

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

Complainant: WordPress Foundation, 200 Brannan Street, Suite 511, San Francisco, California 94107 United States

Complainant Counsel: Steven M. Levy, 301 Fulton Street, Philadelphia, PA 19147 United States

Registrant: Chris Olszewski, 2 Kirkland, Montreal, Quebec H9J 1N1 Canada

Registrar: Wildwest Domains Canada Inc., 14455 North Hayden Road, #226, Scottsdale, AZ 85260 United States

Disputed Domain Name: wordpress.ca

Panelist: Paul W. Braunovan

Service Provider: Resolution Canada Inc.

DECISION

The Parties

1. The Complainant is WordPress Foundation, 200 Brannan Street, Suite 511, San Francisco, California 94107 United States.
2. The Complainant is represented by Steven M. Levy, 301 Fulton Street, Philadelphia, PA 19147 United States.
3. The Registrant is Chris Olszewski, 2 Kirkland, Montreal, Quebec H9J 1N1 Canada.

The Domain Name and Registrar

4. The disputed domain name is wordpress.ca.
5. The Registrar with which the disputed domain name is registered is Wildwest Domains Canada Inc., 14455 North Hayden Road, #226, Scottsdale, AZ 85260 United States.

Procedural History and Rules

6. The Complainant commenced this proceeding under the Canadian Internet Registration Authority (“CIRA”) Domain Name Dispute Resolution Policy

(Version 1.3) (“the Policy”) and the CIRA Domain Name Dispute Resolution Rules (Version 1.5) (“the Rules”) by a complaint dated July 9, 2015.

7. The service provider determined that the complaint was in administrative compliance with the Policy and the Rules and forwarded a copy of the complaint to the Registrant.
8. The Registrant did not file any reply to the complaint.
9. The Panel finds that it was properly constituted pursuant to the Policy and the Rules, and that all of the requirements under the Policy and the Rules for the commencement and maintenance of this proceeding have been met.

Canadian Presence Requirements

10. The Panel finds that the Complainant is an Eligible Complainant (see paragraph 1.4 of the Policy) and has met the Canadian Presence Requirements by virtue of the fact that the Complainant is the owner of the Canadian trade-mark WORDPRESS (TMA698,039), registered October 9, 2007 under the *Trade-marks Act*, R.S.C. 1985, c. T-13, as amended).

The Complaint

11. Pursuant to paragraph 4.1 of the Policy, to succeed in this proceeding the Complainant must prove, on a balance of probabilities, that:
 - (i) 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
 - (ii) the Registrant has registered the domain name in bad faith as described in paragraph 3.5 of the Policy.
12. The Complainant must also provide some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.4 of the Policy. Even if the Complainant proves the first two elements of the test as set out in paragraph 11, above, and provides some evidence that the Registrant has no legitimate interest in the domain name, 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.

Is the Registrant’s dot-ca domain name 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?

13. The terms “Confusingly Similar” and “Mark” are both specifically defined in the Policy.
14. The Complainant owns a Canadian trade-mark registration for the trade-mark WORDPRESS (TMA698,039).
15. The Panel finds that the Complainant has rights in a Mark as that term is defined in paragraph 3.2(c) of the Policy, which defines a Mark as including “a trade-mark, including the word elements of a design mark that is registered in CIPO”.
16. The Panel finds that the Complainant has rights in its registered trade-mark, namely, WORDPRESS, and that the Complainant continues to have such rights since the evidence suggests that the Complainant’s registered trade-mark is still validly registered with the Canadian Intellectual Property Office.
17. The Complainant, however, is required to show that it has rights in a Mark “prior to the date of registration of the domain name”. The Complainant’s submissions include the WHOIS information for wordpress.ca showing a “creation date” of September 4, 2005 and an “expiry date” of September 4, 2016. For the purposes of this decision, the Panel accepts that the date of registration for the disputed domain name is September 4, 2005.
18. The Panel takes note of the fact that the Complainant’s trade-mark was not registered until October 9, 2007, just more than two years after the date of registration of the disputed domain name. The Panel also takes note of the fact that the Complainant’s trade-mark was not filed until August 31, 2006, just less than one year after the date of registration of the disputed domain name.
19. The Complainant’s WORDPRESS trade-mark was registered **after** the date of registration of the disputed domain name and as such the Complainant cannot rely upon its registration of the WORDPRESS trade-mark to meet its onus. The Panel is of the view that the Complainant has the burden of proving that it has rights prior to date of registration of the domain name, and if the Complainant is relying on a **registered** trade-mark pursuant to paragraph 3.2(c) of the Policy, then in our view the Complainant’s trade-mark must have been registered prior to the registration of the domain name. We do not think that the Complainant should be able to rely on a trade-mark registration to establish its rights, yet reference some other date other than the registration date of that trade-mark for the purpose of assessing priority as against the date of registration of the domain name.
20. In light of the above findings, in our view the Complainant cannot rely solely on its Canadian trade-mark registration for WORDPRESS, since the Complainant did not have rights under paragraph 3.2(c) until October 9, 2007,

