

**In the Matter of a Complaint Pursuant to Canadian Internet
Registration Authority Domain Name Dispute Resolution Policy**

Dispute Number: DCA-1211-CIRA
Domain Name: windows7.ca
Complainant: Microsoft Corporation
Registrant: Liang Guo
Registrar: Netfirms, Inc.
Panelist: Elizabeth Cuddihy, QC, ICA
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

The Parties

1. **The Complainant is** Microsoft Corporation of One Microsoft Way, Redmond, Washington, 98052-6399, U.S.A., hereinafter referred to as the “Complainant”.
2. **The Registrant is** Liang Guo of 32 Appleby Crescent, Markham, Ontario, L3R 4L2, hereinafter referred to as the “Registrant”.

The Domain Name and Registrar

3. The Domain Name at issue the “Disputed Domain Name” is windows7.ca.
4. The Registrar for the Disputed Domain Name is Netfirms, Inc., according to printout of CIRA’s WHOIS record for the Disputed Domain Name.
5. The Disputed Domain Name was registered October 22, 2007.

Procedural History

6. The British Columbia International Commercial Arbitration Center (“BCICAC”) is a recognized service provider to the Domain Name Dispute Resolution Policy (“Policy”) of the Canadian Internet Registration Authority (“CIRA”).
7. On December 29, 2009, the Complainant filed a complaint with respect to the Disputed Domain Name (“Complaint”), which Complaint was deemed by BCICAC to be in administrative compliance and the Complainant to be eligible.

8. By letter dated December 29, 2009, BCICAC notified the Registrant of the compliant Complaint and of the commencement of the dispute resolution process in respect of the Complaint.
9. The Registrant did not file a Response.
10. BCICAC advised the parties that no Response had been received within the timeframe permitted by the Policy, and, as permitted in Rule 6.5, the Complainant elected to convert to a single arbitrator.
11. On January 22, 2010, BCICAC appointed Elizabeth Cuddihy, QC, ICA, as sole arbitrator to determine the matter in accordance with the rules.
12. The Panelist has delivered to BCICAC the Statement of Impartiality and Independence as required by the Rules.
13. Absent exceptional circumstances, the Panel was required to deliver its decision by February 12, 2010.
14. The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Rules.

Complainant Eligibility

15. Pursuant to paragraph 1.4 of the Policy and paragraph 2.1(q) of the CIRA Policies, Procedures and Guidelines, Canadian Presence Requirements for Registrants, the Disputed Domain Name, windows7.ca was registered on October 22, 2007 and includes the exact word component of the Complainant's Canadian registered trade mark, WINDOWS which was registered in the Canadian Intellectual Property Office (CIPO) on June 25, 1996 under registration No TMA459,607. Accordingly, the Complainant satisfies the Canadian Presence Requirements as prescribed by the Policy.

Complaint and requested relief

16. The Complainant claims that since 1975, it has manufactured, marketed and sold computer software and related products and services. The Complainant's products and services include computer operating systems, client/server applications, business and consumer productivity applications, software programming tools, interactive media programs, internet platform and

development tools, computer input devices, online information and entertainment services, electronic commerce services and computer publications. The Complainant is the owner of numerous proprietary marks for its computer software and related goods and services.

17. The Complainant's trade marks include the internationally-known trade-mark WINDOWS, the use of which it began in the United States as early as 1983 and in Canada in 1985 and it continues to use these marks. The WINDOWS trade mark is well-known to the general public in particular to computer users. The Complainant has expanded its WINDOWS products and services and now owns a family of WINDOWS trade-marks including a number of WINDOWS trade-marks registered in CIPO and others for which registration is pending. These include WINDOWS XP, WINDOWS VISTA, WINDOWS MOBILE, WINDOWS SYSTEM SERVER, WINDOWS NT, WINDOWS MEDIA & Design, WINDOWS LIVE, GAMES FOR WINDOWS, WINDOWS AZURE, to name a few.

18. As early as February 1, 2007, the first announcements were made regarding the naming of the next release of the Complainant's WINDOWS operating system, Windows 7.

