

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

**Complainant:** Steinbach Credit Union Limited  
**Registrant:** Arockias Inc.  
**Domain Name:** [steinbachcreditunion.ca](http://steinbachcreditunion.ca)  
**Registrar:** Go Daddy Domains Canada, Inc.  
**Arbitrator:** Craig R. Chiasson  
**Service Provider:** British Columbia International Commercial Arbitration Centre  
**BCICAC File:** DCA-2071-CIRA

**DECISION**

**I. THE PARTIES**

1. The Complainant is Steinbach Credit Union Limited ("**Steinbach**") of 333 Main Street, Steinbach, Manitoba, R5G 1B1. The Complainant's counsel is Kristél Kriel of the Regina office of MLT Aikins LLP.
2. The Registrant is Arockias Inc, with contact information provided by Canadian Internet Registration Authority ("CIRA") at [mailsimon10@gmail.com](mailto:mailsimon10@gmail.com).

**II. THE DOMAIN NAME AND REGISTRAR**

3. The Domain Name at issue is [steinbachcreditunion.ca](http://steinbachcreditunion.ca) (the "**Domain Name**").
4. The Registrar of the Domain Name is Go Daddy Domains Canada, Inc.
5. The Domain Name was registered on 8 January 2019.

**III. PROCEDURAL HISTORY**

6. This is a proceeding under the CIRA Domain Name Dispute Resolution Policy (the "**Policy**") and CIRA Dispute Resolution Rules (the "**Rules**").
7. The British Columbia International Commercial Arbitration Centre ("**BCICAC**") is a recognized Provider pursuant to the Policy.
8. The Complainant filed a complaint with respect to the Domain Name pursuant to the Policy on 5 March 2019 (the "**Complaint**").
9. In a letter dated 6 March 2019, the BCICAC confirmed compliance of the Complaint and commencement of the dispute resolution process.
10. The Complaint was delivered to the Registrant on 6 March 2019 and the Registrant was notified that any Response under the Rules was due not later than 26 March 2019. The Registrant confirmed receipt of the Complaint from the BCICAC on 7 March 2019.
11. The Registrant did not provide a Response under the Rules. As a result, the Complainant elected under Rule 6.5 to convert from a panel of three to a single arbitrator.
12. On 28 March 2019, the BCICAC appointed Craig R. Chiasson as sole arbitrator in the Complaint.

13. On 29 March 2019, I wrote to the parties confirming my appointment and receipt of the file, and advised that a decision would be rendered in this matter by 18 April 2019 in accordance with the Rules.

#### **IV. REMEDY SOUGHT**

14. The Complainant requests that the Domain Name, steinbachcreditunion.ca, be transferred to the Complainant.

#### **V. ELIGIBILITY OF COMPLAINANT**

15. The Arbitrator has reviewed all of the material submitted by the Complainant and is satisfied that the Complainant is an eligible Complainant under the Policy and Rules.

#### **VI. CANADIAN PRESENCE REQUIREMENT**

16. The Complainant is a credit union that was incorporated in the Province of Manitoba on 29 April 1941 and has been operating across Manitoba since that time.
17. The Complainant, as a Canadian company, meets the Canadian presence requirement.

