

**IN THE MATTER OF A COMPLAINT PURSUANT
TO THE CANADIAN INTERNET REGISTRATION AUTHORITY (“CIRA”)
DOMAIN NAME DISPUTE RESOLUTION POLICY (“the POLICY”)**

Dispute Number: DCA-2154-CIRA
Complainant: TiVo Brands LLC
Registrant: Microscience Corporation
Disputed Domain Names: tivo.ca
Registrar: 111.dot-ca-registry.ca (Burmac Business Systems Ltd.)
Arbitrator: Mr. Claude Freeman, LL.M. (ADR), C. Med., C. Arb.
Service Provider: British Columbia International Commercial Arbitration Centre (the “BCICAC”)

BCICAC FILE NUMBER: DCA-2154-CIRA

PROCEDURAL HISTORY

1. On October 16, 2019, the above-named Complainant filed a Complaint pursuant to the CDRP and the Rules.
2. In a letter dated October 18, 2019 the Centre confirmed compliance of the Complaint with the CDRP Rules and established the commencement date of the dispute resolution process (October 18, 2019) in accordance with Rule 4.4.
3. As the Complaint with the attachments was filed via electronic transmission (e-mail); the Centre therefore delivered the Complaint to the Registrant only by e-mail.
4. On October 18, 2019, the Registrant sent a written request to the Centre asking to extend the deadline for filing the Registrant’s response. The Centre granted such an extension on October 21, 2019. The initial date of delivery of the Response, November 7, 2019, was postponed to November 27, 2019.
5. On November 26, 2019, the Registrant’s representative contacted the Centre via email with a request to reject the Complaint due to its deficiency for two grounds: the Complaint exceeds five thousand words and that it does not correctly identify the parties, and; therefore, *“should be rejected as it is defective.”*
6. On November 27, 2019, the Centre responded the Registrant by email, indicating that the Centre's calculations show that the Complainant described the particulars of the basis for the Complaint, in accordance with Rule 3.2 (i), in 4,333 words; therefore *“the Centre does not have any grounds to treat the Complaint as deficient.”* The Centre also stated that *“It appears that the interpretation of Paragraph 3.2 (i) of the CIRA Rules is an issue. At this point, only the appointed Panel should decide this matter.”*

In the same email, the Centre stated the following: *"Since the Centre did not reply to your email dated November 26, 2019 within 24 hours, the Centre grants an additional 48 hours (i.e. by 1 pm PST) to submit your Response."* Later, the Centre revoked the 48-hour time extension, as the Registrant has already reached the 20 day limit and the Complainant's consent is required (Rule 5.4).

7. On November 27, 2019, the Centre contacted counsel for the Complainant regarding the Respondent's request for an additional extension of the deadline for filing its Response. The Complainant did not consent to any additional extension of the term.

8. On November 28, 2019, the Centre confirmed that the Registrant did not provide its Response by the due date of November 27, 2019. As permitted given the absence of a Response, the Complainant elected under Rule 6.5 to convert from a panel of three to a single arbitrator.

In the same email, the Centre noted the following: *"The Registrant may send a written request to the Centre to accept the late response, which will be forwarded to the appointed arbitration panel. It will be up to the sole discretion of the panel to elect to accept the late submission."*

Single arbitrator appointment:

In the absence of a response by the Registrant, the Registrant is not in administrative compliance in the following areas:

- 1) failure to nominate candidates from the providers list – per paragraph 5.2(c) of CDRP rules;
- 2) failure to provide a summary of and references to the relevant Canadian Law – per paragraph 5.2(f) of CDRP rules;
- 3) failure to provide a summary of and references to prior CIRA decisions that would be persuasive, and which apply to domain names registered under any other top-level domain – per paragraph 5.2(g) of CDRP rules; and
- 4) failure to conclude with the certification of the Registrant in form set out in Appendix "B", followed by the signature of the Registrant or its authorized representative – per paragraph 5.2 (j) of CDRP rules.

As provided for by paragraph 5.6 of CDRP rules, the Registrant is permitted 10 days notice in order to remedy all instances of non-compliance.

As permitted under Rule 6.5, the Complainant elected to convert from a panel of three arbitrators to a single arbitrator, to render a decision in this matter. On December 5th, 2019, the BCICAC provided the appointment of the herein arbitration to the sole arbitrator, who accepted same.

Pre-hearing issue(s) raised by the Registrant

In item #5 above in the Procedural history, the Registrant raised an issue which is considered pre-hearing in nature. This issue must be addressed by the arbitrator prior to dealing with the Complaint by the Complainant, given that the Registrant requested of the BCICAC that the Complaint be rejected for the reason set out in "a" below. The BCICAC advised the registrant that the appointed panel would have to decide on this and any other issues.

- a) The Registrant has objected with the length of the Complainant's complaint document, indicating that it is deficient, as exceeds five thousand words as permitted by the Policy. The BCICAC responded that they did in fact calculate the length of the complaint

document at 4,333 words. The Registrant has offered no proof of any calculation whatsoever in support of this allegation.

