

**IN THE MATTER OF A COMPLAINT PURSUANT TO THE CANADIAN INTERNET REGISTRATION
AUTHORITY DOMAIN NAME DISPUTE RESOLUTION POLICY**

Complainant:	Forest Laboratories Canada Inc.
Complainant Counsel:	Jane E. Caskey and Adam B. Haller, Norton Rose Canada LLP
Registrant:	Netnic Corporation
Panel:	Barry C. Effler (Chair), Peter Cooke, Harold Margles
Service Provider:	British Columbia International Commercial Arbitration Centre
BCICAC File Number:	DCA-1368-CIRA

DECISION

The Parties, Domain Names and Registrar

1. The Complainant is Forest Laboratories Canada Inc., incorporated under the *New Brunswick Business Corporations Act* on April 12, 2010.
2. The Registrant is Netnic Corporation.
3. The Domain Names at issue in this dispute are FORESTLABORATORIES.CA and FORESTLABS.CA.
4. The Registrar is DOT-CA-REGISTRY.CA (Burmac Business Systems Ltd).
5. The Domain names were registered by the Registrant on October 1, 2011.

Procedural History

6. The procedural history of this matter was set out in a letter from the British Columbia International Commercial Arbitration Centre to the Panel herein dated March 16, 2012:

The British Columbia International Commercial Arbitration Centre (BCICAC) is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (CDRP) of the Canadian Internet Registration Authority (CIRA).

The above named Complainant has filed a Complaint with respect to the above-referenced domain names in accordance with the CDRP on January 20, 2012.

The Complainant has delivered to the Centre 5 copies of the Complaint as permitted by the Rules on January 20, 2012; no electronic copy was filed at that time.

The Complaint was reviewed and found to be compliant. By letter and email dated, January 23, 2012, BCICAC as Service Provider so advised the parties and forwarded a copy of the Complaint to the Registrant's address via FedEx. FedEx confirmed that the Complaint was delivered to the Registrant on January 25th, 2012. On February 27, 2012 FedEx contacted the Centre and advised that a confirmation of the delivery was

sent in error, clarification of the address was required. The Centre has immediately contacted the Registrant to clarify the mailing address. The Registrant did not provide mailing address.

The date for delivery of the Response was February 13, 2012.

The Complainant forwarded an electronic version of the Complaint, and the Centre served the Registrant with the Complaint via email on February 10th, 2012. Due to the fact that the actual receipt of the Complaint by the registrant was February 10, 2012 deadline for filing a response was moved to March 1, 2012.

On February 27, 2012 the Registrant requested an extension of time to file a response pursuant to Rule 5.4. New deadline was set on March 12, 2012.

The Registrant delivered its Response to the Centre on March 12, 2012 via email.

In accordance with CIRA Rule 5.5, the Centre reviewed the Response for administrative compliance and advised the parties that the Response is in compliance with the Policy and Rules on March 13, 2012.

The Complaint and the Response were filed in English, which shall be the language of the proceeding.

In accordance with Paragraph 6 of the Rules, the Provider shall appoint a three-person Panel, with consideration to the nominees of the parties, and select a Chair.

The BCICAC names Peter Cooke and Harold Margles as panelists. Barry Effler is named as Chair of the Panel.

7. A preliminary question raised by the Complainant was whether Netnic Corporation was the same legal entity as “Netnic Corporation | forestlaboratories-ca” and “Netnic Corporation | forestlabs-ca” which are listed as the registrants of the respective domain names in the CIRA WHOIS reports.
8. The Registrant confirmed in its Response that the addition of the “|” symbol was for convenience and did not change the fact that the registrant in both domain names was in fact Netnic Corporation:

The Complaint attributed nefarious intent to use by NETNIC of registrations in the form of NETNIC CORPORATION |domainname.ca but this form was only implemented upon consultation between the registrar and CIRA itself. Prior to October 2010, domain names were held in pooled accounts, and the release of the login and password permitted access to all domains in said account, which led then to confusion when a client used a

login and password to manage its domain, but then accidentally made those changes to all domain names in that account.

It was decided by CIRA to read in the | or 'pipe symbol' as doing business as for intents of registrations, thus avoiding an expensive company registration for each of thousands of customer accounts. The registrar hard-coded this format into its system and did not make any changes after the October 2010 transition led to individual EPP codes for every domain. The registrar will change this system but the moving of thousands of existing domain names into the related customer accounts is done manually only upon a renewal....¹

9. As required by paragraph 7.1 of the Rules, each Panellist has declared to BCICAC that he can act impartially and independently in this matter as there are no circumstances known to him which would prevent him from so acting.
10. The Panel is not aware of any other legal proceeding or other arbitration in relation to the Domain Name that would give rise, under paragraph 13.2 of the Rules, to a need to stay or terminate the progress of this proceeding.

