

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number: DCA 681-CIRA
Domain Name: www.radiocanada.ca
Complainant: Canadian Broadcasting Corporation/Société Radio-Canada
Registrant: William Quon
Registrar: Canadian Domain Name Services Inc.
Panellists: David Wotherspoon, Jacques A. Léger, Q.C., and Harold Margles
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

1. The Parties

Complainant is the Canadian Broadcasting Corporation/Société Radio-Canada [hereinafter the *CBC/Radio-Canada*], a corporation organised under the laws of Canada, having a principal place of business at 1400 Boulevard René-Lévesque Est, Montreal, Quebec, H2L 2M2.

Registrant is William Quon, an individual with a listed mailing address of 55 University Avenue, Suite 1704, Toronto, Ontario, M5J 2H7.

2. The Domain Name and Registrar

The Domain Name at issue [hereinafter the *Domain Name*] is:

“www.radiocanada.ca”

The Registrar of the Domain Name is Canadian Domain Name Services Inc. with an address at 27-1300 King St. E. Suite 135, Oshawa, Ontario, L1H 8J4.

3. Procedural History

On February 6, 2003, **Complainant** filed a Complaint [hereinafter the *Complaint*] with respect to the Domain Name with the British Columbia International Commercial

Arbitration Centre [hereinafter the *Centre*]. The Complaint was reviewed by the Centre and found to be in administrative compliance with the requirements under Rule 42 of the CIRA Domain Name Dispute Resolution Rules [hereinafter referred to as the *CIRA Rules*]. By letter and E-Mail dated February 7, 2003, the Centre so advised the parties and forwarded a copy of the Complaint to the **Registrant**¹. The Centre also informed the parties of the commencement of the proceeding as of February 10, 2003 and of the **Registrant**'s 20-day delay to respond to the Complaint.

The **Registrant** requested an extension for delivery of its Response to March 7, 2003, and the extension was granted by the Center as permitted under Rule 5.4. A second request for extension was however denied by the Administrator noting that the panel may, at its discretion, solicit further submissions under Paragraph 11.1 of the CIRA Rules. The **Registrant** delivered its Response, in compliance with the CIRA Domain Name Dispute Resolution Policy [hereinafter referred to as the *CIRA Policy*] and the CIRA Rules, to the Centre on March 7, 2003².

The Center reviewed the **Registrant**'s Response and delivered same to the **Complainant** on March 10, 2003.

On March 17, 2003, the **Complainant** delivered, within the time period permitted under Rule 11.1, a Response to the **Registrant**'s claim for costs [hereinafter referred to as the *Reply*].

The Panel has reviewed the documentary evidence provided by the parties and agrees with the Centre's assessment that the Complaint complies with the formal requirements of the CIRA Policy and Rules.

The Panel believes it was constituted in compliance with the CIRA Rules. Each of the panellists has completed an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.

The Panel has received no further submissions from either party since its formation.

The Panel is obliged to issue a decision on or prior to April 15, 2003 in the English language and is unaware of any other proceedings which may have been undertaken by the parties or others in the present matter.

¹ Delivery of hard-copy of the Complaint to the Registrant failed due to an out of date mailing address, however, E-Mail delivery of the Complaint to the Registrant was confirmed by telephone call to the BCICAC on February 10, 2003. At that time a current address for delivery for the Registrant was requested to allow for delivery of the hard-copy of the Complaint and appendices. On February 14, 2003, the Registrant provided an address for delivery c/o Mr. Harold Saffrey at the same address subsequently declared by the Registrant in it's Response. Delivery of the hard-copy of the Complaint was confirmed on February 17, 2003.

² The Registrant has re-iterated in Paragraph 39 of its Response its request for permission to make further submissions beyond the time-period provided.

4. Factual Background

The **Complainant** in this administrative proceeding, CBC/Radio-Canada, is recognised as Canada's public broadcaster and has become one of Canada's largest cultural institutions, providing Canadians from coast to coast with a national resource of, amongst others, distinctively Canadian radio and television programming. The **Complainant** distributes radio and television programs via satellite, microwave and landline to 103 **Complainant**-owned stations, 1,164 **Complainant** rebroadcasters, 26 private affiliates and 282 affiliated or community rebroadcasters, and has also established a significant Internet presence through the use of its well-known websites such as CBC.CA and RADIO-CANADA.CA.

