

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

Disputed Domain Name: homeassistanceprogram.ca (the "Domain Name")

Complainant: Ontario Power Authority

Registrant: The Urban Environment (Toronto) c.o.b.a. GreenSaver

Registrar: Intenic.ca Inc.

Panel: Hugues G. Richard

Service Provider: British Columbia International Commercial Arbitration
Centre (the "Provider")

BCICAC FILE No: DCA-1354-CIRA

DECISION

A. THE PARTIES

1. The Complainant, the Ontario Power Authority ("OPA") is a provincial statutory authority created by the Ontario legislation under the *Electricity Act*, S.O. 1998, Chapter 15, Schedule A (as amended by the *Electricity Restructuring Act, 2004*).
2. The Complainant promotes electricity conservation and the efficient use of electricity in the Province of Ontario. In doing so, the Complainant coordinates and funds the delivery of electricity conservation and demand management programs ("CDM Programs") through local distribution companies ("LDCs") in Ontario.
3. The Registrant, The Urban Environment (Toronto) c.o.b.a. GreenSaver, is a business with its principal place of business in Toronto, Canada. The Registrant's contact person is Vladan Veljovic, President and CEO.

B. DISPUTED DOMAIN NAME AND REGISTRAR

4. The disputed domain name that is the subject of this arbitration is homeassistanceprogram.ca (the "Domain Name").
5. The Registrar of the Domain Name is Intenic.ca Inc.
6. The Domain Name was registered on August 18, 2011.

C. PROCEDURAL HISTORY

7. On November 21, 2011, the Complainant filed its Complaint for decision in accordance with the CIRA Domain Name Dispute Resolution Policy (the Policy) and the CIRA Domain Name Dispute Resolution Rules (the Rules), as amended by the Canadian Internet Registration Authority (CIRA) on August 22, 2011.
8. In a letter dated November 24, 2011, the Provider confirmed compliance of the Complaint and commencement of the dispute resolution process.
9. Counsel for the Registrant had requested to extend the deadline to file a Response by 20 days, as the parties were discussing settlement. The Provider granted such an extension until January 4, 2012. The Registrant has not provided its Response.
10. On January 10, 2012, the Complainant requested to proceed with arbitration.
11. As permitted given the absence of a Response, the Complainant has elected under Rule 6.5 to convert from a panel of three to a single arbitrator.
12. The Provider appointed Hugues G. Richard (the "Panel") as sole arbitrator to decide this dispute.

D. PANELIST IMPARTIALITY AND INDEPENDENCE

13. As required by section 7 of the Rules, the Panel has submitted to the Provider a declaration of impartiality and independence in relation to this dispute.

E. EFFECT OF FAILURE OF REGISTRANT TO FILE A RESPONSE

14. As mentioned, the Registrant failed to file a compliant Response.
15. In the absence of such a Response, no information or submissions have been filed to have the Complaint dismissed.
16. Under section 5.8 of the Rules, "[i]f a Registrant does not submit a Response within the period for submission of a Response or any period extended [...] the Panel shall decide the Proceeding on the basis of the Complaint (...)".
17. As stated in *Browne & Co. Ltd. v. Bluebird Industries (October 22, 2002)*, *Resolution Canada, CIRA Dispute No 00002, p.7* and recently repeated in *Jan-Pro Canada Inc. v. Computerfest (January 27, 2011)*, *Resolution Canada, CIRA Dispute No 00162, para.12 nothing in the Rules can prevent the Panel to assess the integrity and credibility of the facts alleged by the Complainant*.
18. In the present case, the Panel sees no reason to question the Complainant's integrity and credibility.

F. REMEDY SOUGHT

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

G. APPLICABLE LAW

20. In accordance with Section 12.1 of the Rules, the Panel shall apply the laws of Ontario and the laws of Canada applicable therein.

H. JURISDICTION OVER THE PARTIES: ELIGIBILITY OF THE COMPLAINANT

21. Paragraph 1.4 of the Policy states that, at the time of submitting a complaint, the Complainant must satisfy the *Canadian Presence Requirements for Registrants* (Version 1.3) (the "CPR").
22. As stated by the CPR, in order to apply to CIRA for registration and to hold and maintain the registration of a dot-ca domain name, the applicant (i.e. the Complainant) has to establish its Canadian presence.
23. As alleged in the Complaint, the Complainant satisfies section 2(p) of the CPR as it is a "provincial or territorial Crown corporation, government agency or government entity".
24. The Complainant has therefore established its Canadian presence.

