

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

**DECISION**

Domain Name: lemetropolitain.ca

Complainant: Altomedia Inc.

Authorized representative of the Complainant: Bruno P. Soucy, Blaney McMurtry LLP.

Registrant: L'Express de Toronto Inc (sic)

Registrar: eNom Canada Corp.

Service Provider: Resolution Canada

Panelist: Daria Strachan

**A. THE PARTIES**

1. The Complainant, Altomedia Inc. (the "Complainant"), is a corporation located in city of Brampton, ON.
2. The Registrant for the domain name is L'Express de Toronto Inc. (incorrectly referenced as L'Express de Toronto Inc, and hereinafter referred to as the "Registrant"), located in the city of Toronto, ON.

**B. DISPUTED DOMAIN NAME AND REGISTRAR**

3. The disputed domain name is lemetropolitain.ca (the "Domain Name").
4. The Registrar for this domain name is eNom Canada Corp. (the "Registrar").
5. The disputed domain name was registered on October 25, 2017.

**C. PROCEDURAL HISTORY**

6. This is a proceeding under the Canadian Internet Registration Authority ("CIRA") *Domain Name Dispute Resolution Policy Version 1.3* (the "Policy") and the CIRA *Domain Name Dispute Resolution Rules Version 1.5* (the "Rules"). By registration of the Domain Name

with the Registrar, the Registrant agreed to the resolution of this dispute pursuant to the Policy and the Rules.

7. The Complainant filed its Complaint on February 2, 2018 (the "Complaint"). The date of commencement of the proceeding was February 7, 2018.
8. The provider, Resolution Canada, served notice of the Complaint on the Registrant as required pursuant to Paragraph 4.3 of the Rules. Service of the Complaint was made by e-mail on February 7, 2018.
9. The Registrant did not file a response. However, on February 27, 2018, counsel for the Registrant, Sana Ebrahimi, advised Resolution Canada that the Registrant was "willing to voluntarily release the domain name".
10. As the Complainant has nevertheless requested that a decision be rendered, on March 7, 2018, the Panel was appointed. As prescribed by Paragraph 7 of the Rules, the Panel has declared to Resolution Canada that it can act impartially and independently in connection with this matter, and that there are no circumstances known to the Panel that would prevent it from so acting.

**D. CANADIAN PRESENCE REQUIREMENTS: ELIGIBILITY OF THE COMPLAINANT**

11. The Complainant is a corporation incorporated under the laws of the province of Ontario, with its main business office located in the city of Brampton, Ontario. As such, the Complainant meets the Canadian presence requirements in accordance with Paragraph 2 (d) of the CIRA *Canadian Presence Requirements for Registrants*.

**E. THE POSITION OF THE COMPLAINANT**

12. The Complainant is the publisher of French language publications, both in print format as well as published online through the Complainant's various websites. One of the Complainant's publications is a French language weekly newspaper, *Le Métropolitain* (the "Complainant Newspaper"), which targets the French speaking population within the Greater Toronto Area (GTA). First published in 1993, the Complainant Newspaper has a weekly readership of approximately 10,000.
13. The online version of the Complainant Newspaper is located at [www.lemetropolitain.com](http://www.lemetropolitain.com) (the "Complainant Website") and has average weekly traffic of approximately 1,460 visits.
14. Access to the Complainant Newspaper and the Complainant Website is free of charge. All revenue is derived from third party advertisers that purchase advertisement space in the Complainant Newspaper and the Complainant Website, including through the use of banner ads on the Complainant Website.

15. In addition, the Complainant registered "LE METROPOLITAIN" as a trade name on May 6, 2013.
16. Both the Complainant and the Registrant are Toronto-based weekly newspapers that concentrate on local and regional news for a French readership within the GTA. The Registrant publishes a weekly French language newspaper called *L'Express* (the "Registrant Newspaper"). The online version of the Registrant Newspaper is published on a website located at [www.l-express.ca](http://www.l-express.ca) (the "Registrant Website"). The Registrant generates revenue in the same manner as the Complainant. They are each other's main competitor.
17. The Complainant submits that it has a conservatively estimated operating budget of \$750,000.00 for the 2018 calendar year.
18. On January 24, 2018, the Complainant first learned that the Registrant had registered the Domain Name. Upon further investigation, the Complainant discovered that the Domain Name was configured to redirect users to the Registrant Website, a commercial website that directly competes with the Complainant Website.
19. The Complainant alleges that the Registrant's conduct is harmful in that it negatively affects the Complainant's ability to secure advertisers for the Complainant Website, reducing the amount of revenue the Complainant is able to generate from advisers.
20. The Complainant alleges that by redirecting website traffic, it reduces traffic to the Complainant Website and facilitates use of the pay-per-click advertisements located on the Respondent Website.
21. In addition, the Complainant alleges that there is a real possibility of confusion for those seeking to access the Complainant Website and being redirected to the Respondent Website. The Complainant further states that the Registrant has appropriated the Complainant's entire Mark into the Domain Name.
22. The Complainant alleges that the Respondent registered the Domain Name in bad faith in the hopes of interfering with the Complainant's business operations, deriving benefits from the Complainant's goodwill that it has acquired over the past twenty-five (25) years.
23. Lastly, the Complainant alleges that the Respondent has no legitimate interest in the Domain Name as none of the circumstances set out in paragraph 3.4 of the Policy exist in this instance. The Complainant points out that the Respondent never created a separate website associated with the Domain Name, only using the Domain Name to redirect users to the Registrant Website.

