

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

Dispute Number: DCA-1883-CIRA
Domain Name: <regeneron.ca>
Complainant: Regeneron Pharmaceuticals, Inc.
Registrant: Dave Chandler
Registrar: Rebel.ca Corp
Panel The Honourable Neil Anthony Brown QC
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

OVERVIEW

1. This matter concerns a dispute between the Complainant and the Registrant regarding the registration of <regeneron.ca> ("the disputed domain name").
2. 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").
3. This is a proceeding under the CIRA Domain Name Dispute Resolution Policy (the "Policy") in accordance with the CIRA Dispute Resolution Rules (the "Rules").
4. The Complainant claims that the Registrant registered the disputed domain name in breach of the Policy.

THE PARTIES

1. The Complainant in this proceeding is Regeneron Pharmaceuticals, Inc. of 777 Old Saw Mill River Road, Tarrytown, NY 10591, United States of America ("the Complainant").
2. The Registrant in this proceeding is Dave Chandler of 1475 Lower Water St 343, Halifax, NS, B3J 3Z2, Canada and wd.chandler@gmail.com ("the Registrant").

REGISTRATION OF THE DISPUTED DOMAIN NAME

The disputed domain name was registered by the Registrant on December 7, 2016. The Registrar of the disputed domain name is Rebel.ca Corp. of 300-12 York St. Ottawa, Ontario, Canada. K1N 5S6.

PROCEDURAL HISTORY

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 May 26, 2017.
- (b) The Complaint was reviewed and found to be administratively compliant and the BCICAC as service provider confirmed administrative compliance of the Complaint to the parties and, as Notice in accordance with Rules 2.1 and 4.3, forwarded a copy of the Complaint to the Registrant, together with its Schedules.
- (c) The Complainant and the Registrant attempted to negotiate a settlement; however they were unable to come to a mutual agreement. The Registrant requested an extension to the time within which to file a

Response but the Complainant opposed such an extension. The Registrant has not filed a Response in this proceeding. Consequently and as permitted by the Rules, the Complainant has elected under Rule 6.5 to convert from a panel of three to a single arbitrator.

(d) On June 19, 2017, the BCICA appointed The Honourable Neil Anthony Brown QC as sole arbitrator of the proceeding. The arbitrator has signed an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.

(h) 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 by virtue of its ownership of several trademarks registered with the Canadian Intellectual Property Office.

FACTS

The facts set out below are taken from the Complaint, together with related exhibits. Where there are factual matters in dispute they are dealt with elsewhere in this decision.

The Complainant is a company incorporated in the United States of America with its principal place of business at 777 Old Saw Mill River Road, Tarrytown, NY 10591, United States of America. It was founded in 1988 and is a leading science and technology company delivering life-transforming medicines for serious diseases. It owns the REGENERON trademarks in the USA and Canada. Without permission of the Complainant the Registrant registered the disputed domain name on December 7, 2016. The domain name resolves to a website which offers the domain name for sale. The domain name does not otherwise resolve to an active website. The Registrant has attempted to sell the domain name directly to the Complainant for \$1,500. The Complainant's case is that the domain name incorporates its trade name and trademark, that the Registrant's conduct shows that it is in breach of the Policy and that the domain name should be transferred to the Complainant.

The Complainant is the owner of two trademarks registered with the Canadian Intellectual Property Office ("CIPO"), namely:

- (a) TMA496348 for REGENERON, registered on June 18, 1998;
- (b) TMA896616 for REGENERON, registered on February 17, 2015;

collectively, "the REGENERON trademark").

CONTENTIONS OF THE PARTIES

A. THE COMPLAINANT

The Complainant submits as follows:

1. CANADIAN PRESENCE REQUIREMENTS

The Complainant satisfies the Canadian presence requirement of paragraph 1.4 the Policy and paragraph 2(q) of the *CIRA Policies, Procedures and Guidelines: Canadian Presence Requirements for Registrants* in view of the Complainant's trade name and registered trademarks of the REGENERON trademarks with CIPO, evidence of which is adduced in Exhibit 4 to the Complaint.

2. THE REGISTRAR

The Registrar of record in respect of the disputed domain name registration is Rebel.ca Corp. The Complainant has adduced evidence to that effect (see Exhibit 5 to the Complaint for a copy of the CIRA WHOIS database search results for the disputed domain name).

