

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

Dispute Number: DCA-1513-CIRA CDRP
Domain Name : <empiretheatres.ca>
Complainant: Empire Theatres Limited
Registrant: Michael Morgan
Registrar: AvailableDomains.ca 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 Empire Theatres Limited of 610 East River Road, New Glasgow, NS B3H 3S (“Empire”) represented by Jonathan D. Tenenbaum, Esq., Web.com Group, Inc. 12208 Gran Bay Parkway West Jacksonville, FL, USA 32258.

The Registrant is Michael Morgan of 15 Lorna Court, Elmsdale, NS B2S1H4, Canada (“the Registrant”).

THE DOMAIN NAME AND REGISTRAR

2. The Domain Name in issue in this proceeding is <empiretheatres.ca> (“the disputed domain name”). The Registrar is AvailableDomains.ca Inc.: The disputed domain name was registered by the Registrant on or about January 19, 2011.

PROCEDURAL HISTORY

3. 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”).
4. According to the information provided by the BCICAC :
 - (a) The Complainant filed a Complaint with respect the disputed domain name in accordance with the Policy on June 21, 2013.
 - (b) The Complaint was reviewed and found to be compliant. By letter dated June 25, 2013, BCICAC as service Provider confirmed compliance of the Complaint and commencement of the dispute resolution process.

- (c) The Complaint together with its annexures was sent by BCICAC as service provider to the Registrant by letter and email on June 25, 2013 and delivered on that date; a successful mail delivery report was subsequently furnished, enabling the Panel to conclude that the Complaint and its schedules were duly delivered to the Registrant. By the same communication the Registrant was informed that it could file a Response in the proceeding.
- (d) The Registrant did not reply to that communication and did not provide 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.
- (f) On July 29, 2013, BCICAC named The Honourable Neil Anthony Brown QC as the Panel. On August 2, 2013, the Panel signed an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.
- (g) 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.
- (h) 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

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

- (a) Empire is among the largest and well-known movie exhibition and entertainment providers in Canada.
- (b) Empire is the owner of a Canadian trademark registration on March 12, 1993 with CIPO for the EMPIRE THEATRES Mark as further identified as Registration No. TMA409468.
- (c) Registrant registered the disputed domain name on January 19, 2011. The domain name has at times resolved to what appears to be a monetization webpage that carries links to for-profit sites, from which Registrant may be inferred to collect revenue in the form of pay-per-click and/or affiliate marketing fees, that advertise and sell a variety of goods and services including some related to movies and movie tickets that directly compete with Empire's goods and services.

POSITION OF THE COMPLAINANT

6. Complainant submits as follows:

- (a) Empire is a large movie exhibition and entertainment provider in Canada. Throughout its history Empire has spent a significant amount of money and extensive resources on development and marketing of the Mark and its brand. The Mark has been used on or in connection with Empire's business in Canada since 1984. Empire is also the owner of a Canadian trademark registration with CIPO for the EMPIRE THEATRES Mark as further identified as Registration No. TMA409468. Data from

CIPO as related to the Mark's CIPO trademark registration is attached to this Complaint as Annex 2.

(b) Registrant's domain name is identical or confusingly similar to the Mark.

(c) Registrant registered the Domain Name without authorization on or about January 19, 2011. The Domain Name has at times resolved to what appears to be a monetization webpage that carries links to for-profit sites, from which Registrant, on information and belief, collects revenue in the form of pay-per-click and/or affiliate marketing fees, that advertise and sell a variety of goods and services including some related to movies and movie tickets that directly compete with Empire's goods and services.

(d) The subject Domain Name (i) incorporates wholesale the famous and well-known Mark, (ii) is confusingly similar to Empire's own domain name EMPIRETHEATRES.COM, at which Empire operates a website, and (iii) so nearly resembles the Mark in appearance, sound and the ideas suggested thereby as to be likely to be mistaken for the Mark. The Domain Name virtually mirrors Empire's Mark and own website's domain name, and accordingly it cannot be disputed that the Domain Name is identical and confusingly similar to Mark.

(e) Registrant Has Registered and is Using the Domain Name in Bad Faith. The Registrant, recognizing the famous renown of the Mark, registered and uses the subject domain name, which wholly incorporates the Mark, so as to attract and mislead users who are searching for information about the Empire products in order to profit from the Internet traffic through collection of the click-through revenue, and to mislead and confuse consumers as to the origin, source or sponsorship of Registrant's website.