24. The Complainant requests that the Domain Name be transferred from the Registrant to the Complainant.

**F. DISCUSSION AND REASONS**

25. In accordance with Paragraph 4.1 of the Policy, to succeed in this 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;
- b) The Registrant has registered the domain name in bad faith as described in Paragraph 3.5 of the Policy;

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 of the Policy.

***Confusingly Similar***

26. In order to satisfy this branch of the test the Complainant has to show that it has rights in a Mark that pre-date the registration date of the Domain Name and that the Domain Name is confusingly similar with the disputed Mark.

27. Pursuant to Paragraph 3.2(a) of the Policy, a "Mark" is defined as:

- (a) a trade-mark, including the word elements of a design mark, or a trade name 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;

28. The Complainant has provided evidence that they had acquired common law rights in the Mark in Canada approximately twenty-five years in advance of the date of registration of the Domain Name being registered by the Registrant on October 25, 2017. The Complainant has been using Marks LEMETROPOLITAIN and LE METROPOLITAIN with respect to the Complainant Newspaper since 1993, and with respect to the Complainant Website since 1998. In addition, the Complainant registered "Le Metropolitain" as a business trade name four (4) years prior to the Registrant's registration of the Domain Name.

29. On January 24, 2018, a user of the Complainant Website sent an email to the Complainant alerting them to the fact that that user had been attempting to access the Complainant Website, had typed lemetropolitain.ca (instead of lemetropolitain.com) and found themselves on the Respondent Website. The Panel found the Complainant's affidavit persuasive and helpful in this regard.
30. The test to determine whether a domain name is confusingly similar is that of "first impression and imperfect recollection"<sup>1</sup>. With the only difference between the Complainant's Mark and Domain Name being the use of the dot-ca suffix as opposed to the dot-com suffix, the Complainant Website located at lemetropolitain.com could readily be confused with the Domain Name registered by the Registrant, namely lemetropolitain.ca.
31. The Panel accepts the Complainant's position, finding that the Domain Name is likely to be mistaken for the Complainant's LEMETROPOLITAIN Mark. Therefore, the Complainant has established, on a balance of probabilities, the facts required to support the requirements of Paragraph 4.1 (a) of the Policy.

#### ***Bad Faith***

32. The Complainant must show, on the balance of probabilities, that the disputed Domain Name was registered in bad faith. Paragraph 3.5 of the Policy deals with the grounds that constitute bad faith. These grounds are not exhaustive; it is left open for the Panel to conclude that there are other grounds that lead to a finding of bad faith conduct.
33. The Complainant provided numerous examples alleging that the Registrant's conduct constituting bad faith in accordance with Paragraph 3.5 of the Policy. The Panel found no basis for alleging that the Respondent registered the Domain Name for the purpose of exerting pressure on the Complainant to purchase or procure the Domain Name from the Respondent (paragraph 3.5(a) of the Policy), nor was there any evidence provided to support an allegation that the Respondent had engaged in a pattern of registering domain names (paragraph 3.5(b) of the Policy).
34. That said, the Panel is satisfied that bad faith has been established in accordance with paragraphs 3.5 (c) and (d) of the Policy. Those paragraphs of the Policy state that a finding of bad faith registration of a domain name is evidenced where:
  - (c) the Registrant registered the domain name or acquired the Registration 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; or

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<sup>1</sup> *Papa John's International, Inc v. McGrath* 2015 CarswellNat 4562 at para. 35