3. THE COMPLAINANT'S RELEVANT TRADEMARK RIGHTS AND THEIR USE BY THE COMPLAINANT IN ITS BUSINESS

The Complainant is the owner of all rights in and to the distinctive mark REGENERON. In Canada the Complainant owns the registered trademarks incorporating the word REGENERON (more particularly described above in this decision). Print outs for CIPO's online database relating to those trademarks are contained in Exhibit 4 to the Complaint.

Since 1988, the Complainant has had a long history of scientific and technological achievements using the REGENERON trademarks. In particular, the Complainant has extensively and continuously used the REGENERON trademark in the US, Canada and around the world.

The Complainant has had significant recognition of its work over many years. In 2011, Regeneron's President and CEO, Leonard S. Schleifer was named Ernst & Young's 2011 New York Entrepreneur Of The Year, and the Complainant has also received several significant awards marking achievements in its field of work.

The Complainant has thus acquired a long-standing and well developed reputation for its work.

4. THE GROUNDS ON WHICH THE COMPLAINT IS MADE

The Registration and Use of the disputed domain name.

On December 7, 2016 without the permission of the Complainant, the Registrant registered the disputed domain name. The Complainant attaches Exhibit 5 which is a copy of the WHOIS information for the domain name together with CIRA's notice advising of the identity of the domain name owner.

The domain name resolves to a website which offers the domain name for sale. The Registrant has also offered to sell the domain name to the Complainant for \$1,500. The Complainant attaches Exhibit 6 which is a copy of the email from the Registrant to the Complainant offering to sell the domain name for \$1500.

The Registrant owns more than 12,000 <.ca> domain names many of which incorporate the trademarks of other parties.

The Complainant sent a cease and desist letter to the Registrant on May 11, 2017 and received a reply on May 12, 2017, a copy of which is attached to the Complaint as Exhibit 6, offering the domain name for sale for \$1500.

Confusingly Similar.

The Complainant submits that the disputed domain name is confusingly similar to the REGENERON trademark as it so nearly resembles the trademark in appearance, sound and in the ideas suggested so as to be likely to be mistaken for the trademark. Moreover, the entire trademark is incorporated in the domain name. The disputed domain name is therefore confusingly similar to the REGENERON trademarks in which the Complainant had rights prior to the registration date of the domain name and continues to have such rights.

Registration of the disputed domain name in bad faith.

The Complainant relies on paragraph 3.5 (a)

The disputed domain name was registered by the Registrant in bad faith as it was registered primarily for the purpose of selling it to the Complainant or a competitor for valuable consideration in excess of the Registrant's actual costs of registering the domain name, namely attempting to sell it to the Complainant for \$1500.

The Complainant relies on paragraph 3.5 (b)

The Registrant registered the domain name to prevent the Complainant from registering the REGENERON trademarks as a domain name and to that end the Registrant engaged in a pattern of registering domain names to prevent the trademark owners from registering their marks as domain names.

The Registrant has No Legitimate Interest in the Domain Name

There is and 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 trademarks in or as part of a domain name.

The Complainant relies on each of Paragraphs 3.4 (a), (b), (c), (d), (e) and (f) and submits that the facts of the case do not come within any of those provisions and that consequently, the Registrant has no legitimate interest in the disputed domain name.

Accordingly, the Complainant has made out each of the elements that it is required to establish.

The disputed domain name should therefore be transferred from the Registrant to the Complainant.

B. THE REGISTRANT

The Registrant did not file a Response in this proceeding.

However, on May 15, 2017 the Registrant sent an email to the Complainant stating "I will transfer the domain regeneron.ca for \$1,500."

The Panel will take that email into account in formulating its decision.

DISCUSSION OF THE ISSUES

1. CANADIAN PRESENCE REQUIREMENTS

Paragraph 1.4 of the Policy provides that a complainant initiating a complaint must satisfy the Canadian Presence Requirements for Registrants in respect of the domain name that is the subject of the proceeding.

