

**CANADIAN INTERNET REGISTRATION AUTHORITY**  
**DOMAIN NAME DISPUTE RESOLUTION POLICY**  
**COMPLAINT**

Dispute Number: DCA - 2034 - CIRA  
Domain Names: livejasmin.ca  
Complainant: WebMindLicenses Kft.  
Registrant: Barry Gray  
Panel: Barry C. Effler, Claude Freeman and Elizabeth Cuddihy  
(Chair)  
Service Provider: British Columbia International Commercial Arbitration  
Centre

**DECISION**

**The Parties**

1. The complainant is WebMindLicenses Kft. of 1101 Budapest, Expo ter 5-7, Hungary, (the Complainant).
2. The Registrant is Barry Gray of G3210 Kleinpell Street, Burton, Michigan 48529, United States of America, (the Registrant).

**The Disputed Domain Name and Registrar**

3. The Domain Name at issue is livejasmin.ca, (the Disputed Domain Name).
4. The Registrar of record for the Disputed Domain Name is Register4less, Inc.
5. The Disputed Domain Name was registered on February 15, 2006.

**Procedural History**

6. The British Columbia International Commercial Arbitration Centre, (BCICAC) is a recognized service provider to the Domain Name Dispute Resolution Policy, (the Policy) and the Rules, (the Rules) of the Canadian Internet Registration Authority, (CIRA).

7. The Complainant filed a complaint on October 25, 2018, (the Complaint) with the BCICAC seeking an order in accordance with the Policy and the Rules that the Disputed Domain Name be transferred to the Complainant.

8. BCICAC confirmed the Complaint to be in administrative compliance with the Rules and forwarded copy of the Complaint to the Registrant in accordance with the Rules.

9. The Registrant filed a response via email on November 16, 2018. Following review of that response, as per rule 4.2, the BCICAC found it to be non-compliant with the CIRA Rules and in accordance with Rules 4.6, the BCICAC gave the Registrant notice to remedy all instances of non-compliance within ten (10) days of the BCICAC's notice to do so. The Registrant submitted its Response in compliance with the Policy and the Rules.

10. The BCICAC named Barry C. Effler, Claude Freeman and Elizabeth Cuddihy to act as the three-person Panel to determine the matter. Elizabeth Cuddihy was appointed as Chair of the Panel.

11. As prescribed by the Policy, the Panel has declared that it can act impartially and independently and that there are no circumstances known to the Panel which would prevent it from so doing.

### **Canadian Presence Requirements**

12. In order for a Registrant to be permitted to apply for registration of, and to hold and maintain the registration of a dot- ca domain name, the Canadian Presence Requirements for Registrants, (the Presence Requirements) require that the applicant meet at least one of the criteria listed as establishing a Canadian presence.

13. The Complainant is the owner of Canadian trade-mark registration for LIVEJASMIN, registered in the Canadian Intellectual Property Office (CIPO) on January 30, 2007, as Registration Number TMA680639, (the Complainant's Mark).

14. The Complaint relates to a Disputed Domain Name, which includes the whole of the exact word component of the Complainant's Mark registered in CIPO, accordingly, the Presence Requirements are satisfied.

### **The Position of the Parties**

#### **The Position of the Complainant**

15. The Complainant, as owner of the Complainant's Mark registered in CIPO on January 30, 2007 claims rights recognized to apply to class of services 38; namely, transmission of adult electronic entertainment in the form of continuous streaming audio, video and multimedia



provided via worldwide communication network since July 1, 2004 at which time it extended its services to Canada.

16. The Complainant's rights to the Complainant's Mark were earlier registered in the United States of America and are effective since August 2003 at which time it extended its services to that country. The Complainant also owns Trademark rights to the Complainant's Mark in several European countries; namely, in Hungary, Great Britain, Germany, Spain, France and Italy all since 2017. The Complainant also licenses for a fee the Complainant's Mark to a Luxembourg company, (the Licensee) for use of the Complainant's Mark for the provision of the same services as outlined in paragraph 15 above for sale through the interactive communication platform, [www.livejasmin.com](http://www.livejasmin.com). The domain name LIVEJASMIN.COM was registered November 11, 2001 and licenced to the Licensee. Another member of the group of companies in Luxembourg is the owner of the domain name <jasmin.com> registered on November 11, 1998 in the beginning of the group of companies' activities in the field of adult entertainment.

17. The Complainant' Mark is well-known worldwide for the delivery of streaming services in the field of adult entertainment where the client pays for the time spent by the minute with a model. The Complainant contends also that its web platform [www.livejasmin.com](http://www.livejasmin.com), available in nineteen languages receives over ten million visitors per day and is ranked number twelve among adult entertainment sites worldwide. In the USA it ranks as number thirty-eight. The number of new clients on the web platform in 2017 averaged four thousand one hundred and thirty-one per day bringing the total active clients to date to twenty-eight million, thus half a million models.

