

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

Dispute Number: DCA-1789-CIRA
Domain Name: <osim.ca>
Complainant: OSIM International Ltd.
Registrant: Yulian Hariyanto
Registrar: Tucows.com.Co.
Panel The Honourable Neil Anthony Brown QC (Chair), Douglas M. Isenberg and Anton Melnyk Q.C.
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

OVERVIEW

1. This matter concerns a dispute between the Complainant and the Registrant regarding the registration of <osim.ca> (“the disputed domain name”).
2. 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”).
3. This is a proceeding under the CIRA Domain Name Dispute Resolution Policy (the “Policy”), in accordance with the CIRA Dispute Resolution Rules (the “Rules”).
4. The Complainant claims that the Registrant registered the disputed domain name in breach of the Policy, which the Registrant denies.

THE PARTIES

1. The Complainant in this proceeding is OSIM International Ltd., of 65 UBI Avenue 1, OSIM Headquarters, 408939, Singapore. (“the Complainant”).
2. The Registrant in this proceeding is Yulian Hariyanto of 232 Autumn Hill Blvd, Thornhill, Ontario, L4J9Y5, Canada and yyg@rogers.com (“the Registrant”).

REGISTRATION OF THE DISPUTED DOMAIN NAME

The disputed domain name was registered by the Registrant on January 20, 2005. The Registrar of the disputed domain name is Tucows.com.Co of 96 Mowat Avenue, Toronto, ON M6K 3M1, Canada.

PROCEDURAL HISTORY

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 June 2, 2016.
- (b) The Complaint was reviewed and found to be administratively compliant. By letter and confirmatory email dated June 6, 2016, the BCICAC as service provider confirmed administrative compliance of the Complaint to the parties and, as Notice in accordance with Rules 2.1 and 4.3, forwarded a copy of the Complaint to the Registrant together with its Schedules and by the same communication informed the parties that in accordance with Rule 4.4 the date of commencement of the Proceeding was June 7, 2016 and that any Response had to be filed by June 27, 2016.

(c)The Registrant delivered its Response to the BCICAC on June 10, 2016. Upon review of the Response it was determined not to be in administrative compliance with the Policy and the Rules and the Registrant was given 10 days' notice to remedy all instances of non-compliance.

(d)The Registrant submitted its amended Response to the BCICAC on June 22, 2016 and upon review it was found to be in administrative compliance.

(e)On June 29, 2016 and pursuant to Rule 11.1, the Complainant submitted to the BCICAC a Reply to the Registrant's Response.

(f)On June 30, 2016, the Registrant submitted to the BCICAC a Response to the Complainant's Reply.

(g) On July 4, 2016, BCICAC appointed The Honourable Neil Anthony Brown QC as Chair of the Panel and Douglas M. Isenberg and Anton Melnyk Q.C. as panelists. Each of the panelists has signed an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.

(h) 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 by virtue of its ownership of several trademarks registered with the Canadian Intellectual Property Office.

FACTS

The facts set out below taken from the Complaint, the Response, the Complainant's Reply to the Response and the Registrant's further Response, together with related exhibits. Where there are factual matters in dispute they are dealt with elsewhere in this decision.

The Complainant is a company incorporated in Singapore with its principal place of business at 65 UBI Avenue 1, OSIM Headquarters, 408939, Singapore. ("the Complainant"). It also has a Canadian subsidiary. The Complainant is engaged in the industry of the provision of healthy lifestyle products which it markets under the OSIM mark. In 2014 its global sales were in excess of \$690,000,000, a large proportion of which were derived from sales of OSIM products. The Complainant has been operating in Canada since at least as early as 2002 and it sells products in Canada under the OSIM mark. In more recent years, it has also operated physical retail stores under the OSIM mark in Burnaby and Richmond, British Columbia. It also operates on the internet where it has several domain names including osim.com which are used by consumers, including those in Canada, to order products online. The Complainant has been successful and has received several awards for its work.

On January 20, 2005, the Registrant registered the disputed domain name. It does not resolve to an active website.

The Complainant is the owner of several trademarks registered with the Canadian Intellectual Property Office ("CIPO"), namely:

- (a) TMA662796 for OSIM , registered on April 19, 2006 ;
- (b) TMA689628 for OSIM , registered on June 12, 2007;
- (c) TMA578799 for OSIM & Design , registered on April 2, 2003;
- (d) TMA608972 for OSIM IMEDIC, registered April 29, 2004.
- (e) TMA565093 for OSIM GLOBAL HEALTH CARE, registered on July 23, 2002;
- (f) TMA857720 for OSIM COMPOSITE Logo, registered on August 14, 2013; and
- (g) TMA609339 for OSIM HEALTHFOCUS, registered on May 4, 2004.

CONTENTIONS OF THE PARTIES

A. THE COMPLAINANT

The Complainant submits as follows:

1. CANADIAN PRESENCE REQUIREMENTS

The Complainant satisfies the Canadian presence requirement of paragraph 1.4 the Policy in view of the Complainant's registration of the OSIM marks with CIPO, evidence of which is adduced in Schedule B to the Complaint.

2. THE REGISTRAR

The Registrar of record in respect of the disputed domain name registration is Tucows.com Co. The Complainant has adduced evidence to that effect (see Schedule A to the Complaint for a copy of the CIRA WHOIS database search results for the disputed domain name).