- (d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other on-line 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 or location or of a product or service on the Registrant's website or location.
35. The Complainant highlights the fact that the Domain Name redirects potential readers to the Registrant Website, which contains pay-per-click advertisements. The Complainant alleges that potential readers are likely to be misdirected resulting in a disruption to the Complainant and its business.
36. It is clear to the Panel that the Registrant registered lemetropolitain.ca as a domain name with a view to attracting business from those who have come to recognize the Complainant's Mark, along with the purpose of disrupting the Complainant's business. As direct competitors of one another, there is little doubt that the Respondent was aware of the Complainant's Mark at the time it registered the Domain Name, which further supports a finding that the Registrant registered the Domain Name in bad faith.
37. As previously indicted, the Domain Name simply redirected readers to the Registrant Website. There is no evidence that the Registrant was seeking to create a website for the Domain Name in dispute. Rather, the evidence demonstrates the Registrant's intention to disrupt the Complainant's online business. This illustrates the bad faith conduct of the Respondent.
38. Further, the Panel notes that subsequent to the filing of this complaint the Respondent ceased using the Domain Name: web traffic is no longer being diverted to the Respondent Website through the use of lemetropolitain.ca.
39. The Panel recognizes that the volume of traffic to a website may impact the amount of advertising revenue available. Notice can be taken of this fact, without demonstrating that the Complainant has already suffered a financial loss in this regard. It is common knowledge that websites are able to generate revenue from the advertisements located on the website, including through the use of banner ads. By diverting traffic from the Complainant Website to the Respondent Website, there is a real possibility that the Respondent's conduct will negatively impact the Complainant's source of revenue generated through third party advertisements. These are commercial entities who are in direct competition with one another in a niche market.
40. It is not a stretch to find that if the readership of the Complainant Website declines, that advertisers may look to advertise elsewhere and / or reduce the amount of advertising funds they allocate to the Complainant. Further, that as the Complainant's main competition, the Registrant was seeking to benefit from having the Domain Name resolve

to the Registrant Website. As previously stated in *Victoria's Secret Stores Brand Management, Inc. v. Poustie*<sup>2</sup>:

Given that the Domain Name is identical to the Complainant's "Victoria's Secret" mark, that the domain name was registered many years after the Complainant's registration and that the domain name resolved for a period of time to a competitor's website, the Panel can infer, based on previous case law, that such actions were done for commercial gain, whether or not such gain was already realized.

41. It is the Panel's view that the Registrant intentionally attempted to attract, for commercial gain, Internet users to the Registrant Website, by diverting internet users from the Complainant Website and by creating a likelihood of confusion with the Complainant's Mark in accordance with Paragraph 3.5 of the Policy. The Registrant's registration of the Domain Name was done in bad faith.

***No Legitimate Interest***

42. Paragraph 3.4 provides six (6) possible ways in which a Registrant may have a legitimate interest in a domain name, which the Complainant outlined in its submissions.
43. The Complainant has adduced evidence that the Domain Name redirects users to the Respondent Website, a direct competitor of the Complainant in a niche market. The Panel does not believe that such use shows that the Domain Name was used in good faith by the Registrant or that the Registrant had rights in the Mark. Therefore Paragraph 3.4 (a) of the Policy is not satisfied. Moreover, the Panel similarly does not believe that the disputed Domain Name was registered in good faith in association with any wares, services or business, so the Registrant's use cannot fall under Paragraphs 3.4 (b) or (c) of the Policy. The Registrant was not using the disputed Domain Name in good faith in association with criticism, review or new reporting, as set out at Paragraph 3.4 (d) of the Policy. The disputed Domain Name is not the legal name or a name, surname or other reference by which the Registrant was commonly identified as required pursuant to Paragraph 3.4 (e) of the Policy. Lastly, the domain name is not the geographical name of the location of the Registrant's place of business, as required under Paragraph 3.4 (f) of the Policy. As a result, none of the criteria set out under Paragraph 3.4 has been satisfied.
44. The Panel is satisfied that the Complainant has provided sufficient evidence that the Registrant had no legitimate interest in the Domain Name. The Complainant has therefore satisfied its burden under the Policy.

**G. CONCLUSION AND DECISION**

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<sup>2</sup> 2014 CarswellNat 2565 at para. 46.

45. For the reasons set out above, the Panel finds that the Complainant does have rights in the lemetropolitan Mark, which pre-date the registration of the disputed Domain Name. It also finds that the Domain Name is confusingly similar to the Complainant's Mark and that the Registrant had no legitimate interest in the Domain Name. The Panel further finds that the Complainant has shown that the Registrant registered the Domain Name in bad faith pursuant to Paragraphs 3.5 (c) and (d) of the Policy.
46. The Panel therefore orders, pursuant to Paragraph 4.3 of the Policy, that the registration of the domain name lemetropolitan.ca be transferred to the Complainant.

Dated: March 23, 2018.

A handwritten signature in cursive script that reads "Daria Strachan". The signature is written in black ink and is positioned above a horizontal line.

Daria Strachan, Sole Panelist