

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

COMPLAINT

Dispute Number: DCA-880 CIRA
Domain Name: advair.ca
Complainant: GLAXO GROUP Ltd.
Registrant: Turvill Consultants - NARD
Registrar: Ten Dollar Domain Names Inc.
Panel: Michael D. Manson
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

A. THE PARTIES

1. The Complainant is GLAXO GROUP Ltd., Glaxo Wellcome House, Berkeley Avenue, Greenford, Middlesex, UB6 0NN, England, United Kingdom.
2. The Registrant is Turvill Consultants - NARD, 265 Port Union Road, North Suite, 15525 Scarborough, Ontario, M1C 2L3, Canada.

B. THE DOMAIN NAME AND REGISTRAR

3. The domain name at issue is advair.ca. The domain name is registered with Ten Dollar Domain Names Inc. of Toronto, Ontario.

C. PROCEDURAL HISTORY

4. The Complainant submitted this complaint to the British Columbia International Commercial Arbitration Centre as service provider in respect of the *CIRA Domain Name Dispute Resolution Policy* of the Canadian Internet Registration Authority (CIRA). The Service Provider served notice of the complaint to the Registrant as required by *CIRA Rules*, paragraph 4.3. No response to the complaint was received from the Registrant. The Complainant elected to have the complaint heard by a single panellist as permitted under paragraph 6.5 of the *CIRA Rules*. The Service Provider selected Michael Manson as the single panel member for this complaint.

D. PANEL MEMBER IMPARTIALITY AND INDEPENDENCE STATEMENT

5. As required by the *CIRA Rules*, paragraph 7.1, I, Michael Manson, have declared to the provider that I can act impartially and independently in respect of this matter as there are no circumstances known to me which would prevent me from so acting.

E. BASIS FOR DECIDING THE COMPLAINT

6. Since the Registrant has not submitted a response to the complaint, paragraph 5.8 of the *CIRA Domain Name Dispute Resolution Rules* applies, namely that the panel shall decide the proceeding on the basis of the complaint filed.

F. FACTUAL BACKGROUND

7. The BCICAC has certified that the complainant has complied with the formal requirements of the CDRP under the *Resolution Rules*.
8. The BCICAC has certified and I accept that it has complied with the provisions of the CDRP and the *Resolution Rules* in attempting to deliver the complaint to the Registrar and provided the documentation of delivery attempts by courier and e-mail to this effect. Pursuant to paragraph 2.6 of the *Resolution Rules*, the Registrant is deemed to have received the complaint and Respondent has failed to respond to the complaint.
9. The materials submitted by the Complainant shows that the Complainant satisfies CIRA's Canadian presence requirement for registrants, being the owner of Canadian Trade-mark Registration No. TMA561,494 for the trade-mark ADVAIR, for use in association with pharmaceutical preparations and substances for the prevention, treatment and/or alleviation of respiratory disorders. The Complainant is also the owner of other trade-mark registrations for ADVAIR in the United States, which for purposes of this proceeding are not relevant.
10. The evidence submitted also establishes, on the face of the trade-mark registration relied on by the Complainant, that the trade-mark has been used in Canada by the Complainant since as early as April 19, 2002 such that the Complainant has rights in the trade-mark. While submissions were made by the Complainant's agent that there was also evidence of use of the ADVIAR trade-mark since possibly as early as 1998, no evidence was led to this effect with respect to specific use in Canada and therefore was not considered to be of any weight in this case. Nevertheless, on the face of the Complainant's trade-mark registration, there has been use by the Complainant of the trade-mark ADVAIR in Canada for more than two years prior to the Registrant's registration of the domain name advair.ca.
11. The Registrant has registered a .ca domain name "advair.ca" (the "Domain Name"), which makes use of the Complainant's registered trade-mark ADVAIR, which is virtually identical to the Complainant's registered trade-mark and is thus essentially the same as the Complainant's mark.
12. The Complainant has submitted that, firstly, advair.ca is confusingly similar to ADVAIR, the Complainant's registered trade-mark in respect of which the Complainant had rights prior to the date of registration of the domain name and that the Complainant continues to have such rights. I find that the domain name is

confusingly similar to the Complainant's mark, as provided for under paragraph 3.4 of the *CIRA Domain Name Dispute Resolution Policy*.

