

CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY
COMPLAINT

Dispute Number: DCA - 1796 - CIRA
Domain Names: GMAILSUPPORT.CA
GMAILSUPPORTCANADA.CA
GMAILSUPPORTNUMBER.CA
Complainant: Google Inc.
Registrant: Catherine MacDonald
Panel: Elizabeth Cuddihy
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

The Parties

1. The Complainant is Google Inc. of 1600 Amphitheatre Parkway, Mountain View, California 94043, United States of America (the Complainant).
2. The Registrant is Catherine MacDonald, (the Registrant).

The Disputed Domain Names and Registrar

3. The Domain Names at issue are GMAILSUPPORT.CA, GMAILSUPPORTCANADA.CA, and GMAILSUPPORTNUMBER.CA, collectively (the Disputed Domain Names).
4. The Registrar for the Disputed Domain Names is Go Daddy Domains Canada, Inc.
5. The Disputed Domain Names were each registered on July 28, 2015.

Procedural History

6. The British Columbia International Commercial Arbitration Centre, (BCICAC) is a recognised service provider to the Domain Name Dispute Resolution Policy, (the Policy) and the Rules, (the Rules) of the Canadian Internet Registration Authority, (CIRA).

7. The Complainant filed a complaint dated June 18, 2016, (the Complaint) with the BCICAC seeking an order in accordance with the Policy and the Rules that the Disputed Domain Names be transferred to the Complainant.

8. BCICAC confirmed the Complaint to be in administrative compliance with the requirement of the Rules and the commencement of the dispute resolution process and forwarded copy of the Complaint to the Registrant in accordance with the Rules.

9. The Registrant did not provide a response within the timeframe required by the Rules.

10. The Complainant elected to convert to a single arbitrator in accordance with Rule 6.5 and the BCICAC nominated Elizabeth Cuddihy to act as sole arbitrator to determine the matter.

11. As prescribed by the Policy, the Panel has declared that it can act impartially and independently and that there are no circumstances known to the Panel which would prevent it from so doing.

12. As there was no Response to the Complaint, the Panel shall in accordance with Rule 5.8 decide the Proceeding on the basis of the Complaint.

Canadian Presence Requirements

13. In order for a Registrant to be permitted to apply for registration of, and to hold and maintain the registration of a dot ca domain name, the Canadian Presence Requirements for Registrants, (the Presence Requirements) require that the applicant meet at least one of the criteria listed as establishing a Canadian presence.

14. The Complainant is the owner of Canadian Trade-mark registration for GMAIL and GMAIL registered in the Canadian Intellectual Property Office (CIPO) on January 4, 2011 as registration Number TMA786269 and on September 24, 2013 as registration Number TMA861117 respectively, (the Complainant's Mark).

15. Accordingly, as the Complaint relates to Disputed Domain Names, all of which include the exact word component of a Mark registered in CIPO and owned by the Complainant, the Presence Requirements are satisfied.

The Position of the Parties

The Position of the Complainant

16. The Complainant is the owner of the Complainant's Mark registered in CIPO since January 4, 2011. The Disputed Domain Names, GMAILSUPPORT.CA, GMAILSUPPORTCANADA.CA and GMAILSUPPORTNUMBER.CA each contain the entire word of the Complainant's Mark except for the addition, in each of the Disputed Domain Names, of a

non-distinctive word; namely, SUPPORT, CANADA and NUMBER respectively and are confusingly similar to the Complainant's Mark. The Disputed Domain Names were each registered on July 28, 2015, well after the Complainant's Mark.

17. The Complainant is one of the premier, free, web-based email services in the world with over one billion monthly users as of February 2016. The Complainant's Marks which have been in use in Canada since as early as April 1, 2004 identify the Complainant's award-winning web-based email service. In addition the Complainant offers the GMAIL Help Center in connection with its web-based email since that date. As a result the Complainant's Marks have acquired a reputation and goodwill in Canada which are well-known.

18. The Complainant submits that the Disputed Domain Names are confusingly similar to the Complainant's Mark in which the Complainant had rights prior to the registration of the Disputed Domain Names and continues to have such rights, and further that the Registrant has no legitimate interest in the Disputed Domain Names and that the Disputed Domain Names, although the web page contains a disclaimer as to affiliation with the Complainant, were registered in bad faith and relies on subparagraphs (c) and (d) of paragraph 3.5 and the lead-in sentence of paragraph 3.5.

19. Accordingly, the Complainant requests that the Disputed Domain Names, GMAILSUPPORT.CA, GMAILSUPPORTCANADA.CA and GMAILSUPPORTNUMBER.CA be transferred to the Complainant.