- b) Secondly, the Registrant submitted a separate objection that since the complaint document did not correctly identify the parties the Complaint is also deficient. Courts of law regularly allow parties to make corrections/erratum or corrigendum to documents that have already been filed, and to do so without dismissing the matters. The same allowances for typographical or other clerical errors must be permitted. Other than to make an objection on this point, the Registrant has not advanced any other clear basis or sound argument as to why a typographical error should not be allowed and then corrected.

The Registrant has not offered or provided any substantive evidence, proof or argument to assert sound reasoning for this arbitrator to allow the rejection of the Complaint on the basis of length alone.

Accordingly, the rejection of the Complaint is denied.

Basis for the Complaint

The Complainant (TiVo BRANDS LLC – hereafter “TiVo”), submits as follows below for the basis for the Complaint.

The Complainant respectfully submits that, in accordance with Paragraph 3.1 of the Policy:

(a) the Registrant’s “dot-ca” domain name, being www.TiVo.ca (the “**Disputed Domain Name**”) is Confusingly Similar to the TIVO Mark, in which the Complainant’s predecessor in title had rights prior to the date of registration of the Disputed Domain Name and which the Complainant now has and continues to have;

(b) the Registrant has no legitimate interest in the Disputed Domain Name, as described in Paragraph 3.4 of the Policy; and

(c) The Registrant has registered and uses the Disputed Domain Name in bad faith, as described in Paragraph 3.5 of the Policy.

The Complainant further sets out and supports their positions rather extensively below. It should be noted that the Exhibits submitted by the Complainant in support of their Complaint have been reviewed by this arbitrator, and reconcile with the allegations in the Complaint, which cite those Exhibits. Accordingly, in the interest of editorial brevity and literary ease, the notations to the exhibits have not been included in the Complaint below.

A. Confusingly Similar

Rights in a Mark

1. In accordance with Paragraph 3.1(a) of the Policy, the Complainant must show that it had Rights, and continues to have Rights, in a Mark that was Confusingly Similar to the Disputed Domain Name prior to the date of Registration of the same.

2. TiVo Brands LLC is the current owner of the TIVO Mark. While the TIVO Mark was initially applied for by TiVo Inc. it was later assigned to the Complainant. Accordingly, as per Paragraph 3.1(a) of the Policy, the Complainant has been lawfully assigned the rights in and to the TIVO Mark and continues to have such rights.

Date of Registration

3. The Disputed Domain Name was registered on January 9, 2003. This registration date is set out in a "WHOIS" report. Accordingly, January 9, 2003 is the date for determining whether the Complainant had rights in a "Mark" prior to registration of the Disputed Domain Name.

4. A review of the historical data of the Complainant's TIVO Mark reveals the following:

(a) The Complainant's predecessor in title filed the TIVO Mark in Canada on November 26, 1998, and claimed priority back to its USA registration for the same trademark which was filed in the USA on May 29, 1998;

(b) The USA trademark registration matured and was registered on January 23, 2001;

(c) The Canadian registration of the TIVO Mark was advertised on April 4, 2001, and would have registered shortly thereafter, but the TIVO Mark was opposed, thereby delaying the registration;

(d) The opposition proceeding was withdrawn by the opponent and the TIVO Mark application was allowed on November 20, 2002;

(e) The TIVO Mark matured to registration on November 11, 2003;

(f) The TIVO Mark was assigned to the Complainant on July 18, 2005; and

(g) The TIVO Mark was renewed on November 20, 2018, where the Complainant continues to use the TIVO Mark.

5. Given the prosecution history of the TIVO Mark, it is apparent that the protracted opposition proceedings delayed registration of the TIVO Mark. Absent such a prolonged examination process of the trademark, the Complainant respectfully submits that the TIVO Mark would have likely registered well before the Disputed Domain Name. Copies of the Opposition Materials filed in the opposition proceedings evidence the delay in registration which was created through the opposition proceeding.

6. In cases of trademarks registered based upon a priority claim, the Complainant respectfully submits that it has rights back to that date accepted by the Canadian Intellectual Property Office. In that respect, the Complainant respectfully submits that it had rights in and to the TIVO Mark as at the date stated in the USA trademark application, that being November 26, 1998. In the alternative, the Complainant respectfully submits that it has a common law trademark in the TIVO Mark as contemplated by Paragraph 3.2(a) of the Policy and that its common law trademark rights predates the registration date of the Disputed Domain Name.

7. The TIVO Mark has been well known in Canada and abroad since at least as early as 2000. For example, at the time that the Disputed Domain Name was registered, the following trademarks were applied for and/or registered:

Canada:

(a) TMA619659: TIVO, TV YOUR WAY – Filed on November 9, 2000; Registered on September 15, 2004;

(b) TMA595,172: TIVO & WALKING TV Design – Filed on January 20, 2000; Registered on November 19, 2003;

USA:

(a) Serial Number 75493408: TIVO – Filed on May 29, 1998; Registered on January 23, 2001;

(b) Serial Number 75774400: TIVO CENTRAL – Filed on August 12, 1999; Registered on March 20, 2001;

(c) Serial Number 75841174: TIVO – Filed on November 4, 1999; Registered on May 7, 2002;

(d) Serial Number 76359394: TIVO – Filed on January 15, 2002; Registered on October 29, 2002;

UK:

(a) EU001006014: TIVO – Filed November 27, 1998; Registered February 1, 2011

8. Given its international presence, the TIVO Mark has become particularly well known to consumers in Canada in respect of the live, recorded, on-demand and streaming entertainment and other related products. The Complainant became known as the creator and leader in digital video recording shortly after its emergence in 1998 in the San Francisco area. Despite the Complainant's formal launch date of certain goods and services in Canada occurring some time later, the Complainant was in fact providing its goods and services to Canadians prior to the date that the Registrant registered the Disputed Domain Name.

