

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

Domain in Dispute: myshaw.ca  
Complainant: Shaw Cablesystems G.P.  
Registrant: Gnanavannan Ratnasabapathy  
Registrar: Namepro Solutions Inc.  
BCICAC File: DCA-1334-CIRA

**DECISION**

**1. The Parties**

Complainant is Shaw Cablesystems G.P. of Calgary, Alberta, Canada, represented by Alexia Walter, Complainant's Manager, Intellectual Property, Legal Department.

Registrant is Gnanavannan Ratnasabapathy of Toronto, Ontario, Canada. The Registrant did not file a Response.

**2. The Domain Name and Registrar**

The disputed domain name is <myshaw.ca> (the "Disputed Domain Name"), which was created on January 22, 2005 (as confirmed by the Panel's independent review of the Whois record at <http://www.cira.ca>).

**3. Governing Policy and Rules**

This is a proceeding under the CIRA Domain Name Dispute Resolution Policy ("Policy") and the CIRA Domain Name Dispute Resolution Rules ("Resolution Rules"). The Policy and Rules were recently revised, on August 22, 2011, to versions 1.3 and 1.4, respectively. Paragraph 1.8 of the Policy states: "The version of the Policy in effect at the time a Proceeding is initiated will apply to the Proceeding." And, paragraph 1.2 of the Rules states: "The version of the Resolution Rules in effect at the time a Proceeding is initiated will apply to that Proceeding." Accordingly, because the Complaint filed on August 16, 2011, this Decision is based upon the previous versions of the Policy and Rules, namely, 1.2 and 1.3, respectively. See *Sittercity Incorporated v. Mile Mocilac*, CIRA Dispute No. 00169. Thus, all following references to the Policy and the Rules are to version 1.2 of the Policy and version 1.3 of the Rules.

**4. Procedural History**

The history of this proceeding, according to the information provided by the dispute resolution service provider, British Columbia International Commercial Arbitration Centre (BCICAC), is as follows:

- a. On August 16, 2011, Complainant filed a Complaint pursuant to the Policy and the Rules.

- b. In a letter dated August 18, 2011, BCICAC confirmed compliance of the Complaint and commencement of the dispute resolution process.
- c. The Complaint was delivered to the Registrant on August 18, 2011, via FedEx.
- d. The Registrant has not provided a Response. As permitted given the absence of a Response, the Complainant has elected under Rule 6.5 to convert from a panel of three to a single arbitrator.
- e. BCICAC appointed the undersigned as sole arbitrator on September 15, 2011, and the undersigned has executed a document titled "Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality."
- f. Absent exceptional circumstances, and pursuant to Rule 12.2, the Panel's decision is to be delivered to BCICAC by October 6, 2011.

The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Rules. Based upon the information provided by the BCICAC, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding, unless otherwise noted, have been met.

## **5. Canadian Presence Requirement**

Paragraph 1.4 of the Policy states: "The person initiating a Proceeding (the 'Complainant') must, at the time of submitting a complaint (the 'Complaint'), satisfy the Canadian Presence Requirements for Registrants (the "CPR") (currently available at [http://www.cira.ca/en/cat\\_Registration.html](http://www.cira.ca/en/cat_Registration.html)) in respect of the domain name that is the subject of the Proceeding unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office ('CIPO') and the Complainant is the owner of the trade-mark." Here, as discussed below, it is evident that the Complainant is the owner of Reg. No. TMA597,803 at the Canadian Intellectual Property Office for the trademark SHAW. As a result, the Panel is satisfied that the Complainant is eligible to initiate this proceeding.

## **6. Factual Background and Parties' Contentions**

Complainant states that its parent company, Shaw Communications Inc., is a diversified communications and media company that provides consumers with broadband cable television, high-speed Internet, home telephone, telecommunications services, satellite direct-to-home services and engaging programming content. Complainant further states that Shaw Communications Inc. serves 3.4 million customers and, through Shaw Media, operates "one of the largest conventional television networks in Canada, Global Television, and 19 specialty networks including HGTV Canada, Food Network Canada, History Television and Showcase.

