



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE
DOMAIN NAME DISPUTE
ADMINISTRATIVE PANEL
DECISION

CIIDRC case number:	19685-CDRP	Decision date: January 24, 2023
Domain Name:	<imax.ca>	
Panel:	María Alejandra López García	
Complainant:	IMAX Corporation	
Complainant's representative:	Aaron Guile	
Registrant:	ElieNovation Holdings	
Registrant's representative:	Yaacov Abenhaim of zDomainName.com	

1. PROCEDURAL HISTORY

The procedural history of this case was set out in a letter from the CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE (the "CIIDRC") to the Panel, as follows:

1. On December 6, 2022, the Complainant filed a Complaint with the CIIDRC pursuant to the Canadian Internet Registration Authority ("CIRA") Domain Name Dispute Resolution Policy (the "CDRP") and the CIRA Domain Name Dispute Resolution Rules (the "Resolution Rules").
2. On December 7, 2022, CIRA was notified of this proceeding. On the same date, CIRA transmitted by email to CIIDRC its verification response informing who is the Registrant of the disputed domain name. CIRA also confirmed that the <imax.ca> domain name (the "Disputed Domain Name") was placed on a Registrar LOCK.
3. On December 7, 2022, CIIDRC, as Service Provider, confirmed compliance of the Complaint with CIRA's requirements under Resolution Rule 3.2 and commencement of the dispute resolution process.

Domain Name: imax.ca
19685-CDRP

4. Pursuant to Resolution Rule 4.4, CIIDRC notified the Registrant of this administrative proceeding and forwarded a Notice of commencement of the administrative proceeding with the Complaint to the Registrant via email on December 7, 2022.
5. On December 27, 2022, Counsel for the Registrant requested an extension of time to submit a response. On the same date, the CIIDRC pursuant to Resolution Rule 5.4 an extension was granted and a new deadline for the response was set at January 16, 2023.
6. No response was received by the new deadline of January 16, 2023.
7. On January 18, 2023, a late response was received with the request that it be considered by the Panel.
8. The Complainant in this administrative proceeding has elected for a Panel consisting of a single-member. CIIDRC appointed María Alejandra López García as a single-member Panel in this matter on January 19, 2023.
9. The Disputed Domain Name was registered on December 15, 2021.

This matter is conducted pursuant to the CDRP and the Resolution Rules of the CIRA.

2. FACTS ALLEGED BY THE PARTIES

The Complainant is a recognized Canadian theatre corporation founded in Montreal in 1967. The Complainant designs and manufactures its own cameras and projection systems; develops films, production, post-production and distribution to its own affiliates theatres at a worldwide level. The Complainant has been operating in the film industry since 1967 and has built its assets in the entertainment industry around its trademark IMAX, registered in Canada in August 21, 1970. The Complainant also owns a large domain name portfolio, for different gTLDs and ccTLDs, including for www.imax.com, registered on October 27, 1989.

The Complainant owned the Disputed Domain Name since October 20, 2000 until September 28, 2021, and subsequently it was registered by the Respondent on December 15, 2021. The Complainant bases the absence of its renewal due to an inadvertently expiration and administrative error.

The Complainant requested a quote to the Registrant in an attempt to negotiate a fair price to recover the Disputed Domain Name. On September 27, 2022, the Registrant quoted the Disputed Domain Name in \$180,000 USD.

On January 18, 2023, the Registrant without providing any reason why he could not have filed the Response on time, submitted a late Response, alleging that it was not registered in bad faith and requesting to be considered by the Panel.

The Registrant is currently using the Disputed Domain Name for its sale, through DAN.com.