I. FACTUAL BACKGROUND BASED ON THE COMPLAINANT'S CONTENTIONS

25. The Complainant's contentions include the following.
26. The Complaint is based on the trade-marks HOME ASSISTANCE and HOME ASSISTANCE PROGRAM, both of which were adopted and used by the Complainant prior to the date of registration of the Domain Name in dispute.
27. The HOME ASSISTANCE mark was adopted and used by the Complainant as an official mark, prior to the date of the registration of the Domain Name in dispute, and the Registrar of Trade-Marks has subsequently given public notice of the adoption and use of this official mark pursuant to paragraph 9(1)(n)(iii) of the *Trade-marks Act* (Application number 0921329).
 - (a) **The Disputed Domain Name is confusingly similar to a mark in which the Complainant has Rights prior to the date of registration of the Disputed Domain Name, and continues to have such Rights.**

28. On May 10, 2011, the Complainant first used and displayed the mark HOME ASSISTANCE in advertising a new low income CDM Program initiative. By using and displaying the HOME ASSISTANCE mark in the advertisement of the Complainant's new program, the Complainant adopted and used the mark HOME ASSISTANCE as a trade-mark, within the meaning of section 4(2) of the *Trade-marks Act*.
29. On the same date, and consistently thereafter, the Complainant has used the HOME ASSISTANCE mark as part of the phrase "HOME ASSISTANCE PROGRAM" and has presented the low income CDM Program to the public as the "HOME ASSISTANCE PROGRAM".
30. On August 12, 2011, the Complainant used the HOME ASSISTANCE mark as part of the phrase "HOME ASSISTANCE PROGRAM" in a live seminar promoting the Complainant's services. The Registrant was in attendance at this promotional seminar. Six days later, the Registrant registered the Disputed Domain Name.
31. The Complainant contends that by reason of the above noted extensive and continuous use in Canada since May 10, 2011, it has acquired extensive goodwill and reputation in the marks HOME ASSISTANCE and HOME ASSISTANCE PROGRAM in association with the Complainant's services, well prior to the date of registration of the Disputed Domain Name.
32. The Complainant filed a trade-mark application, on September 2, 2011 for the trade-mark HOME ASSISTANCE PROGRAM, on the basis of its use of the mark since May 20, 2011 in association with the Complainant's services (Application number 1543357).
33. The Disputed Domain Name consists of the Complainant's HOME ASSISTANCE PROGRAM mark, and consists of or includes the exact word component of the Complainant's HOME ASSISTANCE trade-mark and official mark. The Complainant contends that the Disputed Domain Name is confusingly similar to the two marks, namely HOME ASSISTANCE and HOME ASSISTANCE PROGRAM, in which the Complainant has rights prior to the date of registration of the Disputed Domain Name, and continues to have such rights.

(b) The Registrant has no legitimate interest in the Disputed Domain Name

34. The Complainant's marks are not legitimately used by any entity other than the Complainant and its licensees. Furthermore, no licensee of the Complainant is permitted to authorize use of the Complainant's marks by any third party.
35. The Complainant has not authorized the Registrant to use or display the Complainant's marks. The Registrant has used the Domain Name to direct members of the public who may be interested in the Complainant's HOME

ASSISTANCE PROGRAM to a website operated by the Registrant, and away from the Complainant's website.

36. The Registrant has not used the Disputed Domain Name in Canada in good faith, in association with any non-commercial activity. To the contrary, the Registrant has used and continues to use the Disputed Domain Name in the course of its business, to direct members of the public who may be eligible for the Complainant's HOME ASSISTANCE PROGRAM to the Registrant, and away from the Complainant and its licensees.
37. The Disputed Domain Name also does not comprise the legal name of the Registrant, and is not a name, surname or other reference by which the Registrant has been commonly identified. Rather, the Disputed Domain Name consists of the mark adopted by the Complainant in respect of its new low income CDM Program services.
38. The Disputed Domain Name is not the geographical name of any non-commercial activity or place of business of the Registrant.
39. The Registrant does not have any legitimate interest in the Disputed Domain Name as described in paragraph 3.4 of the Policy.

