

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number: 00003

Domain Name: www.biogen.ca

Complainant: Biogen, Inc.

Registrant: Xcalibur Communication

Registrar: DomainsAtCost Corp.

Panellist: Hon. Roger P. Kerans FCI Arb

Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

1 PRELIMINARY MATTERS

- 1.1 This is a dispute about the domain name "www.biogen.ca".
- 1.2 The Canadian Internet Registration Authority (CIRA), which is responsible for operating the dot-ca Internet country code Top Level Domain (ccTLD), established, by its Domain Name Dispute Resolution Policy (CDRP), published November 29, 2001, a mechanism for the resolution of disputes about domain names, established the "CIRA Dispute Resolution Rules: (the "Resolution Rules"), and named the British Columbia International Commercial Arbitration Centre (BCICAC) as a service provider under that that Policy.
- 1.3 A complaint was filed by the complainant at the BCICAC on October 18, 2002.
- 1.4 The BCICAC has certified and I accept that the complaint complied with the formal requirements of the CDRP and the Resolution Rules.
- 1.5 The BCICAC has certified and I accept that it has complied with provisions of the CDRP and the Resolution Rules in giving Notice of the Complaint to the Registrar of record and Respondent on October 22, 2002, and that the Respondent has failed to respond.
- 1.6 The Complainant has elected under paragraph 6.5 of the Resolution Rules to have this dispute resolved by a single arbitrator.
- 1.7 On November 18, I was named as sole arbitrator, and have executed a statement of independence and impartiality as required by BCICAC Rules.

2 POSITIONS OF THE PARTIES

2.1 The Complainant submits:

2.1.1 That it has a Canadian presence required by the CDRP and Section 2. (q) of the Canadian Presence Requirements For Registrants by virtue of the fact that it is the owner of a registered Canadian trade-mark for the name BIOGEN, which was registered in 1984.

2.1.2 BIOGEN is a coined word and not a common word in French or English.

2.1.3 Since 1984, the Complainant has used this trade-mark in Canada in connection with the sale of its products and services in the pharmaceutical industry.

2.1.4 The principal business of the Complainant is to engage in discovery and development of drugs for human health through genetic engineering.

2.1.5 The Complainant has registered its trade-mark throughout the world, and registered it as part of a domain name in 17 countries.

2.1.6 Sales of Avonex, a drug for MS patients marketed in Canada in connection with the Biogen trade-mark, has since 1998 had Canadian sales of over US\$37 millions.

2.1.7 The domain name in dispute is confusingly similar to the trade-mark.

2.1.8 The respondent has no legitimate interest in the domain name in dispute; and the website under the domain name in dispute merely points to a website offering domain name registrations for sale.

2.1.9 On May 8, 2002, and thereafter, counsel for the Complainant sought to contact the Respondent by post, fax, and telephone. The Respondent did not answer or reply. Further inquiry determined that the fax number and phone number were not registered to the Respondent, and the postal address was a "Mailboxes" address. No record of a telephone number in the name of Xcalibur Communications could be found.

2.1.10 The Respondent did reply to email from the Complainant saying it would look into the claim of the Complainant, but has since made no response.

2.1.11 Decisions under the CDRP should be consistent with decisions under the UDRP.

2.2 The Respondent filed no submissions.

3 DECISION

3.1 Canadian Presence.

- 3.1.1 The CDRP paragraph 1.4 requires that a Complainant have a Canadian presence as defined by the CIRA Policy called Canadian Presence Requirements For Registrants (RPPG 05-20001108-00006 Version 1.2 Effective Date: November 8, 2000).
- 3.1.2 Both paragraph 1.4 and Section 2. (q) exempt a Complainant from those rules if it holds a registered trade-mark in Canada that is related to the domain name in dispute.
- 3.1.3 I accept that the evidence offered by the Complainant that it has registered the trade-mark BIOGEN in Canada, and I find that it is a mark closely related to the domain name in dispute.

3.2 Confusing Similarity

- 3.2.1 Paragraph 4.1(a) of the CDRP requires that the complainant establish on a balance of probabilities that the domain name in dispute 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.”
- 3.2.2 I accept the evidence that the Complainant has a valid and subsisting registered trade mark in Canada respecting the word “BIOGEN” which has subsisted since 1984. In my view this creates rights in the mark within the meaning of Paragraph 3.3 of the CDRP.
- 3.2.3 In my view, and because “biogen” is a coined word, a person familiar with the trade-mark and searching the web for the Complainant or its products would find the domain name in dispute confusingly similar. The Complainant has proved this aspect of the matter.

3.3 No legitimate Interest

- 3.3.1 Paragraph 4.1(c) of the CDRP requires that the Complainant must provide some evidence that the Registrant has no legitimate interest in the domain name.
- 3.3.2 I accept the evidence from the Complainant that the sole use by the Respondent of the domain name in dispute is to offer it for sale, and that it would appear that the Respondent has not and is not carrying on any other business in connection with this domain name - or at all.
- 3.3.3 In my view, the Respondent has no legitimate interest in the domain name in dispute. The Complainant has established that the Respondent’s use of the name failed to fall within any of the six matters of legitimate interest spelled out in paragraph 3.6 of the CDRP.

3.4 *Bad Faith*

3.4.1 Paragraph 4.1(b) of the CDRP requires that the complainant establish on a balance of probabilities that the Registrant has registered the domain name in bad faith .

3.4.2 Paragraph 3.7 of the CDRP provides three possible ways in which bad faith may be inferred: 1) if the Respondent “registered the domain name . . . primarily for the purpose of sale to the Complainant . . . or a competitor . . .”, 2) if the Respondent “registered the domain name . . . to prevent the Complainant from registering the mark in a trade name, or 3) if the Respondent “registered the domain name . . . for the purpose of disrupting the business of the Complainant.”

3.4.3 In my view, having regard to the total lack of any evidence of any legitimate interest in the name on the part of the Respondent, and that the domain name contains a unique coined word, and the failure of the Respondent to reply to the Complaint, the only reasonable inference is that the Respondent was aware of the existence of the Complainant’s use before registering the domain name in question, and was at the time of registration guilty of at least one of the three tests for bad faith, if not all three. The failure of the Respondent to respond to the Complainant after being told that the Complainant had a subsisting trade-mark, and after the Respondent had undertaken to make enquires, is further justification of this inference.

4 **FORMAL ORDER**

4.1 I hereby order and direct that the domain name in dispute be transferred to the Complainant. I reject the option of a mere cancellation because (a) it is difficult to imagine who could challenge the use by the Complainant and (b) cancellation may encourage others to again try to cyber-squat.



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Hon. Roger Philip Kerans FCIArb
Sole Arbitrator
November 29, 2002
Victoria, B.C., Canada.