

**IN THE MATTER OF A COMPLAINT PURSUANT TO THE CANADIAN INTERNET
REGISTRATION AUTHORITY (“CIRA”) DOMAIN NAME DISPUTE RESOLUTION
POLICY (“POLICY”)**

Complainant: Alberta Treasury Branches, Edmonton, Alberta

Complainant’s Counsel: Tom Sides
Fraser Milner Casgrain LLP
Edmonton, Alberta

Registrant: Jim Yoon, New York, NY

Disputed Domain: Internic.ca

Panel: Denis Magnusson, sole member

Service Provider: Resolution Canada

DECISION

Parties

The Complainant is Alberta Treasury Branches of Edmonton Alberta. The Registrant is Jim Yoon of New York, N.Y.

Disputed Domain Name and Registrar

The disputed domain name is **atbfinancial.ca** which was registered on February 16, 2005. The Registrar is Internic.ca

Procedural History

The Complainant filed the Complaint with the Provider, Resolution Canada which found the Complaint in compliance with the CIRA *Domain Name Dispute Resolution Rules* (“Rules”) and transmitted it to the Registrant. The Registrant has not filed a Response.

No Response having been submitted, the Complainant opted to have the matter decided by a single member panel, CIRA Rules, para. 6.5. The Provider appointed the undersigned Denis N. Magnusson as the sole member of the Panel to decide this matter.

As the Registrant has not filed a Response, the Panel is required to decide the matter “on the basis of the Complaint”, CIRA Rules, para. 5.8.

Relief Requested

The Complainant requested that the Panel order that the domain name registration be transferred from the Registrant to the Complainant.

Background Facts

Alberta Treasury Branches (“ATB”) was established in 1938 by the government of Alberta to provide financial services in Alberta. Since 1997 it has been a provincial crown corporation under provincial legislation, the *Alberta Treasury Branches Act*. ATB has assets of \$16.1 billion and is the largest Alberta-based financial institution.

In January, 2002 ATB created a new corporate subsidiary named ATB Financial. On January 16, 2001 ATB filed an application with the Canadian Intellectual Property Office (“CIPO”) to

register “ATB Financial” as a trademark for various financial services. That trademark was accepted for registration on October 25, 2002.

The Registrant is Jim Yoon of New York, NY. The domain name atbfinancial.ca was first registered on February 16, 2005. Using a web browser to locate atbfinancial.ca resolves to a page headed “Best Financial” at the top right of the page. Headings immediately below across the page read “financial, mortgage, mortgages, personal loans, car loans, loan, loans, credit card”. A list of links on the left hand side of the page under the subtitle “Site Menu” includes such links as “creditcard”, “easy loans”, “money loans”, etc. Clicking on the first such link “creditcard”, for example, resolves to a page on which under the heading “sponsored links” features a series of links, of which “Orchard Bank Mastercard,apply online now” with a link to orchardbank.com is a typical example.

Eligible Complainant

The Complaint reveals more than one basis under which the Complainant would qualify as an eligible Complainant under the Policy. For example, an eligible Complainant includes any person who is the owner of a trademark registered in the CIPO, to which trademark the dispute relates, Policy, para. 1.4. The Complaint noted three such trademark registrations of which the Complainant was the owner, each of which comprises the words “ATB Financial”, with and without design material. In particular, TMA569606 consists of the words “ATB Financial” alone, registered for services including “credit services”. As the registered domain name in dispute is **atbfinancial.ca**, this registered trademark clearly “relates to” the dispute over this domain name registration under the Policy.

Onus on Complainant

Policy para. 4.1 requires that:

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. [emphases added]

(a) Confusingly Similar

Marks in Which Complainant Had and Has Rights

Policy, para. 3.2 states a “Mark” includes a trademark registered in the CIPO. The Complaint listed the following three trademark registrations related to the Complaint, owned by the Complainant as a result of the assignment effective January 1, 2005:

<u>Mark</u>	<u>CIPO Reg. No.</u>	<u>Date Registered</u>
ATB Financial	TMA569606	25 October, 2002
ATB Financial (design colour)	TMA579217	08 April, 2003
ATB Financial (design)	TMA572269	13 December, 2002

The Complaint offers ample evidence that the Complainant has extensively used and continues to use these marks in Canada. All of the above registered trademarks are “Marks” in which the Complainant had Rights *prior to* the date of registration of the disputed domain name on February 16, 2005 and in which the Complainant continues to have Rights.

Confusingly Similar

Policy, para. 3.4 defines “Confusingly Similar”:

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.

