

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

BETWEEN:

RESEARCH IN MOTION LIMITED

Complainant

- and -

OLIVIER MULLIE

Registrant

A. DECISION

The Parties

1. The Complainant, Research In Motion Limited, is a company incorporated under the laws of Canada.
2. The Registrant, Olivier Mullie, is an individual resident in Ottawa, Ontario.

B. The Domain Names and Registrar

3. The disputed domain names that are the subject of this arbitration are

- planetblackberry.ca;
- blackberryshop.ca;
- shopblackberry.ca;
- shopcrackberry.ca;
- blackberrystore.ca;
- blackberrysource.ca;
- blackberrycentral.ca;
- bberry.ca; and
- blackberryaccessories.ca;

(collectively, the **Domain Names**).

4. The Registrar of the Domain Names is Sibername Internet and Software Technologies Inc., with an office in Ottawa, Ontario.

C. Procedural History

5. This matter is arbitrated under the CIRA Domain Name Dispute Resolution Policy (the **Policy**) and the CIRA Domain Name Dispute Resolution Rules (the **Rules**). By registration of the Domain Names with the Registrar, the Registrant agreed to the resolution of certain disputes under the Policy and Rules.

6. Based on information from the Dispute Resolution Service Provider - the British Columbia International Commercial Arbitration Centre (**BCICAC**) - the history of this proceeding can be summarized as follows:

- (a) On February 20, 2008, the Complainant filed with BCICAC a Complaint regarding the Domain Names.
- (b) The Complaint was reviewed by BCICAC and found to be compliant with administrative requirements. In a letter dated February 20, 2008, BCICAC advised the parties of that and sent a copy of the Complaint to the Registrant.
- (c) The Registrant failed to provide a Response in the time allowed under Rule 5.1 and did not seek an extension. Therefore, Rule 5.8 requires the arbitral panel to decide the matter based on the Complaint alone.
- (d) The Complainant elected to proceed with a three-member panel. The BCICAC named such a panel, namely, Anton M. S. Melnyk, Hugues G. Richard, and David R. Haigh, Q.C., Chair of the panel (the **Panel**).
- (e) Each of Messrs. Haigh, Melnyk and Richard delivered to the BCICAC a required Statement of Impartiality and Independence, according to Rule 7.2.

D. Preliminary Determinations

7. The Panel was properly constituted and appointed in accordance with the Policy and the Rules.

8. Under Rule 12.1, the law of Ontario applies.

E. Factual Background

9. Based on the Complaint in this uncontested dispute, a summary of the facts is set out below.

10. The Complainant is the owner of the following Canadian trademarks registered on the dates noted:

- BLACKBERRY – November 21, 2001;
- BLACKBERRY and Color Design – November 21, 2001;
- BLACKBERRY and Design – December 11, 2001;
- BLACKBERRY CONNECTION – November 8, 2004;
- BLACKBERRY – April 21, 2005;
- BLACKBERRY & BBBB Design – March 1, 2006; and
- BLACKBERRY and BBBB Design – March 1, 2006;

(collectively, the **Trademarks**).

The Complainant has used the Trademarks in Canada since at least 1999.

11. The Complainant has incurred in excess of \$264 Million (U.S.) in advertising and promoting the Trademarks since 2001.

12. A variety of items of evidence show that the Trademarks and the Blackberry Smart Phone is well known in Canada and in many parts of the world.

13. The Complainant has established a significant Internet presence, including registration and use of the following sites:

- blackberry.com;
- shopblackberry.com;
- discoveryblackberry.com;
- blackberrypearl.com; and
- blackberrycurve.com.

On the website shopblackberry.com, the Complainant sells various Blackberry products. That domain name was registered on June 16, 2004 and has been active as a website for nearly four years.

14. On various dates beginning on May 18, 2006 and ending on November 16, 2007, the Registrant registered the Domain Names.

15. The Registrant has registered at least 42 Domain Names that appear to be comprised of or contain third party Canadian trademark registrations. The Registrant has also registered ten domain names that appear to contain trademarks that are the subject of common law rights owned by third parties. The Registrant's registration of domain names has a pattern of employing well known trademarks of third

parties in the field of mobile communication devices and computers, such as Apple, Telus, Rogers, Motorola, Dell, Canon, Bluetooth, Treo (the **Pattern of Domain Registrations**).

16. On January 7, 2008, the Complainant's lawyers sent a cease and desist letter to the Registrant regarding the Domain Names.

17. The Complainant seeks to rely on a reply letter dated January 23, 2007 from legal counsel for the Registrant. In the specific circumstances, the Panel rules that the January 23, 2007 letter is inadmissible as a privileged "without-prejudice" letter. In any event, even if it were admissible, the letter would not itself be significant evidence under 3.7(a) of the Policy of a bad faith primary purpose on the part of the Registrant to make a profit on selling or transferring the Domain Names.

F. Discussion and Conclusions

Eligibility of the Complainant

18. As a company incorporated under the laws of Canada, the Complainant is eligible to make this Complaint under Rule 1.4 and under paragraph 2(d) of the CIRA Policies, Rules and Procedures – Canadian Presence Requirements for Registrants.

Confusingly Similar to the Marks

19. The Complainant's burden of proof under paragraph 4.1(a) of the Policy is to establish that "the Registrant's .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".

First Sub-Element

20. Paragraph 4.1(a) of the Policy contains a number of sub-elements. The first relevant sub-element is whether the Complainant had Rights in Marks, as defined in paragraph 32 of the Policy, before the registration date of the Domain Names.

21. The Complainant did so. Not only were the Trademarks registered before the registration of the Domain Names, but also "Blackberry" had been used even earlier in Canada for the purpose of distinguishing the wares and services of the Complainant's business from others. The Complainant also used "shopblackberry" as a Mark before the registration date of the Domain Names.

