

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

Domain Name: ULTIMATEFIGHTINGCHAMPIONSHIPS.CA

Complainant: Zuffa, LLC
Registrant: David Bruce
Registrar: Tucows.com Co.

Panel: David Lametti (sole panelist)

Service Provider: ResolutionCanada

DECISION

A. The Parties

1. The Complainant is Zuffa, LLC (“Zuffa” or “the Complainant”), a limited liability company registered in Nevada. Its corporate address is 2960 W. Sahara Avenue, Suite 200, Las Vegas, Nevada, USA, 89102. The Complainant’s authorized representative is Ms Carol Anne O’Brien, Barrister and Solicitor, 151 Yonge Street, Suite 1500, Toronto, Ontario, M5C 2W7.
2. The Registrant is Mr David Bruce. His address is 490A Hein, Kelowna, British Columbia, Canada, V1X 4A3.

B. The Domain Name and Registrar

3. The domain name at issue is ULTIMATEFIGHTINGCHAMPIONSHIPS.CA.
4. The domain name is registered with Tucows.com Co.

C. Procedural History

5. On 3 February 2011, the Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, Resolution Canada. The Provider served notice of the Complaint to the Registrant as required by paragraph 4.3 of the *CIRA Domain Name Dispute Resolution Rules* [“Rules”]. In the event of no response being filed, the Complainant elected to have the Complaint heard by a single panelist, as permitted under paragraph 6.4 of the Rules. The Complainant’s representative waived the right to suggest specific panelists.

6. An email response by the Registrant was received on 28 February 2011, the last day to on which to file for an extension to submit a response. This response did not conform to the requirements under paragraphs 5.2 and 5.3 of the Rules. The Provider responded on 3 March 2011 with a specific list of deficiencies that needed to be corrected, with an extended deadline of 12 March 2011 for compliance. No corrected response or further correspondence from the Registrant was received.

7. On 21 March 2011, the Provider therefore moved to have the Complaint treated as uncontested, and appointed a panelist.

D. Panel Member Impartiality and Independence Statement

8. As required by paragraph 7.1 of the Rules, the panelist has declared to the Provider 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.

E. Canadian Presence Requirement

9. Zuffa's trademark ULTIMATE FIGHTING CHAMPIONSHIP is registered in Canada and thus satisfies the Canadian Presence Requirement. Zuffa also holds two other similar registered design marks in Canada, each incorporating the registered mark: THE ULTIMATE FIGHTING CHAMPIONSHIP and ULTIMATE FIGHTING CHAMPIONSHIP UFC.

F. Factual Background

10. Zuffa's trademark ULTIMATE FIGHTING CHAMPIONSHIP was registered in Canada in 2005. Zuffa has also used the mark as an unregistered mark in Canada, prior to registration, in association with its services as early as 1993.

11. Zuffa has other related design marks registered in Canada in 2005, and these were also used prior to registration of the design marks.

12. Zuffa has used the marks extensively throughout Canada and the world, producing and promoting mixed martial arts events in a variety of media. These events are highly popular, and the popularity of the sport is increasing rapidly. The Complainant also has extensive licensing agreements for a wide variety of products bearing the UFC marks and brand. It also maintains a website, UFC.COM, which uses the registered marks, and provides information and services to, *inter alia*, Canadian users of the site.

13. The Registrant registered the domain name on February 25, 2008. The site resolves to an "under construction" message. It does not appear that content has ever been added to the website.

14. The Representative of the Complainants asked the Registrant, in an email on 27 October 2011, to inquire about a transfer of the domain name to the trademark holder.

15. The Registrant responded in an email that he was aware that the Representative was referring to Zuffa, and that the name Zuffa was well known and associated with the ultimatefightingchampionships. He responded that he had purchased the domain name because of its potential revenue and its potentially high visitation rate whether using the name itself or search engines to arrive there.

16. On 9 December 2010, the Representative of the Complainant offered \$2500 for the domain name, along with a set of tickets for an event in Canada.

