

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

Domain Name: cusaonline.ca
Complainant: Carleton University Students’ Association Inc.
Registrant: Justin Essiambre
Registrar: Go Daddy Domains Canada, Inc.
Panelist: Sharon Groom
Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant, Carleton University Students’ Association Inc., is a non-profit organization incorporated under the laws of Canada.
2. The Registrant for the domain name is Justin Essiambre.

B. The Domain Name and Registrar

3. The disputed domain name is cusaonline.ca. The Registrar for this domain name is Go Daddy Domains Canada, Inc. The disputed domain name was registered on January 20, 2010.

C. Procedural History

4. This is a proceeding under the *CIRA Domain Name Dispute Resolution Policy* (Version 1.1) (the “Policy”) and the *CIRA Domain Name Dispute Resolution Rules* (Version 1.2) (the “Rules”).
5. The history of the proceeding as provided by the dispute resolution provider, Resolution Canada, Inc., is that the Complainant filed a complaint (the “Complaint”) against the Registrant with Resolution Canada, Inc. on April 27, 2010, requesting that the current registration of the domain name cusaonline.ca be transferred to Carleton University Students’ Association Inc.

6. Resolution Canada, Inc. served notice of the Complaint on the Registrant as required by paragraph 4.3 of the Rules. Service of the Complaint was made by e mail on April 28, 2010 and by courier on the same day. It was received by the Registrant on May 4, 2010.

7. The Registrant had twenty (20) days from the date the Complaint was filed to file a Response, but no Response from the Registrant was ever filed.

8. The Complainant has elected to proceed before a panel consisting of only one panelist.

D. Panelist Impartiality and Independence

9. As required by paragraph 7 of the Rules, the panelist has submitted to Resolution Canada, Inc. a declaration of impartiality and independence in relation to this dispute.

E. Canadian Presence Requirements

10. The Complainant, Carleton University Students' Association Inc., is a Canadian corporation. As such it meets the Canadian Presence Requirements under paragraph 2(q) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3.

F. Factual Background

11. The Complainant states that it is the owner of the domain name cusaonline.com and has been using the acronym CUSA as a trade-mark to identify itself since at least as early as 1969 (it was incorporated March 14, 1969) and has been using the trade-mark CUSAONLINE since at least as early as 2003 (its domain name cusaonline.com was registered on February 3, 2003).

12. The Complainant's submissions indicate that the trade-marks CUSA and CUSAONLINE have been used in association with the Complainant's various campus businesses which include various pubs, restaurants and bookstores as well as student services such as the Carleton Disability Awareness Centre, the Womyn's Centre and the Aboriginal Services Centre.

13. The Complainant's evidence includes copies of advertisements for the Complainant's services showing use of the acronym CUSA, the earliest of which appears to be dated 1991, and CUSAONLINE, the earliest of which appears to be dated 2004. The evidence also demonstrates current use of these terms.

14. The Complainant e mailed the Registrant on March 8, 2010 requesting that the domain name cusaonline.ca be transferred to the Complainant as they were concerned that confusion was going to result from the use of the disputed domain name by the Registrant. The Complainant offered to pay the Registrant's out of pocket costs in registering the domain name. The Registrant responded on March 14, 2010 stating that he had had a number of offers for this domain name and that the Complainant was welcome to submit an offer.

G. CIRA Domain Name Dispute Resolution Policy

15. Under paragraph 3.1 of the Policy it requires that the Complainant establish 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 no legitimate interest in the domain name as described in section 3.6; and

c) the Registrant has registered the domain name in bad faith as described in section 3.7.

16. According to paragraph 4.1 of the Policy the Complainant must establish points (a) and (c) above on the balance of probabilities and for point (b) it must provide some evidence that the Registrant has no legitimate interest in the domain name.

H. Analysis

Confusingly Similar

17. The Complainant has to show that it has rights in a mark that is confusingly similar to the domain name, that these rights pre-date the date of registration of the disputed domain name and that the rights continue to exist.

18. The date of registration of the domain name is January 20, 2010, therefore this is the relevant date for this analysis.