18. In addition the Licensee, as operator of the website <http://www.awempire.com> allows affiliates of this website, (the AWEmpire affiliates) to promote the services of the [www.livejasmin.com](http://www.livejasmin.com) platform, (the Platform). This network of AWEmpire affiliates number in excess of forty-two thousand who redirect traffic to the [www.livejasmin.com](http://www.livejasmin.com) site as well as to other trademark affiliates.

19. The Complainant submits that the Disputed Domain Name was registered on the 15<sup>th</sup> of February 2006 without the authority of the Complainant, is confusingly similar to the Complainant's Mark in which the Complainant had rights prior to the registration of the Disputed Domain Name and continues to have such rights, and further that the Registrant has no legitimate interest in the Disputed Domain Name and that the Disputed Domain Name was registered in bad faith in accordance with paragraph 3.5 of the Policy.

20. Accordingly, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

### **The Position of the Registrant**

21. The Registrant claims that the use of the Disputed Domain Name was apparent to the Complainant for many years and with the full knowledge and consent of the Complainant by

the Complainant's acquiesce since the creation of the Disputed Domain Name, as both the Claimant and the Registrant '...shared profits made from...' the Disputed Domain Name site. The Registrant claims that the agreement to use the Disputed Domain Name was based on a verbal agreement at first and by acquiescence later of a twelve year time span and accordingly not a use in bad faith as alleged by the Complainant.

22. The Registrant further claims that the action by the Complainant to terminate the AWEmpire affiliate agreement was "...with the intent to influence this Arbitration Panel's decision as well as to limit the Complainant's exposure to any affirmative defense the Respondent might have in establishing the Respondent's offerings to be characterized as "bona fide".

23. The Registrant accordingly claims that the registration of the Disputed Domain Name was not in bad faith, that the use of the Disputed Domain Name was not confusingly similar to the Complainant's Trademark, that any similarity was authorized by the Complainant's own instructions on its model feed tool and requests the Panel reject the transfer of the Disputed Domain Name to the Complainant.

### **Analysis and Findings**

24. The purpose of the Policy as stated in paragraph 1.1 is to provide a forum by which cases of bad faith registration of dot-ca domain names can be dealt with relatively inexpensively and quickly. The Policy does not apply to other types of differences between owners of trade-marks and Registrants of Domain names.

### ***Relevant provisions of the Policy are provided below***

25. Paragraph 4.1 of the Policy provides:

**4.1 Onus.** To succeed in a Proceeding, the Complainant must 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 3.5;

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.

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 paragraph 3.4.

26. Paragraph 3.2 of the Policy provides in part:

**3.2 Mark. A "Mark" is**



- (a) a trade-mark, including the word elements of a design mark, or a tradename that has been used in Canada by a person, or the person's predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person;
- (b) a certification mark, including the word elements of a design mark that has been used in Canada by a person or that person's predecessor in title, for the purpose of distinguishing the wares or services that are of a defined standard;
- (c) a trade-mark, including the word elements of a design mark, that is registered in CIPO; or
- (d) the alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of which the Registrar of Trade-marks has given public notice of adoption and use pursuant to paragraph 9(1)(n) of the *Trade-marks Act* (Canada).

27. Paragraph 3.3 provides:

**3.3 Confusingly Similar:** 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.

28. Paragraph 3.4 provides:

**3.4 Legitimate Interest:** 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 the evidence presented, shall demonstrate that the Registrant has a legitimate interest in the 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 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 Registrant includes, but is not limited to, use to identify a website.

29. Paragraph 3.5 provides:

**3.5 Registration in Bad Faith.** For the purposes of paragraph 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 licensor or licensee 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 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.

30. In summary, to succeed in a proceeding, the Complainant must prove on a balance of probabilities that:

1. The dot-ca domain name is confusingly similar to a Mark in which the Complainant had Rights prior to the registration of the Disputed Domain Name and continues to have such Rights;

2. The Registrant has registered the Disputed Domain Name in bad faith; and

3. The Complainant must provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Name.

4. Notwithstanding the evidence presented that the Registrant has no legitimate interest in the Disputed Domain Name, the Registrant will succeed if the Registrant proves on a balance of probabilities that he has a legitimate interest in the Disputed Domain Name.

### ***Confusingly Similar to a Mark***



31. Evidence shows that the Complainant is the owner of the Complainant's Mark, and the Complainant's Mark was registered in CIPO as No TMA680639 on January 30, 2007 with effective date of July 1 2004 as noted in paragraph 15 above.

32. In accordance with paragraph 3.3 of the Policy, 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 mistaken for the Mark. In assessing the domain name, the dot-ca suffix is ignored. It is the narrow resemblance that is applied.

33. The Disputed Domain Name incorporates the entire word of the Complainant's Mark. The only difference between the Disputed Domain Name and the Complainant's Mark is the .ca extension. The Complainant submits that prior panels deciding under the Policy have held that where a domain name identically reproduces a Complainant's Mark, excluding the dot-ca suffix, it is sufficient to establish that the domain name is Confusingly Similar to a Complainant's Mark.

