

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

DECISION

Domain Name: ubreakifix.ca  
Complainant: uBreakiFix Co.  
Registrant: Haroon Syed  
Registrar: Go Daddy Domains Canada, Inc.  
Service Provider: Resolution Canada Inc.  
Panel: Sharon Groom, Daria Strachan, Peter C. Cooke (Chair)

THE PARTIES

The Complainant is uBreakiFix Co. (the “Complainant”) with an address at 1806 33<sup>rd</sup> Street, Suite 120, Orlando, Florida, USA 32839.

The Registrant is Haroon Syed (the “Registrant”) with an address at 1705 rue Plante, Brossard, Quebec, Canada, J4W 1K8.

THE DOMAIN NAME AND REGISTRAR

The subject of this proceeding is the domain name ubreakifix.ca (the “Domain Name”), registered on August 21, 2014. The Registrar of the Domain Name is Go Daddy Domains Canada, Inc.

PROCEDURAL HISTORY

This is an administrative dispute resolution proceeding pursuant to the Canadian Internet Registration Authority (“CIRA”) *Domain Name Dispute Resolution Policy* (version 1.3) (the “Policy”) and the CIRA *Domain Name Dispute Resolution Rules* (version 1.5) (the “Rules”). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of this dispute pursuant to the Policy and the Rules.

According to the information provided by Resolution Canada Inc., the dispute resolution service provider, the history of the proceeding is as follows:

The Complainant filed a complaint (the “Complaint”) dated May 11, 2015 with Resolution Canada Inc., requesting that the Domain Name registration be transferred from the Registrant to the Complainant. After having determined that the Complaint was in administrative compliance with the requirements of the Policy and the Rules, Resolution Canada Inc. commenced the dispute resolution process and served notice of the Complaint on the

Registrant (as required by paragraph 4.3 of the Rules) by email on May 26, 2015. A response (the "Response") dated June 14, 2015 was received.

On August 6, 2015 the panel was appointed. As required by paragraph 7.1 of the Rules, the panel has declared to Resolution Canada Inc. that it can act impartially and independently in this matter, as there are no circumstances known that would prevent it from so acting.

### ELIGIBILITY OF COMPLAINANT

The Complainant satisfies Paragraph 2(q) of the CIRA *Canadian Presence Requirements for Registrants*. The Complainant is the owner of the Canadian registered trademark UBREAKIFIX TMA901,622 which although shown as pending in the Complaint, became registered on April 21, 2015, prior to the Complaint being filed in May.

### OVERVIEW OF THE POLICY

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:

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

The Registrant has registered the domain name in bad faith as described in paragraph 3.5;

And the Complainant must provide some evidence that:

The Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

### COMPLAINANT'S POSITION

The Complainant contends as follows:

The Complainant contends that it has rights in multiple "UBREAKIFIX" trademark applications and registrations, and that the Domain Name is confusingly similar to the trademark.

The Complainant contends that the Registrant registered and is using the Domain Name in bad faith because it registered the Domain Name for the purpose of disrupting the business of a competitor, in particular, the Complainant. The Complainant further contends that the Registrant has intentionally attempted to attract, for commercial gain, internet users to the Registrant's website by creating a likelihood of confusion with the Complainant's trademark.

The Complainant contends that the Registrant has no legitimate interest in the Domain Name, as the Complainant has not granted permission to the Registrant to use the Domain Name.

### REGISTRANT'S POSITION

The Registrant argues that his business model differs from the Complainant's in that he wants to use the website to provide advice to customers buying electrical, electric and computer equipment, and connect them with potential service providers. He also indicated that he considers the term "UBREAKIFIX" to be a generic name for fixing the damaged and out of order engineering products and their services.

### DISCUSSIONS AND FINDINGS

#### Confusing Similarity between Domain Name and Complainant's Mark

In order to satisfy this branch of the test, the Complainant must demonstrate (i) that it has rights in a mark, (ii) that the rights in its mark predate the registration date of the Domain Name, and (iii) that the mark is confusingly similar with the disputed Domain Name.

The Complainant contends that it has rights in the "UBREAKIFIX" trademark, and that the domain name is confusingly similar to this trademark. The Complainant further asserts that it has been in business in Canada since the end of 2013, and now has 5 locations in Canada. The Complainant has submitted evidence of their trademark registrations in Canada, and trademark registrations in the United States which predate the August 2014 registration date of the domain name. They allege that the Domain name is identical or confusingly similar to the Complainant's UBREAKIFIX trademark.

As per paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if the domain name so nearly resembles the mark in appearance, sound or in the ideas suggested by the mark that it will likely be mistaken for the mark. 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..."

The test to be applied when considering whether a mark and domain name are "confusingly similar" is one of first impression and imperfect recollection. The Complainant must prove, on a balance of probabilities, that a person, as a matter of first impression, knowing the Complainant's corresponding mark, and having an imperfect recollection of the mark, would likely confuse the Domain Name for the Complainant's mark based upon the appearance, sound or the ideas suggested by the mark.

