

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number: DCA-1056-CIRA
Domain Name: utemp.ca
Complainant: The Governing Council of the University of Toronto
Registrant: Temporary Source Inc.
Registrar: Webnames.ca (UBC Research Enterprises Inc.)
Panel: Stefan Martin
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

PREAMBLE

1. The Canadian Internet Registration Authority (“CIRA”) is responsible for operating the dot-ca Internet country code Top Level Domain (“ccTLD”).
2. This is an administrative proceeding pursuant to the CIRA Domain Name Dispute Resolution Policy, adopted by CIRA and in effect as of December 4, 2003 (the “Policy”) and the CIRA Domain Name Dispute Resolution Rules, version 1.2 (the “Rules”).
3. Paragraph 3.1 of the Policy requires that the Registrant submit to this dispute resolution proceeding.
4. The British Columbia International Commercial Arbitration Centre (“BCICAC”) is a recognized service provider pursuant to the Policy.

THE PARTIES

5. The Complainant is The Governing Council of the University of Toronto, located at 255 Huron Street, Room 350, Toronto, Ontario, M5S 3J1.
6. The Registrant is Temporary Source Inc., located at 360 Bloor Street, Suite 205, Toronto, Ontario, M5S 1X1.

THE DOMAIN NAME AND REGISTRAR

7. The Domain Name that is the subject of this proceeding is “utemp.ca”.
8. The Registrar of the Domain Name is Webnames.ca (UBC Research Enterprises Inc.)
9. The Domain Name was registered by the Registrant on September 14, 2006.

PROCEDURAL HISTORY

10. According to the information provided by BCICAC, the dispute resolution service provider, the history of this proceeding is as follows:
 - (a) On January 28, 2008, the Complainant filed a complaint regarding the Domain Name with BCICAC.
 - (b) On January 29, 2008, after having determined that the complaint was in administrative compliance with the requirements of the Policy and the Rules, the BCICAC commenced the dispute resolution process and served notice of the complaint to the Registrant.
 - (c) On February 27, 2008, the Registrant requested and the BCICAC granted an extension for the delivery of its Response to March 12, 2008.
 - (d) The Registrant failed to provide a timely response to the complaint as set out in Paragraph 5 of the Rules.
 - (e) The Complainant has decided to proceed with the arbitration.
 - (f) The complaint was filed in English, which is the language of this proceeding in accordance with Paragraph 10.1. of the Rules.
 - (g) In the absence of a response, the Complainant has elected, under Paragraph 6.5 of the Rules, to convert from a panel of three arbitrators to a single Panel.
 - (h) Mtre Stefan Martin has been appointed as sole panellist and has delivered to the BCICAC the required Statement of Impartiality and Independence, as required by Paragraph 7 of the Rules.
 - (i) Absent exceptional circumstances, the Panel was required to deliver its decision by April 7, 2008.

11. The Panel finds that it was properly appointed in accordance with the Policy and the Rules.
12. Based upon the information provided by the BCICAC, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding were met.
13. The Complainant was represented by legal counsel throughout this proceeding. The Respondent was not represented by legal counsel.

FACTUAL BACKGROUND

14. The Panel proceeds on the basis of the following facts, which are established by the evidence submitted by the Complainant:
 - (a) The Complainant is The Governing Council of the University of Toronto, located at 255 Huron Street, Room 350, Toronto, Ontario, M5S 3J1.
 - (b) The Registrant is Temporary Source Inc., located at 360 Bloor Street, Suite 205, Toronto, Ontario, M5S 1X1.
 - (c) On September 14, 2006, the Registrant registered the domain name "utemp.ca".
15. The Complainant contends as follows:
 - (a) the Domain Name is confusingly similar to the mark "UTemp" 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 no legitimate interest in the Domain Name because:
 - (i) the Registrant has not used the Domain Name in good faith and has no rights in the Complainant's trade-mark "UTemp";and because there is no evidence that the Domain Name is:
 - (ii) clearly descriptive;
 - (iii) a generic name;
 - (iv) being used in association with a non-commercial activity;
 - (v) comprised of the legal name of the Registrant or is a name, surname or other reference by which the Registrant is commonly identified;

- (vi) the geographical name of the location of the Registrant's non-commercial activity or place of business.
 - (c) The Registrant registered and is using the Domain Name in bad faith because:
 - i) the Registrant registered the Domain Name primarily for the purpose of disrupting the business of the Complainant, who is a competitor of the Registrant.
16. The Registrant, as previously mentioned, did not respond to the complaint.