3. THE COMPLAINANT'S RELEVANT TRADEMARK RIGHTS AND THEIR USE BY THE COMPLAINANT IN ITS BUSINESS

The Complainant is the owner of all rights and goodwill throughout the world, including in Canada in and to the distinctive mark OSIM. In Canada the Complainant owns the trademarks incorporating the word OSIM (more particularly described above in this decision). Print outs for CIPO's online database relating to those trademarks are contained in Schedule B to the Complaint.

Since 1993, the Complainant has used the OSIM trademarks to offer its healthy lifestyle products internationally. OSIM products are known for their high quality and reliability. In 2014 the Complainant's international sales under its various brands were in excess of \$690, 000,000 and a large proportion of those sales are attributable to goods sold under the OSIM marks.

The Complainant has a long-standing and well developed international reputation and has spent significant amounts of money on extensive advertising to help ensure that its OSIM mark is recognised and widely known around the world.

The Complaint has been operating in Canada since at least as early as 2002 and since then it has offered for sale its OSIM branded wares to Canadians via its online retail portals. More recently and through its Canadian subsidiary it has operated physical retail stores under the OSIM marks in Burnaby and Richmond, British Columbia.

The Complainant uses the internet to advertise and sell its OSIM brand products and to that end it owns several domain names that incorporate the OSIM marks, including osim.com which was registered in 1997 and since then it has used that domain name and others to promote the OSIM mark internationally. It has used them to enable consumers in Canada and internationally to browse and purchase OSIM branded products.

The OSIM marks are distinctive and famous internationally and have enjoyed such distinctiveness and fame since long prior to January 20, 2005 when the Registrant registered the dispute domain name.

So successful has the Complainant been that it has received several business awards.

The Complainant submits **Schedule E**, WHOIS printouts from the osim.com website and **Schedule F**, WHOIS printouts for the osim.com domain name.

4. THE GROUNDS ON WHICH THE COMPLAINT IS MADE

Confusingly Similar

Paragraph 3.3 of the Policy provides:

"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."

The Domain Name in question is identical to the Complainant's OSIM Mark.

The Registrant has No Legitimate Interest in the Domain Name

Registrant has No Rights in the Mark

The Registrant has no rights in the name OSIM which, to the Complainant's knowledge, the Registrant has never used as a trademark or trade name for any wares or services.

A Google search conducted for "Isabelle Yang" and OSIM together returned no hits. This search results page is enclosed as **Schedule K**. That search suggests the Registrant has no material online presence directly or indirectly incorporating the Domain or the OSIM Mark.

In contrast, the Complainant is the owner of several registrations for the distinctive OSIM Mark in Canada. Pursuant to s. 19 of the *Trade-marks Act*, the Complainant enjoys the exclusive right to the use throughout Canada of OSIM: *Trade-marks Act*, R.S.C. 1985, c. T-13, s. 19, see **Schedule L** to the Complaint.

Accordingly, any use of the OSIM Mark by the Registrant is not lawful use and cannot be counted towards a consideration of legitimate interest. In this regard the Complainant relies on the decision in: *CIRA 00005 – CEOFUNDS.CA at para 4.5*; see **Schedule M to the Complaint**. In any event, the Complainant is only required to show "some evidence:"; see *DCA 681-CIRA – RADIOCANADA.CA*, **Schedule N**. In the present case, the Complainant has advanced evidence that the Registrant is in fact not using the domain for its purpose, much less a legitimate one).

The Domain Name is not Clearly Descriptive

The Domain Name osim.ca is not clearly descriptive of any ware or services, nor is it the name or surname of the Registrant, nor it is the name of any geographical origin for any ware or services in either of Canada's official languages. The name OSIM is a coined and distinctive brand, owned in Canada and throughout the world by the Complainant.

The Domain Name is not used for Justifiable Non-Commercial Activity

There is no basis to believe that the Registrant is using the Domain for legitimate criticism, review, news reporting or similar non-commercial activity. It does not resolve to a functional website.

The Registrant has Registered the Domain Name in Bad Faith

Bad Faith due to Attempts to Sell Domain. Sub-paragraph 3.5 (a).

There is no doubt that the windfall profit of \$10,000 demanded by the Registrant is well in excess of the Registrant's actual costs of registering the domain name. There is ample evidence from the surrounding circumstances to draw the inference that the Registrant's purpose in registering this domain was to resell it for profit to the Complainant:

- (a) The domain was only registered after the Complainant and its OSIM Mark achieved wide global reputation.
- (b) The domain is not being used for any purpose; it is sitting idle.
- (c) When approached by the Complainant, the Registrant demanded the payment of \$10,000.

The clear intention of this Registrant was to secure a potentially valuable domain for the purpose of ransoming it back to OSIM as it expanded its operations internationally.

The Registrant's registration of the domain is therefore in bad faith pursuant to s. 3.5(a) of the Policy.

Bad Faith due to Likelihood of Confusion. Sub-paragraph 3.5 (d).

Alternatively, the Registrant's purpose was ultimately to exploit the domain commercially contrary to subparagraph 3.5(d) by creating 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.

The Registrant does not currently appear to be operating a website from the domain. However, given the strength of the Complainant's OSIM Mark internationally as well as its Canadian registered rights, any use by the Registrant will result in use of the OSIM Mark to attract customers to the Registrant's website contrary to subparagraph 3.5(d).

The Complainant has therefore made out each of the elements that it is required to establish.

B. THE REGISTRANT

The Response is as follows:

“June 21, 2016

Dear Sir/ Madam,

I registered the domain osim for my daughter, Isabelle Yang.

