

**CANADIAN INTERNET REGISTRATION AUTHORITY**  
**DOMAIN NAME DISPUTE RESOLUTION POLICY**  
**RESOLUTION OF COMPLAINT**

Dispute Number: DCA - 2148 - CIRA  
Domain Names: vivendi.ca  
Complainant: Vivendi  
Registrant: Microscience Corporation  
Panel: Melvyn J. Simburg (Chair), Thomas Manson, Q.C., and  
Anton Melnyk, Q.C.  
Service Provider: British Columbia International Commercial  
Arbitration Centre

**DECISION**

**The Parties**

1. The Complainant is a French multinational mass media conglomerate headquartered in Paris. The company has activities in music, television, film, video games, telecommunications, tickets and video hosting service
2. The Registrant is a company engaged in developing and marketing branding ideas and names, and selling them.

**The Disputed Domain Name and Registrar**

3. The Domain Name at issue is vivendi.ca (Disputed Domain Name).
4. The Registrar of record for the Disputed Domain Name is Burmac Business Systems, Ltd d/b/a dot-ca-registry.ca.
5. The Disputed Domain Name was registered on August 25, 2005.

**Procedural History**

6. The British Columbia International Commercial Arbitration Centre, (BCICAC) is a recognized service provider to the Domain Name Dispute Resolution Policy, (Policy) and the Rules, (Rules) of the Canadian Internet Registration Authority, (CIRA).
7. Complainant filed a complaint on October 4, 2019 (Complaint) with the BCICAC seeking an order in accordance with the Policy and the Rules that the Disputed Domain Name be transferred to Complainant.

8. BCICAC confirmed the Complaint to be in administrative compliance with the Rules. As the Complaint with attachments was filed exclusively online, BCICAC forwarded a copy of the Complaint to the Registrant in accordance with the Rules to domains@microscience.net.

9. The Registrant submitted its response to BCICAC on November 28, 2019.

10. Pursuant to request from the Panel, Complainant filed a Reply on January 6, 2020.

11. As required by paragraph 7.1 of the Rules, each Panellist has declared to BCICAC that he can act impartially and independently in this matter as there are no circumstances known to him that would prevent him from so acting.

12. The Panel is not aware of any other legal proceeding or other arbitration in relation to the Domain Name that would under paragraph 13.2 of the Rules result in a need to stay or terminate this proceeding.

### **Canadian Presence Requirements**

13. In order for Complainant to be permitted to apply for registration of, and to hold and maintain the registration of a “.ca” domain name, the Canadian Presence Requirements for Registrants, (the Presence Requirements) require that the applicant meet at least one of the criteria listed as establishing a Canadian presence.

14. Complainant is an eligible complainant under paragraph 1.4 of the Policy, because it meets the Canadian Presence Requirements as the owner of registered Canadian trademark VIVENDI, Reg. No. TMA537752 issued November 27, 2000, based on an application filed February 25, 1998.

### **Relief Requested**

15. Complainant requests that the Disputed Domain Name be transferred from the Registrant to the Complainant.

### **Positions of the Parties**

#### ***Position of Complainant***

16. The Complainant is a French multinational mass media conglomerate headquartered in Paris. The company has activities in music, television, film, video games, telecommunications, tickets and video hosting service. With 44,142 employees in 78 countries, the Complainant's total revenues amounted to €13,932 million worldwide in 2018.<sup>17</sup> The Complainant also owns and communicates on the Internet through various domain names, the main one being <vivendi.com>, registered on November 12, 1997. Complainant contends it is likely Registrant was aware of Complainant and

Complainant's activities through Complainant's website "vivendi.com" at the time Registrant registered the Disputed Domain Name.

18. The Disputed Domain Name <vivendi.ca> was registered on August 25, 2005 by the Registrant "Microscience Corporation". The Complainant contends that the domain name is identical to Complainant's Canadian trademark VIVENDI as the trademark VIVENDI is included in its entirety.

19. Complainant's mark VIVENDI is prior in time as it was registered with the Canadian Intellectual Property Office in the year 2000.

20. The Complainant contends the addition of a CCTLD ".CA" is not sufficient to escape the finding that the domain is identical to the trademark and does not change the overall impression of the designation as being connected to the Complainant's trademark.

21. The Complainant contends that the Registrant ("Microscience Corporation") has no rights or legitimate interests in respect of the domain name and is not related in any way with the Complainant. Furthermore, Complainant contends that the Disputed Domain Name was registered to attract Internet users for commercial gain as it redirects to commercial links related to Complainant.