(f) The Mark is an invented and coined mark that has a strong reputation, of which Registrant was undoubtedly aware at the time the Domain Name was registered. Moreover, by virtue of the registration of the Mark, Registrant had constructive knowledge of Empire's rights in the Mark at the time the Domain Name was registered.

(g) Registrant has registered and is using the subject domain name intentionally to misdirect and divert customers looking for the Empire goods and services to a for-profit web site that collects revenue from websites advertised on the Registrant's website.

(h) As a direct consequence of the Registrant's conduct, the public will be misled as to the source, sponsorship or origin of the information and products offered on the links connected to the subject website. The Registrant's purposefully deceptive domain name anticipates, relies upon and profits from this consumer confusion and constitutes bad faith use of the Domain Name.

(i) Regardless, Registrant's actions are intentional, willful and clearly in bad faith, and were committed with full knowledge of the ownership by Empire of the Mark and the Complainants' exclusive rights to use and license the Mark.

(j) Registrant's Other Actions are Representative of Bad Faith. Registrant maintains a large number of domain name registrations, several of these domain registrations clearly support a bad faith claim under Section 3.5(b) of the Policy, as to a pattern of registering domain names in order to prevent persons who have rights in those marks from registering the marks themselves as domain names. The foregoing clearly supports a bad faith claim under Section 3.5(c) of the Policy.

(k) Complainant has made numerous attempts to contact Registrant in this matter, all of which have been ignored,

(l) Registrant has no rights or legitimate interests in the Mark.

(m) Complainant is not affiliated in any way with Registrant and has never authorized Registrant to use the Mark and/or or to register or use the Domain Name. Registrant is not, nor ever has been, a representative of Empire or licensed to use the Mark. Upon information and belief, Registrant is not commonly known by the name "Empire Theatres" or any variation thereof. Registrant has no trademark rights in the Mark or in the Domain Name. Accordingly, Registrant has no right or legitimate interest in the Mark or in the Domain Name.

(n) It is clear that Registrant had knowledge of the Mark prior to the registration of the Domain Name. Registrant's use of the Domain Name confirms that he is not making a legitimate non-commercial or fair use of the Domain Name without intent for commercial gain. There is no information whatsoever in support of any proposition whereby Registrant could be considered to have a legitimate interest in the Domain Name pursuant to any of the circumstances listed in Section 3.4 of the Policy.

(o) Directing Internet users to websites featuring revenue generating advertisements or links does not constitute bona fide offering of goods or services and is not a legitimate or noncommercial fair use. Moreover, it is not a legitimate use of the Mark to use it in a domain name to attract customers and re-direct them to competing products.

DISCUSSION

(A) CONFUSINGLY SIMILAR

7. 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.”

8. Registrant has filed no response to the Complaint and, accordingly, it has provided no evidence of legitimate use. Complainant has verified all of the above matters that it relies on by affidavit evidence and the Panel accepts that evidence.

9. The panel finds that the disputed domain name is confusingly similar to the Complainant’s EMPIRE THEATRES mark, 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.

10. Complainant has adduced evidence, which the panel accepts, that it is the owner of the EMPIRE THEATRES trademark.

11. Accordingly, the Panel finds that Complainant has rights in the EMPIRE THEATRES trade-mark and continues to have such rights.

12. The test of whether a domain name is confusingly similar with a mark or trade name, 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.

13. 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.

14. The Panel has undertaken the comparison between the disputed domain name and the EMPIRE THEATRES trade mark and finds that the domain name so nearly resembles the trademark in appearance, sound and the ideas suggested as to be likely to be mistaken for the mark. The EMPIRE THEATRES name is clearly well established and so prestigious that the objective bystander would naturally assume that the “empire theatres” of the domain name was invoking the EMPIRE THEATRES of the trademark and that it was an official EMPIRE THEATRES domain name leading to an official EMPIRE THEATRES website.

15. Moreover, if the trade-mark is included in the disputed domain name, a Registrant cannot avoid a finding of confusion by appropriating another’s entire mark in a domain name: *RGIS Inventory Specialists v. AccuTrak Inventory*, BCICAC Case No. 00053; *Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)*, BCICAC Case No. 00020. Applying that principle to the present case, the disputed domain name incorporates the whole of the registered EMPIRE THEATRES trade-mark. Accordingly, the Panel finds that the Registrant cannot avoid a finding of confusion as it has misappropriated the entirety of the EMPIRE THEATRES trade-mark.

