

**IN THE MATTER OF A COMPLAINT PURSUANT TO
THE CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

Dispute Number: DCA - 1144-CIRA
Domain Name: www. xchangecanada.ca
Complainant: United Business Media LLC
Registrant: TechnoPlanet Productions Inc.
Registrar : Tucows.com Co.
Panellists: Claude Freeman, LL.M. (ADR), C.Med., C.Arb. – Panel Chair
David R. Haigh Q.C.
W.A. Derry Millar
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

THE PARTIES

The Complainant is United Business Media LLC of Manhasset, New York, USA

The Registrant is TechnoPlanet Productions Inc. of Markham, Ontario, Canada.

THE DOMAIN NAME AND REGISTRAR

The Domain Name in issue in this proceeding is: “xchangecanada.ca”.

The Registrar is Tucows.com Co.

The Domain Name was registered on October 28, 1998.

PROCEDURAL HISTORY

The British Columbia International Commercial Arbitration Centre (“**BCICAC**”) is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (“**Policy**”) of the Canadian Internet Registration Authority (“**CIRA**”).

The Complainant filed a Complaint with respect to the domain name in issue in accordance with the Policy on February 23, 2009 (the “**Complaint**”).

The BCICAC reviewed the Complaint and found it compliant, and by letter to the parties, advised them of this. The Registrant requested an extension of time (under Rule 5.4) from

the BCICAC for its response to April 10, 2009, which was approved by the BCICAC. The Registrant provided its' Response to the BCICAC on April 8, 2009.

The Registrant's Response was reviewed by the BCICAC and delivered to the Complainant on April 14, 2009. Further, all communications, and documents submitted were in English, and therefore English shall be the language of the proceeding.

The BCICAC named (in accordance with Paragraph 6 of the Rules) Claude Freeman as Chair, and David R. Haigh and Derry Millar as Panellists (the "**Panel**").

The Panel has reviewed all of the material submitted by the Complainant and the Registrant and is satisfied that the Complainant is an eligible complainant under the Policy and Rules.

BACKGROUND

The Complainant is United Business Media LLC, a subsidiary of United Business Media Limited (UBM Ltd.), a publicly traded company on the London Stock Exchange. UBM has various subsidiaries worldwide – under the banner "UBM Group", and provides business information services to, in part, the technology, healthcare, media, automotive and financial services sectors. The company's annual report for the year 2007 states that they provide information, education services to host the professional exchanges amongst various commercial communities such as doctors, jewellery dealers, pharmacists, developers, amongst a few, and are based in over 30 countries, with a staff base of approximately 6500 people. Its annual revenues for 2007 are stated at 801.6 million Pounds Sterling. The Complainant, more specifically, organizes and conducts seminars and conferences in association with the XCHANGE trade-mark, and includes offerings of recruiting, training, education, and networking opportunities in the form of three or four day events featuring keynote speakers, lectures debates, and discussions. Their website at: HYPERLINK "http://www.everythingchannel.com/xchange" www.everythingchannel.com/xchange provides further details on Complainant's services.

The Complainant has the following Canadian trade-mark:

TMA503,113 for the word "XCHANGE" registered October 28, 1998.

For the terms of the disclaimers and otherwise, the panel relies on the actual Canadian Intellectual Property Office Trade Mark Data attached as Exhibit "3" of the Complaint.

The Complainant has had a significant on-line presence since at least 1997 and uses the website www.everythingchannel.com as its primary website.

The Complainant meets the Canadian Presence Requirements of the Canadian Internet Registry Authority because it owns the "XCHANGE" Canadian trade-mark.

The Registrant in its Response did not however, provide any historical or current details of the scope of its business activities, (other than information technology) and therefore the Panel cannot provide any comparative overview of Registrant's activities as it did for the Complainant. Suffice it to say though, that during the course of its business activities, the Registrant sought to, and did enter into an agreement "XCHANGEtm Event License Agreement" with the Complainant on April 25, 2002, for an "XCHANGE Event" to be hosted by Complainant for Registrant prior to October 2002. This event would, as the agreement indicates, have for the effect of assisting the Registrant with business leads and other client generation, by way of coaching the Registrant with promotion and visibility strategy execution. It should be noted that the above-mentioned license agreement was in effect until cancelled by the Complainant in 2006 (as per paragraph 15 of the complaint).

At the time of review by the panel, it appears as if the only link to the Registrant is by way of the email address: HYPERLINK "mailto:info@technoplanet.com" info@technoplanet.com. Further, it is important to note that the reason given by the Registrant for registering the domain name, was that its' predecessors had domain names which would not be able to be transferred to the Registrant.

The Registrant states that the Registrant has parked the domain name "xchangeCanada.ca". The Registrant also states in their email response of July 29, 2009, that the Registrant is making no use (existing or otherwise planned) of "xchangeCanada.ca".