#### **VII. FACTS**

18. The Complainant's submission set out the following facts, and attaches a number of documents relating them.
19. The Complainant is Manitoba's largest credit union and the 7th largest in Canada worth over \$5.453 billion in total assets and has over 75,000 members from a large geographic area.
20. The Complainant has been using the common law trademark "Steinbach Credit Union Limited" and the business name "Steinbach Credit Union" as permitted under *The Corporations Act* (Manitoba) since 29 April 1941.
21. The Complainant is the owner of and operates online using the domain names scu.mb.ca and scudirect.ca, which were registered on 22 October 2000 and 13 January 2010, respectively.
22. The Complainant has historic and well-known use of the common law trademark "Steinbach Credit Union" and has taken various steps to register and protect its Marks, in particular the trademark "SCU Steinbach Credit Union & Chain Design" which was filed on 2001-02-02 under application Serial No. 1091528 and registered on 2003-03-20 under Registration Serial No. TMA577,727 with the Canadian Intellectual Property Office (CIPO).
23. The Registrant has advertised the Domain Name for sale and on 21 February 2019 the Complainant received a communication through its website contact form offering the Domain Name for sale to the Complainant.
24. The domain name "steinbachcreditunion.com" has also been registered by an unknown registrant, which registration is currently the subject of an Internet Corporation for Assigned Names and Numbers (ICANN) complaint.
25. Subsequent to the Complaint being submitted, on 7 March 2019 the Registrant communicated to counsel for the Complainant stating, among other things, the Registrant's willingness to sell the Domain Name to the Complainant for a "reasonable price".

## VIII. POSITIONS OF THE PARTIES

### A. Complainant

26. The Complainant submits that: (i) the Domain Name is confusingly similar to and misappropriates the Complainant's Marks in which the Complainant had rights prior to the registration of the Domain Name and in which it continues to have rights; (ii) the Registrant has no legitimate interest in the Domain Name; and (iii) the Domain Name was registered in bad faith.

#### (i) Domain Name is Confusingly Similar and Complainant's Rights in the Marks Prior to the Domain Name Registration and Continuing Rights

27. Complainant says that the Domain Name is identical to the Complainant's Marks (in which the Complainant has had and continues to have rights) and that there is clearly a reasonable likelihood of confusion pursuant to both the Policy and subsections 6(5) of the *Trade-marks Act* (Canada), including that:

- (a) The Complainant's registered trademark has acquired a level of distinctiveness through continued use since at least as early as 2000 and that the business name and common law trademark "Steinbach Credit Union" has become well-known through the Complainant's use of the same for nearly 80 years;
- (b) The Domain Name is directly related to the credit union services offered by the Complainant;
- (c) The Domain Name is comprised exclusively of the Complainant's legal name and is similar in all ways (including appearance, sound and ideas) with the Complainant's Marks; and
- (d) There is evidence of confusion in the marketplace created by the Domain Name in the form of comments on social media (including Facebook) which show a clear, confusing connection between the Domain Name and the Complainant's business.

28. Based on the comments on social media thus far, the Complainant also says that "as an established and well-respected financial institution, the Complainant is concerned that the Domain Name could damage the goodwill and reputation that the Complainant has built up in the marketplace in association with its business." The Complaint attaches documents containing social media comments.

#### (ii) The Registrant Has No Legitimate Interest in the Domain Name

29. The Complainant says that although information about the Registrant is not available on the public WHOIS database, a number of points "strongly suggest" that the Registrant has no legitimate interest in the Domain Name:

- (a) The Complainant's existing rights in its Marks;
- (b) There is no evidence of any other Steinbach Credit Union operating in Canada or that the Registrant could have registered the Domain Name in association with any wares, services, businesses or non-commercial activity;
- (c) The Domain Name uses the legal name of the Complainant and refers to the geographical name of the location of the Complainant's place of business;
- (d) The Registrant is advertising the Domain Name for sale:

- On the website of the Domain Name, the Registrant appears to be asking a sale price of €12,999 for the Domain Name and that potential purchasers should act “before it’s too late”; and
  - The Complainant received an offer through its website contact form to buy the Domain Name for \$12,999 (the Complaint attaches documents relating to these allegations); and
- (e) There is not and has never been any commercial or business relationship between the Complainant and any other entity that would permit use of the Complainant’s Marks.

**(iii) The Domain Name Was Registered in Bad Faith**

30. The Complainant says that the Registrant’s registration of the Domain Name was in bad faith because:

- (a) The Registrant appears to have registered the Domain Name primarily for the purposes of selling it to the Complainant for an amount in excess of the Registrant’s actual costs;
- (b) The Registrant appears to have registered the Domain Name to prevent the Complainant from registering it and there is evidence that the Registrant’s conduct is part of a pattern of registering domain names for that purpose – the Complainant refers to the “steinbachcreditunion.com” registration by an unknown registrant, that is subject to an ICANN complaint; and
- (c) The Registrant’s registration of the Domain Name has had the effect (and can be seen to have been for the purpose) of disrupting the business of the Complainant.