Eligibility of Complainant

11. The Panel has reviewed the material submitted by the Complainant and is satisfied that the Complainant is an eligible complainant under paragraph 1.4 of the Policy, because it meets the Canadian Presence Requirements as a corporation under the laws of a province of Canada.

Relief Requested

12. The Complainant requests that the Domain Names FORESTLABS.CA and FORESTLABORATORIES.CA be transferred from the Registrant to the Complainant.

Applicable Law

13. As directed by paragraph 12.1 of the Rules, the Panel will render its decision based upon the rules and principles of the laws of Ontario, and the laws of Canada.

Facts

14. The undisputed facts relevant to the Panel's decision are set forth in the Complaint and its schedules, and are as follows:

¹ Response filed by Netnic Corporation., p. 4.

- (a) The Complainant is a wholly owned subsidiary and licensee of Forest Laboratories, Inc , a pharmaceutical company.
 - (b) The Registrant is in the business of the registration of domain names.
 - (c) The Registrant registered the Domain Names on October 1, 2011.
 - (d) The Complainant was incorporated April 12, 2010
 - (e) FOREST LABORATORIES is the subject of a pending Canadian trade-mark application No. 1,462,768 filed by Forest Laboratories, Inc. the Complainant's parent company on December 14, 2009.
15. The fundamental issue in this proceeding is whether the Complainant had rights in the FOREST LABORATORIES mark prior to the date on which the Domain Names were registered. The relevant evidence will be discussed below.
16. In light of this Panel's decision on this issue, it is neither necessary nor is it appropriate for the Panel to make any further findings of fact.
17. The Panel notes from the Response that the Registrant states that it is holding the two Domain names in trust for the parent company of the Complainant, Forest Laboratories, Inc.:

Respondent makes the following note to the Panel:

The beneficial registrant of the domains frx.ca, forestlabs.ca and forestlaboratories.ca is Forest Laboratories, Inc., 909 Third Avenue, New York City, New York, United States of America.²

Discussion and Findings

18. Policy paragraph 4.1 sets forth the onus on a complainant. It provides, in relevant part, as follows:
- 4.1 **Onus.** *To succeed in the Proceeding, the Complainant must prove, on a balance of probabilities, that:*
- (a) *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; and*

² Response filed by Netnic Corporation., p. 2.

(b) *the Registrant has registered the domain name in bad faith as described in paragraph 3.5;*

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.*

19. The Complainant is not the owner of a registered Canadian trade-mark for FOREST LABORATORIES, so it cannot rely upon that trade-mark. Instead, the Complainant must prove that the unregistered FOREST LABORATORIES trade-mark and trade name was a “Mark” in which the Complainant had “Rights” prior to the date on which the Domain Names were registered.

20. The Policy provides a definition of the term “Mark” (but as amended no longer defines Rights):

3.2 **Mark.** *A “Mark” is:*

(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; ...(emphasis added)*

21. The relevant definition of “Mark” requires that a trade-mark be “used”. The term “use” is no longer defined in the Policy.

22. Despite the amendments to the Policy, a complainant who relies upon an unregistered trade-mark as a “Mark” and asserts “Rights” in that Mark must continue to prove that the trade-mark was in “use” or was “used” by that complainant or its predecessor or by a licensor before the disputed domain names was registered.

23. In this case, the Complaint contains statements regarding the Complainant’s use of the FOREST LABORATORIES trade-mark before the date on which the Domain Name was registered:

(a) *use as the distinctive part of the Complainant’s corporate name in Canada;*

(b) *use associated with the sale of a prescription drug product;*

(c) *use on Forest’s main webpage*

24. The Complaint is supported by exhibits attached to the Complaint which includes the certificate of incorporation of the Complainant, screen shots of the Complainant's parent company's website, packaging showing drugs apparently sold in Canada by the parent company's UK subsidiary Forest Laboratories UK Ltd., press releases, attendee lists, articles and so on regarding the Complainant's use the FOREST LABORATORIES trade-mark before the date on which the Domain Name was registered.
25. The Complaint and related materials do not contain sufficient evidence to allow the panel to conclude that the FOREST LABORATORIES trade-mark was "used" such that the Complainant had Rights in that mark at the relevant date. In none of the evidence does FOREST LABORATORIES appear in the manner to suggest that it is used as a trade-mark, or that the **Complainant's** trade name has rights. (emphasis added)
26. Where a complainant relies upon an unregistered trade-mark, Policy paragraph 4.1(a) requires the complainant to prove, on a balance of probabilities, that the trade-mark is a "Mark" in which the Complainant had "Rights" prior to the date of registration of the disputed domain name. To meet that onus, a complainant must adduce sufficient evidence from which the panel can make a finding that the complainant's trade-mark was used.
27. The Complaint contains a statement to the effect that "The Mark is used in Canada in order to distinguish the products, services, and business of the Complainant, and its parent licensor, from those of others". Having reviewed the exhibits filed in support of that claim the Panel concludes that it does not have before it sufficient evidence upon which to make a finding that the unregistered FOREST LABORATORIES trade-mark, or the Complainant's trade name, was a "Mark" in which the Complainant had "Rights" prior to the registration of the Domain Names.
28. For those reasons, the Complainant has failed to prove, on a balance of probabilities, that the Domain Names are Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the Domain Names, as required by Policy paragraph 4.1(a).
29. The Complainant has adduced no evidence to establish that it is carrying on business at all. Indeed, all of its evidence is directed to the sales and research activities of Forest Laboratories Inc., the Complainant's parent, and its European subsidiary companies. The trademark application is by Forest Laboratories Inc. The Registrant's evidence leads the Panel to the