13. The Complainant also alleges that the Registrant has no legitimate claim or interest in the domain name, as described in paragraph 3.6 of the *Policy*.
14. For the reasons submitted by the Complainant's agent in this regard, namely, that the Registrant has no rights in the trade-mark in Canada, the domain name resolves to the legaldrugsonline.com internet pharmacy, which offers competitors' products for sale, as well as the Complainant's products, and that none of the exceptions to a bad faith finding are present in this case, I find that there is no evidence that the Registrant has a legitimate interest in the domain name, as set out in paragraph 3.6 of the *Policy*, which would constitute a legitimate interest of the Registrant in the domain name.
15. I also believe that it is important to comment on the Complainant's agents' position that even if the Respondent was a retail seller of the Complainant's products, it has not been conferred any proprietary rights in the Complainant's marks, nor could it use the Complainant's mark as a domain name. I agree entirely with the Complainant's agents' position in this regard, and would add that not only are there consistent decisions of the WIPO Arbitration and Mediation Centre on point, but it is clear under Canadian law that a mere distributor or retailer of a manufacturer's products bearing the manufacturer's trade-mark acquires no rights to use such trade-mark unless authorised to do so by the manufacturer.

Lifegear, Inc. et al. v. Urus Industrial Corporation(2002), 23 C.P.R. (4th) 58 at 61 (F.C.T.D.).

Havana House Cigar & Tobacco Merchants Ltd. et al. v. Skyway Cigar Store (1998), 81 C.P.R. (3d) 203 at 218 to 222 (F.C.T.D.); aff'd in part (1999), 3 C.P.R. (4th) 501 (F.C.A.).

16. The Complainant has also established, on a balance of probabilities, that the Registrant has registered the domain name in bad faith. Not only has the Complainant led evidence of a pattern of bad faith registrations by the Registrant, but has also provided clear and convincing evidence that the Registrant has registered the domain name advair.ca primarily for the purpose of disrupting the business of the Complainant, by directing potential customers of the Complainant to a website that advertises and offers for sale competing products of competitors.

Subparagraph 3.7(b) of the Policy

Glaxo Group Ltd. v. Defining Presence Marketing Group Inc.
(Manitoba) BCICAC, Case No. 00020

Sleep Country Canada Inc. v. Pilford Ventures Inc., Resolution
Canada, Case No. 00027

17. Furthermore, I also find that any person encountering the domain name advair.ca would conclude that the Registrant's business, products and/or services was either a business of the Complainant or was at least endorsed, sponsored or approved by the Complainant. Accordingly, the Complainant's business reputation would be put at risk by the Registrant's business conduct in making use of the domain name advair.ca.


*I.O.F. v. Norendu (Forester College of Technology) CIRA Dispute
Resolution Case 00017*

18. Accordingly, I find that the Registrant acted in bad faith in registering the domain name advair.ca.

G. CONCLUSION/DECISION

19. The Complainant has proven, on a balance of probabilities, that the domain name advair.ca is confusingly similar to the Complainant's registered trade-mark ADVAIR, in which the Complainant had rights prior to the date of registration of the domain name and the Complainant continues to have such rights. The Complainant has also produced evidence that the Registrant has no legitimate interest in the domain name and has proven on a balance of probabilities that the Registrant acted in bad faith, pursuant to paragraph 3.7 of the *Policy*. For all these reasons, the complaint is successful and the panel orders and directs that the registration of advair.ca be transferred to the Complainant by the Registrar Ten Dollar Domain Names, Inc. (tendollar.ca).

Dated at Vancouver, British Columbia, Canada, this 10th day of November, 2005.



Michael D. Manson
Sole Panel Member