Created in 1936 by Act of Parliament, **Complainant** operates under the *Broadcasting Act*, R.S.C. 1985, c. B-9.01 and has used and continues to use Radio-Canada as a trademark in Canada and as part of its corporate name, CBC/Radio-Canada, and trade names, Société Radio-Canada and Radio-Canada.

The evidence also shows that the **Complainant** is owner of the Official Mark, Radio Canada International, Serial No. 910, 359, advertised on January 27, 1999 pursuant to subparagraph 9(1)(n)(iii) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. Radio Canada International is an international shortwave radio service whose broadcasts can be heard around the world in many different languages.

The **Complainant**'s portfolio includes or has included numerous critically-acclaimed and award-winning television programs that cover a wide range of categories including drama, comedy, sports, documentaries, news, and music³. Its extensive sports programming includes the Hockey Night in Canada/La Soirée du Hockey, the Grey Cup Championship Game, and the Olympic Games, while its news coverage, which offers 24-hour-a-day news and information programming through its two television networks, the CBC Newsworld and the Réseau de l'information, makes it Canada's largest news organisation with 800 professionals posted worldwide. In addition to television programming, the **Complainant** offers, through CBC Radio One, CBC Radio Two, La Première Chaîne and La Chaîne Culturelle, four commercial-free radio networks broadcasted across Canada in both English and French.

As previously-mentioned above, the **Complainant** has also established a significant presence on the Internet with its websites, CBC.CA and RADIO-CANADA.CA, being ranked as the number one news and information content websites among English and French Canadians, respectively. The **Complainant** also operates a website in association

³ For example The National, The Nature of Things, Royal Canadian Air Farce, La Fureur, and Enjeux.

with its Radio-Canada International radio service which is located at RCINET.CA and a number of youth-oriented radio-related websites⁴.

The **Registrant** is an independent technology consultant providing services to the financial, media and entertainment sectors including the creation of white papers (guides for the design and implementation of technological infrastructure) and assisting in the design, implementation and support of network infrastructures.

As shown by the evidence, the **Registrant** registered the Domain Name on November 8, 2000. The evidence reveals that the Domain Name has been and continues to be associated with a modest website, comprised of a single page, indicating that the site is “Under Construction”, inviting browsers to “Visit again soon” or “Please visit us again”, and providing an E-Mail address⁵ for contact.

There has never been any relationship between the **Complainant** and the **Registrant**, and the **Registrant** has never been licensed or otherwise authorised to use the Radio-Canada marks, in Canada or otherwise, in any manner, including in or as part of a domain name.

5. Parties’ Contentions

A. Complainant

The **Complainant** contends at paragraph 7 of the Complaint that, by virtue of continuous use since at least as early as 1936 in Canada, it is the owner of the RADIO-CANADA trade-mark. It also contends at paragraphs 10 and 11 of the Complaint that the RADIO-CANADA trade-mark, the RADIO CANADA INTERNATIONAL official mark and the RADIO CANADA INTERNATIONAL trade-mark [hereinafter collectively, the *Radio-Canada Marks*] have achieved vast and unparalleled public recognition and awareness in Canada and around the world and have been prominently and extensively featured in radio, television and on the Internet in Canada. According to the **Complainant**, the RADIO-CANADA Marks appear, without limitation, in the opening and closing credits of its television programs, are announced during the **Complainant**’s radio programs, and are prominently displayed on the **Complainant**’s websites.

The **Complainant** alleges in its Complaint that it attempted on several occasions to contact the **Registrant** by telephone, registered mail and E-Mail to address its concern over the Domain Name registration, but that the **Registrant** did not return or answer any of the **Complainant**’s telephone calls or correspondence.

⁴ See 120seconds.com, justconcerts.com, newmusiccanada.com, bandeapart.fm, and bandeapart.tv.

⁵ E-Mail address provided on November 11, 2002, November 12, 2002 and on April 1, 2003 is dotcaweb@hotmail.com.

More specifically, at paragraph 33 of the Complaint, the **Complainant** alleges that it was made aware of the Domain Name shortly following registration and that at the time the Domain Name did not resolve to an active website. According to the **Complainant**, it then attempted, through an agent to contact the **Registrant** on several occasions by telephone but that none of the telephone calls were returned by the **Registrant**.

The **Complainant** then explains at paragraph 34 that its agent contacted the **Registrant** via E-Mail at the wquon@wise-net.com address on January 16, 2002 indicating that it had unsuccessfully attempted to contact the **Registrant** by telephone to address its concern regarding the Domain Name registration and proposing an amicable solution, i.e. offering to provide the **Registrant** with another domain name at no cost in exchange for the transfer of RADIOCANADA.CA. Once again, the **Registrant** did not respond.

