

**IN THE MATTER OF A COMPLAINT PURSUANT TO THE
CANADIAN INTERNET REGISTRATION AUTHORITY (CIRA)
DOMAIN NAME DISPUTE RESOLUTION RULES (the Rules)**

Dispute Number: DCA-1342-CIRA
Domain Name: **ryersonhousing.ca**
Complainant: Ryerson University
Registrant: MetCap Living Management Inc.
Registrar: Tucows.com Co.
Panelist: Harold Margles
Service Provider: British Columbia International
Commercial Arbitration Centre

DECISION

Procedural History

On September 7, 2011, The Complaint was filed with respect to the Domain Name with the British Columbia International Commercial Arbitration Centre, hereinafter referred to as the Centre. The Complaint was reviewed by the Centre and was found to be in administrative compliance with the requirements under Rule 42 of the CIRA Domain Name Dispute Resolution Rules, hereinafter referred to as the CIRA Rules. The **Registrant** was served with the Complaint by e-mail and FedEx on September 9, 2011. The **Registrant** elected not to file a Response to the Complaint. Harold Margles was appointed as the sole arbitrator.

The Panelist has reviewed the documentary evidence provided by the **Complainant**, and agrees with the Centre's assessment that the Complaint complies with the formal requirements of the CIRA Policy and its Rules.

The panelist believes that the panel was constituted in compliance with the CIRA Rules. The Panelist has completed an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.

The Panel is obliged to make its decision on or before November 1, 2011, in the English language and is unaware of any other proceedings which may have been undertaken by the parties or others in the present matter.

As no Response has been filed, the Panel is required to decide the proceeding on the basis of the Complaint, including the exhibits thereto. The Panel accepts such evidence subject to its relevance, the weight to be attached thereto and the inferences which can reasonably be drawn therefrom.

The Panel will therefore draw such inferences as common sense and the **Complainant's** unchallenged evidence mandates

Parties

The **Complainant** is a university with its campus located downtown in the city of Toronto. It was established by Ontario legislation under the *Ryerson University Act 1977*.

It operates a website at RYERSON.CA.

It is the owner of a number of registered trade-marks and other official marks under section 9(n)(ii) of the *Trade-marks Act*, inter alia numbers 913879, 901979, 914992, 914993, 914994, 914995, 914996, 914997, 914998, 915049. All the trade-marks are in association with the word **University**. **Ryerson**,

The Registrant is a limited company with its head office in downtown Toronto. It provides property management services in a number of Canadian markets, including the Greater Toronto area, and offers numerous properties for rent that are close to the downtown Toronto Campuses of both the **Complainant** and the University of Toronto.

Factual Background

The **Complainant** uses both the Ryerson trade-marks and its Domain Name in association with the housing services which it offers to its students and prospective students through its website [Http://www.ryerson.ca/student_services/housing/](http://www.ryerson.ca/student_services/housing/) as "STUDENT HOUSING SERVICES, RYERSON UNIVERSITY".

Through the University website, the **Complainant** provides students with, among other information, detailed information about off-campus houses close to its downtown campus. It can reasonably be assumed that many of these students are from outside Toronto, and that they would be relying on the website information available to them in order to make informed and reliable decisions on the appropriate choice of housing.

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The **Complainant's** website for student housing services identifies a number of topics for the student's needs, such as "Residence Instruction info" and "off campus housing", which facilitate the decision-making of the students.

The **Registrant** registered the Domain Name *ryersonhousing.ca* on February 28, 2005. On the top of its website page is the phrase "Welcome to RYERSON UNIVERSITY"

The words "RYERSON UNIVERSITY" are a direct copy of the **Complainant's** registered trade-mark 913879, as well as the wording of the other official marks. The website repeatedly refers to the **Complainant** "Ryerson", "student", "campus", and identifies itself as the **Registrant** only at the bottom of the second page, as the owner of the copyright in the website.

It is implicit that students, particularly new students, seeking information from the **Complainant** for housing advertised in association with the **Complainant's** trade-marks,

would be looking not only at location and cost, but also to the **Complainant's** establishment of standards and criteria for such housing. Any student seeing advertising of downtown Toronto housing in association with the trade-mark **Ryerson**, would reasonably expect that such housing was either part of or otherwise approved by the **Complainant**.

The Domain Name directs students to rent accommodation in any of seven apartment buildings managed by the **Registrant**. It is clear the **Registrant**, both by its choice of Domain Name, and the manner in which it employs that Domain Name on the website, is seeking to persuade students that its owner is affiliated with the **Complainant**.

The **Registrant's** use of the **Complainant's** trade-mark at the top of its website page demonstrates that the **Registrant** knew of the **Complainant**, its services and location. It is reasonable to conclude that the **Registrant** intended to cause confusion and to appropriate the goodwill of the **Complainant** in its trade-mark(s).

I was somewhat troubled by the fact that the **Complainant** had not taken proceedings against the **Registrant** for over 5 years. However, because the remedy being sought is statutory and not equitable, laches do not apply.