DISCUSSION AND FINDINGS

JURISDICTION OVER THE PARTIES

17. The Complainant, The Governing Council of the University of Toronto, is an educational institution which is located in Canada and which is authorized as a university under an Act of the legislature of Ontario. It therefore satisfies the CIRA Canadian Presence Requirement for Registrants, as stipulated in paragraph 1.4 of the Policy.

EFFECT OF FAILURE OF REGISTRANT TO FILE A RESPONSE

18. Section 5.8 of the Rules provides that:

“If a Registrant does not submit a Response within the period for submission of a Response or any period extended pursuant to paragraph 5.4 or 5.6, the Panel shall decide the Proceeding on the basis of the Complaint [...].”

19. However, as stated in *Browne & Co. Ltd. v. Bluebird Industries* (CIRA Decision N° 00002):

“This requirement does not preclude the Panel from assessing the integrity and credibility of the evidence as disclosed in the Complaint.”

20. In the present case, the Panel does not see any reason to question the integrity and credibility of Complainant's evidence.

APPLICABLE LAW

21. Pursuant to Section 12.1 of the Rules, the Panel shall apply “the laws of Ontario, or, if the Registrant is domiciled in Quebec, the laws of Quebec, or, if a preference for the laws of another province or territory has been indicated by both parties, the laws of the other province or territory and, in any event, the laws of Canada applicable therein”.
22. The Registrant is domiciled in Ontario. The Complainant, which is also located in Ontario, has not stated a preference for any applicable law and therefore the Panel will render its decision in accordance with the Policy, the Rules and any rules and principles of law applicable in the Province of Ontario and the laws of Canada applicable therein.

OVERVIEW OF THE POLICY

23. Paragraph 4.1 of the Policy sets forth the Complainant’s burden of proof in order to succeed in the proceeding. The onus is on the Complainant to 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.

The Complainant must also provide some evidence that:

- (c) the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.6.

CONFUSING SIMILARITY BETWEEN DOMAIN NAME AND COMPLAINANT’S MARKS

24. The Complainant submits that the Domain Name is confusingly similar to the mark “UTemp” in which the Complainant had rights prior to the date of registration of the Domain Name, that is September 14, 2006, and in which the Complainant continues to have such rights.

Confusingly Similar

25. Paragraph 3.4 of the Policy defines the term “confusingly similar” as follows:

“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.”

26. As such, the Complainant is not required to demonstrate that there exists a likelihood of confusion as to the source of any products or services at issue.
27. Moreover, in applying this definition, it is important to note paragraph 1.2 of the Policy which stipulates that:

“[...] For the purposes of this Policy, “**domain name**” means the domain name excluding the “dot-ca” suffix and the suffixes associated with all third and fourth level domain names accepted for registration by CIRA.”

28. The test to be applied is one of first impression and imperfect recollection (*Government of Canada v. Bedford*, May 27, 2003, p. 15) :

“Accordingly, for each Domain Name the Complainant must prove on a balance of probabilities that a person, on a first impression, knowing the Complainant’s corresponding mark only and having an imperfect recollection of it, would likely mistake the Domain Name (without the .ca suffix) for Complainant’s corresponding mark based upon the appearance, sound or the ideas suggested by the Mark.”

29. In light of the above, the Panel is of the view that the Complainant’s mark “UTemp” is identical to the Domain Name and therefore “confusingly similar” thereto.

Rights in the mark

30. In order to determine whether or not the Complainant had “rights” in its mark “UTemp” prior to the registration of the Domain Name and continues to have such “rights” therein, it is important to note that the Complainant’s mark is not registered but only allegedly used.
31. As emphasized in *Trailwest Online Inc. v. Tallwest Systems Inc.*, DCA 968-CIRA, the Policy applies to both registered and unregistered marks. However, when an unregistered mark serves as a basis for a complaint, subparagraph 3.3(a) of the Policy stipulates that a person has “rights” in such a mark if it has *been used in Canada by that person, that person’s predecessor in title or a licensor of that person or predecessor*. Therefore, although the Complainant is not required to

demonstrate that its mark has acquired distinctiveness, it is nevertheless required to prove that it has been used.