Paragraph 2 (q) of the Requirements provides that:

"A Person which does not meet any of the foregoing conditions [conditions (a) to (p)], but which is the owner of a trade-mark which is the subject of a registration under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13 as amended from time to time, but in this case such permission is limited to an application to register a .ca domain name consisting of or including the exact word component of that registered trade-mark".

The Complainant is the owner of the two REGENERON trademarks more particularly set out above and which are registered with CIPO. The Complainant has produced evidence of those registrations in Exhibit 4 to the Complaint and which the Panel accepts.

The Complainant has therefore satisfied CIRA's Canadian Presence Requirement for Registrants in respect of the disputed domain name. It should also be noted that TMA496348 for REGENERON was registered on June 18, 1998 and TMA896616 for REGENERON was registered on February 17, 2015, both of which dates are prior to the date on which the disputed domain name was registered, namely December 7, 2016.

2. GENERAL

The purpose of the Policy, as stated in paragraph 1.1, is to provide a forum in which cases of bad faith registration of .CA domain names can be dealt with relatively inexpensively and quickly.

In accordance with paragraph 4.1 of the Policy, to succeed in the Proceeding, 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.

The Panel will now deal with each of the three elements.

3. CONFUSINGLY SIMILAR

As the Complainant correctly submits, it is required to prove 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 disputed domain name and continues to have such Rights. The Complainant must therefore show that it has rights to a mark, that it had those rights before the domain name was registered, that it still has them and that the disputed domain name is confusingly similar to the marks on which it relies to establish that proposition. The Complainant submits that it can meet those requirements.

The first question that arises is whether the Complainant has a trademark on which it can rely for the purpose of this proceeding. The Complainant has adduced evidence which the Panel accepts, to show that it is the owner of two trademarks for REGENERON and in both cases consisting solely of that term and which are registered in Canada. The details of those trademarks and the Complainant's rights to those marks are verified and set out in Exhibit 4 to the Complaint. They are the trademarks already defined as the REGENERON trademark. The Panel accepts the evidence and finds that the Complainant is the owner of the two REGENERON trademark.

The next question that arises is whether the mark relied on are "mark(s)" in which the Complainant had Rights prior to the date of registration of the Domain Name and continues to have such Rights. Taking in turn each of the two trademarks and bearing in mind that the date of registration of the domain name was December 7, 2016, ("the due date") the Panel holds that:

- (a) The Complainant did have rights in TMA496348 for REGENERON, registered on June 18, 1998, prior to the due date;
- (b) The Complainant did have rights in TMA896616 for REGENERON, registered on February 17, 2015, prior to the due date.

The Panel also finds that with respect to the two trademarks in which the Complainant had rights prior to the due date, the Complainant continues to have such rights. That is so because the Panel finds that the REGENERON marks are marks as defined by Paragraph 3.2 of the Policy and that they come within the meaning of "mark" in Paragraph 3.2 (a), as the unchallenged evidence shows that they are all registered with CIPO. The panel therefore finds that the two REGENERON trademarks are marks in which the Complainant had rights before the disputed domain name was registered and in which it still has rights.

Pursuant to paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if it so nearly resembles the same in appearance, sound or in the ideas suggested so as to be likely to be mistaken for the mark. The test to be applied when considering "confusingly similar" is one of first impression and imperfect recollection and the "dot-ca" suffix should be excluded from consideration; *see . Coca-Cola Ltd. v. Amos B. Hennan*, BCICAC Case No. 00014

Having regard to those principles, the Panel finds that the disputed domain name is confusingly similar to the Complainant's REGENERON trademark. That is so because an objective bystander when asked to make a comparison between the domain name and the trademark would clearly see that they are the same. The objective bystander would then assume that the domain name was related to the trademark and that it may well be an official domain name of the Complainant. An internet user would also probably conclude that the idea suggested by the domain name was that it was the name of the REGENERON brand and that it would lead to a website dealing with the Complainant's business conducted under that brand.

Accordingly, the disputed domain name is confusingly similar to the REGENERON trademark as it so nearly resembles the marks in appearance, sound and in the ideas suggested as to be likely to be mistaken for the REGENERON trademark itself, within the meaning of Paragraph 3.3 of the Policy.

The Panel therefore concludes that the disputed domain name is confusingly similar to the REGENERON trademark in which the Complainant had rights prior to the registration date of the disputed domain name and in which it continues to have such rights.