9. Based on the foregoing, the Complainant respectfully submits that it has established on the balance of probabilities its rights in the TIVO Mark within the meaning of Paragraph 3.1(a) of the Policy, and that these Rights were established prior to the date of registration of the Disputed Domain Name, that being January 9, 2003.

Confusingly Similar

10. In determining whether a domain name is Confusingly Similar to a Mark, Paragraph 3.3 of the Policy states the following:

“Confusingly Similar”. In determining whether a domain name is “Confusingly Similar” to a Mark, the Panel shall only consider whether the domain name so

nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark.

11. 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 Canadian *Trademarks Act*.

12. For the purpose of determining whether a domain name is Confusingly Similar to a Mark, Paragraph 1.2 of the Policy indicates that the “.ca” suffix of the domain name should not be considered.

13. Applying the test of confusion under the Policy, the Complainant submits that upon first impression and imperfect recollection, the public will perceive the Disputed Domain Name as being associated with the Complainant as the Disputed Domain name is identical to the TIVO Mark, aside from the “.ca” suffix. Accordingly, Complainant respectfully submits that the Disputed Domain Name is confusingly similar to the TIVO Mark.

14. Based on the foregoing, the Complainant respectfully submits that it has met its burden under Paragraph 3.1 (a) of the Policy.

B. No Legitimate Interest in the Domain Name

15. Under Paragraph 4.1(c) of the Policy, the Complainant must provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Name as described in paragraph 3.4 of the Policy. The burden to provide “some evidence” of no legitimate interest is a low one, and is less than the burden of a balance of probabilities used in civil courts.

16. Paragraph 3.4 lists six sets of circumstances, any one of which shall demonstrate that the Registrant has a legitimate interest in a domain name:

3.4 Legitimate Interests. For the purposes of Paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in a domain name:

(a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;

(b) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of: (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;

(c) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;

(d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;

(e) the domain name comprised the legal name of the Registrant or was a surname or other reference by which the Registrant was commonly identified; or

(f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

17. The Registrant has redirected the Disputed Domain Name to www.mediadiscovery.net which is a pay-per-click website displaying various sponsored and/or advertised links, as evidenced by the screenshot of the landing page.

18. In the past, the Disputed Domain Name resolved to a landing page which contained links to competitors' products, and confirmed through the Wayback Machine database.

19. The Complainant submits that the Registrant has no "legitimate interest" in the Disputed Domain Name as that concept is defined in Paragraph 3.4 of the Policy. In particular:

(a) as per Paragraph 3.4(a) of the Policy, the Registrant has no Rights in the TIVO Mark, and does not hold a valid trademark registration for the TIVO Mark;

(b) the Disputed Domain Name redirects to a pay-per-click website with a view to reaping commercial advantage by attempting to capitalize on consumer confusion. Such a redirection negates any claim of a legitimate interest and cannot be considered to constitute a *bona fide* use of the Disputed Domain Name;

(c) the Registrant has not used the Disputed Domain Name as a Mark for the purpose of distinguishing any of its goods, services or business from the goods, services, or businesses of another person;

(d) given that the Disputed Domain Name has not been used in good faith, the Registrant may not rely on the protection extended by Paragraphs 3.4(b), (c) and

(d) of the Policy. The Disputed Domain Name itself is not a descriptive or generic term, nor has the Disputed Domain Name been used in connection with a non-commercial activity;

(e) the Disputed Domain Name is not the name, surname or reference by which the Registrant is commonly identified, and, as such, do not qualify under Paragraph 3.4(e); and

(f) the Disputed Domain Name is neither a geographical name nor location where the Registrant carries on business, and hence the Registrant cannot claim the benefit of Paragraph 3.4(f).

20. In conclusion, the Complainant submits that it has presented evidence that is sufficient to meet its burden to present "some evidence" that the Registrant has no legitimate interest in the Disputed Domain Name. Having met this threshold, the burden then shifts

to the Registrant to prove, on a balance of probabilities, that it has a legitimate interest in the Disputed Domain Name, failing which, no legitimate use should be found.

C. Bad Faith Registration of Domain Names

21. The Complainant submits that the Registrant has registered the Disputed Domain Name in bad faith in accordance with the definition of "bad faith" contained in Paragraph 3.5 of the Policy.

22. The Policy states the following with respect to the bad faith requirement:

3.5 Registration in Bad Faith.

For the purposes of Paragraphs 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:

(a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration;

(b) the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone 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.