3. CONTENTIONS OF THE PARTIES

- **Complainant**

- The Complainant asserts that the Disputed Domain Name is identical to Complainant's registered trademark IMAX for motion picture films and entertainment services; that Complainant's company is notorious for their motion picture and movie theatre services spanning the globe. That Complainant has been operating in the film production industry since 1967 and has built an entire multimillion-dollar entertainment conglomerate around their trademarked and distinctive term IMAX.
- The Complainant asserts that their trademark application IMAX was filed with the CIPO on October 1969 and registered on August 21, 1970.
- That Complainant's primary website www.imax.com was registered on October 27, 1989 which provides instant access for online consumers who seeks entertainment options, current films productions, and theatre locations.
- That Complainant maintains an extensive brand portfolio of hundreds of domain names consisting of ccTLDs and gTLDs variations of the trademarked term IMAX; and that this significantly increases the likelihood of confusion when consumers are searching for Complainant's brand name theatre and movies, only to find Registrant's infringing website for www.imax.ca.
- The Complainant asserts that it has consistently and consecutively used their trademark IMAX for over 50 years, since its registration in August 1970; that it has been significantly impacting and revolutionizing the motion picture industry since it's founding in 1967 and generates over \$300 million in revenue; that Complainant has more than 1,500 IMAX theatres in more that 80 countries and territories around the world; that Complainant maintains their Canadian trademark rights by providing cinematic and file equipment services to over a dozen theatres in multiple Canadian provinces such as the Cineplex Cinemas in Langley, Mississauga and Vaughan; that Complainant has their motion picture company devoted to the trademark IMAX and that it should be permitted to reflect their trademark accordingly without confusion of Registrant's infringing domain name.
- The Complainant asserts that this cybersquatting method is not only used to capitalize on notorious brand recognition but also that demonstrates Registrant's intention to confuse consumers and target Complainant's customers with an identical domain name to Complainant's numerous ccTLDs counterparts.
- That the domain name <imax.ca> is confusingly similar to Complainant's trademark as it uses the totality of Complainant's trademark and directs online consumers to an unaffiliated website.
- The Complainant contends that the Registrant has no rights or legitimate interests in the domain name <imax.ca>, because Complainant has not licensed nor allowed the Registrant to use the trademark IMAX for any purpose; the Registrant doesn't appear to have any legitimate connection to the IMAX term; the

and Registrant is not commonly known by the domain name and registered it for the primary purpose of disrupting the Complainant's business.

- The Complainant contends that it has definitely owned the disputed domain name <imax.ca> for nearly a decade, since its registration; that Complainant's ownership of the domain name inadvertently expired on September 28, 2021, and it was subsequently registered by the Registrant on December 15, 2021, and that now forwards to the Registrant's infringing site displaying a sales quote listing on Dan.com.
- The Complainant submits that in an effort to avoid escalating the matter into a domain dispute, the Complainant requested a quote in an attempt to negotiate a fair price to recover the domain, and that the response of the Registrant was an astronomical asking price of \$180,000 USD.
- The Complainant contends that based on the Registrant's quote amount, that it is clear Registrant registered the domain name with Complainant's company in mind and had the intention of leveraging the domain's expiration against the Complainant in an attempt to extort a large amount of money given the Complainant's public notoriety and status.
- The Complainant contends that the Registrant is not making a legitimate non-commercial or fair use of the domain name because it contains the fanciful term IMAX to attract internet traffic with the ultimate goal of targeting Complainant's company for extortionate profit.
- The Complainant asserts that the Registrant is illegitimately using the domain name <imax.ca> to confuse customers who associate the IMAX brand and navigating them away from Complainant's company website to Registrant's unaffiliated site.
- The Complainant also asserts that the Registrant has not only registered and used the disputed domain name to capitalize on Complainant's international online reputation, but that the Registrant has provided a sales quote amount that would not likely be purchased by any potential buyer other than the Complainant, given the brand meaning to the unique IMAX term.
- Also, that the Registrant's domain registration of <imax.ca> in 2021, nearly a decade after Complainant first registered the domain, combined with the asking price demonstrates that the Registrant must have clear knowledge about Complainant's globally recognized motion picture brand company.

- **Registrant**

- The Registrant, represented by Yaacov Abenhaim of zDomainName.com, on January 18, 2023, submitted a late response, as follows:
- Denial of all complaints.
- "We are a small web development company with locations in both Montreal and the United States. Part of our business model involves purchasing different domain names with the purpose of building websites on them. These websites are developed for both clients of ours and as company investments. In 2021, we acquired the [Disputed] Domain Name - over 1 year ago - because it was easy to remember and corresponded to a short, four-letter potential acronym that we intended to use for a website. We believe the term "iMax" is generic, giving it a wide range of uses that are not related to the Complainant's business or Mark. The letter "i" is not only a dictionary word, but has also become commonly used as a

prefix for consumer products and services, such as "iCloud," "iPod," "iSIGN," "iGame," "iTunes," and "iRent." The term "MAX" is not only a common first name, but also an abbreviation for the word "Maximum." The term "iMax" is also registered in 173 other extensions by companies and individuals whom are not the Complainant or affiliated with the Complainant. Some examples of the "IMAX" domain name registered in extensions not owned by the Complainant include IMAX.net, IMAX.org, IMAX.co.uk. IMAX.one, IMAX.fr, IMAX.es, IMAX.be, and over one hundred others. The WIPO Global Brand Database currently shows 244 registered IMAX trademarks, for companies all over the world for all manner of goods and services that have nothing whatsoever to do with the Complainant.