The Complainant has thus made out the first of the three elements that it must prove.

NO LEGITIMATE INTEREST IN THE DOMAIN NAME

Under the Policy, the question whether the Registrant has a legitimate interest in the disputed domain name is to be decided in the following framework. First, there must be an assertion that the Registrant has no legitimate interest in the domain name. That criterion has been satisfied because the Complainant has made such an assertion in the Complaint.

Secondly, there is a positive obligation then imposed on the Complainant which is described as an "onus", meaning clearly an onus of proof. That onus of proof is set out in Paragraph 4.1 of the Policy, which provides that the Complainant must provide some evidence that "...(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4 (emphasis added)." Each of the sub-paragraphs of paragraph 3.4 describes a situation which, if made out, would give the Registrant a legitimate interest in the domain name. The obligation on the Complainant is therefore to show that the Registrant cannot make out any each of the successive tests in the sub-paragraphs of 3.4. The Complainant is not required to prove conclusively or even on the balance of probabilities that the Registrant cannot satisfy those tests, but merely that there is "some" evidence to that effect.

Thirdly, if and when that is done, the Panel has to decide whether the evidence as a whole shows on the balance of probabilities that the Registrant has a legitimate interest in the domain name. That is so because the final paragraph of 4.1 states that:

"Even if the Complainant ... 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."

Fourthly, paragraph 3.4 makes it clear that if the Registrant takes the opportunity of claiming that it has a legitimate interest in the domain name, it is not confined to the criteria set out in that paragraph, for those criteria are "without limitation". In other words, a registrant may try to bring itself within any of the specified criteria, but it may also rely on any other fact or argument it wishes to rely on to show that it has a legitimate interest. If it does do this, the role of the Panel is to decide if the registrant has made out its case and to make that decision on the balance of probabilities.

The first task of the Panel is therefore to see if the Complainant has provided "some evidence" that the Registrant has not brought himself within any of the specific criteria in paragraph 3.4.

Applying that test, the Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the disputed domain name. The Panel reaches the following conclusion on each of the sub-paragraphs of paragraph 3.4.

(a) Paragraph 3.4(a)

The Complainant has shown that the disputed domain name was not a mark, that the Registrant used any such mark in good faith or that the Registrant had rights in any such mark;

(b) Paragraph 3.4(b)

The Complainant has shown by the evidence that the Registrant did not register the domain name in good faith in association with any wares, services or business and that the domain name was clearly descriptive of: (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;

(c) Paragraph 3.4(c)

The Complainant has shown by the evidence that the Registrant did not register the domain name in Canada in good faith in association with any wares, services or business and that the domain name was understood in Canada to be the generic name thereof in any language;

(d) Paragraph 3.4(d)

The Complainant has shown by the evidence that the Registrant did not use the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;

(e) Paragraph 3.4(e)

The Complainant has shown by the evidence that the domain name did not comprise the legal name of the Registrant or that it was a name, surname or other reference by which the Registrant was commonly identified.

(f) Paragraph 3.4(f)

The Complainant has shown by the evidence that the disputed domain name is not the geographical name of the location of the Registrant's non-commercial activity or place of business.

In total, therefore, the Complainant has provided substantial and therefore more than "some" evidence that the Registrant cannot bring himself within any of the specified criteria in paragraph 3.4.

The Registrant has not availed himself of the substantial opportunities given him by the Policy to show that he has a legitimate interest in the domain name. Indeed, the major contribution on the Registrant to this proceeding is the email he sent to the Complainant on May 15, 2017 stating "I will transfer the domain regeneron.ca for \$1,500." This email shows the brazen attitude of the Registrant towards trademarks and their owners and clearly negates any notion that he might have a legitimate interest in the domain name.

The Complainant has therefore shown that the Registrant has no legitimate interest in the domain name and has thus established the second of the three elements that it must prove.

REGISTRATION IN BAD FAITH

The Panel now turns to consider whether the disputed domain name was registered in bad faith. In that regard, the Panel notes that, consistent with the decision in *Canadian Broadcasting Corporation? Societes Radio-Vanada v. William Quon*, CIRA Dispute Number 00006(April 8, 2003), pp.13-14, surrounding circumstances may be considered in assessing whether the disputed domain name has been registered in bad faith.

