

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

Complainant: TWENGA, “Societe Anonyme”, company organized under French law

Complainant Counsel: M. David-Irving Tayer, Witetec, Attorney at law

Registrant: privacy protected

Disputed Domain Name: Twenga.ca

Registrar: HEXONET Services Inc.

Panelist: Barry C. Effler, LL.B., LL.M., C. Arb. (Fellow)

Service Provider: British Columbia International Commercial Arbitration Centre
(the “BCICAC”)

BCICAC File Number: DCA-1351-CIRA

DECISION

The parties

1. The Complainant is TWENGA, “Societe Anonyme”, company organized under French law.
2. The Respondent is registered as privacy protected and will not be disclosed in this Decision.

The Domain Name and Registrar

3. The Domain Name at issue in this dispute is “Twenga.ca”.
4. The Registrar is HEXONET Services Inc.
5. The Domain name was registered by the Registrant on October 5, 2010.

Procedural History

6. The British Columbia International Commercial Arbitration Centre (“BCICAC”) is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (“Policy”) of the Canadian Internet Registration Authority (“CIRA”).
7. The Complainant filed a complaint with respect to the domain name in issue in accordance with the Policy on November 8, 2011 (the “Complaint”).

8. The Complaint was forwarded to the Registrant via email on November 8, 2011. Attempts to deliver the Complaint to the Registrant via courier were not unsuccessful. This issue will be discussed later in this decision.
9. The Registrant did not provide a Response. As permitted given the absence of a Response, the Complainant elected under Rule 6.5 to convert from a panel of three to a single arbitrator.
10. The BCICAC appointed me as sole arbitrator. I confirm that I have no interest, direct or indirect, in the outcome of this dispute. I am not aware of any circumstances that would give rise to any justifiable doubts as to my independence or impartiality or any perceivable bias in this matter.
11. I have reviewed the material submitted by the Complainant and I am satisfied that the Complainant is an eligible complainant under the Policy and the Rules.
12. CIRA recently implemented a revised Policy (Version 1.3) and revised Rules (Version 1.4) (together, the "Revised Policy and Rules"), each of which is effective as of August 22, 2011 (the "Effective Date"). According to paragraphs 1.8 and 1.2 of the Revised Policy and Rules, respectively, the version of the policy and rules in effect at the time a proceeding is initiated will apply to that proceeding. As this Complaint was filed after August 22, 2011, these are the Rules and Policy which will apply.

Service on the Respondent

13. The Complainant has made a number of attempts to contact the respondent:
 - a. WHOIS search resulted in a notice that:

“Personal information about the holder of this domain name is not available in the search results because the registration is privacy protected. Interested in contacting the holder of this domain name? CIRA offers an online Message

Delivery Form that allows you to send a message to the Administrative Contact for this domain name.”¹

- b. The Complainant sent a message to the Respondent using the CIRA Message Delivery Form on August 4, 2011, August 10, 2011, and September 1, 2011.
 - c. On August 18, 2011 the Complainant contacted CIRA seeking information about the Registrant and was advised that the information was not available “as the Registrant has enacted privacy on their .CA domain and therefore, for security and privacy reasons, we cannot release any personal information on the Registrant.”²
 - d. On August 18, 2011 the Complainant sent a message to the domain registrar at “support@hexonet.net” and received a reply stating “We have forwarded your message directly to the respective reseller to respond to.”³
 - e. The Complainant states that on August 24 and September 24, 2011 it sent messages to the “contact page’ shown on the twenga.ca website.
14. The Complainant states it has received no response to any of its messages to the Respondent.
15. The Complainant has now commenced this Complaint.
16. Because of the privacy status of the Registrant, there is no available information regarding the Administrative Contact for the Registrant available to the Complainant.
17. Following the Complaint being filed, CIRA released to the Service Provider the name of the Registrant and contact information.

¹ WHOIS search result for Twenga.ca, Exhibit B-1 of the Complainant’s submission.

