

**IN THE MATTER OF A COMPLAINT PURSUANT
TO THE CANADIAN INTERNET REGISTRATION AUTHORITY (“CIRA”)
DOMAIN NAME DISPUTE RESOLUTION POLICY (“the POLICY”)**

Dispute Number: DCA-1426-CIRA
Complainant: Research In Motion Limited
Registrant: Mr. Andy Drews
Disputed Domain Names: blackberry10.ca
Registrar: Can Reg
Arbitrator: Mr. Claude Freeman
Service Provider: British Columbia International Commercial Arbitration Centre (the “BCICAC”)

BCICAC FILE NUMBER: DCA-1426-CIRA

On September 24, 2012, the Complainant filed a complaint (dated September 17, 2012) against the Registrant, with the BCICAC, seeking that the Registrant’s registration of <blackberry10.ca> be transferred to the Complainant.

The complaint filed by the Complainant was reviewed by the BCICAC and on September 27, 2012 was found to be in administrative compliance with the Policy and Rules. In accordance with the provisions of Rule 4.3, and by email dated September 27, 2012, the BCICAC, as dispute resolution service provider, so advised the parties and forwarded by mail (and three emails) a copy of the complaint to the Registrant for his response. Further mail notifications of the arbitration process (including the appointment of the herein arbitrator) were sent by the BCICAC to the Registrant on October 18 and 31, 2012.

To date, the Registrant has provided no response whatsoever.

Accordingly, in the absence of a response by the Registrant, the Registrant is not in administrative compliance in the following areas:

- 1) failure to nominate candidates from the providers cost – per paragraph 5.2(c) of CDRP rules;
- 2) failure to provide a summary of and references to the relevant Canadian Law – per paragraph 5.2(f) of CDRP rules;
- 3) failure to provide a summary of and references to prior CIRA decisions that would be persuasive, and which apply to domain names registered under any other top-level domain – per paragraph 5.2(g) of CDRP rules; and
- 4) failure to conclude with the certification of the Registrant in form set out in Appendix “B”, followed by the signature of the Registrant or its authorized representative – per paragraph 5.2 (j) of CDRP rules.

As provided for by paragraph 5.6 of CDRP rules, the Registrant is permitted 10 days notice in order to remedy all instances of non-compliance.

As permitted under Rule 6.5, the Complainant elected to convert from a panel of three arbitrators to a single arbitrator, to render a decision in this matter. On October 30, 2012, the BCICAC provided the appointment of the herein, sole arbitrator, which was accepted by this arbitrator on October 30, 2012.

Background/Facts

For most consumers, readers, and internet users, including those who are users of Personal Device Assistants (“PDAs”)/Smartphone equipment, “BlackBerry” (registered to Research In Motion Limited (“RIM”)) has become synonymous with other leading names of these products such as, but not limited to: Motorola, Nokia, Samsung, and LG, to name a few. In fact, owners of PDAs/Smartphones who own devices not manufactured by RIM were in fact very likely to either see or be offered Blackberry products and product literature/brochures at the point-of-sale where they purchased their products. It is therefore safe to say, that the name BlackBerry has been, is, and is seen and heard with regularity, when shopping for PDAs/Smartphones – not to mention the various and numerous times that the name BlackBerry has been, and is heard and seen, in daily life (including the media and television events). One need simply enter the word “black” into the internet browser/search engine, to be met with the menu options of BlackBerry, and its’ related products information. In fact, it is virtually impossible to avoid the BlackBerry product names in any internet search with the prefix “black”. By way of submissions included with the complaint by the Complainant, RIM reports worldwide sales of 14.9 billion dollars (US) for the year ending February 27, 2010 and 19.9 billion dollars sales (US) for the year ending February 26, 2011. Global revenues for the business years 2009 to 2011 inclusively, are reported at 45 billion dollars (US). The irrefutable fact is that BlackBerry has become clearly synonymous with the world of PDA/Smartphone devices.