23. The Complainant relies on paragraphs 3.5(b), 3.5(c), and 3.5(d) of the Policy to support its contention that the Registrant has registered the Disputed Domain Name in bad faith.

24. Relying on Paragraph 3.5(b) of the Policy, the Complainant submits that the Registrant 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. Specifically, the following unauthorized domain names have been registered by the Registrant and/or affiliated companies which Daniel Mullen control, including the following: Panavision.ca; delldeals.ca; dellbusiness.ca; americanexpresscreditcards.ca; burberry.ca;

Westinghouse.ca; Patagonia.ca. Further, as evidenced in the TIVO.CA WHOIS Report, the Registrant and/or Daniel Mullen own approximately 302 other domain names.

25. Relying on Paragraph 3.5(c) of the Policy, the Complainant respectfully submits that resolving www.tivo.ca to other shopping websites qualifies the Registrant as a “competitor” of the Complainant, as the website has, in the past, provided end users with access to links of competitors of the Complainant, thereby competing for Internet traffic by attempting to capitalize on end user confusion. At present, the Disputed Domain Name resolves to unrelated links, which nevertheless cause confusion and compete for internet traffic.

26. Relying on Paragraph 3.5(d) of the Policy, the Complainant respectfully submits that, in addition, use of Disputed Domain Name is disruptive to the Complainant, as potential consumers are likely to be confused into believing that the Disputed Domain Name and website are somehow affiliated with, or sponsored by, the Complainant. The mere potential for the misdirection of end users to the Registrant’s website based upon end user initial interest confusion, irrespective of the nature or content of the Registrant’s website, constitutes a disruption to the Complainant’s business and the goodwill subsisting in the TIVO Mark. If an end user is confused into believing that there is some association between the Disputed Domain Name and the Complainant, but that confusion is immediately dispelled upon the Registrant’s website, a disruption to the Complainant has nevertheless occurred. Under the circumstances, it is reasonable to infer that the Registrant not only knew this diversion would be disruptive, but intended it to be so.

27. Lastly, the Complainant further submits that it is inconceivable that the Registrant did not know of the Complainant’s earlier rights in the TIVO Mark, given the Complainant’s use of the TIVO Mark for many years prior to the Registrant’s registration of the Disputed Domain Name and based on the notoriety of the goods and services offered by TIVO under the TIVO Mark. Based on the bad faith criteria listed in Paragraph 3.5 of the Policy and the surrounding circumstances, the Complainant submits that it has established the bad faith conduct of the Registrant.

LAW AND DECISIONS

28. The Complainant submits that, as directed by Paragraph 12.1 of the Rules, the proper choice of law in the matter are the rules and principles of law of the province of Ontario and the law of Canada, in particular those federal laws that related to trademarks as well as the common law treatment of trademarks.

29. With respect to the three criteria that must be proved pursuant to Paragraph 3.1 of the Policy, the Complainant relies on the decisions set forth below.

A. Rights in a Mark/ Confusingly Similar

30. All that is required under Paragraph 3.1(a) of the Policy is that the Complainant has “Rights” in a Mark and the “Rights” existed prior to the date of registration of the Disputed Domain Name. The term “Rights” is not defined in the Policy. The Complainant must also show that the Mark is confusing with the Disputed Domain Name.

In a Mark

31. The Complainant respectfully submits that it had Rights in the Mark prior to the date of Registration of the Disputed Domain name and relies on the following:

(a) the priority date stated in its Canadian Application; and

(b) the common law rights in the Mark which predate the date of registration of the Disputed Domain Name.

32. The Complainant submits that it has rights back to that date accepted by the Canadian Intellectual Property Office, that being the date of the USA application which was on May 29, 1998. The Complainant relies on the decision of *Twenga v. privacy protected*, CIRA Decisions No. 00177 (January 23, 2012), where the Panel opined as follows:

I am prepared to find that once a trade-mark has been registered, that the trademark owner has rights in the Mark from the date of application and thereafter. Further, in the case of a trade-mark registered based on clause 14 (1) (b) of the Trade-marks Act, R. S. C., 1985, c. T-13, I am prepared to accept that the Complainant has rights in the Mark back to the date accepted by the Canadian Intellectual Property Office for the TWENGA trade-mark, which was issued based on the registration in France on November 18, 2004. Rights are not defined in the Policy and in my view are not limited to the classical test of prior use as described in "Cheap Tickets."

A broad reading of the phrase "rights in the Mark" is required to provide for a fair balance between the rights of a domain name holder and that of a trade-mark registrant. The trade-mark registrant has followed the application process in the Trade-marks Act and that process allows for a determination of who is entitled to the use of the trademark. In the case of trade-marks which are for the same class of goods and services as provided by the owner of the domain name, I defer to the registration of the trade-mark as establishing which of the competing claimants have rights in the trade-mark.

