

**CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

DECISION

Domain Name: sensormatic.ca

Complainant: Tyco Fire & Security GmbH

Registrant: is Darren Leonard c/o DP Enterprise

Registrar: Go Daddy Domains Canada, Inc.

Service Provider: Resolution Canada Inc.

Panelists: Alessandro Colonnier (Chair), Yuri Chumak and Jay Josefo

A. THE PARTIES

1. The Complainant is Tyco Fire & Security GmbH (the “Complainant”).
2. The Registrant is Darren Leonard c/o DP Enterprise (the “Registrant”).

B. DISPUTED DOMAIN NAME & REGISTRAR

3. The disputed domain name is sensormatic.ca (the “Domain Name”) and the Registrar is Go Daddy Domains Canada, Inc.

C. PROCEDURAL HISTORY

4. This is a dispute resolution proceeding initiated pursuant to the *CIRA Domain Name Dispute Resolution Policy* (the “Policy”) and the *CIRA Policies, Rules, and Procedures - CIRA Domain Name Dispute Resolution Rules* (the “Rules”). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of this dispute pursuant to the Policy and the Rules.
5. The Complainant filed its complaint (the “Complaint”) on April 29, 2015.
6. The Panel was not provided with a response from the Registrant.
7. The Panel was informed by Resolution Canada Inc. (the “Provider”) that the Registrant filed a document purporting to be a response within the time set out in the Rules, yet it was determined by the Provider to not be in administrative compliance with the Rules. The Registrant’s representative, Darren Perlman, was advised of all instances of non-compliance by the Provider on June 4, 2015 and was given 10 days to correct all such instances of non-compliance per Paragraph 5.6 of the Rules. The Provider informed the Panel that no further communication was received from the Registrant by July 14, 2015, well in excess of the 10 day limit as contemplated by the Rules. The Panel was not advised of the contents of the document purporting to be a response.
8. Importantly, the Panel notes that, among other requirements, the document purporting to be a response was missing the certification of the Registrant which

contains, *inter alia*, a statement certifying that the information in the Response is complete and accurate, which is required per Rule 5.2(i) of the Rules.

9. According to Rule 1.1(a), it is the Provider, rather than the Panel, who has the responsibility of determining whether or not a Response is in compliance with the Rules.
10. On July 10, 2015, the Panel was appointed. As prescribed by the Policy, the Panel has declared to the Provider that it can act impartially and independently in connection with this matter, and that there are no circumstances known to the Panel which would prevent it from so acting.

D. CANADIAN PRESENCE REQUIREMENTS: ELIGIBILITY OF THE COMPLAINANT

11. The Complainant is a Swiss company. However, it owns a Canadian trade-mark registration for the mark “SENSORMATIC”, registration number TMA212694. The Panel is therefore satisfied that the Complainant meets the presence requirement in accordance with paragraph 2(q) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3.

E. THE POSITIONS OF THE PARTIES

The Complainant’s Position

12. The Complainant, through its predecessor in title, affiliates and licensees, has been very widely known around the world for nearly 50 years as a supplier of electronic article surveillance equipment and related design, installation and maintenance services.
13. The Complainant is an affiliate of Tyco International Plc, which is the world’s largest pure-play fire and security business providing more than three million customers around the globe with the latest fire protection and security products.
14. The Complainant obtained two trade-mark registrations in Canada for the word “SENSORMATIC”, the earliest having been registered March 5, 1974. The Complainant owns various trade-mark registrations for the word “SENSORMATIC” around the world. The trade-mark “SENSORMATIC” is a highly distinctive coined term, and has generated in excess of \$100 million in revenue in Canada alone between 2012 and 2014.
15. The Domain Name was registered on August 9, 2013, without the permission of the Complainant, and made to resolve to a website www.jeanmachine.com where, according to his LinkedIn profile, the Registrant appears to be employed as an operations manager.
16. The Complainant sent a letter to the Registrant on December 2, 2014. The Registrant responded on the same day, stating that www.jeanmachine.com had nothing to do with the Domain Name and that the Registrant’s plans had nothing to do with the SENSORMATIC brand.

