

**IN THE MATTER OF A COMPLAINT MADE PURSUANT TO THE CANADIAN
INTERNET REGISTRATION AUTHORITY DOMAIN NAME DISPUTE
REGISTRATION RESOLUTION POLICY (v 1.1) AND RULES (v 1.2)**

Complainant: The Governing Council of the University of Toronto
21 King's College Circle
Toronto, ON, M5S 3J3
(the "Complainant")

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Registrant: MetCap Living Management Inc.
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Toronto, ON, M5H 3R3
(the "Registrant")

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Disputed Domain Name utorontohousing.ca
(the "Domain Name")

Registrar: Tucows.com Co. (UBC Research Enterprises Inc.)

Single Member Panel: R. John Rogers

Service Provider: British Columbia International Commercial Arbitration
Centre (the "BCICAC")

BCICAC File: DCA-1145-CIRA

PROCEDURAL HISTORY

The BCICAC is a recognized service provider pursuant to the Domain Name Dispute Resolution Policy (v 1.1) (the “Policy”) and Rules (v 1.2) (the “Rules”) of the Canadian Internet Registration Authority.

The Complainant filed a complaint dated February 23, 2009 (the “Complaint”) with the BCICAC seeking an order in accordance with the Policy and the Rules directing that registration of the Domain Name be transferred from the Registrant to the Complainant.

The BCICAC determined the Complaint to be in administrative compliance with the requirements of Rule 4.2 and, by letter of transmittal dated February 27, 2009 (the “Transmittal Letter”), forwarded a copy of the Complaint to the Registrant to serve as notice of the Complaint in accordance with Rules 2.1 and 4.3. The Transmittal Letter determined the date of the commencement of proceedings in accordance with Rule 4.4 to be February 24, 2009 and advised the Registrant that in accordance with the provisions of Rule 5, a Response to the Complaint was to be filed within 20 days of the date of commencement of proceedings, or March 19, 2009.

By letter dated March 23, 2009, a copy of which was sent to the Registrant, BCICAC advised the Complainant that as the BCICAC had received no response to the Transmittal Letter, pursuant to Rule 6.5 the Complainant was entitled to elect to convert from a three member panel to a single member panel. The Complainant elected a single member panel and the undersigned was appointed by the BCICAC as the Single Member Panel by letter dated April 7, 2009. The undersigned filed his Acceptance of Appointment as the Single Member Panel and Statement of Independence and Impartiality with the BCICAC on April 16, 2009 and determines that he has been properly appointed and constituted as the Single Member Panel to determine the Complaint in accordance with the Rules.

CANADIAN PRESENCE REQUIREMENTS

The Canadian Presence Requirements for Registrants v 1.3 (“Presence Requirements”) require that to be permitted to apply for registration of, and to hold and maintain the registration of, a .ca domain name, the applicant must meet at least one of the criteria listed as establishing a Canadian presence. Section 2(j) of the Presence Requirements specifies that an educational institution located in Canada which is authorized or recognized as a university or college under an act of the legislature of a province or territory of Canada has the requisite Canadian presence.

The Complainant is an educational institution located in Canada authorized as a university under an act of the legislature of the Province of Ontario. The Complainant, therefore, meets the Canadian presence requirement.

ALL TECHNICAL REQUIREMENTS MET

Based upon the information provided by BCICAC, the Panel finds that all technical requirements for the prosecution of this proceeding have been met, and, no Response to the Complaint having been filed by the Registrant, the Panel finds that pursuant Rule 5.8 the Panel is to decide this proceeding on the basis of the Complaint.

FACTS

As the Registrant has chosen not to respond to the Complaint, the facts put forward by the Complainant are summarized as follows:

