

CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number: DCA-711 CIRA
Domain Name: cocacola.ca
Complainant: Coca-Cola Ltd.
Registrant: Amos B. Hennan
Registrar: Can Reg (Infinet Communications Group)
Panel: Stefan Martin
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

PREAMBLE

1. The Canadian Internet Registration Authority (“CIRA”) is responsible for operating the dot-ca Internet country code Top Level Domain (“ccTLD”).
2. This is an administrative proceeding pursuant to the CIRA Domain Name Dispute Resolution Policy, adopted by CIRA and posted on the CIRA website on November 29, 2001 (the “Policy”) and the CIRA Domain Name Dispute Resolution Rules, version 1.1 (the “Rules”).
3. The CIRA Registration Agreement governing dot-ca domain names requires, in virtue of section 3.1 (a)(iv), that the Registrant comply with the Policy throughout the term of the registration agreement. Paragraph 3.1 of the Policy requires that the Registrant submit to this dispute resolution proceeding.
4. The British Columbia International Commercial Arbitration Centre (“BCICAC”) is a recognized service provider pursuant to the Policy.

THE PARTIES

5. The Complainant is Coca-Cola Ltd., situated at 42 Overlea Boulevard, Suite 100, Toronto, Ontario.
6. The Registrant is Amos B. Hennan, situated at 34314 Marshall Rd, Abbotsford, British Columbia.

THE DOMAIN NAME AND REGISTRAR

7. The Domain Name that is the subject of this proceeding is “cocacola.ca”.
8. The Registrar of the Domain Name is Can Reg (Infinet Communications Group).
9. The Domain Name was registered by the Registrant on November 8, 2000.

PROCEDURAL HISTORY

10. According to the information provided by BCICAC, the dispute resolution service provider, the history of this proceeding is as follows:
 - (a) On June 17, 2003, the Complainant filed a complaint regarding the Domain Name with BCICAC.
 - (b) On July 10, 2003, after having determined that the complaint was in administrative compliance with the requirements of the Policy and the Rules, the BCICAC delivered a copy of the complaint to the Registrant.
 - (c) The Registrant failed to provide a response to the complaint as set out in Paragraph 5 of the Rules.
 - (d) The complaint was filed in English, which is the language of this proceeding in accordance with Paragraph 10.1. of the Rules.
 - (e) In the absence of a response, the Complainant has elected, under Paragraph 6.5 of the Rules, to convert from a panel of three arbitrators to a single Panel.
 - (f) Mr. Martin has delivered to the BCICAC the required Statement of Impartiality and Independence, as required by Paragraph 7 of the Rules.
 - (g) Absent exceptional circumstances, the Panel was required to deliver its decision on October 21, 2003.
11. The Panel finds that it was properly appointed in accordance with the Policy and the Rules.
12. Based upon the information provided by the BCICAC, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding were met.
13. The Complainant was represented by legal counsel throughout this proceeding. The Respondent was not represented by legal counsel.

14. On October 17, 2003, pursuant to paragraph 11.1 of the Rules, the Panel issued a procedural order requesting further evidence regarding the Domain Name registration date. Pursuant to paragraph 9.1 of the Rules, the Panel ordered that the date for the issuance of this decision be postponed to October 28, 2003.
15. On October 17, 2003, the Complainant provided its response to said request through its attorneys.

FACTUAL BACKGROUND

16. The Panel proceeds on the basis of the following facts, which are established by the evidence submitted by the Complainant:
 - (a) The Complainant is Coca-Cola Ltd.
 - (b) The Registrant is Mr. Amos B. Hennan, an individual residing in Abbotsford, British Columbia, Canada.
 - (c) On November 8, 2000, the Registrant registered the domain name cocacola.ca.
 - (d) By letter dated December 4, 2000, the Complainant gave notice to the Registrant of the Complainant's objection to the registration of the Domain Name cocacola.ca.
17. The Complainant contends as follows:
 - (a) The Complainant is the owner of the following registered trademarks:
 - COCA-COLA: TMDA 055268
 - COCA-COLA: TMA 356,071
 - COCA-COLA: TMA 384,430
 - COCA-COLA: TMA 396,492
 - COCA-COLA: TMA 460,606

and that the Domain Name is confusingly similar to the Complainant's corresponding trademarks.