17. Further communication occurred between January and February 2015, whereby the Complainant reiterated its position and the Registrant claimed that he would release the Domain Name if the Complainant was willing to cover all of the Registrant's costs.
18. The Complainant in essence asserts that the Domain Name is confusingly similar with the registered trade-mark SENSORMATIC. The Registrant does not have a legitimate interest in the Domain Name as there is no relationship between the parties, it was not registered in good faith, it is not clearly descriptive, it is not generic of any wares, it is not used with a non-commercial activity, it is not a legal name, and finally it is not a geographical location. Further, the Registrant registered the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement. The Complainant also alleges that the Registrant registered the Domain Name to sell for a profit and has also engaged in a pattern of unauthorized domain name registrations by virtue of its registration of many other domain names.
19. The Complainant accordingly has, based on the above submissions, requested the transfer of the Domain Name to it.

The Registrant's Position

20. The Registrant, having failed to file a response in an acceptable form, has made no submissions.

F. DISCUSSION & REASONS

21. In accordance with paragraph 4.1 of the Policy, to succeed in this proceeding the Complainant must prove, on a balance of probabilities, that:
 - (a) the Registrant's 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 of the Policy;

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 of the Policy.

"CONFUSINGLY SIMILAR" – PARAGRAPH 3.3 OF THE POLICY

22. As per paragraph 3.2(c), a complainant may rely on its registered trade-mark(s) when seeking to establish the requisite Rights as prescribed by the Policy.

23. The Complainant has a registered trade-mark with CIPO under TMA212694 which was issued on March 5, 1974. This registration date is well before the August 9, 2013 registration date of the Domain Name.
24. As per paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if the domain name so nearly resembles the mark in appearance, sound or in the ideas suggested by the mark so as to be likely to be mistaken for the mark.
25. Pursuant to paragraph 1.2 of the Policy, a domain name is defined as the second level domain (the portion that immediately precedes the dot-ca suffix).
26. The test to be applied when considering “confusingly similar” is one of first impression and imperfect recollection. The Complainant must prove, on a balance of probabilities, that a person, as a matter of first impression, knowing the Complainant’s corresponding marks only, and having an imperfect recollection of the marks, would likely confuse the Domain Name for the Complainant’s marks based upon the appearance, sound or the ideas suggested by the mark.
27. It should be noted that the test for confusion under the Policy is not the same test for confusion set out under the Canadian *Trade-marks Act*. Under the Section 6(5) of the *Trade-mark Act*, when assessing the likelihood of confusion between marks, the factors to consider are as follows: (a) the inherent distinctiveness of the marks and the extent to which they have become known; (b) the length of time the marks have been in use; (c) the nature of the wares, services, or businesses; (d) the nature of the trade; (e) the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them; and (f) the surrounding circumstances.
28. In contrast, the Policy provides that confusion is established if a domain name so nearly resembles a mark in appearance, sound, or in the ideas suggested. This is similar to the test set out under Section 6(5)(e) of the *Trade-marks Act*. However, the remaining factors as set out under the *Trade-marks Act* do not apply to the assessment of confusion under the Policy. The Policy’s summary proceedings are ill-suited for the in-depth and traditional confusion analysis contemplated by the *Trade-marks Act*.
29. In this case, the Domain Name is identical to the registered trade-mark “SENSORMATIC”. This is, in our view, clearly sufficient and conclusive for us to make a finding of confusion.
30. The Panel concludes that the Domain Name is confusingly similar with the Complainant’s registered trade-mark, given that the Domain Name is identical to the Complainant’s trade-mark in appearance, sound and in the ideas suggested so as to be likely to be mistaken for the trade-mark.

