

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

Between

Diners Club International Ltd.

Complainant

And

Planet Explorer Inc.

Respondent

AWARD

Introduction

1. This is an domain dispute pursuant to the pursuant to the Canadian Internet Registration Authority (CIRA) Domain Name Dispute Resolution Policy (CDRP) of the Province of British Columbia, Canada (the “Province”), which took place at the city of Vancouver in the Province in accordance with the Canadian Internet Registration Authority (CIRA) Domain Name Dispute Resolution Policy (CDRP) of the British Columbia International Commercial Arbitration Centre (the “Centre”).

The Parties

2. The Claimant, Diners Club International Ltd., is a corporation in Chicago, Illinois, United States of America.

3. The Respondent is a Canadian corporation registered to do business in British Columbia with a Post Office Box address in Victoria, British Columbia.

4. The domain names in dispute are DINERS-CLUB.CA DINERSCARD.CA and the Registrar of Record for the subject domain names at the time of the Complaint was filed was Webnames.ca (UBC Research Enterprises Inc.).

Background

5. The following information derives from the Complaint.

6. The Complainant licenses to banks and financial institutions around the world, including the Diners Club business unit of Citibank Canada (“Diners Club Canada”), the right to issue credit cards under the trade-mark DINERS CLUB which are referred to worldwide as the DINERS CLUB credit cards. Under the licence agreement between the Complainant and Diners Club Canada, Diners Club International has direct control of the character and quality of all products and services offered by Diners Club Canada in association with the trade-marks DINERS CLUB and DINERS CLUB INTERNATIONAL.

7. The Complainant is the owner of Canadian registered trade-mark no. TMA174,910 for the trade-mark DINERS CLUB which is used by the Complainant in association with the services listed above.

8. The trade-mark DINERS CLUB was registered in the Canadian Intellectual Property Office (CIPO) under registration No. TMA174,910 on March 12, 1971, which is prior to the date of registration of both the subject domain names. The aforesaid registration is in good standing.

4. DINERS CLUB is a “Mark” pursuant to paragraph 3.2(c) of the CIRA Domain Name Dispute Resolution Policy (“the Policy”) and the Complainant has Rights in the Mark pursuant to paragraph 3.3(b) of the Policy.

5. All use of the trade-marks DINERS CLUB and DINERS CLUB INTERNATIONAL by Diners Club Canada ensures to the benefit of the Complainant.

6. The Complainant’s licensee Diners Club Canada extensively has used the trade-mark DINERS CLUB in Canada since 1953, the year when it first introduced the DINERS CLUB

credit card in Canada. At present, Diners Club Canada has hundreds of thousands of business relationships with Canadian consumers, corporations and merchants. Canadian cardholders of the DINERS CLUB credit card spend an average of \$12,750 annually using their DINERS CLUB credit card, which is one of the highest spending amounts in the Canadian credit card industry.

7. During the past three years alone, Diners Club Canada has spent between \$8-\$9M each year in Canada marketing the DINERS CLUB credit card of which approximately \$2.5M annually has been specifically dedicated to advertising. Advertisements for the DINERS CLUB credit card have been featured in various Canadian publications including the following:

- enRoute;
- Canadian Business;
- Report on Business Magazine (R.O.B.); and
- Where Vancouver.

8. The DINERS CLUB credit card is accepted in establishments from coast to coast in Canada, including all lodging chains in Canada, all car rental chains in Canada, all airlines in Canada, a number of restaurant chains and independent restaurants in Canada, a number of retail stores and chains in Canada, and the majority of gas and service stations in Canada.

9. DINERS CLUB is also a “Mark” pursuant to paragraph 3.2(a) of the CIRA Domain name Dispute Resolution Policy (“the Policy”),

10. The domain name DINERS-CLUB.CA was approved for registration on July 24, 2003.

11. The domain name DINERSCARD.CA was approved for registration on July 29, 2003.

12. The domain name DINERSCARD.CA, is not associated currently with any web site. The domain name DINERS-CLUB.CA is associated with a web site.

13. In addition to being the owner of the subject domain names the Respondent is also the owner of the Chinese domain name DINERS-CLUB.CN.

14. The Respondent was the former owner of the domain name DINERS-CLUB.NET.

16. The Respondent is not a licensee of the Complainant and it not otherwise authorized to use the Complainant's trade-mark DINERS CLUB. The terms DINERS-CLUB and DINERSCARD are not the subject of any trade-mark registrations or applications in which the Respondent has rights. The subject domain names are not the name of any business belonging to the Respondent and are not identified with the Respondent.

17. The Respondent is engaged in a commercial dispute with the Complainant and uses the site to which the domain name DINERS-CLUB.CA resolves for the purposes of that dispute.

18. The Respondent is a Canadian corporation registered to do business in British Columbia and claims to carry on business as a "Wilderness Tour Operator offering high quality adventures in Canada and many other destinations around the world".

19. It is apparent from the web site to which the domain name DINERS-CLUB.CA resolves that the Respondent had prior knowledge of the Complainant's Mark at the time of registration of the subject domain names. The administrative contact for the Respondent admits in its web site that it was a former DINERS CLUB cardholder.

20. The title bar of the DINERS-CLUB.CA web site states "Welcome to Diners Club".

21. The Respondent was the former owner of the domain name DINERS-CLUB.NET which was the subject of the National Arbitration Forum decision of *Diners Club International Ltd. v. Infotechnics Limited, supra*. The Respondent was found in default in that proceeding and the domain name was transferred to the Complainant after a showing of the Respondent's bad faith. In that proceeding, the Respondent filed an "Additional Statement of Respondent Pursuant to Rule 7 of the National Arbitration Forum Supplemental Rules". This document was not considered by the Panel because it was out of time. In the document, the Respondent to the present dispute claimed to be the true and correct owner of the domain name DINERS-CLUB.NET.