This is my daughter's nickname. I call her Osim.

In my childhood, there was a Japanese tv series about an adorable girl named Osim,

That is a widely popular soap opera, everyone loved her.

So the name has sentimental value to me.

I watched that series when I was a kid almost 30 years ago,

and now I'm a father with three children.

I think Osim is a common name in Japan, and because of the series,

(by that time) a lot of parents loved this character and named their daughter with this name.

I have this name since 2005. I never heard of Osim brand by that time, at least in Toronto.

I also registered all my family names long long time ago, they are:

yangyang.ca (since 2004)

osim.ca (since 2005)

isabelleyang.ca (since 2008)

ianyang.ca (since 2008)

annayang.ca (since 2008)

yansenyang.ca (since 2008)

yansen.ca (since 2008)

I hope some day they will become success and can have their own website.

I never misuse those names.

I did receive emails from an anonymous person making the inquiry, which I got a lot of them from time to time.

I ignored them but this email kept coming, so just said any random number to make it stopped bothering me. I

have no intention to sell the domain, I want to keep it for my daughter when she grown up. I only have very few domains, they are all for the family.

I have an example, I love a character from a popular series Games of Throne.

And I have a daughter with the same age, then I called her Arya.

I read from the newspaper, Arya is a very popular name for new babies in 2016.

I find out the domain was still available, so I register it.

Eleven years later, some random company from other part of the world said they have the same name and claim the domain. Can they take it away from me?

I'm a family guy, do not familiar with the laws, I cannot provide a summary of, and references to, the relevant Canadian law, nor summary of, and references to, prior decisions in CIRA Proceedings or the dispute resolution.

I hope I can still keep this name for my daughter.

Sincerely Yours,

Yang Yang

(905) 771-1861

yyg@rogers.com”.

C. THE COMPLAINANT'S REPLY TO THE REGISTRANT'S RESPONSE

The Complainant's Reply is in substance as follows.

1. In its correspondence, the Centre has identified the Registrant of the osim.ca domain as one “Yulian Hariyanto.”
2. There has been no communication received from an individual by the name of Yulian Hariyanto. All communications with the Centre have been through “Yang Yang.” No explanation has been provided as to

who Mr. Yang Yang is, how he relates to the Registrant, or what (if any) authority Mr. Yang Yang has to speak for the Registrant.

3. In the absence of such information, the Complainant submits that Mr. Yang Yang has failed to establish standing to make submissions and that no Response has actually been provided by the Registrant. Accordingly, the Complainant asks that the Panel reject the submissions of Mr. Yang Yang.

4. In the event that the Panel elects to consider the submissions of Mr. Yang Yang, the Complainant makes the following remarks:

5. In order to establish legitimate interest, the Registrant must meet at least one of the criteria set out in section 3.4 of the Policy.

6. In this case, there is no dispute that the Registrant has not meaningfully used the domain as a mark, in association with or as a description of wares or services, or for other activities.

Accordingly, the Registrant cannot claim application of subsections (a)-(d). Likewise, there is no contention or evidence that the domain is a geographical location and the Registrant cannot avail itself of subsection (f).

7. The only remaining subsection of Section 3.4 provides that legitimate interest may be made out where: (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;

8. The Registrant can also not avail itself of this section.

9. There appears to be no dispute that OSIM is not the name, surname, or common identifier of the Registrant Yulian Hariyanto. On this basis alone, there is no legitimate interest by the Registrant.

10. The only other information provided is the uncorroborated allegations of Mr. Yang Yang who claims that OSIM was the name of a character on an unspecified Japanese TV series several decades ago and that this may have been his personal nickname for his then-infant daughter in or around 2005. For clarity, there is no allegation that OSIM is the name or surname of that daughter who is apparently named Isabelle Yang.

11. Such unexplained and uncorroborated allegations cannot rise to a level where the Registrant has established that it (or even Isabelle Yang) are commonly identified by the name OSIM. This is the type of “feeble” and uncorroborated evidence that has been rejected by panels before (see for example *WIPO Case D2001-1026*, www.remyxo.com at section 6(b), attached as Schedule P). A higher level of proof is required which will often include testimonials, documents, or sworn statements from those with knowledge of the use of the nickname.

12. All of that is absent here. At best, Mr. Yang Yang has put forward an uncorroborated allegation that a single individual may have at some period in time referred to a person who is not the Registrant by the name OSIM.

13. Even this allegation should be considered with scepticism.

14. It is a commonly identified problem that a Complainant has little ability to probe the Registrant’s activities when attempting to prove bad faith or disprove legitimate interest (see for example Complaint Submissions, Schedules N and O). As such, the evidence needed to support a claim for legitimate interest may lie only with the Registrant. A Registrant’s failure to lead such evidence can and should give rise to an adverse inference that there either is no such evidence, or that such evidence is detrimental to the Registrant’s position.

15. In this case, the Registrant has failed to provide a single piece of correspondence, memorabilia, testimonial, or other evidence that demonstrates an instance where his daughter was referred to as OSIM. If she were in fact commonly known by this name, this would suggest that there would be ample documented instances of it to prove the fact. No such documents have been put forward and this leads to the conclusion that none exist.

16. Likewise, no details have been provided for the alleged Japanese TV character referenced in the Response. Mr. Yang Yang has failed to even provide a name for that show. There is no way to either corroborate or disprove the allegation (though for clarity, the Complainant has no knowledge of such a character or show).