At paragraph 35 of the Complaint, the **Complainant** further explains that it directly informed the **Registrant** on April 30, 2001, via registered mail⁶ on CBC/Radio-Canada letterhead and E-Mail at wquon@wise-net.com, of its rights in the Radio-Canada Marks and requested that the Domain Name be transferred to it. According to the **Complainant**, this correspondence was also left unanswered by the **Registrant**.

At paragraph 36, the **Complainant** then explains that it renewed its request to transfer the Domain Name on March 22, 2002 by way of messenger mail⁷ and E-Mail correspondence at noc@wiseferve.com⁸. As with the telephone calls and E-Mails, the **Complainant** contends that its concerns went unanswered.

The **Complainant** notes in paragraph 37 that the Domain Name became associated with a modest website shortly following issuance of its March 22, 2002 demand correspondence. In paragraph 38, it further explains that another demand letter was sent to the **Registrant** by registered mail and E-Mail at noc@wiseferve.com⁹ and wquon@wnti.com¹⁰ on November 5, 2002 by **Complainant**'s outside counsel. This letter was also sent, according to the **Complainant** at paragraph 39, to the E-Mail indicated on the **Registrant**'s website located at RADIOCANADA.CA, namely to dotcaweb@hotmail.com. The **Complainant** indicates in the same paragraph that "[o]nce again, the **Registrant** failed to respond".

At paragraph 40 of the Complaint, the **Complainant** advances that it visited the **Registrant**'s website one day following the issuance of the November 5, 2002 demand

⁶ The letter indicates that it was sent at the following address : 111 Granton Drive, Richmond Hill, Ontario, L4B 1L5.

⁷ The letter indicates that it was sent by messenger to the following address : 8 King Street East, Suite 1500, Toronto, Ontario, M5C 1B5.

⁸ This E-Mail address and the address specified in footnote 6 are currently listed in the WHOIS entry for the Domain Name.

⁹ The Complainant contends that this E-Mail address was the administrative contact E-Mail for the Domain Name at the time.

¹⁰ The Complainant contends that this E-Mail address was the administrative contact E-Mail associated with WISESERVE.COM which appeared to be a domain name owned by the Registrant at the time.

correspondence, i.e. on November 12, 2002, and discovered that the website had once again been altered. Further, the **Complainant** notes that the **Registrant** had adopted the “Canada Canadian Radio” and “Canadian Radio” metatags. The **Complainant** submits that no metatags were included in the underlying source code of the **Registrant’s** previous website.

The **Complainant** asserts in paragraphs 44, 45, and 48 its continued rights in the RADIO-CANADA Marks and the fact that the CIRA Policy not only contemplates protection for registered trade-marks, but also for unregistered trade-marks. According to the **Complainant** at paragraph 44, the RADIO-CANADA trade-mark has become an extremely strong mark and remarkably well-known throughout Canada and should therefore, be entitled to wide ambit of protection.

At paragraph 55 of the Complaint, the **Complainant** submits that the Domain Name is confusingly similar to the RADIO-CANADA trade-mark given that 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 **Complainant** also submits at paragraph 57, that the Domain Name is confusingly similar to the RADIO CANADA INTERNATIONAL official mark and RADIO CANADA INTERNATIONAL trade-mark given that the Domain Name so nearly resembles the marks in appearance, sound or the ideas suggested by the marks as to be likely to be mistaken for the marks, particularly given that it incorporates the distinguishing elements of the subject marks, namely “Radio Canada”.

The **Complainant** further advances in paragraph 74 that the **Registrant** acquired the Domain Name with the intention of selling it to the **Complainant** for valuable consideration. In support of this contention, the **Complainant** notes the following factors:

- (i) The **Registrant** had actual or constructive knowledge of the Radio-Canada Marks at the time of the Domain Name registration;
- (ii) Save for *de minimis* postings, the Domain Name has remained inactive for over two years;
- (iii) The **Registrant** failed to respond to the **Complainant’s** three transfer requests, as well as to the **Complainant’s** initial E-Mail and telephone inquiries;
- (iv) The **Registrant** altered its website following issuance of the **Complainant’s** second demand correspondence and once again made modest changes to its website following issuance of the **Complainant’s** final demand correspondence; and

- (v) The **Registrant** posted an E-Mail address on its RADIOCANADA.CA website, which suggests that end users may inquire as to the availability of the subject domain name.

