

IN THE MATTER OF
A Complaint pursuant to the Canadian Internet Registration Authority (**CIRA**)
Dispute Resolution Policy (**CDRP**) and Domain Name Dispute Resolution Rules (the **Rules**).

File Number: DCA-2098-CIRA
Domain Name: u-alberta.ca
Complainant: The Governors of the University of Alberta
Registrant: Fabrice Toho
Registrar: HEXONET Services Inc.
Sole Arbitrator: Michael Erdle
Service Provider: British Columbia International Commercial Arbitration Centre
(BCICAC)

DECISION

On May 3, 2019, the Complainant filed a complaint against the Registrant with the BCICAC, with respect to the registration of <u-alberta.ca> (the “Domain Name”).

The BCICAC confirmed the Complainant was in administrative compliance with the Policy and the Rules and forwarded a copy of the complaint to the Registrant on May 17, 2019.

The Registrant did not respond to the BCICAC with respect to the complaint within the time required under the Rules.

Accordingly, under Rule 6.5, the Complainant was permitted to elect to convert from a three-person tribunal to a single arbitrator.

I was appointed as sole arbitrator by BCICAC.

Factual Background

In accordance with Rule 5.8, having received no response to the complaint, I shall decide the complaint based on the information provided in the Complaint and accompanying materials, as set out in this award.

The Complainant is a Canadian educational institution continued pursuant to the Alberta Post-Secondary Learning Act. University of Alberta is one of western Canada's largest academic and research universities, comprised of 18 faculties, 15,000 staff, and more than 38,000 students at four Alberta campuses.

The Complainant operates a number of websites, including its main site located at www.ualberta.ca (the "UAlberta Website"). The Complainant states that the UAlberta Website has received more than 73 million page views in each of the past two calendar years (2017 and

2018). The UAlberta Website contains significant institutional information relating to the Complainant's various graduate and undergraduate programs, including information targeted to prospective applicants.

The Complainant has taken steps to protect its brand by registering a number of trademarks and official marks associated with the UAlberta Website, including:

- UALBERTA [trademark), TMA-0877752, registered October 19, 1999 in association with educational services, research services, communicational services, library services, various clothing, sporting goods, office accessories, and other items;
 - UALBERTA (official mark), TMA-0908318, public notice granted October 8, 1997; and
 - UALBERTA.ca [official mark), TMA-0923973, public notice granted April 6, 2016;
- [collectively, the "Marks").

The Domain Name was registered with the Registrar HEXONET Services Inc. on December 11, 2018.

The Complainant filed a Request for Disclosure of Registrant Information with the CIRA on January 31, 2019. CIRA's disclosure response identified the Registrant as Fabrice Toho, whose address is 606 rue Cathcart, Bureau 800, Montreal, Quebec, H3B 1K9.

The Complainant submitted evidence showing that the website associated with the Domain Name displayed the Complainant's name and logo, along with images obtained from existing or previous iterations of the University of Alberta website. The screenshots show pages purporting to be information about the university, with links and email addresses directing Internet users to the Registrant.

The Complainant also submitted evidence obtained from an individual who allegedly was misled into submitting an application to study at University of Alberta, and paying an "admission fee" to Registrant, in the belief that he was dealing with the Complainant.

The Registrant did not submit any evidence in response to the Complaint.

Requested Remedy

The Complainant requests that the Panel order that the Domain Name be transferred to the Complainant.

Eligibility

The Complainant satisfies CIRA's eligibility requirements for Complainants, pursuant to paragraph 1.4 of the Policy, because it is a Canadian university (section 2(j) of the Canadian Presence Requirements). In addition, the complaint relates to a trademark and official marks registered with the Canadian Intellectual Property Office and the Complainant is the owner of the Marks.

Reasons for Award

Under the Policy, the onus is on the Complainant to prove on a balance of probabilities that the domain name is confusingly similar to Complainant's trademark, that the Complainant has rights in the mark, and that it has been registered in bad faith.

The Complainant must also provide "some evidence" that the Registrant has no legitimate interest in the disputed domain name.