19. The Registrant registered the Disputed Domain Name WINDOWS7.CA on October 22, 2007.

20. As early as May 2009, the Registrant's Disputed Domain Name was used to redirect users to a pornographic website associated with the website www.ZhungGuo.ca. Through an exchange of correspondence between an agent of the Complainant and the Registrant, the Registrant indicated his willingness to sell the Disputed Domain Name for \$10,000.00. A sale did not materialize. On July 27, 2009, the Complainant issued a cease and desist letter. The Registrant provided no response. On or about August 12, 2009, the Disputed Domain Name re-directed to a virtually blank web page which purported to be associated with a "windows and door service company". The newly launched Disputed Domain Name web site contained links to web sites associated with LINUX, MAX OS X and UNIX, which are operating systems which compete with WINDOWS. On or about November 5, 2009, the Registrant began once again to redirect users of the Disputed Domain Name to a pornographic website at www.ZhungGuo.ca.

21. The Complainant claims that the Disputed Domain Name is confusingly similar to its Mark WINDOWS in which it had rights prior to the registration of the Disputed Domain Name and continues to have such rights, that the Registrant registered the Disputed Domain Name in bad faith and that the Registrant has no legitimate interest in the Disputed Domain Name and requests that the Panel order the transfer of the Disputed Domain Name from the Registrant to the Complainant.

Analysis and Findings

22. Paragraph 4.1 of the Policy provides:

.4.1 Onus. To succeed in the Proceeding, the Complainant must 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;

and the Complainant must provide some evidence that:

- (c) 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.

Confusingly similar prior rights

23. To deal first with the issue of confusingly similar to the WINDOWS Mark in which the Complainant had rights prior to the date of registration of the Disputed Domain Name.

24. The evidence in respect of ownership of the Complainant's Mark shows that the Complainant is the owner of the WINDOWS Mark, which was registered in CIPO June 21, 1996 as number TMA459,607 and continues to own the Mark.

The evidence further shows that the Disputed Domain Name was registered October 22, 2007.

25. The date of registration of the Complainant's Mark is clearly prior to the date of registration of the Disputed Domain Name.

26. Accordingly the Complainant had prior rights in the Mark and continues, based on the evidence, to have such rights.

27. As for "confusingly similar", the Policy provides:

3.4 "Confusingly Similar". 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 to be mistaken for the Mark.

28. Referring to *Amazon Com Inc v. David Abraham*, CIRA – 000182004 CarswellNat 5228, 35 C.P.R. (4th)58 (C.I.R.A.- B.C.I.C.A.C. at 4), the test is whether the average Internet user with an imperfect recollection of the trade-mark WINDOWS who wishes to access a web site operated by the Complainant either by entering a domain name including one of the Complainant's trade-marks into the address bar of an Internet browser, or by entering the key terms of the domain name into an Internet search engine, would likely be confused as a matter of first impression with the Disputed Domain Name.

29. The Disputed Domain Name is identical to the Mark WINDOWS but for the numeral 7 and the "dot-ca" suffix.

30. Paragraph 1.2 of the Policy stipulates

"domain name" means the domain name excluding the "dot-ca" suffix and the suffixes associated with all third and fourth level domain names accepted for registration by CIRA

31. As for the numeral 7 as part of Disputed Domain Name, the Complainant submits that it is a well known practice for producers of computer software to use numerals in ever-increasing incremental order to name subsequent generations of their software. (See John E. Harmon and Steven J. Anderson, *The Design and Implementation of Geographic Information Systems* (Wiley, 2003) at 184-185).

32. It has been held that the addition of descriptive or non-descriptive terms to a trade-mark will not prevent the finding of confusing similarity. Reference is made to *Seiko Epson Corporation v. Zokool Technologies, Inc.*, CIRA – 00123, 2009 CarswellNat 1175 (C.I.R.A. (B.C.I.C.A.C.)), at para.28 where the Panel states:

Moreover, the Domain Names are not merely similar to the Complainant's registered EPSON trade-marks. Each Domain Name features the Complainant's trade-mark EPSON. The fact that the whole of the Complainant's Mark is incorporated in the Domain Names is sufficient to support a finding of confusing similarity and the addition of descriptive or non-distinctive terms in the Domain Name [here, "ink", "inkjet", and "cartridge"] will not prevent them from being found Confusingly Similar with the Complainant's mark. (see *General Motors Acceptance Corporation v. Bob Woods*, CIRA case No 00051)

33. The most distinctive element of the Disputed Domain Name is the Complainant's trade-mark WINDOWS. I agree that the addition of the numeral 7 to the Mark will not prevent the finding of Confusingly Similar. In fact the name of the Complainant's next generation operating system, Windows 7 had been released and was in the public domain as early as February 2007, well before the date of registration of the Disputed Domain Name by the Registrant.