On March 3, 2011, the **Complainant** sent a letter to the **Registrant** detailing the **Complainant's** trade-mark, and demanding the immediate removal of the **Registrant's** website. The **Registrant** chose not to respond either to the letter or by removing the offending website.

The **Registrant** has sought to use the same appropriation of trade-marks in creating a website for attracting University of Toronto students to its housing since at least June 22, 2004. The **Registrant's** offending Domain Name *utorontohousing.ca* was ordered transferred to that **Complainant**, the University of Toronto, by decision of the WIPO Arbitration and Mediation Center on December 1, 2008: D2008-1490.

On April 23, 2009, The University of Toronto again obtained an order against the **Registrant** for the transfer of the **Registrant's** Domain Name *utorontohousing.ca* by the British Columbia International Commercial Arbitration Center DCA-1145 CIRA.

Nonetheless, **the Registrant** continued the same practice with the **Complainant**, ignoring the demand to cease, and obligating the **Complainant** to initiate this proceeding.

Issues

Is the Domain name *ryersonhousing.ca* confusingly similar to the Complainant's registered trade-marks *Ryerson*, *Ryerson University* and its website *RYERSON.CA Student Housing Services*?

Paragraph 4.1 of the Policy obligates the **Complainant** to prove that, on the balance of probabilities, the **Registrant's** Domain Name is confusingly similar to the **Complainant's** trade-marks. The Complainant has established its right to the marks both by their registration and unchallenged use thereof. By not responding to the Complaint, the **Registrant** has conceded those rights.

The **Registrant's** use of the word "housing" as part of its Domain name does not serve to distinguish such Domain Name from the trade-marks of the **Complainant**. The **Complainant's** consistent and unchallenged use of its trade-marks *Ryerson* and *Ryerson*

University in association with educational and housing services distinguishes its marks from the similar services of others.

The Domain name is confusingly similar in appearance, sound and meaning to the trademarks of the **Complainant**.

The Governing Council of The University of Toronto and MetCap Living Management Inc
 BCICAC File: Dca-1145-CIRA
The Governing Council of The University of Toronto v MetCap Living Management Inc.
 D2008-1490

Has the Registrant registered the Domain Name in bad faith?

Paragraph 3.7 of the Policy sets another high standard for the **Complainant**. It must prove that the **Registrant** has registered the Domain Name in bad faith as defined in paragraph 3.7:

"...a Registrant will be considered to have registered a domain name in bad faith **if, and only if:**"

The paragraph sets out different intentions in sub paragraphs (a) and (b) which are not pertinent to the facts in the Complaint.

"(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."

There is no direct evidence of the **Registrant's** intent from the **Registrant**. The Policy imposes a high burden on the **Complainant** which must be met by inference from the facts which the **Complainant** is able to gather independently and by the exercise of common sense by the Panel from the Domain Name website and the **Registrant's** use thereof.

It is clear from both the **Complainant's** student housing website and the **Registrant's** website that the **Registrant** is a competitor of the **Complainant** in the provision of housing for Ryerson University students.

The **Complainant** can succeed if and only if the primary purpose of the **Registrant** is to disrupt the business of the **Complainant** by the registration of the Domain Name.

I adopt the reasoning of the panel in **Canadian Broadcasting Corporation and William Quon CIRA Dispute 00006 at page 13:**

"However, it is quite difficult usually, if not impossible, to show bad faith with concrete evidence. The panel is therefore of the opinion that it can take into consideration surrounding circumstances and draw inferences to determine whether or not the Registrant's actions are captured by paragraph 3.7....To require the Complainant to provide direct evidence of the Registrant's bad faith intentions would allow a Registrant with a certain level of skill to easily evade that application of the CIRA Policy, hence rendering it moot or irrelevant.

"... Therefore once the Complainant has presented sufficient evidence to establish one of the situations in 3.7, it is incumbent on the Registrant to either respond or explain why its conduct should not be considered bad faith. The panel's understanding of the Policy is that, although the initial burden to prove (on a balance of probabilities) the Registrant's bad faith in the registration of the disputed Domain Name lies squarely on the shoulders of the Complainant,

such obligation need not be more than to make out a prima facie case, akin to a number of decisions rendered in the ICANN Policy and, once it has done so, the Panel may find in certain circumstances that there is a shift in onus and it is then incumbent on the Respondent to either justify or explain its conduct, if not to demonstrate the contrary."

The onus has shifted to the **Registrant**. It has not provided any evidence to rebut the presumption of intent to disrupt the business of the **Complainant**.

The Registrant's website is captioned with "Welcome to
RYERSON UNIVERSITY"

This caption wrongfully appropriates the Ryerson University trade-mark of the **Complainant**, and leads the reader to believe that this is a website of the **Complainant**.

The caption is followed by:

"Student Accommodations"

"Attending Ryerson is easy..."

"Are you a prospective or current student of Ryerson University?"

