

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

Dispute Number: DCA-1600-CIRA
Domain Name: <amazonfirephone.ca>
Complainants: Amazon.com, Inc., Amazon Technologies, Inc.,
Eamazon (Canada) Inc.
Registrant: Unknown, but appears to be shi lei or Cheng Luo
Register: Go Daddy Domains Canada, Inc.
Panelists: Harold Margles, James E. Redmond Q.C., Melvyn Simburg
Service Provider: British Columbia International Commercial
Arbitration Centre

PARTIES

The Complainants, who also identify themselves collectively as the Complainant, comprise Amazon.com, Inc., its affiliate and intellectual property holding company Amazon Technologies, Inc., and its affiliate Eamazon (Canada) Inc. All three of these companies show their address as 410 Terry Avenue North, Seattle, Washington, USA. There is no evidence that Eamazon has a place of business, or otherwise carries on business, in Canada. While the Complaint invites the panel to refer to one or more of the Complainants as the context requires, the evidence does not identify which company engages in which activity and, in particular, which company, if any, uses the many Amazon trademarks in Canada, the manner of such use, the amount of advertising dollars spent in marketing and advertising in Canada, or the extent of such use across Canada over any given period of time.

An eligible Complainant "must at the time of submitting a complaint satisfy the Canadian presence requirements 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" - CIRA Domain Name Dispute Resolution Policy 1.4.

This Complaint is founded upon the registrations of the trademark Amazon in Canada. While the Complainant Technologies appears to be the ultimate owner of 17 Amazon Canadian trademarks, the involvement of the other Complainants in the sales, marketing and distribution of products and services in association with the trademark Amazon is unclear. As Technologies meets the presence requirements and has requested transfer of the Domain Name to itself, the Panel will not address whether either of the other styled Complainants is a proper party, or has met the standing, presence and use

requirements of the Policy. Henceforth all references to the Complainant shall refer to Amazon Technologies, Inc.

Amazon.com began business on the World Wide Web in July 1995, and serves consumer customers through numerous retail websites. Its most recently reported quarterly sales amount to \$19.4 billion. The company employs 124,600 full and part-time employees. It is number 49 on the "Fortune 500" list of America's largest corporations.

The Registrant's identity is unknown. The Complainant believes that the Registrant is a person or entity known as "shi lei", in light of the fact that such a person or entity registered identical second level domains in the top level domains info, .org, .us, .co, .co.uk, and .in, within days of the date on which the Registrant registered the disputed Domain Name < **amazonfirephone.ca** > on April 6, 2014. The Registrant is engaged in passive holding of the disputed Domain Name.

PROCEDURAL HISTORY

On July 15, 2014, the Complaint was filed with respect to the disputed Domain name < **amazonfirephone.ca** > with the British Columbia International Commercial Arbitration Centre, hereafter referred to as the Centre. The Complaint was reviewed by the Centre and found to be in administrative compliance with the requirements under Rule 4.2 of the CIRA Domain Dispute Resolution Rules, hereinafter referred to as the CIRA Rules. By letter and e-mail on July, 16, 2014, The Centre advised the parties that the Complaint had been reviewed and found to be compliant. The Centre advised that on July 16, 2014 it had forwarded a copy of the Complaint to the Registrant by electronic transmission and on August 15, 2014 enclosed, with the Centre's letter to the Panel, confirmation of the delivery of the Complaint to the Registrant. The Registrant has not provided a Response to the Complaint.

The Panel has reviewed the documentary evidence provided by the Complainant. The Panel agrees with the Centre's assessment that the Complaint complies with the formal requirements of the CIRA Policy and its Rules.

The Panel believes that it was constituted in compliance with the CIRA Rules. The panelists have each completed an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.

The Complainant Amazon Technologies is the owner of 1,429 trademark registrations world-wide that consist of or contain the Amazon trademark. 17 of these registrations are in Canada, the first being TMA for the mark Amazon, on November 23, 2000. It is also the owner of at least 66 trademark registrations worldwide for marks that consist of or contain the "FIRE" trademark, and has filed Canadian trademark applications for registration of the trademark "AMAZON FIRE" on April 2, 2014, 4 days before the Registrant registered the disputed Domain Name. There is no evidence of the Complainant's use of the trademark "FIRE" in Canada prior to the filing of these 2 applications for registration.

