

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

Domain Name: asurion.ca
Complainant: Asurion, LLC
Registrant: IBWA.com Inc.
Registrar: Domainsatcost Corporation
Service Provider: Resolution Canada Inc.
Panel: Peter C. Cooke

DECISION

A. THE PARTIES

1. The Complainant is Asurion, LLC with a postal address of 648 Grassmere Park, Nashville, Tennessee 37211, USA.
2. The Registrant is IBWA.com Inc. with a postal address of 1000 de la Gauchetiere Street West, 9th Floor, Montreal, Quebec, H3B 5H4, Canada

B. THE DOMAIN NAME AND REGISTRAR

3. The subject of this proceeding is the domain name asurion.ca, registered on March 22, 2006.
4. The Registrar of the domain name is Domainsatcost Corporation.

C. 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 the information provided by Resolution Canada Inc. the dispute resolution service provider, the history of the proceeding is as follows:

7. The Complainant filed a complaint dated September 29, 2014 with Resolution Canada Inc., requesting that the Domain Name registration be transferred from the Registrant to the Complainant.
8. After having determined that the complaint was in administrative compliance with the requirements of the Policy and the Rules, Resolution Canada Inc. commenced the dispute resolution process and served notice of the complaint on the Registrant (as required by paragraph 4.3 of the Rules) by email on October 3, 2014. No response was received from the Registrant.
9. The Complainant has elected to proceed before a panel consisting of one panellist. As required by paragraph 7.1 of the Rules, the Panel has declared to Resolution Canada Inc. that he can act impartially and independently in this matter, as there are no circumstances known to him that would prevent him from so acting.

D. ELIGIBILITY OF COMPLAINANT

10. The Complainant satisfies Paragraph 2(q) of the *CIRA Canadian Presence Requirement for Registrants*, as the Complainant is the owner of a registered Canadian trade-mark corresponding to the Domain Name.

E. OVERVIEW OF THE POLICY

11. Paragraph 4.1 of the Policy sets forth the Complainant's burden of proof in order to succeed in the 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 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.

F. COMPLAINANT’S CONTENTIONS

12. The Complainant contends as follows:
- a) The Complainant is the owner in Canada of the trade-mark ASURION TMA580,365 registered on May 1, 2003, and the Complainant’s rights in the ASURION mark precede the March 22, 2006 registration date of the Registrant’s asurion.ca Domain Name, and the Domain Name is “confusingly similar” with the ASURION mark.
 - b) The Registrant registered and is using the Domain Name in bad faith because the Registrant registered the Domain Name in order to prevent the Complainant from registering the Domain Name. In particular, the Registrant has engaged in a pattern of registering domain names in order to prevent the owners of these marks from registering them as domain names.
 - c) The Registrant has no legitimate interest in the Domain Name, as the Domain Name at issue is not associated with an active website.

G. DISCUSSIONS AND FINDINGS

Confusing Similarity between Domain Name and Complainant’s Mark

13. The Complainant submits that it is the owner in Canada of the trade-mark ASURION TMA 580,365 registered on May 1, 2003, and that the Complainant’s rights in the ASURION mark precede the March 22, 2006 registration date of the Registrant’s asurion.ca Domain Name, and further that the Domain Name is “confusingly similar” with the ASURION mark.
14. A domain name is confusingly similar to a mark if the domain name so nearly resembles the mark in appearance, sound or ideas suggested by the mark as to be likely to be mistaken for the mark, as per paragraph 3.3 of the Policy.
15. In applying this definition, it is important to note paragraph 1.2 of the Policy which stipulates that:
- For the purposes of this Policy “domain name” means the domain name excluding the dot-ca suffix...
16. The Complainant has established that it registered the ASURION trade-mark in 2003 prior to the registration of the Domain Name in 2006 and that it continues to have rights therein. The registration of the ASURION trade-mark must be considered to be valid for the purposes of this proceeding.

17. In this case the Domain Name is not merely similar to the Complainant's registered trade-mark but is identical to it. The Panel is therefore of the view that the Complainant has succeeded in establishing confusing similarity under paragraph 3.1(a) of the Policy.

Bad Faith Registration

18. The Complainant submits that the Registrant has registered and is using the Domain Name in bad faith, as the Registrant registered the Domain Name in order to prevent the Complainant from registering the Domain Name. In particular, the Complainant alleges that the Registrant has engaged in a pattern of registering domain names in order to prevent the owners of these marks from registering them as domain names.
19. Paragraph 3.5 of the Policy states that the following circumstances, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:
- ...
- 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* (emphasis mine);
20. The Complainant submits that the Registrant owns "hundreds" of domain names, at least 15 of which contain trade-marks owned by third parties. The Complainant further submits that in *Great Pacific Industries Inc. v. Ghalib Dhalla* (CIRA – 00009) it was held that the registration of as few as two domain names was sufficient to establish a pattern as described above. This principle was followed in other decisions, for example *Yamaha Corporation and Yamaha Motor Canada Ltd. v. Jim Yoon* (CIRA - 00089).
21. Accordingly, the Panel concludes that the Registrant registered the Domain Name in bad faith pursuant to paragraph 3.5 (b) of the Policy.

No Legitimate Interest in the Domain Name

22. The Complainant has submitted that the Registrant has no legitimate interest in the Domain Name as the Domain Name at issue is not associated with an active website, and in support refers to the decisions in *Coca-Cola Ltd. V. Hennan* (CIRA -00014) in addition to *Viacom International Inc. v. Harvey Ross Enterprises Ltd.* (CIRA – 00015).
23. Paragraph 3.4 of the Policy requires that the Complainant provide some evidence that the Registrant has no legitimate interest in the Domain Name.

24. The Complainant has provided sufficient evidence that the Domain Name is not associated with an active website and as per the case law cited above, has therefore satisfied its initial burden.
25. It therefore becomes incumbent on the Registrant to provide evidence that it has a legitimate interest in the Domain Name. Since the Registrant did not provide a response to the Complaint, the Panel is limited to reviewing the Complainant's Complaint.
26. Paragraph 3.4 of the Policy sets out the following:

The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint was submitted:

- (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 used 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 used 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 web site.

27. The Registrant cannot rely on 3.4(a) of the Policy. The Domain Name may be a Mark, but it is the Complainant's Mark. The Complainant has not licensed or otherwise authorized the Registrant to use the Mark or register it as a domain name.

28. The Registrant cannot rely on 3.4(b) or 3.4 (c) of the Policy. The Domain Name is neither clearly descriptive nor a generic name, but is an inherently distinctive coined word.
29. The Registrant cannot rely on 3.4(d) of the Policy as the Domain Name is not being used in association with criticism, review or news reporting.
30. The Registrant cannot rely on 3.4(e) of the Policy as the Domain Name is not the legal name or other identifier of the Registrant.
31. The Registrant cannot rely on 3.4 (f) of the Policy as the Domain Name has no relation to the geographical name of the Registrant's place of business.
32. In view of the above, the Panel concludes that the Registrant has no legitimate interest in the Domain Name.

H. CONCLUSION AND DECISION

33. 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.
34. The Complainant has proven, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith
35. The Complainant has adduced some evidence that the Registrant has no legitimate interest in the Domain Name.
36. The Registrant did not file a response disputing the Complainant's submissions or justifying its registration of the Domain Name.
37. For these reasons the complaint regarding the Domain Name is successful and the Panel orders, pursuant to paragraph 4.3 of the Policy, that the registration of the Domain Name asurion.ca be transferred to the Complainant.



Peter C. Cooke
Dated November 5, 2014