22. Complainant submits that it does not carry out any activity for, nor does it have any business with the Registrant. Neither license nor authorization has been granted by the Complainant to the Registrant to make any use, or apply for registration of the disputed domain name; nor is the domain name related to a legal name of the Registrant.

23. The Registrant Microscience Corporation is affiliated to Daniel Mullen c/o/b Netnic Corporation and that Mr. Mullen engages in an extensive pattern of unauthorized domain name registrations without regard to rights holders and is a serial cybersquatter. Complainant further contends that the Disputed Domain Name was not registered for a legitimate business purpose, but rather to obtain commercial gain through traffic and being offered for sale, and that it is currently available for purchase.

### *Position of the Registrant*

24. Registrant maintains that the Complaint is not in compliance with Rules 4.1 and 4.2 and should be dismissed on that basis.

25. Registrant contends that the Complaint does not adequately identify the Registrant or identifies more than one party as the Registrant and is therefore deficient.

26. Registrant contends that the Complaint does not adequately identify the domain name in dispute.

27. Registrant contends that the Complaint suffers from additional defects in compliance with respect to parties, addresses, email addresses, phone numbers, and signature.

28. Registrant contends that Complainant's use of the trademark "Vivendi" is improper in that current active use is as a company name, not as a brand name. Registrant further contends that Complainant has no active business in Canada using the trademark "Vivendi" and that the mark is an orphaned mark. Registrant contends the mark "Vivendi" is being used by a different company without license from Complainant. Registrant contends that the goods and services listed for the mark "Vivendi" are conducted in Canada by Complainant. Registrant asks the Panel to judge the validity of the registration TMA537752 and not use the registration as a basis for Complainant to challenge Registrant's registration of the Disputed Domain Name.

29. Registrant cites the delay in Complainant's bringing this action 14 years after registration of the Disputed Domain Name and requests the Panel to deny the Complaint based on the doctrine of Laches.

30. Registrant contends that Mr. Mullen registered domains for his business, and any that are not immediately put to use are left with a parking service, so that the pages are not blocked by search engines. Mr. Mullen registers Latin words as domain names for potential future use. Mr. Mullen does not control what appears on the web pages, but Complainant could train the algorithm that delivers the results on the page to cause a certain appearance over time. Because Complainant is not in the business of parking domain names, Registrant contends there is no competition between Registrant's use and Complainant's business activities.

### **Analysis and Findings**

31. The purpose of the Policy as stated in paragraph 1.1 is to provide a forum in which cases of bad faith registration of dot-ca domain names can be dealt with relatively inexpensively and quickly. The Policy does not apply to other types of differences between owners of trademarks and Registrants of Domain names.

### ***Relevant provisions of the Policy are provided below***

32. Paragraph 4.1 of the Policy provides:

**4.1 Onus.** To succeed in a Proceeding, 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 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 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 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 of the Policy.

33. Paragraph 3.2 of the Policy provides in part:

**3.2 Mark.** A “Mark” is

(a) a trade-mark, including the word elements of a design mark, or a tradename that has been used in Canada by a person, or the person’s predecessor in title, 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;

The Policy does not require that a mark be registered in CIPO.

34. Paragraph 3.3 provides:

**3.3 Confusingly Similar:** In determining whether a domain name is “Confusingly Similar” to a Mark, the Panel shall consider only whether the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark.

In assessing whether a domain name is “Confusingly Similar,” the Panel shall consider only the appearance, sound, or idea suggested and not have regard to other factors. According to paragraph 1.2 of the Policy, the presence of the country code top-level domain “dot-ca” does not alleviate the potential confusion between a trademark and domain name. The addition lacks distinctiveness and is not sufficient to give the Domain Name an individual meaning.

35. Paragraph 3.4 provides:

**3.4 Legitimate Interest:** For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all the evidence presented, shall demonstrate that the Registrant has a legitimate interest in the domain name:

- (a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;
- (b) the Registrant registered the domain name in Canada in good faith in association with wares, services or business and the domain name was clearly descriptive in Canada in the English or French language 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) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;
- (d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;
- (e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or
- (f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

In paragraph 3.4(d) "use" by the Registrant includes, but is not limited to, use to identify a website.