17. On 26 January 2011, the Registrant responded that he had registered the domain name in order to make a profit, and was awaiting a “market report” on Zuffa’s site and on the popularity of the domain name. He indicated that his maintenance costs were \$2600 thus far, and that “I just can’t see myself selling this site for little or no profit”. He also noted that he had registered seven other domain names that used the Zuffa trademarks:

ULTIMATEFIGHTINGCHAMPIONSHIP.US
ULTIMATEFIGHTINGCHAMPIONSHIPS.ORG
ULTIMATEFIGHTINGCHAMPIONSHIPS.INFO
ULTIMATEFIGHTINGCHAMPIONSHIPS.BIZ
ULTIMATEFIGHTINGCHAMPIONSHIPS.US
ULTIMATEFIGHTINGCHAMPIONSHIP.INFO
ULTIMATEFIGHTINGCHAMPIONSHIP.BIZ

Finally, the Registrant invited a “bulk offer” for all the names.

18. The Complainant filed this Complaint on 3 February 2011.

G. CIRA Domain Name Dispute Resolution Policy Requirements

19. The *CIRA Domain Name Dispute Resolution Policy* [“Policy”] sets out at paragraph 4.1 what the Complainant must establish in order to successfully prove the complaint:

To succeed in the Proceeding, the 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 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 3.7;
- and the Complainant must provide some evidence that:

(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6.

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 . . .

The Panel will deal with each of these criteria in turn.

H. Is the Registrant’s Domain Name Confusingly Similar to the Complainant’s Mark?

20. Paragraph 3.2 of the Policy includes the following in the definition of what constitutes a “mark” for the purposes of the Policy:

A “Mark” is:

- (a) a trade-mark . . . or a trade name that has been used in Canada . . . for the purpose of distinguishing the wares, services or business of that person . . . from the wares, services or business of another person; [and]
- (c) a trade-mark . . . that is registered in CIPO . . .

21. The Complainant must establish trademark rights that precede the domain name registration date. This the Complainant has done by showing that both the unregistered common law mark and the registered trademark preceded the Registrant’s registration of the domain name. The mark is well-known in Canada.

22. Paragraph 3.4 of the Policy defines “confusingly similar” in the following terms:

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 to be mistaken for the Mark.

23. The domain name at issue is confusingly similar with the Complainant’s trademark. Except for the addition of an “s” and the lack of spacing among the component words, the distinctive elements of the domain name and the trademark are identical. It is well established that neither pluralization [*Enterprise Rent-A-Car Co. v. Canadian Domain Name Services Inc.*, CIRA Decision 97 (2008) (*enterprisecarrentals.ca*)] nor a change in spacing [*Canada Safety Council v. 3032102 Nova Scotia Ltd.*, CIRA Decision 139 (2009) (*nationalsafetycouncils.ca*)] is a significant difference mitigating against a finding of confusing similarity.

24. Thus, the Panel finds that the Registrant’s domain name **ULTIMATEFIGHTINGCHAMPIONSHIPS.CA** is confusingly similar with the Complainant’s registered mark in which the Complainant had rights prior given the longstanding registration of the essentially identical trademark.

I. Was the Registration of the Domain Name Made in Bad Faith?

25. In order to succeed in the second stage of the test, the Complainant must show, on the balance of probabilities, that the Registrant registered the domain name in bad faith. Paragraph 3.7 of the Policy states that the Registrant will be considered to have registered the domain name in bad faith, if and only if one of the following three conditions is met:

- (a) the Registrant registered the domain name . . . primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant [or others related to or competing with the Complainant] for valuable consideration in excess of the Registrant's actual costs in registering the domain name . . . ;
- (b) the Registrant registered the domain name . . . in order to prevent the Complainant [or others related to the Complainant] 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; or
- (c) the Registrant registered the domain name . . . primarily for the purpose of disrupting the business of the Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant.