16. As Complainant puts it in the Complaint, in a proposition with which the Panel agrees: “The Domain Name virtually mirrors Empire’s Mark and own website’s domain name, and accordingly it cannot be disputed that the Domain Name is identical and confusingly similar to Mark.” Accordingly, the Panel finds that the disputed domain name is confusingly similar

with the EMPIRE THEATRES trade-mark in which Complainant had rights prior to its registration date and continues to have such rights.

(B) NO LEGITIMATE INTEREST IN THE DOMAIN NAME

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

18. The Panel finds that Complainant has provided such evidence. Complainant's case in this regard is as follows: Registrant has no legitimate interest in the disputed domain name as described in paragraph 3.4 of the Policy because of the following:

- (a) "Complainant is not affiliated in any way with Respondent and has never authorized Respondent to use the Mark and/or to register or use the Domain Name. Respondent is not, nor ever has been, a representative of Empire or licensed to use the Mark. Upon information and belief, Respondent is not commonly known by the name "Empire Theatres" or any variation thereof. Respondent (Registrant) has no trademark rights in the Mark or in the Domain Name. Accordingly, Respondent (Registrant) has no right or legitimate interest in the Mark or in the Domain Name". On the evidence, the Panel accepts that submission and so finds.
- (b) "Empire's use and registration of the Mark long precedes Respondent's (Registrant's) registration in 2011 of the subject Domain Name. Moreover, given the widespread publicity and fame of the Mark, Respondent's (Registrant's) use of the .ca suffix in conjunction with the Mark, and the links included on Respondent's (Registrant's) website, it is clear that the Respondent (Registrant) had knowledge of the Mark prior to the registration of the Domain Name. Respondent's (Registrant's) use of the Domain Name confirms that he is not making a legitimate non-commercial or fair use of the Domain Name without intent for commercial gain. There is no information whatsoever in support of any proposition whereby Respondent (Registrant) could be considered to have a legitimate interest in the Domain Name pursuant to any of the circumstances listed in Section 3.4 of the Policy. Rather, Respondent (Registrant) has intentionally registered the Domain Name explicitly for the purpose of making illegitimate or unfair use of the Mark by using the Domain Name to improperly attract Internet visitors who will then generate pay-per-click and/or affiliate marketing fees when they click through the links on Respondent's (Registrant's) website to the for-profit third-party websites advertised there, including links to third-party websites that offer products and services that compete directly with Empire's products and services". On the evidence, the Panel accepts that submission and so finds.
- (c) "It is widely held that directing Internet users to websites featuring revenue generating advertisements or links does not constitute bona fide offering of goods or services and is not a legitimate or noncommercial fair use. Moreover, it is not a legitimate use of the Mark to use it in a domain name to attract customers and re-direct them to competing products." On the evidence, the Panel accepts that submission and so finds.

The same result on this issue is reached by an examination of the various criteria set out in paragraph 3.4 of the Policy.

- (a) Registrant has not used the domain name as a mark in good faith with Registrant having rights in the mark within the meaning of subparagraph 3.4 (a).
- (b) There is no evidence that Registrant registered the domain name in association with any particular wares, services or business and it is therefore not possible to consider whether the term EMPIRE THEATRES is clearly descriptive of, or a generic name for, any wares, services or business under subparagraphs 3.4(b) and (c) of the Policy.
- (c) There is no evidence that the domain name is being used for non-commercial activity, or at all, within the meaning of subparagraph 3.4(d).
- (d) There is no evidence that the domain name is a legal name of Registrant or the name or surname or other reference by which Registrant was or is commonly identified within the meaning of subparagraph 3.4 (e).
- (e) Sub-paragraph 3.4 (f) of the Policy does not apply because the term EMPIRE THEATRES is not a geographical location.

19. The Panel accepts the submission of Complainant and the evidence adduced in its support and concludes that these matters constitute evidence that Registrant has no legitimate interest in the disputed domain name.

20. Moreover, Registrant has not filed a response to the Complaint or sought to rebut the above evidence and has thus provided no evidence of legitimate use. In addition, in view of the facts set out above, it is inherently unlikely that Registrant has or could establish a legitimate interest in the domain name.

(C) REGISTRATION OF EMPIRE THEATRES.CA IN BAD FAITH

21. The Panel now turns to consider whether the disputed domain name was registered in bad faith. The Panel finds that, on the ground relied on by Complainant and generally, Registrant registered the disputed domain name in bad faith.