19. The Complainant claims in its evidence that it has been using the acronym CUSA to identify its services for over forty years. The acronym is short for Carleton University Students' Association. The evidence demonstrates that this acronym is used in a prominent fashion on advertisements for the Complainant's services as well as on documentation used in delivering the services. I therefore find that this mark meets the criteria set out in paragraph 3.2(a) of the Policy as it is a trade-mark that has been used for the purposes of distinguishing the Complainant's services from those of others.

20. With regard to the mark CUSAONLINE, the applicant has been using this as part of the domain name www.cusaonline.com since 2003. The mere use of a term as a domain name is not sufficient in and of itself to constitute use of the term as a trade-mark. In order to be considered a Mark for the purposes of the Policy (and indeed a "trade-mark" under the *Trade-marks Act*), the domain name must be used in a prominent manner to distinguish a person's wares and services from those of others. However the evidence also shows that the term CUSAONLINE.COM is being used in the banner for the Complainant's website and thus appears in a prominent fashion on each web page on the site. In my opinion this use is sufficient to satisfy the definition of a Mark in the Policy paragraph 3.2(a) as the term is being used prominently to identify and distinguish the Complainant's services from those of others.

21. The Complainant acquired rights in these two marks prior to the date the Registrant registered the domain name in question, namely January 20, 2010. It is also evident from the Complainant's materials that these marks have not been abandoned.

22. The domain name registered by the Registrant is cusaonline.ca. This domain name incorporates the whole of the Complainant's marks CUSA and CUSAONLINE and adds no other distinguishing material. Therefore it is apparent that the domain name is confusingly similar to the Complainant's marks.

23. Therefore, I find that the Complainant has demonstrated rights in marks that are confusingly similar to the domain name, and that these rights pre-date the date of registration of the domain name. I also find that these rights are still in existence.

Legitimate Interest

24. Paragraph 3.6 of the Policy provides six possible ways in which a Registrant may have a legitimate interest in a domain name. The submissions made by the Complainant indicate that the domain name initially contained a link to a Wikipedia entry for the Carleton University Students' Association, specifically the section entitled "Controversies". As of April 6, 2010 the domain name linked to a blog located at www.cusatruth.com which contained a number of photographs of members of CUSA with offensive, personal remarks about these members. The website was later amended to go back to the "Controversies" section of Wikipedia referred to above.

25. The domain name was therefore not being used as a mark, prior to receiving the notice from the Complainant, to identify any wares or services being provided by the Registrant. Therefore paragraph 3.6(a) of the Policy is not satisfied. Also, the Registrant does not appear to have used the domain name in good faith in association with any wares, services or business for which the domain name was clearly descriptive or the generic term (3.6(b) and (c)). The domain name was not the legal name or other identifier of the Registrant (3.6(e)), and it was not the geographical name of the location of the Registrant's place of business (3.6(f)).

26. The only legitimate interest that seems to have any potential for applying in this situation is the one set out in paragraph 3.6(d) of the Policy which states that using a domain name in good faith in association with a non-commercial activity including criticism, review or news reporting, can be a legitimate interest. In this case the domain name was used, for a time, to criticize certain members of the Carleton University Students' Association. However the Complainant argues that such criticism was not in good faith for two reasons:

- 1) the Registrant must have been aware of the Complainant's rights in the trade-marks CUSAONLINE and CUSA as the Registrant is a Carleton University student and the content of the Registrant's website indicated a familiarity with the Complainant's services. Therefore the adoption of a domain name which was confusingly similar to www.cusaonline.com (only differing in that the Registrant's used ".ca") cannot be said to have occurred in good faith;

- 2) the criticism that took place on the Registrant's site was not a legitimate, objective form of criticism of the Complainant's services, but rather was used for inappropriate and offensive personal comments about specific members of the organization. Such criticism

is not the form that was intended to be protected as a “legitimate interest” under the Policy and such criticism cannot be said to have occurred in “good faith”.

