

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

Dispute Number: DCA-1415-CIRA
Domain Name : <mymagna.ca>
Complainant: Magna International Inc.
Registrant: Victor Silva
Registrar: Go Daddy Domains Canada, Inc.
Panel: The Honourable Neil Anthony Brown QC
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

THE PARTIES

1.The Complainant in this proceeding is Magna International Inc., a Company incorporated under the laws of Canada of 337 Magna Drive, Aurora, ON L4G 7K1, ("Magna").

2.The Registrant is Victor Silva, of 2943 Major Mackenzie Dr, PO Box 96740, Maple, ON L6A OA2, Canada ("the Registrant").

THE DOMAIN NAME AND REGISTRAR

3.The Domain Name in issue in this proceeding is <mymagna.ca> ("the disputed domain name").

4.The Registrar is: Go Daddy Domains Canada, Inc.(Registrar Number : 2316042)

5.The disputed domain name was registered by the Registrant on June 26,2011.

PROCEDURAL HISTORY

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

7. According to the information provided by the BCICAC :

- (a) the Complainant filed a Complaint with respect to the disputed domain name in accordance with the Policy on August 1,2012.
- (b) the Complaint was reviewed and found to be compliant. By letter dated August 7, 2012, the BCICAC as service Provider confirmed compliance of the Complaint and commencement of the dispute resolution process;
- (c) the Complaint was sent by the BCICAC to the Registrant by **email** on August 7, 2012, together with a copy of the Complaint Transmittal Sheet and copies of exhibits **No.1-23** to the Complaint which were deemed to be delivered to the Registrant on August 8,2012. Pursuant to Rule 4.4, the proceedings were deemed to **be** commenced on August 8,2012;
- (d) by means of the said **email** of August 7,2012, the Respondent was informed that he had 20 days to respond to the Complaint by filing with the **BCICA** a Response in accordance with the Policy and the Resolution Rules and that his response was due no later than August 28,2012. The Registrant did not reply to that communication and has not provided a Response;
- (e) as permitted under **CIRA** Domain Name Dispute Resolution Rules ("the Rules") the Complainant elected under Rule 6.5 to convert from a panel of three to a single arbitrator.

8. (i) On September 10,2012, **BCICAC** named The Honourable Neil Anthony Brown QC as the Panel. On September 11,2012, the Panel signed an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.

(ii) The Panel has reviewed all of the material submitted by the Complainant and is satisfied that the Complainant is an eligible Complainant under the Policy and the Rules;

9. In accordance with Rule 5.8, where, as here, no Response is submitted, the Panel shall decide the Proceeding on the basis of the Complaint.

FACTS

10. The facts set out below are taken from the Complaint.

11. Magna is a Canadian company engaged in the global automotive supply industry and is one of Canada's largest and best known companies. It was founded in **1957** and has been very successful, making its name, trademarks and products very well known in Canada and beyond. Magna owns various Canadian trademark registrations comprising or containing the expression MAGNA which are very well known for their association with automotive products of the Complainant.

12. Evidence has been submitted by the Complainant of the registration of the various trademarks of the Complainant for MAGNA ("the MAGNA Trademarks") and the Panel

accepts that evidence. The MAGNA trademarks have been extensively and continuously used and promoted in Canada for many years and as a result they have **become** very well known.

13. The Registrant registered the disputed domain name on June 26, 2011. The disputed domain name resolves to a parking page **website** displaying a banner featuring an image of an automobile. The site is populated with **"pay-per-click"** advertisements that resolve to **websites** promoting automotive goods and services supplied by competitors of the Complainant.

14. The Respondent has contacted the Complainant and offered to sell the disputed Domain Name to it. The Complainant has responded by rejecting that offer and demanding that the Respondent cease and desist from his activities relating to the registration and use of the domain name. However, the Respondent has replied by naming a lesser sum as his price for the domain name but otherwise continues with his retention and use of the domain name.

CANADIAN PRESENCE REQUIREMENTS

15. The Canadian Presence **Requirements** for Registrants (the "Presence Requirements") require that in order for a **Registrant to be permitted** to apply for registration of and to hold and maintain the registration of a ".ca" domain name, the **applicant** must meet at least one of the criteria—listed as establishing a Canadian presence. Section 2(d) of the Presence Requirements specifies that a corporation incorporated pursuant to the laws of Canada or of a Canadian province satisfies this requirement.

16. The Complainant is incorporated under the laws of the Province of British Columbia and accordingly, satisfies the Canadian Presence Requirements.

POSITION OF THE COMPLAINANT

17. The Complainant submits that:

(a) **CONFUSINGLY SIMILAR**

The disputed domain name 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.

The Complainant is the owner of the MAGNA Trademarks and has prior rights in those marks in accordance with paragraph 3.2(c) of the Policy.