22. Complainant's case in support of bad faith is as follows:

- (a) Registrant, being aware of the famous renown of the Mark, must be taken to have registered and used the subject domain name, which wholly incorporates the Mark, to attract and mislead users who are searching for information about the Empire products in order for him to profit from the Internet traffic through collection of the click-through revenue, and to mislead and confuse consumers as to the origin, source or sponsorship of Registrant's website. Accordingly, the only reasonable inference is that Registrant has acted with a bad faith intent to profit from the Mark.
- (b) Registrant had constructive knowledge of Empire's rights in the Mark at the time the Domain Name was registered. Normally, constructive notice is not seen as sufficient to prove bad faith, but in the light of the evidence the Panel finds that Registrant had actual notice and hence registered the domain name in bad faith.
- (c) It was further submitted that it is bad faith to register a domain name for the purpose of intentionally attempting to attract, for commercial gain, Internet users to the registrant's website or other on-line location, by creating a likelihood of confusion

with another'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. This is one of the particular circumstances evidencing bad faith under Section 3.5(d) of the Policy. The Panel finds on the totality of the evidence and drawing all reasonable inference from it, that this ground has been made out.

- (d) It was also submitted that as a direct consequence of Registrant's conduct, the public will be misled as to the source, sponsorship or origin of the information and products offered on the links connected to the subject website, that the Registrant's purposefully deceptive Domain Name anticipates, relies upon and profits from this consumer confusion and constitutes bad faith use of the Domain Name and that, although it appears the Domain Name may currently direct traffic to the EMPIRETHEATRES.COM website, this is probably just temporary and may be an effort on the part of Respondent to avoid Empire's claims in this matter. The Panel agrees with these submissions and so finds
- (e) It was also submitted that in any event Registrant's actions must be taken to be intentional, willful and clearly in bad faith, and were committed with full knowledge of the ownership by Empire of the Mark and Complainants' exclusive rights to use and license the Mark. The Panel agrees and so finds.
- (f) Complainant also relies on a list of additional .ca domain names registered by Registrant and attached hereto as Annex 4 that was put in evidence. It was submitted that the list shows that Registrant maintains a large number of domain name registrations, several of which clearly support a bad faith claim under Section 3.5(b) of the Policy, as to a pattern of registering domain names in order to prevent persons who have rights in those marks from registering the marks themselves as domain names. The Panel finds that the list clearly supports a bad faith claim under Section 3.5(c) of the Policy. The only conclusion that can be reached on this evidence is that Registrant has engaged in a pattern of registering domain names in order to prevent persons with rights in the trademarks from registering the trademarks as domain names.
- (g) Complainant maintains that it should also be noted that it has made numerous attempts to contact Registrant in this matter, all of which have been ignored, including but not limited to various efforts set out in the evidence. The Panel agrees that the evidence relating to this matter shows evidence of bad faith on the part of Registrant.

23. The Registrant has filed no response to the Complaint and, accordingly, Registrant has provided no evidence on the issue of bad faith. The Panel therefore accepts that the evidence and the inferences open on the evidence show bad faith registration on the part of Registrant.

2. GENERAL

24. The Panel has also had regard to all of the circumstances revealed by the case presented by Complainant and finds that quite apart from and in addition to the liability of Registrant pursuant to paragraph 3.5 (b) of the Policy, Registrant registered the disputed domain name in bad faith within the generally accepted meaning of that expression.

25. In particular, the accumulated facts are that : (a) Complainant's trademark is well known and has been so for many years; (b) Empire has spent a significant amount of money and extensive resources over the years on development and marketing of the Mark and its brand; (c) Registrant has taken Complainant's trademark to use as a domain name without the

approval or consent of Complainant; (d) this calls for an explanation unless an adverse inference is to be drawn from it; (e) Registrant has not put in a Response or sought to explain itself by some other means and accordingly adverse inferences may be drawn from that fact; and (f) Registrant has accumulated a stock of domain names that raise the suspicion that it is a serial offender in this regard.

26. Those being the facts, the Panel finds that Registrant registered the disputed domain name in bad faith within the generally accepted meaning of that expression.

DECISION

27. The Panel finds that Complainant has satisfied the requirements of Paragraph 4.1 of the Policy and that it is entitled to the remedy it seeks.

ORDER

The Panel directs that the registration of the Domain Name <**empiretheatres.ca**> be transferred from Registrant to Complainant.

Date: August 9, 2013

The Honourable Neil Anthony Brown QC

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