

**IN THE MATTER OF A COMPLAINT PURSUANT TO THE CANADIAN
INTERNET REGISTRATION AUTHORITY DOMAIN NAME DISPUTE
RESOLUTION POLICY**

Domain Names: disneystore.ca, disneycruises.ca and disneytravelagent.ca

Complainant: Disney Enterprises, Inc.

Registrant: Realm Solutions Inc.

Registrar: BareMetal.com, Inc.

Panel: David Allsebrook (Chair), Myra Tawfik, James Minns

Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. Disney Enterprises, Inc. (the “Complainant”), is a corporation incorporated pursuant to the laws of the State of Delaware, United States of America. Its address is in the State of California, U.S.A.
2. The registrant Realm Solutions Inc. (the “Registrant”) is located in Calgary, Alberta.

B. The Domain Name and Registrar

3. The disputed domain names are disneystore.ca, disneycruises.ca and disneytravelagent.ca (the “Domain Names”). The registrar for the Domain Names is BareMetal.com Inc. (the “Registrar”).

C. Procedural History

4. This is a proceeding under the Canadian Internet Registration Authority (“CIRA”) *Domain Name Dispute Resolution Policy* (Version 1.3) (the “Policy”) and the CIRA *Domain Name Dispute Resolution Rules* (Version 1.5) (the “Rules”).
5. The history of the proceeding as provided by the dispute resolution service provider, Resolution Canada, Inc. (“Resolution Canada”), is that the Complainant filed a complaint against the Registrant with Resolution Canada requesting that the current registration of the Domain Name be transferred to the Complainant.

6. The Amended Complaint is dated October 31, 2019. It was served upon the Registrant by the Service Provider (Resolution Canada).
7. The Panel is advised by Resolution Canada that in response to the Complaint, the Registrant provided the authorization codes to permit the Complainant to transfer the domain name registrations to itself. The Complainant instead elected to have its complaint determined under the Policy. No response has been filed to the Complaint. The Panel is not aware of the Complainant's reasons for not accepting the transfer of the Domain Names. The transfer of the Domain Names is the only relief being sought in the Complaint.
8. The Panel was appointed on December 22, 2019.

D. Panellist Impartiality and Independence

9. As required by paragraph 7 of the Rules, the panellists have submitted to Resolution Canada declarations of impartiality and independence in relation to this dispute.

E. Canadian Presence Requirements

10. Pursuant to paragraph 1.4 of the Policy, a complainant must, at the time of submitting a complaint, satisfy the Canadian Presence Requirements for Registrants published by CIRA. To be eligible to file a complaint and to own a .ca domain name registration, a complainant must satisfy one of the criteria specified in section 2 of the Canadian Presence Requirements for Registrants. The Complainant relies upon paragraph 2(q), which states:

“Trade-mark registered in Canada. A Person which does not meet any of the foregoing conditions, but which is the owner of a trade-mark which is the subject of a registration under the *Trade-marks Act* (Canada) R.S.C. 1985, c.T-13 as amended from time to time, but in this case such permission is limited to an application to register a .ca domain name consisting of or including the exact word component of that registered trade-mark; “

11. Paragraphs 2(a) through 2(p) identify circumstances in which Persons have a qualifying Canadian presence. The final clause of paragraph 2(q) makes it clear that absent such a presence individual trademarks may nonetheless qualify. The Complaint is in effect an application to register the Domain Names because the relief it is seeking is the transfer of the Domain Names to the Complainant.
12. The Complainant is the owner of the registered trademarks DISNEY, THE DISNEY STORE, DISNEY STORE, and DISNEY CRUISE LINE (the “Disney Marks”) in Canada. Particulars of the registrations were provided with the Amended Complaint. The Complaint includes the following the dates for these registrations.