conclusion that the Complainant is merely a "shelf" company at this point in time. In the circumstances, the panel considers it premature to provide an opinion on the Complainant's submissions as to the potential expansion of the meaning to be attributed to each of the words "rights" and "use" in the amendments to the Policy.

30. Under the circumstances, it is neither necessary nor appropriate for the Panel to address any other issues.

Conclusion

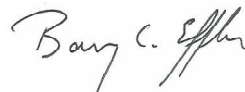
31. The Panel finds that the Complainant has not met the burden assigned to it under paragraph 4.1(a) of the Policy. In particular, the Complainant has not proven, on a balance of probabilities, that it had Rights in the Forest Laboratories mark prior to the date of registration of the Domain Names.
32. Accordingly, the Panel holds that the Complainant has not established its claim, and is not entitled to the remedy set forth in the Complaint.

Order

33. For the reasons set forth above, the Panel dismisses the Complaint and declines to make any order with respect to the Domain Names.

Dated: April 22, 2012

Barry C. Effler (Chair), Peter Cooke, Harold Margles



Barry C. Effler (Chair) for the Panel

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(b) *use associated with the sale of a prescription drug product;*

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24. The Complaint is supported by exhibits attached to the Complaint which includes the certificate of incorporation of the Complainant, screen shots of the Complainant's parent company's website, packaging showing drugs apparently sold in Canada by the parent company's UK subsidiary Forest Laboratories UK Ltd., press releases, attendee lists, articles and so on regarding the Complainant's use the FOREST LABORATORIES trade-mark before the date on which the Domain Name was registered.
25. The Complaint and related materials do not contain sufficient evidence to allow the panel to conclude that the FOREST LABORATORIES trade-mark was "used" such that the Complainant had Rights in that mark at the relevant date. In none of the evidence does FOREST LABORATORIES appear in the manner to suggest that it is used as a trade-mark, or that the **Complainant's** trade name has rights. (emphasis added)
26. Where a complainant relies upon an unregistered trade-mark, Policy paragraph 4.1(a) requires the complainant to prove, on a balance of probabilities, that the trade-mark is a "Mark" in which the Complainant had "Rights" prior to the date of registration of the disputed domain name. To meet that onus, a complainant must adduce sufficient evidence from which the panel can make a finding that the complainant's trade-mark was used.
27. The Complaint contains a statement to the effect that "The Mark is used in Canada in order to distinguish the products, services, and business of the Complainant, and its parent licensor, from those of others". Having reviewed the exhibits filed in support of that claim the Panel concludes that it does not have before it sufficient evidence upon which to make a finding that the unregistered FOREST LABORATORIES trade-mark, or the Complainant's trade name, was a "Mark" in which the Complainant had "Rights" prior to the registration of the Domain Names.
28. For those reasons, the Complainant has failed to prove, on a balance of probabilities, that the Domain Names are Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the Domain Names, as required by Policy paragraph 4.1(a).
29. The Complainant has adduced no evidence to establish that it is carrying on business at all. Indeed, all of its evidence is directed to the sales and research activities of Forest Laboratories Inc., the Complainant's parent, and its European subsidiary companies. The trademark application is by Forest Laboratories Inc. The Registrant's evidence leads the Panel to the

conclusion that the Complainant is merely a "shelf" company at this point in time. In the circumstances, the panel considers it premature to provide an opinion on the Complainant's submissions as to the potential expansion of the meaning to be attributed to each of the words "rights" and "use" in the amendments to the Policy.

30. Under the circumstances, it is neither necessary nor appropriate for the Panel to address any other issues.

Conclusion

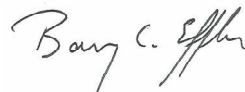
31. The Panel finds that the Complainant has not met the burden assigned to it under paragraph 4.1(a) of the Policy. In particular, the Complainant has not proven, on a balance of probabilities, that it had Rights in the Forest Laboratories mark prior to the date of registration of the Domain Names.
32. Accordingly, the Panel holds that the Complainant has not established its claim, and is not entitled to the remedy set forth in the Complaint.

Order

33. For the reasons set forth above, the Panel dismisses the Complaint and declines to make any order with respect to the Domain Names.

Dated: April 22, 2012

Barry C. Effler (Chair), Peter Cooke, Harold Margles



Barry C. Effler (Chair) for the Panel