² Message dated August 18, 2011 from Barry Coughlin of CIRA to Claire Corona, Exhibit B-7 of the Complainant’s submission.

³ Message dated August 19, 2011 from HEXONET Abuse department to Claire Corona, Exhibit B-8 of the Complainant’s submission.

18. When I reviewed the material submitted for this matter, I did not understand that service of the Complaint had been made by email to the Registrant's Administrative Contact.
19. I prepared an Order dated December 22, 2011 requesting CIRA to release the Administrative Contact information to the Service Provider. Due to email delivery issues with me, this Order was not received by the Service Provider until December 29, 2011. On December 30, 2011, I received written confirmation from the Service Provider of service of the Complaint made on November 8, 2011.
20. Accordingly, I have withdrawn my Interim order as it is not required.
21. In these exceptional circumstances, I hereby extend the time for the delivery of this decision to January 23, 2012.

Background Facts

22. The following background is based on the submission of the Complainant.
23. The Complainant is a French company which operates a website that provides an open shopping platform presenting deals for various goods and allowing for price comparisons. This has been operating since at least 2006.
24. The Complainant is the owner of a number of trademark registrations around the world, including French registration number 04 3 324 517 dated November 18, 2004 for the word "TWENGA."
25. The Complainant is the owner of a Canadian registered trade-mark, being TMA810,178 for the word "TWENGA"; registered October 25, 2011. This registration satisfies the Canadian presence requirement of the Policy.

Evidence and Analysis

26. The test to be met by the Complainant in order to succeed is set out in paragraph 4.1 of the

Policy:

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

(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.

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in paragraph 3.4.

27. The Canadian registered trade-mark, being TMA810,178 for the word "TWENGA";

has a filing date of May 12, 2008 and was registered October 25, 2011. Note that the Canadian trade-mark registration is after the date of registration of the domain name in question, which was October 5, 2010.

28. The preliminary question to be determined is if the Complainant had rights in a Mark prior to the date of registration of the Domain name as required by paragraph 4.1 (a) of the Policy. The expression "Rights" is not defined in the Policy or the Rules. "Mark" is defined in paragraph 3.2 of the Policy and includes a registered Canadian trade-mark.

29. The date of filing of an application for a trade-mark is the date that an applicant is asserting that it should be entitled to exclusive use of the trade-mark regarding certain specified goods or services. A trade-mark may be registerable in Canada pursuant to clause 14 (1) (b) of the *Trade-marks Act*, R. S. C., 1985, c. T-13:

14. (1) Notwithstanding section 12, a trade-mark that the applicant or the applicant's predecessor in title has caused to be duly registered in or for the country of origin of the applicant is registrable if, in Canada, ...

(b) it is not without distinctive character, having regard to all the circumstances of the case including the length of time during which it has been used in any country; (emphasis added)

30. The Registrant had an opportunity to challenge the registration of the Canadian trade-mark to the word "TWENGA" during the trade-mark registration process and either did not do so or did not do so successfully. The registration of the trade-mark establishes the rights of the Complainant to the trade-mark.

31. The Canadian trade-mark registration references the registration in France of a trade-mark, mentioned above, being French registration number 04 3 324 517 dated November 18, 2004. The Wares and Services specified in the French registration are the same as those in the Canadian trade-mark registration.

32. Reverse domain name hijacking refers to a trade-mark holder bringing an action to obtain a registered domain name which domain name had been registered before the trade-mark was obtained. The essence of the problem is that the trade-mark is sought and obtained in order primarily to gain access to or challenge for a domain name. The goods and services the trade-mark is obtained for are different than the goods and services offered under the domain name. If the goods and services are identical, then the prior use by the domain name holder would be relevant in the trade-mark

application process and the domain name holder would be in a position to challenge and block registration of the trade-mark. In those circumstances, the Canadian Intellectual Property Office would be tasked with determining which of the claimants was appropriately entitled to the trade-mark. This is the case in the circumstances of the trade-mark for “TWENGA” as the usage is specifically including on-line services for the sale of goods.