Conclusion - Confusion

31. The Panel finds that the Complainant has satisfied the requirements enumerated under paragraph 3.1(a) of the Policy.

“BAD FAITH REGISTRATION” – PARAGRAPH 3.5 OF THE POLICY

32. The Complainant has alleged that the Domain Name was registered in bad faith pursuant to paragraphs 3.5(a), (b) and (d).
33. Subparagraph 3.5(b) allows a finding of bad faith if the Registrant registered the domain name in order to prevent the Complainant from registering the mark as a domain name, provided that the Registrant engages in a pattern of such behavior.
34. In this case, the registration of the Domain Name has prevented the Complainant from registering its “SENSORMATIC” mark as a .ca domain name. Given the long-standing use and registration of the “SENSORMATIC” trade-mark in Canada by the Complainant, the Registrant must have or should have had knowledge of the Complainant’s mark at the time he chose to register a domain name that is identical with the said mark.
35. Evidence was adduced by the Complainant as Exhibit 14 of the Complaint that the Registrant has registered and owns at least 15 domain names to which he does not appear entitled. A review of those domain names indicated to the Panel that the Registrant engages in a pattern of registering domain names to prevent rightful owners of trade-marks from registering them as domain names. In fact, the Complainant proffers Exhibit 16 of its Complaint which consists of an Affidavit of an executive of one of these rightful owners stating that that such rightful owner has not, at any time, authorized the Registrant to register the relevant domain names. The Panel accepts the Complainant’s evidence that the Registrant’s other registered domain names, including dot-com and dot-ca domain names, are identical to or confusingly similar with corresponding registered trade-marks of others.
36. Of note, the Complainant’s evidence in Exhibit 13 contains a letter sent from the Registrant to the Complainant. In the letter, the Registrant indicates that the domains in question are held “on behalf of the owner of the company [the Registrant] works for”. The Panel finds it hard to believe that the Jean Machine company that the Registrant works for, as shown in the Registrant’s LinkedIn profile found in Exhibit 9, would require the Registrant to hold 15 domain name registrations comprising the marks of others.
37. Therefore, the Panel concludes that the Registrant has registered the Domain Name in order to prevent the Complainant from registering the mark as a domain name, given the Registrant’s pattern of registering domain names to prevent other persons who have rights in those marks from registering those marks as domain names, contrary to Paragraph 3.5(b) of the Policy. Bad faith is therefore inferred on this ground.

38. As the Panel has concluded that the Registrant has registered the Domain Name in bad faith in accordance with Paragraph 3.5(b) of the Policy, the Panel does not need to consider the other possible grounds of bad faith.

Conclusion – Bad Faith

39. The Panel finds that the Complainant has satisfied the requirements enumerated under paragraph 3.1(c) as it relates to paragraph 3.5(b) of the Policy. In light of this finding, the Complainant’s submissions relating to 3.5(a) and 3.5(d) of the Policy do not need to be addressed.

“LEGITIMATE INTEREST” – PARAGRAPH 3.4 OF THE POLICY

40. The final element to determine is whether the Registrant has a legitimate interest in the Domain Name.
41. As per paragraph 4.1 of the Policy, the Complainant must provide “some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.4”.
42. Once this onus has been discharged by the Complainant, the Registrant may still succeed if it can show, on a balance of probabilities, that it has a legitimate interest in the Domain Name pursuant to paragraph 3.4.
43. In the view of the Panel, and with regard to the evidence, the Registrant does not meet any of the circumstances listed in paragraph 3.4 of the Policy. The Registrant’s registration and use of the Domain Name cannot be said to have been done in good faith as the Registrant had no rights in the established and rather distinctive “SENSORMATIC” mark, contrary to Paragraph 3.4(a) of the Policy. Further, the Domain Name cannot be said to be descriptive or generic in accordance with Paragraphs 3.4(b) and 3.4(c). The Registrant has not used the Domain Name in association with a non-commercial activity including pursuant to Paragraph 3.4(d). Finally, the Domain Name is neither the legal name of the Registrant, nor is it a geographical name of the location of the Registrant’s place of business pursuant to Paragraphs 3.4(e) and 3.4(f).
44. The Panel is of the view that the Registrant has failed to satisfy the onus under paragraphs 4.1(c) and 3.4 of the Policy.

Conclusion – Legitimate Interest

45. Accordingly, the Panel finds that the Complainant has satisfied the requirements enumerated under paragraph 3.1(b) of the Policy and that the Registrant does not have a legitimate interest in the Domain Name.

DECISION & ORDER

46. For the reasons set out herein, the Panel decides this dispute in favour of the Complainant.
47. Pursuant to paragraph 4.3 of the Policy, the Panel orders the transfer of the domain name sensormatic.ca to the Complainant.

Dated at Ottawa, Ontario, Canada, this 29th day of July, 2015.



Alessandro Colonnier (Chair) for the Panel
Yuri Chumak
Jay Josefo