFUSINGLY SIMILAR

15. As the Complainant submits, it is required to prove that the Disputed 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. The Complainant must therefore show that it has rights to a mark, that it had those rights before the domain name was registered, that it still has them and that the Disputed Domain Name is confusingly similar to the CAA trademark. The Complainant submits that it can meet those requirements.

16. The first question that arises is whether the Complainant has a trademark on which it can rely for the purpose of this proceeding. The Complainant has adduced evidence which the Panel accepts, to show that it is the owner of the CAA trademarks. The details of the trademarks going to make up the CAA trademarks as defined above are verified and set out in Schedule E to the Complaint and the Complainant's rights to them have thereby been verified. The trademarks are No. TMA 839, 294 for CREATIVE ARTISTS AGENCY and No. TMA 839, 291 for CAA Design and both were registered in CIPO on January 4, 2013. As has been shown above, the Complainant holds two trademarks, but it is sufficient for present purposes to consider the effect of the CREATIVE ARTISTS AGENCY mark, although the CAA Design will also be referred to later in this decision

17. The next question that arises is whether the CREATIVE ARTISTS AGENCY trademark is a "Mark" in which the Complainant had Rights prior to the date of registration of the

Domain Name and continues to have such rights. The Panel finds that the Disputed Domain Name is confusingly similar to a trademark in which the Complainant had rights prior to the date of registration of the domain name and continues to have such rights, namely the CREATIVE ARTISTS AGENCY trademark. The CREATIVE ARTISTS AGENCY trademark is clearly a mark as defined by Paragraph 3.2 of the Policy and it comes within the meaning of Paragraph 3.2 (a), as the evidence shows that it is registered in CIPO.

18. The evidence is that the CREATIVE ARTISTS AGENCY trademark was registered by the Complainant on January 4, 2013, two and a half years prior to the date on which the Disputed Domain Name was registered, namely on July 31, 2015 and that it still has those rights acquired by registration of the mark. The panel therefore finds that the CREATIVE ARTISTS AGENCY mark is a mark in which the Complainant had rights before the Disputed Domain Name was registered and in which it still has rights.

19. Pursuant to paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if it so nearly resembles the same in appearance, sound or in the ideas suggested so as to be likely to be mistaken for the mark. The test to be applied when considering "confusingly similar" is one of first impression and imperfect recollection and the "dot-ca" suffix should be excluded from consideration (see *Coca-Cola Ltd. v. Amos B. Hennan,* BCICAC Case No. 00014).When those principles are applied, the Disputed Domain Name is, beyond argument, confusingly similar to the Complainant's CREATIVE ARTISTS AGENCY mark.

20. In particular, the Disputed Domain Name consists of the entirety of the CREATIVE ARTISTS AGENCY mark. As the domain name includes the trademark, the immediate impression is that the domain name is the same and relates to the CREATIVE ARTISTS AGENCY trademark. An objective bystander would naturally conclude that the domain name relates to the trademark and the services provided for creative artists pursuant to that trademark. As the principal business of the Complainant and trademark owner is the provision of services for creative artists, the internet user would naturally conclude that the domain name is an official domain name of the Complainant and that it relates to the services provided by the Complainant under the trademark.

21. Accordingly, the Disputed Domain Name is confusingly similar to the trade-mark as it so nearly resembles the trademark in appearance, sound and in the ideas suggested as to be likely to be mistaken for the trademark within the meaning of Paragraph 3.3 of the Policy.

22. The Panel therefore concludes that the Disputed Domain Name is confusingly similar to the CREATIVE ARTISTS AGENCY trade-mark in which the Complainant had rights prior to the registration date of the Disputed Domain Name and in which it continues to have such rights. The Complainant has thus established the first element that it must prove.

REGISTRATION AND USE IN BAD FAITH

23. The Panel now turns to consider whether the Disputed Domain Name was registered in bad faith. The Panel finds, on the grounds relied on by the Complainant and generally, that the Registrant registered the Disputed Domain Name in bad faith. Specifically, the Panel finds that the Registrant has registered and used the Disputed Domain Name in bad faith as described in Paragraph 3.5 of the Policy. That is so for the following reasons.