26. As the Complainant has shown, and as the Registrant has admitted via email, the Registrant did hope to profit from the registration. While it is unclear from the email exchange whether the Registrant's profit plan was to be achieved *primarily* from the proceeds of transfer of the name or by some other means, it is clear that the Registrant was well aware by his own admission of the popularity of UFC brand and trademarks, and of their link to the trademark owner, Zuffa. The Registrant's emails do indicate that he felt the site could be worth a great deal of money, and he clearly wanted a better offer from the Complainant than the offer that was made. (I note that the Registrant offered no breakdown as to what the \$2600 in sunk costs allegedly comprised; as a figure it is unconvincing on its own, and seems merely pulled out of a hat and tailored to up the offer.) Perhaps most importantly, it is clear that the Registrant did not use the domain name for any other purpose, posting no content on the site during the three years in which he has held the registration. On balance, then, it appears that the Complainant did register the name primarily for the purpose of transferring the name to Zuffa in excess of actual costs. While the Registrant did not actively seek out the Complainant, that is not always determinative.

27. In any event, the Registrant did also register seven other closely related domain names under other domain name regimes: .us, .biz, .info. Moreover, the Complainant has also shown that the Registrant has a number of current domain name registrations, some of which clearly incorporate known websites, trade names or trademarks (for example, canadianboxingfederation.ca and pathwaysystems.ca). This is sufficient to conclude that

the Registrant “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”, and has thus registered the domain name in question in bad faith as defined in the Policy.

28. Therefore this Panel concludes that the Registrant acquired the domain name ULTIMATEFIGHTINGCHAMPIONSHIPS.CA in bad faith under paragraphs 3.7(a) and 3.7(b) of the Policy.

J. Does the Registrant Have a “Legitimate Interest” In the Domain Name?

29. The final element of the test set out in the Policy is to determine whether or not the Registrant has a legitimate interest in the domain name. This inquiry tries to find some more or less objective or ascertainable link between the Registrant and the domain name in question, aside from mere registration, and which is legitimate. Paragraph 3.6 of the Policy states:

The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint was submitted

- (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 used the domain name in Canada in good faith in association with any 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 used 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.

30. It bears repeating that this definition is restrictive – only the interests listed in subparagraphs (a) to (f) below can be considered legitimate interests. In terms of procedure the Complainant must provide some evidence that none of these interests applies to the Registrant. The burden would then shift to the Registrant to show that it

has, on the balance of probabilities, any one of these legitimate interests as defined under these subparagraphs.

31. The Complainant has introduced sufficient evidence of the Registrant having no legitimate interest under any of the above heads. The Registrant admitted that he was aware of Zuffa and the UFC. On the evidence submitted, the Registrant does not appear to have ever used the domain name in conjunction with any active website. Finally, the Complainant points out that the Registrant does not fall into, or otherwise use the domain name in a matter comprising, any of the six categories listed above.

32. The Complainant having thus satisfied its initial burden of showing “some evidence” of “no legitimate interest” puts the onus on the Registrant to show a legitimate interest.

33. The Registrant has not responded, and thus fails to meet its burden of showing a legitimate interest in the domain name.

34. The Panel therefore concludes that the Registrant did not have a legitimate interest in the domain name ULTIMATEFIGHTINGCHAMPIONSHIPS.CA under paragraph 3.6 of the Policy.

K. Conclusion and Decision

35. The Complainant has established that the Registrant’s domain name ULTIMATEFIGHTINGCHAMPIONSHIPS.CA is confusingly similar to the Complainant’s registered Canadian mark.

36. The Complainant has established that the Registrant had registered the domain name ULTIMATEFIGHTINGCHAMPIONSHIPS.CA in bad faith, as defined in the Policy.

37. The Complainant has provided some evidence that the Registrant has no legitimate interest, as defined in the Policy, in the domain name ULTIMATEFIGHTINGCHAMPIONSHIPS.CA. The Registrant has not established, as set out in the Policy, that it does have a legitimate interest.

38. For these reasons, the Complaint regarding the domain name ULTIMATEFIGHTINGCHAMPIONSHIPS.CA is successful.

L. Remedy

39. The Complainant has asked that the domain name at issue be transferred to it. The Panel hereby so orders.

A handwritten signature in blue ink, reading "David Lametti", with a long horizontal flourish extending to the right.

David Lametti
Sole Panelist

April 5, 2011