

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

Domain name: grandmarnier.ca
Complainant: Société des Produits Marnier Lapostolle
Registrant: Andrew Pakula
Registrar: Namespro Solutions Inc.
Panel: Peter C. Cooke

Service Provider: Resolutions Canada Inc.

DECISION

THE PARTIES

1. The Complainant is Société des Produits Marnier Lapostolle with an address at 91 Boulevard Haussman, 75008 Paris, France.
2. The Registrant is Andrew Pakula with an address at P.O. Box 200, Palgrave Ontario, Canada L7E 359.

THE DOMAIN NAME AND REGISTRAR

3. The domain name that is the subject of this proceeding is "grandmarnier.ca".
4. The Registrar of the domain name is Namespro Solutions Inc.

PROCEDURAL HISTORY

5. This is an administrative dispute resolution proceeding pursuant to the CIRA Domain name Dispute Resolution Policy version 1.3 (August 22, 2011) (the "Policy") and the CIRA Domain name Dispute Resolution Rules version 1.4 (August 22, 2011) (the "Rules").
6. According to information provided by the dispute resolution service provider, Resolutions Canada Inc., the history of this proceeding is as follows:
 - (a) The Complainant filed a domain name complaint dated March 10, 2014 with Resolutions Canada Inc.
 - (b) Having determined the complaint was in administrative compliance with the requirements of the Policy and the Rules, Resolutions Canada Inc. commenced the dispute resolution process and served notice of the complaint to the Registrant on March 11, 2014.
 - (c) The Registrant delivered a deficient response on March 31, 2014, that was not in administrative compliance with the Rules.
 - (d) Having determined the response was not in administrative compliance with the Rules, Resolutions Canada Inc. advised the Registrant of all instances of non-compliance. As per the Rules, the Registrant was given ten days to correct the instances of non-compliance. The Registrant did not re-submit.

- (e) The Panel was appointed on May 2, 2014.
 - (f) As required by paragraph 7.1 of the Rules, the Panel declared to Resolutions Canada Inc. that he can act impartially and independently in this matter, as there were no circumstances known to him which would prevent him from so acting.
 - (g) Absent exceptional circumstances, the Panel was required to deliver its decision by May 23, 2014.
7. As the Registrant did not submit a response within the period for a response or the extended period, the Panel will decide the matter solely on the basis of the complaint submitted by the Complainant pursuant to paragraph 5.8 of the Rules.

Eligibility of Complainant

8. The Complainant satisfies the CIRA Canadian Presence Requirement for Registrants. As stipulated by paragraph 1.4 of the Policy, the Complainant is the owner of numerous registered Canadian trade-marks corresponding to the domain name, two of which are identified at 12(a) herein.

Relief Requested

9. The Complainant requests the transfer of the domain name registration from the Registrant to the Complainant.

Applicable Law

10. As directed by paragraph 12.1 of the Rules, the Panel will render its decision based upon the laws of Ontario and the laws of Canada applicable in Ontario.

OVERVIEW OF THE POLICY

11. Paragraph 4.1 of the Policy explains the burden of proof the complainant must meet to succeed in this proceeding. The onus is on the Complainant to 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 in which the Complainant continues to have such rights; and
 - (b) the Registrant has registered the domain name in bad faith as described in paragraph 3.5;

The Complainant must also adduce some evidence showing:

- (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

COMPLAINANT'S CONTENTIONS

12. The Complainant contends as follows:

- (a) The Complainant is the owner in Canada of numerous registered trade-marks featuring the words GRAND MARNIER for use in association with liqueurs including TMA189486 and TMA252488, registered in 1973 and 1980 respectively. The domain name is confusingly similar to the Complainant's trade-marks in which the Complainant had rights prior to the registration of the domain name on or about April 1, 2009, and in which the Complainant continues to have such rights.
- (b) The Registrant registered and is using the domain name in bad faith because:
 - i) the Registrant registered the domain name primarily for the purpose of disrupting the business of the Complainant or competing with it in a deceptive or misleading fashion; and/or
 - ii) 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 source, sponsorship, affiliation, or endorsement of the Registrant's website or location of a product or service on the Registrant's website or location.
- (c) The Registrant has no legitimate interest in the domain name. Good faith use of the domain name is not possible where the Complainant's mark is famous. The Registrant's activity is not non-commercial, as the domain name resolves to a pay-per-click service. The domain name is neither descriptive nor generic. The Complainant never licensed or authorized the Registrant to use the trade-marks.

DISCUSSION AND FINDINGS

CONFUSING SIMILARITY BETWEEN DOMAIN NAME AND COMPLAINANT'S MARKS

13. The Complainant submits that the domain name "grandmarnier.ca" is confusingly similar to its registered GRAND MARNIER trade-marks, which the Complainant had registered prior to the date of registration of the domain name and in which the Complainant continues to have rights.
14. As per 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 to be mistaken for the Mark.
15. In applying this definition, it is important to note paragraph 1.2 of the Policy which stipulates:

"[...] For the purposes of this Policy, "**domain name**" means the domain name excluding the "dot-ca" suffix and the suffixes associated with all third and fourth level domain names accepted for registration by CIRA."
16. The Complainant has established that it registered a GRAND MARNIER trade-mark in 1973 prior to the registration of the domain name in 2009 and it continues to have rights therein. The registrations of this trade-mark must be presumed valid for the purposes of this proceeding.
17. As the "dot-ca" suffix must not be taken into account when assessing similarity, the Registrant's domain name is not merely similar to the Complainant's registered GRAND MARNIER trade-marks. It is actually identical to them.
18. In light of the above, the Panel is of the view that the Complainant has met its first burden.

