

**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

***DISSENTING REASONS***

**Introduction**

1. I agree with the Majority of the Panel's Decision in all respects but one. In particular, I agree that the Complainant has successfully demonstrated that: 1) it meets the Canadian presence requirement; 2) the Registrant's Domain Name is confusingly similar to several marks in which the Complainant has subsisting rights predating the Domain Name's registration; and 3) the Registrant has no legitimate interest in the Domain name.
2. Where the Majority and I part company is with respect to the bad faith registration requirement at paragraph 3.1(c) of the Policy. In my view, the arguments put forward by the Complainant fail to make out a case for bad faith registration.
3. Before proceeding, I wish to make abundantly clear that these reasons should not be construed as condoning the Registrant's use of the Domain Name as a pay-per-click "domaining" page. However, for the reasons that follow, I do not believe any of the arguments the Complainant advanced demonstrate bad faith registration. In my respectful view, it is not for the Panel to adjudicate beyond those submissions, no matter how blatantly the Registrant violates the Policy.

**Analysis**

4. The Complainant argued in its written materials that the Domain Name was registered in bad faith pursuant to subparagraphs 3.5 (b), (c) and (d) of the Policy. Those provisions read as follow:

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:

...

(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;

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

3.5(b)

5. 3.5(b) describes "passive warehousing" [see: Bernadette Dino, "Passive Warehousing Under ICANN's Uniform Dispute Resolution Policy: A Utilitarian Perspective", (2002) 10 CommLaw Conspectus 301]. This occurs when a registrant registers a domain name that resembles a trademark but, unlike classic cybersquatting, never makes offers to sell the domain name or otherwise uses it to construct an active web site [Ibid, p. 301]. The Registrant is not engaging in passive warehousing.
6. Although the Complainant amply demonstrated Mr. Mullen's long pattern of registering domain names, there is no evidence his motive in this case was to prevent the Complainant from registering the impugned Domain Name. Pay-per-click landing pages like this are "active" in that they are designed to attract traffic, often using search engine optimization and other techniques, to generate advertising revenue. The Registrant therefore does not appear to have registered the Domain Name to block the Complainant from doing so (perhaps in an attempt to solicit an offer), but rather to generate revenue, Complainant's wishes be damned.

3.5(c)

7. With respect to paragraph 3.5(c), there is no evidence the Registrant acted with intent to disrupt the Complainant's business. In a perverse way, the Registrant's

pay-per-click scheme is actually furthered when the Complainant's business thrives. After all, the more times "Panavision" is searched online, the more likely the Registrant's traffic flow will increase.

3.5(d)

8. Finally, the Complainant argued that the registration contravenes paragraph 3.5(d). This provision is similar to, and appears to be inspired by, the tort of passing off. In the interest of transparency, I reproduce the Complainant's argument under this head in its entirety:

The Registrant is using the Domain Name as a revenue generating business.

The Registrant was undoubtedly aware of the existence of the Complainant's PANAVISION® Marks, websites and brand at the time of registration of the Domain Name. The evidence shows that the Domain Name resolves to a landing page where Internet users can find a number of related links and "Sponsored Listings" (i.e., advertisements) for various third-party websites relating to cameras, lenses, and related goods and/or services. The Registrant generates revenues for the related links and ads published on the web page whenever an Internet user visits the website and clicks one of the links or ads.

The Registrant's practice of profiting from the misdirection of Internet traffic and the links and ads for various third parties on its websites has been noted and detailed in the decisions of prior CDRP panels [see, for example, *Optrex Limited. v. Nameshield Inc.* (CDRP Dispute No. 00274; December 17, 2014), attached as Schedule G.3, at paragraphs 47 and 48].