The **Complainant** also asserts that the **Registrant** has engaged in a pattern of registering domain names incorporating third party trade-marks and has prevented the **Complainant** from registering the RADIO-CANADA Marks as a domain name. To support this allegation, the **Complainant** contends that the **Registrant** is owner of multiple unrelated domain name registrations that are comprised of third party trade-marks to which the **Registrant** has no entitlement, namely RADIOCANADA.CA, SMARTWEB.CA, ONEKINGWEST.CA, and ETOBICOKE.CA.

Additionally, the **Complainant** alleges that the **Registrant** does not have a legitimate interest in the Domain Name. In support of this contention, the **Complainant** notes the following factors:

- (i) As mentioned above, there has never been any relationship between the **Complainant** and the **Registrant** and the **Registrant** has never been licensed or otherwise authorised to use the Radio-Canada Marks in any manner, in Canada or otherwise, including in or as part of a domain name;
- (ii) The Domain Name incorporates the whole of the **Complainant's** Radio-Canada Trade-mark;
- (iii) By virtue of its RADIO CANADA INTERNATIONAL official mark registration, the **Registrant** may well be prohibited from adopting the **Complainant's** mark as a domain name in association with any business, and accordingly, likely may not be said to have rights in the Domain Name in this regard; and
- (iv) The adoption of *de minimis* postings and metatags represents a feigned attempt to legitimise the Domain Name registration.

Finally, with respect to the **Registrant's** claim for costs, the **Complainant** submits that the **Registrant** is not entitled to costs given that the Complaint was brought in good faith and does not constitute an abuse of the administrative process, given that the **Registrant** registered the Domain Name in bad faith. The **Complainant** also notes that it has difficulty with the claim for costs for work performed by legal counsel due to the fact that there is no legal counsel on the record and that there is no evidence that legal counsel has acted on behalf of the **Registrant**.

B. Registrant

The **Registrant** contends that he has a legitimate interest in the Domain Name and has registered the Domain Name in good faith. More specifically, the **Registrant** is of the opinion that he satisfies the CIRA Policy conditions in that he:

- (i) has used the Domain Name in Canada in good faith in association with services and that said Domain Name was clearly descriptive in Canada in the English language of the character and quality of the services and business with which it was associated; and
- (ii) has used the Domain Name in Canada in good faith in association with its services and business and the Domain Name was understood in Canada to be the generic name in English for such business or services with which it was associated.

At paragraph 3 of the Response, the **Registrant** alleges that he registered the Domain Name in respect of work he was doing and continues to do in the media sector, namely radio, for a company known as the Standard Broadcasting Corporation Limited. More specifically, the **Registrant** explains that he was designing network solutions and implementations for his client's radio stations (approximately 60), all of which are English-language stations located west of the province of Quebec.

According to paragraph 5 of the Response, the **Registrant** chose the Domain Name for possible use because it was clearly descriptive of the character and quality of his client's services and because he thought that the Domain Name was an extremely generic and common description of the services in association with which it might be used¹¹.

The **Registrant** alleges in the next paragraphs that he "was not aware at the time of registration or at anytime thereafter, of the **Complainant**'s ownership of any trade mark rights for the word RADIOCANADA or its phonetic equivalent and only knew of the **Complainant**'s radio station as being called the CBC or its longer name the Canadian Broadcasting Corporation" and that he "is unilingual English-speaking and was not and is not familiar the (*sic*) French services provided by the CBC".

The **Registrant** further submits that he has been using the impugned Domain Name for "private E-Mails and private webpage development in private sub-directories from the parent web level web page, which is unavailable to the public. It is not inactive as claimed by the **Complainant**".

With respect to the **Complainant**'s Radio-Canada Marks and the question of confusion, the **Registrant** submits that there is no confusion between the words RADIOCANADA

¹¹ In support of this allegation, the Registrant provided the results of a Google word search for "radiocanada". According to the Registrant, "the search produced listings that include other descriptive uses of the word "radiocanada" by others describing radio use in Canada."

and the **Complainant**'s marks and that by looking at the marks as a whole, the marks of the **Complainant** and the Domain Name are different and not confusingly similar.

In support of this position, the **Registrant** notes in paragraph 11 that "in respect of the market for which his client is concerned, there has been no use shown, nor is there any use, in respect of the word RADIOCANADA, or its phonetic equivalents, that could be associated with the CBC in respect of its English radio services west of the province of Quebec, or even English radio services anywhere else for that matter".