1. The Complainant is The Governing Council of the University of Toronto, a 50-member corporate body having its principal place of business in the City of Toronto, Province of Ontario.
2. The Complainant was established by Ontario provincial legislation under *The University of Toronto Act, 1971*.
3. The Complainant oversees the academic, business and institutional affairs of The University of Toronto (the “University”).
4. The University was founded in 1827 and currently has 61,210 full time equivalent students, 9,219 faculty and staff, and 421,506 alumni.
5. The University is comprised of numerous schools, colleges and faculties and operates from five locations, including the St. George Campus in downtown Toronto.
6. The Complainant operates a website on behalf of the University at www.utoronto.ca (the “University Site”).
7. The Complainant has used the common law mark “UTORONTO” (the “UofT Mark”) in association with the provision of educational services by the University since at least December 1, 1985.
8. The Complainant registered the UofT Mark as the domain name UTORONTO.CA for the University Site in March of 1988 and has used this domain name since 1994 in connection with the Complainant’s websites.
9. Virtually all of the University’s schools, colleges, faculties and other related organizations have sub-sites within the UTORONTO.CA domain resulting in a total of over 61,000 host computers using this domain.
10. The University’s School of Continuing Studies offers distance education through the University Site.
11. The UTORONTO.CA domain is also used as the second level domain for over 90,000 electronic mail addresses issued to students, faculty and employees of the Complainant.
12. The Complainant uses both the UofT Mark and the domain UTORONTO .CA in association with the housing services that it offers to its students through its site, “Student Housing Service, University of Toronto”, situated at www.housing.utoronto.ca (the “Student Housing Site”).
13. Through the Student Housing Site, the Complainant provides students with, among other information, detailed information about off campus housing opportunities close to its St. George campus.
14. The Student Housing Site also provides landlords within the City of Toronto the opportunity to advertise their rental accommodation to visitors to the Student Housing Site.
15. The Registrant registered the Domain Name in 2004.
16. The Domain Name consists of the UofT Mark combined with the descriptive word “housing”.

17. The Registrant provides property management services in a number of Canadian markets, including the Greater Toronto Area, and offers numerous properties for rent that are close to the Complainant's St. George campus.
18. The Domain Name resolves to a web site (the "Domain Name Website") which focuses on advertising student housing accommodation in seven apartment buildings managed by the Registrant, all of which apartment buildings are located in the vicinity of the Complainant's St. George campus.
19. The Domain Website is headed "Student Accomodations (sic)" and starts with the following statement in bold type:

Attending the University of Toronto is easy ...
 When you live at Continental Tower, Castellana, Wellesley Square,
 Sherwood Apartments, Garden View Apartments or Sherbourne Estates
20. Following the above statement, the website asks:

Are you a prospective or current student of U of T?
 Do you want to live near campus but not in a residence?.
21. The Continental Tower, Castellana, Wellesley Square, Sherwood Apartments, Garden View Apartments, and two buildings known as "Sherbourne Estates" are all apartment buildings managed by the Registrant.

REMEDY SOUGHT

The Complainant seeks an order from the Panel that as the Domain Name is confusingly similar to the UofT Mark, that as the Registrant has no legitimate interest in the Domain Name, and that as the Registrant has registered the Domain Name in bad faith, the Panel instruct the Registrar of the Domain Name to transfer the Domain Name to the Complainant.

THE POLICY

The purpose of the Policy as stated in paragraph 1.1 of the Policy is to provide a forum in which cases of bad faith registration of .ca domain names can be dealt with relatively inexpensively and quickly.

Paragraph 4.1 of the Policy puts the onus on the Complainant to demonstrate this "bad faith registration" by proving on a balance of probabilities that:

1. the UofT Mark qualifies as a "Mark" as defined in paragraph 3.2 of the Policy;
2. the Complainant had "Rights" (as "Rights" are defined in paragraph 3.3 of the Policy) in the UofT Mark prior to the date of registration of the Domain Name and continues to have "Rights" in the UofT Mark,
3. the Domain Name is "Confusingly Similar" to the UofT Mark as the concept of "Confusingly Similar" is defined in paragraph 3.4 of the Policy;
4. the Registrant has registered the domain name in "bad faith" in accordance with the definition of "bad faith" contained in paragraph 3.4 of the Policy; and
5. the Registrant has no "legitimate interest" in the Domain Name as the concept of "legitimate interest" is defined in paragraph 3.6 of the Policy.

If the Complainant is unable to satisfy this onus, bad faith registration is not demonstrated and the Complaint fails.

MARK

The relevant portion of paragraph 3.2 of the Policy states that for the purpose of the Policy a “Mark” is:

- (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;

The Complainant has used the UofT Mark as its common law trademark in Canada to distinguish its provision of educational services from another provider of such services since at least December 1, 1985. The Complainant continues to use the UofT Mark in a similar capacity.

The Complainant registered the UofT Mark as the domain name UTORONTO.CA for the University Site in March of 1988 and has used this domain name since 1994 in connection with the University Site and the many subsites, subzones, and second level domains for electronic mail addresses associated with the University.

The UofT Mark clearly qualifies as a “Mark” within the provisions of paragraph 3.2 (a) of the Policy.