1. Confusingly Similar & Rights in the Trade-mark

The registration of a mark with CIPO is sufficient in and of itself to establish "rights" within the meaning of the Policy. (*Viacom International Inc. v. Harvey Ross Enterprises Ltd.*, CIRA Dispute 00015, 2003)

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 whether a domain name is "Confusingly Similar", the Panel shall only consider the appearance, sound, or idea suggested and not have regard to other factors. The "domain name", for the purposes of the Policy, means the domain name excluding the dot-ca suffix. (Paragraph 3.3 of the Policy)

The Complainant relies on the decision in *Great Pacific Industries Inc. v. Dhalla* (CIRA Dispute 0009, 2003) in which the Panel accepted that the test for confusion must be made from the perspective of "an average Internet user, with an imperfect recollection of the Mark who wishes to access a website operated by the Complainant."

The Complainant submits that there is significant likelihood of confusion between the Domain Name [u-alberta] and the trademark and official mark *ualberta*, and the official mark *ualberta.ca*.

Apart from the placement of a "-" between "u" and "alberta," the two domains are identical. The Complainant submits that the nearly identical nature of the two domains is likely to lead to confusion.

Previous Panels have determined that the addition of a single letter or other character to a mark are not sufficient to avoid a finding that the domain name and mark are confusingly similar. Nor is the addition or omission of punctuation, such as a hyphen, in my view.

The Complainant also submitted evidence of actual confusion, in at least one case where it appears that the Registrant drew a prospective international student to the website operated under the Domain Name and solicited the payment of "admission fees" of \$150 USD through an email address linked to the Domain Name.

Based on the foregoing, I find that the Complainant has rights in the Marks and that the Domain Name is confusingly similar to the Marks.

2. Legitimate Interest

The Policy requires that the Complainant must provide “some evidence” that the Registrant has no Legitimate Interest in the Domain Name.

Paragraph 3.4 of the Policy provides a non-exhaustive list of instances when a registrant can establish a “Legitimate Interest” in a domain name. From the evidence submitted, it does not appear that the Registrant meets any of these criteria.

There is no evidence that the Registrant made any good faith use of the Domain Name. On the contrary, the Complainant submits that the evidence shows that the Domain Name was used solely in pursuit of a scheme to mislead potential students into making applications through the website and email address operated by the Registrant in connection with the Domain Name.

The Complainant relies on the evidence submitted with the Complaint showing that the website operated under the Domain Name included the University of Alberta name and logo, along with images obtained from the University of Alberta Website. It also relies on redacted documents supplied by a prospective international student who was misled into making an application and paying an “admission fee” through the Registrant’s website and email address.

Based on the foregoing, I find that the Registrant has no legitimate interest in the Domain Name.

3. Registration in Bad Faith

The Complainant submits that the Registrant registered the Domain Name in bad faith in an attempt to pass off the Domain Name as one belonging to the Complainant, thereby creating an air of legitimacy for his efforts to obtain money from international students by misleading them into believing they were applying to the Complainant.

The Complainant relies on purported “admission documents” that the Complainant believes were provided by the Registrant to an unsuspecting victim of this fraud. The “admission documents” include references to and logos of the University of Alberta, as well as references to the Domain Name. None of these documents are official documents of the Complainant. Rather, they appear to have been manufactured by the Registrant in furtherance of his alleged fraudulent actions.

In previous decisions, the Panel held that where a registrant passes itself off as another entity, such action represents bad faith registration and use for the purposes of the Policy. (*Toronto-Dominion Bank v. Lefebvre*, CIRA Dispute 1911, 2017)

On the facts and evidence presented by the Complainant, it is reasonable to infer that the Registrant registered the Domain Name for the purpose of exploiting the goodwill associated with the Marks to attract international students to his website, apparently for the purpose of deceiving them into paying “admission fees”.

Based on the evidence and submissions of the Claimant, I find on a balance of probabilities that the Registrant registered the Domain Name in bad faith.

Decision and Order

Based on the uncontested evidence of the Complainant, including the facts and arguments in the Complaint and supporting documents, I find that the Complainant has satisfied the requirements and burden of proof in the Policy and the Rules.

I find that the Claimant has rights in the Marks.

I find that the Domain Name is confusingly similar to the Marks UALBERTA and UALBERTA.CA.

I find that the Registrant has no legitimate interest in the Domain Name and has registered the Domain Name in bad faith.

I hereby order and direct that the registration of the Domain Name be transferred from the Registrant to the Complainant.

Dated at Toronto, Ontario, this 13th day of September, 2019.

A handwritten signature in black ink, appearing to read "M. Erdle", with a long horizontal flourish extending to the right.

Michael Erdle,
C.Arb; FCI Arb.