By clause 3.1 of the Policy, the Complainant is obliged to prove that:

"(c) the Registrant has registered the domain name in bad faith as described in paragraph 3.5. "

Section 3.5 provides that " (f)or the purposes of paragraphs 3.1(c) ... any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:... " and then goes on to provide four such circumstances, two of which are relied on by the Complainant, namely.

"(a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration; and

(b) 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;

(c) ...

(d)..."

It is to be noted again that the criteria for bad faith are not exclusive, but that complainants may rely on circumstances other than those enumerated to show bad faith registration.

The Panel will now examine the two criteria relied on by the Complainant.

Purpose of selling: Paragraph 3.5(a)

Here, the Complainant principally relies on the email the Registrant sent to the Complainant on May 15, 2017 stating "I will transfer the domain regeneron.ca for \$1,500. The Complainant also relies on the fact that the Registrant offered the domain name for sale at \$949 USD and \$499 USD.

The Panel finds those facts made out on the evidence.

These facts entitle the Panel to conclude that the primary intention of the Registrant when he registered the domain name was to sell it to the Complainant or a competitor or engage in some other dealing with the domain name that would produce a profit for the Registrant in excess of his registration costs.

That ground has therefore been made out by the Complainant and the Panel so finds.

Preventing the Complainant from registering its trademark as a domain name: Paragraph 3.5(b)

Clearly the Registrant registered the domain name with the intention that the Complainant could not register it. In doing so, the Registrant was continuing with a pattern of registering domain names to prevent the relevant trademark owners from doing so. That is so because the evidence is that the Registrant owns some 12,000 other <.ca> domain names and that some of them clearly incorporate well-known trademarks like MICROSOFT. Indeed, the proclivity of the Registrant to engage in this inappropriate activity is demonstrated by the UDRP decision in *William Grant & Sons Limited v. Dave Chandler* WIPO Case, No. D2016-0476 where the Registrant, also the Registrant in the present case, simply took the GLENFIDDICH trademark, created the domain name <glenfiddich.club> and linked it to advertisements for rival brands of whisky. In her decision, the learned panellist took the opportunity of saying of the Registrant:

"Fourth, the Respondent's registration of numerous other domain names incorporating third party trademarks to which the Respondent does not appear to have rights is further evidence of the Respondent's bad faith."

The Panel therefore has no hesitation in saying that this ground is made out and the Panel so finds.

Bad Faith in general

As has already been noted, bad faith registration may be shown by conduct other than the conduct specified. This is made clear by Section 3.5 providing as it does, that "(f)or the purposes of paragraphs 3.1(c) ... any of the following circumstances, **in particular but without limitation**, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:..." (emphasis added). This provision is included, as bad faith conduct may take many forms and it is frequently used to find bad faith registration and (under the UDRP) bad faith use.

Thus, Version 1.3 of the Policy, operating from August 22, 2011 adopted the formulation which provided that "any of the following circumstances, **in particular, but without limitation**, if found to be proved, shall be evidence that a Registrant has registered a domain name in bad faith..." (emphasis added) and that provision is then followed by four specified circumstances. The phrase adopted to effect this provision, "in particular, but without limitation" is the same as that used in the UDRP and which has always been interpreted as supporting the use of other circumstances in addition to the specified ones to show bad faith.

The Panel has examined all of the evidence carefully and has conclude that it shows on the balance of probabilities that the Registrant registered the domain name in circumstances that can fairly be described as bad faith within the generally accepted meaning of that expression.

The Complainant has thus made out the third of the three elements that it must establish.

CONCLUSION AND DECISION

The Panel finds that the constituent elements of the Policy have been made out and that the Complainant is entitled to the relief it seeks. The Panel will therefore order that the disputed domain name be transferred to the Complainant.

ORDER

The Panel directs that the registration of the Domain Name <regeneron.ca> be transferred from the Registrant to the Complainant, Regeneron Pharmaceuticals, Inc.

Date: June 27, 2017

A handwritten signature in black ink, appearing to read "Neil Brown", with a long horizontal flourish extending to the right.

The Honourable Neil Anthony Brown QC