33. *Cheap Tickets and Travel Inc. v. Emall.ca Inc.* CDRP Decision no. 4 (January 31, 2003) examined a similar set of circumstances where the trade-mark was registered after the registration date of the domain name in dispute. The Panel (Bradley J. Freedman, David R. Haigh Q.C. and Patrick Flaherty) in this case found:

39. The Complainant also relied upon its May 25, 1999 application to the Canadian Intellectual Property Office for the registration of the CHEAP TICKETS trade-mark, and the subsequent registration of that trade-mark. In the Panel’s view, the trade-mark application is not evidence that the CHEAP TICKETS trade-mark was distinctive either on the date of the application or on September 16, 1999 (the domain name registration date). By virtue of Trade-marks Act section 54, the registration of the CHEAP TICKETS trade-mark is evidence of the facts set out in the registration. However, the trade-mark registration is not conclusive or determinative of those facts, particularly where the validity of the trade-mark is challenged.

...

41. After careful consideration of all of the Complainant’s evidence and argument, the Panel concludes that the Complainant has not proven, on a balance of probabilities, that CHEAP TICKETS was a “Mark” within the meaning of the Policy prior to the Domain Name registration date. In particular, the Panel concludes that the Complainant has not provided sufficient evidence of the use and distinctiveness of the CHEAP TICKETS trade-mark so as to prove, on a balance of probabilities, that prior to September 16, 1999 the Complainant or its predecessors used the CHEAP TICKETS trade-mark for the purpose of distinguishing the wares, services or business of the complainant or its predecessor.

34. The saga of this particular dispute continued after the domain name dispute ended.

Emall.ca Inc. v. Cheap Tickets and Travel Inc. [2009] 2 F.C.R. 43(F.C.A.) was an

appeal decision affirming a decision by the Federal Court to expunge a trade-mark and a design mark for “Cheap Tickets” owned by Cheap Tickets and travel Inc.; see (2007), 56 C.P.R. (4th) 81; 311 F.T.R. 295; 2007 FC 243). At paragraph 15 of its decision, the Federal Court of Appeal discussed the Federal Court decision:

[15] Justice Strayer found that the trade-marks were clearly descriptive of the character or quality of the services or wares in association with which they were used by Cheaptickets, a travel agency. On that basis, he concluded that by virtue of the combined operation of paragraph 18(1)(a) and paragraph 12(1)(b), the registration was invalid.

35. The *Cheap Tickets* domain dispute resolution case provides a useful discussion of use and distinctiveness as they are applied in Canadian trade-mark law. At paragraph 31:

If a complainant’s “Mark” is a trade-mark registered in the Canadian Intellectual Property Office prior to the domain name registration date, the complainant is not required to establish distinctiveness or use - the mere registration of the trade-mark is sufficient to establish “Rights” in the “Mark”. On the other hand, if the complainant’s “Mark” is an unregistered trade-mark or a trade-mark registered in the Canadian Intellectual Property Office after the domain name registration date, the complainant must establish that the trade-mark was used in Canada by the complainant or its predecessor for the purpose of distinguishing the wares, services or business of the complainant or its predecessor prior to the domain name registration date.

To determine if the Complainant had rights in a Mark prior to the date of registration of the Domain name as required by paragraph 4.1 (a) of the Policy, a registered Canadian trade-mark must be owned by the Complainant prior to the filing of the Complaint.

Foreign and unregistered trade-marks are not sufficient. A pending application for a Canadian trade-mark is also not sufficient, only a registered Canadian trade-mark will support a complaint. Once such registration has occurred, I agree with the quotation from *Cheap Tickets* that “the complainant must establish that the trade-mark was used in Canada by the complainant or its predecessor for the purpose of distinguishing the

wares, services or business of the complainant or its predecessor prior to the domain name registration date.” Prior use will establish rights in the Canadian registered trade-mark prior to the date of registration of the Domain name.

