

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

DECISION

Domain Name: norlevo.ca
Complainant: Laboratoire HRA - Pharma
Registrant: Dominique Ferland
Registrar: Tucows.com Co.
Service Provider: ResolutionCanada Inc.
Panel: Eric Macramalla

A. THE PARTIES

1. The Complainant is Laboratoire HRA - Pharma (the “Complainant”).
2. The Registrant is Dominique Ferland (the “Registrant”).

B. DISPUTED DOMAIN NAME & REGISTRAR

3. The disputed domain name is norlevo.ca (the “Domain Name”).

C. PROCEDURAL HISTORY

4. This is a dispute resolution proceeding initiated pursuant to the *CIRA Domain Name Dispute Resolution Policy* (the “Policy”) and the *CIRA Policies, Rules, and Procedures - CIRA Domain Name Dispute Resolution Rules* (the “Rules”). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of this dispute pursuant to the Policy and the Rules.
5. The Complainant filed its complaint (the “Complaint”) on August 31, 2012. The Date of Commencement of the proceeding was September 19, 2012.
6. The Registrant was provided 20 days to respond to the Complaint. No Response was filed.
7. On October 31, 2012, the Panel was appointed. As prescribed by the Policy, the Panel has declared to the Provider that it can act impartially and independently in connection with this matter, and that there are no circumstances known to the Panel which would prevent it from so acting.

D. CANADIAN PRESENCE REQUIREMENTS: ELIGIBILITY OF THE COMPLAINANT

8. The Complainant is eligible to initiate these proceedings on the basis that it satisfies Section 2(q) of the CIRA’s Canadian Presence Requirements, namely that it is the owner of the Canadian trade-mark registration for NORLEVO.

E. THE POSITIONS OF THE PARTIES

The Complainant's Position

9. The Complainant is the owner of the Canadian trade-mark registration NORLEVO, Registration No. TMA751464. The Complainant is also the owner of common law trade-mark rights in the NORLEVO trade-mark dating back to 2001 (collectively, the "NORLEVO Trade-mark").
10. In 2001, the Complainant entered into a Distribution Agreement with Garvinci Inc. for the commercialization of a contraceptive product. The Agreement provided that upon its termination, Garvinci would cease all use of the NORLEVO trade-mark.
11. In 2006, the Registrant registered the Domain Name.
12. In 2011, the Complainant terminated its Agreement with Garvinci.
13. The Complainant has been awarded significant monetary damages in connection with a Court Action in France related to Garvinci's breach of contract. Garvinci did not appear and was noted in default.
14. Garvinci has claimed that it is owed compensation.
15. The Domain Name is confusingly similar with the NORLEVO Trade-mark as the Domain Name is identical to the NORLEVO Trade-mark.
16. The Registrant does not have a legitimate interest in the Domain Name. The Registrant registered the Domain Name in bad faith.
17. The Complainant is seeking the transfer of the Domain Name.

The Registrant's Position

18. A timely response was not filed by the Registrant. Following the expiration of the period within which to respond, the Registrant issued email correspondence to the Panel indicating that it registered the Domain Name on behalf of Garvinci as its consultant. The Registrant's relationship with Garvinci ended in 2007, and the Domain name was to be transferred to Garvinci thereafter. The login information to the account was provided to Garvinci. However, the transfer was not completed. Garvinci, however, did renew the Domain Name. The Panel has no reason to doubt the Registrant's veracity on the matter and appreciates that transferring dot-ca domain names can be challenging at times.

G. DISCUSSION & REASONS

19. In accordance with paragraph 4.1 of the Policy, to succeed in this proceeding, the Complainant must prove, on a balance of probabilities, that:

- (a) the Registrant's 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 of the Policy;

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 of the Policy.

CONFUSINGLY SIMILAR - PARAGRAPH 3.3

20. In order to satisfy this branch of the test, the Complainant must demonstrate (i) that it has rights in a mark, (ii) that the rights in its mark predate the registration date of the Domain Name, and (iii) that the Domain Name is confusingly similar with the disputed domain name.