34. Accordingly for the reason stated above, the Disputed Domain Name is confusingly similar to the Complainant's Mark.

***Rights in the Mark prior to the Disputed Domain Name registration and continuing Rights***

35. The Disputed Domain Name was registered on February 15, 2006.

36. As noted in paragraphs 15 and 31 above, the Complainant's Mark was registered in Canada in CIPO on January 30, 2007 with effective date of July 1, 2004. In addition, evidence shows that the Complainant's common law rights and statutory rights to the Complainant's Mark based on use and registered rights worldwide predate the registration of the Disputed Domain Name and continues to have such rights.

37. The Panel is satisfied that the Complainant's Mark was registered well before the registration of the Disputed Domain Name and accordingly had Rights in the Complainant's Mark well before the registration of the Disputed Domain Name and as the evidence shows that the Complainant's rights are active, the Complainant continues to have such Rights.

***Was the Disputed Domain Name registered in bad faith?***

38. The Complainant relies on paragraphs (c) and (d) of 3.5 of the Policy in support of bad faith registration of the Disputed Domain Name by the Registrant. The Panel notes that the Policy provides that "if any of the 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".

39. The Complainant relies on several facts and surrounding circumstances to establish bad faith in the Registration by and the use by the Registrant of the Complainant's Mark. The Complainant refers to the notoriety of the Complainant's Mark and the fact that livejasmin is

not a term or generic phrase and there is no proof that the Registrant has any right or legitimate interest in the term. Evidence shows that the Registrant has no trademark, service marks or any other trading name or product with any likeness to the term jasmin or livejasmin.

40. The Complainant submits that the Registrant has never been licensed to, nor has it ever authorized the use of, the Complainant's Mark, in Canada or otherwise, including in, or as part of a domain name or the Disputed Domain Name. Evidence shows that the Registrant subscribed to the AWEmpire affiliates program the terms of which prohibited the use of the Complainant's intellectual property rights except as set forth in the conditions and did not grant or otherwise assign any rights in any intellectual property owned by the Complainant, including without limitation any and all of its trademarks or service marks.

41. Furthermore the Registrant has intentionally attempted to attract, for commercial gain, internet users to the website to which the Disputed Domain Name resolves redirecting users to pages of models who propose to provide identical services to those provided on the Complainant's Platform and promoting the Registrant's other site [www.motorcitykitty.com](http://www.motorcitykitty.com), a competitor of the Platform.

42. Evidence shows that when the Complainant became aware of the Disputed Domain Name, there ensued several exchanges of communication in an attempt to settle the issues amicably but to no avail. In fact the Registrant threatened to turn the Disputed Domain Name website into a parody which would be prejudicial to the Complainant's Mark.

43. Unable to reach a settlement, the Complainant issued a notice to the Registrant to cease and desist infringement of the Complainant's Mark and reminding the Registrant that the Registrant had broken the terms of the AWEmpire affiliate terms and conditions to which he had subscribed. The Registrant's response did not provide any further clarification of the rights to the Complainant's Mark.

44. As of September 24, 2018, evidence shows that the Registrant has updated the Disputed Domain Name website openly promoting erroneous information, with user comments posted.

45. Based on all the circumstances demonstrated in the material and all the evidence provided by the parties, the Panel is satisfied that the Complainant has proven bad faith registration of the Disputed Domain Name as required by the Policy.

### ***Legitimate Interest of the Registrant***

46. Paragraph 3.4 of the Policy sets out a non-exhaustive list of criteria upon which the Panel may find, based on all the evidence, that the Registrant has a legitimate interest in the Disputed Domain Name. Paragraph 4.1 of the Policy places the onus on the Complainant to provide "some evidence" that the Registrant did not have a legitimate interest in the Disputed Domain Name. Although "some evidence" is not defined, it imposes, in the Panel's view, a lower threshold than on a balance of probabilities. The onus on the Complainant is to provide "some evidence" of a negative.



47. The Complainant has provided evidence in respect of the non-exhaustive list contained in paragraph 3.4 of the Policy that the Registrant has no legitimate interest in the Disputed Domain Name. The Registrant did not adduce substantive evidence to support a legitimate interest by the Registrant in the Disputed Domain Name. Accordingly the Complainant's evidence has not been successfully challenged.

48. Based on all the evidence provided, the Panel is satisfied that the Registrant has no legitimate interest in the Disputed Domain Name.

### **Decision**

49. For the reasons set out herein, the Panel decides in favour of the Complainant and orders the transfer forthwith of the Disputed Domain Name to the Complainant.

Dated on December 27, 2018

The Panel  
Barry C. Effler, Claude Freeman and Elizabeth Cuddihy

Per: 

Elizabeth Cuddihy (Chair)