The Complainant has also submitted a copy of the 2010 BrandZ Ranking of the Top 100 Brands, and lists BlackBerry as number 14 out of 100 Global Brands ranking. Also included is Interbrand’s 2010 Global listing ranking BlackBerry as 54th most valuable brand world-wide. Another report submitted is Landor’s 2010 report of Breakaway Brands which ranks BlackBerry as third on its list of Top Ten Breakaway Brands. BlackBerry was ahead of brands such as Disney, Apple and Google.

Regardless of any basis (revenues, assets, etc.) by which the rankings are arrived at, needless to say that “BlackBerry” has earned a place alongside many other brands who are not only highly ranked, but whose names may be, or are considered household names world-wide.

Needless to say, “BlackBerry” has achieved product notoriety beyond argument and as such, name brand recognition is truly irrefutable. It would defy logic to assume that BlackBerry’s world-wide brand notoriety has been obtained by any other means than expending of incalculable resources, (financial, intense marketing/advertising, and phone service provider marketing/support, to name a few of those resources), as well as diligent trade-mark registration and ongoing protection of same.

Trade-mark registration information submitted for Blackberry in Canada dates back to November, 2001 – well ahead of the December, 2011 registration of “BlackBerry10’ by the Registrant. The complainant submits that it is the owner of the trade-mark “BlackBerry10”, which is the subject matter of this complaint, and which relates particularly to one of its’ planned

2013 product launches. As of the date of this decision, the BlackBerry 10 product has been certified / approved by the United States government as meeting its technical standards and requirements for use by its Departments and agencies. This unto itself is not an insignificant testimonial to the visibility and corporate ownership of “BlackBerry10” by the Complainant. The Complainant submits as well, that it is the owner of over 4000 trade-mark registrations and applications world-wide containing, or comprised of the element BlackBerry.

The complainant was incorporated in 1984, obtained listing on the Toronto Stock Exchange in 1997, and on the NASDAQ in 1999. The company is a global company with operations/offices in North America, Europe, Asia, Pacific, and Latin America.

It is pertinent to point out that while the prime subject matter of the complaint deals with “BlackBerry10”, the disputed domain name for the most part is made up of the BlackBerry name, which, despite the addition of “10” at the end of “BlackBerry” still refers most, if not all readers/internet users to the BlackBerry product lines.

Although, the Complainant submits that “BlackBerry10” appears to currently not be in use on the internet, it resolves to the Registrar’s default page. The date of registration by the Registrant of the disputed domain name is December 6, 2011.

The complainant submits that on June 14, 2012, it sent the Registrant a cease and desist letter to which the Registrant did not respond. The Complainant issued a follow-up letter on July 13, 2012, and for which the Registrant provided no response.

The Complainant therefore submits that the Registrant is infringing on their trade-mark via the disputed domain name “BlackBerry10”. Albeit, as noted earlier, the site is not active, in the event it was to become active, this might convey the wrong image, and have negative and expensive consequences for the Complainant.

For unsuspecting consumers, this ties in to “Confusingly similar”, and therefore would wrongly transfer potentially negative perceptions of BlackBerry.

Sites/domain names blatantly infringing on previously and properly registered, highly visible and well-known domain names, trade-marks (which are clearly owned by those with a demonstrated, and prior, legitimate interest) do nothing to enhance the credibility (for the tests of legitimate interest/confusingly similar/bad faith) of those Registrants who feel they have some free right or licence to infringe.

The Complainant therefore submits that the use of (“BlackBerry10”) is, can be, and will be confusing and distracting – with the results being that internet users, and existing/potential PDA/Smartphone customers, will be confused. This will have a damaging effect to the public image “BlackBerry”.

In short, the Complainant submits that the disputed domain name is:

- 1) Confusingly similar
- 2) Registrant has no right or legitimate interest in the domain name, and
- 3) The domain name was registered and used in bad faith.