The Registrant registered the disputed domain name on June 26, 2011. All the MAGNA Trademarks matured to registration well before the registration date of the disputed domain name, the earliest of which, Registration **No. TMA303**, 870, matured to registration on June 21, 1985, but it has been used by the Complainant since 1968.

The disputed domain name is confusingly similar with the MAGNA Trademarks as it so nearly resembles same in appearance, sound or in the ideas suggested so as to be likely to be mistaken for the mark. In particular, the Respondent has taken the Complainant's trademark and used it in his domain name after adding the **letters** "my" as a prefix, which gives rise to confusion as to whether the domain name is an official domain name of the Complainant.

Accordingly, the domain name is confusingly similar to a mark in which the complainant had prior rights to the date of registration of the domain name.

(b) **NO LEGITIMATE INTEREST**

The Registrant has no legitimate interest in the disputed domain name as described in paragraph 3.4.

No Relationship Between the Parties

There has never been any relationship between the Complainant and the Registrant, and the Registrant has never been licensed, or otherwise authorized to register or use, the MAGNA Trademarks in any way, including in, or as part of, a domain name.

Paragraph **3.4(a)**

The disputed domain name has not been used as a Mark as defined by the Policy, namely "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". Nor does the Registrant have any Rights in any use of the Domain Name as a trademark. In any event, the disputed domain name was not acquired in good faith or for a *bona fide* purpose.

Paragraph **3.4(b)**

The Registrant has not used the disputed domain name in association with any wares, services or business and the Domain Name is not clearly descriptive in any of the senses stipulated by this paragraph.

Paragraph **3.4(c)**

The Registrant cannot claim a legitimate interest in the disputed domain name, as **<mymagna.ca>** is not generic of any wares, services or business, nor has the disputed domain name been acquired in good faith or for a *bona fide* purpose.

Paragraph **3.4(d)**

The Registrant has never used the disputed domain name in association with a non-commercial activity, and therefore cannot invoke paragraph **3.4(d)** of the Policy.

Paragraph **3.4(e)**

The disputed domain name is not a legal name, surname, or other reference, by which the Registrant is commonly identified and, accordingly, the Registrant cannot rely on paragraph **3.4(e)** of the Policy.

Paragraph **3.4(f)**

The disputed domain name is not the geographical name of the location of the Registrant's non-commercial activity or place of business.

Accordingly, the Registrant does not have a legitimate interest in the disputed domain name and is therefore removed from the application of paragraph 3.4 of the Policy.

(c) REGISTRATION OF MYMAGNA.CA IN BAD FAITH

Purpose in Registering domain name - Paragraph 3.5(a)

The domain name was registered primarily for the Purpose of selling it to the Complainant. This is seen from the content of the Registrant's **website**, the use of the **website** by the Registrar to attempt to sell the domain name and the attempt of the Registrant to persuade the Complainant to buy the domain name from him.

Pattern of Bad Faith Registrations- Paragraph 3.5 (b)

On the evidence, the domain name was registered to prevent the Complainant from registering its MAGNA Trademarks in the form of the domain name and this is consistent with a well established **pattern** of conduct by the Registrant of registering domain names based on the registered trademarks of others.

Disrupt A Competitor - Paragraph 3.5(c)

The Registrant registered the disputed domain name primarily for the purpose of disrupting the business of the Complainant. This is shown by the evidence that the Registrant intentionally registered the domain name to create a likelihood of confusion by driving traffic to or from the Registrant's **website** from which it stands to gain financially through redirection fees, thereby disrupting the Complainant's business.

Intentionally Attract Traffic For Commercial Gain - Paragraph 3.5(d)

The Complainant also relies on paragraph 3.5(d) of the Policy and submits that the Registrant intentionally attempted to attract, for commercial gain, Internet users to his **website** by creating a likelihood of confusion with the Complainant's MAGNA Trademarks **as** to the source, sponsorship, affiliation, or endorsement of the Registrant's **website** or location or of a product or **service** on the Registrant's **website** or location.

Surroundine Circumstances

The Complainant also relies on all of the surrounding circumstances which, in its submission, show that the Registrant registered the domain name in bad faith.

The facts demonstrate that the disputed domain name should be transferred to the Complainant **as**:

- (a) The disputed domain name is confusingly similar with the MAGNA Trademarks, in which the Complainant had rights prior to the registration date of the disputed domain name and continues to have such rights.
- (b) the Registrant does not have a legitimate interest in the domain name;
- (c) the Registrant registered the disputed domain name in bad faith :
 - (i) primarily for the purpose of selling it to the Complainant for valuable consideration in excess of the Registrant's actual costs of registration;
 - (ii) for the purpose of disrupting the business of the Complainant;
 - (iii) to prevent the Complainant from registering the domain name having engaged in a pattern of registering domain names in order to prevent persons who have rights in Marks **from** registering those marks **as** domain names ; and
 - (iv) intentionally to attract, for commercial gain, Internet users to his **website** by creating a likelihood **of confusion** with the Complainant's MAGNA Trademarks **as** to the source, sponsorship, affiliation, or endorsement.