24. First, the Complainant submits that the Registrant has registered and has used the Disputed Domain Name to host an agency website containing the Complainant's CREATIVE

ARTISTS AGENCY Trademark to represent itself as "Creative Artists Agency". The Panel has examined Schedule J to the Complaint which shows pages of the Registrant's website to which the Disputed Domain Name resolves. The website is expressly described as "Creative Artists Agency". Beneath a photograph of a woman under the title "Creative Artists Agency" is a description of the services that the purported Creative Artists Agency claims to provide and text to the effect that the site offers the representation of artists and artists' agents, especially the negotiation of contracts, a financial and accounting department that ensures the follow up of contracts, the service of rewarding talents with bonuses relating to film exploitation, advertising deals, events and TV and/or radio campaigns, Press Department runs for interviews, photo shootups, festivals and tributes. It also purports to give itself an air of authenticity by including an Oscar logo above the words Academy of Motion Pictures Arts and Sciences. The words Creative Artists Agency appear several times. The site also carries a telephone number with a "1" prefix which can only be interpreted as an attempt to encourage viewers to call that number to avail the viewer of the services of those associated with the website.

25. The Panel agrees with the submission of the Complainant that this presentation is an attempt to impersonate the Complainant regarding the provision of the same agency services and marketing/management services as are offered by the Complainant under the CREATIVE ARTISTS AGENCY mark and that this constitutes bad faith registration of the Disputed Domain Name.

26. The Panel also agrees with the submission of the Complainant that the goods and services offered on the Registrant's website directly overlap with the services registered in association with the CREATIVE ARTISTS AGENCY mark, including consultancy and business services, market research services, financial advisory services and management of brands. As the Complainant notes, the Complainant's business is one that is run on reputation and inside knowledge and that consequently the Registrant's website, posing as the Complainant's website, defeats the ability for CAA to choose how it is represented online and that it would lead to confusion when potential clients or those looking for the Complainant come across the site. That constitutes bad faith and shows that the Disputed Domain Name was registered in bad faith.

27. Likewise, the Registrant's website can be construed only as an attempt to pass itself off as the Complainant. This is accomplished by providing and advertising similar services to those offered by the Complainant, using an identical name to the Complainant trademark and business and advertising the prestige of representing over 200 artists of all fields. Moreover, the telephone number is clearly an invitation to the viewer to contact the Registrant and avail him or herself of its services. All of this amounts to bad faith and shows that the Disputed Domain Name was registered in bad faith.

28. In addition to that, the evidence, which the Panel accepts, shows that an email was sent to the luxury automaker Infiniti from an individual described as Ms. Morgan using the email address rmorgan@creativeartistsagency.ca, incorporating as it does the Disputed Domain Name which incorporates the Complainant's trademark. In that email, Ms. Morgan represents herself to be the Complainant, uses its Design trademark and requests Infiniti for the use of a vehicle for the actor Tom Hanks during his time in Europe. This email was clearly an act of bad faith being an attempt to have a car delivered to the Registrant by a subterfuge. As the Complainant submits, this is the Registrant brazenly using the Complainant's good name to

obtain commercial gain and a likely fraud as well as being a poor reflection of the Complainant.

29. On February 1, 2016, Dentons, the attorneys for the Complainant, sent a letter to the Registrant, advising the Registrant of the Complainant's trademark rights and requiring that the Registrant cease using the Disputed Domain Name, transfer the Internet domain name to the Complainant, discontinue its use of the CREATIVE ARTISTS AGENCY and CAA Design trademarks, destroy or deliver for destruction all materials that include the trademarks and provide a written undertaking permanently to cease and desist from using the trademarks and any other confusingly similar variation in the future. The Registrant responded to this letter and giving the Registrant's apparent but baseless defence that:

"I inform you that we contact the CIRA is that Creative Artists Agency is a free address of law and that therefore nothing authorizes you to request that we remove this address. If you want to start a procedure against us we are at your disposal, and any defamatory continued to justice."

30. The Registrant has subsequently disabled the website but, as the Complainant rightly submits, it remains possible for the Registrant to use the Disputed Domain Name for emails, such as the email address rmorgan@creativeartistsagency.ca.In any event, while the domain name remains registered it is a breach of the Complainant's trademark rights.