32. As for whether or not the Complainant has “used” its mark “UTemp” within the meaning of the Policy, it must be noted that, in the complaint, it is alleged that the mark has been used in association with staffing services. In this regard, subsection 3.5(b) of the Policy stipulates that a mark is deemed to be used in association with services *if the mark is used or displayed in the performance or advertising of those services*.
33. Therefore, in order for the Complainant to prove that it had “rights” in its mark “UTemp” prior to the registration of the Domain Name and that it continues to have such “rights” therein, it must demonstrate on a balance of probabilities that its mark “UTemp” was continuously used or displayed in the performance or advertising of staffing services before and after the registration of the Domain Name, that is September 14, 2006.
34. As for what amount of evidence is sufficient, the Panel agrees with the decision *Credit Counseling Society of British Columbia v. Solutions Credit Counseling Services Inc.*, DCA-829-CIRA, that mere assertions of use are insufficient to establish use on a balance of probabilities. However, it should be added that a domain name arbitration proceeding is a summary proceeding which must remain as such. Therefore, a Complainant should not be put to the expense and trouble of showing use of a mark by evidentiary overkill when it can be proven in a simple, straightforward fashion.
35. For example, in the above-cited decision *Credit Counseling Society of British Columbia v. Solutions Credit Counseling Services Inc.*, it was decided that evidence of advertising of the complainant’s mark, in association with the services which it covered, on the Internet, in the Telus pages and in the Superpages directories was sufficient.
36. Moreover, in the decision *Trailwest Online Inc. v. Tallwest Systems Inc.*, DCA 968-CIRA, examples of use of the complainant’s mark in advertising and in promotion for the services it provided were also considered sufficient.
37. In the case at hand, the Complainant has provided examples of use of its mark “UTemp” on its Internet site, directory, business cards, brochure, letterhead, job order form, placement confirmation form, employee evaluation form, policies and procedures document, agreement to confidentiality, timesheet and fax coversheet.
38. The Complainant has alleged in its complaint that it has continuously used its mark “UTemp” prior to the registration of the Domain Name and thereafter, and it has provided evidence of such use.

39. As for the Registrant, it never filed any response and the Panel must therefore rely on the content of the complaint.
40. In light of the above, the Panel is of the view that the Domain Name is identical, and therefore confusingly similar, to the mark "UTemp" in which the Complainant had rights prior to the date of registration of the Domain Name and in which the Complainant continues to have such rights.
41. The Complainant has met its first burden of proof.

NO LEGITIMATE INTEREST IN THE DOMAIN NAME

42. The Complainant submits that the Registrant has no "legitimate interest" in the Domain Name, as this term is defined in paragraph 3.6 of the Policy.
43. Paragraph 3.6 of the Policy sets forth an exhaustive list of criteria for determining whether a registrant has a legitimate interest in a domain name. It reads as follows:

"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.

In paragraphs 3.6 (b), (c), and (d) "use" by the Registrant includes, but is not limited to, use to identify a web site."

44. According to paragraph 4.1 of the Policy, the Complainant must provide some evidence that the Registrant has no legitimate interest in the Domain Name, as described in paragraph 3.6 of the Policy. Therefore, the Complainant has an initial burden of proof regarding the issue of the absence of a legitimate interest in the Domain Name. As stated in *Credit Counseling Society of British Columbia v. Solutions Credit Counseling Services Inc.*, DCA-829-CIRA, this burden is light. However, once the initial burden is satisfied, the onus shifts on the Registrant to demonstrate on a balance of probabilities that its use of the Domain Name falls under at least one of the above-cited criteria. In the case at hand, the Registrant failed to provide a response and therefore no evidence that the Registrant has a legitimate interest in the Domain Name has been provided to the Panel.
45. This being said, the Complainant has alleged that the Registrant has no legitimate interest in the Domain Name and has provided some evidence to that effect. The Panel is therefore limited to reviewing the evidence and arguments submitted by the Complainant.
46. The Complainant essentially alleges that the Registrant has no legitimate interest in the Domain Name because it does not satisfy any of the above-cited exhaustive criteria and, more specifically, because the Registrant has not used the Domain Name in good faith and has no rights in the Complainant's trade-mark "UTemp", as stipulated in subparagraph 3.6(a) of the Policy.
47. In this regard, it is alleged that the directing mind of the Registrant is a former employee of the Complainant. Furthermore, the Complainant has made proof of the fact that the Domain Name is used in association with services which are similar to those which are associated with the Complainant's mark, that is temporary staffing services. Finally, the Domain Name seems to be used for the sole purpose of redirecting Internet users to the Internet site of the Registrant.
48. These facts support the conclusion that the Registrant has not used the Domain Name in good faith pursuant to 3.6(a) of the Policy.

