

**IN THE MATTER OF A COMPLAINT MADE PURSUANT TO THE CANADIAN
INTERNET REGISTRATION AUTHORITY DOMAIN NAME DISPUTE
REGISTRATION RESOLUTION POLICY (v 1.3) AND RULES (v 1.5)**

Complainants:

Indeed, Inc.
6433 Champion Grandview Way
Building 1
Austin, Texas 78750
United States

and

Indeed Canada Corp.
1959 Upper Water Street, Suite 900
Halifax, NS
B3J 3N2, Canada

(collectively the “Complainants”)

Complainants’ Counsel

Bereskin & Parr LLP
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Registrant:

Julie Derouin
1872 des Carriers
Montreal, Quebec
H2G 1W4, Canada
Email: bandkohalsara@yahoo.com

(the “Registrant”)

Disputed Domain Name:

myindeed.ca
(the “Domain Name”)

Registrar:

Webnames.ca Inc.
Suite 333-333 Terminal Avenue
Vancouver, BC
V6A 4C1, Canada
Tel: 1-866-976-9835
Email: support@webnames.ca

Single Member Panel: R. John Rogers

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

BCICAC File: DCA-1899-CIRA

PROCEDURAL HISTORY

The BCICAC is a recognized service provider pursuant to the Domain Name Dispute Resolution Policy (v 1.3) (the “Policy”) and Rules (v 1.5) (the “Rules”) of the Canadian Internet Registration Authority (“CIRA”).

On July 24, 2017, the Complainants filed a complaint dated July 24, 2017 (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 Indeed, Inc. (“Indeed”).

The BCICAC determined the Complaint to be in administrative compliance with the requirements of Rule 4.2 and, by letter of transmittal dated July 25, 2017 (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 July 25, 2017. The Transmittal Letter 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 August 14, 2017.

The Transmittal Letter and a copy of the Complaint was sent to the Registrant by email to the email addresses bandkohalsara@yahoo.com and postmaster@myindeed.ca.

By a letter dated August 15, 2017 delivered by email, with a copy sent to the Registrant by email to the two aforementioned email addresses, the BCICAC advised the Complainants that as the BCICAC had not received a Response to the Transmittal Letter by August 14, 2017 as required by Rule 5.1, that pursuant to Rule 6.5 the Complainants had the right to elect that the panel in this matter be converted from a three member panel to a single member panel.

The Complainants so elected and the undersigned was appointed by the BCICAC as the Single Member Panel by letter dated August 22, 2017, copies of which letter were sent by email to both the Complainants and to the Registrant. The undersigned has confirmed to the BCICAC that he can act impartially and independently as the Single Member Panel in this matter.

The undersigned determines that he has been properly appointed and constituted as the Single Member Panel to determine the Complaint in accordance with the Rules.

Domain Name: myindeed.ca
Indeed, Inc.
and
Indeed Canada Corp.
BCICAC File: DCA-1889- CIRA

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(d) lists incorporation under the laws of Canada or any province or territory of Canada as being one of these criteria.

Section 2(q) of the Presence Requirements specifies that a Person which does not meet any of the foregoing conditions laid out in Section 2, but which is the owner of a trade-mark which is the subject of a registration under the *Trade-marks Act* (Canada) R.S.C. 1985, c. T-13, meets the Presence Requirements provided that the domain name sought to be registered in that Person’s name consists of or includes the exact word component of that registered trade-mark.

The Complainants have provided evidence that Indeed is the owner of the Canadian trade-mark INDEED under Canadian trade-mark registrations No. TMA759,439 and TMA876,194 (the “Trade-Mark”). Indeed licenses the right to use the Trade-Mark in Canada to Indeed Canada Corp. (“Indeed Canada”).

As a corporate entity incorporated under the laws of Nova Scotia, Indeed Canada is an Eligible Complainant pursuant to 1.4 of the Policy.

However, as the Domain Name, excluding the .ca, with the attachment of the prefix “my” does not consist of the exact word component of the Trade-Mark as required by the Presence Requirements, I find that Indeed, even though it owns the Trade-Mark registered in the Canadian Intellectual Property Office, is not an Eligible Complainant pursuant to section 1.4 of the Policy.

ALL TECHNICAL REQUIREMENTS MET

Based upon the information provided by the BCICAC and the Complainants, I find that as Indeed Canada is an Eligible Complainant, that all technical requirements for the prosecution of this proceeding have been met.

FACTS OFFERED BY THE COMPLAINANTS

The facts put forward by the Complainants might be summarized as follows:

1. The Complainants provide the world’s largest job site, with over 200 million unique visitors every month from over 60 different countries, and with offices throughout the world, including Toronto, Ontario, Canada.
2. Indeed owns the domain name, “indeed.ca”, and has used this domain name since 2009 with an employment search engine geared to Canadians.
3. As well, Indeed owns the slogan “one search all jobs” (“the Slogan”) registered in Canada under TMA 795,559.
4. Indeed Canada is the Canadian operating arm of Indeed and is an authorized user of the Trade-Mark and Slogan in Canada.