DISNEY

1987

| | |
|--------------------|------|
| THE DISNEY STORE | 1993 |
| DISNEY STORE | 2011 |
| DISNEY CRUISE LINE | 2013 |

13. The next question for the Panel to determine is whether the Domain Names consist of, or include, the exact word component of the registered trademark. In making this analysis the Panel disregards the “.ca” portion of the domain names. Including it would deny the protection of the Policy to most trademarks, denying the benefit of the Policy to Persons who do not otherwise meet the Canadian Presence Requirements.
14. The Panel finds that the domain name disneystore.ca consists of the exact word component of the registered trademark DISNEY STORE. The omission of the space in the domain name does not alter the word component. Internet users are accustomed to adjusting for the omission of spaces when dealing with domain names.
15. The Panel finds that the Domain Names disneycruises and disneytravelagent both include the exact word component “Disney” found in the registered trademark DISNEY. There is no additional distinctive element in the Domain Names.
16. On the basis of the foregoing findings, the Complainant satisfies the Canadian Presence Requirements under paragraph 2(q) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3 in respect of the Domain Names.

F. Factual Background

Allegations of the Complainant:

17. According to the Complaint, “Complainant is a worldwide leading producer of children’s entertainment goods and services such as movies, television programs, books, and merchandise. Complainant also owns and operates world-famous theme parks, hotels, resorts and cruise lines all over the world.” The Complainant states that it and its predecessors in interest have used the Disney Marks continuously for decades for a variety of goods and services and it has established significant goodwill in them for its movies and animated films.
18. The registration for the trademark DISNEY relied upon in the Complaint was made in 1987 for use in respect of the following goods. No services are listed.
 - (1) Chocolate novelties, frozen water novelties, frozen ice cream novelties, frozen ice milk novelties, ice cream sandwiches and frozen confections.
 - (2) Card games.

- (3) Board games.
- (4) Reversible standing chalkboards.
- (5) Dolls.
- (6) Baby boppers, namely rattles, picture stacks and peek in rollers, namely inflatable tube with clear plastic window with printed characters inside.
- (7) Classic book series.
- (8) Record and book combination sets.
- (9) Wallcoverings, namely wallpaper.

19. The Registrant Realm Solutions Inc. was incorporated in Alberta in 1999. At the present time the Registrant redirects the Domain Names as follows: DisneyStore.ca to Complainant's own website; DisneyCruises.ca to random websites, including, but not limited to, Entrepreneur.com and Engadget.com; and DisneyTravelAgent.ca to a landing page which has links to sites related to Complainant's products or services, although not limited to Complainant's goods and services. No history of the use of the Domain Names was provided.

Allegations of the Registrant:

20. The Registrant has not filed a Response.

G. CIRA Domain Name Dispute Resolution Policy

21. Paragraph 4.1 of the Policy requires that the Complainant establish 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;
 - b) (b) the Registrant has registered the domain name in bad faith as described in section 3.5; and
 - c) (c) the Registrant has no legitimate interest in the domain name as described in section 3.4.
22. The Complainant must establish points (a) and (b) above on the balance of probabilities and for point (c) it must provide some evidence that the Registrant has no legitimate interest in the domain name. 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 section 3.4 of the Policy.

H. Analysis

Rights in a Mark

23. Under paragraph 4.1(a) of the Policy, the Complainant has to show, on the balance of probabilities, that it had rights and continues to have rights in a “Mark” prior to the date of registration of the disputed domain name, which may cause the domain name to be mistaken for the Mark. A “Mark” is defined in paragraph 3.2(c) of the Policy to include a trademark, including the word elements of a design mark, that is registered in Canada.
24. For the purposes of determining that the domain name is “Confusingly Similar”, each Domain Name, omitting the “.ca” portion, is compared to the Disney trademarks. According to well-established practice under the Policy, the respective usage is not taken into account; only the domain name and the mark are compared. This comparison shows that the Domain Names and the Complainant’s marks are for all practical purposes identical and therefore Confusingly Similar.