31. The Complainant then refers to prior decisions from CIRA proceedings which it says support its request for the Domain Name to be transferred to the Complainant.

**B. Registrant**

32. On 7 March 2019, the Registrant acknowledged receipt of the Complaint and wrote to counsel for the Complainant, copying among others, the Provider, stating as follows:

This is in response to the email received from BCICAC Re: Complaint pursuant to the Canadian Internet Registration Authority (“CIRA”) Dispute Resolution Policy (the “Policy”) and Domain Name Dispute Resolution Rules (the “Rules”).

We have multiple domains which are on sale and one of which is [www.steinbachcreditunion.ca](http://www.steinbachcreditunion.ca)

We have multiple reasons for owning the domain name which could be explained to CIRA when and if required, but for a reasonable price we would sell the website name.

I understand from the email that your client Steinbach Credit Union Limited is interested in owning this domain.

It would be great if you could let me know, if your client is ready to settle this right away by buying the domain name for

a fair price and we are open to any fair offers. We can either sell it directly to you or through Premium Domains World.

Please respond to this by end of March 14 2019.

33. On 27 March 2019, the Registrant wrote to the BCICAC, with reference to the 7 March 2019 email as follows:

After the conversation we had two weeks back, I sent an email with an [sic] reply and did not get an hear back [sic] if they are willing to pay a reasonable price to own the domain.

34. On the same day, the Registrant also wrote to the BCICAC in response to being advised by the BCICAC that the matter would "proceed in accordance with the CIRA Rules":

Not sure why the rules are made in this way. If the business wants to own that domain, they should be bought it. Maybe the rules needs to be updated.

As it a loss for someone taking all the steps in buying a domain and then later some other business says it's related to theirs.

35. These communications from the Registrant do not constitute a Response in accordance with the Rules.

**IX. DISCUSSION AND FINDINGS**

36. There being no Response by the Registrant, this decision is rendered in accordance with Article 5.8 of the Rules, *i.e.*, on the basis of the Complaint. My decision is based on my review and consideration of the Complaint, including the prior decisions referred to in it and the documents attached to it, and on the communications referred to above provided to me by the BCICAC

37. As set out in paragraph 4.1 of the Policy, to succeed, 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 of the Policy;

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 of the Policy.

38. For the reasons that follow, I find that the Complainant has proved its case on a balance of probabilities.

**A. Confusingly Similar**

39. To succeed in meeting the onus under paragraph 4.1(a), the Complainant must demonstrate that it has had and continues to have rights in a Mark and that the Domain Name is "confusingly similar" to that Mark.

40. The definition of a "Mark" in the Policy includes the following:

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...

41. Pursuant to paragraph 3.3 of the Policy, the determination of whether the Domain Name is "Confusingly Similar" to a Mark requires that the Arbitrator "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".

42. The Complainant has had a long-standing common law trademark and business name of "Steinback Credit Union" and it has a registered Mark using the name "Steinbach Credit Union" namely the trademark SCU Steinbach Credit Union & Chain Design. The Complainant's rights existed before the Domain Name was registered and are continuing.

43. The Domain Name is confusingly similar. The Domain Name is comprised solely of the Complainant's business name which is also the substantive part of the Complainant's registered trademark, and the Domain Name is identical to the Complainant's common law trademark. I find that the Domain Name is likely "to be mistaken for the Marks".

44. Indeed, the documents submitted with the Complaint point to actual confusion in the marketplace, *e.g.*, one Facebook post says to the Complainant “fix your website” with reference to the Domain Name. Another one suggests that the Complainant’s website is for sale on the basis of the information found at the Domain Name’s website, *i.e.*, the marketplace appears to be mistaking the Domain Name for the Marks associated with the Complainant’s business.
45. I am satisfied that the Complainant has satisfied its burden of proof with respect to paragraph 4.1(a).
46. The Registrant has failed to provide any evidence to rebut this conclusion.