Domain Name: myindeed.ca
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5. On May 5, 2017, the Domain Name was registered to an undisclosed registrant.
6. On or about June 2, 2017, the Complainants became aware that the Domain Name resolved to a website that imitated the Complainants' website in overall appearance, look and feel, and colour scheme, as well as including Indeed's name, the Trade-Mark and the Slogan.
7. When visitors to this site, www.myindeed.ca, entered information in fields on this site labelled "What" and "Where", these visitors were then redirected to www.indeed.ca, the website owned and operated by the Complainants.
8. In addition, the Complainants learned that on or about June 2, 2017, the Registrant had sent emails to customers of the Complainants from the email address employerssupport@myindeed.ca in which the Registrant represented that the email was from the Complainants.
9. This email requested its recipient to provide identification in the form of a "utility bill, tax document, or business document".
10. It is the Complainants' submission that these email requests constituted a phishing scheme whereby the Registrant purported to be one of the Complainants in order to obtain financial information from the Complainants' customers.
11. On June 3, 2017, the Complainants' US attorney sent a letter to the Registrant addressed to the website host and Registrar of record for the Domain Name in order to object to the Registrant's violation of the Complainants' trademark rights.
12. Upon the recommendation of the Registrar of record for the Domain Name, on June 6, 2017, the Complainants' Canadian counsel attempted to contact the Registrant through CIRA's Interested Party Contact Form, to which correspondence, the Registrant did not respond.
13. Faced with this lack of response from the Registrant, on June 20, 2017 the Complainants requested from CIRA disclosure of the Registrant's identity and on June 29, 2017 this identity was disclosed by CIRA for the purpose of this Complaint.

FACTS OFFERED BY THE REGISTRANT

As was noted above, the Registrant has not responded to the Complaint.

REMEDIES SOUGHT

The Complainants seek an order from the Single Member Panel in accordance with paragraph 4.3 of the Policy instructing the Registrar of the Domain Name to transfer the Domain Name from the Registrant to Indeed.

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 Complainants to demonstrate this “bad faith registration” by proving on a balance of probabilities that:

1. a trade-mark or trade name owned by the Complainants qualifies as a “Mark” as this term is defined in paragraph 3.2 of the Policy;
2. the Complainants had “Rights” in the Mark prior to the date of registration of the Domain Name and continue to have “Rights” in the Mark,
3. the Domain Name is “Confusingly Similar” to the Mark as the concept of “Confusingly Similar” is defined in paragraph 3.3 of the Policy;
4. the Registrant has no “legitimate interest” in the Domain Name as the concept of “legitimate interest” is defined in paragraph 3.4 of the Policy; and
5. the Registrant has registered the Domain Name in “bad faith” in accordance with the definition of “bad faith” contained in paragraph 3.5 of the Policy.

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

MARK

In the matter at hand, 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 Complainants have provided evidence that they have been operating in Canada well prior to the date of registration of the Domain Name on May 5, 2017. In the course of this operation, the Complainants have used the Trade-Mark in Canada to distinguish their provision of wares, services or business from another provider of similar wares, services or business.

The Complainants continue to use the Trade-Mark in Canada.

The Trade-Mark clearly qualifies as a “Mark” pursuant to paragraph 3.2(a) of the Policy.

RIGHTS

Paragraph 3.1(a) of the Policy requires that the Complainants have “Rights” in the Trade-Mark and that these “Rights” existed prior to the date of registration of the Domain Name and continue to the present date. Unfortunately, this term “Rights” is not defined in the Policy.

Given the evidence before me of the ownership and the use by the Complainants of the Trade-Mark in Canada, I find that for the purpose of paragraph 3.1(a) of the Policy, the Complainants had Rights in the Trade-Mark prior to the registration of the Domain Name on May 5, 2017 and that these Rights continue to the present date.

CONFUSINGLY SIMILAR

Policy paragraph 3.3 provides that the Domain Name will be found to be “Confusingly Similar” to the Trade-Mark only if the Domain Name so nearly resembles the Trade-Mark in “appearance, sound or the ideas suggested” by the Trade-Mark as to be likely to be mistaken for the Trade-Mark. It is to be noted that unlike the requirement under section 2(q) of the Presence Requirements which requires the exact word component of the Trade-Mark, paragraph 3.3 requires a more nuanced approach.

The Domain Name includes the word “indeed”, similar to the Trade-Mark, but in the Domain Name the word “indeed” is preceded by the prefix “my” and 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 “myindeed” is the portion relevant for consideration.