(c) The Registrant registered the Domain Name in bad faith

40. Upon registering the Disputed Domain Name on August 18, 2011, the Registrant used the Disputed Domain Name to direct Internet users to a website operated by the Registrant, thereby directing members of the public who may be interested in the Complainant's HOME ASSISTANCE PROGRAM to the Registrant, and away from the Complainant.
41. The Registrant is clearly seeking to improperly impose itself between the Complainant and its licensees, and potential beneficiaries of the Complainant's HOME ASSISTANCE PROGRAM, by directing such potential beneficiaries to the Registrant's website and away from the website of the Complainant.
42. The Complainant contends that by registering the Disputed Domain Name and using it as set out in the Complaint, the Registrant has improperly and intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website, by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of the Registrant's website.
43. On September 22, 2011, the Complainant instructed its counsel to send a cease and desist letter to the Registrant. The Registrant's counsel provided a response dated October 11, 2011 that failed to respond to the Complainant's demand. On October 20, 2011, the Complainant's Vice-President of Conservation contacted

the Registrant directly to clarify to the Registrant that the Complainant was the only entity capable of authorizing use of the Complainant's marks.

44. Despite repeated requests from the Complainant, the Registrant has continued use of the Disputed Domain Name to direct the public to the Registrant's website. This is evidence of bad faith use of the Disputed Domain Name.
45. The Complainant submits that the Registrant has registered and used the Disputed Domain Name in bad faith, as described in paragraph 3.5 of the Policy.

J. OVERVIEW OF APPLICABLE LAW AND REQUIREMENTS

46. Paragraph 3.1 of the Policy sets out three criteria to be established by the Complainant:

- (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;

- (b) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4; and

- (c) the Registrant has registered the domain name in bad faith as described in paragraph 3.5.

47. The criteria above are not subject to the same burden of proof. According to paragraph 4.1 of the Policy, the Complainant must prove that the domain name is confusingly similar to the Complainant's Mark by a balance of probabilities. The same onus is expected in order to prove the bad faith of the Registrant. In the end, the Complainant must provide "some evidence" (which has been interpreted as "*prima facie*" evidence) that the Registrant has no legitimate interest in the Disputed Domain Name, thereafter the burden of proof shifts onto the Registrant to prove that it does have a legitimate interest.

K. DISCUSSION AND FINDINGS

48. The Panel will deal with each criteria of paragraph 3.1 of the Policy.

- (a) **Is the disputed domain name 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?**

49. Under CIRA Policy, it is not important that the trade-mark was not registered before the date of registration of the domain name. In *Acrobat Construction/Entreprise Management Inc. v. 1550507 Ontario Inc. (June 16, 2003)*, *Resolution Canada, CIRA Dispute No BAT-030303-001016*, p. 7 the Panel states that "[t]he

CIRA Policy not only contemplates protection for registered trade-marks, but also for unregistered trade-marks.

50. Moreover, on the basis of its use of the Mark since May 10, 2011, the Complainant filed a trade-mark application number 1543357 on September 2, 2011, for the trade-mark HOME ASSISTANCE PROGRAM. Also, based on adoption and use of the mark HOME ASSISTANCE since May 10, 2011, the Complainant requested from the Registrar the issuance of a notice under paragraph 9(1)(n)(iii) of the *Trade-marks Act*, application number 0921329.
51. Therefore, the Complainant was able to demonstrate that it had rights prior to the date of registration of the Domain Name.
52. As appears from the Complaint, the Complainant and its licensees continue to make public use of the trade-mark in the course of advertising and delivery of the Complainant's services to the public.
53. Consequently, the Complainant continues to have rights in its HOME ASSISTANCE PROGRAM mark and HOME ASSISTANCE official mark.
54. In determining whether a domain name is "Confusingly Similar", the Policy, under paragraph 3.3, provides detailed instructions for the Panel:

[T]he 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.
55. The Domain Name is homeassistanceprogram.ca; the Mark is HOME ASSISTANCE PROGRAM. In assessing if the Domain Name is "Confusingly Similar", the dot-ca suffix is ignored.
56. The Domain Name is identical to the Complainant's trade-mark HOME ASSISTANCE PROGRAM in appearance, sound and ideas suggested.
57. Therefore, the Domain Name is "Confusingly Similar" to a mark in which the Complainant had rights prior to August 18, 2011.
58. The Panel also finds that the Domain Name is confusingly similar to the mark HOME ASSISTANCE since the added word "Program" in the Domain Name is a generic word qualifying the HOME ASSISTANCE mark. It is a well established principle in evaluating the confusing similarity between a trade-mark and a domain name, that the addition of a generic word in the domain name does not diminish or alter confusing similarity with the trade-mark.