In both its name and content, the **Registrant's** Domain Name website targets existing and potential Ryerson students seeking rental accommodation in the neighbourhood of the **Complainant's** campus. The buildings managed by the **Registrant** are shown by location and the respective distance of each building from the **Complainant's** campus.

As stated by the panel in *The Governing Council of The University of Toronto and MetCap DCA-114CIRA supra* at page 7:

"Common sense suggests that students seeking accommodation who are intending to or are currently attending the University.....will naturally be drawn toward a Domain Name that includes the word (RYERSON - the substitution for the word Toronto, is the panel's) and HOUSING and will associate the Domain Name website with the Complainant. In using the Domain Name in this manner, it appears that the Registrant intends to cause confusion among parties using the Domain Name Website, which confusion clearly acts to the benefit of the Registrant and *disrupts the business of the Complainant*" (emphasis is that of the Panel).

"Nor does the Domain Name Website appear to have any purpose other than to offer rental accommodation at the Registrant's buildings to students attending or intending to attend the University. Indeed, the inclusion of the (Panel's substitution) Ryerson Mark, *Ryerson*, in the Domain Name reinforces this impression. Such a focus gives further credence to the Registrant's primary intention....."

"The Complainant derives rental income from students directed through the Student Housing Site to secure accommodation in student residences owned directly or indirectly by the Complainant. As well, advertising revenue is generated from landlords advertising on the Student Housing Site directed at students and intended students of the University. The Complainant is clearly a competitor of the Registrant.

"It is obvious that the Domain Name Website is designed to compete directly with and to disrupt the business of the Complainant in offering rental accommodation to present and intended students of the University. The Panel finds that the Registrant registered the Domain Name primarily for the purpose of disrupting the business of one of its competitors, the Complainant, and that the Complainant has, therefore, demonstrated that the Registrant registered the Domain Name in bad faith."

The Panel finds that the **Registrant** has registered the Domain Name ryersonhousing.ca in bad faith.

Notwithstanding the above findings, paragraph 4.1 of the Policy affords the **Registrant** the opportunity of defeating the Complaint if the **Registrant** is able to prove, on the balance of probabilities, that it has a legitimate interest in the Domain Name.

Does the Registrant have a legitimate interest in the Domain Name ryersonhousing.ca?

Paragraph 4.1 of the Policy requires that the **Complainant** must provide *some evidence* that the Registrant does not have a legitimate interest in the Domain Name.

Paragraph 3.6 of the Policy provides that:

"The **Registrant** has a legitimate interest in the Domain Name if, and only if, before the receipt by the **Registrant** of notice from or on behalf of the **Complainant**, that a Complaint was submitted:

"(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 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;

"(f) The Domain Name was the geographical name of the location of the Registrant's non-commercial activity or place of business."

In paragraphs 3.6 (b), (c) and (d) "use" by the Registrant includes, but is not limited to, its use to identify a website.

The **Registrant** has not delivered a Response to the Complaint to establish any of the facts upon which legitimate use of the Domain Name can be inferred. The evidence provided by the **Complainant** is to be assessed against the requirements of article 3.6. While the Complaint was delivered some years after the **Registrant** registered the Domain Name, the **Complainant** had been using at least some of its trade-marks since 1977. The Complaint does not specify when each trade-mark was first used or registered prior to the Complaint.

Nonetheless, the **Registrant** clearly knew of the **Complainant's** trade-marks and its use thereof in providing housing services for students before it began its use of the Domain Name.

In the absence of any evidence by the **Registrant** to the contrary, I find that the Domain Name is not a trade-mark in which the **Registrant** has rights. The **Registrant** has not used the Domain Name in good faith prior to the filing of the Complaint. The **Registrant** has not met the test in 3.6(a)

The Domain Name is not clearly descriptive of wares, services, and certainly not the business of the **Registrant** or of the people involved or place of origin. The **Registrant** has not met the test in 3.6(b). The Domain Name, in fact, is descriptive of the **Complainant**.

There is absolutely no evidence to even suggest that any of the criteria in 3.6(c), (d) or (e) apply.

In light of the foregoing, coupled with the findings of the arbitration panels in the two University of Toronto decisions cited above on another Domain Name, and the identical practices of the **Registrant** in a very comparable fact situation, the Panel finds that the **Complainant** has provided some evidence that the **Registrant** has no legitimate interest in the Domain Name.

Although afforded reasonable opportunity to present evidence to rebut the evidence and presumptions arising from the evidence of the **Complainant**, the **Registrant** has chosen not to respond. It must therefore be bound by the findings of fact against it, particularly as to its bad faith and no legitimate use of the Domain Name.

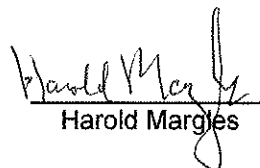
Decision

The Panel finds that the **Complainant** has satisfied the onus placed upon it by Paragraph 4.1 of the Policy, and that it is entitled to the remedy it seeks.

Order

The Panel Orders that the Domain Name < ryersonhousing.ca> be transferred to the **Complainant** forthwith.

Dated: October 20, 2011


Harold Margles

Single Member Panel