Second Sub-Element

22. The second sub-element of paragraph 4.1(a) of the Policy is whether the Domain Names are confusingly similar to the Blackberry Marks. Under paragraph 3.4 of the Policy, this would be so if the Domain Names were to resemble the applicable Marks so nearly in appearance, sound or in the ideas suggested by the Marks as to be likely to be mistaken for the Marks.

23. While the Blackberry Marks use a word in general use ("blackberry"), it is not descriptive of the products of the Complainant. The Blackberry Marks have taken on an extraordinarily well-known meaning completely distinct from blackberry fruit as a result of the success in the marketplace of the Complainant's novel products and of the Complainant's advertising.

24. The Domain Names do resemble the Blackberry Marks in either (a) appearance, (b) sound or (c) the idea suggested by the Blackberry Marks so as to likely be mistaken for the Blackberry Marks. Most of the Domain Names include the word "blackberry". Further, the Domain Names comprised of "blackberryshop", "shopblackberry", "blackberrystore", and "blackberryaccessories" particularly resemble the Blackberry domain name shopblackberry.com. The top-level domain portion (the .ca and .com portion) is an irrelevant distinction.

25. The following Domain Names do not contain the precise word "blackberry":

- bberry.ca; and
- shopcrackberry.ca.

However, they too so resemble the Blackberry Marks in appearance, sound or the idea suggested by the Blackberry Marks, so as to be likely mistaken for the Blackberry Marks by a significant number of Internet users and other consumers.

26. Based on both appearance and sound, "crackberry" and "blackberry" are very similar. Further, as both are suggestive of berries, there is an overlap in the ideas suggested. As well, "crackberry" is a popular culture nickname that references the Blackerry device, as set out in *Webster's Dictionary*.

27. The addition of the non-distinctive element "shop" to shopcrackberry.ca also leads to confusion. The domain name incorrectly suggests that it would resolve to a website operated, or otherwise authorized, by the Complainant to sell BLACKBERRY merchandise. Finally, the Domain Name is very similar to shopblackberry.com, the Complainant's website.

28. As for the Domain Name "bberry", it is very similar to "Blackberry" in appearance, sound, and idea. Furthermore, the term "bberry" is a known short form reference to the Blackberry device.

29. Based on the reasoning above, the Panel holds that the Complainant has satisfied its onus under paragraph 4.1(a) of the Policy.

Registration in Bad Faith

30. Under paragraph 4.1(b) of the Policy, the Complainant must prove that the Registrant has registered the domain name in bad faith as described in paragraph 3.7.

31. Because the Blackberry Marks are famous and because of the nature of browsing and searching on the Internet, it is inconceivable that the Registrant would not have been aware of the business of the Complainant and of its use of the Blackberry Marks and of Blackberry websites. Moreover, the improper Pattern of Domain Registration by the Registrant is evident. Consequently the Panel infers that the Registrant acquired the Domain Names for the bad faith purpose under paragraph 3.7(b) of the Policy, namely, for preventing the Complainant from registering its Marks as domain names. Furthermore, the Pattern of Domain Registration is inconsistent with any good faith purpose that would fall outside of the definitions of bad faith purposes under paragraphs 3.7(a), (b), or (c).

32. For the above reasons, the Panel holds that the Registrant registered the Domain Names in bad faith.

No Legitimate Interest

33. Under paragraph 4.1(c) of the Policy, the onus is on the Complainant to show at least some evidence that the Registrant has no legitimate interest in the Domain Names. Upon discharging that onus, it then shifts to the Registrant to prove that it has a legitimate interest in the Domain Names.

34. In this uncontested arbitration, the Registrant has provided no evidence, so it remains only for the Complainant to show at least some evidence that the Registrant has no legitimate interest in the Domain Names.

35. For the Registrant's use of the Domain Names to be legitimate, that use must fall under one of the sub-paragraphs 3.6(a) – (f). Only 3.6(a) would have any potential application. Paragraph 3.6(a) would require that the Domain Names to be Marks in which the Registrant had rights and which were used in good faith. The Complaint states that the Domain Names have not been used as Marks as defined in the Policy, namely "for the purpose of distinguishing the wares, services or business of that person or

predecessor or licensor of that person or predecessor from the wares, services or business of another person". As a result, there is uncontested evidence that the Registrant does not have a legitimate interest in the Domain Names under 3.6(a).

36. The Complainant has satisfied its onus in providing some evidence that the Registrant has no legitimate interest in the Domain Names.

Decision

37. The panel has decided as follows:

- (a) The Complainant is an eligible complainant.
- (b) The Registrant's Domain Names are Confusingly Similar to the Blackberry Marks, in which the Complainant had Rights before the Registration of the Domain Names, and continues to have such Rights.
- (c) The Registrant has registered the Domain Names in bad faith.
- (d) The Registrant has no legitimate interest in the Domain Names.
- (e) The Complainant has satisfied its onus obligations under paragraph 4.1 of the Policy.

38. Based on these conclusions, the panel decides these proceedings in favour of the Complainant and orders that the Registration of the following Domain Names be transferred to the Complainant:

- planetblackberry.ca;
- blackberryshop.ca;
- shopblackberry.ca;
- shopcrackberry.ca;
- blackberrystore.ca;
- blackberrysource.ca;
- blackberrycentral.ca;
- bberry.ca; and
- blackberryaccessories.ca.

MADE this 21st day of April, 2008.

With the concurrence of M.S. Melnyk Q.C. and Hughes G. Richard,



for DAVID R. HAIGH, Q.C.
Chairman