34. For the reasons stated above, the Panel finds that the Complainant has proven on a balance of probabilities that the Disputed Domain Name is confusingly similar to the WINDOWS Mark, in which the Complainant had rights prior to the date of registration of the Disputed Domain Name and continues to have such rights and that the Complainant therefore satisfies the onus placed on it by clause (a) of paragraph 4.1 of the Policy.

Bad faith registration

35. To deal now with the issue of bad faith registration, the Complainant relied on paragraphs 3.7(a) and 3.7(c) of the Policy.

36. The Policy provides:

3.7. 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) ...; 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.

Bad faith paragraph 3.7(a) of the Policy

37. As evidenced by an exchange of e-mail correspondence between the Registrant and the Complainant's agent, the Registrant indicated a clear willingness to transfer the Disputed Domain Name for a purchase price of \$10,000.00, an amount far in excess of the Registrant's costs to register the Disputed Domain Name.

38. Evidence further shows that, following the unsuccessful attempts to obtain a transfer of the Disputed Domain Name as noted in paragraph 37, the Complainant issued a cease and desist letter in respect of the Registrant's use of the Complainants' Mark and requested an immediate transfer to the Complainant of the Disputed Domain Name. The Registrant provided no response but evidence shows that following that occurrence, the Disputed Domain Name, which earlier had been directing users to www.ZhongGuo.ca, a pornographic website, redirected users to a website purporting to be associated with a "windows and door service company" containing links to web sites associated with LINUX, MAX OX X and UNIX, all computer operating systems which compete with the Complainant's operating system Windows.

39. "The Registrant's purpose in registering the disputed Domain Name may be determined by common sense inference from the Registrant's conduct and other surrounding circumstances" (see *Coca Cola Ltd v. Amos B. Hennan*, CIRA-0014, 2003 CarswellNat 4789, 29 C.P.R. (4th) 233 (C.I.R.A. (B.C.I.C.A.C.) at para. 45).

40. Also, "It is reasonable to infer the Registrant's bad faith intention in registering a domain name from the use to which the Registrant puts the domain

name after registration.” (see *Sleep Country Canada Inc v. Pilfold Ventures Inc*, CIRA-0027, 2005 CarswellNat 779, 38 C.P.R. (4th) 374 (C.I.R.A. (Resolution Canada) at para.21).

41. The Complainant’s business and its Mark, WINDOWS was well-known in association with computer software at the date of registration of the Disputed Domain Name. It is inconceivable that the Registrant was not aware of the Complainant’s business and of its Mark when the Registrant registered the Disputed Domain Name. The use to which the Disputed Domain Name was being put, namely, initially directing users to ZhongGuo.ca, a pornographic site with no reference to the Disputed Domain Name, and then following a cease and desist letter, linking users to competing products of the Complainant, demonstrates the speculative nature of the Registrant’s actions in registering the Complainant’s well-known Mark. In addition the Registrant initially expressed a willingness to sell the Disputed Domain Name for a price far in excess of the Registrant’s cost.

42. Based on the above, the Panel is satisfied that the Registrant registered the Disputed Domain Name primarily for the purpose of selling, renting, licensing or otherwise transferring the Disputed Domain Name to the Complainant and the Complainant has satisfied its burden of proof of bad faith on the part of the Registrant in accordance with paragraph 3.7(a) of the Policy.

Bad faith paragraph 3.7(c) of the Policy

43. The Complainant further claimed that the Registrant registered the Disputed Domain Name 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.

44. Evidence shows that the Registrant used the Disputed Domain Name, first to divert users to a pornographic site and, following the Complainant’s cease and desist letter, in association with a web page which offers links to operating systems such as LINUX, MAX OS X and UNIX which directly compete with the Complainant’s WINDOWS. The web page also links to baidu.com and google.cn which are search engines which directly compete with that of the Complainant. Accordingly, the Panel is satisfied that the Registrant’s use of the Disputed Domain Name in association with a web page that linked to competitors

constitutes the Registrant a competitor of the Complainant for the purposes of paragraph 3(c) of the Policy.

45. As for “disrupting the business of the Complainant”, this phrase has been interpreted as follows:

...[t]his disruption could occur only in the sense that persons encountering the domain name might conclude that the Registrant’s business, associated with the domain name, was a business of the Complainant or was at least endorsed, sponsored or approved by the Complainant. Thus, the Complainant’s business reputation could be put at risk by the Registrant’s business conduct, over which the Complainant had no control. (see *Independent Order of Foresters v. Noredu Enterprises Canada Inc.*, CIRA-0012, 2004 CarswellNat 4929, 34 C.P.R. (4th) 534 (C.I.R.A. (Resolution Canada) at para. 36)

46. The Complainant’s Mark WINDOWS has become a popular operating platform for desktop and laptop computers worldwide. It is most likely that persons encountering the Confusingly Similar Disputed Domain Name might conclude that the business associated with the Disputed Domain Name was a business of the Complainant or, was, at least endorsed, sponsored or approved by the Complainant.

