

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

Dispute Number: 00018  
Complainant: AMAZON.Com INC.  
Registrant: David Abraham  
Disputed Domain Names: AMZON.CA  
AMAMZON.CA  
AMAZZON.CA  
AMAZN.CA  
AMAZONS.CA  
Registrars: DomainsAtCostCorp. for AMZON.CA  
Tucows.com Co. for AMAMZON.CA, AMAZZON.CA  
AMAZN.CA, and AMAZONS.CA  
Panellists: Mr. John Lee, M. Hugues G. Richard, and  
Mr. R. John Rogers (Chair)  
Service Provider: British Columbia International Commercial Arbitration  
Centre (the “BCICAC”)  
BCICAC File Number: DCA-784-CIRA

The Complainant is a well known Internet marketer of goods and services and one of the first businesses to recognize the value of Internet commerce. In 1995 it created a website under the domain name AMAZON.COM permitting consumers from around the world to purchase books on-line. Since then, it has grown its business to include six global websites: [www.amazon.com](http://www.amazon.com), [www.amazon.co.uk](http://www.amazon.co.uk), [www.amazon.de](http://www.amazon.de), [www.amazon.fr](http://www.amazon.fr), [www.amazon.co.jp](http://www.amazon.co.jp) and [www.amazon.ca](http://www.amazon.ca). Worldwide net sales through these websites in 2003 were US \$5.264 billion. Since 1996 the Complainant has spent over US \$243 million on advertising its business and services, all of which advertising prominently displays one or more of the Complainant’s trade-marks.

The Complainant registered the trade-marks (collectively the “AMAZON Marks”) AMAZON (TMA590,443), AMAZON.CA (TMA597,845), and AMAZON.COM (TMA499,121) in the Canadian Intellectual Property Office on September 22, 2003, December 17, 2003 and August 25, 1998, respectively.

On May 25, 2004, the Complainant filed a complaint against the Registrant with the BCICAC seeking that the Registrant’s right to ownership of the disputed domain names (“Disputed Domain Names”) be arbitrated in accordance with CIRA’s Domain Name Dispute Resolution Rules (the “Rules”) and that an order be made pursuant to the Policy that the registrations of the Disputed Domain Names be transferred to 626664 B.C. Ltd. as a nominee of the Complainant.

The complaint filed by the Complainant was reviewed by the BCICAC and found to be in administrative compliance with the Policy and the Rules in accordance with the provisions of Rule 4.2. By letter and email dated May 27, 2004, the BCICAC as dispute resolution service provider so advised the parties and forwarded by express post and email a copy of the Complaint to the Registrant for his response. The Registrant has not responded to the Complaint within the 20-day time period within which the Registrant's response is to be filed pursuant to Rule 5 of the Rules. The BCICAC has advised the Panel that its subsequent attempts at communication with the Registrant have not been successful.

By letter dated July 7, 2004, the BCICAC acting in accordance with Paragraph 6 of the Rules named the Panel for this arbitration. As the Complaint was filed in English and as the Registrant has not responded, the BCICAC by this letter designated English as the language of the proceeding.

### **LACK OF RESPONSE**

Paragraph 2 of the Rules deals extensively with the form of communication among the complainant, the registrant, and the service provider authorizing communication by facsimile, by prepaid postal or courier service, or electronically via the Internet. In all instances, confirmation of transmission is required.

Rule 2.10 specifically deals with the situation where a registrant does not respond to a complaint. This Rule provides that in such an instance, all communication to such registrant shall be sent to the registrant at the email address of the registrant's administrative contact listed in the information of record regarding a domain name registration in the WHOIS database of the top level domain name registry operated by CIRA (the "Registration Information").

Where there is no such email address provided in the Registration Information, Rule 2.10(d) specifies that all such communication should be sent to the facsimile address of the registrant's administrative contact as set out in the Registration Information. In the situation where there is neither an email address nor a facsimile address, Rule 2.10 (e) provides that all such communication should be sent to the postal address for the registrant in the Registration Information on the date the complaint was submitted to the service provider.