BAD FAITH REGISTRATION

19. The Complainant submits that the Registrant has registered the domain name in "bad faith", pursuant to subparagraphs 3.5(c) and (d) of the Policy:

3.5 Registration in Bad Faith. 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:

[...]

(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 of a product or service on the Registrant's website or location.

20. With respect to subparagraph 3.5(c), the Complainant must demonstrate that the Registrant registered the domain name primarily for the purpose of disrupting the business of the Complainant, who is a competitor of the Registrant.
21. To determine whether the Registrant is a "competitor" of the Complainant whose actions "disrupted" the business of the Complainant, the decision of *Omer de Serres Inc. v. Maddeaux* (CIRA Decision 2007-00088) is instructive. The panel in that decision explained that "Resolving a disputed domain name to a customized internet portal...with a view to receiving a commercial advantage by attempting to capitalize on consumer confusion constitutes prima facie evidence of bad faith..."
22. The Complainant has demonstrated in Exhibit H of its evidence that it has an active web presence at www.grand-marnier.com with a home page leading to web pages titled "secrets & expertise", "cocktails and recipes", "products & collections" as well as a page of links. Exhibit J of the complaint includes a screen shot of the Registrant's home page, showing numerous alcohol-related links including one titled "alcohol drink recipes", suggesting the Registrant intended to compete with the Complainant for Internet traffic.
23. In light of this evidence, the Panel is of the view that the Registrant registered the domain name primarily for the purpose of disrupting the business of the Complainant, and is a competitor of the Registrant.
24. For similar reasons, and relying on the same evidence in the complaint, the Panel concludes that the Registrant intentionally attempted to attract Internet users to his website by deliberately creating a likelihood of confusion with the Complainant's mark, contrary to subparagraph 3.5(d).
25. Consequently, the Panel is of the view that the Complainant has met its burden.

NO LEGITIMATE INTEREST IN THE DOMAIN NAME

26. The Complainant submits that the Registrant has no "legitimate interest" in the domain name. Exhibit J of the Complainant's evidence demonstrates that the domain name resolves to a website displaying a number of links to alcohol-related websites with link titles such as "liquor", "mix drinks", and "unique alcohol bottles". The evidence also demonstrates the domain name's use in a pay-per-click service.
27. Paragraph 3.4 of the Policy sets forth a list of circumstances for determining whether a 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.

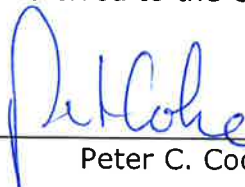
In paragraphs 3.4 (d) "use" by the Registrants includes, but is not limited to, use to identify a web site.

28. As discussed above, the domain name is identical to the Complainant's registered Canadian trade-marks and the Complainant submits that it has never licensed or authorized the Registrant to use its GRAND MARNIER trade-marks. The Registrant can therefore not rely on subparagraph 3.4(a) of the Policy.
29. The Complainant made submissions regarding the history of the GRAND MARNIER trade-marks sufficient for the Panel to conclude that the domain name is not clearly descriptive pursuant to paragraph 3.4(b) of the Policy.
30. The Panel has concluded that the Registrant registered the domain name in bad faith. The Panel has also concluded that the domain name is not understood in Canada to be the generic name of any product, business or service in any language. The Registrant cannot rely on paragraph 3.4(c) of the policy.
31. The Complainant's evidence suggests that the Registrant is engaging in pay-per-click activities using the domain name and is therefore not engaging in "non-commercial" activity as set out in paragraph 3.4(d) of the Policy.

32. The domain name is not the legal name of the Registrant Andrew Pakula, nor is there any evidence that it is the name, surname or other reference by which the Registrant is commonly identified. The Registrant cannot rely on subparagraph 3.4(e) of the Policy.
33. The domain name is not a geographical name, nor does the Registrant appear to be engaged in non-commercial activity. The Registrant cannot rely on subparagraph 3.4(f) of the Policy.
34. In light of the above, the Panel is of the view that the Registrant has no legitimate interest in the domain name and is satisfied that the Complainant has met its final burden of evidence.

CONCLUSION AND DECISION

35. The Complainant has proven, on a balance of probabilities, that the 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 in which the Complainant continues to have such rights, as such terms are defined in the Policy.
36. The Complainant has proven, on a balance of probabilities, that the Registrant registered the domain name in bad faith.
37. The Complainant has adduced some evidence that the Registrant has no legitimate interest in the domain name.
38. The onus shifts to the Registrant to prove, on a balance of probabilities, that it has a legitimate interest in the domain name. The Registrant did not file a response in compliance with the Rules disputing the Complainant's submission or justifying its registration.
39. For these reasons, the complaint regarding the domain name is successful and the Panel orders and directs that the registration of the domain name "grandmarnier.ca" be transferred to the Complainant.



Peter C. Cooke

Dated May 23, 2014