Complainant further states that the trademark SHAW was first used in 1986 and is protected by 44 registrations, including Reg. No. TMA597,803 at the Canadian Intellectual Property Office.

Complainant provided as an exhibit a copy of this trademark registration certificate, which shows that the mark SHAW is owned by Complainant, that the mark is for use in connection with, *inter alia*, “[d]istribution and programming undertaking providing telecommunication services”; that the mark has been used in Canada since at least as early as February 29, 1984; that the application for the mark’s registration was filed on January 20, 1998; and that the mark was registered on December 17, 2003.

Complainant further states that it is the registrant of numerous domain names that contain the SHAW trademark, including <shaw.ca> and that it operates websites at the URLs www.shaw.ca and my.shaw.ca.

Complainant contends that the Disputed Domain Name is confusingly similar to the SHAW trademark, that Complainant had rights in the SHAW trademark prior to the creation of the Disputed Domain Name, and that Complainant continues to have such rights.

Complainant further contends that Registrant has no legitimate interest in the Disputed Domain Name because (1) the Registrant does not own a trademark corresponding to the Disputed Domain Name, (2) the Registrant has not used the Disputed Domain Name in Canada “in relation to wares or services” and instead the Disputed Domain Name is only associated with a web page that is under construction; (3) the Disputed Domain Name does not comprise the legal name of Registrant; and (4) the Disputed Domain Name is not a geographical name.

Complainant further contends that the Registrant should be considered as having registered the Disputed Domain Name in bad faith as described in paragraph 3.7 of the Policy because, *inter alia*, (1) the Registrant has no connection or affiliation with the Complainant; (2) the Registrant registered the Disputed Domain Name primarily for the purpose of selling, renting, licensing or otherwise transferring it to Complainant for valuable consideration in excess of the Registrant’s actual costs in registering the Disputed Domain Name; (3) the Registrant has registered the Disputed Domain Name in order to prevent the Complainant from registering or using it and has engaged in a pattern of such conduct. In support of the last point just mentioned, Complainant has provided as an exhibit a list (dated November 28, 2008) of 12 domain names (in addition to the Disputed Domain Name) compiled by CIRA that CIRA believes to be registered by Registrant, including <microsoft.ca>, <packardbell.ca> and <srilankanairlines.ca>, which Complainant contends “all contain or refer to well-known marks or businesses.”

Complainant requests that the Disputed Domain Name be transferred from the Registrant to the Complainant.

The Respondent did not file a Response.

## **7. Discussion and Findings**

To obtain a transfer of the Disputed Domain Name, Complainant must, as set forth in paragraph 4.1 of the Policy, 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
- (b) the Registrant has registered the domain name in bad faith as described in paragraph 3.7;

and the Complainant must provide some evidence that:

- (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6.

### **Confusingly Similar**

With respect to paragraph 4.1(a) of the Policy, regarding confusing similarity, the Panel finds that, based upon Complainant's representations, including a copy of the trademark registration certificate (showing a registration date of December 17, 2003) that it provided as an exhibit, Complainant has rights in the mark SHAW, that it has used this mark since at least as early as February 29, 1984, and that these rights pre-date creation of the Disputed Domain Name, which occurred on January 22, 2005.

As to whether the Disputed Domain Name is confusingly similar to the SHAW trademark, paragraph 3.4 of the Policy states: "A domain name is 'Confusingly Similar' to a Mark if the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark." In support thereof, Complainant has cited a number of decisions under the Uniform Domain Name Dispute Resolution Policy ("UDRP") for domain names that contained the word "my". Although the UDRP is not identical to the Policy and, therefore, decisions under the UDRP are not necessarily persuasive, a number of previous panels under the Policy have considered the UDRP in their decisions, and paragraph 3.2(m) of the Rules expressly allows a Complainant to refer to "the dispute resolution proceedings which apply to domain names registered under any other top level domain which the Complainant considers persuasive." Accordingly, the Panel on this point considers the following UDRP decisions persuasive: *DHL Operations B.V. and DHL International GmbH v. Eric White*, WIPO Case No. D2010-0016 (in ordering a transfer of the domain name <mydhl.com>, the panel wrote: "a sensible and reasonable person would indeed be confused by similarities between the disputed domain name <mydhl.com> and the Complainants' trademarks"); and *Verizon Trademark Services, LLC v. paulo c/o paulo kann*, WIPO Case No. D2010-0989 (in ordering a transfer of 23 domain names, four of which contain the word "my," the panel wrote: the domain names "are similar to the Complainant's marks and may well give rise to the possibility, if not likelihood in many cases, that Internet users will think that the owner of the Domain Names, or any of them, is in fact the owner of the Complainant's marks to which they are similar, or that there is some form of association between the Respondent and the Complainant").

