

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

Domain Name: ONTARIOUNIVERSITIES.CA

Complainant: Ontario Universities' Application Centre
Registrant: Mr Shawn Henderson
Registrar: dot-ca-registry.ca (Burmac Business Systems Ltd)

Panel: Alessandro Colonnier
Jay E. Josefo
David Lametti (Chair)

Service Provider: ResolutionCanada

DECISION

A. The Parties

1. The Complainant is the Ontario Universities' Application Centre. It is located at 170 Research Lane, Guelph, Ontario, N1G 5E2. The contact person for the complaint is Ms Deanna Underwood, Manager, Communications.
2. The Registrant is Mr Shawn Henderson. His address is 6555 Falconer Drive, Apartment 4, Mississauga, Ontario, L5N 3N6.

B. The Domain Name and Registrar

3. The domain name at issue is ONTARIOUNIVERSITIES.CA.
4. The domain name is registered with dot-ca-registry.ca.

C. Procedural History

5. On 19 August 2014, the Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, ResolutionCanada. The Provider served notice of the Complaint to the Registrant as required by paragraph 4.3 of the *CIRA Domain Name Dispute Resolution Rules* (version 1.4) ["Rules"].
6. A Response was received from the Registrant on 9 September 2014.
7. The Provider therefore composed a panel of three, all as governed by the Rules.

D. Panel Member Impartiality and Independence Statement

8. As required by paragraph 7 of the Rules, the panelists have declared to the Provider that they can act impartially and independently in this matter, as there are no circumstances known to them that would prevent them from so acting.

E. Canadian Presence Requirement

9. The Complainant is resident in Canada and thus satisfies the Canadian Presence Requirement as stated in paragraph 1.4 of the *CIRA Domain Name Dispute Resolution Policy* (version 1.3) [“Policy”].

F. Factual Background

10. The Ontario Universities’ Application Centre (OUAC) is located in Guelph Ontario. It is the not- for- profit agency located in Guelph, Ontario that processes applications for admission to the province’s twenty-one accredited universities. The OUAC provides a service in both English and French to applicants of all undergraduate and professional programs (medicine, law, teacher education and rehabilitation sciences), as well as graduate studies programs at several universities.

11. The OUAC was founded in 1971 by the Committee of Presidents of the Universities of Ontario, now called the Council of Ontario Universities, and the Ontario Universities’ Council on Admissions (OUCA).

12. The Registrant registered the domain name at issue on 18 August 2010.

13. Prior to January 2014, the Complainant became aware of the domain name registration. The web site resolved to a so-called parking page that invites a person to buy the domain name through a website form with a Yahoo email address. The site also includes links to other, general university-related themes.

14. The OUAC completed the website form requesting a quote to purchase ONTARIOUNIVERSITIES.CA. On 12 January 2014, Mohammed Khan, a domain broker representing the Registrant, replied to the quote request stating the expected price \$7500 USD (Appendix B1).

15. On 15 January 2014, Mr Khan emailed the OUAC stating “this is a highly premium generic domain that is valued in the thousands of dollars” (Appendix B2).

16. On 29 January 2014, Mohammed Khan emailed the OUAC stating “this client has allowed buyers to pay for domains over time” (Appendix B3).

17. The Complainant filed this Complaint with CIRA on 19 August 2014.

G. CIRA Domain Name Dispute Resolution Policy Requirements

18. The *CIRA Domain Name Dispute Resolution Policy* (version 1.3) [“Policy”] sets out at paragraph 4.1 what the Complainant must establish in order to successfully prove the Complaint:

To succeed in the 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; and
- (b) the Registrant has registered the domain name in bad faith as described in paragraph 3.5;

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.

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name . . .

The Panel needs only to deal with the first criterion.

H. Is the Registrant’s Domain Name Confusingly Similar to the Complainant’s Mark?

19. Paragraph 3.2 of the Policy includes the following in the definition of what constitutes a “mark” for the purposes of the Policy:

A “Mark” is:

- (a) a trade-mark . . . or a trade name that has been used in Canada . . . for the purpose of distinguishing the wares, services or business of that person . . . from the wares, services or business of another person;
- (b) a certification mark, including the word elements of a design mark, that has been used in Canada by a person or the person’s predecessor in title, for the purpose of distinguishing wares or services that are of a defined standard; [and]
- (c) a trade-mark . . . that is registered in CIPO . . .