In assessing similarity, the “dot-ca” suffix of the domain name is ignored, *Policy* para. 1.2. Thus, the first of the above-noted registered trademarks, consisting of “ATB Financial”, differs from the registered domain name “atbfinancial.ca” only in the capitalization of “ATB” and the “F” of Financial and the placing of a space between “ATB” and “Financial”. The Complaint noted:

“ . . . the differences in capitalization of certain letters between the Mark and the Domain Name are minor and irrelevant given the fact that the Internet protocol addresses do not require or recognize capitalized letters in URLs. Similarly, the presence of a space in the Complainant’s Mark and its absence in the Domain Name is not material to the comparison.

Prior decisions in CIRA proceedings have held that differences in syntax and punctuation are not relevant in the determination of whether a domain name is confusingly similar to the mark in question.”

The panel agrees with these submissions. The domain name atbfinancial.ca greatly resembles the Complainant’s Mark in the form of the registered trademark “ATB Financial”. The Panel finds that the resemblance is so near that the domain name is likely to be mistaken for the Mark, and so the domain name is Confusingly Similar to the Complainant’s Mark.

b) Bad Faith

The CIRA *Policy*, para. 3.7 has a very restrictive definition of what can constitute the Registrant’s necessary Bad Faith in registering the domain name. That definition states that there will be Bad Faith, “*if, and only if*” one or more of three specific circumstances obtain. The Complainant submitted argument with respect to the definition of bad faith in subparas. 3.7(b) and (c).

3.7(b) Registrant’s Purpose of Preventing Complainant Registering Mark as Domain Name

Policy, para. 3.7(b) defines this instance of bad faith:

(b) the Registrant registered the domain name . . . in order to prevent the Complainant . . . from registering the Mark as a domain name, provided that the Registrant . . . has engaged in a pattern [of such activity];

Since domain name registrations cannot recognize the capitalization and spacing of a trademark or trade name, the Panel concludes that the registration of the Domain Name at issue, atbfinancial.ca prevents the Complainant from registering its prior trademark ATB Financial as a domain name.

With respect to establishing the Registrant's pattern of registering domain names for the purpose of preventing the owners of Marks from registering their Marks as domain names the Complaint submitted a list of dot-ca domain names registered by the Registrant:

<u>Domain Name</u>	<u>Apparent Trademark or Trade name</u>
atbfinancial.ca	ATB Financial
empiretheaters.ca	Empire Theatres
encandirect.ca	Encan Direct
pepsico.ca	Pepsico Inc.
royalepage.ca	Royal Lepage

The Panel concludes that this is sufficient evidence of a "pattern" of registering domain names for the purpose of preventing the owners of Marks from registering those Marks as domain names. Thus, the Panel finds that the Complaint has established the Registrant's Bad Faith under Policy para. 3.7(b)

3.7(c) Registrant's Purpose of Disrupting the Business of a Competitor

Policy, para. 3.7(c) sets out this circumstance of bad faith:

(c) the Registrant registered the domain name . . . primarily for the purpose of disrupting the business of the Complainant . . . who is a *competitor* of the Registrant.

The Complaint made a submission that the Registrant could also be found to have registered the domain name in Bad Faith under para. 3.7(c). The Complaint referred to the decision in *Life Assurance Company of Canada v. Hank Morin*¹ as providing a basis upon which Bad Faith could be found in this Complaint under para. 3.7(c). The Panel agrees with that submission, and would find Bad Faith on that basis as well in this case. Having found Bad Faith under para. 3.7(b) above, the Panel does not find it necessary to detail the finding of Bad Faith under para. 3.7(c).

c) Legitimate Interest

The Complainant has the burden of providing some evidence that "the Registrant has no legitimate interest in the domain name as described in paragraph 3.6". Paragraph 3.6 stipulates that the Registrant has a Legitimate Interest in a domain name "if, and only if" the Registrant has one or more of the six specific interests set out in subparas 3.6(a) to (f). The domain name is not a Mark in which the Registrant had rights in the light of the Complainant's prior registration of three trademarks which cover the domain name (para. 3.6(a)); the domain name is not clearly descriptive of any wares or services of the Registrant (para. 3.6(b)); the domain name is not the generic name of any wares or services of the Registrant (para. 3.6(c)); the domain name is not used by the Registrant in association with a non-commercial activity (para. 3.6(d)); the domain name is not a name of the Registrant (para. 3.6(e)); and the domain name is not the geographical name of the Registrant's business.

Thus, the Complainant has provided sufficient evidence that the Registrant has no legitimate interest in the domain name.

¹ CIRA Dispute 00046, November 16, 2005.

Conclusion

The Complainant has satisfied the burden of proof in establishing Confusing Similarity, Bad Faith, and no Legitimate Interest necessary to succeed in the Complaint.

Order

For the reasons set out above, the Panel grants the relief requested by the Complainant, and orders that the registration of the domain name be transferred to the Complainant.

Date: February 13, 2006

Signed

Denis N. Magnusson, Sole Panel Member