Although our official development for the [Disputed] Domain Name has not begun yet, we can assure you it was not registered in bad faith and we are not trying to infringe on the Complainants Mark in any form. Our Company owns and manages thousands of domain names and we have no history of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names. No links, ads, banners, images, text, or sound related to the Complainant or its competitors have ever appeared on the [Disputed] Domain Name. It has never displayed, promoted, redirected, advertised, or copied the Complainants business logo, font or Mark, or that of any competitors while under our ownership. When our company initially acquired the iMax.ca it was temporarily parked with the vendor called DAN.Com where visitors could submit offers to purchase the Domain Name. The [Disputed] Domain Name still points to this page, but this was not done to entice to attract the Complainant into making any type of purchase. Instead, this is something we do on all domain names that we acquire while they are on hold for development. On September 9, 2022, Anthony Beltran from 101Domain.com, which is affiliated with the Complainant, contacted us in regards to acquiring the imax.ca domain from us. After providing the asking price, the Complainant simply never responded. Because of this, we also believe the Complainant may have filed this CDRP frivolously."

- **Remedy Sought**

The Complainant requests the Domain Name be transferred to it. The Registrant wishes to retain full ownership and control over the Domain Name.

4. DISCUSSION AND FINDINGS

4.1. Procedural Aspects

Late filing of the Response

The first issue is whether this Panel will consider the late Response of January 18, 2023.

Paragraph 5.4 of the Resolution Rules, contemplates that "(...) the Provider may, in exceptional cases, extend the period of time for the filing of the Response for a period not to exceed twenty (20) days". The

CIIDRC granted an extension of twenty (20) additional days. However, despite the Provider granted such extension, the Registrant, submitted its Response two (2) days after the (extended) due date.

Although there were no exceptional circumstances described by the Registrant, which could at least, justify its delay, this Panel on the basis of its “powers and obligations” pursuant to paragraph 9.1(b) “ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case”, accepts the Registrant requests and take into account the late Response submitted on January 18, 2023.

4.1 Eligibility

Paragraph 2 of CIRA Canadian Presence Requirements for Registrants, Version 1.3, establishes that:

“On and after November 8, 2000 only the following individuals and entities will be permitted to apply to CIRA (through a CIRA certified registrar) for the registration of, and to hold and maintain the registration of, a .ca domain name:

(...) (d) **Corporation.** A corporation under the laws of Canada or any province or territory of Canada; (...)

(q) **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. (...).”

Paragraph 1.4 of the CDRP, establishes that:

“The person initiating a Proceeding (the “Complainant”) must, at the time of submitting a complaint (the “Complaint”), satisfy the Canadian Presence Requirements for Registrants (the “CPR”) in respect of the domain name that is the subject of the Proceeding unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office (“CIPO”) and the Complainant is the owner of the trade-mark.”

The Complainant is a Canadian Corporation, formed under the laws of Canada, and in addition, is the Trademark Owner of the fanciful term IMAX, Reg. No. TMA170718, registered on August 21, 1970 (and in force until August 21, 2030) in the CIPO, in which the exact word component of such trade-mark is the same as the Disputed Domain Name.

Therefore, the Complainant satisfies the Canadian Presence Requirements under section 1.4 of the CDRP.

4.2 Requirements

In accordance with Paragraph 4.1 of the CDRP, the onus is on the Complainant to prove:

(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 3.5;

and the Complainant must provide some evidence that:

(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4. Once that is done, the onus shifts to the Registrant to prove, on a balance of probabilities, that the Registrant has a legitimate interest in the Domain Name as described in paragraph 3.4 of the CDRP.

The Panel will consider each of these requirements in turn.

4.3 Analysis

4.3.1 That the Domain Name is Confusingly Similar to a Mark in which the Complainant has Rights

The Complainant has proved its prior Trademark Rights over the Canadian trademark IMAX, Reg. No. TMA170718, registered on August 21, 1970 and in force until August 21, 2030, registered at the CIPO.

According to paragraph 3.3 of the CDRP, in determining whether a domain name is "Confusingly Similar" to a Mark, the Panel shall only consider whether 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. As paragraph 1.2 of the CDRP defines, the country code top level domain (ccTLD) '.ca', for the purpose of this proceeding, is excluded.

By applying this test, the Panel finds that the Disputed Domain Name <imax.ca> is confusingly similar to the Complainant's IMAX trademark.

Therefore, the Complainant has satisfied the first CDRP requirement.

4.3.2 That the Registrant has No Legitimate Interest in the Domain Name

According to paragraph 3.4 of the CDRP, for the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in a domain name:

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 registered 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 registered 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 paragraph 3.4(d) "use" by the Registrants includes, but is not limited to, use to identify a web site.