36. Paragraph 3.5 provides:

**3.5 Registration in Bad Faith.** For the purposes of paragraph 3.1(c) and 4.1(b), 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:

- (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 Complainant, or Complainant's licensor or licensee of the Mark, or to a competitor of Complainant, or the licensor or licensee for valuable consideration in excess of the Registrant's actual costs in registering the domain name or acquiring the Registration;
- (b) the Registrant registered the domain name or acquired the Registration in order to prevent Complainant, or 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) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of Complainant, or Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant; or

- (d) the Registrant has intentionally attempted to attract, for commercial gain, internet users to the Registrant's website or other location, by creating a likelihood of confusion with 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.

37. In summary, to succeed in a proceeding, Complainant must prove on a balance of probabilities that:

1. The dot-ca domain name is confusingly similar to a Mark in which Complainant had Rights prior to the registration of the Disputed Domain Name and continues to have such Rights;
2. The registration by the Registrant of the Disputed Domain Name is in bad faith; and
3. Complainant must provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Name.

Notwithstanding evidence presented that the Registrant has no legitimate interest in the Disputed Domain Name, the Registrant will succeed if the Registrant proves on a balance of probabilities that the Registrant has a legitimate interest in the Disputed Domain Name.

### *Confusingly Similar to a Mark*

38. Evidence shows that Complainant is the owner of Complainant's Mark, that Complainant's Mark was in use when the Disputed Domain Name was initially registered, and Complainant continues to have its trademark rights and continues to use the Mark. The relevant definition of "Mark" requires that a trade-mark be "used". The term "use" is no longer defined in the Policy. The Complainant contends that the Mark is being used by Complainant and that the Mark is a famous mark deserving of protection in Canada. Registrant disputes Complainant's claims of use of the Mark and asks the Panel to find that the Mark has been orphaned or is otherwise invalid. The Panel declines to do so. Trademark challenges must be presented as Section 45 proceedings under CIPO; the domain name dispute process is not designed for lengthy or costly proceedings. This proceeding could be stayed if a CIPO proceeding were pending, but neither party has stated that such a proceeding currently exists.

39. In accordance with paragraph 3.3 of the Policy, a domain name is confusingly similar to a Mark if the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely mistaken for the Mark. In assessing the domain name, the dot-ca suffix is ignored. It is the narrow resemblance that is applied. The Disputed Domain Name incorporates the entire words of the dominant features of Complainant's Mark.

40. In the case of *Great Pacific Industries v. Ghalib Dhalq*, 00009 (CIRA Apr. 21, 2003), the Panel stated that the test of confusing similarity is whether the average Internet user,

with an imperfect recollection of the Mark who wishes to access a website operated by Complainant, either by entering a domain name including the Mark into the address bar of an Internet browser or by entering the key terms of the domain name into an Internet search engine, would likely be confused as a matter of first impression.

41. Internet users who wish to access a website operated by the Complainant, either by entering a domain name including the Trade-mark into the address bar of the Internet browser, or by entering the key term of the Domain Name into an Internet search engine, would likely find the Disputed Domain Name as a matter of first impression.

42. Accordingly, for the reasons stated above, the Disputed Domain Name is confusingly similar to Complainant's Mark.

***Rights in the Mark prior to the Disputed Domain Name registration and continuing Rights***

43. Complainant filed its trademark application in Canada for "vivendi" on February 25, 1998, and received registration on November 27, 2000, in International Classes 9, 35, 36, 37, 38, 39, 40, 41, 42, 43 (TMA537752). The Disputed Domain Name was registered on August 25 2005 by Registrant. Registrant's use has been solely for redirecting Internet traffic and parking the Disputed Domain Name for future use or sale.

44. The Panel is satisfied that Complainant's Mark was in use before initial registration of the Disputed Domain Name and accordingly Complainant had Rights in Complainant's Mark before the current Registrant's registration of the Disputed Domain Name and as the evidence shows that Complainant's rights are active, Complainant continues to have such Rights.

***Was the Disputed Domain Name registered in bad faith?***

45. The Panel notes that Section 3.5 of the Policy provides with respect to its subsections, that "any of the 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."

46. The Panel finds that the Registrant registered the domain name primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration.

47. The Panel further finds that the Registrant 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.

48. In addition, the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website, by creating a likelihood of confusion with Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website.

49. Based on all the circumstances demonstrated in the material and all the evidence provided by Complainant, the Panel is satisfied that Complainant has proven bad faith registration of the Disputed Domain Name as required by the Policy.

### *Legitimate Interest of the Registrant*

50. Paragraph 3.4 of the Policy sets out a non-exhaustive list of criteria upon which the Panel may find, based on all the evidence, that the Registrant has a legitimate interest in the Disputed Domain Name. Paragraph 4.1 of the Policy places the onus on Complainant to provide "some evidence" that the Registrant did not have a legitimate interest in the Disputed Domain Name. Although "some evidence" is not defined, it imposes, in the Panel's view, a lower threshold than would "a balance of probabilities." The onus on Complainant is to provide "some evidence" of a negative.