17. The Complainant further notes that no documentary corroboration is provided for the various domains that Mr. Yang Yang purports to have registered. More importantly, no information has been provided about what other domains Mr. Yang Yang may have registered. A plain reading of the limited list provided by Mr. Yang Yang shows a series of domains that may very well be personal names (ianyang.ca, annayang.ca, for example). The only domain that does not conform to this style is the osim.ca domain.

18. Mr. Yang Yang further admits that he has previously researched potentially popular domains and proceeded to register them without any legitimate interest. He has apparently done this with ARYA.CA based on the fame and popularity of the Game of Thrones character.

19. This behaviour is consistent with a domain squatter, not a Registrant exhibiting legitimate interest in these domains.

20. Further supporting this conclusion is Mr. Yang Yang’s statement that as of 2005 he had not heard of the OSIM brand in Toronto; he is silent on whether he knew of the OSIM brand more generally. Again, the silence on this point should lead to an adverse inference that he was in fact aware of the brand as early as 2005.

21. In sum, the limited information provided by Mr. Yang Yang is most consistent with an attempt to register the osim.ca domain for eventual resale with knowledge of the OSIM brand and marks. The evidence is not consistent with registration based on legitimate interest.

22. Given the foregoing, there is no basis to find legitimate interest on the part of the Registrant as the Registrant's submissions (if that is what they are) provide no way to corroborate, test, prove, or disprove what is being alleged. Further, even if the submissions are all taken together as true, they do not rise to a level where they establish that the Registrant is commonly identified by the name OSIM.

23. The Complainant otherwise relies and refers to its submissions in its Complaint.

D. REGISTRANT'S RESPONSE TO THE COMPLAINANT'S REPLY

The Registrant's Response begins with the text:

"Reply to: Osim.ca-Reply Submissions of The Complainant

Yulian Hariyanto and Yang Yang is the same person.

My Chinese name is Yang Yang, in 1976 my father change it to Yulian Hariyanto due to anti-Chinese policy in my formal country. When I landed in Canada, I changed it back to my Chinese name Yang Yang.

Attached is the name change certificate."

There then appears a copy of a certificate issued by the Ministry of Health and Ministry Responsible for Seniors, Division of Vital Statistics, British Columbia, Canada, recording a change of name registered on August 29, 2001 from Yulian Hariyanto to Yang Yang, the change of name of a child from "NOT STATED IAN" to "IAN YANG" and the change of name of another child from "NOT STATED YANSEN" to "YANSEN YANG". The certificate also states that the Place of Residence, presumably of Yang Yang is "Richmond, British Columbia." The certificate is dated September 26, 2001.

The text then continues as follows:

I moved to Canada with my family as skill immigrants, due to anti-Chinese riot in my formal country.

When I landed in Canada, my first stop was Vancouver as I had a friend that landed a year before.

I stayed in Vancouver for three weeks then I permanently moved to Toronto.

In reply to Complainant's argument:

18. Mr. Yang Yang further admits that he has previously researched potentially domains and proceeded to register them without any legitimate interest. He has apparently done this with ARYA.CA based on the fame and popularity of the Game of Thrones character

I just use this as an example, I never try to register domain ARYA.CA arya.ca already taken by someone in 2000, eleven years before the series Game of Thrones (first season in 2011).

My argument is: how can this happen? You register your name and eleven years later, some random company declares it has the same name and takes it from you."

DISCUSSION OF THE ISSUES

1. CANADIAN PRESENCE REQUIREMENTS

Paragraph 1.4 of the Policy provides that a complainant initiating a complaint must satisfy the Canadian Presence Requirements for Registrants in respect of the domain name that is the subject of the proceeding.

Paragraph 2 (q) of the Requirements 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 OSIM marks more particularly set out above and which are registered with CIPO.

The Complainant has therefore satisfied CIRA's Canadian Presence Requirement for Registrants in respect of the disputed domain name.

2. REGISTRATION OF THE DISPUTED DOMAIN NAME

- (a) The Registrant registered the disputed domain name on January 20, 2005 and the registrar of the domain name is Tucows.com Co.
- (b) The Complainant submits that it believes the Registrant of the domain name is Isabelle Yang. It says that this is so because it conducted a search of Tucows' WHOIS which revealed that information as to the registrant of the domain name was privacy blocked. That is correct, as the Complaint has exhibited a copy of the search results as Schedule A to the Complaint, and it does not provide a name for the registrant of the domain name.
- (c) However, the Complainant's submission goes on to say that "a request made of" Tucows disclosed "Ms Yang as the current Registrant." The Panel is not aware of how that request or disclosure was made, but it is not correct to say that the disclosure revealed that "Ms Yang" is the Registrant if, by "Ms Yang" the Complainant means Ms Isabelle Yang: there is nothing on the record to the effect that Isabelle Yang is the Registrant of the domain name or ever was.
- (d) When the Complaint was filed, with the name of the Registrant given as Isabelle Yang, the Centre properly communicated with the Registrar, Tucows, on June 3, 2016 informing it that the Complaint had been filed and requesting that the domain name be locked. The Registrar replied on June 6, 2016 to the effect that the locks had been applied and providing details of the Registrant. The details provided were that the Registrant of the disputed domain name was Yulian Hariyanto of 232 Autumn Hill Blvd, Thornhill, Ontario, L4J8Y, Canada, with an email address of yyg@rogers.com.
- (e) Paragraph 1.2 of the Policy provides that the Registrant is "a person (the "Registrant") who has obtained the registration of a domain name in the Registry...". In the present case, that person is clearly Yulian Hariyanto and the Centre has correctly given Yulian Hariyanto as the Registrant of the disputed domain name in this proceeding.
- (f) The Panel will therefore deal with this proceeding on the basis that the Registrant is Yulian Hariyanto as that is the "person...who has obtained the registration of (the) domain name."