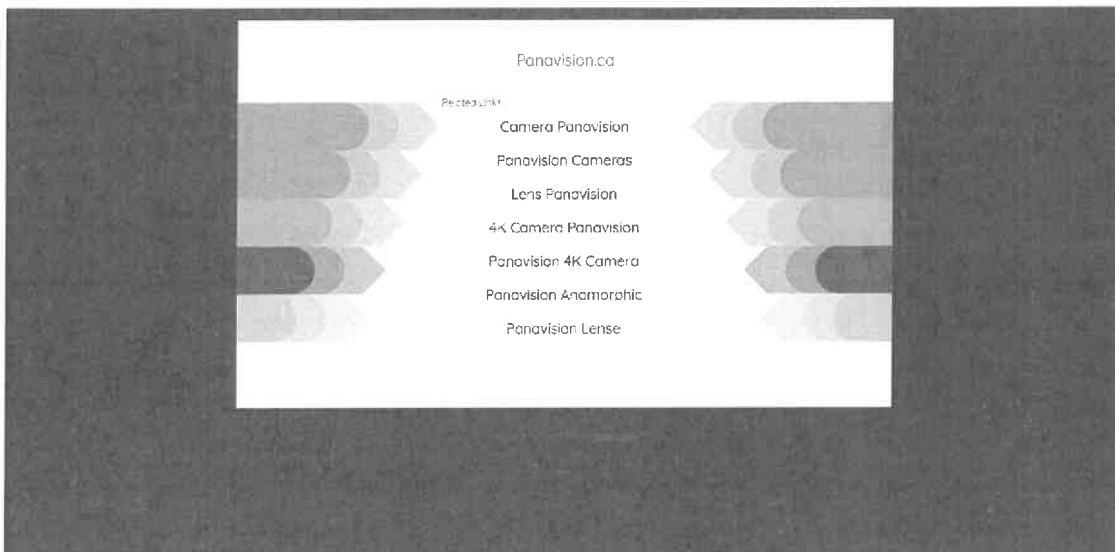
In view of the above and consistent with the Registrant's previous practice, the Complainant submits that the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website and has therefore obtained the Domain Name in bad faith pursuant to paragraph 3.5(d) of the Policy.

Copies of CDRP decisions referred to in the Particulars of the Complaint are attached as Schedules L.1 to L.5.

9. Even a generous reading of these submissions does not permit me to conclude 3.5(d) applies here. Fundamentally lacking in the Complainant's position is the assertion and proof that the website itself would lead to a likelihood of confusion causing one to think this was the Complainant's website, or that it was a website

endorsed by, sponsored by or affiliated with the Complainant. The facts do not bear out that conclusion.

10. Having viewed the landing page, I find that no reasonable person navigating there could possibly think he or she landed on a website the Complainant endorsed, sponsored or otherwise affiliated itself with:



11. Indeed, upon reaching the landing page, the visitor would likely realize instantly he or she had not reached the Complainant's website or one affiliated with it. The Complainant is unlikely to feature "Related Links" as the centerpiece of its legitimate website, and to gratuitously and repeatedly display its name and key words relating to its industry, a common SEO click generation tactic. Text like "Camera Panavision" followed immediately by "Panavision Cameras" demonstrates textbook and obvious SEO.
12. At paragraph 32 of its reasons, the Majority draws a presumption from the identity between the Domain Name and the Complainant's trademark:

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.
13. With respect, this answers a question subparagraph 3.5(d) does not pose. Confusing similarity is addressed at the first stage of the analysis under subparagraph 3.1(a) and paragraph 3.3 of the Policy. A careful reading reveals that subparagraph 3.5(d) is not concerned with the Domain Name, but the content one sees upon navigating to it.
14. Subparagraph 3.5(d) is different from 3.5(a)-(c). Each of the first three subparagraphs focus on the *domain name* and the purpose for which it was

registered. In contrast, 3.5(d) focuses on the *website*. Subparagraph 3.5(d) asks following question: now that the visitor is on the page, is there a likelihood of confusion such that the visitor would think the website is the source of the Complainant's goods or services, or that the Complainant endorses, sponsors or affiliates itself with the website?

15. In this case, the answer is clearly "no". The Complainant goes on at length in its submissions about its rich history in the film industry and manufacture of ultra-precision digital imaging and visual cinematographic equipment [Complaint, p. 5]. It is hard to believe a class-leading, multinational corporation like the Complainant and its related group of companies would associate themselves with the website one sees upon navigating to the Domain Name.
16. In light of the foregoing, it is my respectful opinion that the Complainant has not made out a case for bad faith registration as the Registrant's conduct does not fall under any of subparagraphs 3.5(b)-(d) of the Policy.
17. It makes sense that the Registrant's conduct (i.e. pay-per-click revenue generation) falls outside the four "cookie cutter" bad faith registration categories. Paragraph 3.5 is based on paragraph 4b of the ICANN Uniform Dispute Resolution Policy (UDRP):

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location.

18. I pause to note that CDRP panels should exercise caution in relying upon UDRP provisions and decisions since the policies are not identical. Unlike the UDRP, the Policy does not require a complainant to demonstrate the domain name has been used in bad faith, only bad faith registration. However, the resemblance between UDRP paragraph 4b and paragraph 3.5 (and subparagraphs 4b(iv) and 3.5(d) in particular) is uncanny. The former clearly influenced the latter [See for example: Michael Geist, *New rules for domain disputes* (Toronto Star, August 2011) [https://www.thestar.com/business/2011/08/06/geist\\_new\\_rules\\_for\\_domain\\_disput es.html](https://www.thestar.com/business/2011/08/06/geist_new_rules_for_domain_disput_es.html)].
19. The UDRP came into effect in October 1999 [*Timeline for the Formulation and Implementation of the Uniform Domain-Name Dispute-Resolution Policy*: <https://www.icann.org/resources/pages/schedule-2012-02-25-en>]. This was several years before pay-per-click domaining became a phenomenon. It therefore should surprise no one that the four bad faith examples listed at paragraph 3.5 of the Policy and 4b of the UDRP do not contemplate such activity.
20. As noted at paragraph 3 above, these reasons should not be taken as endorsing the Registrant's conduct, nor should they be read as concluding that the Domain Name

was not registered in bad faith, or that pay-per-click domaining websites like the one in issue are acceptable under the Policy.