33. This interpretation provides the fair balance between the rights of a domain name holder and that of a trademark registration. The Complainant understands that the Policy attempts to address the interest of protecting registrants from reverse domain name hijacking. Reverse domain name hijacking refers to a trade-mark holder bringing an action to obtain a registered domain name which domain name had been registered before the trademark was obtained. Is it on this basis that the Policy insists that a complainant has Rights in the Mark prior to the registration of a domain name. While this portion of the policy protects registrants from reverse domain name hijacking, the interests of trademark holders must also be recognized within the Policy.

34. The Complainant notes that under previous versions of the Policy, the words "Rights", "Mark" and "Use" had strict, interrelated definitions, which generally excluded marks that had not been registered or used (in a strict trademarks sense) in Canada prior to the registration of a disputed domain name. However, in August 2011, the CDRP Policy was amended to bring it further in line with the Uniform Domain Name Resolution Policy (the "UDRP"). While the reasons for such amendments are not publicly known, the effect is that such amendments provide flexibility to panels in adjudicating whether or not a Complainant had Rights in a Mark. The Complainant respectfully submits that this flexible interpretation is in keeping with the Policy for the following reasons:

(a) The Policy is modelled after the UDRP. While both the CDRP and UDRP require a complainant to have rights to a confusingly similar mark, the CDRP explicitly requires that these rights predate the registration date of the disputed domain name. The UDRP does not require that rights in a mark necessarily predate the date of the disputed domain name registration, given that there can be obvious challenges in establishing “bad faith” on the part of the registrant if it did not own earlier rights;

(b) It is a well-known fact by Canadian trademark practitioners that the Canadian Intellectual Property Office (the “CIPO”) has significant delays in terms of processing applications, where, but for such bureaucratic delays, trademark applications would proceed to registration in a more expedient fashion;

(c) Once an applicant makes a trademark application, the details of that application become public. Such public disclosure is often the source of abuse toward trademark applicants. For example, such disclosure provides individuals with information about pending trademarks, where individuals can take such information to register domain names without legitimate interest, and/or provide scam type notices to try to extract money from trademark applicant;

(d) In all applications, the applicant must assert in the application that they have rights in and to the application;

(e) It is always up to the Registrant to oppose a trademark application. In the present instance, the Application for the TIVO Mark was never opposed; and

(f) Under recent amendments to Canadian trademark legislation, no declaration of use is required and processing times are to be improved. Applications are also able to proceed on a divisional basis, where, for example, if an opponent opposes based on a certain class of goods/and or services, the applicant can still have the uncontested portions of the trademark proceed, thereby expediting registration even in cases of protracted opposition proceedings.

35. Based on, and given the foregoing, the Complainant respectfully submits that the most recent amendments to the Policy support a flexible approach to finding Rights in a Mark. It is also consistent with maintaining a balance between rights of domain name holders and trademark owners.

36. Further, and in addition, while “Rights” is not defined in the Policy, it is trite law that unregistered or common law trademarks are protected under both Canadian trademark law and the Policy. The Complainant acknowledges that in cases such as in the present instance, where a trademark registration matured to registration after the Disputed Domain Name, the Complainant may also rely on its common law rights to establish its rights predate the Disputed Domain Name registration.

37. While “use” has not been defined in the Policy, it has been confirmed that use of a Mark in association with services offered online constitutes use of the Mark in Canada in accordance with s. 4(2) of the *Trade-marks Act: TSA Stores, Inc. v. the Register of Trade-marks* 2011 FC 273(FC). This finding is consistent with Canadian trademark law in which the use of unregistered marks elsewhere effectively spills over into Canada,

and thus receive some measure of protection in Canada, without even necessarily having to be used in Canada (See for example, *Orkin Exterminating Co. Inc. v. Pestco Co.* 1985 CanLII 167 (ON CA), and cited with approval in *Asos Canada Services Ltd v. Nexon Media Inc.*, (2013), 110 CPR (4th) 386; *Guitar Center, Inc. v. Pipemi*, 2014, DCA 1570-CIRA, where the Panel held that the USA based complainant established common law use of its mark based on evidence showing that it operated numerous retail locations, many within 100 miles of the Canadian border; Canadians regularly visited these locations; and the complainant operated a .com website accessible to Canadians).

Confusingly Similar

38. Lastly, with respect to the “Confusingly Similar” portion of the test, in accordance with Paragraph 3.3 of the Policy, a domain name is confusingly similar to a Mark if the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely mistaken for the Mark. In making this assessment, the dot-ca suffix is ignored. Accordingly, in the present instance where the entire mark is incorporated into the Disputed Domain Name, confusion will be established (See for example: *Omer De Serres Inc. v. 10 Dollar Domain Names Inc.*, DCA-1005-CIRA; *Citizens of Humanity, LLC v. Essi Molesky*, DCA-1665-CIRA).

39. It is respectfully submitted that the Complainant therefore had Rights in a Mark in Canada prior to the registration of the Disputed Domain Name and that the TIVO Mark is Confusingly Similar with the Disputed Domain Name.

B. Legitimate Interest

40. The Complainant has put forward evidence that the Disputed Domain Name does not fall within any of the six indicia of legitimate interest set out in Paragraph 3.6 of the Policy, and therefore, the Registrant does not have a legitimate interest in the Disputed Domain Name. Although “some evidence” is not defined, it is a lower threshold than a balance of probabilities (See for example, *Citizens of Humanity, LLC, supra*).