In this case the Domain Name is not merely similar to the Complainant's trademark but is identical to it.

The Panel can therefore conclude that the Domain Name is confusingly similar with the Complainant's trademark, given that the Domain Name so nearly resembles the trademark in appearance, sound and in the ideas suggested so as to be likely to be mistaken for the mark.

The Panel thus finds that the Domain Name is confusingly similar with a mark in which the Complainant had rights prior to the registration date of the Domain Name, and continues to have such rights.

### Bad Faith Registration

The Complainant submits that the Registrant registered the Domain Name primarily for the purpose of disrupting the business of a competitor. The Complainant further submits that the Registrant has registered and is using the Domain Name in bad faith because the Registrant is using the Domain Name on their website to mislead customers looking for repair services from the Complainant, by directing them to the Registrant.

Paragraph 3.5 of the Policy sets out that the following circumstances, if found to be present, shall be evidence that a Registrant has registered a domain name in bad faith:

(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;

(d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location;

The Complainant alleges that the Complainant and Registrant are in the same business. The Complainant has an established business under the UBREAKIFIX trademark. The Complainant alleges that customers seeking the Complainant have tried to call the locations listed on the Registrant's website and their calls went unanswered. The Complainant further alleges that the Registrant's website has utilized materials and stock photos from the Complainant's website, along with similar colour schemes.

The Registrant alleges that the Registrant selected the Domain Name as a generic name for fixing damaged and out of order products. The Registrant does not deny using the materials and stock photos found on the Complainant's website, noting that they are available online and are the property of the respective manufacturers. The Registrant takes the position that its business plan is different enough from that of the Complainant that customers will not be misled.

An inference of bad faith under 3.5(c) can be made where the registrant of a confusingly similar domain name sells goods or services similar to those of the complainant (HRB Royalty v. Taxman CIRA No 00093). The Registrant's response does not provide a reasonable explanation such that good faith could be implied. Accordingly, the Panel can conclude that bad faith exists as per paragraph 3.5 (c). A similar finding can be made regarding paragraph 3.5(d) as the Registrant used a domain name confusingly similar to the Complainant's Mark in the operation of a website that offered services similar to the Complainant's. This combination appears designed to attract the public to the Registrant's website by creating confusion with the Complainant as to the source of the website, for commercial gain. The Panel finds that the Complainant has established that the Registrant registered the Domain Name in bad faith, pursuant to paragraphs 3.5 (c) and (d) of the Policy.

#### No Legitimate Interest in the Domain Name

Paragraph 3.4 of the Policy requires that the Complainant must provide *some* evidence that the Registrant has no legitimate interest in the Domain Name. Once this onus has been discharged by the Complainant, the Registrant may still succeed if it can show, on a balance of probabilities, that it has a legitimate interest in the Domain Name pursuant to paragraph 3.4.

The Complainant has submitted that the Registrant has no legitimate interest in the Domain Name, as the Complainant has not granted permission to the Registrant to use the Domain Name.

The Panel finds that the Complainant has provided sufficient evidence that the Registrant does not have a legitimate interest in the Domain Name. The Complainant has confirmed that it did not authorize the registration, and the Registrant's website appears likely to mislead the public into believing that the Registrant is affiliated with, or endorsed by, the Complainant.

The Registrant has sought to legitimize the Domain Name in its Response. A review of the criterion set out in 3.4 of the Policy demonstrates that the Registrant cannot successfully rely on any of these provisions.

The Registrant cannot rely on 3.4(a) of the Policy. The Domain Name may be a mark, but it is the Complainant's trademark. The Complainant has not licensed or otherwise authorized the Registrant to use the mark or to register it as a domain name.

The Registrant cannot rely on 3.4(b) or 3.4 (c) of the Policy. Despite the Registrant's submissions, the Domain Name is not clearly descriptive nor a generic name, but is distinctive of the Complainant.

The Registrant cannot rely on 3.4(d) of the Policy as the Domain Name is not being used in association with criticism, review or news reporting.

The Registrant cannot rely on 3.4(e) of the Policy as the Domain Name is not the legal name or other identifier of the Registrant.

The Registrant cannot rely on 3.4 (f) of the Policy as the Domain Name has no relation to the geographical name of the location of the Registrant's place of business.

In view of the above, the Panel must conclude that the Registrant has no legitimate interest in the Domain Name.

#### CONCLUSION AND DECISION

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.

The Complainant has proven, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith.

The Complainant has adduced some evidence that the Registrant has no legitimate interest in the Domain Name. The Registrant's Response did not legitimize its registration of the Domain Name.

For these reasons, the Complaint regarding the Domain Name is successful.

#### ORDER

The Panel orders, pursuant to paragraph 4.3 of the Policy, the transfer of ubreakifix.ca to the Complainant.



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Panel: Sharon Groom, Daria Strachan, Peter C. Cooke

By: Peter C. Cooke (Chair)

Dated August 24, 2015