disneystore.ca

25. The domain name disneystore.ca was registered on March 22, 2006. The Complainant registered its trademark THE DISNEY STORE in Canada in 1993. In the opinion of the panel the domain name disneystore.ca could be mistaken for the trademark THE DISNEY STORE, in which the Complainant had rights as of the domain name registration date. The requirements of paragraph 4.1(a) of the Policy are satisfied with respect to disneystore.ca.

disneycruises.ca

26. The domain name disneycruises.ca was registered on March 22, 2005. The pertinent Disney trademarks are DISNEY, registered in 1987, and DISNEY CRUISE LINE, registered in 2013. DISNEY CRUISE LINE was not registered at the relevant time. However, its registration is based upon its having been used in Canada since 1997. In the absence of a Response from the Registrant, the Panel concludes that such use conferred rights in the Mark DISNEY CRUISE LINE in Canada by the time disneycruises.ca was registered eight years later. This conclusion is reinforced by the implicit acknowledgement of these rights by the Registrant’s actions in registering multiple domain names which include the name “Disney” and which names refer to business activities of the kind carried on under the “Disney” name by the Complainant.

27. The Panel further concludes that as the distinctive element “Disney” is identical and the remainder of the trademark and domain name respectively are descriptive or functional elements, a consumer is likely to mistake the two. The requirements of paragraph 4.1(a) of the Policy are satisfied with respect to disneycruises.ca.

disneytravelagent.ca

28. The domain name disneytravelagent.ca was registered on March 14, 2005. The pertinent Disney trademarks are again DISNEY, registered in 1987, and DISNEY CRUISE LINE, registered in 2013 and used in Canada since 1997. There is no suggestion that the Complainant operates a travel agency business or has a registered trademark which refers to travel agency services. As with disneycruises.ca, the Panel concludes that as the distinctive element “Disney” is identical and the remainder of the trademark and domain name respectively are descriptive or functional elements, a consumer is likely to mistake the two. The requirements of paragraph 4.1(a) of the Policy are satisfied with respect to disneytravelagent.ca.

Bad Faith

29. The Complainant must show, on the balance of probabilities, that the domain name was registered in bad faith. Paragraph 3.5 of the Policy lists a number of grounds which constitute bad faith and it must be noted that this list is not exhaustive. It is open to the panel to find other grounds which lead to a conclusion of bad faith conduct.
30. It is the Complainant’s contention that the Registrant knowingly, willfully and in bad faith adopted the Complainant’s Mark as a domain name with the intention of relying on the good-will and reputation enjoyed by the Complainant’s Mark for the purpose of disrupting the business of the Complainant. It invokes paragraph 3.5(c) of the Policy which gives as an illustration of bad faith, that 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.”

disneystore.ca

31. The domain name disneystore.ca was registered on March 22, 2006, over 13 years ago. Bad faith must be established as of the registration date. The domain name presently takes users to the Complainant’s web site. There is no allegation that any other use has ever been made or has been threatened. There is no allegation or evidence that users seeking the Complainant online are being hindered from doing so. On the contrary, users are taken directly to the Complainant’s web site, without qualification or delay.

32. The Complaint says that this redirection supports “the (erroneous) conclusion that any communication with or from the disputed domain name Disneystore.ca is one authorized by the Complainant.” There is no reason to suppose that Internet users give the issue of authorization any thought, or, if they do, that they draw any such conclusion. Even if consumers had been shown to have drawn a conclusion about authorization, consumers’ legal opinions do not confer or withhold actual legal rights. Contrary to what the Complainant implies, any conclusion that authorization is required for every appearance of another’s trademark would be incorrect. One may, for example, lawfully employ another’s trademark to refer to the goods and services of that other, as a genuine description or generic name, or as a surname.
33. The Registrant has done nothing for 13 years to disrupt the business of the Complainant and has done everything necessary to effect a transfer of the registration to the Complainant when the first objection to the registration was received. No inference of intention to disrupt can be drawn from this conduct.
34. To satisfy the bad faith test under paragraph 3.5(c), the Registrant must be a competitor of the Complainant. There is no evidence as to what business the Registrant is in. The Complainant says that the Registrant is a competitor for internet traffic simply by having registered the Domain Names. This interpretation of “competitor” goes far beyond the ordinary meaning of “competitor”, namely one who is competing to sell like goods and services, where each sale made by one is a sale denied to the other competitors. If adopted, the suggested test would always be satisfied by the confusing similarity test, which would have the effect of writing the bad faith test out of the Policy altogether. Even if this test were to be adopted, in this case the Registrant’s domain name traffic is redirected to the Complainant, so the Registrant cannot be said to be competing for traffic so as to exclude the Complainant from it.