3. GENERAL

The purpose of the Policy, as stated in paragraph 1.1, is to provide a forum in which cases of bad faith registration of .CA domain names can be dealt with relatively inexpensively and quickly.

In accordance with paragraph 4.1 of the Policy, to succeed in the Proceeding, the Complainant must prove, on the 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.

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

CONFUSINGLY SIMILAR

As the Complainant correctly 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 disputed 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 marks on which it relies to establish that proposition. The Complainant submits that it can meet those requirements.

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 a series of trademarks including the term OSIM and in two cases consisting solely of that term which are

registered in Canada. The details of those trademarks and the Complainant's rights to those marks are verified and set out in Schedule B to the Complaint.

The next question that arises is whether the mark relied on are "mark(s)" in which the Complainant had Rights prior to the date of registration of the Domain Name and continues to have such Rights. Taking in turn each of the trademarks and bearing in mind that the date of registration of the domain name was January 20, 2005, ("the due date") the Panel holds that:

- (a) The Complainant did not have rights in TMA662796 for OSIM, registered on April 19, 2006, prior to the due date;
- (b) The Complainant did not have rights in TMA689628 for OSIM, registered on June 12, 2007, prior to the due date;
- (c) The Complainant did have rights in TMA578799 for OSIM & Design, registered on April 2, 2003, prior to the due date;
- (d) The Complainant did have rights in TMA608972 for OSIM IMEDIC, registered April 29, 2004, prior to the due date.
- (e) The Complainant did have rights in TMA565093 for OSIM GLOBAL HEALTH CARE, registered on July 23, 2002 prior to the due date;
- (f) The Complainant did not have rights in TMA857720 for OSIM COMPOSITE Logo, registered on August 14, 2013 prior to the due date; and
- (g) The Complainant did have rights in TMA609339 for OSIM HEALTHFOCUS, registered on May 4, 2004, prior to the due date.

The Panel finds that with respect to the trademarks in which the Complainant had rights prior to the due date, namely

- (a) TMA578799 for OSIM & Design, registered on April 2, 2003;
 - (b) TMA608972 for OSIM IMEDIC, registered April 29, 2004.
 - (c) TMA565093 for OSIM GLOBAL HEALTH CARE, registered on July 23, 2002;
- and
- (d) TMA609339 for OSIM HEALTHFOCUS, registered on May 4, 2004 prior to the due date,

the Complainant continues to have such rights (hereinafter referred to as "the OSIM marks").

The Panel finds that the OSIM marks are marks as defined by Paragraph 3.2 of the Policy and that they come within the meaning of "mark" in Paragraph 3.2 (a), as the unchallenged evidence shows that they are all registered with CIPO.

The panel therefore finds that the OSIM marks are marks in which the Complainant had rights before the disputed domain name was registered and in which it still has rights.

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).

Having regard to those principles, the Panel finds that the disputed domain name is confusingly similar to each of the Complainant's OSIM Marks. That is so because with respect to each trademark, an objective bystander asked to make a comparison between the domain name and each of the trademarks would probably be struck by the fact that the term OSIM is the first and dominant part of each mark and that the domain name consists solely of the same term and would, for that reason, assume that the domain name was related to the trademark and that it may well be an official domain name of the Complainant. An internet user would also probably conclude that the idea suggested by the domain name were that it was the name of a well-known brand and that it would lead to a website dealing with the Complainant's business conducted under that brand.

Accordingly, the disputed domain name is confusingly similar to each of the OSIM marks as it so nearly resembles all of the marks in appearance, sound and in the ideas suggested as to be likely to be mistaken for each of the OSIM Marks within the meaning of Paragraph 3.3 of the Policy.

The Panel therefore concludes that the disputed domain name is confusingly similar to the OSIM marks 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 made out the first of the three elements that it must prove.

NO LEGITIMATE INTEREST IN THE DOMAIN NAME

Under the Policy, the question whether the Registrant has a legitimate interest in the disputed domain name is to be decided in the following framework. First, there must be an assertion that the Registrant has no legitimate interest in the domain name. That criterion has been satisfied because the Complainant has made such an assertion in the Complaint.

Secondly, there is a positive obligation then imposed on the Complainant which is described as an “onus”, meaning clearly an onus of proof. That onus of proof is set out in Paragraph 4.1 of the Policy, which 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 (emphasis added)*.” Each of the sub-paragraphs of paragraph 3.4 describes a situation which, if made out, would give the Registrant a legitimate interest in the domain name. The obligation on the Complainant is therefore to show that the Registrant cannot make out any each of the successive tests in the sub-paragraphs of 3.4. The Complainant is not required to prove conclusively or even on the balance of probabilities that the Registrant cannot satisfy those tests, but merely that there is “some” evidence to that effect.

Thirdly, if and when that is done, the Panel has to decide whether the evidence as a whole shows on the balance of probabilities that the Registrant has a legitimate interest in the domain name. That is so because the final paragraph of 4.1 states that:

“Even if the Complainant ... 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.”