POSITION OF THE REGISTRANT

18.The Registrant did not file a Response in this proceeding.

DISCUSSION

CONFUSINGLY SIMILAR

19. Under paragraph 4.1 of the Policy the Complainant must prove on the 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."

The Registrant has filed no response to the Complaint and, accordingly, the Registrant has provided no evidence of legitimate use.

The panel finds that the disputed domain name is confusingly similar to the Complainant's MAGNA Trademarks, being, within the meaning of paragraph 4.1 of the Policy, "a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights". That is so for the following reasons.

The Complainant has adduced evidence, which the panel accepts, that **Magna** is the owner of the MAGNA Trademarks and accordingly the Panel finds that the Complainant has rights in the MAGNA Trademarks and continues to have such rights.

The test of whether a domain name is confusingly similar with a mark, pursuant to paragraph 3.3 of the Policy, is if it so nearly resembles same in appearance, sound or in the ideas suggested so as to be likely to be mistaken for the mark. In undertaking that exercise, Paragraph 1.2 of the Policy provides that a domain name is defined so as to exclude the "dot-ca" suffix; see: *Coca-Cola Ltd. v. Amos B. Hennan*, BCICAC Case No. 00014.

The Panel has undertaken the comparison between the disputed domain name and the MAGNA Trademarks and in particular the effect of the prefix "my" that the Registrant has added before the trademark to create the domain name. It has now been well established that the use of such a prefix in these circumstances does not detract from an **identity** or confusing similarity that otherwise exists, as it does in the present case. *See,*

in this regard, the decision cited by the Complainant with respect to the analogous case of the domain name <myshaw.ca>: *Shaw Cablesystems GP v. Gnanavanmanm*, BCICAC Case No. DCA-1334-CIRA. In any event it is clear that the domain name cannot but suggest to the internet user that it relates to the MAGNA Trademarks, that it is probably an official domain name of the Complainant to be used by internet users interested in Magna's goods and services and that it will probably lead to an official website of the Complainant, all of which suggestions are of course false. Moreover, the MAGNA name is so well established and so prestigious as one of the most famous marks in Canada and beyond, that the objective bystander would naturally assume that the "magna" of the domain name was invoking the MAGNA of the trademark.

Accordingly the Panel finds that the domain name so resembles the trademark in appearance, sound and the ideas suggested as to be likely to be mistaken for the mark.

Accordingly, the Panel finds that the disputed domain name is confusingly similar with the MAGNA Trademarks in which the Complainant has rights prior to its registration date and continues to have such rights.

REGISTRATION OF MYMAGNA.CA.CA IN BAD FAITH

20. The Panel now turns to the second issue which is whether the disputed domain name was registered in bad faith. The Panel finds that, on each of the grounds relied on by the Complainant, the Registrant registered the disputed domain name in bad faith. The Panel will consider each of those grounds in turn.

Purpose in Registering domain name - Paragraph 3.5(a)

21. The Panel notes that the website to which the Respondent has caused the disputed domain name to resolve is populated by links and advertisements relating to motor cars and a broad range of other activities of an automotive nature. When it is also apparent that the most dominant element of the domain name is the same as the Complainant's prominent trademark and that the domain name is said to be for sale, the inference is irresistible that the intention of the Respondent in registering the domain name was to induce the Complainant to buy it and clearly for more than it had cost the Respondent to register it. The Panel also agrees with the Complainant that the evidence of the dealings between the parties shows that this was the intention of the Respondent and that he carried it through by persisting in his efforts to sell the domain name to the Complainant. This ground is therefore made out.

Pattern of Bad Faith Registrations - Paragraph 3.5 (b)

22. The Panel accepts the extensive evidence of the Complainant showing that the Registrant is the owner of more than 100 dot-ca domain names which include the trademarks of third parties, such as <mycostco.ca>. This shows, as the Complainant submits, that the Registrant has engaged in a deliberate and unauthorised pattern of domain name registration and in particular that it has prevented the Complainant from

registering the disputed domain name contrary to paragraph 3.5(b). This ground is therefore made out.