In paragraphs 12 and 13 of the Response, the **Registrant** further notes that there is no trade-mark registration for RADIOCANADA nor RADIO-CANADA owned by the **Complainant** and that there has never been use of the single word RADIOCANADA without a hyphen by the **Complainant**.

The **Registrant** also alleges in paragraph 19 of the Response that "the use of the words RADIO-CANADA [by the **Complainant**] is restricted to its Francophone radio services, an area of the radio market in association with which the **Registrant** never had any intention of using the word RADIOCANADA in association with.

The **Registrant** further contends in paragraph 22 that "there is no possibility of confusion between RADIOCANADA.CA and the **Registrant**'s use of the words RADIO-CANADA considering all surrounding circumstances including the different markets being separated by languages, the spelling of the words "RADIO-CANADA" being [...] so well known".

In paragraph 23, the **Registrant** admits that "he was visited on three separate occasions by different individuals, each refusing to identify himself and each requesting that he transfer the domain name RADIOCANADA.CA over to the individual's organization" but submits that "[i]n none of those three cases, did any individual identify himself as being with the CBC, although one of individuals, and only one of the individuals, did say that he was a developer of the website for the CBC".

In paragraph 25, the **Registrant** denies ever receiving any of the letters or E-Mails allegedly sent to him by the **Complainant**.

However, the **Registrant** admits in paragraph 26 that he received E-Mail solicitations at various times in which the transfer of the domain name RADIOCANADA.CA was requested.

According to the **Registrant**, the solicitations were not considered and were promptly erased due to (i) the fact that the solicitations appeared to come from individuals of questionable standing and did not mention any recognisable company name and (ii) he had registered the Domain Name for his own legitimate purposes and was not, and is not, interested in the transfer or sale of the Domain Name.

In paragraph 27, the **Registrant** states that “there has been no valid request made by the **Complainant** for the transfer of the domain name ever received by [him and he] has never indicated that he intends to sell the domain name RADIOCANADA.CA nor does he have any intention of doing so”.

In respect of the **Complainant**'s contention that the **Registrant** has engaged in a pattern of registering domain names incorporating third party trade-marks to which the **Registrant** has no entitlement, namely RADIOCANADA.CA, SMARTWEB.CA, ONEKINGWEST.CA, and ETOBICOKE.CA, the **Registrant** alleges the following:

- in respect of the ONEKINGWEST.CA registration, he owns an interest in that property by virtue of having purchased two condominium units at that address;
- in respect of the ETOBICOKE.CA registration, he owns property in that location;
- in respect of SMARTWEB.CA, he registered the domain name on November 8, 2000 (not the date alleged by the **Complainant** in the Complaint) before Bell Canada started to use the SMARTWEB trade-mark

In sum, the **Registrant** contends that the three above websites were all registered by the **Registrant** in good faith with legitimate interests and are being used for private E-Mail correspondence and private webpage development unavailable to the public.

6. Discussion and Findings

Paragraph 4.1 of the CIRA Policy sets forth the **Complainant**'s burden of proof in order to succeed in the proceeding. The onus is on the **Complainant** to prove, on a 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 3.7;

A **Complainant** must also provide some evidence that:

- (c) the **Registrant** has no legitimate interest in the domain name as described in paragraph 3.6.

Paragraph 4.1 of the CIRA Policy further provides that even if a **Complainant** proves (a) and (b) and 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 3.6. In other words, once the Complainant has met its evidentiary burden under sub-paragraphs 4.1 (a) and (b), either by positive or negative evidence, the onus is shifted to the Registrant who must then prove, on a balance of probabilities, that he is making legitimate use of the domain name.

The three elements found in paragraph 4.1 must be proven cumulatively by the Complainant albeit with a different burden of proof imposed in sub-paragraph 4.1 (c) (legitimate interest).

These three elements are considered below.

Confusing Similarity

The Panel has reviewed the documentary evidence provided by the **Complainant** regarding its rights in the trademarks RADIO-CANADA and RADIO CANADA INTERNATIONAL and in the Official Mark RADIO CANADA INTERNATIONAL and finds that the **Complainant** has satisfactorily shown that it owned such rights prior to the date of registration of the domain name and that it continues to own such rights.