which is more than two years after the date of registration of the disputed domain name.

21. However, the Complainant has also asserted rights in the trade-mark WORDPRESS based on use of the mark in Canada. Paragraph 3.2(a) of the Policy states that a Mark is: “a trade-mark, including the word elements of a design mark, or a trade name 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”. The Complainant asserts use of the WORDPRESS mark since at least as early as March 28, 2003. Since the date of registration for the disputed domain name is September 4, 2005, the Panel will now review the Complainant’s alleged evidence of use of the WORDPRESS trade-mark in Canada from March 28, 2003 to September 4, 2005.
22. The Complainant has submitted the following evidence in support of its claim:
 - (i) Copy of wordpress.com website home page from May 2003 (Exhibit D-10);
 - (ii) Copy of wordpress.com website home page from June 2003 (Exhibit D-11);
 - (iii) Portions of February 24, 2005 New York Times article (Exhibit D-12);
 - (iv) Cnet.com September 24, 2004 article mentioning WordPress (Exhibit D-13);
 - (v) First Wikipedia.com page on WordPress (April 19, 2004) (Exhibit D-14);
 - (vi) May 14, 2004 mention of WordPress on LaurenWood.org (Exhibit D-15);
 - (vii) November 10, 2004 mention of WordPress on Boren.me (Exhibit D-16);
 - (viii) June/July 2004 mentions of WordPress on Watershedstudio.com (Exhibit D-17);
 - (ix) Google search limited to March 2003 to March 2005 and excluding Complainant’s own website (Exhibit D-18).

The Panel also notes that the Complainant’s Canadian trade-mark registration WORDPRESS (TMA698,039) is based on use in Canada since at least as early as January 2004.

23. Based on a review of all of the evidence filed, the Panel finds that the Complainant has rights in the trade-mark WORDPRESS as per the definition of Mark in paragraph 3.2(a) of the Policy. The Panel does note that *most* of the evidence is in the form of third-party references to WORDPRESS, rather than more direct evidence showing the Complainant itself using the WORDPRESS mark. However, it is noted that the evidence does include

copies of the Complainant's website from 2003 which prominently feature use of the WORDPRESS trade-mark. In such circumstances, the Panel is of the view that the third-party references support the Complainant's position that that the WORDPRESS mark was used in Canada by the Complainant "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".

24. A disputed domain name will be held to be 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 to be mistaken for the Mark.
25. In the Panel's view, the disputed domain name is Confusingly Similar to the Complainant's trade-mark WORDPRESS. In fact, it is identical.
26. The use of the Complainant's Marks (going back to 2003) is prior to the registration of the disputed domain name (September 4, 2005). The Complainant's evidence suggests that the Complainant continues to have such rights in the Marks.
27. The Panel is of the view that the Complainant has met its burden in establishing 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 disputed domain name and continues to have such rights.

Did the Registrant register the domain name in bad faith?

28. Under paragraph 3.5 of the Policy, 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 Registrant's actual costs of 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.