36. The Complainant did not submit evidence of prior use of the trade-mark in Canada to me. It had, however, filed its application for the trade-mark on May 12, 2008. Unlike the Learned Panel in *Cheap Tickets*, I am prepared to find that once a trade-mark has been registered, that the trade-mark owner has rights in the Mark from the date of application and thereafter. Further, in the case of a trade-mark registered based on clause 14 (1) (b) of the *Trade-marks Act*, R. S. C., 1985, c. T-13, I am prepared to accept that the Complainant has rights in the Mark back to the date accepted by the Canadian Intellectual Property Office for the TWENGA trade-mark, which was issued based on the registration in France on November 18, 2004. Rights are not defined in the Policy and in my view are not limited to the classical test of prior use as described in “Cheap Tickets.”
37. A broad reading of the phrase “rights in the Mark” is required to provide for a fair balance between the rights of a domain name holder and that of a trade-mark registrant. The trade-mark registrant has followed the application process in the *Trade-marks Act* and that process allows for a determination of who is entitled to the use of the trade-mark. In the case of trade-marks which are for the same class of goods and services as provided by the owner of the domain name, I defer to the registration of the trade-mark as establishing which of the competing claimants have rights in the trade-mark. Where the trade-mark is for a different class of goods and services, considerations of the possibility of reverse domain name hijacking would lead to the necessity of then

balancing the rights of the parties by considering restricting the interpretation of “rights in the Mark” to the date of Registration of the trade-mark. I leave that analysis to a future date when such a fact circumstance comes before me.

38. The domain name and the registered Canadian trade-mark are identical except for the addition of the “.ca” domain suffix. I find that the domain name is confusingly to the trade-mark.
39. Paragraph 3.5 of the Policy sets out circumstances that evidence when a domain name registration has been made in bad faith. The Complainant provided evidence that the Twenga.ca domain is a site providing links to various companies offering goods and services of various kinds. The name is posted on the site as “Twenga.ca Inquire about the domain name.” This is a domain name parking site referring people who go to this domain to other on-line advertisers and offering the domain name as being for sale. The evidence of the Complainant is that its twenga.com and its 26 other domain suffixes are active as an on-line seller of deals on goods and services. The links on the twnga.ca site are to competitors of TWENGA, the company. I am satisfied that the test for bad faith registration of the twnega.ca domain name as set out in sub-paragraph 3.5 (d) of the Policy has been met by the Complainant.
40. The next test to be considered is whether the registrant has any legitimate interest in the domain name as provided for in paragraph 3.4 of the Policy. Referencing the clauses in paragraph 3.4 of the Policy:
- a. There is no evidence that the Registrant has any rights in the Twenga mark;

- b. According to the Complaint, Twenga is a word from an African dialect meaning “straight to the goal.” It is not clearly descriptive of anything in either of the English or French languages.
- c. Twenga is not a generic name for any goods or services, in any language.
- d. The domain is being used to refer traffic to other sites for business purposes and is clearly not a non-commercial activity.
- e. The word “Twenga” is not the legal name of the Registrant or any other type of reference to the Registrant.
- f. The domain name is not a geographical name of a location of the Registrant.

41. I am satisfied that the Registrant has no legitimate interest in the domain name.

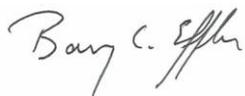
Conclusion and Decision

42. The Complainant has established its case in accordance with paragraph 4.1 of the Policy.

43. Paragraph 4.3 of the Policy requires me to determine if the appropriate remedy is to delete the registration of the domain name or order it transferred to the Complainant.

The domain name is based on a distinctive word that is trade-marked in Canada by the Complainant. The appropriate remedy therefore is a transfer of the domain name and accordingly, I direct that the domain name “Twenga.ca” be transferred to the Complainant.

This Decision made at Winnipeg, Manitoba this 23rd day of January, 2012.



Barry C. Effler, LL.B., LL.M., C. Arb. (Fellow)
Sole Panelist