41. In cases where a domain name is an exact match for a brand owner’s trademark, the initial assumption is that a registrant does not have a legitimate interest in the domain name absent an agreement to the contrary between the parties (See for example, *Panavision International, L.P. v. Daniel Mullen c/o/b/ Netnic Corporation*, Resolution Canada Case No. 00378).

42. Given that the Complainant has put forth some evidence, the burden shifts to the Registrant to prove, on a balance of probabilities, that it has a legitimate interest in and to the Disputed Domain Name (*Omer De Serres Inc., supra*). In the absence of adequate evidence, the Registrant will fail to demonstrate its legitimate interest.

C. Bad Faith

43. In order to establish bad faith, only one element of Paragraph 3.5 must be established. In the present instance, the Complainant establishes at least three elements of bad faith. In addition, despite the enumerated bad faith indicia in Paragraph 3.5 of the Policy, panelists are to have regard to the totality of the circumstances (*BASF SE v. Jean-Yves Collin*, DCA-1999-CIRA).

Paragraph 3.5(b) – Pattern of Registering Domain Names

44. Paragraph 3.5(b) provides, in part, that the Complainant must establish that the Registrant “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”. The policy, does not, therefore, impose a temporal limitation on which unauthorized domain name registration the Complainant may rely upon when establishing the pattern of registration.

45. In *Panavision International, L.P., supra*, the Panel acknowledged that Mr. Mullen and related companies continue to be named in such proceedings. The Panel ultimately concluded that Mr. Mullen continues to engage in an extensive pattern of unauthorized domain name registrations and ultimately deemed Mr. Mullen to be a “serial cybersquatter”. The Complainant relies on Mr. Mullen’s and his related companies’ behavior to satisfy the requirements of Paragraph 3.5(b).

Paragraph 3.5(c) – Registering a Domain Name for Commercial Advantage

46. The website which corresponds with the Disputed Domain Name directs Internet users to further links. Currently, these links include links to unrelated websites, but have, in the past, included links to websites allegedly selling the Complainant’s product, and links to websites which sell products that are in direct competition with the Complainant. Previous jurisprudence has held that “a competitor is someone who acts in opposition to another, including competing for Internet users and that there is no requirement that the Registrant be a commercial business competitor or someone that sells competing products” (*Omer De Serres Inc., supra*).

47. The Registrant’s use of the Disputed Domain Name is also “disruptive” to the Complainant, as potential consumers are likely to be confused into believing that the Registrant’s website is somehow affiliated with, or sponsored by, the Complainant. In addition, the mere misdirection of end users to the Registrant’s website and to websites operated by competitors of the Complainant, constitutes a disruption to the Complainant.

Paragraph 3.5(d) – Attracting Users for Commercial Gain

48. The Complainant also relies on Paragraph 3.5(d) of the Policy, and respectfully submits that the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Domain by creating a likelihood of confusion with the TIVO Mark. Resolving a disputed domain name to a pay-per-click portal, such as in the present instances, with a view to reaping a commercial advantage by capitalizing on consumer confusion constitutes a *prima facie* evidence of bad faith as per Paragraph 3.5(c) of the Policy (See for example the following: *The Standard Life Assurance Company of Canada v. Hank Morin*, Resolution Canada Case No. 00046; *Sleep Country Canada Inc. v. Pilfold Ventures Inc.*, BCICAC Case No. 00027; *Lee Valleys Tools Limited v. Pilfold Ventures Inc.*, Resolution Canada Case No. 00040; *Reitmans Canada Limited/Reitmans Canada Limitee v. Pilfold Ventures Inc.*, BCICAC Case No. 00032; *The Men’s Warehouse Inc. v. Wade Traversy*, Resolution Canada Case No. 00023; *Fresh Intellectual Properties Inc. v. Sweets and Treats*, BCICAC Case No. 00033; *Canada Post Corporation v. Marco Ferro*, BCICAC Case No. 00042).

49. In such cases, the Registrant will also be found to be a “competitor” of the Complainant,

as it has offered a means by which end users may access links to businesses that compete with the Complainant, while also competing for Internet traffic by trying to capitalize on consumer confusion.

50. Based on the foregoing, the Complainant respectfully submits that it has satisfied its burden of proof of bad faith in accordance with Paragraph 3.5 of the Policy.

REMEDY SOUGHT

51. In accordance with Paragraph 4.3 of the Policy, and for the reasons described above, the Complainant seeks an order from the Panel instructing the Registrar of the Disputed Domain Name to transfer ownership of the Disputed Domain Name to the Complainant.

Reasons for the Decision

As noted earlier, the Registrant was not only found administratively non-compliant, but has not put forth submissions of any kind by the period prescribed, to be reviewed in any detail. Accordingly, as per paragraph 4.1 of the CDRP policy, the onus is on the Complainant to prove on a balance of probabilities that the disputed domain names as registered by the Registrant are confusingly similar to that of the Complainant, and that they have been registered in bad faith. In addition, the Complainant is required under this paragraph to provide “some evidence” that the Registrant has no legitimate interest in the disputed domain name(s).