RIGHTS

The relevant portion of paragraph 3.3 of the Policy states that for the purpose of the Policy the Complainant has “Rights” in the UofT Mark if:

- (a) in the case of paragraphs 3.2 (a) and 3.2(b), the Mark has been used in Canada by that person, that person’s predecessor in title or a licensor of that person or predecessor;

As noted above in the examination of the qualification of the UofT Mark as a “Mark”, paragraph 3.2(a) of the Policy applies and the Complainant has used the UofT Mark in Canada both prior to and following the registration of the Domain Name.

The Complainant, therefore, has “Rights” in the UofT Mark.

CONFUSINGLY SIMILAR

Policy paragraph 3.4 provides that the Domain Name will be “Confusingly Similar” to the UofT Mark if the Domain Name so nearly resembles the UofT Mark in appearance, sound or the ideas suggested by the UofT Mark as to be likely to be mistaken for the UofT Mark.

In the matter at hand, the Domain Name consists of the UofT Mark, UTORONTO, followed by the word “housing” and followed by the .ca suffix. As paragraph 1.2 of the Policy defines the Domain Name for the purpose of this proceeding to exclude the .ca suffix, the portion of the Domain Name consisting of “UTORONTOHOUSING” is relevant.

Therefore, to satisfy the onus placed upon it by the Policy, the Complainant must demonstrate that “UTORONTOHOUSING” so nearly resembles the UofT Mark in appearance, sound or the ideas suggested by the UofT Mark as to be likely to be mistaken for the UofT Mark.

Other Panels have considered the situation where, as here, the disputed domain name has incorporated a Mark. These Panels have determined that the addition of generic or descriptive words to a trademark in the creation of a domain name does not distinguish that domain name so as to make it *not* confusingly similar to the trademark for the purpose of the Policy. For example, in *Berlitz Investment Corporation v. Katelin Adkins*, WIPO Case No. D2007-0008, the Panel held that the addition of the phrase “languagecourse” did not prevent the domain name from being confusingly similar to the BERLITZ mark.

The *Berlitz* decision was followed in a WIPO decision dated December 1, 2008 involving the Complainant and the Registrant (*The Governing Council of the University of Toronto v. Metcap Living Management Inc.* WIPO Case No. D2008-1490). In this decision, the Panel had to consider whether or not the disputed domain name “universityoftorontohousing.com” was confusingly similar to the trademark, “University of Toronto”. In determining that the disputed domain name was confusingly similar to the trademark, the Panel held that the addition of the descriptive word “housing” did not make the disputed domain name sufficiently different so as to distinguish it from the trademark.

The matter at hand, as well as involving the same two parties as the *Metcap* case referred to above, also involves the same descriptive word “housing” as considered in the *Metcap* case.

As with the Panel in the *Metcap* case this Panel finds that the descriptive word “housing” is not sufficient to distinguish the Domain Name from the UofT Mark and finds that the Complainant has satisfied the onus of demonstrating that the Domain Name is “Confusingly Similar” to the UofT Mark in accordance with paragraph 3.4 of the Policy.

BAD FAITH

Under paragraph 3.7 of the Policy, the Registrant will be considered to have registered the Domain Name in bad faith if, and only if, the Complainant can demonstrate that the Registrant in effecting the registration of the Domain Name was motivated by any one of the three general intentions set out in paragraph 3.7. Of these intentions, the form of intention contained in paragraph 3.7(c) is the one most applicable to the matter at hand.

Paragraph 3.7(c) provides as follows:

(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.

There is before the Panel no direct evidence of the Registrant's intention in registering the Domain Name. Such intention must therefore be based upon a common sense inference from the Domain Name Website and from the Registrant's use of this website.

As well, in determining the Registrant's intention, the Panel must be cognizant of the wording of paragraph 3.7(c) which requires both that the Complainant be a competitor of the Registrant and, that the Registrant's *primary* purpose in registering the Domain Name is the disruption of the business of the Complainant.

Although the Domain Name Website contains a direct link to another of the Registrant's websites which deals on a generic basis with tenant accommodation in the downtown area of the City of Toronto, the Domain Name Website on its face is clearly targeted only at visitors seeking student tenant accommodation. Indeed, it is specifically targeted at students attending or intending to attend the University and who are seeking rental accommodation in the neighbourhood of the Complainant's St. George Campus.

Prominently displayed on the Domain Name Website is a map of a portion of the City of Toronto showing the locations of the seven rental buildings offered for student accommodation by the Registrant and their location relative to the St. George Campus of the University. As well, each of the seven buildings offered by the Registrant is listed separately together with details on the distance from each property to the St. George Campus, the transit route from each property to the St. George Campus, and driving directions from each property to the St. George Campus.