Disrupt A Competitor - Paragraph 3.5(c)

23. The Complainant has submitted that the Registrant registered the domain name <**mymagna.ca**> primarily for the purpose of disrupting the business of the Complainant. The Panel accepts that submission and finds accordingly. This finding is directly in point with the decision in *Credit Counselling Society of British Columbia v. Solutions Credit Counselling Service Inc.*, BCICAC Case No. 00031, where the panel observed:

We therefore infer that it registered the Domain Name with a view to attract to itself business from those who had come to recognize the Complainant's Mark, that is primarily for the purpose of disrupting the business of the Complainant.

Applying that principle to the present case, the Panel concludes that, as the disputed domain name is confusingly similar to the MAGNA Trademarks and incorporates the whole of the mark, the use of the disputed domain name in the manner shown by the Complainant must result in internet users thinking that the Registrant is by some means affiliated with, or endorsed by, the Complainant. That must surely be so in a case such as this where MAGNA is truly a famous mark and has been so for many years. When a Registrant takes a famous name and, without permission or authority, uses it as the basis for a domain name and then a website that promotes competing goods and services, the only rational conclusion that can be reached is that this was being done by the Registrant to cast himself in the role of a competitor of the Complainant and to disrupt the Complainant's business and divert that business to himself. the Registrant. This ground is therefore made out.

Intentionally Attract Traffic For Commercial Gain - Paragraph 3.5(d)

24. The Panel finds that within the meaning of paragraph 3.5(d) of the Policy, the Registrant intentionally attempted to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location. That is so because it has been held in analogous circumstances by past UDRP Panels, as submitted by the Complainant, that directing a domain name that is confusing with a third party trade-mark to a website designed to derive revenue by way of advertisements constitutes bad faith as per paragraph 4(b)(iv) of the UDRP. See: *Research In Motion Limited v. International Domain Names Inc. /Moniker Privacy Services*, WIPO Case No. D2008-0780; *Lowen Corporation d/b/a Lowen Sign Company v. Henry Chan*, WIPO Case No. D2004-0430.

Applying that principle to the present case and bearing in mind the evidence that the Registrant's website displays advertisements and links to third party websites offering

automotive-related goods and services for sale, it is plain that, as the disputed domain name contains the whole of the MAGNA Trademarks and is confusing with them, the disputed domain name is, within the meaning of paragraph 3.5(d), being used in an attempt intentionally to attract, for commercial gain, Internet **users** to the Registrant's **Website** by creating a likelihood of confusion with the subject marks and trade name as to source, sponsorship, affiliation or endorsement. This ground is therefore made out.

Surrounding Circumstances

25.The Panel also accepts the submission of the Complainant that the totality of the evidence, showing the registration of the domain name and the use to which it has been put by the Registrant shows that the Registrant registered the domain name in bad faith. This ground is therefore made out.

26.All of those factors go to show a very substantial case against the Registrant of **registration** of a domain name in bad faith.

27.Accordingly, the Panel finds that the Registrant registered the disputed domain name in bad faith within the meaning of paragraph 3.5(d) of the Policy.

NO LEGITIMATE INTEREST IN THE DOMAIN NAME

28. Paragraph 4.1 (c) of the Policy requires the Complainant to provide some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

29. The Panel finds that the Complainants have provided such evidence. The evidence has already been mentioned above, but in essence it is as follows:

- (a) The registration and use by the Registrant of the disputed domain name has been without the permission of the Complainant and there is no relationship between the Complainant and the Registrant.
- (b) The disputed domain name has not been used as a Mark "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".
- (c) The disputed domain name was not acquired in good faith or for a *bona fide* purpose because it is confusing with the Complainant's MAGNA Trademarks to which the Registrant has no entitlement and the presence of advertisements for the goods and services of competitors of the Complainant shows that the registration and use of the domain name has been for illegitimate purposes.

- (d) The Registrant has not used the disputed domain name in good faith in association with any wares, services or business, and the Domain Name is not clearly descriptive.
- (e) The disputed domain name is not generic of any wares, services or business, nor has it been used in good faith or for a *bona fide* purpose.
- (f) The Registrant has never used the disputed domain name in association with a non-commercial activity.
- (g) Magna is not a legal name, surname, or other reference, by which the Registrant is commonly identified.
- (h) The disputed domain name is not the geographical name of the location of the Registrant's **non-commercial** activity or place of business.

30.The Panel accepts the submission of the Complainant that the above matters constitute evidence that the Registrant has no legitimate interest in the disputed domain name and makes a finding to that effect.

31.As the Registrant has not filed a response to the Complaint or sought to rebut the above evidence, he has provided no evidence of legitimate use.

DECISION

32.The Panel finds that the Complainants have satisfied the requirements of Paragraph 4.1 of the Policy and that it is entitled to the remedy that it seeks.

ORDER

33.The Panel directs that the registration of the Domain Name <my**magna.ca**> be transferred from the Registrant to the Complainant Magna International Inc.

Date: September 13, 2012



The Honourable Neil Anthony Brown QC