Therefore, to satisfy the onus placed upon it by the Policy, the Complainants must demonstrate that the “myindeed” portion of the Domain Name so nearly resembles the Trade-Mark in appearance, sound or the ideas suggested by the Trade-Mark so as to be likely to be mistaken for this identifier.

In the Complaint, the Complainants submit that the Domain Name is the same in appearance and commercial impression to the Trade-Mark and that the added prefix does not negate the confusing similarity between the Trade-Mark and the Domain Name. I agree with this submission.

Apart from an attempt to personalize the Trade-Mark, the addition of the prefix “my” does not describe an item or idea markedly different from that described by the Trade-Mark. Moreover, as described above, the use of the Domain Name by the Registrant to resolve to a website which very clearly resembles that of the Complainants suggests that the intent of the Registrant in the use of the Domain Name was to create the likelihood of it being confused with the Trade-Mark and, in effect, passing off the website owned and operated by the Registrant as being one owned and operated by the Complainants.

On the evidence before me, I therefore find that the Complainants have satisfied the onus placed upon them by paragraph 3.3 of the Policy and have demonstrated that the Domain Name so nearly resembles the Trade-Mark in appearance, sound or the ideas suggested by the Trade-Mark as to likely be mistaken for the Trade-Mark.

NO LEGITIMATE INTEREST

Paragraph 4.1 of the Policy requires that to succeed in the Complaint, the Complainants 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 3.4 of the Policy.

Paragraph 3.4 of the Policy provides that the Registrant has a legitimate interest in a domain name if:

- 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 paragraph 3.4(d) “use” by the Registrant includes, but is not limited to, use to identify a web site.

It is to be noted that in paragraphs 3.4(a), (b), (c), and (d), there is a requirement that the Registrant used the Domain Name “in good faith”. The evidence before me, as referenced below, is that the Registrant used the Domain Name not in good faith, but rather to trade upon the goodwill of the Complainants without a license to do so. Therefore, the provisions of these paragraphs do not apply.

The Registrant’s name is not included in the Domain Name, so the provisions of paragraph 3.4(e) do not apply nor do the provisions of paragraph 3.4(f) apply.

I therefore find that the Complainants have provided some evidence that the Registrant has no legitimate interest in the Domain Name.

BAD FAITH

Under paragraph 3.5 of the Policy, the Registrant will be considered to have registered the Domain Name in bad faith if, and only if, the Complainants can demonstrate that the Registrant

in effecting the registration of the Domain Name was motivated by any one of the four general intentions set out in paragraph 3.5.

Of these intentions, the form of intention contained in paragraph 3.5(d) is the one most applicable to the matter at hand.

Paragraph 3.5(d) provides as follows:

(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 evidence before me demonstrates that the Registrant registered the Domain Name primarily for the purpose of attempting to attract for commercial gain Internet users to the website to which the Domain Name resolves by creating a likelihood of confusion with the Trade-Mark as to the source, sponsorship, affiliation or endorsement of the Registrant's website.

I note particularly:

1. The similarity of the design of the website to which the Domain Name resolves to the website owned and operated by the Complainants; and
2. That in the email sent by the Registrant to visitors of the site to which the Domain Name resolves, the Registrant represented that it was from the Complainants and sought the contact details of these visitors by requesting that the recipient of the email provide a "utility bill, tax document, or business document".

I therefore find that the Complainants have satisfied the provisions of subparagraph 3.5(d) of the Policy by establishing that the Registrant registered the Domain Name primarily for the purpose set out in this subparagraph.

DECISION

As was above set out, paragraph 4.1 of the Policy provides that to be successful in the Complaint the Complainants have the onus of proving on a balance of probabilities three specific items and of providing some evidence that the Registrant has no legitimate interest in the Domain Name.

I find that the Complainants have satisfied this onus with respect to all three of these items by demonstrating on a balance of probabilities that the Trade-Mark qualifies as a Mark in accordance with paragraph 3.2 of the Policy; that the Domain Name is Confusingly Similar to the Trade-Mark; and that the Registrant has registered the Domain Name in bad faith in accordance with the provisions of paragraph 3.5 of the Policy.

I have also found that the Complainants have shown some evidence that the Registrant does not have a legitimate interest in the Domain Name in accordance with the provisions of paragraph 3.4.

I therefore find that the Complainants have satisfied the onus placed upon them by paragraph 4.1 of the Policy and are entitled to the remedy sought by them.

ORDER

In the Complaint, the Complainants have requested that the Domain Name be transferred to Indeed. However, as I have found that Indeed does not meet the Presence Requirements, I order that the domain name “myindeed.ca” be transferred to Indeed Canada Corp.

Dated: August 28, 2017.

“R. John Rogers”

R. John Rogers

Single Member Panel