20. The difficulty for the Complainant is the linking of “Ontario Universities” and “Ontario Universities Application Centre”, as the former is much wider than the latter.

21. There is no evidence on the record that the OUAC has registered ONTARIO UNIVERSITIES or something similar as a trade-mark, or has used ONTARIO

UNIVERSITIES as an unregistered mark for the purposes of distinguishing its services. There is also no evidence, to the extent that such may be possible, that ONTARIO UNIVERSITIES has been registered as a certification mark, or might somehow be protected by the common law doctrine of extended passing off.

22. There is also no evidence on the record that the OUAC has registered ONTARIO UNIVERSITIES' APPLICATION CENTRE or something similar as a trade-mark.

23. Moreover, the words "Ontario" and "Universities" are both descriptive and generic, and thus would only be protectable as trade-marks with the development of a Secondary Meaning over time. This Secondary Meaning has not been shown.

24. It is possible that ONTARIO UNIVERSITIES' APPLICATION CENTRE has acquired enough secondary meaning over time to be considered as an unregistered trade-mark or trade name for the purposes of distinguishing its services.

25. However, even if ONTARIO UNIVERSITIES' APPLICATION CENTRE were capable of being construed as a common law trade-mark or trade name, there is still the question of whether the registered domain name is confusingly similar to the trade-mark. Paragraph 3.3 of the Policy defines "confusingly similar" in the following terms:

In determining whether a domain name is "Confusingly Similar" to a Mark, the Panel shall only consider whether 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. In this case, there is a substantial difference between "Ontario Universities Application Centre" and the kinds of services that the title would indicate are provided by the Centre, and the much wider concept of "Ontario Universities." Even if the longstanding use of OUAC can be construed as a Mark in its own right for certain specific information and registration services offered, such a right does not give it an ambit of protection that includes "Ontario Universities". The latter is simply much larger in scope, and the ideas suggested by the two terms are quite different.

27. Finally, the Panel notes that there is neither any evidence of actual confusion in the Complaint as between the domain name at issue and the OUAC, nor in its view is there any likelihood of confusion for any user (and especially not for someone contemplating university in Ontario.)

28. Thus the Panel finds that Registrant's domain name ONTARIOUNIVERSITIES.CA is not confusingly similar with any acquired right that the Complainant's use of Ontario Universities Application Centre might engender.

29. The failure to demonstrate "confusingly similar" is enough to dispose of the Complaint in favour of the Registrant.

I. Was the Registration of the Domain Name Made in Bad Faith? Does the Registrant Have a “Legitimate Interest” in the Domain Name?

30. Given the finding above, these two questions need not be answered.

J. Reverse Domain Name Hijacking

31. The Registrant has raised the issue of Reverse Domain Name Hijacking under paragraph 4.6 of the Policy.

32. The Complainant had raised arguments for the domain name having been registered in bad faith and without legitimate interest. While the Panel did not need to pronounce on the validity of these arguments given its finding on confusingly similar, the arguments themselves are indicative of a good faith belief on the part of the Complainant that its actions were launched with some belief in its “colour of right”. As the Complaint was lodged with some legitimate basis for believing that the Registrant had registered the domain name contrary to the purposes articulated in the Policy, an error (especially one that appears to have been made in good faith) on the first criterion of confusingly similar is not sufficient to ground a claim in Reverse Domain Name Hijacking. The Complaint was not lodged solely to dislodge the Registrant of his right.

K. Conclusion and Decision

33. The Complainant has not established that the Registrant’s domain name ONTARIOUNIVERSITIES.CA is confusingly similar to either the Ontario Universities’ Application Centre, or with the services it provides.

34. For these reasons, the Complaint fails.



David Lametti
Chair

For Panelists Alessandro Colonnier and Jay E. Josefo.

14 October 2014