The **Registrant** noted in its Response that RADIO-CANADA was not a registered trade-mark. The Panel agrees with the **Complainant** that the CIRA Policy not only contemplates protection for registered trade-marks, but also for unregistered trade-marks. More specifically, the wording of sub-paragraph 3.2 (a) is broad enough to capture unregistered trade-marks, particularly in view of the fact that sub-paragraph 3.2 (c) expressly contemplates the protection of registered trade-marks apart from the protection of trade-marks generally, as provided for in sub-paragraph 3.2 (a).

Paragraph 3.4 of the CIRA Policy provides a definition of the term Confusingly Similar. It requires a finding that the Mark at issue is likely to be mistaken for the domain name at issue because of the resemblance in “appearance, sound or the ideas suggested by the Mark”. As such, the test is not one of confusion, as is normally found in Canadian trade-mark jurisprudence, but of resemblance.

In this case, the only difference between the RADIOCANADA.CA Domain Name and the RADIO-CANADA trade-mark is the absence of a hyphen in the Domain Name. It has been held under the similar Uniform Domain Name Dispute Resolution (“UDRP”) Policy that the absence of punctuation marks, such as hyphens, does not alter the fact that a domain name is identical to a mark (*La Société des Loteries du Québec v. RSA Software Inc.*, WIPO, Case No. D2002-0051; *Chernow Communications, Inc. v. Jonathan D. Kimball*, WIPO, Case No. D2000-0119). The Panel adopts the reasoning set-forth in those decisions and concludes that the second-level part of the Domain Name,

"RADIOCANADA", is phonetically identical to the **Complainant's** trademark RADIO-CANADA. An Internet user who has knowledge or recollection of the name RADIO-CANADA, might easily mistake the **Registrant's** web site, associated with the Domain Name, as being somehow affiliated to or owned by the **Complainant**. The Panel is of the opinion that this fact alone is sufficient to conclude that the Domain Name is confusingly similar to **Complainant's** RADIO-CANADA trade-mark¹².

The Panel is therefore of the opinion that the **Complainant** has met the burden of proof as established by sub-paragraph 4.1 (a) of the CIRA Policy.

Bad Faith

Pursuant to sub-paragraph 4.1 (b) of the CIRA Policy it is first incumbent upon the **Complainant** to prove, on the balance of probabilities, that the **Registrant** has registered the Domain Name in bad faith. Paragraph 3.7 of the CIRA Policy states that a **Registrant** will be considered to have registered the domain name in bad faith if, and only if the **Registrant** registered the domain for one of the purposes identified in sub-paragraphs 3.7 (a), (b) or (c) that state:

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:

- (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; or
- (c) the **Registrant** registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the

¹² In view of the fact that the Domain Name is found to be confusingly similar to the RADIO-CANADA Trade-mark, it is unnecessary for the panel to consider the issue of confusing similarity between the Domain Name and the RADIO CANADA INTERNATIONAL official mark and trade-mark. It should be noted that ss. 9(1) of the *Trade-marks Act* provides that: "No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for...".

Complainant, or the **Complainant's** licensor or licensee of the Mark, who is a competitor of the **Registrant**.

The **Complainant** relies on sub-paragraphs 3.7 (a) and (b) to assert that the **Registrant** has registered the Domain Name in bad faith. More specifically, with respect to sub-paragraph 3.7 (b), the **Complainant** relies on UDRP case law to assert that examination must be had to the surrounding circumstances to determine whether or not a **Registrant** has engaged in a pattern of registering comprised of third party mark.

The Panel recognises that the bad faith provisions in the CIRA Policy are somewhat different than those found in the UDRP Policy. More specifically, the UDRP Policy provides a non-exhaustive list of situations in which a finding of bad faith can be made, "without limitation" on the panel's ability to consider facts on a case-by-case basis. The CIRA policy is quite different. It provides for an exhaustive list, and limits the panel to making a finding of bad faith "if, and only if", the factors on the list are established. (The same is true of 3.6 dealing with legitimate interests.) It would therefore be improper for a CIRA Panel to make a finding of bad faith based on facts not covered by paragraph 3.7.

Notwithstanding the restriction on the Panel's ability to consider other factors created by the words "if, and only if", this does not change the burden on a Complainant when proving bad faith. A Complainant must prove one of the three factors on a balance of probabilities.