The Registrant responded to the Complainant's letter by way of email, asserting that it had removed, ceased, and otherwise undertaken extensive efforts to make no references to "XCHANGE", but that "XCHANGE CANADA.CA" was directly related to Registrant's business, and was owned by them. They further added that the URL of HYPERLINK "http://www.xchangeCanada.ca" www.xchangeCanada.ca was no longer in use, and was for sale, and this by way of a "landing page". By way of their email Response, the Registrant advised the Complainant that they hoped to settle this issue in a satisfactory manner to both sides, and should the Complainant wish, they could put in an offer to purchase this URL. Following this response by the Registrant, the Complaint ensued.

POSITION OF THE COMPLAINANT

The Complainant submitted that:

(a) The Domain Name xchangeCanada.ca is Confusingly Similar to the Marks in which Complainant had Rights prior to the date of registration of the Domain Name and continues to have such Rights;

(b) The Registrant has no legitimate interest in the Domain Name as described in paragraph 3.6 of the Policy; and

(c) The Registrant has registered the Domain Name in bad faith as described in paragraph 3.7 of the Policy.

The Complainant's submissions will be dealt with in the Analysis portion of this decision.

Relief Sought

The Complainant requested that xchangecanada.ca be transferred from the Registrant to the Complainant.

POSITION OF THE REGISTRANT

Direct competition between the Registrant and the Complainant

The Registrant pleads that it is not a competitor of the Complainant and that the addition of "Canada" to the word "xchange" makes for a somewhat different version of the URL compared to its simple version of "xchange". Further, they do not use nor promote the current version. The word xchange is widely used world-wide, and there appears no absolute, world-wide ownership of the word "xchange" by the Complainant. It also argues, that any other permutations world-wide (non-competing) by any other users have either not been or appear not to have been defended by the Complainant. The argument is also made, or alluded to, by the Registrant that following the fall-out regarding the event apparently expected by way of the agreement of April 25, 2002 between the parties, the Registrant was left without the expected outcome of the event. This fall-out was apparently the result the event host cancelling with very short notice, and not holding the event. The event, as it was understood, was not to be an event that was in direct competition with the Complainant.

The Complainant's rights in the Mark

The Registrant argues that because the Complainant failed to both defend its trade-mark, and that the name is so widely used world-wide, that its Canadian version is non-competing, by virtue of its uniqueness. The Registrant also alleges that it registered the current name some two years ago.

Bad faith on the part of the Registrant

The Registrant says that there is no evidence of bad faith on its part.

The Registrant says that the fact that there has, or not been development of the xchangecanada.ca site does not indicate bad faith. The Registrant says it has not profited from the domain and has made no predatory use of it.

The Registrant says there is no evidence that it registered the domain name "primarily for the purposes of disrupting the Complainant and its business," nor that it registered the domain name "primarily for the purpose of selling the domain name to the Complainant or

to any competitor of the Complainant” for valuable consideration, and that it has a legitimate interest/right in the domain name, specifically due to both the “Canadianization” of this, as well as their registration of some two years ago as well as the world-wide use of its prefix “xchange”.

The Registrant says: the domain name “xchangeCanada.ca” is currently parked and isn’t in a development stage, and will continue to be parked until some form of sale or resolution, and that it has never been demonstrated by the Complainant that they have ever derived any illegitimate use of the domain.

ANALYSIS AND FINDINGS

The Complaint

Paragraph 4.1 of the *CIRA Domain Name Dispute Resolution Policy* sets out that, to succeed, the Complainant must establish on a balance of probabilities that:

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

the Registrant has registered the domain name in bad faith as described in paragraph 3.7;

and the Complainant must provide some evidence that:

the Registrant has no legitimate interest in the domain name as described in paragraph 3.6.

Even if the 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.

It is the view of the Panel that, for the reasons that follow, the Complainant has met its burden under paragraph 4.1 (a) and (c). The Complainant has established that it has a Mark according to the definition in paragraph 3.2(c). It has established that the domain name registered by the Registrant is confusingly similar to that mark. The Complainant has also provided some evidence that the Registrant has no legitimate interest in the subject domain name. We have found that the Complainant did not prove paragraph 4.1(b).

Paragraph 4.1(a)

To succeed in meeting its onus under paragraph 4.1(a), the Complainant has to show that it has rights, in a Mark, and that the disputed domain name is confusingly similar to that Mark.

Rights of the Complainant in the XCHANGE trade-mark

The Complainant is the owner of the XCHANGE trade-mark since at least October 28, 1998, and that therefore the Complainant has rights in the XCHANGE trade-marks in accordance with paragraph 3.3(c) of the Policy.

The name xchange was registered on October 28, 1998, so the Complainant's rights in the XCHANGE trade-mark predate the registration of xchangecanada.ca.