21. A complainant under the Policy is not limited to the cookie cutter examples of bad faith registration listed in paragraph 3.5. The prefatory portion notes the four examples are just that, and not an exhaustive list of what amounts to bad faith registration:

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... (Emphasis added)

22. The Complainant might have advanced other arguments allowing it to meet the bad faith registration requirement. It chose not to despite its otherwise very complete and probative submissions.
23. While I ultimately agree with the Majority's proposed outcome, I am of the view that the Panel lacks the authority to reach it in this case as doing so would be to adjudicate beyond the parties' submissions.
24. Rule 12.1 sets out the applicable law under the Policy:

12.1 Applicable Law. A Panel shall render a decision in a Proceeding on the basis of the evidence and argument submitted and in accordance with the Policy, the Resolution Rules and any rules and principles of the laws of Ontario, or, if the Registrant is domiciled in Quebec, the laws of Quebec, or, if a preference for the laws of another province or territory has been indicated by both parties, the laws of the other province or territory and, in any event, the laws of Canada applicable therein. (Emphasis added)

25. As I have concluded that the argument the Complainant submitted falls short on the bad faith registration prong, I am without authority to reason based on what the Complainant might have argued.
26. This is also consistent with the "principles of the laws of Ontario". Like all common law jurisdictions, Ontario follows the adversarial system. The Ontario Court of Appeal has made clear that *sua sponte* reasoning (i.e. adjudicating beyond the parties' submissions) is unfair and amounts to a reviewable error:

[60] It is fundamental to the litigation process that lawsuits be decided within the boundaries of the pleadings. As Labrosse J.A. said in 460635 Ontario Limited v. 1002953 Ontario Inc., [1999] O.J. No. 4071 at para. 9 (C.A.) (QL):

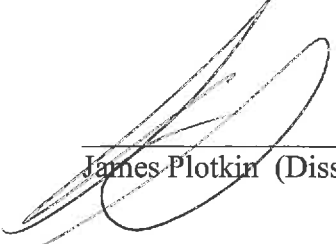
. . . The parties to a legal suit are entitled to have a resolution of their differences on the basis of the issues joined in the pleadings. A finding of liability and resulting damages against the defendant on a basis that was not pleaded in the statement of claim cannot stand. It deprives the defendant of the opportunity to address that issue in the evidence at trial. . .

[61] By stepping outside of the pleadings and the case as developed by the parties to find liability, Spence J. denied RBC and Barbican the right to know the case they had to meet and the right to a fair opportunity to meet that case. The injection of a novel theory of liability into the case via the reasons for judgment was fundamentally unfair to RBC and Barbican. (Emphasis added)

[62] In addition to fairness concerns which standing alone would warrant appellate intervention, the introduction of a new theory of liability in the reasons for judgment also raises concerns about the reliability of that theory. We rely on the adversarial process to get at the truth. That process assumes that the truth best emerges after a full and vigorous competition amongst the various opposing parties. A theory of liability that emerges for the first time in the reasons for judgment is never tested in the crucible of the adversarial process. [*Rodaro v. Royal Bank of Canada*, [2002] O.J. No. 1365, 59 O.R. (3d) 74 (C.A.)]

27. This applies equally to arbitration [*Hercus v. Hercus*, [2001] O.J. No. 534, para. 75, 103 A.C.W.S. (3d) 340].
28. I note in passing it is not lost on me that the Registrant made no submissions. He curiously provided the first and last pages of what would normally make up a response, but with several blank pages in the middle. It is unclear whether this was intentional or careless. In any event, and his cavalier attitude toward these proceedings notwithstanding, the Registrant's non-participation does not merit lowering the Complainant's burden.
29. For these reasons, and despite agreeing with the Majority's conclusion, the Complainant's submissions do not permit me to find bad faith registration under subparagraph 3.1(c) of the Policy. I would therefore dismiss the Complaint.

Dated at Ottawa, Ontario, Canada, this 22<sup>nd</sup> day of November, 2018.

  
James Plotkin (Dissenting)