A Complainant is the Registrant of the Domain Name < **amazonfire.com** >, which was created on April 17, 2002, and is used in association with goods and services associated with the "FIRE" trademark, as

well as the Domain Name <amazon.ca> which was created on September 19, 2000, and is used in Canada.

A Complainant announced the Amazon "Kindle Fire" reader on September 28, 2011, and has developed a series of Kindle Fire e-readers which a Complainant continues to market in association with its trademarks. On April 2, 2014, a Complainant launched its Amazon Fire TV products. On numerous occasions prior to Registrant's registration of the disputed Domain Name, the mainstream and technology press and blogs reported that a Complainant would launch a smartphone with a 3-D screen. A Complainant offers for sale on its Amazon websites a number of phone and phone-related products.

DECISION

At the time this matter was being considered by this Panel, an arbitration decision was rendered in Amazon.com, Inc.; and Amazon Technologies, Inc. v. shi lei in the National Arbitration Forum. The arbitrator dealt with the same Registrant, shi lei, having registered the almost identical Domain Name <amazonfirephone.us> in the United States.

The Arbitrator held that:

Both Amazon.com, Inc. and Amazon Technologies, Inc. have sufficient nexus to claim rights in the <amazonfirephone.us> Domain Name.

The Respondent, shi lei, registered the Domain Name on April 2, 2014.

The Complainant has proved that the Domain Name <amazonfirephone.us> is:

- (a) Confusingly similar to the trademarks Amazon and Fire of the Complainants.
- (b) The Respondent, shi lei, has no legitimate interests or rights in respect of the Domain Name.
- (c) The Domain Name has been registered or is being used in bad faith.

The evidence before the arbitrator and this Panel is not significantly different, other than the fact that the Complainants had registered and used the trademark Fire in the United States prior to the Registrant registering the Domain Name in Canada and the United States on the same date. In Canada, since April 17, 2002, the Complainants had the registered Domain Name <amazonfire.ca> used in association with the goods and services associated with the FIRE trademark and sold on its websites.

Inasmuch as all of the evidence has been submitted by the Complainant, the Panel accepts the evidence and submissions of such counsel subject to their relevance, the weight to be attached thereto, and the inferences to be drawn therefrom. As the Registrant has chosen not to contest the Complaint or submit any evidence or to consent to the transfer of the disputed Domain Name, the Panel will, accordingly, draw such inferences as common sense and the Complainant's unchallenged evidence and submissions mandate.

The Complainant must establish that the disputed 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

Is the Domain Name < **amazonfirephone.ca**> confusingly similar to Complainant's U.S. and Canadian registered trademark **Amazon** and registered U.S. and unregistered Canadian trademark FIRE?

The Registrant's passively held Domain Name antedated the Complainant's application for registration of the trademark FIRE, but subsequent by 12 years to the Complainant's registered Domain Name <**amazonfire.com**>.

The trademark Amazon has become so well-known through its websites, sales and the ongoing introduction of new products and services, that it has a very high level of distinctiveness.

The disputed Domain Name contains both of The Complainant's trademark **Amazon** and their American registered trademark FIRE, together with the generic word "phone".

"The fact that the whole of the distinctive element of the (Complainant's trademarks) is incorporated into the Domain Name is sufficient to support a finding of confusing similarity."

General Motors Acceptance Corporation v Bob Woods Case No. DCA-891-CIRA

"A domain name containing a well-known trademark in its entirety is confusingly similar to the trademark".

American Express Marketing and Development Corp. v Nameshield Inc., c/o Daniel Mullen CIRA Dispute No.00249 (Resolution Canada)

"...combination of two trademarks must be considered as confusingly similar to such trademarks."

Credit Industriel et Commercial S.A. v Richard WIPO Case no.D2005-0569.

Although the disputed Domain Name also contains the generic word "phone", this word "is only likely to increase the confusing similarity" given that the word is connected to Complainant's recent product innovations. *American Express Marketing supra*.