Reasons

As noted earlier, the Registrant was not only found administratively non-compliant, but has not put forth any submissions to be reviewed in any detail. Accordingly, as per paragraph 4.1 of the CDRP policy, the onus is on the Complainant to prove on a balance of probabilities that the disputed domain names as registered by the Registrant are confusingly similar to that of the Complainant, and that they have been registered in bad faith. In addition, the Complainant is required under this paragraph to provide “some evidence” that the Registrant has no legitimate interest in the disputed domain name(s).

1. Confusingly Similar

The first test is whether the Disputed Domain Names are confusingly similar to Complainant’s domain name.

The evidence before us shows that in Canada, the Complainant has been using the BlackBerry mark both corporately, and by way of CIPO registration(s) since 2001.

In order to address the issue of confusion with the standard legal test prevailing in Canada, one can find that in determining whether or not there exists a reasonable likelihood of confusion between the trademarks at issue, the Registrant must have a regard to all the surrounding circumstances, including non-exhaustingly, those specifically enumerated in Subsection 6 (5) of the Canadian Trademarks Act.

- a) inherent distinctiveness of the trademarks, and the extent to which they have become known;
- b) length of time the trademarks have been in use;
- c) nature of wares, services or business;
- d) nature of the trade; and
- e) degree of resemblance between the trademarks in appearance or sound in the ideas suggested by them.

A generally accepted principle when applying the test of confusion is looking at the trademarks from the point of the unwary consumer – comparing similarities as opposed to differences. Can the consumer be easily misled by error or otherwise – and perhaps not even know? Could this also impact not only on the consumer, but also on other potential commercial relationships being sought with the Complainant?

There are many, past decisions under the CIRA Policy and UDRP, in which it was held that the registrations of misspellings and various renditions of famous trade-marks and trade-names amount to cyber-piracy. Refer to: AMAZON.Com Inc. v. Abraham, BCICAC File No. DCA-784-CIRA, Bell Canada v. Archer Enterprises, BCICAC File No. DCA-860-CIRA, and Canada Post Corporation v. Ferro, BCICAC File No. DCA-871-CIRA.

The Registrant's dot.ca domain is Confusingly Similar with a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights. Simply put, it was held in *Government of Canada on behalf of Her Majesty the Queen in Right of Canada v. David Bedford*, BCICAC Case No 00011, where a 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 it is valid based upon lack of distinctiveness or non-use.

In another decision, *Research In Motion Limited v. Input Inc. Domain Manager*, WIPO Case No. D2011-2197, the panel concluded and held in part, that it was "inconceivable" that the respondent could not be familiar with the "BlackBerry" trade-mark.

This Arbitrator concludes on this issue that the Complainant has met the onus of demonstrating that the disputed domain name is "confusingly similar" – as also supported in part by the "tests" applied by Subsection 6 (5) of the Canadian Trademarks Act ("a" to "e" above).

2. Legitimate Interest

A sufficient and initial proof brought on by the Complainant and pertaining to the Registrant's lack of legitimate interest forces the Registrant to rebut, explain or otherwise plead this issue, for which the Registrant has not done so. Failing to do so permits the Arbitrator to make a negative inference.

As described above, the Complainant must provide "some evidence" that the Registrant has no legitimate interest in the domain name(s), as described in Policy paragraph 4.1(c). If the Complainant satisfies this evidentiary burden, the onus shifts to the Registrant to prove on a balance of probabilities that the Registrant has a legitimate interest in the challenged domain name, for which again the Registrant has not done so.

Policy paragraph 3.4 sets forth an exhaustive list of criteria for determining whether a registrant has a legitimate interest in a domain name. It provides as follows:

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 has 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 of 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 paragraphs 3.4 (b), (c), and (d) "use" by the Registrant includes, but is not limited to, use to identify a web site.

The legitimate interest criteria set forth in Policy paragraphs 3.4 (a), (b), (c), and (d) are satisfied only if the Registrant's use was in "good faith", a term which is not defined by the Policy. This Arbitrator notes that "good faith" as used in Policy paragraph 3.4 is not necessarily the opposite of "Bad Faith" as defined in Policy paragraph 3.5.

