

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

DECISION

Domain Name: cathaydragon.ca
Complainant: Cathay Pacific Airways Limited
Registrant: John Dieleman
Registrar: HEXONET Services Inc.
Service Provider: Resolution Canada Inc.
Panelist: Alessandro Colonnier

A. THE PARTIES

1. The Complainant is Cathay Pacific Airways Limited (the “Complainant”), with an address at 550 West 6th, Unit 500, Vancouver, British Columbia, Canada V5Z 4S2.
2. The Registrant is John Dieleman, (the “Registrant”), with an address at Rue Pasteur, Cabourg, France 14390.

B. DISPUTED DOMAIN NAME & REGISTRAR

3. The disputed domain name is cathaypacific.ca (the “Domain Name”) and the Registrar is HEXONET Services Inc.

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 July 5, 2016.
6. The Registrant did not file a response.
7. On August 3, 2016, 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 submits that it satisfies paragraph 2(d) of the *CIRA Canadian Presence Requirements for Registrants*, Version 1.3 (the “CPRR”) as it is a

Canadian corporation with a registered address in Canada. The Panel accepts this position.

E. THE POSITION OF THE COMPLAINANT

9. The Complainant is a Hong Kong based airline offering scheduled passenger and cargo services to 173 destinations around the world. The Complainant was founded in 1946 and today has a fleet of more than 140 wide body aircrafts.
10. Dragonair is a wholly-owned subsidiary of the Complainant, and on January 28, 2016, the Complainant announced that Dragonair would be rebranded to Cathay Dragon. On the same day, a trademark application was filed in Canada for the design mark “Cathay Dragon”.
11. The Complainant also owns a multitude of trademark applications and registrations in various jurisdictions around the globe, for the word or design mark “CATHAY PACIFIC”. Specifically, the Complainant has three trademark registrations in Canada, two of which for “CATHAY PACIFIC” and another for “Dragonair” (the “Cathay Marks”).
12. The Complainant alleges that the Domain Name is confusingly similar with the Complainant’s Cathay Marks as the Domain Name is simply a combination of a part of the Cathay Marks. The Complainant further alleges that there is a likelihood of confusion given the Complainant’s Canadian trademark application for CATHAY DRAGON & New Brush Wing Design (the “Cathay Dragon Application”), which comprises the words “Cathay Dragon” together.
13. The Complainant further alleges that the Registrant registered the Domain Name in bad faith given the timing of the registration, which was a mere two days after the Complainant made its aforementioned rebranding announcement. The Complainant contends that bad faith can also be made out on the grounds that the Registrant is asking for EUR 7,999 for the sale of the website; well in excess of the Registrant’s out of pocket expenses.
14. Finally, the Complainant alleges that the Registrant does not have a legitimate business interest in this domain as he is simply offering the website for resale with no bona fide connection to the name Cathay Dragon.
15. The Complainant has requested the transfer of the Domain Name to it.

F. DISCUSSION & REASONS

16. The Policy sets out at paragraph 4.1 what the Complainant must establish in order to successfully prove the Complaint and transfer the Domain Name to it. Paragraph 4.1 reads:

To succeed in the Proceeding, the Complainant must prove, on the balance of probabilities, that:

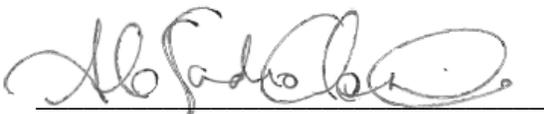
- (a) the Registrant's Domain Name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights; and
 - (b) the Registrant has registered the domain name in bad faith as described in paragraph 3.5 of the Policy;
- 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.
- 17. Paragraph 3.2 of the Policy further stipulates that a "Mark" is either of:
 - (a) a trade-mark, including the word elements of a design mark, or a trade name 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 the person's predecessor in title, for the purpose of distinguishing 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).
- 18. In its submissions, the Complainant asserts that by "virtue of its trademark and service mark registrations (...) the Complainant is the owner of the Complainant's Marks". The Complainant further states that the "Respondent's domain name consists of the two terms "CATHAY" and "DRAGON", which combined are identical to the Complainant's CATHAY DRAGON trademark application and confusingly similar to the well-known CATHAY PACIFIC and DRAGONAIR trademarks, in which the Complainant had rights prior to the date of registration of the Domain Name".
- 19. The Complainant relies entirely on the use of its trademark registrations and its trademark application in Canada, in accordance with the first portion of Subparagraph 3.2(a) of the Policy (relating to trademarks rather than trade name) and Subparagraph 3.2(c) of the Policy.
- 20. However, the Panel notes that the Complainant is a Canadian company with an address in British Columbia. However, the trademark registrations, as well as the

trademark application as provided by the Complainant are in the name of “Cathay Pacific Airways Limited”, a company with an address in Hong Kong.

21. The Panel notes that the trademark registration TMA291165 for CATHAY PACIFIC was originally filed and registered by the Complainant; however, an assignment was made in 2001, assigning TMA291165 from the Canadian Cathay Pacific company to the current owner of TMA291165 being the Hong Kong Cathay Pacific company.
22. Based on the evidence provided in the Complaint and the information on the Canadian trademarks register, the Panel necessarily concludes that the Complainant is a different corporate entity to the owner of the Cathay Marks and the Cathay Dragon Application. Indeed, had the entities been the same, a change of address, rather than an assignment, would have sufficed. No other evidence was provided by the Complainant to define the relationship between the Complainant with its Canadian address and the Hong Kong company.
23. The Panel further notes that although the second portion of Subparagraph 3.2(a) allows for a “Mark” to include the trade name of a complainant; the present Complaint does not make such an argument and instead relies entirely on the trademark registrations and application belonging to a separate entity.
24. As the Complainant is a Canadian company with an address in British Columbia, while the owner and therefore rights holder of the Cathay Marks is a Hong Kong company with an address in Hong Kong, the Panel concludes that the Complainant does not and did not have rights in a Mark prior to the date of registration of the Domain Name, pursuant to the Complainant’s submissions based on the first portion of Subparagraph 3.2(a) (as it relates to trademarks) and Subparagraph 3.2(c). No other submissions were made.
25. In view of the Panel’s finding relative to Paragraph 4.1(a) of the Policy, the Panel finds it unnecessary to delve into Paragraphs 4.1(b) or 4.1(c) of the Policy.

G. CONCLUSION AND DECISION

26. The Panel finds that based on the Complainant’s submissions, the Registrant’s Domain Name is not confusingly similar to a Mark in which the Complainant had rights prior to the date of registration pursuant to paragraph 4.1(a) of the Policy.
27. For this reason, the Complaint against the Domain Name cathaydragon.ca is dismissed. The Panel notes that this decision is made without prejudice to the Complainant from seeking relief and alleging rights in a Mark based on its trade name rather than trademarks.



Alessandro Colonnier for the Panel

August 15, 2016.