1. Confusingly Similar

The first test is whether a Disputed Domain Name is confusingly similar to a Complainant’s domain name.

The evidence before us shows that in Canada, the Complainant has been using the “TIVO” Trademark in Canada prior to the Registrant through its predecessor in title.

In order to address the issue of confusion with the standard legal test prevailing in Canada, one can find that in determining whether or not there exists a reasonable likelihood of confusion between the trademarks at issue, the Registrant must have a regard to all the surrounding circumstances, including non-exhaustingly, those specifically enumerated in Subsection 6 (5) of the Canadian Trademarks Act.

- a) inherent distinctiveness of the trademarks, and the extent to which they have become known;
- b) length of time the trademarks have been in use;
- c) nature of wares, services or business;
- d) nature of the trade; and
- e) degree of resemblance between the trademarks in appearance or sound in the ideas suggested by them.

A generally accepted principle when applying the test of confusion is looking at the trademarks from the point of the unwary consumer – comparing similarities as opposed to differences. Can the internet user be easily misled by error or otherwise – and perhaps not even know? Could this confusion also impact not only on any and all other potential commercial relationships in existence or being sought with the Complainant? If this would impact on the commercial relationship sought with the Complainant by the internet users, then by logical corollary, this confusion would impact (or possibly sabotage) the commercial relationships the Complainant has or is seeking with its' existing client base as well.

The Registrant's dot.ca domain is Confusingly Similar with a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights. Simply put, this assertion was held in BCICAC Case No. 00011, *Government of Canada v. David Bedford*.

The test for "Confusingly Similar" under Policy 3.4 is one of resemblance based on first impression and imperfect recollection. Given that the Trademarks are identical to the Domain Name, a person would inevitably mistake the Domain Name (without the .ca suffix) for the Trademarks. The Complainant submits a person knowing any of the Complainant's Trademarks would likely mistake the Domain Name "for the Complainant's corresponding mark based upon the appearance, sound or ideas suggested by the Mark".

Confusion under the *Trade-marks Act* occurs if the use over the trade-marks is likely to lead to the inference that the wares and services associated with the trade-marks are manufactured, sold or performed by the same person. That being said, even if the Registrant is not marketing/selling, manufacturing products or services of the like the Complainant provides, this can create an intellectual extrapolation.

In this case, the Registrant's registration of the Domain Name does not link to any website, and the registrant has not established any theme, type of business, product or service through the Domain Name. Nonetheless, through registration of the Domain Name, the Registrant has continued to hold the Domain Name captive, in spite of prior Trademark ownership by the Complainant.

Whether the Domain Name currently resolves or not to a website – without intervention by the Complainant, web confusion could very well likely occur in the future, in the event the Registrant decided to link the Domain Name to a website.

In that event, the unwary user of the web could be misled and think that the Registrant really is the Complainant – thus creating a false, "climate", thus impacting directly and negatively on the Complainant.

To this arbitrator, the domain name "TiVo.ca" is clearly a part of, (and similar in appearance, sound and in the ideas) with the "TIVO" Trademark. There appears therefore, not only confusion with, but also misappropriation of the domain name, by the Registrant.

This Arbitrator concludes on this issue that the Complainant has met the onus of demonstrating that the disputed domain name is "confusingly similar" – as also supported in part by the "tests" applied by Subsection 6 (5) of the Canadian Trademarks Act ("a" to "e" above).

2. Legitimate Interest

A sufficient and initial proof brought on by the Complainant and pertaining to the Registrant's lack of legitimate interest forces the Registrant to rebut, explain or otherwise plead this issue, for which the Registrant has not done so. Failing to do so permits the Arbitrator to make a negative inference.

As described above, the Complainant must provide "some evidence" that the Registrant has no legitimate interest in the domain name(s), as described in Policy paragraph 4.1(c). If the Complainant satisfies this evidentiary burden, the onus shifts to the Registrant to prove on a balance of probabilities that the Registrant has a legitimate interest in the challenged domain name, for which the Registrant has not done so.

Policy paragraph 3.4 sets forth an exhaustive list of criteria for determining whether a registrant has a legitimate interest in a domain name. It provides as follows:

The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a complaint was submitted.

- (a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant has Rights in the Mark;*
- (b) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of: (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;*
- (c) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;*
- (d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review of news reporting;*
- (e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or*
- (f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.*

In paragraphs 3.4 (b), (c), and (d) "use" by the Registrant includes, but is not limited to, use to identify a web site.

The legitimate interest criteria set forth in Policy paragraphs 3.4 (a), (b), (c), and (d) are satisfied only if the Registrant's use was in "good faith", a term which is not defined by the Policy. This Arbitrator notes that "good faith" as used in Policy paragraph 3.4 is not necessarily the opposite of "Bad Faith" as defined in Policy paragraph 3.5.