Fourthly, paragraph 3.4 makes it clear that if the Registrant takes the opportunity of claiming that it has a legitimate interest in the domain name, it is not confined to the criteria set out in that paragraph, for those criteria are “without limitation”. In other words, a registrant may try to bring itself within any of the specified criteria, but it may also rely on any other fact or argument it wishes to rely on to show that it has a legitimate interest. If it does do this, the role of the Panel is to decide if the registrant has made out its case and to make that decision on the balance of probabilities.

The first task of the Panel is therefore to see if the Complainant has provided “some evidence” that the Registrant has not brought himself within any of the specific criteria in paragraph 3.4.

Applying that test, the Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the disputed domain name. The Complainant has not dealt with all of those criteria *seriatim*, but having regard to the totality of the evidence, the Panel reaches the following conclusion on each of them.

(a) Paragraph 3.4(a)

The Complainant has shown that the disputed domain name was not a mark, that the Registrant used any such mark in good faith or that the Registrant had Rights in any such mark;

(b) Paragraph 3.4(b)

The Complainant has shown by the evidence that the Registrant did not register the domain name in good faith in association with any wares, services or business and that the domain name was clearly descriptive 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) Paragraph 3.4(c)

The Complainant has shown by the evidence that the Registrant did not register the domain name in Canada in good faith in association with any wares, services or business and that the domain name was understood in Canada to be the generic name thereof in any language;

(d) Paragraph 3.4(d)

The Complainant has shown by the evidence that the Registrant did not use the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;

(e) Paragraph 3.4(e)

The Complainant has shown by the evidence that the domain name did not comprise the legal name of the Registrant or that it was a name, surname or other reference by which the Registrant was commonly identified. The Registrant is Yulian Hariyanto. The evidence shows that the legal name of the registrant Yulian Hariyanto was Yulian Hariyanto until he changed it on August 29, 2001 to Yang Yang, which it still is; the domain name osim.ca does not contain the legal name Yang Yang. Even if the legal name of Yulian Hariyanto were still Yulian Hariyanto, the result would be the same, as the domain name osim.ca does not contain the name Yulian Hariyanto either. The only other way in which the Registrant could bring himself within paragraph 3.4(e) would be to show that osim.ca was a reference by which Yulian Hariyanto was commonly identified; there is no evidence to that effect and the Registrant does not claim that it is; his argument is not that he is identified as Osim or osim.com, but, at best, that Isabelle Yang's nickname is Osim. It is of course conceivable that Isabelle is commonly identified as Osim because it is her nickname, and that issue will be considered later, but even if that were the case, it is not a name or reference by which he, the Registrant, is commonly identified. Accordingly, not only has the Complainant elicited "some evidence" that the Registrant's name is not Osim, osim or osim.com, but it has shown to the satisfaction of the Panel that it is simply not the case.

(f) Paragraph 3.4(f)

The Complainant has shown by the evidence that the disputed domain name is not the geographical name of the location of the Registrant's non-commercial activity or place of business.

In total, therefore, the Complainant has provided some evidence that the Registrant cannot bring himself within any of the specified criteria in paragraph 3.4.

It is necessary, however, for the Panel to consider the evidence brought forth by the Registrant and the submissions he makes that are based on it, to see whether that evidence and submissions establish that he has a legitimate interest in the domain name. The substance of what the Registrant relies on has already been made clear, i.e. that he registered the domain name for his daughter by registering his daughter's nickname, Osim as the domain name. The reason for doing so is given that Osim was the name of a girl who was a character in a popular Japanese soap opera of some years before and he thought that it would be of sentimental value to his daughter to give her a domain name that encapsulated the name Osim, which by now had become a common name in Japan because of the series. He adds that this was the real reason for registering osim.ca as a domain name and not to copy the brand Osim, which he had never heard of, "at least in Toronto." Furthermore, he submits that he had registered other domain names embodying the names of other members of his family, such as ianyang.ca. They would then be able to have websites bearing their names.

It is not beyond argument, as matter of principle, that a registrant can have a legitimate interest when it registers a domain name embodying the nickname of a person other than the registrant. Domain name cases are not precedents but there are nevertheless decisions where such an argument has succeeded. All such cases, however, depend on the evidence and whether the Panel is able to say on the evidence that on the balance of probabilities the claim is persuasive. The Panel has given careful consideration to all that has been put by the Registrant and of course to the evidence as a whole, but it is unable to find that what the Registrant has put in this case gives him a legitimate interest in the domain name. On the Registrant's side of the argument are the following points:

1. It is understandable that the Registrant may have wanted to give his daughter a domain name based on her nickname for the sentimental value attached to the name.
2. He has registered other domain names based on the names of other family members.
3. He has not used the domain name for commercial or improper purposes although he has owned it since the year 2005.
4. He has said that he has "never heard of Osim brand by that time (2005), at least in Toronto."