- (b) The Registrant has no legitimate interest in the Domain Name because:
 - (i) the Registrant has no rights in the marks;
 - (ii) the Domain Name is not clearly descriptive;
 - (iii) the Domain Name is not a generic name;

- (iv) the Domain Name has not been used in association with a non-commercial activity;
 - (v) the Domain Name is not the name or surname of the Registrant; and
 - (vi) the Domain Name is not a geographical name.
- (c) The Registrant registered and is using the Domain Name in bad faith because the Registrant registered the Domain Name to prevent the Complainant from registering its marks as domain names, and has engaged in a pattern of doing so.
18. The Registrant, as previously mentioned, did not respond to the complaint.

DISCUSSION AND FINDINGS

JURISDICTION OVER THE PARTIES

19. The Complainant, Coca-Cola Ltd., has a principal office and place of business in Toronto and therefore satisfies the CIRA Canadian Presence Requirement for Registrants.
20. Furthermore, the evidence submitted by the Complainant establishes that the Complainant is the owner of various trademarks registered in Canada which are Marks pursuant to Section 3.2(c) of the Policy and therefore the Complainant is an Eligible Complainant in accordance with Section 1.4 of said Policy.

EFFECT OF FAILURE OF REGISTRANT TO FILE A RESPONSE

21. Section 5.8 of the Rules provides that:

“If Registrant does not submit a Response within the period for submission of a Response or any period extended pursuant to Paragraph 5.4 or 5.6, the Panel shall decide the proceedings on the basis of the Complaint.”

22. However, as stated in *Browne & Co. Ltd. v. Bluebird Industries* (CIRA Decision N° 00002):

“This requirement does not preclude the Panel from assessing the integrity and credibility of the evidence as disclosed in the Complaint.”

23. In the present case, the Panel does not see any reason to question the integrity and credibility of Complainant's evidence.

APPLICABLE LAW

24. Pursuant to Section 12.1 of the Rules, the Panel shall apply the laws of Ontario, or if the Registrant is domiciled in Quebec, the laws of Quebec, or, if a preference for the laws of another province or territory has been indicated by both parties, the laws of the other province or territory and, in any event, the laws of Canada applicable therein.
25. The Registrant is domiciled in British Columbia. The Complainant has not stated a preference for any applicable law and therefore the Panel will render its decision in accordance with the Policy, the Rules and any rules and principles of law applicable in the Province of Ontario and the laws of Canada applicable therein.

OVERVIEW OF THE POLICY

26. Paragraph 4.1 of the Policy sets forth the Complainant's burden of proof in order to succeed in the proceeding. The onus is on the Complainant to 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.

The Complainant must also provide some evidence that:

- (c) the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.6.

CONFUSING SIMILARITY BETWEEN DOMAIN NAME AND COMPLAINANT'S MARKS

27. The Complainant asserts that the Domain Name is "Confusingly Similar" to one or more of the Complainant's corresponding Marks, namely:
- COCA-COLA: TMDA 055268
 - COCA-COLA: TMA 356,071
 - COCA-COLA: TMA 384,430
 - COCA-COLA: TMA 396,492
 - COCA-COLA: TMA 460,606

28. The Complainant has provided sufficient evidence to demonstrate that it has registered the above-mentioned Marks in Canada and that said registrations are still in force.
29. In this regard, the Complainant has Rights in the Marks pursuant to paragraph 3.3 of the Policy.
30. Paragraph 3.4 of the Policy provides a definition of “Confusingly Similar”, and it reads as follows:

“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.”

31. In applying this definition, it is important to note that Paragraph 1.2 of the Policy provides that for the purpose of the Policy, a domain name means:

“For the purposes of this Policy, "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.”

32. The test to be applied is one of first impression and imperfect recollection (*Government of Canada v. Bedford*, May 27, 2003, p. 15) :

“Accordingly, for each Domain Name the Complainant must prove on a balance of probabilities that a person, on a first impression, knowing the Complainant’s corresponding mark only and having an imperfect recollection of it, would likely mistake the Domain Name (without the .ca suffix) for Complainant’s corresponding mark based upon the appearance, sound or the ideas suggested by the Mark.”

