

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

DECISION

Domain Name: panavision.ca

Complainant: Panavision International, L.P.

Registrant: Daniel Mullen c/o/b Netnic Corporation

Registrar: rapidregister.ca

Service Provider: Resolution Canada

Panelist: Eric Macramalla (Chair), James Plotkin and Daria Strachan

A. THE PARTIES

1. The Complainant is Panavision International, L.P. (the “Complainant”), which is a company organized under the laws of Delaware.
2. The Registrant is Daniel Mullen c/o/b Netnic Corporation (the “Registrant”) located in Charlottetown, P.E.I.

B. DISPUTED DOMAIN NAME & REGISTRAR

3. The disputed domain name is panavision.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 30, 2018. The Date of Commencement of the proceeding was September 12, 2018.
6. The Registrant’s Response was deemed deficient by the Provider on the basis that 29 of the 31 pages submitted were blank. The Response did not raise any defences and only included the Registrant’s Certification. A Notice of Deficient Response was issued by the Provider on October 5, 2018 providing the Registrant with the opportunity to file an Amended Response, which it did not.
7. On October 29, 2018 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 the owner of multiple Canadian trademark registrations comprised of, or containing, the element PANAVISION. The Panel is therefore satisfied that the Complainant is eligible to initiate these proceedings.

E. THE POSITIONS OF THE PARTIES

The Complainant's Position

9. The Complainant's submissions include the following.
10. The Complainant is a U.S.-based company having been organized under the laws of Delaware. The Complainant, and its related and affiliated entities, provide a comprehensive suite of end-to-end production and post production services to the largest studios, networks, independent production companies and over-the-top ("OTT") content streaming providers and social media platforms. The Complainant and its affiliates are one of the world's most recognized providers of ultra-precision digital imaging and visual cinematographic equipment, including cameras, optical lenses, photographic equipment, lighting, and other accessories for the motion picture, television, and related industries. The Complainant's business was founded in 1954 to design and manufacture wide-screen film photographic and projection lenses. Since that time, the Complainant has consistently been at the forefront of cinematographic equipment development, and viewers of motion pictures and other visual arts have come to associate the Complainant with a high-quality visual experience. Currently, the Complainant provides equipment and services in Canada, the United States, and around the world, which are available through its affiliates in North America, South America, Europe, Africa, Asia, and the Pacific.
11. The Complainant is the owner of the following Canadian trademark registrations, which shall be collectively referred to as the PANAVISION Trademarks:

Trademark	Reg. No.	Reg. Date
PANAVISION	TMA355556	1989-05-05
PANAVISION	TMA387278	1991-08-02
PANAVISION	TMA272100	1982-08-27
PANAVISION & Design	TMA620379	2004-09-22
PANAVISION NOVA	TMA863820	2013-10-29
SUPER PANAVISION 70	TMA903987	2015-05-20

12. The Domain Name is confusingly similar with the PANAVISION Trademarks. Further, the Registrant does not have a legitimate interest in the Domain Name. Finally, the Registrant registered the Domain Name in bad faith as (i) the Registrant engaged in a pattern of unauthorized domain name registrations containing third party trademarks, (ii) the Registrant registered the Domain Name primarily for the purpose of disrupting the business of the Complainant, a

competitor, and (ii) the Registrant registered the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement.

13. The Complainant is seeking the transfer of the Domain Name.

The Registrant's Position

14. The Registrant filed a deficient Response comprised only of cover page and a Registrant Certification. The Registrant was invited to amend the Complaint, but failed to provide a response.

F. DISCUSSION & REASONS

15. 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

16. 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

17. Where the Complainant relies upon a trademark 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 trademark 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.
18. The Domain Name was registered on August 2, 2017.

19. The PANAVISION Trademarks issued to registration well before the August 2, 2017 registration date of the Domain Name. Therefore, the Panel concludes that the Complainant has established rights that precede the registration of the Domain Name.

Confusingly Similar

20. 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.
21. 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).
22. 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.
23. 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-marks 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.
24. 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*.
25. The Panel concludes that the Domain Name is confusingly similar with the Complainant’s PANAVISION Trademarks, given that the Domain Name so nearly resembles the PANAVISION Trademarks in appearance, sound and in the ideas suggested so as to be likely to be mistaken for these marks. The Domain Name is comprised exclusively of the PANAVISION trademark, and as a result, the Registrant cannot escape a finding of confusing similarity.

Conclusion - Confusion

26. The Panel finds that the Domain Name is confusingly similar with the PANAVISION Trademarks in which the Complainant had rights prior to the registration date of the Domain Name, and continues to have such rights.

BAD FAITH REGISTRATION

27. The Complainant has alleged that the Registrant has engaged in a pattern of unauthorized domain name registrations containing third party trademarks to which it is not entitled. Specifically, the Complainant has relied upon previous CDRP decisions involving the Registrant and directed the Panel to the following unauthorized domain names registered by the Registrant, including Daniel Mullen: birkenstocks.ca, oscardearenta.ca, chipotles.ca, royalcanadianlegion.ca, balenciaga.ca, louisvilleslugger.ca, cadillacs.ca, and canadagoosestore.ca
28. Paragraph 3.5(b) provides, in part, that the Complainant must establish that the Registrant “*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 is that of the Panel]
29. The Policy does not, therefore, impose a temporal limitation on which unauthorized domain name registrations the Complainant may rely upon when establishing a “pattern” of registrations. The Complainant may rely upon domain names previously owned by the Registrant to establish a “pattern”.
30. On this basis, the Panel concludes that these registrations constitute evidence of bad faith registration as per Paragraph 3.5(b).
31. The Complainant has also alleged that the Domain Name was registered in bad faith pursuant to paragraph 3.5(d) of the Policy, namely that the Registrant registered the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s marks as to the source, sponsorship, affiliation, or endorsement.
32. The Domain Name is comprised exclusively of the PANAVISION trademark. Under the circumstances, the Panel is of the view that the Domain Name is likely to confuse potential consumers into believing that the Registrant is somehow affiliated with, or endorsed by, the Complainant. Furthermore, resolving the disputed domain name to a pay-per-click website in these circumstances featuring sponsored links to competitors of the Complainant is evidence of bad faith. The website puts the Registrant in a position to reap a financial benefit by way of referral fees. Accordingly, the Panel concludes that bad faith does indeed exist as per Paragraph 3.5(d).
33. The Panel acknowledges that Mr. Mullen and related companies continue to be named as Registrants in disputes before the Policy. Indeed, Mr. Mullen continues to engage in an extensive pattern of unauthorized domain names registrations

without regard to rights holders. Under the circumstances, the Panel concludes that Mr. Mullen is serial cybersquatter.

LEGITIMATE INTEREST

34. The final element to determine is whether the Registrant has a legitimate interest in the Domain Name.
35. 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”.
36. 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.
37. The Panel finds that the Complainant has provided sufficient evidence that the Registrant does not have a legitimate interest in the Domain Name. The Complainant did not authorize the registration and the domain name is likely to mislead the public into believing that the Registrant is affiliated with, or endorsed by, the Complainant.
38. In cases where a domain name is an exact match for a brand owner’s trademark, the initial assumption will be that a registrant does not have a legitimate interest in said domain absent an agreement to the contrary between the parties. Nothing in the record displaces this assumption.
39. Accordingly, the Panel finds that the Registrant does not have a legitimate interest in the Domain Name.

DECISION & ORDER

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

Dated at Ottawa, Ontario, Canada, this 21st day of November, 2018.



Eric Macramalla (Chair)
Daria Strachan