

Registrant's pay-per-click domain is bad faith
Canada - Macera & Jarzyna - Moffat & Co

Internet issues
Domain names

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A [domain name dispute](#) resolved on December 2 1015 involved the ownership of the domain name 'behr.ca'. Complainant Behr Process Corporation sought an order that the domain name be transferred to it.

Complainant

Behr manufactures interior house paints, exterior house paints, decorative finishes, primers, stains and surface preparation products.

Behr owns Canadian trademark BEHR (Registration TMA369136), used continuously in Canada since May 3 1962, and Canadian trademark BEHR (Registration TMA912580), used continuously in Canada since March 26 2003.

A Canadian presence is required to own a '.ca' domain name. Since Behr owns the registered Canadian trademark BEHR, it is qualified to own the domain name 'behr.ca'.

Registrant

On January 9 2008 the domain name 'behr.ca' was created by the registrant. The identity of the registrant is 'privacy protected'.

'Confusingly similar' test

This proceeding was commenced pursuant to the Canadian Internet Registration Association Domain Name Dispute Resolution Policy (CDRP). To succeed in such proceedings, the complainant must prove, on the balance of probabilities, that:

- the registrant's '.ca' domain name is confusingly similar to a mark in which it had rights prior to the date of registration of the domain name, and continues to have such rights;
- the registrant has registered the domain name in bad faith as described in the CDRP; and
- the registrant has no legitimate interest in the domain name.

The CDRP has adopted a trademark test to determine confusing similarity. The test to be applied is one of first impression and imperfect recollection. The complainant must prove that a person, as a matter of first impression, knowing the complainant's corresponding marks only and having an imperfect recollection of the marks, would likely mistake the domain name for the complainant's marks based on the appearance, sound or idea suggested by the mark.

In addition, the complainant must demonstrate that it had rights in the mark that pre-date the registration of the domain name.

Bad-faith criterion

The complainant must also prove that the disputed domain name "has been registered and is being used in bad faith".

In this case, the undisputed evidence showed that the registrant simply pointed the domain name to a pay-per-click website, which may give rise to a finding of bad faith. These websites put the registrant in a position to reap a financial benefit by way of referral fees.

Evidence

Despite receiving notice of the complaint, the registrant made no submissions to the panel.

The links on the domain name included "Behr Paint Colors": "Interior Paint Colors", "Behr Paint": "Behr Paint Colors Interior" and other paint-related links. However, the complainant had in no way authorised, permitted or allowed the registrant to register or use the domain name.

The panel found that the registrant had intentionally attempted to attract, for commercial gain, internet users to an online location by creating a likelihood of confusion with the complainant's mark as to the source,

sponsorship, affiliation or endorsement of the registrant's website, which was evidence of bad faith.

Complainant's legitimate interest in domain name

In this case:

- the registrant did not own a relevant trademark;
- the registrant had not used the domain name in Canada in good faith in association with any goods, services or business;
- the domain name was not clearly descriptive in Canada, in the English or French language, of the character or quality of the goods, services or business, or of the conditions of, or the persons employed in, production of the goods, performance of the services or operation of the business; or of the place of origin of the goods, services or business;
- the registrant had not used the domain name in Canada in good faith in association with any goods, services or business and the domain name was not understood in Canada to be the generic name thereof in any language;
- the registrant had not used the domain name in Canada in good faith in association with a non-commercial activity, including criticism, review or news reporting;
- the domain name did not comprise the legal name of the registrant and was not a name, surname or other reference by which the registrant was commonly identified; and
- the domain name was not the geographical name of the location of the registrant's non-commercial activity or place of business.

All of this being so, the registrant had no legitimate interest in the domain name. As a result, the panel ordered the transfer of the domain name 'behr.ca' to the complainant.

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