33. The cocacola.ca Domain Name, without the dot-ca suffix, is identical to Complainant’s Marks, except for the omission of the hyphen in between the terms “coca” and “cola”. However, the absence of punctuation marks is irrelevant to the evaluation of the similarity between a domain name and a trademark. (*Canadian Broadcasting Corporation / Société Radio Canada v. William Quon*, April 8, 2003; Dispute No. DCA 681-CIRA).

34. Accordingly, the Panel finds that the cocacola.ca Domain Name is Confusingly Similar, within the meaning of Paragraph 3.4(b) of the Policy, to the Complainant's Marks.

NO LEGITIMATE INTEREST IN THE DOMAIN NAME

35. Paragraph 4.1(c) of the Policy requires that the Complainant provide some evidence that the Registrant has no legitimate interest in the Domain Name.
36. The Complainant has provided sufficient evidence that the Domain Name was not associated with any active website and has therefore satisfied its burden under Paragraph 4.1(c) of the Policy. (*Canadian Broadcasting Corporation / Société Radio Canada v. William Quon*, April 8, 2003; Dispute No. DCA 681-CIRA, p. 13).
37. Accordingly, it is incumbent upon the Registrant to provide evidence that he had a legitimate interest in the Domain Name.
38. Paragraph 3.6 of the Policy sets forth an exhaustive list of criteria for determining whether a registrant has a legitimate interest in a domain name. It reads as follows:

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 was 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 Registrant includes, but is not limited to, use to identify a web site.

39. Since the Registrant has failed to provide a response to the Complaint, the Panel is limited to reviewing correspondence exchanged between the parties and submitted by the Complainant.
40. The evidence demonstrates that the Registrant has never used the Domain Name in connection with or in relation to any wares, services or business. Therefore, the Registrant cannot rely on any of the "legitimate interests" listed in subparagraphs 3.6(a), (b) and (c) of the Policy.
41. Furthermore, "cocacola" is not the legal name, surname or other reference by which the Registrant was commonly identified and therefore the Registrant cannot invoke subparagraph 3.6(e) of the Policy.
42. Finally, the evidence further demonstrates that the Registrant has never used the Domain Name in association with a non-commercial activity, and therefore he cannot avail himself of the provisions of subparagraphs 3.6(d) and (f) of the Policy.
43. In this regard, it is clear that Registrant has no legitimate interest in the Domain Name cocacola.ca.

BAD FAITH REGISTRATION

44. Paragraph 3.7 of the Policy sets forth an exhaustive list of criteria for determining whether a Registrant registered a domain name 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.

45. The Registrant's purpose in registering the Domain Name may be determined by common sense inferences from the Registrant's conduct and other surrounding circumstances. (*Canadian Broadcasting Corporation v. Quon* (April 8, 2003; Dispute No. DCA 681-CIRA); *Government of Canada v. Bedford* (May 27, 2003, p.24)).
46. The Panel notes that:
- (a) on July 5, 2001, the Registrant offered to sell the Domain Name to the Complainant for the sum of \$10,000 (E-mail sent by the Registrant to the Complainant on July 5, 2001, Complaint, Exhibit L);
 - (b) the Domain Name is not associated with any active website;
 - (c) the Coca-Cola Trademarks are so well known that it is inconceivable that the Registrant was not aware of them at the time he registered the Domain Name (Complaint, Exhibit M);
 - (d) Registrant agreed to deregister the Domain Name (Complaint, Exhibits F, H and J) but failed to follow through on his undertaking.

47. The Panel therefore concludes that the Registrant did register the Domain Name in bad faith.

CONCLUSION AND DECISION

48. The Complainant has proven, on a balance of probabilities, that the 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”, as such terms are defined in the Policy.
49. The Complainant has adduced some evidence that the Registrant has no legitimate interest in the Domain Name, as described in paragraph 3.6. The Registrant, having decided not to file a response, has obviously not proven, on a balance of probabilities, that he has a legitimate interest in the Domain Name, as described in paragraph 3.6.
50. Finally, the Complainant has also proven, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith as described in Paragraph 3.7 of the Policy.
51. For these reasons, the complaint regarding the Domain Name is successful and the Panel orders and directs that the registration of the domain name cocacola.ca be transferred to the Complainant.

Stefan Martin

Date: October 28, 2003