However, it is quite difficult, usually, if not impossible, to actually show bad faith with concrete evidence. The Panel is therefore of the opinion that it can take into consideration surrounding circumstances and draw inferences to determine whether or not the **Registrant's** actions are captured by paragraph 3.7. For example, the Panel may consider surrounding circumstances to decide whether or not the **Registrant** has registered the Domain Name primarily for the purpose of selling it to the **Complainant** or a competitor. To require the **Complainant** to provide direct evidence of the **Registrant's** bad faith intentions would allow a **Registrant** with a certain level of skill to easily evade the application of the CIRA Policy, hence rendering its application moot or irrelevant. This reasoning is consistent with the recent CIRA decision *Biogen, Inc. v. Xcalibur Communication*, CIRA, Dispute Number 00003, wherein the Panel considered the surrounding circumstances of the case to conclude bad faith.

Therefore, once the **Complainant** has presented sufficient evidence to establish one of the situations in 3.7, it is incumbent upon the Respondent to either respond or explain why its conduct should not be considered bad faith. The Panel's understanding of the Policy is that although the initial burden to prove (on a balance of probabilities) the Respondent's bad faith in the registration of the disputed Domain Name lies squarely on the shoulders of the **Complainant**, such obligation does not need to be more than to make

out a *prima facie* case, akin a number of decisions rendered under the ICANN Policy¹³, and once it has done so, the Panel may find in certain circumstances, that there is a shift of onus and it is then incumbent upon the Respondent to either justify or explain its conduct, if not to demonstrate the contrary.

In the present case, in light of the particular circumstances of the case and of the evidence submitted by the **Complainant**, the Panel concludes that the **Registrant** has, as defined in sub-paragraph 3.7 (b), registered the Domain Name in order to prevent the **Complainant** from registering the **Complainant**'s Mark as a domain name and that the **Registrant** has engaged in a pattern of registering domain names that incorporate third-party marks.

A finding under sub-paragraph 3.7 (b) requires evidence 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. In this case, the Panel believes that the **Complainant** has satisfied its burden of proving, on a balance of probabilities, that the **Registrant** has engaged in such a pattern. With respect to the pattern issue, as indicated above, it was thus incumbent upon the **Registrant** not only to superficially explain why its conduct should not be ascribed to the alleged situation but to somehow rebut the evidence presented by the **Complainant**. The Panel is of the view that the **Registrant** has failed to do so. In fact the Registrant's explanations as to why certain domain names were registered are unpersuasive and untenable.

More specifically, the following factors allow the Panel to conclude that the Registrant has engaged in a pattern of registering domain names that incorporate third-party marks and that the Domain Name was registered in bad faith:

- (i) The registration by the **Registrant** of the following domain name registrations: RADIOCANADA.CA, ETOBICOKE.CA, and ONEKINGWEST.CA in which the **Registrant** has no legitimate interest;
- (ii) The fact that these domain names are unrelated (*Countess Mara Inc. v. Choi Kwangho*, WIPO, Case No. D2001-0089);
- (iii) The fact that none of these domain names is associated with an active website;
- (iv) As few as two domain name registrations has been sufficient to establish that a **Registrant** has engaged in a pattern of registering domain names that incorporate marks of third parties (see *New York Life Insurance Company v. Arunesh C. Puthiyoth*, WIPO,

¹³ See for example : *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO, Case No. D2000-0270); *Volvo Trademark Holding AB v. Cup International Limited*, WIPO, Case No. D2000-0338; *Voicestream Wireless Corporation v. Phayze 1 Phayze 2; Phayze Inc.*, WIPO, Case No. D2002-0636.

Case No. D2000-0812; *Volvo Trademark Holding AB v. Cup International Limited, supra*);

- (v) In view of the **Complainant's** extensive reputation and all-pervasive operations in Canada, the fact that the **Complainant** was created by an act of Parliament, and the fact that the Complainant's corporate name (CBC/Radio-Canada) is frequently cited in both French and English throughout Canada makes is highly unlikely that the **Registrant** was not aware of the **Complainant's** rights in the Domain Name;
- (vi) The registration of the impugned Domain Name is preventing the **Complainant** from registering its marks as a dot-ca domain name;

The Registrant has attempted to explain why the above domain names were registered. For example, the Registrant alleges in the case of the ONEKINGWEST.CA domain name that he owns two apartments at that address. This argument is not convincing. The fact that someone owns condominiums in a corporation whose name is that address does not give that person the right to register a domain name that incorporates someone else's trade-mark. With respect to the ETOBICOKE.CA domain name, the Registrant has attempted to show that he owns property in that location by providing a copy of a hydro electric bill with an Etobicoke address. For the obvious reasons, this argument must also fail as a hydro bill is not sufficient to prove that a person owns property in that municipality. More particularly, the evidence indicates that the Borough of Etobicoke is the owner of two official marks for ETOBICOKE with registrations that pre-date the Registrant's Domain Name registration such that the use by the Registrant of the Domain Name could potentially be seen to be an infringement of the said official mark registrations.