Rights in the Marks & Rights that Predate the Domain Name Registration Dates

21. Where the Complainant relies upon a trade-mark registered prior to the domain name registration date, the Policy does not require or permit a Panel to go behind the registration to determine whether the mark is valid or invalid based upon lack of distinctiveness or non-use. In cases where a trade-mark registration matured to registration after the domain name registration date, or the Complainant is relying on common law rights, it must establish rights that predate the domain name registration.
22. The Complainant's NORLEVO Trade-mark matured to registration after the Domain Name registration date. The Panel is satisfied that the Complainant is the owner of common law rights in the NORLEVO trade-mark.
23. In light of the foregoing, the Complainant has established that it has the requisite rights in the NORLEVO trade-mark.

Confusingly Similar

24. As per paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if the domain name so nearly resembles the mark in appearance, sound or in the ideas suggested by the mark so as to be likely to be mistaken for the mark.
25. Pursuant to paragraph 1.2 of the Policy, a domain name is defined as the second level domain (the portion that immediately precedes the dot-ca suffix).
26. The test to be applied when considering "confusingly similar" is one of first impression and imperfect recollection. The Complainant must prove, on a balance of probabilities, that a person, as a matter of first impression, knowing the

Complainant's corresponding marks only, and having an imperfect recollection of the marks, would likely confuse the Domain Name for the Complainant's marks based upon the appearance, sound or the ideas suggested by the mark.

27. It should be noted that the test for confusion under the Policy is not the same test for confusion set out under the Canadian *Trade-marks Act*. Under the Section 6(5) of the *Trade-mark Act*, when assessing the likelihood of confusion between marks, the factors to consider are as follows: (a) the inherent distinctiveness of the marks and the extent to which they have become known; (b) the length of time the marks have been in use; (c) the nature of the wares, services, or businesses; (d) the nature of the trade; (e) the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them; and (f) the surrounding circumstances.
28. In contrast, the Policy provides that confusion is established if a domain name so nearly resembles a mark in appearance, sound or in the ideas suggested. This is similar to the test set out under Section 6(5)(e) of the *Trade-marks Act*. However, the remaining factors as set out under the *Trade-marks Act* do not apply to the assessment of confusion under the Policy. The Policy's summary proceedings are ill-suited for the in-depth and traditional confusion analysis contemplated by the *Trade-marks Act*.
29. The Domain Name is comprised exclusively of the NORLEVO trade-mark. Under the circumstances, the Panel is of the view that the Domain Name is confusingly similar with the NORLEVO trade-mark.

Conclusion - Confusion

30. The Panel finds that the Domain Name is confusingly similar with the NORLEVO trade-mark in which the Complainant had rights prior to the registration date of the Domain Name, and continues to have such rights.

BAD FAITH REGISTRATION

31. It appears that Garvinci is maintaining control over the Domain Name in an attempt to extract payment from the Complainant. As per the Agreement, the Domain Name should have been transferred to the Complainant upon termination. However, it was not. In the view of the Panel, a terminated licensee should not be permitted to leverage a licensor's intellectual property with a view to extracting some type of benefit. This cannot be said to be *bona fide* or good faith dealing with a domain name.
32. In light of the foregoing, the Panel finds that the Complainant has established bad faith as per paragraph 3.5.

LEGITIMATE INTEREST

33. The final element to determine is whether the Registrant has a legitimate interest in the Domain Name.

34. As per paragraph 4.1 of the Policy, the Complainant must provide “some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.6”.
35. Once this onus has been discharged by the Complainant, the Registrant may still succeed if it can show, on a balance of probabilities, that it has a legitimate interest in the Domain Name pursuant to paragraph 3.4.
36. The Panel finds that the Complainant has provided sufficient evidence that there is an absence of legitimate interest and nothing was submitted that would alter the Panel’s conclusion.

DECISION & ORDER

37. For the reasons set out herein, the Panel decides this dispute in favour of the Complainant.
38. Pursuant to paragraph 4.3 of the Policy, the Panel orders the transfer of the domain name norlevo.ca to the Complainant.

Dated at Ottawa, Ontario, Canada, this 21st day of November, 2012.



Eric Macramalla
Chair