29. The Complainant has alleged bad faith with respect to paragraph 3.5(c), as referenced above.

Paragraph 3.5(c) Bad Faith

30. The Complainant has raised an allegation of bad faith pursuant to paragraph 3.5(c) of the Policy. As noted above, paragraph 3.5(c) of the Policy states that bad faith will be found where 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.
31. The Panel finds that the Registrant registered the domain name primarily for the purpose of disrupting the business of the Complainant. As noted by the Complainant, the disputed domain name resolves to a website which offers various services in domain names, web hosting, SSL & security, email accounts, marketing tools and building a website. The Registrant is obviously aware of who the Complainant is, as part of the Registrant's service offerings are setup, backups and security related to WordPress created websites. The fact that it is offering such services at www.wordpress.ca can in the Panel's view only be seen as attempt to disrupt the business of the Complainant (by appropriating business to its own website). In our view, all of the evidence, when viewed in its totality and in the absence of any reply from the Registrant, suggests that the Registrant registered the domain name primarily for the purpose of disrupting the business of the Complainant.
32. However, the Panel notes that for paragraph 3.5(c) of the Policy also requires that the Complainant be a "competitor" of the Registrant. The term "competitor" is not defined in the Policy or the Rules. The services offered by the Registrant include a "Website Builder From only \$4.99/mo! Grow your business with a beautiful website. Our Design Wizard makes it as easy as

drag and drop! Includes all you need to get online”. The Panel is of the view that where a Registrant uses its website to offer services competitive to that of the Complainant, as is the case on the present facts, such use supports a finding that the Registrant is a competitor of the Complainant.

33. The Panel finds that the Complainant has successfully established the bad faith of the Registrant under paragraph 3.5(c).

Does the Registrant have a legitimate interest in the disputed domain name?

34. Paragraph 3.4 of the Policy provides a non-exhaustive list of various criteria that a panel is to consider in assessing legitimate interest. The Policy requires that the Complainant must provide some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.4. If the Complainant meets this burden, the Registrant will still succeed in the proceeding if it proves on a balance of probabilities that it has a legitimate interest in the disputed domain name.
35. Based on a review of the evidence and submissions, the Panel is of the view that the Complainant has met its initial burden of providing *some* evidence that the Registrant has no legitimate interest in the disputed domain name as described in paragraph 3.4. In particular, the Complainant has provided some evidence that the disputed domain name was not a Mark that the Registrant used in good faith and that the Registrant had rights in the Mark. The Complainant has also met its burden in showing that the disputed domain name is not a clearly descriptive or generic name associated with the wares or services offered on the website, and that the Registrant did not use the disputed domain name in good faith in association with a non-commercial activity. Finally, the Complainant has met its burden in showing that the disputed domain name is not the legal name of the Registrant or some other name by which it was commonly identified, nor was the disputed domain name the geographic name or the location of the Registrant’s non-commercial activity or business.
36. As a result, the Panel finds that the Complainant has met its burden of showing *some* evidence that the Registrant had no legitimate interest in the disputed domain name under this subparagraph. The Panel is of the opinion that this finding is sufficient for the Complainant to meet its burden pursuant to paragraph 4.1(c) of the Policy.

Burden shifts to Registrant to prove Legitimate Interest on a balance of probabilities

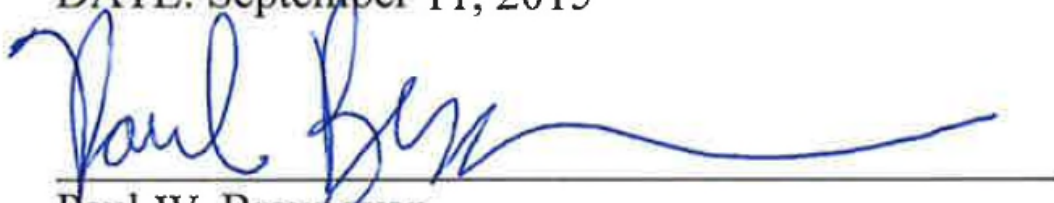
37. Since the Complainant has met its burden pursuant to paragraph 4.1(c) of the Policy, the Registrant can only succeed in this proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate

interest in the domain name. Since the Registrant has not filed a reply to the complaint, the Panel is of the opinion that it is unable to find, on a balance of probabilities, that the Registrant has a legitimate interest in the disputed domain name pursuant to paragraph 3.4 of the Policy.

Summary of Findings

38. The Panel has found that the Complainant has proven, on a balance of probabilities, 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, and that the Registrant has registered the disputed domain name in bad faith as such term is described in paragraph 3.5 of the Policy. Further, the Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the disputed domain name, as that term is defined in paragraph 3.4 of the Policy, and that the Registrant has failed to meet its burden of proving, on a balance of probabilities, that it has a legitimate interest in the disputed domain name.
39. As a result of the above findings, the Panel orders that the disputed domain name wordpress.ca be transferred from the Registrant to the Complainant.

DATE: September 11, 2015



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