The Position of the Registrant

20. The Registrant did not file a Response.

Analysis and Findings

21. The purpose of the Policy as stated in paragraph 3.3 is to provide a forum by which cases of bad faith registration of dot-ca domain names can be dealt with relatively inexpensively and quickly. The Policy does not apply to other types of differences between owners of trade-marks and Registrants of Domain names.

Relevant provisions of the Policy are provided below

22. Paragraph 4.1 of the Policy provides:

4.1 Onus. To succeed in a Proceeding, the Complainant must prove, on a balance of probabilities, that:

(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; and

(b) The Registrant has registered the domain name in bad faith as described in paragraph 3.5; And the Complainant must provide some evidence that:

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

Even if the Complainant proves (a) and (b) and provides some evidence of (c), 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.

23. Paragraph 3.2 of the Policy provides in part:

3.2 Mark. A "Mark" is

- (a) A trade-mark, including the word elements of a design mark, or a tradename 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;
- (b) A certification mark, including the word elements of a design mark that has been used in Canada by a person or that person's predecessor in title, for the purpose of distinguishing the wares or services that are of a defined standard;
- (c) A trade-mark, including the word elements of a design mark, that is registered in CIPO; or
- (d) The alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of which the Registrar of Trade-marks has given public notice of adoption and use pursuant to paragraph 9(1) (n) of the *Trade-marks Act* (Canada).

24. Paragraph 3.3 provides:

3.3 Confusingly Similar: In determining whether a domain name is "Confusingly Similar" to a Mark, the 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.

25. Paragraph 3.4 provides:

3.4 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 the evidence presented, shall demonstrate that the Registrant has a legitimate interest in the 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 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.

In paragraph 3.4(d) "use" by the Registrant includes, but is not limited to, use to identify a website.

26. Paragraph 3.5 provides:

3.5 Registration in Bad Faith. For the purposes of paragraph 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:

- (a) The Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant, or the licensor or licensee for valuable consideration in excess of the Registrant's actual costs in registering the domain name or acquiring the Registration;
- (b) The Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone in concert with one or more additional persons has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names;
- (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; or
- (d) The Registrant has intentionally attempted to attract, for commercial gain, internet users to the Registrant's website or other 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.

27. In summary, to succeed in a proceeding, the Complainant must prove on a balance of probabilities that:

1. The dot-ca domain name is confusingly similar to a Mark in which the Complainant had Rights prior to the registration of the Disputed Domain Names and continues to have such Rights;
2. The Registrant has registered the Disputed Domain Names in bad faith; and
3. The Complainant must provide some evidence that the Registrant has no legitimate interest in the Disputed domain Names.

Notwithstanding the evidence presented that the Registrant has no legitimate interest in the Disputed Domain Names, the Registrant will succeed if the Registrant proves on a balance of probabilities that he has a legitimate interest in the Disputed Domain Names.

Confusingly Similar to a Mark

28. Evidence shows that the Complainant is the owner of the Complainant's Mark, and the Complainant's Mark is registered in CIPO as No TMA786269 on January 4, 2011 and as No TMA861117 on September 24, 2013 respectively.

29. In accordance with paragraph 3.3 of the Policy, 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 mistaken for the Mark. In assessing the domain name, the dot-ca suffix is ignored. It is the narrow resemblance that is applied.

30. Each of the Disputed Domain Names incorporates the entire word of the Complainant's Mark, each with the addition of a non-distinctive word; namely, SUPPORT, CANADA, and NUMBER. Where the whole of the Complainant's Mark is included in a Disputed Domain Name there is no doubt that the Disputed Domain Names are likely to be mistaken for the Complainant's Mark. In fact the Panel is of the view that the addition of the non-distinctive word contributes to the Disputed Domain Names being mistaken for the Complainant's Mark. Accordingly for the reasons noted, GMAILSUPPORT.CA, GMAILSUPPORTCANADA.CA, and GMAILSUPPORTNUMBER.CA, the Disputed Domain Names are confusingly similar to the Complainant's Mark.

Rights in the Mark prior to the Disputed Domain Names registration and continuing Rights

31. GMAILSUPPORT.CA was registered July 28, 2015. GMAILSUPPORTCANADA.CA was registered July 28, 2015. GMAILSUPPORTNUMBER.CA was registered July 28, 2015.

32. As noted in paragraph 28 above, the Complainant owns Canadian registered trademarks issued on January 4, 2011 and September 24, 2013 respectively. In addition evidence shows that these Canadian registrations were based on the use of the Complainant's Marks in association with electronic mail services in Canada and elsewhere since as early as April 1 2004. Further evidence shows that the Complainant continues to use the Complainant's Marks in association with its services in Canada.

33. The Panel is satisfied that the Complainant's Mark was registered well before the registration of GMAILSUPPORT.CA, GMAILSUPPORTCANADA.CA and GMAILSUPPORTNUMBER.CA, (the Disputed Domain Names) and accordingly had Rights in the Complainant's Mark well before the registration of the Disputed Domain Names and the Complainant continues to have such Rights.