This Arbitrator has reviewed submissions by the Complainant and absent any submissions to not only debate the Complainant's positions, but to provide any historical proof of commercial activities, and fully eliminate confusion between the Registrant and the Complainant, leaves for invalidated support for the Complainant. Furthermore, the history covered by the Complainant's submissions themselves (registration, and market notoriety et al), speaks clearly about the Complainant's right to their legitimate interest.

The domain name in dispute was registered by the Registrant without any prior or existing written contract, or other form of trade-mark use or licence with the Complainant, who has thus far demonstrated historical and prior Trademark Registration and legitimacy.

There is no known commercial or business relationship of any sort between the parties, permitting the use etc. of any of the Complainant's trade-marks or domain name by the Registrant, which could give rise to any confusion. Absent any rebuttal, this, unto itself demonstrates a clear, historical lack of interest in the disputed domain name by the Registrant.

The Registrant has not provided any justification whatsoever to justify its claim to a legitimate interest in the disputed domain name. The Domain Name is identical to a Mark in which the Complainant has rights, and for which the Registrant has demonstrated no legitimate interest.

3. Registration in Bad Faith

The following facts lead this Arbitrator to conclude that the disputed domain name was registered in bad faith:

- 1) The Registrant has, (after historical name branding by the Complainant) registered (or acquired) a confusingly similar name.
- 2) The registration of the disputed domain name infringes directly with the Complainant's trade-mark, and services. The disputed domain name is also embedded as a component of the Complainant's trade-mark.
- 3) The disputed name could have a confusingly and negative public image impact/confusion about affiliation or sponsorship with the complainant, not to mention the diversion of commercial activity away from the Complainant - refer to *Bell Canada v. Archer Enterprises*, BCICAC Case No. 00038, and *Yamaha Corporation and Yamaha Motor Canada Inc. v. Jim Yoon*, BCICAC Case No. 00089.
- 4) The Registrant did not respond to BCICAC's timeline opportunity to submit a response to provide answers, rebuttals, support or evidence for the registration/acquisition of the disputed domain name.
- 5) Where the Registrant would seemingly have some justification for the registrations, the Registrant has to put forward some form of evidence to support their conduct, but has not done so. See *Musician's Friend Inc. v. Lowcost Domains Inc.*, CIRA Dispute No. 00074, citing in turn *Canadian Broadcasting Corporation/Société Radio-Canada*.

All of the foregoing is irreconcilable, and sustains the conclusion that there appears to be no compelling need (or right) for the Registrant to register and keep the disputed domain name – let alone divert any of Complainant's potential web traffic away to any other competing or confusing site. Had there been a sound business and legal reason to do so, supported by a

business and contractual arrangement with the Complainant, it might be logical for the Registrant to counter-argue all of this. This does not in any way suggest that any counter-argument would be successful. Websites (not to mention trade-names) are to be seemingly purchased/registered, designed and maintained for some legitimate purpose, and certainly no sound reasons have been advanced by the Registrant to support their acquisition of the Disputed Domain Name. At the very least, any use made valid by any arguments that might be raised by the Registrant would (or might have been) less confusing at the outset, if they were to register a name which would not be confusing and infringing on the Complainant's Trade-mark. Very importantly, the potential for future redirection/resolving of traffic from one web site ("TiVo.ca") to other sites competitive with TIVO can only create a clear impression of causing confusion, disruption and hijacking of the Complainant's business. See *Intesa Sanpaolo S.p.A. v. Interex Corporate Registration Services Inc.*, CIRA Case No. 01130 (2013).

Balance of Probabilities

Even if a complainant has met the burdens of proof contained in Paragraph 4.1, a complaint will be dismissed if the registrant is able to prove on a balance of probabilities that the registrant has a legitimate interest in the disputed domain name. Again, such "legitimate interest" must meet one or more of the six tests as set out in Paragraph 3.4 and referred to above.

This balance of probabilities test in Paragraph 4.1 of the Policy deals with the situation where even though a Complainant has satisfied all of the burdens of proof contained in Paragraph 4.1, an Arbitrator believes that justice requires the Registrant to succeed. In finding against a Registrant, the Arbitrator is depriving that Registrant of a property interest. Such a decision should not be, and is not taken lightly. Therefore, even if an Arbitrator finds that a Complainant has satisfied the rather heavy burdens of proof placed on it by Paragraph 4.1, if the Arbitrator is satisfied that on a balance of probabilities the Registrant has a legitimate interest in the disputed Domain Name, the Arbitrator must find for the Registrant and dismiss the complaint. The Registrant has manifestly provided no argument of any sort, to either refute the allegations made by the Complainant or at the very least, support the registration (and any rights) in the disputed Domain Name.

In the case at hand, this Arbitrator is satisfied that on a balance of probabilities, and based upon the evidence before him, and rules, that the Registrant has no legitimate interest in the disputed Domain Name ("TiVo.ca")

Decision and Order

I find that the Complainant has succeeded in this proceeding, as initiated under the Policy. I therefore direct that the registration of ("TiVo.ca") be transferred to the Complainant: TiVo Brands LLC.

Dated this 23rd day of December, 2019



Claude Freeman, LL.M. (ADR), C.Med., C.Arb.