31. The Registrant also registered or otherwise acquired the Disputed Domain Name primarily for the purpose of disrupting the business of the Complainant and to impersonate the Complainant to solicit goods and services of others.

32. The registration and use of the Disputed Domain Name is causing the Complainant to miss a portion of Internet traffic that it would otherwise receive by users who are trying to find or connect with the genuine Creative Artists Agency of the Complainant.

33. The Complainant also relies on Paragraph 3.5(c) of the Policy and argues that the Registrant is disrupting the Complainant's business by purporting to provide information relating to agency services while using the Complainant's trademarks. The Panel agrees. As clients seeking the provision of agent services by the Complainant are presented with identical services offered by the Registrant, the Registrant is competing directly for clients by passing off its services as those of the Complainant. The Registrant also offers information that is similar to that offered under the trademarks and the services of the Complainant generally. This is clearly disrupting the business of the Complainant within the meaning of Paragraph 3.5(c) of the Policy.

34. For all of the foregoing reasons, the Complainant has established beyond argument that the Registrant has registered the domain name in bad faith as described in paragraph 3.5 of the Policy.

NO LEGITIMATE INTEREST IN THE DOMAIN NAME

35. Paragraph 4.1 of the Policy provides that the Complainant must provide some evidence that "...(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4." The Panel finds that the Complainant has provided evidence that the Registrant has no legitimate interest in the Disputed Domain Name.

Paragraph 3.4(a)

36. The Complainant has shown that the Disputed Domain Name was not acquired in good faith or for a *bona fide* purpose and that is the only conclusion the Panel can reach on the evidence. The clear intention of the Registrant was to misappropriate the Complainant's trademarks and use them to divert business from the Complainant to the Registrant's website and then to entice internet users to use its services and to do so presumably for financial reward. This completely undermines any claim of good faith or legitimate interest.

(a) **Paragraph 3.4(b)**
37. The Complainant has shown by the evidence that Registrant has not registered the Disputed Domain Name in good faith, but in bad faith.

(b) **Paragraph 3.4(c)**
38. The Complainant has shown that the Registrant has not registered the Disputed Domain Name in good faith, but in bad faith.

(d) **Paragraph 3.4(d)**
39. The Complainant has shown that 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. In any event and as previously noted, the Disputed Domain Name has not been used in good faith. The Registrant has not used the domain name for a non-commercial fan or information website.

(e)Paragraph 3.4(e)
40. It is apparent from the evidence that CREATIVE ARTISTS AGENCY, CAA Design and <creativeartistsagency.ca> are not legal names, surnames, or other references by which the Registrant is commonly identified, and accordingly, the Registrant cannot rely on paragraph 3.4(e) of the Policy.

(f)Paragraph 3.4(f)
41. The Disputed Domain Name is not the geographical name of the location of the Registrant's non-commercial activity or place of business.

42. Moreover, the Registrant has not filed a response to the Complaint or sought to rebut the above evidence and has thus provided no evidence of legitimate use. If the Registrant had any evidence that it had any legitimate interest in the domain name, it could have brought that evidence forward but it has not done so. In addition, in view of the facts set out above, it is inherently unlikely that the Registrant could establish a legitimate interest in the Disputed Domain Name when its *modus operandi* in this matter in registering the domain name by misappropriating the Complainant's trademark without permission has been improper.

43. In light of the foregoing, the Panel finds that the Registrant does not have a legitimate interest in the Disputed Domain Name and that it is therefore removed from the application of Paragraph 3.4 of the Policy.

CONCLUSION

44. The Panel finds that the constituent elements of the Policy have been made out, that the Complainant is entitled to the relief it seeks and that the Panel will order that the Disputed Domain Name be transferred to the Complainant.

DECISION

45. The Panel finds that the Complainant has satisfied the requirements of Paragraph 4.1 of the Policy and that it is entitled to the remedy it seeks.

ORDER

46. The Panel orders and directs that the registration of the Domain Name <creativeartistsagency.ca> be transferred from the Registrant to the Complainant.

Date: April 14, 2016

The Honourable Neil Anthony Brown QC
Sole Arbitrator