

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

BETWEEN:

BHP BILLITON INNOVATION PTY LTD.

Complainant

- and -

ABDELMOULA MOUHSINE

Registrant

DECISION

A. The Parties

1. The Complainant, BHP Billiton Innovation Pty Ltd., is a wholly owned corporate subsidiary of BHP Billiton Limited, which has its head office in Melbourne, Australia. The Complainant holds some of the intellectual property of BHP Billiton Limited and BHP Billiton Plc (together comprising the **BHP Billiton Group**).

2. The Registrant, Abdelmoula Mouhsine, is an individual with a postal address in Montreal, Quebec.

B. The Domain Name and Registrar

3. The disputed domain name that is the subject of this arbitration is bhpbilliton.ca (the **Domain Name**).

4. The Registrar of the Domain Name is Go Daddy Domains Canada Inc., which has an office in Scottsdale, Arizona, U.S.A.

C. Procedural History

5. This matter is arbitrated under the CIRA Domain Name Dispute Resolution Policy (the **Policy**) and the CIRA Domain Name Dispute Resolution Rules (the **Rules**). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of certain disputes under the Policy and Rules.

6. Based on information from the Dispute Resolution Service Provider – the British Columbia International Commercial Arbitration Centre (BCICAC) – the history of this proceeding can be summarized as follows:

- (a) On June 29, 2012, the Complainant filed with BCICAC a Complaint regarding the Domain Name.
- (b) BCICAC reviewed the Complaint and found it to be compliant with administrative requirements. By letter and e-mail dated June 29, 2012, BCICAC confirmed compliance to the parties and delivered the Complaint to the Registrar.
- (c) BCICAC received an e-mail dated July 5, 2012 from the Registrant's e-mail address.
- (d) The Registrant failed to provide a Response in the time allowed under Rule 5.1 and did not seek an extension. Therefore, Rule 5.8 requires the arbitrator to decide the matter based on the Complaint alone.
- (e) The Complainant elected under Rule 6.5 to proceed with a sole arbitrator. The BCICAC named David R. Haigh, Q.C., as sole arbitrator (the **Arbitrator**).
- (f) The Arbitrator delivered to the BCICAC a required Statement of Impartiality and Independence, according to Rule 7.2

D. Preliminary Determinations

- 7. The Arbitrator was appointed in accordance with the Policy and the Rules.
- 8. Under Rule 12.1, the Law of Quebec applies.

E. Factual Background

- 9. Based on the Complaint in this uncontested dispute, a summary of the facts is set out below.
- 10. BHP Billiton Group is the world's largest diversified resources group, employing more than 40,000 people in more than 100 operations in 25 countries. BHP Billiton's approximate annual turnover in 2011 amounted to US \$71.7 billion.
- 11. The Complainant is the owner of numerous trademarks for BHP Billiton, including a Canadian one, registered on April 7, 2011 (the **Trademark**).

12. The Registrant registered the Domain Name on March 19, 2012 – after the Complainant registered the Trademark in Canada.

13. In a March 30, 2012 e-mail, BHP Billiton Group received an offer to sell the Domain Name, purportedly from the owner of the Domain Name. The e-mail identified the contact person as David LaPierre at admin@sysby.com. On May 7, 2012, counsel for BHP Billiton Limited replied to David LaPierre at admin@sysby.com stating that the owner of the Domain Name had no authority to register a domain name containing the well-known trademark BHP Billiton and that counsel would commence proceedings unless the Domain Name were transferred unconditionally to BHP Billiton. On May 8, 2012, an e-mail from admin@sysby.com proclaimed no knowledge of the BHP Billiton Group, stated that registration of the Domain Name had been effected upon seeing that the .com domain name (bhpbilliton.com) existed, and denied that there was anything improper with offering the Domain Name for sale. By an e-mail dated May 9, 2012, counsel for BHP Billiton Limited repeated its demand. There was no further reply.

14. The Domain Name has resolved to a "parking" webpage, which includes the following statement: "This web page is parked FREE, courtesy of GoDaddy.com."