27. I agree with the Complainant’s submissions. Adopting a domain name which you know to be for all intents and purposes the same as the domain name used by your student association cannot be said to be a legitimate interest. Even if the Registrant did want to engage in good faith criticism of the Complainant, it could do so without adopting a domain name which is likely to cause confusion amongst people looking for the Complainant’s services on the web. In addition, referring to a person who is serving as a volunteer on a students’ association as “the most racist person you will ever meet”, “loner”, “hypocrite” and “huge idiot, aspiring dictator hypocrite” does not constitute a good faith criticism, nor does it make the use of a domain name that is confusingly similar to the Complainant’s marks, a legitimate interest.

28. Therefore, I find that the Complainant has presented some evidence to demonstrate that the Registrant had no legitimate interest in the domain name and therefore none of the criteria in paragraph 3.6 have been satisfied.

Bad Faith

29. The Complainant has to show, on the balance of probabilities, that the domain name was registered in bad faith. Paragraph 3.7 of the Policy deals with the grounds which constitute bad faith. The Complainant alleges that the Registrant’s conduct constitutes bad faith under paragraphs 3.7(a) and 3.7(c). I shall deal with each one below.

30. The Complainant contends that the Registrant’s response to the Complainant’s offer to pay the Registrant’s out of pocket costs for registering the domain name and transferring it to the Complainant, namely that the Registrant wrote “I have received a number of offers for this domain name, if you would like to submit an offer you may.” is evidence that the Registrant primarily registered the domain name for the purpose of selling it to the Complainant for valuable consideration in excess of the Registrant’s actual costs in registering the domain name. I agree with this conclusion. The Registrant did not accept the Complainant’s offer to pay out of pocket costs and asked, in effect, for a better offer, which no doubt was intended to exceed the Registrant’s out of pocket costs. I therefore find that the Complainant has shown bad faith under paragraph 3.7(a), on the balance of probabilities.

31. While it is not necessary for the purposes of this decision, as I have already found that the Complainant has demonstrated bad faith, I shall consider whether the Complainant was also successful in proving bad faith under paragraph 3.7(c). The Complainant has stated that the Complainant’s mark CUSA has been used for over 40 years, therefore one can assume that it is quite well known, especially amongst Carleton University students, of which the Registrant is apparently one. The Complainant also makes substantial use of its domain name www.cusaonline.com in providing its services, therefore the Registrant must have been aware of this domain name and it can be no coincidence that the Registrant chose to register the same domain name (except for the “.ca”). As I have already determined that the Registrant had no legitimate interest in this domain name, it can only be assumed that the registration of a domain name so confusingly similar to the Complainant’s marks was done for the purpose of disrupting the Complainant’s business. It is very likely that students seeking the Complainant’s services at

www.cusaonline.com would come across the Registrant's domain name www.cusaonline.ca and assume that this site was run by the Complainant. This would disrupt the business of the Complainant because it would cause confusion amongst the Complainant's users when searching the internet.

32. With regard to the criteria that the Registrant be a competitor of the Complainant, the Registrant's actions make it a competitor in that it is competing for the web traffic that would otherwise go to the Complainant by utilizing the Complainant's marks in its domain name. The Complainant refers to the case of *McKee Homes Ltd. v. Gerlinde Honsek* (CIRA Dispute No. 079) in supporting its contention that competing for internet traffic by capitalizing on consumer confusion makes the Registrant a competitor of the Complainant for the purposes of the domain name dispute proceedings. I agree with this and therefore find that the Complainant has shown, on the balance of probabilities, that the Registrant has registered the domain name in bad faith under paragraph 3.7(c) as well.

I. Conclusion and Decision

33. In conclusion, I find that the Complainant has rights in the marks CUSA and CUSAONLINE which predate the registration of the domain name. I also find that the domain name is confusingly similar to the Complainant's marks and that the Registrant had no legitimate interest in the domain name. Finally, I find that the Complainant has shown that the Registrant registered the domain name in bad faith.

34. I therefore order, pursuant to paragraph 4.3 of the Policy, that the registration of the domain name cusaonline.ca be transferred to the Complainant, Carleton University Students' Association Inc.

Dated June 7, 2010

Sharon Groom



Sharon Groom
June 7, 2010