

**903IN THE MATTER OF A COMPLAINT PURSUANT TO THE CANADIAN INTERNET
REGISTRATION AUTHORITY DOMAIN NAME DISPUTE RESOLUTION POLICY**

Complainant:	TELUS Corporation
Complainant's counsel:	The GigaLaw Firm,
Registrant:	Unknown
Panel:	Barry C. Effler
Service Provider:	British Columbia International Commercial Arbitration Centre
BCICAC File Number:	DCA-1903-CIRA

DECISION

The Parties, Domain Names and Registrar

1. The Complainants are TELUS Corporation of Austin, Texas, United States and Indeed Canada Corp., of Halifax, Nova Scotia.
2. The Registrant is not known.
3. The Domain Name at issue in this dispute is **KOODOTEL.CA**.
4. The Registrar is RCOM Canada Corp.
5. The Domain Name was registered by the Registrant on May 27, 2017.

Procedural History

6. The procedural history of this matter was set out in a letter from the British Columbia International Commercial Arbitration Centre to the Panel herein dated August 24, 2017:

The British Columbia International Commercial Arbitration Centre (the "Centre") is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy of the Canadian Internet Registration Authority (CIRA).

The above named Complainant has filed a Complaint with respect to the above-referenced domain name in accordance with the CDRP on August 1, 2017.

The Complaint was reviewed and found to be compliant. By letter and email dated, August 1, 2017 BCICAC as Service Provider, so advised the parties and forwarded a copy of the Complaint to the Registrant via electronic transmission. Attempts to deliver the Complaint to the Registrant by courier have been unsuccessful.

The Complainant did not file any further submissions with respect to the issue of the Registrant's legitimate interest (or lack thereof) in the disputed domain name, as permitted by section 11.1 of the CIRA Domain Name Dispute Resolution Rules Version 1.4.

The Registrant has not provided a Response. 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.

The Centre hereby appoints you, Barry Effler LL.B., LL.M., C, Arb. (Fellow), as sole arbitrator in the above-referenced matter.

7. As required by paragraph 7.1 of the *Rules*, I have declared to BCICAC that I can act impartially and independently in this matter as there are no circumstances known to me which would prevent me from so acting.
8. I am not aware of any other legal proceeding or other arbitration in relation to the Domain Name that would give rise, under paragraph 13.2 of the *Rules*, to a need to stay or terminate the progress of this proceeding.
9. Reference to *Policy* herein means the *CIRA Domain Name Dispute Resolution Policy, version 1.3 (August 22, 2011)*. Reference to *Rules* herein means the *CIRA Domain Name Dispute Resolution Rules Version 1.5 (July 28, 2014)*.

Eligibility of Complainant

10. I have reviewed the material submitted by the Complainant and am satisfied that the Complainant is an eligible complainant under paragraph 1.4 of the *Policy*. TELUS Corporation is a British Columbia corporation which meets the Canadian presence requirement.

Relief Requested

11. The Complainant requests that the Domain Name in dispute be transferred from the Registrant to the Complainant.

Applicable Law

12. As directed by paragraph 12.1 of the Rules, I will render my decision based upon the rules and principles of the laws of Ontario, and the laws of Canada.

Background Facts

13. Background facts alleged by the Complainant and accepted by me as probative are quoted here from the Complaint: [edited to remove reference to exhibits provided with the Complaint for improved readability]:

ABOUT COMPLAINANT

1. [Complainant TELUS Corporation] is Canada's fastest-growing national telecommunications company, with \$12.8 billion of annual revenue and 12.7 million subscriber connections, including 8.6 million wireless subscribers, 1.7 million highspeed Internet subscribers, 1.4 million residential network access lines and more than 1.0 million TELUS TV customers. Complaint provides a wide range of communications products and services, including wireless, data, Internet protocol (IP), voice, television, entertainment and video, and is Canada's largest healthcare IT provider.
2. Complaint is a public company that is traded on the Toronto Stock Exchange (symbol: T) and the New York Stock Exchange (symbol: TU)....
5. Complainant's Koodo service is a national provider of postpaid and prepaid wireless voice and data services with a broad distribution network, including Complainant-owned stores, dealers and third-party electronics retailers....

7. Complainant is the registrant of the domain name <koodomobile.com>, which was created on February 20, 2007 and which Complainant uses in connection with a website advertising its Koodo service.

ABOUT REGISTRANT

1. Registrant registered the Disputed Domain Name on May 27, 2017.
 2. As shown in the Whois record for the Disputed Domain Name, the identity of the Registrant is not publicly available.
 3. Registrant is using the Disputed Domain Name in connection with a website that advertises itself as “KoodoTel” and that offers black-market mobile phone plans to customers.
 4. Registrant states that its “plans provide huge monthly discounts” for “only [a] few customers across Canada.” Registrant further states: “We make it available to anyone so everyone can enjoy the savings. These are not Corporate plans nor fraudulent in any way.... These plans are completely safe, secure and legal.”
 5. Despite Registrant’s assertions, Registrant’s activities are part of what has been described as a “black market” in cell phone plans, where third parties switch users’ phone plans to provinces in which less-expensive rates are available, even when the users are not entitled to those plans....
 6. Registrant’s activities make it appear as if Registrant is somehow affiliated or connected with Complainant (when, in fact, it is not) and that its service is somehow authorized or approved by Complainant (when, in fact, it is not).
14. The Complainant submitted evidence that it is the owner of 15 Canadian trade-marks. The trademark on which this Complaint is based is KOODO, which is protected by at least 15 registrations at CIPO owned by Complainant, including Reg. No. TMA711257 for the

mark KOODO (registered April 8, 2004) for use in connection with “wireless telecommunication services, namely providing text messaging services; ring tone selection services; graphic image services permitting users to download graphics from the Internet; picture and multimedia message services permitting the user to capture pictures, and send those content objects using their wireless communications devices; providing access to downloadable games and applications.”