49. As for the remaining criteria which could help establish the Registrant's legitimate interest in the Domain Name, there is no evidence that the Domain Name was (i) clearly descriptive, (ii) understood in Canada to be the generic name in any language of the wares, services or business in association with which it may have been used, (iii) used by the Registrant in Canada in association with a non-commercial activity, (iv) the legal name of the Registrant or a name, surname or other reference by which the Registrant was commonly identified, or (v) the geographical name of the location of the Registrant's non-commercial activity or place of business.
50. As such, subparagraphs 3.6 (b) to (f) are of no use to help establish that the Registrant has legitimate interests in the Domain Name.
51. In light of all the above, the Panel is of the view that the Registrant has no legitimate interest in the Domain Name. The Complainant has met its second burden of proof.

BAD FAITH REGISTRATION

52. The Complainant submits that the Registrant has registered the Domain Name in "bad faith" as this term is defined in paragraph 3.7 of the Policy.
53. Paragraph 3.7 of the Policy sets forth the following exhaustive list of criteria for determining whether a Registrant registered a domain name in "bad faith":

"For the purposes of paragraph 3.1(c), a Registrant will be considered to have registered a domain name in bad faith if, and only if:

(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 the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor 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 the Complainant, or the 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; or

(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.”

54. The Complainant refers to subparagraph 3.7(c) of the Policy and submits that the Registrant registered the Domain Name in bad faith because it registered the Domain Name primarily for the purpose of disrupting the business of the Complainant, who is a competitor of the Registrant.
55. In this regard, the Panel refers once again to the above-cited decision *Trailwest Online Inc. v. Tallwest Systems Inc.*, wherein the parties were considered to be in direct competition because they offered similar services to a similar market. In the case at hand, the parties also offer similar services to a similar clientele, i.e. temporary staffing services.
56. Furthermore, in the above-cited decision *Credit Counseling Society of British Columbia v. Solutions Credit Counseling Services Inc.*, the President of the registrant was a former employee of the complainant and the registrant never provided any explanation for its registration of the disputed domain name. These facts allowed the Panel to infer that the registrant was aware of the use of the mark at issue by the complainant, and that the registrant registered the disputed domain name to attract business from those who had come to recognize the complainant's mark, thus disrupting the complainant's business.
57. In the case at hand, the directing mind of the Registrant is also a former employee of the Complainant and the Registrant also failed to provide any explanation for its registration of the disputed domain name.
58. Moreover, it appears that the Registrant uses the Domain Name in order to redirect Internet traffic towards its own Internet site.
59. In other words, the Registrant has registered a domain name which is identical to a mark in which the Complainant had prior rights and is benefiting from any notoriety of such mark in order to increase the traffic on its own Internet site, thus potentially increasing its sales to the detriment of the Complainant, its competitor.
60. As reiterated recently in *Enterprise Rent-a-Car Company v. Supriyo Malaker o/a DotCrafter*, CIRA dispute number 0086 relating to ecar.ca and ecars.ca, such use of a domain name clearly constitutes disrupting the business of a competitor.

61. In light of the above, the Panel is of the view that the Registrant registered the Domain Name primarily for the purpose of disrupting the business of the Complainant, its competitor.
62. Consequently, the Panel is of the view that the Complainant has met its third and final burden of evidence.

CONCLUSION AND DECISION

63. The Complainant has proven, on a balance of probabilities, that the 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 in which the Complainant continues to have such rights, as such terms are defined in the Policy.
64. The Complainant has adduced evidence that the Registrant has no legitimate interest in the Domain Name, as described in paragraph 3.6 of the Policy. Furthermore, the Registrant, having decided not to file a response, has obviously not proven, on a balance of probabilities, that it has a legitimate interest in the Domain Name, as described in paragraph 3.6 of the Policy.
65. Finally, the Complainant has also proven, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith as described in Paragraph 3.7 of the Policy.
66. For these reasons, the complaint regarding the Domain Name is successful and the Panel orders and directs that the registration of the domain name "utemp.ca" be transferred to the Complainant.



Stefan Martin

Date: April 7, 2008