On the other hand, there are aspects of the evidence that trouble the Panel and tend to favour the Complainant, which are:

1. There is no evidence, even in a layman's sense, that there was such a soap opera in Japan, that it was "widely popular" or that it had a character named Osim.
2. There is no evidence that the name Osim is well known or "a common name", in Japan or any other country. It is of course not conclusive by itself, one way or the other, but it is well known that the internet is a vast reservoir of information and it is curious that no attempt seems to have been made to show, as is alleged, that "by that time (2005) a lot of parents loved this character and named their daughters with this name."
3. There is no evidence from family or friends, which would be comparatively easy to bring forward, that Osim is or was the nickname of Ms Yang.
4. The Panel is troubled by the way in which the Registrant denies that he knew of the Osim brand "at least in Toronto." As the Panel understands it, and judging by the Change of Name Certificate in evidence, the Registrant lived in Richmond, British Columbia at least in 2001 when he changed his name and that by the time he registered the domain name, in 2005, he lived or at least gave his address as in Thornhill, which is part of Greater Toronto. The implication is that he did not hear of Osim in Toronto, but may have heard of it when he lived in Richmond, British Columbia.
5. The Complainant's evidence is that since 2002 and through OSIM Canada, it has operated "physical retail stores under the OSIM mark in Burnaby and Richmond, British Columbia." When the Registrant changed his name from Yulian Hariyanto to Yang Yang on August 29, 2001 his address on the Change of Name Certificate was given as Richmond, British Columbia, where one of the Complainant's two retail stores under the OSIM mark was operating and in the same general region where the other store was operating.

The Panel is particularly mindful of the remarks of the Panel in *Shaw Industries Group, Inc. and Columbia Insurance Company v. The Visual Image Solution*, WIPO Case No. D2008-1102¹ that:

"Given the ease with which a respondent in a Policy proceeding might claim that someone with a name corresponding to the domain name in dispute is the intended beneficiary of its registration, a UDRP panel must demand the presentation of tangible evidence to support such a claim, otherwise the purpose of the Policy would be totally eviscerated. The Respondent's failure to furnish such evidence in this case leaves the Panel with no alternative but to dismiss the Respondent's contention."

Applying those observations the Panel requires tangible evidence to support the Registrant's claim in the present case and it must conclude that tangible evidence has not been forthcoming. That is particularly so in the areas of dispute just referred to and where evidence on those matters must be within the knowledge of and available to the Registrant and yet it has not been brought forward.

This leaves the Panel unable to find on the balance of probabilities from the totality of the evidence that the Registrant has shown that he has a legitimate interest in the disputed domain name.

The Complainant has thus established the second of the three elements that it must prove.

REGISTRATION IN BAD FAITH

The Panel now turns to consider whether the disputed domain name was registered in bad faith. In that regard, the Panel agrees with the submission of the Complainant that, consistent with the decision in *Canadian Broadcasting Corporation? Societes Radio-Vanada v. William Quon*, CIRA Dispute Number 00006 (April 8, 2003), pp.13-14, surrounding circumstances may be considered in assessing whether the disputed domain name has been registered in bad faith.

¹ Some references in this decision are to cases decided under the Uniform Domain Name Dispute Resolution Policy. The panel's citation of those cases is consistent with paragraph 3.2(1) of the Rules, which expressly allows references to 'dispute resolution proceedings which apply to domain names registered under any other top level domain which the Complainant considers persuasive.'

By clause 3.1 of the Policy, the Complainant is obliged to prove that:

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

Section 3.5 provides that “ (f)or the purposes of paragraphs 3.1(c) ... 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:... “ and then goes on to provide four such circumstances, two of which are relied on by the Complainant, namely:

“(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 in registering the domain name, or acquiring the Registration;

(b)...

(c) ...

(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.”

It is to be noted again that the criteria for bad faith are not exclusive, but that complainants may rely on circumstances other than those enumerated to show bad faith registration.

The Panel will now examine the two criteria relied on by the Complainant

Intention to sell, rent, licence or transfer the domain name-Paragraph 3.5(a)

The Complainant submits that the record shows that the Registrant’s conduct brings it within this sub-paragraph and that it justifies the conclusion that the Registrant registered the domain name for the primary purpose of selling it to the Complainant. To support this contention, the Complainant points to the email traffic between the parties and says that it shows that this was the Registrant’s primary purpose.

The Panel is reluctant to find bad faith intention on the basis only of the email traffic showing that the Registrant, when approached by the Complainant, asked for \$10,000 for the domain name. That is so because, although domain name decisions are not precedents, and every case must be judged on its own facts, there are now many analogous decisions under the Uniform Domain Name Dispute Resolution Policy (“the UDRP”) to the effect that if the first approach comes from the trademark owner offering to buy the domain name and the registrant puts a price on what he has to sell, because he has been asked to do so, this will not necessarily be regarded as bad faith registration. The cases are discussed in Levine, *op.cit*, pp 281-286 and summarised by the learned author at p.283, where it is said:

‘Panels have consistently rejected the notion often advanced by complainants that respondents’ demands of “outrageous prices” for domain names constitute abusive registration.’

The Panel will therefore not find bad faith registration on this ground alone. However, the emails in question certainly show a disposition and an interest on the part of the Registrant in selling the domain name for a substantial sum of money and the Panel’s view is that that circumstance can and should be taken into account in the wider assessment of bad faith registration.

Intentionally Attract Traffic For Commercial Gain –Paragraph 3(5)(d)

The Complainant also relies on paragraph 3.5(d) of the Policy and submits that the Registrant intentionally attempted to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with the HSBC marks as to the source, sponsorship, affiliation or endorsement of the contents of Registrant’s website.

The Panel is unable to accept that submission. The sub-paragraph clearly requires some overt conduct by the registrant to activate its provisions and in particular it requires that there is some conduct showing that the registrant “intentionally attempted to attract, for commercial gain, Internet users to” his website. In the present case, it is common ground that the Registrant has done nothing with the domain name since registering it and does not have a website to which he could induce internet users to visit, even if he wanted to.