As per paragraph 3.2(c) of the Policy, a "Mark" includes:

- (c) a trade-mark, including the word elements of a design mark, that is registered in CIPO...

The Panel finds that the XCHANGE name is such a Mark.

The Panel finds that the Complainant has established the requisite rights in the Mark.

Paragraph 3.4 of the Policy provides a definition of the term 'Confusingly Similar'. The Policy 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.

It is the Panel's view that a person knowing the Complainant's mark, XCHANGE, would certainly mistake the domain name "xchangecanada.ca" for the Complainant's corresponding mark. Here, there is no difference between the xchangecanada.ca domain name and the XCHANGE mark, and "xchangecanada.ca" is phonetically close to the Complainant's mark such as to create confusion. The domain link name used by the Complainant includes XCHANGE.

An Internet user who has knowledge of the name XCHANGE might easily mistake the domain xchangecanada.ca as being somehow affiliated with or owned by the Complainant. This is sufficient to conclude that the domain name is confusingly similar to the Complainant's mark, XCHANGE.: *Glaxo Group Ltd. v. Defining Presence Marketing*, CIRA Dispute Number 00020; *Great Pacific Industries. v. Ghalib Dhalla* CIRA Dispute Number 00009 ("*Great Pacific*"); *Government of Canada v. David Bedford, c.o.b. Abundance Computer Consulting*, BCICAC Case No. 00011; *CBC/SRC*..

Paragraph 4.1(b) – Registration in Bad Faith

The Complainant asserts that the Registrant registered the domain name xchangecanada.ca in bad faith, according to all three subsections of Paragraph 3.7.

Paragraph 3.7 says:

Registration in Bad Faith. 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 Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant.

The Complainant must prove bad faith under at least one sub-paragraphs of paragraph 3.7 on a balance of probabilities. The Panel finds that there is insufficient evidence to make a finding under sub-paragraphs (a) (b) and (c).

Paragraph 4.1(c) – Legitimate Interest in the Domain Name

The Complainant asserts that the Registrant has no legitimate interest in the domain name xchangecanada.ca. This assertion rests on the assumption that the Registrant knew of the XCHANGE trade-mark and set out to capitalize upon its similarity to it.

The Complainant has succeeded in showing "some evidence" of this, albeit that what

appears to be more out of either confusion or the appearance of its firm belief, it offered to sell what it described as a “parked and unused domain name. As such, it falls to the Registrant to show that it has a legitimate interest. C.Arb.

The Policy states that a Registrant has a legitimate interest in a domain if, prior to notice of a complaint, it is able to demonstrate that it had any of the indicia of legitimate interest listed in paragraph 3.6 (a-f). The Panel finds that the Registrant did not succeed in doing so.

There has been a business relationship between the Complainant and the Registrant, and the Registrant was licensed and authorized to use the XCHANGE mark for a limited period of time, but however such use was restricted pursuant to the agreement amongst them. The XCHANGE name has not been used for the purpose of distinguishing the business or products of the Registrant [paragraph 3.6(c)].

The XCHANGE name is not generic, [paragraph 3.6(c)], nor is it the geographical name of the location of the Registrant’s place of business [paragraph 3.6(f)]. The Registrant has not used the XCHANGE name for non-commercial activity [paragraph 3.6(d)], nor is it a reference by which the Registrant is commonly identified [paragraph 3.6(e)], however when the word XCHANGE becomes part of the word xchangecanada.ca, it becomes difficult to parcel out the entitlement of ownership to those who have embedded the word XCHANGE in their domain name nomenclature.

The Registrant has not adduced any evidence that counters the assertions about its lack of legitimate interest, and fails to make any positive claim to rights in the Mark. The Registrant does not provide a plausible explanation of how it would employ the domain name in a legitimate business fashion if it were to do so. The Panel has to bring into question what the Registrant would do if their business requirements would dictate an otherwise use of the current domain name, and the commercial value thereof. Accordingly, the issues regarding bad faith would perhaps interact differently.

Applying the definition in paragraph 3.6 of the Policy, the Registrant does not have a legitimate interest in the domain name xchangecanada.ca, and to the extent possible, has satisfied this panel that the name is confusingly similar, to that of XCHANGE.

ORDER

The Panel finds that the Complainant has not proven Paragraph 4.1(b) of the Policy.

For the above reasons, the Panel orders that although the Complainant may have met the tests or burden under paragraphs 4.1 (a) and (c), it did not meet the bad faith requirement.

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David R. Haigh, Q.C.	Claude Freeman, LL.M. (ADR), C.Med., C.Arb. Chair	Derry Millar,
	<i>Original signed by Claude Freeman for the Panel</i> _____	
	Per: Claude Freeman, Chair Date May 11th, 2009	