(b) Was the Registration of the domain name made in bad faith?

59. The Registrant was aware, prior to the date of registering the Domain Name, of the Complainant's significant use of the trade-mark HOME ASSISTANCE PROGRAM and HOME ASSISTANCE mark.
60. As appears of the Complaint, on August 12th, 2011, the Registrant was in attendance at a Complainant's live seminar. The Complainant used the HOME ASSISTANCE mark and the HOME ASSISTANCE PROGRAM trade-mark that day, promoting the Complainant's services. Six days after, the Registrant registered the disputed domain name.
61. In accordance with Section 5.8 of the Rules and as mentioned in paragraph 16 of this current decision, the Panel shall decide on the basis of the Complaint, since the Registrant has failed in providing a Response.
62. Furthermore, it has been ruled by the panel in *Lego Juris A/S v. James Carswell (May 7, 2010), Resolution Canada, CIRA Dispute No 00150, Tab 9, para.26* that: "*With regards to the criteria that the Registrant be a competitor of the Complainant, the Registrant's actions make it a competitor in that it is competing for web traffic that would otherwise go to the Complainant by utilising the Complainant's well known trade-marks in its domain name*".
63. In the present case, the Registrant improperly interposes itself between the Complainant and its licensees every time an Internet user is redirected to the Registrant's website and away from the Complainant's website.
64. Therefore, the Registrant's website is creating, according to paragraph 3.5 (5) of the Policy, "a likelihood of confusion with the Complainant's Marks as to the source, sponsorship, affiliation, or endorsement of the Registrant's website", as mentioned by the Complainant in its allegations.
65. It has been ruled by the panel in *Canadian Broadcasting Corporation v. William Quon (April 8, 2003), BCICAC, CIRA Dispute No DCA681-CIRA, p. 13*, that "[o]nce the Complainant has presented sufficient evidence to establish one of the situations in 3.7 [now replaced by 3.5], it is incumbent upon the Respondent to either respond or explain why its conduct should not be considered bad faith."
66. From this standpoint, it is hard to conclude that the Registrant has registered the Domain Name in good faith, since the Registrant has neither justified nor explained its conduct.
67. As a result of the foregoing, the Panel is of the opinion, in accordance with subparagraph 3.5 (d) of the Policy, that the Registrant has registered the Domain Name in bad faith.

(c) Does the Registrant have a legitimate interest in the domain name?

68. The last step of the test of paragraph 3.1 of the Policy is determining whether or not the Registrant has a legitimate interest in the domain name.
69. It is required, under subparagraph 4.1 (c) of the Policy, that the Complainant provides “some evidence” to show that the Registrant has no legitimate interest in the Domain Name.
70. The Complainant’s burden of proof is a light one, as it appears in the case *Spafinder, Inc. v. Ontario Spa Inc. (August 18, 2008), Resolution Canada, CIRA Dispute No 00108, para. 43*. In this case, the panel concluded: “*While this evidence might not have been sufficient to bear the burden required under the first two prongs of the CIRA test, the Panel interprets “some evidence” as being a lower burden for the question of “(no) legitimate interest”.*”
71. In the present case, the Panel finds that the Complainant has met its burden of proof.
72. However, under the Policy, even if the Complainant has provided sufficient evidence, the onus now shifts onto the Registrant to prove its legitimate interest in the domain name. Indeed, paragraph 4.1 *in fine* states that “*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 as described in paragraph 3.4.*”
73. Paragraph 3.4 of the Policy outlines circumstances demonstrating that the Registrant has a “legitimate interest”:

“For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in a domain name:

(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 registered 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 registered 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".

74. In paragraph 3.4(d) "use" by the Registrants includes, but is not limited to, use to identify a web site.

75. As mentioned, the Registrant has filed no Response.

76. Therefore, the Panel is satisfied with the statements of the Complainant. The Panel concludes that the Registrant has no legitimate interest in the Domain Name.

L- CONCLUSION AND ORDER

77. In conclusion, the Panel finds the Domain Name is confusingly similar to a mark in which the Complainant has rights. The Panel also finds that the Registrant has registered the Domain Name in bad faith. Finally, the Panel is satisfied that the Complainant has provided sufficient evidence to demonstrate that the Registrant did not have a legitimate interest in the Domain Name.

78. For these reasons, the Panel orders that the registration of the Domain Name be transferred to the Complainant by the Registrar Intenic.ca Inc.

Dated January 25, 2011



Hugues G. Richard
Sole Panelist