In the matter at hand, as there is no facsimile address listed for the Registrant in the Registration Information for the Disputed Domain Names, the BCICAC has attempted to communicate with the Registrant using both the email address and the postal address provided for in the Registration Information. The Registrant has not responded to any of these attempts. A hard copy of the Complaint was delivered to the Registrant by express post with delivery confirmed. The BCICAC attempted without success to contact the Registrant by telephone at the telephone number listed for the Registrant in the Registration Information and was unable to do so. The BCICAC tried and failed to find a new telephone number for the Registrant.

Despite its lack of success in communicating with the Registrant, we are satisfied that the BCICAC has properly attempted to contact the Registrant in accordance with the Rules.

It is always difficult for a Panel to proceed where a Registrant has not responded to a complaint found to be compliant with Rule 4.2. In such instances, the Panel is entirely dependent upon the Complainant's submission.

However, a Registrant should not be able to subvert the dispute resolution process by simply refusing to respond to a complaint or by refusing or neglecting to provide email or postal addresses or current telephone or facsimile numbers.

Rule 5.8 anticipates such a situation occurring. This Rule provides that the Panel shall decide the matter on the basis of the complaint as submitted by the complainant in the event that a registrant does not submit a response within the period for submission. It is noted that the provisions of Rule 5.8 are not permissive. They are mandatory. That is, Rule 5.8 does not grant the Panel the discretion to determine whether or not to proceed. This Rule provides that the Panel *shall* proceed on the basis of the complaint where no response has been filed by the registrant.

We find that the provisions of Rule 5.8 apply to the matter at hand.

### **FACTS**

According to the complaint, the Complainant has operated a website under the domain name AMAZON.CA since June 25, 2002 for the purpose of selling books, computer games, compact discs, DVD's, gifts and the like. Sales figures for this website since its inception exceed CDN \$30 million. Although we do not have evidence before us as to the precise registration date of all of the Disputed Domain Names, we are satisfied that the Registrant knew or should have known of the existence of the Complainant's interest in the AMAZON Marks prior to the registration of the Disputed Domain Names.

All of the Disputed Domain Names are misspellings of the word AMAZON with the exception of AMAZONS.CA which adds an "s" to the word. The Registrant previously participated in the Complainant's Associates Program (the "Associates Program") whereby the Registrant earned referral fees for sales to third parties who were referred to websites owned by the Complainant through websites operated by the Registrant. It would appear that customers wishing to access one of the websites operated by the Complainant and who incorrectly typed in the domain name for the Complainant's website would end up on one of the websites run by the Registrant having a URL consisting of one of the Disputed Domain Names. These websites containing one of the Disputed Domain Names would then direct the potential customer to the Complainant's website and the Registrant would claim a referral fee.

Unfortunately for the Registrant, the Associate's Program specifically prohibited from participating in the referral program websites that included any letter additions to the word "amazon" or misspellings of the AMAZON Marks. When the Complainant became aware of the existence of the use being made of the Disputed Domain Names by the Registrant, it refused to pay the Registrant any further referral fees for the websites using these domain names, notified the Registrant of this fact and its belief that the disputed names violated the Complainant's legal rights under the AMAZON Marks, and subsequently filed this Complaint.

## **REASONS**

Paragraph 4.1 of the Policy places the onus on the Complainant to prove on a balance of probabilities that the Disputed Domain Names are confusingly similar to the AMAZON Marks and that the Registrant has registered the Disputed Domain Names in bad faith. In addition, the Complainant is required under this paragraph to provide “some evidence” that the Registrant has no legitimate interest in the Disputed Domain Names.

### **Confusingly Similar**

To address firstly the question as to whether the Disputed Domain Names are confusingly similar to the AMAZON Marks.

The evidence before us shows that the Complainant has been using at least one of the AMAZON Marks in carrying on Internet commerce since 1995. We have before us evidence of the registration particulars of only one of the Disputed Domain Names, AMZON.CA, which was approved on 2002/07/01. This is clearly well after the Complainant starting using some or all of the AMAZON Marks.