51. Complainant has provided evidence that none of the conditions stated in the non-exhaustive list contained in paragraph 3.4 of the Policy is present in this dispute, and therefore has met its burden to provide "some evidence" that the Registrant has no legitimate interest in the Disputed Domain Name, and in fact Complainant has provided evidence that the Registrant's interest is currently for an improper use.

52. Registrant did not provide evidence that on a balance of probabilities refutes Complainant's evidence. A practice of parking Latin-based domain names for future sale is not an active use of the Disputed Domain Name. Based on the evidence provided, the Panel is satisfied that the Registrant has no legitimate interest in the Disputed Domain Name.

### **Additional Defenses Raised by Registrant**

53. **Compliance with Rules 4.1 and 4.2:** The Rules provide that the Provider determines administrative compliance of the Complaint. The Provider has done so and the Panel has found no basis to overrule the Provider on this issue.

54. **Identification of Registrant, limitation to one Registrant, identification of domain name in dispute, defects in identification of parties, addresses, email addresses, phone numbers and signature:** The Provider has not rejected the Complaint based on administrative compliance and the Panel has found no basis to overrule the Provider on these issues. Furthermore, the Panel finds substantial and sufficient compliance.

55. **Defects in Complainant's trademark or registration:** For the reasons set forth earlier, the Panel declines to consider a trademark challenge in this forum.

56. **Laches:** Various panels have disagreed on whether *laches*<sup>1</sup> is an appropriate defense in a domain name proceeding. The recognition of *laches* as a defense in UDRP

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<sup>1</sup> To successfully defend on the basis of laches a defendant must demonstrate the presence of three elements: (1) a delay in asserting a right or a claim; (2) that the delay was not excusable; and (3) that there was undue prejudice to the party against whom the claim is asserted." *Kason Indus., Inc. v. Component Hardware Group, Inc.*, 120 F.3d 1199, 1203 (11th Cir.1997) cited in *Laminex, Inc. v. Yan*

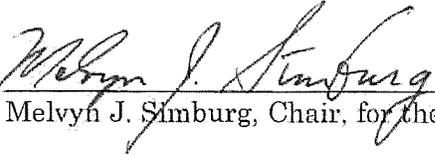
proceedings was discussed in *Professional Rodeo Cowboys Ass'n, Inc. v. Alternative Advertising Concepts, Inc. / Kenneth Forman*, FA 1440736 (Nat. Arb. Forum June 26, 2012) and *Laminex, Inc. v. Yan Smith*, FA1211001470990 (Nat. Arb. Forum, Jan. 7, 2013). This Panel cannot rule out that the equitable doctrine of laches might apply in an appropriate case, but the Panel prefers to decide this matter on the merits as set forth in the Analysis and Findings above.<sup>2</sup> Even if the doctrine might apply in a CIRA proceeding, the Panel emphasizes that the doctrine requires more than mere delay. A party against whom a claim is made must show either acquiescence by the claimant to the point of waiver, or prejudice or other potential injustice caused to a registrant by the delay in prosecuting the claim. Registrant has not done so.

## Decision

57. For the reasons set out herein, the Panel decides in favor of Complainant and orders the transfer forthwith of the Disputed Domain Name to Complainant.

Dated: February 10, 2020

Melvyn J. Simburg (Chair), Thomas Manson, Q.C., Anton Melnyk, Q.C.

  
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Melvyn J. Simburg, Chair, for the Panel

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*Smith*, FA1211001470990 (Nat. Arb. Forum, Jan. 7, 2013). In *Manitoba Metis Federation Inc. v. Canada (Attorney General)*, 2013 SCC 14 (CanLII), [2013] 1 SCR 623 the Chief Justice and Karakatsanis J, speaking for a majority of the court, stated (at para 145) that in determining whether there has been delay amounting to laches, the main considerations are (1) acquiescence on the claimant's part; and (2) any change of position that has occurred on the defendant's part that arose from reasonable reliance on the claimant's acceptance of the *status quo*: *M. (K.) v. M. (H.)*, [1992] 3 S.C.R. 6, at pp. 76-80. (at para 145) “.

<sup>2</sup> See *UTV Limited v. Unitedeurope Consulting, Kwang Pyo Kim* WIPO Case No. D2011-2293 (Mar 5, 2012), section 6.