disneycruises.ca

35. The domain name disneycruises.ca was registered on March 22, 2005. This is the material date for determining the issue of bad faith. The Complaint alleges that “DisneyCruises.ca is a clear reference to Complainant’s popular cruise business and is similar to Complainant’s DISNEY CRUISE LINE® mark...” and that “The Registrant is confusing consumers to believe, reasonably so, that the Disputed Domain Names are part of Complainant’s portfolio of genuine Canadian websites, thereby disrupting business to Complainant’s Official Websites.”
36. The Complaint alleges that such an opinion is disruptive of the Complainant’s business. As stated above that conclusion is factually speculative and logically tenuous.

disneytravelagent.ca

37. The domain name disneytravelagent.ca was registered on March 14, 2005. The Complaint alleges that “the generic words “Travel Agent” added to the Mark for the disputed domain name DisneyTravelAgent.ca refer to Complaint’s well-known travel businesses.
38. As noted above, since there are legitimate uses for another person’s trademark as or in a domain name, the mere registration of them cannot establish bad faith and the Policy requires more specific types of misconduct. In this case however, the domain names were registered over a short period of time for different activities, all of which track activities of the Complainant. The Complainant’s activities and DISNEY trademark are well known. This provides a suggestion of an improper motive in obtaining the registrations. Generating internet traffic for any reason can produce revenue through advertising sales and kickbacks from sites to which traffic is forwarded. If that is the object here, the use of famous names would likely generate profit by exploiting Disney’s goodwill. If the registrations were intended for a legitimate purpose it would be simple enough for the Registrant to file a Response to say so. It has also not contested any of the Complainant’s trademark registrations even though it had the domain names registered, in some cases before they were applied for. Instead, it did not contest the Complaint and voluntarily took the steps to transfer the domain names to the Complainant. In these circumstances the Panel concludes that the registrations were more likely than not obtained in bad faith.

Legitimate Interest

39. In order to succeed, the Complainant has to provide some evidence that the Registrant does not have a legitimate interest in the Domain Name. Paragraph 3.4 lists six possible ways in which a Registrant may have a legitimate interest in a domain name. This list of legitimate interests is not exhaustive as it is said to be “without limitation”.
40. The Complaint alleges that the domain names are all “specifically targeted” at Complainant and its well-known businesses despite the Registrant having no connection with the complainant. The identity of the “Disney” element of the Domain Names with the Complainant’s trademarks, together with the absence of an additional inherently distinguishing component, is enough to impose an obligation on the Registrant to demonstrate a legitimate interest in the Domain Names. The Registrant has not done so.
41. Accordingly, the Panel concludes that the Registrant has no legitimate interest in the Domain Names.

I. Conclusion and Decision

42. In conclusion, the panel finds that for the purposes of the Policy:

The Complainant meets the Canadian Presence Requirements;

The Complainant has rights in the Disney Marks;

The Domain Names were registered in bad faith; and

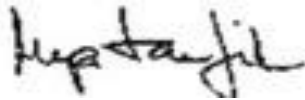
The Registrant has no legitimate interest in the Domain Names.

43. The Complaint is therefore upheld, and the Domain Names are directed to be transferred to the Complainant

Dated: January 08, 2020



By: David Allsebrook (Chair)



By: Myra Tawfik



By: James Minns