This Arbitrator has reviewed submissions by the Complainant and absent any submissions to not only debate the Complainant's positions, but to provide any historical proof of commercial activities, and fully eliminate confusion between the Registrant and the Complainant, leaves for invalidated support for the Registrant. Furthermore, the history covered by the Complainant's submissions themselves (registrations, advertising, sales volumes et al), speaks volumes about the Complainant's right to a legitimate interest.

The Complainant registered (BlackBerry) in Canada in 2001, however, the domain name in dispute was not registered by the Registrant until 2011, and this, without any prior or existing written contract, or other form of trade-mark use or licence.

There has never been any commercial or relationship of any sort between the parties, permitting the use etc. of any of the Complainant's trade-marks or domain name by the Registrant, which could give rise to any confusion.

The Registrant has failed to justify its claim to a legitimate interest in the disputed domain name.

3. Registration in Bad Faith

The following facts lead this Arbitrator to conclude that the disputed domain names were registered in bad faith:

- 1) The Registrant himself, has, (after considerable historical and past name and product branding by the Complainant) registered a confusingly similar name.
- 2) The Registrant has provided no response to two cease and desist letters by the Complainant.
- 3) The registration of the disputed domain name seems to not be in step – or compatible with the historical corporate image of the Complainant.
- 4) The disputed name could have a confusingly and negative public image impact on the complainant.

- 5) No attempt whatsoever has been made by the Registrant to provide any answers, rebuttals, support or evidence for the registration of the disputed domain names.
- 6) Where the Registrant would seemingly have some justification for the registrations, the Registrant has put forward no evidence to support his conduct. See *Musician's Friend Inc. v. Lowcost Domains Inc.*, CIRA Dispute No. 00074, citing in turn *Canadian Broadcasting Corporation/Société Radio-Canada*.

All of the foregoing is irreconcilable, and sustains the conclusion that there appears to be no compelling need (or right) for the Registrant to register and keep the disputed domain name. Had there been a sound business reason to do so, it would be logical for the Registrant to counter-argue all of this. This does not suggest that any counter-argument would be successful. Websites are to be seemingly purchased for some legitimate purpose, and certainly no sound reasons have been advanced by the Registrant to support his actions. At the very least, any use made valid by any arguments that might be raised by the Registrant would have been less confusing at the outset, if he were to register a name which would be more original so as to not create any confusion, and infringe on the Complainant's name.

Balance of Probabilities

Even if a complainant has met the burdens of proof contained in Paragraph 4.1, a complaint will be dismissed if the registrant is able to prove on a balance of probabilities that the registrant has a legitimate interest in the disputed domain name. Again, such "legitimate interest" must meet one or more of the six tests set out in Paragraph 3.4 and referred to above.

This balance of probabilities test in Paragraph 4.1 of the Policy deals with the situation where even though a complainant has satisfied all of the burdens of proof contained in Paragraph 4.1, an Arbitrator believes that justice requires the Registrant to succeed. In finding against a Registrant, the Arbitrator is depriving that Registrant of a property interest. Such a decision should not be taken lightly. Therefore, even if an Arbitrator finds that a complainant has satisfied the rather heavy burdens of proof placed on it by Paragraph 4.1, if the Arbitrator is satisfied that on a balance of probabilities the registrant has a legitimate interest in the disputed domain name, the Arbitrator must find for the registrant and dismiss the complaint. The Registrant has manifestly provided no argument, solid, or otherwise, to either refute the allegations made by the Complainant or at the very least, support the registration (and any rights) in the disputed domain name.

In the case at hand, this Arbitrator is satisfied that on a balance of probabilities, based upon the evidence before him, that the Registrant has no legitimate interest in the Disputed Domain names.

Decision and Order

I find that the Complainant has succeeded in this proceeding, initiated under the Policy.

I therefore direct that the registrations of (“BlackBerry10.ca”) be transferred to the Complainant:
Research In Motion Limited

Dated this 9th day of November, 2012

Claude Freeman, LL.M. (ADR), C. Med., C. Arb.