For the foregoing reasons, the Panel finds that the **Complainant** has met its burden of proof and and the Registrant has failed to adequately rebut the evidence presented by the Complainant. Accordingly, the Panel concludes that **Registrant's** registration has been made in bad faith pursuant to sub-paragraph 3.7 (b) of the CIRA policy.

No Legitimate Interest

As indicated above, sub-paragraph 4.1 (c) of the CIRA Policy also requires the **Complainant** to provide some evidence that the **Registrant** has no legitimate interest in the domain name as described in paragraph 3.6 which states that the **Registrant** has a legitimate interest in a domain name if, and only if, the **Registrant** satisfies one of the six listed classes of recognised legitimate interests. In particular, sub-paragraph 3.6 (b) holds that a **Registrant** has a legitimate interest if 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 [...] of (i) the character or quality of the wares, services or business.

The Panel is of the opinion that the **Complainant** has satisfied its burden under subparagraph 4.1 (c) when it provided some evidence that the Domain Name was not associated with any active website. It was thus incumbent on the **Registrant** to prove, on a balance of probabilities, that he had a legitimate interest in the Domain Name. The Panel is of the view that the **Registrant** has failed to persuasively demonstrate any of the situations in paragraph 3.6. More specifically, the **Registrant** has not shown good faith use of the Domain Name in association with any wares, services or business nor has he shown that the Domain Name is descriptive of his wares, services or business in any way or is understood in Canada to be the generic name thereof.

With respect to the question of “use”, the Panel is not persuaded and finds no evidentiary foundation for the **Registrant**’s assertion that he has been using the impugned Domain Name for private e-mails and private webpage development, which is unavailable to the public. The evidence submitted by the **Complainant** to the effect that the Domain Name has and is merely associated with a single-page website with an “under construction” message leads the Panel to conclude that the **Registrant** has not used the Domain Name in Canada.

The **Registrant** also contends in his Response that the Domain Name was registered in respect of work he was doing and continues to do in the media sector, namely radio, for a company carrying business and known as Standard Broadcasting Corporation Limited. However, the only evidence filed by the **Registrant** in support of this contention appears to be an Internet E-Mail message from a Mr. Gary Slaight addressed to “President’s Report” thanking some people for Standard Radio’s success. This document in no way proves that the **Registrant** was or is conducting work in the media sector for Standard Broadcasting Corporation Limited or that a contract for service exists between them. Furthermore, were we to lend any credibility to the fact that the Registrant is actively involved in the radio industry in Canada, this would contradict the Registrant’s pretension that he has never heard of Radio-Canada. In other words, it would be highly unlikely, if not inconceivable, for someone providing services to the radio industry to not have been exposed to the Radio Canada trade-marks. Although it is not necessary to decide the issue, on the evidence it appears that the **Registrant**’s exculpatory explanation would in itself result in a violation of the **Complainant**’s rights. This explanation could not, therefore, provide a basis for proving the **Registrant** had a legitimate interest in the name.

Furthermore, the Panel notes that the **Registrant**’s services or business, although alleged to be furnished to the media/radio sector, is limited to (as admitted by the **Registrant** in his Response) (i) the creation of white papers and (ii) assisting in the design, implementation and support of network infrastructures. In other words, it cannot be said that the Domain Name is clearly descriptive of the character or quality of the **Registrant**’s wares, services or business.

Finally, the Panel is of the opinion that the **Registrant** has not proved on a balance of probabilities that the expression “radiocanada” is generic in relation to any of the **Registrant**’s wares, services or business as explained above.

8. Decision

For the foregoing reasons, the Panel decides:

- that the Domain Name registered by the **Registrant** is confusingly similar to the trademarks in which the **Complainant** has rights;
- that the **Registrant** has no legitimate interests in respect of the Domain Name; and
- the Domain Name has been registered by the **Registrant** in bad faith.

Accordingly, pursuant to paragraph 4.3 of the CIRA Policy, the Panel orders that the registration of the Domain Name:

“RADIOCANADA.CA”

be transferred forthwith to the **Complainant** by the Registrar, Canadian Domain Name Services Inc.

The request for costs is therefore dismissed.

David Wotherspoon, Jacques A. Léger, Q.C., and Harold Margles

David Wotherspoon
Chair

Dated: April 8, 2003