"It is a well established principle that a domain name that wholly incorporates a Mark in particular one as famous as the one in this case will be found to be confusingly similar to the Mark despite the fact that the domain name may also contain a descriptive or generic term."

L'Oreal SA & L'Oreal Canada v Victor Silva Case No. DCA-1478-CIRA

"the overall impression of the designation" of the disputed Domain Name is one of being connected to the Complainant.

Wikimedia Foundation Inc. v Kevo Ouz a/resolve to a websitek/a/Online Marketing Realty WIPO Case No. D2009-07798

The Panel can reasonably infer both from the evidence and the failure of the Registrant to respond to the Complaint, that the Registrant deliberately created the disputed Domain Name so as to make it confusingly similar to the Complainant's trademarks in both the United States and Canada so as to cause confusion. The timing of the Domain Name registration evidenced the Registrant's knowledge of the media release publicity relating to the launch of the Amazon Fire TV products as well as Amazon phones. The Complainants have satisfied the burden of proof under paragraph 3.1 (a) of the Policy. The disputed

Domain Name <amazonfirephone.ca> is confusingly similar to the Complainant's trademarks Amazon and Fire.

Pursuant to 3.1(b) and 3.4 of the Policy, does the Registrant have a legitimate interest in the Domain Name?

The Registrant has adduced no evidence that it owns any goods or services in association with the disputed Domain Name. There is no evidence that the Registrant registered the disputed Domain Name in good faith. There is no evidence that the Registrant has used the disputed Domain Name in good faith, or at all. The disputed Domain Name is not the name of the Registrant, or a geographical area.

The Panel finds in all the circumstances, as well as the absence of any evidence supporting any of the factors in 3.4 of the Policy, that the Registrant has no legitimate interest in the disputed Domain Name <amazonfirephone.ca>.

Pursuant to Paragraphs 3.1(c) and 3.5 of the Policy, has the Registrant registered the disputed Domain Name in bad faith?

The Registrant chose to adopt a Domain Name where the prominent component was the world famous trade-mark - AMAZON owned by the Complainant. This evidences an intention to attract for commercial gain the attention of internet users.

"The apparent lack of so-called active use (e.g. to resolve to a website) of the domain name without any active attempt to sell or contact the trademark holder (passive holding) does not as such prevent a finding of bad faith. The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include the complainant having a well-known trademark, no response to the complaint having been filed, and the registrant's concealment of his identity. Panels may draw inferences about whether the domain name was used in bad faith given the circumstances surrounding the registration, and vice versa."

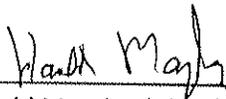
Second Edition WIPO Overview 2.0 paragraph 3.2

These factors are applicable to the present case. The contemporaneous registrations of the disputed Domain Name in both the United States and Canada, passive holding, no response to each Complaint, the Amazon trademark being very well-known and the Registrant's concealment of his identity, satisfy the Panel that the Registrant registered the Domain Name primarily for the purpose of disrupting the business of the Complainant. Paragraph 3.5 of the Policy does not limit acts of bad faith to those enumerated as examples.

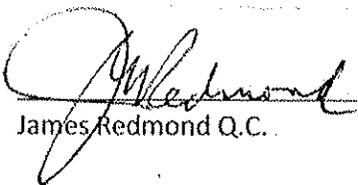
The Panel finds that the Registrant registered the disputed Domain Name <amazonfirephone.ca> in bad faith.

The Panel orders that the registration of the Domain Name <amazonfirephone.ca> be forthwith transferred to the Complainant Amazon Technologies, Inc. by the Registrar Go Daddy Domains Canada, Inc. (Registrar Number 2316042)

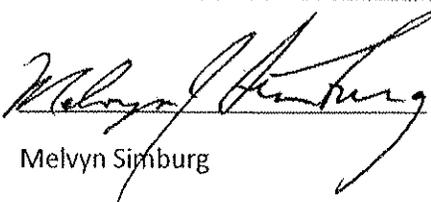
Dated this 21st day of September, 2014



Harold Margles (Chair)



James Redmond Q.C.



Melvyn Simburg