F. Discussion and Conclusions

Eligible Complainant

15. This Complaint relates to a trademark registered in Canada that the Complainant owns. As such, the Complainant is eligible to make this Complaint under Rule 1.4.

Confusingly Similar to the Mark

16. The Complainant's burden of proof under paragraph 4.1(a) of the Policy is to establish that "the Registrant's dot-ca 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".

First Sub-Element

17. Paragraph 4.1(a) of the Policy contains a number of sub-elements. The first relevant sub-element is whether the Complainant had Rights in Marks (as defined in paragraph 3.2 of the Policy) before the registration date of the Domain Name.

18. The Complainant registered the Trademark before the registration of the Domain Name, so the Complainant did have such Rights.

Second Sub-Element

19. The second sub-element of paragraph 4.1(a) of the Policy is whether the Domain Name is confusingly similar to the Mark. Under paragraph 3.3 of the Policy, this would be so if the Domain Name were to resemble the applicable Mark so nearly in appearance, sound or in the ideas suggested by the Mark as to be likely to be mistaken for the Mark.

20. The Domain Name obviously does resemble the Trademark so as to likely be mistaken for it. The top-level domain portion (the .ca portion) is an irrelevant distinction, so the Domain Name and the Trademark are essentially identical.

21. Based on the reasoning above, the Complainant has satisfied its onus under paragraph 4.1(a) of the Policy.

Registration in Bad Faith

22. Under paragraph 4.1(b) of the Policy, the Complainant must prove that the Registrant has registered the Domain Name in bad faith as described in paragraph 3.5.

23. Because BHP Billiton Group is a well-known group of companies around the world and in Canada, and because of the nature of browsing and searching on the Internet, the Registrant would have been either (i) aware of the business of the Complainant/BHP Billiton Group, and of its use of the Trademark, or (ii) willfully blind to such information. The Registrant told the Complainant that it registered the Domain Name because the Registrant saw the bhpbilliton.com domain name, the Registrant wished to have the opportunity to sell the .ca domain name to the owner of the .com domain name. The Registrant has refused to transfer registration of the Domain Name other than by sale. It follows that the Registrant acquired the Domain Name for a bad faith purpose under paragraph 3.5(a) of the Policy, namely, for selling the Domain Name to the Complainant for a profit.

24. For the above reasons, the Registrant registered the Domain Name in bad faith

No Legitimate Interest

25. Under paragraph 4.1(c) of the Policy, the onus is on the Complainant to show at least some evidence that the Registrant has no legitimate interest in the Domain Name. Upon discharging that onus, the onus then shifts to the Registrant to prove that it has a legitimate interest in the Domain Name.

26. In this uncontested arbitration, the Registrant has provided no evidence, so it remains only for the Complainant to show at least some evidence that the Registrant has no legitimate interest in the Domain Name.

27. For the Registrant's use of the Domain Name to be legitimate, that use must fall under one of the sub-paragraphs 3.4(a) – (f) of the Policy. The uncontested evidence is that the Registrant does not have a legitimate interest in the Domain Name under any of those sub-paragraphs.

28. The Complainant has satisfied its onus in providing some evidence that the Registrant has no legitimate interest in the Domain Name.

Decision

29. The Arbitrator has decided as follows:

- (a) The Complainant is an eligible complainant.
- (b) The Registrant's Domain Name is Confusing Similar to a Mark, in which the Complainant has Rights before the Registration of the Domain Name, and continues to have such Rights.
- (c) The Registrant has registered the Domain Name in bad faith.
- (d) The Registrant has no legitimate interest in the Domain Name.
- (e) The Complainant has satisfied its onus obligations under paragraph 4.1 of the Policy.

30. Based on these conclusions, the Arbitrator decides these proceedings in favour of the Complainant and orders that the Registration of the following Domain Name, bhpbilliton.ca, be transferred to the Complainant.

MADE this 27th day of August, 2012.

Per: 
DAVID R. HAIGH, Q.C.
Sole Arbitrator