Paragraph 3.4 of the Policy provides that a domain name is confusingly similar to a trade-mark if the domain name so nearly resembles the trade-mark in appearance, sound or the ideas suggested by the trade-mark as to be likely to be mistaken for the trade-mark. Stated another way, the test is whether the average Internet user with an imperfect recollection of the AMAZON Marks who wishes to access a website operated by the Complainant either by entering a domain name including one of the AMAZON 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 Names (see *Great Pacific Industries Inc. v. Ghalib Dhalla* CIRA Dispute Number 00009 (April 21, 2003), pp. 20-21)

In the matter at hand, it would appear that the purpose for the Disputed Domain Names was to attract potential customers of the Complainant who were attempting to access websites whose names included the AMAZON Marks. That the Registrant was successful in attracting such referrals whether it was through typing errors or through misspellings clearly demonstrates that the Disputed Domain Names are confusingly similar to the AMAZON Marks. Nor do we believe the addition of the letter “s” to the word “amazon” sufficient to distinguish the Disputed Domain Name AMAZONS.CA in appearance, sound or idea suggested from the AMAZON Marks.

We therefore find that the Complainant has proven on a balance of probabilities that the Disputed Domain Names are confusingly similar to the AMAZON Marks and that the Complainant therefore satisfies the onus placed on it by clause (a) of Paragraph 4.1 of the Policy.

### **Bad Faith Registration**

The second onus of proof that the Complainant has to overcome is to demonstrate that the Registrant has registered the Disputed Domain Names in bad faith. Paragraph 3.7 of the Policy enumerates three tests to determine whether or not such bad faith does exist. The wording of this Paragraph 3.7 is exhaustive providing that “if, and only if” a Panel finds that the action of a

registrant meets any one of these tests that the registrant will be considered to have registered a domain name in bad faith.

#### Registration Primarily for Alienation

The first of these tests is whether a registrant registered the domain name primarily for the purpose of generating revenue from the domain name by means of selling or otherwise alienating it to the complainant or a competitor of the complainant at a cost in excess of the registrant's actual costs in registering or acquiring the domain name.

The evidence before us suggests that the purpose of the Registrant registering the Disputed Domain Names was not to alienate the Disputed Domain Names to the Complainant, but to generate referral revenue from the Complainant by directly potential customers of the Complainant to the Complainant's websites. Indeed, evidence submitted by the Complainant showed that as of December 5, 2003 there appeared to be thirty domain names apart from the Disputed Domain Names registered with CIRA by the Registrant. All but one of these thirty domain names would appear to be misspellings of famous and mostly Internet commerce related trade-marks such as eBay, Expedia, Travelocity and Office Depot.

Although it is possible that one of the purposes for the Registrant registering the Disputed Domain Names was to generate revenue from them by means of alienating them to the Complainant, we find that the Registrant did not register the Disputed Domain Names *primarily* for the purpose of generating revenue from them by selling or otherwise alienating them to the Complainant. This first test therefore, does not apply.

#### Registration to Prevent Registration

The second test is whether the Registrant registered the Disputed Domain Names in order to prevent the Complainant, or the Complainant's licensee of the AMAZON Marks, from registering the AMAZON Marks as domain names. The evidence before us is that the Complainant has registered the AMAZON Marks as domain names. Therefore, this second test does not apply.

#### Registration to Disrupt Business

The third test is whether the Registrant registered the Disputed Domain Names primarily for the purpose of disrupting the business of the Complainant who is a competitor of the Registrant.

The evidence before us is that initially the primary business of the websites using the Disputed Domain Names was to attract potential customers of the Complainant. These potential customers of the Complainant could then be directed on to the Complainant's websites and the Registrant would earn a referral fee. There is no doubt that the Registrant was well aware of the existence of the Complainant, its business model and its reputation when he registered five misspellings of the Complainant's name as the Disputed Domain Names. It is clear that he intended to take advantage of the reputation of the Complainant and the goodwill associated with the AMAZON Marks by exploiting the Internet traffic that was intended for the domain name corresponding to the correct spelling of the applicable AMAZON Mark, but that found its way to the site associated with the misspelled domain name due to a typing error.

The evidence before us shows that once the Complainant refused to pay the referral fees sought by the Registrant, that the Registrant ceased sending on customers to the Complainant's websites and directed this Internet traffic to other sites.

Therefore, although the Registrant is not competing with the Complainant by attempting to sell goods and services similar to those offered by the Complainant, the Registrant is clearly competing with the Complainant for Internet traffic.