Bad Faith in general

It should be noted, however, that bad faith registration may be shown by conduct other than the conduct specified. This is made clear by Section 3.5 providing as it does, that “(f)or the purposes of paragraphs 3.1(c) ... 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:...” (emphasis added). This provision is included, as bad faith conduct may take many forms and it is frequently used to find bad faith registration and (under the UDRP) bad faith use.

That provision being in the Canadian policy is important as it was not always there and has been added to the Policy to create what is its current version. Version 1.2 of the Policy provided as follows:

‘3.7. Registration in Bad Faith. For the purposes of paragraph 3.1(c), a Registrant will be considered to have registered a domain name in bad faith, *if and only if*,...” one of three specified circumstances is proved. Thus, general bad faith outside the three specified circumstances was insufficient and the Policy was applied in that manner (emphasis added).

However, Version 1.3 of the Policy, operating from August 22, 2011 adopted a new formulation which provided that “any of the following circumstances, *in particular, but without limitation*, if found to be proved, shall be evidence that a Registrant has registered a domain name in bad faith...” (emphasis added) and that provision is then followed by four specified circumstances.

It can be seen that this change was a deliberate move to widen the ambit of bad faith and to enable arbitrators to examine all of the conduct of a registrant shown by the evidence and to decide that it amounted to general bad faith if the evidence supported that conclusion. In particular, the phrase adopted to effect this change, “in particular, but without limitation” is the same as that used in the UDRP and which has always been interpreted as supporting the use of other circumstances in addition to the specified ones to show bad faith.

The Panel has examined all of the evidence carefully and has conclude that it shows on the balance of probabilities that the Registrant registered the domain name in circumstances that can fairly be described as bad faith within the generally accepted meaning of that expression.

As will have been seen from the section of this decision dealing with legitimate use, the Panel has considerable scepticism about the version of events given by the Registrant and the conclusions that have to be drawn from them. In particular, the Panel is influenced by the following: unlikelihood of the reason given by the Registrant for registering the domain name at all; why he did not register the domain name in the name of his daughter as Registrant, if his true intention was to give or transfer it to her in later years; why, three years later, he should then have registered a second domain name reflecting the name of the same daughter, *isabelleyang.ca*; the lack of any information or evidence about the Japanese soap opera (even its name) or the character Osim; the assertion that “Osim is a common name in Japan” ,which could have been shown by some sort of evidence; and the lack of any information or evidence that “...a lot of parents...named their daughters with this name.”

The Panel is also concerned by the statement by the Registrant that “I have the name since 2005. I never heard of Osim brand by that time, at least in Toronto.” That statement clearly leaves open the possibility that he had heard of the Osim brand at a place other than Toronto and at a time before he started to live in Toronto, namely when he lived in the Vancouver region, and prior to 2005 when he registered the domain name. As can be seen from the certificate recording his change of name on August 29, 2001, and submitted by the Registrant, he lived at that time in Richmond, British Columbia, one of the only two places in Canada where the Complainant, at some time after 2002, had commenced to run a “physical retail stor(e)” and adjacent to where it operated its other store, namely at Burnaby, British Columbia.

The Panel also notes that the domain name was registered at a time by which the Complainant and its OSIM brand and mark had become entrenched internationally and had established an active and physical presence in Canada. This is shown by the evidence and submissions of the Complainant, particularly Schedule D to the

Complaint, which is the detailed 2004 Annual Report of the company and it is clear from that evidence that the OSIM brand had acquired some prominence by the time the domain name was registered.

Finally, the Panel also takes into account that, although the evidence does not make out bad faith based, by itself, on the negotiations to buy the domain name, the evidence and the submissions of the Complainant certainly show a disposition by the Registrant to sell the domain name at some time and for a substantial sum of money.

The Panel recognises that some of the above is equivocal, but in total it casts doubt on the veracity of the Registrant's general submission, which is that the registration of the domain name was entirely innocent. The Panel has no wish to criticise the Registrant, but in the context of this proceeding it notes that the Registrant could have been more forthcoming on issues that he must have realised were important and could determine the outcome of this case.

The Panel cannot be certain of it, but on the balance of probabilities, the Panel finds that the intention of the Registrant was to register the domain name because it reflected the Complainant's name and OSIM trademark and eventually to use it for a purpose more consistent with his own interests than the Complainant's interests and probably for a purpose that would benefit him financially. That constitutes bad faith registration.

The Complainant has thus made out the third of the elements that it must establish.

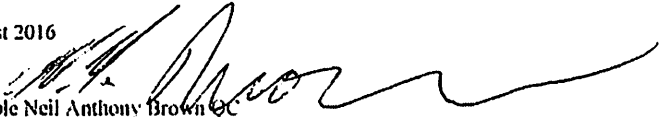
CONCLUSION AND DECISION

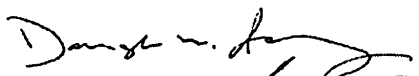
The Panel finds that the constituent elements of the Policy have been made out and that the Complainant is entitled to the relief it seeks. The Panel will therefore order that the disputed domain name be transferred to the Complainant.

ORDER

The Panel directs that the registration of the Domain Name <osim.ca> be transferred from the Registrant to the Complainant OSIM International Ltd.

Date: 2 August 2016


The Honourable Neil Anthony Brown Q.C.
Chair


Douglas M. Isenberg
Panelist


Anton Melnyk Q.C.
Panelist