47. As held in *Sleep Country Canada Inc v. Pinfold Ventures Inc*, “it is reasonable to infer the Registrant’s intention in registering a domain name from the use to which the Registrant puts the domain name after registration”. In that case the Registrant used the confusingly similar domain name on a web site that was dominated by links to mattress and bedding retailers who might compete for business with the Complainant.

The adverse impact on, or disruption of, the Complainant’s business from the Registrant so using the Confusingly Similar domain name should have been obvious to the Registrant. I infer that this intention was formed by the Registrant as the domain name was first registered. Further, the dominant use on that web site of links to businesses competing with the Complainant supports the further inference that the Registrant registered the domain name “primarily for the purpose of disrupting the business of the Complainant. (see *Sleep Country Canada Inc v. Pilfold Ventures Inc*, CIRA- 0027, 2005 CarswellNat 779, 38 C.P.R. (4th) 374)C.I.R.A. (Resolution Canada) at para.21)

48. By the Registrant diverting users of the Confusingly Similar Disputed Domain Name to a pornographic website and by linking its sites to sites associated with LINUX, MAX OS X and UNIX, which are operating systems which compete with the Complainant's operating system WINDOWS, the Panel further finds that the Registrant registered the Disputed Domain Name primarily for the purpose of disrupting the business of the Complainant, a competitor.

49. For the reasons stated above, the Panel finds that the Complainant has satisfied its burden of proof that the Registrant registered the Disputed Domain Name in bad faith in accordance with both paragraphs 3.7(a) and 3.7(c) of the Policy.

Legitimate Interest

50. The final element of the test set out in the Policy is to determine whether or not the Registrant has a legitimate interest in the Disputed Domain Name.

51. The Policy provides:

3.6 Legitimate Interests. 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 as a Mark, the Registrant used the Mark in good faith and the Registrant had 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 or 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 3.6(b), (c), and (d) "use" by the Registrants includes, but is not limited to, use to identify a web site.

52. The Panel finds that the Complainant has provided sufficient evidence that the Registrant does not have a legitimate interest in the Disputed Domain Name as prescribed by paragraph 3.6 of the Policy:

(i) As per paragraph 3.6(a), the use of the Disputed Domain Name originally to direct users to a pornographic site and, subsequent to Complainant's notice to cease and desist use of the Mark, to link users to products of competitors of the Complainant cannot be said to constitute *bona fide* use of the Disputed Domain Name. The Registrant had no rights in the WINDOWS Mark and in any event the Registrant has not used the Disputed Domain Name as a Mark as defined by the Policy; namely, "for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person". It follows that the Registrant cannot claim Rights in the Disputed Domain Name.

(ii) As the Panel finds that the Disputed Domain Name has not been used in good faith, the Registrant may not rely on the protection extended by paragraph 3.6(b), (c) and (d) of the Policy. In any event, the Disputed Domain Name itself is not found to be a descriptive or generic term, nor has the Disputed Domain Name been used in connection with a non-commercial activity.

(iii) The Disputed Domain Name is not comprised of the legal name of the Registrant, nor was it a name, surname or other reference by which the Registrant was commonly identified. As well, the Disputed Domain Name is not the geographical name of the location of the Registrant's non-commercial activity or place of business. Accordingly, paragraphs 3.6(e) and (f) cannot be relied upon.

53. As the Registrant has not responded to the Complaint, it has not provided any proof, on a balance of probabilities, that it has a legitimate interest in the Disputed Domain Name.

54. Accordingly, the Panel finds that the Registrant does not have a legitimate interest in the Disputed Domain Name.

Decision and Order

55. For the reasons set out herein, the Panel decides this Dispute in favour of the Complainant.

56. The Panel orders, pursuant to paragraph 4.3 of the Policy, that the Disputed Domain Name, windows7.ca be transferred from the Registrant to the Complainant.

Dated at Chester, Nova Scotia, this 2nd of February 2010.

(sgd) Elizabeth Cuddihy _____

Elizabeth Cuddihy, Sole Panelist