Were the Disputed Domain Names registered in bad faith?

34. The Complainant has relied on paragraph 3.5 (d) and (c) as well as the non-exhaustive nature of the circumstances as reflected in the introductory language of paragraph 3.5.

Bad Faith under 3.5(d)

35. Relying on subparagraph 3.5 (d), the Complainant submits that the Disputed Domain Names are confusingly similar to the Complainant's Mark. Accordingly, the average Internet user, upon seeing GMAILSUPPORT.CA or GMAILSUPPORTCANADA.CA or GMAILSUPPORTNUMBER.CA would immediately assume that the website is operated by or sponsored by the Complainant. The Complainant further submits that the Registrant's intent is to use keywords in association with its websites so that they are more likely to appear in Internet search engines results for "Gmail Support" and "Gmail Help". When this occurs, some consumers may mistakenly follow the links to the Registrant's websites, when in fact they are seeking the authentic Gmail support web page of the Complainant.

36. A cursory comparison of the Complainant's GMail support web page and that of the Registrant shows that the Registrant has copied the exact layout and format of the Complainant's web page leading an internet user to believe that the user has reached the legitimate support site. While the GMAILSUPPORTNUMBER.CA does not have the same formatting as the GMAILSUPPORT.CA and the GMAILSUPPORTCANADA.CA, it does have the same reference to "Gmail Support" and the contact phone number at the top of the webpage making it clearly confusing. Reference is made to *LF, LLC v. Sansome, Dispute No.00174* where such actions have been found to constitute bad faith.

37. The Complainant further submits that the Registrant's clear intent to confuse consumers and trade off of the Complainant's goodwill is not remedied by the fact that there is a fine print disclaimer half way down the webpage under the heading "Discover more about Gmail". The very top of the Registrant's infringing websites says "Gmail Help" and "Call Now: +64-09-0810265" which directs consumers away from reading the disclaimer hidden in the print below the misleading heading "Discover more about Gmail". Reference is made to *HMV (IP) Ltd. V. Matescu, 2012, Dispute No. 00185* where it was ruled that the existence of a disclaimer cannot by itself cure bad faith, when bad faith has been established by other factors.

38. The Complainant further submits that the Registrant is clearly seeking commercial gain in that the Gmail support services purporting to be provided from the websites are chargeable the whole without licence from the Complainant.

39. Based on the above, the Panel is satisfied that the Complainant has satisfied its burden of proof of bad faith on the part of the Registrant in accordance with subparagraph 3.5(d) of the Policy.

40. As the Panel is satisfied that the Complainant has proven at least one circumstance of bad faith, there is no need to assess or analyze the further submissions of bad faith on the part of the Registrant.

Legitimate Interest of the Registrant

41. Paragraph 3.4 of the Policy sets out a non-exhaustive list of criteria upon which the Panel may find, based on all the evidence, that the Registrant has a legitimate interest in the Disputed Domain Names. Paragraph 4.1 of the Policy places the onus on the Complainant to provide "some evidence" that the Registrant did not have a legitimate interest in the Disputed Domain Names. Although "some evidence" is not defined, it imposes, in the Panel's view, a lower threshold than on a balance of probabilities. The onus on the Complainant is to provide "some evidence" of a negative.

42. The Complainant has provided evidence in respect of the non-exhaustive list contained in paragraph 3.4 of the Policy that the Registrant has no legitimate interest in the Disputed Domain

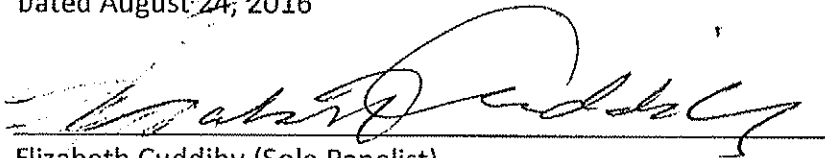
Names. The Registrant did not provide a Response and accordingly the Complainant's evidence is not refuted.

43. Based on the evidence provided which is not refuted by the Registrant, the Panel is satisfied that the Registrant has no legitimate interest in GMAILSUPPORT.CA, GMAILSUPPORTCANADA.CA and GMAILSUPPORTNUMBER.CA, (the Disputed Domain Names).

Decision

44. For the reasons set out herein, the Panel decides in favour of the Complainant and orders the transfer of the Disputed Domain Names; namely, GMAILSUPPORT.CA, GMAILSUPPORTCANADA.CA and GMAILSUPPORTNUMBER.CA to the Complainant forthwith.

Dated August 24, 2016



Elizabeth Cuddihy (Sole Panelist)