This conclusion is further reinforced by the fact that the Registrant did not register one misspelling of the applicable AMAZON Marks as a domain name, but five such registrations. With the additional thirty domain names registered by the Registrant with CIRA clearly being misspellings of famous trade-marks, it is obvious that the Registrant is engaged in the business which has become known as "typo-squatting" or "typo-piracy". His business is to attract Internet traffic to his websites and by referring this traffic on to websites such as those owned by the Complainant, to generate referral fees. By carrying on this business through the websites named with the Disputed Domain Names, the Registrant was clearly competing with the Complainant and disrupting its business.

We find that the Registrant registered the Disputed Domain Names primarily for the purpose of disrupting the business of the Complainant who was a competitor of the Registrant.

We therefore find that the Complainant has satisfied the onus of demonstrating that the Registrant registered the Disputed Domain Names in bad faith as required by Paragraph 3.7 of the Policy.

### **Legitimate Interest of Registrant**

The third hurdle facing a complainant in Paragraph 4.1 is that the complainant must provide some evidence that the registrant has no legitimate interest in the disputed domain name.

Again an exhaustive test is applied in Paragraph 3.6 which provides that a registrant has a "legitimate interest" in a domain name "if, and only if" before a complaint is filed, the domain name in question meets the criteria of one or more of six tests.

#### Use of a Mark.

The first test set out in paragraph 3.6 (a) is whether or not the domain name in dispute includes a trade-mark, a trade name, or a certification mark owned by the registrant and that such was used in good faith by the registrant. There is no evidence before us the Registrant owned any such interest in the Disputed Domain Names.

#### Use of a Clearly Descriptive Name.

The second test set out in paragraph 3.6 (b) is that the disputed domain name was used by the registrant in Canada in good faith in association with any wares, services or business and that such domain name was clearly descriptive of such wares, services or business. There is no evidence that the Registrant used the Disputed Domain Names in such manner.

#### Use of Generic Name.

The third test is similar to the second. That the domain name was understood in Canada to be the generic name in any language of any wares, services or business of the registrant. There is no evidence that the Disputed Domain Names was a generic name used by the Registrant.

#### Use for Non-Commercial Activity, of a Geographic Location, or of Registrant's Name

The fourth through sixth tests contained in Paragraphs 3.6 (d)-3.6 (f) are that a registrant used the disputed domain name in Canada in good faith in association with a non-commercial activity of the registrant or the geographical name of the location of such non-commercial activity, or that such name comprised the legal name of the registrant or a name with which the registrant is commonly identified.

There is no evidence that these tests were satisfied with respect to the Disputed Domain Names in the matter before us.

We therefore find that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Disputed Domain Names as required by Paragraph 3.6.

#### **Balance of Probabilities**

Even if a complainant has met the burdens of proof contained in Paragraph 4.1, a complaint will be dismissed if the registrant is able to prove on a balance of probabilities that the registrant has a legitimate interest in the disputed domain name. Again, such "legitimate interest" must meet one or more of the six tests set out in Paragraph 3.6 and referred to above.

This balance of probabilities test in Paragraph 4.1 of the Policy deals with the situation where even though a complainant had satisfied all of the burdens of proof contained in Paragraph 4.1, a Panel believes that justice requires the registrant to succeed. In finding against a registrant, the Panel is depriving that registrant of a property interest. Such a decision should not be taken lightly. Therefore, even if a Panel finds that a complainant has satisfied the rather heavy burdens of proof place on it by Paragraph 4.1, if the Panel is satisfied that on a balance of probabilities the registrant has a legitimate interest in the disputed domain name, the Panel must find for the registrant and dismiss the complain

In the case at hand, the Panel is satisfied that on a balance of probabilities, based upon the evidence before it that the Registrant has no legitimate interest in the Disputed Domain Names.

**DECISION AND ORDER**

We find that the Complainant has succeeded in this proceeding initiated under the Policy.

We therefore direct that the registrations of the Disputed Domain Names, namely, AMZON.CA, AMAMZON.CA, AMAZZON.CA, AMAZN.CA, and AMAZONS.CA be transferred to 626664 B.C. Ltd., as a nominee of the Complainant.

Dated this 28<sup>th</sup> day of July, 2004.

“John Lee”

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John Lee

“Hughes Richard”

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Hughes G. Richard

“John Rogers”

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John Rogers, Chair