Discussion and Findings

15. *Policy* paragraph 4.1 sets forth the onus on a complainant. It provides as follows:

4.1 **Onus.** *To succeed in the 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.

16. The *Policy* provides a definition of the term “Mark” (but as amended no longer defines Rights):

3.2 **Mark.** *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; ...

17. The Complainant TELUS Corporation established that it has rights in a trade-mark that was a "Mark" prior to the date on which the Domain Name was registered. The trade-marks were all registered significantly earlier than the May 27, 2017 date of registration of the Domain Name. (see paragraph 14, above for details.)
18. The relevant definition of "Mark" requires that a trade-mark be "used". The term "use" is no longer defined in the *Policy*. As indicated in the Background Facts set out above, the Complainant carries on business using the koodomobile.com website, among others, since at least February 20, 2007. The Complainant therefore meet this requirement.
19. The issue of the Confusingly Similar test for *Policy* paragraph 4.1 (a) is the most difficult test for the Complainants to meet. The word portion of the trade-mark does not exactly match the word portion of the Domain Name.
20. The Complainants' submission is that the name KOODOTEL.ca so nearly resembles Complainant's KOODO Marks in appearance, sound, or the ideas suggested, as to be likely to be mistaken for the KOODO Marks. The presence of the "dot.ca" suffix is irrelevant in a paragraph 3.1 (a) of the *Policy* analysis, and thus, is excluded from consideration for the purposes of determining whether the disputed Domain Name is confusingly similar to Complainant's trademarks. Here the relevant portion of the Domain Name, "KOODOTEL," is an intentional variation on the KOODO Mark and related marks like KOODOMOBILE. As such, the Complainant's mark and the disputed Domain Name remain similar in appearance and commercial impression. This intentional addition of the word fragment TEL does not negate the confusing similarity between the Complainant's mark and the disputed Domain Name. TEL in common parlance may be

referenced for telephone and for telecommunications, both of which areas are services under the KOODO Mark.

21. The addition of TEL to the Complainant's KOODO Mark does not give the domain name any distinctiveness. In fact, since the KOODO mark is well known in the telephone and telecommunications areas of business, the addition of TEL adds to the confusing similar nature of this domain name.
22. I am satisfied that the Domain Name is confusingly similar to the Complainant's Mark.
23. I am satisfied that the Complainant has established bad faith by the Registrant for the purposes of paragraphs 4.1 of the *Policy*. Paragraphs 3.5 of the *Policy* outlines circumstances which if found shall be evidence that the Registrant has registered a domain name in bad faith. The paragraph expressly states that this list is without limitation.

Paragraph 3.5 of the *Policy*:

3.5 Registration in Bad Faith. *For the purposes of paragraphs 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:*

(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.

24. Clause (d) requires the Complainant to show that the Registrant has "intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website". Complainant's evidence is that the Domain Name is being used to sell "black market" mobile phone services by operating a website under the KOODOTEL.ca name and including the phrase "Welcome to KoodoTel" on that website. TELUS Corporation under the KOODO mark and brand is in the business of providing mobile phone services. I am

satisfied that the Registrant is intentionally giving the impression that the internet customer has reached an official TELUS Corporation website.

25. The opening page of the KOODOTEL website does include a very faint disclaimer in grey type on a black background that states: "Koodo is a trademark owned by Telus Corporation. This website is in no way affiliated with Koodo or Telus." The font size is about 1 or 2 point.
26. The inclusion of a disclaimer that clearly is intended to be overlooked by customers does not help to eliminate the confusingly similar nature of the KOODOTEL website. This website is clearly intended to attract for commercial gain Internet users by creating a confusion over the KOODO mark and brand of mobile phone service. This meets the Bad Faith test in paragraph 3.5(d) of the *Policy*.
27. The Complainant has established evidence to meet the tests set out in Paragraph 4.1 (a) Confusing Similar domain name to a trademark of the Complainant and (b) evidence of bad faith by the Registrant.
28. The test in paragraph 4.1 of the Policy is

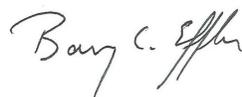
Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in paragraph 3.4.
29. The Complainant has met the onus to establish its case for the purposes of meeting the confusingly similar and bad faith requirements of paragraph 4.1 (a) and (b). The onus is on the Registrant to prove on a balance of probabilities that the Registrant has a legitimate interest in the Domain Name.
30. The Registrant has chosen to not participate in these proceedings and accordingly has not provided any evidence to the Panel in support of its position.

31. There is no evidence before this Panel that the Registrant has any business or personal project that would indicate a legitimate interest in the Domain Name.
32. There is no evidence that any of the circumstances outlined in paragraph 3.4 of the *Policy* regarding legitimate interest apply and I am satisfied that the Registrant has no legitimate interest in the Domain Name.
33. I am satisfied that the Complainant has met the onus on it to succeed, as required by paragraph 4.1 of the *Policy*.
34. Paragraph 4.3 of the *Policy* requires the Panel to decide if the Domain Name should be cancelled or transferred to the Complainant if the Panel decides in favour of the Complainant.
35. I am transferring the Domain Name as I have found intentional misuse of this Domain Name to masquerade as the word portion of the trade-mark owned by the Complainants.

Order

36. For the reasons set forth above, I order the Domain Name in issue to be transferred to the Complainant.

Dated: September 13, 2017



Barry C. Effler, LL.B., LL.M.
Sole Panellist