Common sense suggests that students seeking accommodation who are intending to or are currently attending the University at its St. George Campus will naturally be drawn toward a Domain Name that includes the words UTORONTO and HOUSING and will associate the Domain Name Website with the Complainant. In using the Domain Name in this manner, it appears that the Registrant intends to cause confusion among parties using the Domain Name Website, which confusion clearly acts to the benefit of the Registrant and disrupts the business of the Complainant.

Nor does the Domain Name Website appear to have any purpose other than to offer rental accommodation at the Registrant's buildings to students attending or intending to attend the University. Indeed, the inclusion of the UofT Mark, UTORONTO, in the Domain Name reinforces this impression. Such a focus gives further credence to the Registrant's primary intention.

The evidence before the Panel is that the Complainant provides through its Student Housing Site student accommodation services to students attending or intending to attend the University. Such services include the offer of rental accommodation to students attending the University's St. George Campus as well as the University's other campuses. And this rental accommodation offering is from both the Complainant and from other landlords who have paid to advertise on the Student Housing Site.

The Complainant derives rental revenue from students directed through the Student Housing Site to secure accommodation in student residences owned directly or indirectly by the Complainant. As well, advertising revenue is generated from landlords advertising on the Student Housing Site directed at students and intended students of the University. The Complainant is clearly a competitor of the Registrant.

It is obvious that the Domain Name Website is designed to compete directly with and to disrupt the business of the Complainant in offering rental accommodation to present and intended students of the University. The Panel finds that the Registrant registered the Domain Name primarily for the purpose of disrupting the business of one of its competitors, the Complainant, and that the Complainant has, therefore, demonstrated that the Registrant registered the Domain Name in bad faith.

NO LEGITIMATE INTEREST

Paragraph 4.1 of the Policy requires that to succeed in the Complaint, the Complainant must provide some evidence that the Registrant has no legitimate interest in the Domain Name as the concept of "legitimate interest" is provided for in paragraph 3.6.

Paragraph 3.6 of the Policy provides that:

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 Registrants includes, but is not limited to, use to identify a web site.

As noted above, the Registrant has elected not to respond to the Complaint. Therefore, the Panel must review the provisions of paragraph 3.6 against the evidence before the Panel as provided by the Complainant.

There is no evidence before the Panel that the Domain Name is a Mark in which the Registrant has Rights and that the Registrant used the Domain Name in good faith prior to the filing of the Complaint as set out in paragraph 3.6(a).

On the face of it, the Domain Name does not appear to be clearly descriptive of wares, services or business of the Registrant or of the people involved in or place of origin thereof as provided for in paragraph 3.6(b). If anything, the Domain Name is descriptive of the services offered by the Complainant and its place of origin.

Similarly, there is no evidence that the Domain Name is understood in Canada as the generic name of wares, services, or business offered by the Registrant, that the Domain Name is used in Canada in connection with a non-commercial activity of the Registrant, or that the Domain Name is a name by which the Registrant is commonly identified. Therefore, the provisions of paragraphs 3.6(c), 3.6(d) and 3.6(e) do not apply.

Finally, although the Domain Name does include a portion of the geographical name of the location of the Registrant's activity in that the Domain Name includes the word "Toronto", one of the locations where the Registrant is commercially active, there is no evidence before the Panel that the Domain Name is the location of the Registrant's non-commercial activity or place of business.

Therefore, the Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name.

However, even if the Complainant has satisfied the onus on it to prove that the Domain Name is Confusingly Similar to the UofT Mark, that the Registrant has registered the Domain Name in bad faith, and that the Registrant has no legitimate interest in the Domain Name, Paragraph 4.1 of the Policy grants the Registrant the opportunity still to succeed in the Complaint if the Registrant is able to prove on a balance of probabilities

that it has a legitimate interest in the Domain Name as the concept of “legitimate interest” is described in paragraph 3.6.

The Registrant, although given ample opportunity to do so, has chosen not to respond to the Complaint and, therefore, must be taken to have elected not to exercise this right to demonstrate to the Panel that it has such a legitimate interest in the Domain Name.

DECISION

The Panel finds that the Complainant has satisfied the onus placed upon it by paragraph 4.1 of the Policy and is entitled to the remedy sought by it.

ORDER

The Panel orders that the domain name, <utorontohousing.ca> be transferred to the Complainant.

Dated: April 23, 2009.

R. John Rogers
Single Member Panel