22. The web site at www.diners-club.net contained similar content to that which is currently contained at the web site to which the domain name DINERS-CLUB.CA resolves.

23. The web page to which the domain name DINERS-CLUB.CA resolves contains strong criticism of the Complainant. The Complainant considers it to be "... insulting, accusatory, abusive and intimidating towards the Complainant and the employees of the Complainant's Canadian licensee".

24. On the web site to which the subject domain name DINERS-CLUB.CA resolves, it is alleged by the Respondent that the Respondent's merchant account was cancelled by the Complainant. It is also alleged that the Respondent has "initiated legal proceedings against Citibank and Diners Club for breach of contract".

25. The web site to which the domain name DINERS-CLUB.CA resolves appears to be used as a vehicle to elicit support for a class-action against the Complainant. It states:

"We are in the process of gathering information from individuals and companies whom have experienced similar issues with Diners Club International, in any country. The purpose is to launch a class action lawsuit in order to force some corporate governance onto Citigroup. [CONTACT US TODAY!]"

26. The following information derives from the Defence.

27. The Respondent uses the subject domain name to criticize the Complainant.

28. The meta tags for the subject domain names were set up to be different from the information on the Complainant's official web sites. More specifically, they include the words "Breach", "Contract" and "Violation". Only a consumer specifically typing these words in association with the terms "Diners" and "Club" on a search engine would be directed to the Registrant's sites.

29. The title of the Respondent's web sites is "Diners Club Warning", making it clear for any consumer that he is not accessing the official Diners Club web site.

30. There is no reference to the Complainant's logos, colours or designs. Instead, a large "WARNING" sign in red block letters is displayed on the first page of the Respondent's web sites.

31. The content on the web site Diners-Club.net was fundamentally different from the content of the web site to which the domain name DINERS-CLUB.CA resolves. Subsequent to the UDRP decision, the design of the Respondent's web site was changed completely to avoid any confusion with the official site of the Complainant.

32. The purpose of the web site to which the domain name DINERS-CLUB.CA resolves is: (1) to warn existing and potential customers of the Complainant about the Complainant's practices, and (2) to gather support for a class action lawsuit.

33. No offer to sell the Respondent's web sites to the Complainant has been made or considered. There is no evidence that the domains in dispute were acquired for the purpose of being sold or transferred to the Complainant for valuable consideration.

34. The Respondent has registered many domains around the world in order to ensure its right to criticize the Complainant.

35. No revenue is generated through the web site to which the domain name DINERS-CLUB.CA resolves.

36. The Respondent provided details of its dispute with the Complainant.

37. The Respondent claims costs.

Discussion and Conclusions

Identical or confusingly similar

38. The Complainant relies on its use and registration of the words "Diners Club". The domain name DINERS-CLUB.CA differs from the Complainant's mark only by the addition of a dash and .ca, both of which are inconsequential. It is identical to the Complainant's mark

39. The domain name DINERSCARD.CA incorporates the word “Diners”, but adds the word “card”. The Complainant's business is centred on its credit card. The objective of the Respondent is to attract users to a web site that criticizes the Complainant.

40. The inquiry is not whether a web site to which as domain name resolves will confuse users. The issue is whether the domain name is confusingly similar to a mark of a complainant. In this case, the domain name DINERSCARD.CA clearly is confusingly similar.

41. The Administrative Panel is satisfied that the Complainant has met the requirements of the Policy.

Legitimate interest

42. The Respondent contends that it has a legitimate interest in the subject domain names because they are used to criticize the Complainant and to obtain support for a class action against the Complainant. It is clear that the law recognizes these activities as legitimate.

43. The Respondent provides details of its complainants against the Complainant. The Complainant states that the Respondent goes beyond the bounds of permissible criticism.

44. A domain name dispute usually is not a forum for the resolution of disputed factual issues.

45. It is clear that the use of a domain name or a mark for criticism is legitimate. The issue often is the extent to which the use encroaches on the proprietary rights of the complainant.

46. Criticizing domain names in which respondents have been found to have a legitimate interest, generally contain language that identifies the domain name as being used for criticism. Domain names which merely use the mark of another have not been upheld. The same analysis has been applied to fan-club use.

47. The owner of a mark is entitled to decide who and how its mark will be used insofar as the mark is being used without qualification in relation to the Respondent or its commercial activities.

48. Again, the focus of the inquiry is not on the web site to which the domain name resolves or the information, disclaimers etcetera at that site. The issue is whether the unqualified use of mark in relation to its owner or its owner's commercial activities is legitimate. It is not.

49. This conclusion does not limit the ability to criticize. It is not a question of free speech. It is a question of the scope or nature of the use of the property of another.

50. The Administrative Panel is satisfied that the Complainant has met the requirements of the Policy.

Bad faith

51. Having determined that the Respondent does not have a legitimate interest in the subject domain names, the Administrative Panel makes no finding concerning the allegation of bad faith.

Decision

52. Based on the information provided to it and on its findings of fact, the Administrative Panel concludes that the Complainant has established its Complaint.

53. The Complainant seeks the transfer to it of the subject domain names. The Administrative Panel so orders.

54. The Respondent's application for costs is dismissed.

Made at the City of Vancouver, in the Province of British Columbia, Canada this day of
February 2004.

Edward C. Chiasson Q.C.,

Roger Kerans

David Haigh