According to the facts and evidence submitted by the Parties before this Panel, the Registrant is not affiliated to the Complainant, nor has been licensed, or even authorized in any manner by the Complainant to register the Disputed Domain Name <imax.ca>, nor has Rights in the Mark, and even less is commonly known by the term <imax.ca>. As stated by the same Registrant in its Response: "We are a small web development company with locations in both Montreal and the United States. Part of our business model involves purchasing different domain names with the purpose of building websites on them".

As it has been shown by the Complainant, the term IMAX, is a fanciful widely-known Canadian Trademark, conceived by creativity and sustained for 50 years through consistent effort, which to this Panel and in the present dispute, is far to be considered as a "generic term" as the Registrant argues in its Response. The Registrant recognized that the reason of its acquisition was with future website's development purposes, however, no evidence related to such development was submitted neither.

Therefore, this Panel finds that the Registrant has no legitimate interest in the Disputed Domain Name, and in consequence the Complainant has satisfied this requirement.

4.3.3 That the Registrant has Registered the Domain Name in Bad Faith

According to paragraph 3.4 of the CDRP, for the purposes of paragraphs 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:

- 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;
- 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; or
- d. the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

Under the circumstances of the present dispute, where 1) the Complainant was the owner of the Disputed Domain Name since October 20, 2000 until September 28, 2021 (due to an inadvertently expiration and administrative error), the Disputed Domain Name was subsequently registered by the Respondent on December 15, 2021; 2) the Registrant claims to be a company dedicated to purchase domain names; 3) such Disputed Domain Name is parked on sale; 4) the Complainant on an attempt to recover the Disputed Domain Name request for a quote, and 5) the Registrant provides a quote of \$180,000 USD, constituting an excess of the Registrant's actual costs in registering the domain name, amount that could possibly be covered by an entity such as the Complainant; leads this Panel to infer that the Registrant, at the moment of the registration of the Disputed Domain Name "*knew or should have known*" about the existence, value and strong reputation of the Complainant.

In relation to it, point 3.2.1 of the "WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") states:

"Knew or should have known"

“Noting the near instantaneous and global reach of the Internet and search engines, and **particularly in circumstances where the complainant’s mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers)**, panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant’s mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent’s claim not to have been aware of the complainant’s mark.

On the other hand, where the complainant’s mark is not inherently distinctive and it also corresponds to a dictionary term or is otherwise inherently attractive as a domain name (e.g., it is a short combination of letters), **if a respondent can credibly show that the complainant’s mark has a limited reputation and is not known or accessible in the respondent’s location**, panels may be reluctant to infer that a respondent knew or should have known that its registration would be identical or confusingly similar to the complainant’s mark. Particularly noting the Internet’s borderless nature, a sweeping respondent disclaimer of knowledge based as such on its (deemed) presence in a particular location different from the location(s) in which the complainant’s goods or services are accessible may be seen by panels as lacking in credibility or relevance. In this respect, it is noted that the business of cybersquatting often seeks to exploit the global reach of the Internet, and may in fact purposefully target a location other than that in which the respondent may be “present”.” (emphasis added).

Furthermore, point 3.2.3 of the WIPO Overview 3.0, states as well:

“Willful blindness and the duty to search for and avoid trademark-abusive registrations

Panels have held that **especially domainers** undertaking bulk purchases or automated registrations **have an affirmative obligation to avoid the registration of trademark-abusive domain names**. Panelists will look to the facts of the case to determine whether such respondent has undertaken good faith efforts to screen such registrations against readily-available online databases to avoid the registration of trademark-abusive domain names (...) Panels have conversely found **that where a respondent provides evidence that it has undertaken additional measures to avoid abusive use of any registered domain names**, e.g., through methods such as applying negative keywords, such undertakings will corroborate the respondent’s claim to good faith.” (emphasis added).

“Although WIPO Overview 3.0 addresses the Uniform Domain Name Dispute Resolution Policy (“UDRP”), Paragraph 3.2(I) of the Resolution Rules expressly allows references to “dispute resolution proceedings which apply to domain names registered under any other top level domain which the Complainant considers persuasive.” (see *Xerox Corporation vs. Mark Cataford*, CIIDRC Case No. 18331-CDRP).

Apart from the Response, the Registrant has not provided any evidence to infer the absence of bad faith.

Based on all the above, this Panel concludes that the Disputed Domain Name has been registered in bad faith. Therefore, the Complainant has satisfied this requirement.

4 DECISION and ORDER

For the above reasons, in accordance with Paragraph 4 of the CDRP, Paragraph 12 of the Resolution Rules, the Panel orders that: that the Disputed Domain Name <**imax.ca**> be transferred to Complainant.

Made as of January 24, 2023

SIGNATURE OF PANEL



María Alejandra López G.