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 4.1(a) of the Policy.

## **Bad Faith**

With respect to paragraph 4.1(b) of the Policy, regarding bad faith, the Panel notes that a Registrant will be considered to have registered a domain name in bad faith if, *inter alia*:

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.

Policy, paragraph 3.7(b).

Although the Registrant's action have not prevented the Complainant from registering the SHAW trademark *alone* as a domain name in the .ca ccTLD, Registrant's actions obviously prevent Complainant from registering the domain name <myshaw.ca>, given the inherently exclusive nature of domain name registrations. Previous decisions under the Policy have found paragraph 3.7(b) applicable where a domain name contains a complainant's trademark, even if the domain name is not identical to the trademark. See, e.g., *Seiko Epson Corporation v. Zokool Technologies, Inc.*, CIRA Dispute No. 00123 (transfer of <epsonink.ca>, <epsoncartridge.ca> and <epsoninkjet.ca>, where complainant had rights in the mark EPSON); and *Staples, Inc. & The Business Depot Ltd. v. Erik Maddeaux*, CIRA Dispute No. 00105 (transfer of <staplesonlinerebate.ca>, <staplesonlinerebates.ca> and <staplesrebate.ca>, where complaint had rights in the marks STAPLES, STAPLES STICKIES and STAPLES THE OFFICE SUPERSTORE).

Further, the Panel agrees with Complainant that at least some of the 12 domain names identified in the CIRA report as being registered by the Registrant (including <microsoft.ca>, <packardbell.ca> and <srilankanairlines.ca>) contain well-known trademarks of others, and Registrant has not disputed this. This is sufficient for finding that Registrant has engaged in a pattern of conduct described in paragraph 3.7(b) of the Policy. *Handi Foods Ltd. v. Bob Jenkins*, CIRA Decision No. 00128 (finding bad faith under paragraph 3.7(b) of the Policy based upon two domain name registrations).

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 4.1(b) of the Policy.

## **No Legitimate Interest**

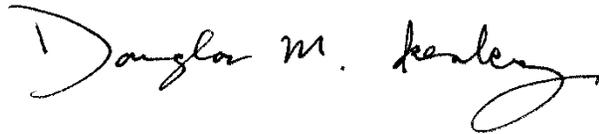
With respect to paragraph 4.1(c) of the Policy, regarding a lack of legitimate interests, the Registrant has, by failing to submit a Response, not made any attempt to argue that it has a legitimate interest in the Disputed Domain Name under any of the six elements described in paragraph 3.6 of the Policy. Further, as shown in the Complaint (and as independently confirmed by the Panel), the Disputed Domain Name is not being used in connection with an active website. Under such circumstances, previous panels have found that a complainant has satisfied its burden under paragraph 4.1(c) of the Policy. See, e.g., *Fitness Anywhere Inc. v.*

*Bannerfrench*, CIRA Dispute No. 00160 (finding no legitimate interests where the registrant failed to submit a response and “the domain name does not lead to any active site”).

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 4.1(c) of the Policy.

**7. Decision**

For all the foregoing reasons, in accordance with paragraph 4.3 of the Policy, the Panel orders that the Disputed Domain Name <myshaw.ca> be transferred to Complainant.

A handwritten signature in black ink that reads "Douglas M. Isenberg". The signature is written in a cursive style with a large, looping initial 'D'.

Douglas M. Isenberg

Panelist

Dated: October 5, 2011