**B. Bad Faith Registration**

47. To succeed in meeting the onus under paragraph 4.1(b) of the Policy, the Complainant must demonstrate that any one of a list of circumstances set out in paragraph 3.5 of the Policy exists. Subparagraph 3.5(a) requires that the Complainant demonstrate that:
  - (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 ... for valuable consideration in excess of the Registrant’s actual costs in registering the domain name, or acquiring the Registration.
48. The Registrant advertised the Domain Name for sale on the Domain Name’s website and the Complainant was approached with an offer to purchase the Domain Name by Premium Domains World. The prices in both cases were in excess of the Registrant’s reasonable costs to register the Domain Name. The Registrant’s connection to, or control of, Premium Domains World with respect to the Registrant’s sale of the Domain Name to the Complainant was confirmed by the Registrant in its email to the Complainant’s counsel (copying the BCICAC) of 7 March 2019: “We can either sell [the Domain Name] directly to you or through Premium Domains World”.
49. Accordingly, I find that the Registrant has registered the Domain Name in bad faith.
50. Given my findings with respect to the circumstances described in paragraph 3.5(a) of the Policy required, I do not need to address whether the circumstances described in the other subsections of paragraph 3.5 of the Policy exist in this case.
51. I note, however, that I agree with the Complainant that there is evidence which suggests that the Registrant “alone or 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”, which would also amount to bad faith registration pursuant to paragraph 3.5(b) of the Policy. The evidence includes:
  - (a) the .com version of the Domain Name using the Complainant’s Mark, “steinbachcreditunion.com”, was registered by an unknown registrant, and is subject to an ICANN complaint;
  - (b) the Registrant’s confirmation in its email to the Complainant that it has “multiple domain names on sale”;
  - (c) the Registrant’s confirmation in its email to the Complainant that it “can either sell [the Domain Name] directly to you or through Premium Domains World” and in

another email that if the Complainant were to “pay a reasonable price” it could own the Domain Name; and

- (d) Premium Domains World appears to be in the business of buying and reselling domain names.
52. I am satisfied that the Complainant has satisfied its burden of proof with respect to paragraph 4.1(b).
53. The Registrant has failed to provide any evidence to rebut this conclusion.

**C. No Legitimate Interest in Domain Name**

54. To succeed in meeting the onus under paragraph 4.1(c) of the Policy, the Complainant must provide some evidence that the Registrant has no legitimate interest in the Domain Name. The circumstances which would demonstrate that the Registrant has a legitimate interest in the Domain Name are set out in paragraph 3.4 of the Policy as follows:

(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.

55. None of these circumstances exist in this case, in particular (a) to (d) require a showing of good faith and as stated above, I have determined that the Registrant’s registration of the Domain Name was in bad faith.
56. In addition, the Complainant has provided evidence of its rights the Marks and that the Registrant has no “Rights in the Marks”. The Complainant also asserts that it has not and has never been in any commercial or business relationship that would permit the Registrant or any other entity to use its trademarks, including for the Domain Name.

57. The Complainant referred to Dispute 00378 "Panavision.ca" in which the Panel stated at paragraph 38:

In cases where a domain name is an exact match for a brand owner's trademark, the initial assumption will be that a registrant does not have a legitimate interest in said domain absent agreement to the contrary between the parties. Nothing in the record displaces this assumption.

58. The same can be said in this case.
59. I am satisfied that the Complainant has satisfied its burden of proof with respect to paragraph 4.1(c).
60. The Registrant has failed to provide any evidence to rebut this conclusion or to submit a response that it has a legitimate interest in the Domain Name.

**X. ORDER**

61. I have concluded that the Complainant has met the requirements of paragraph 4.1 of the Policy.
62. Accordingly, pursuant to 4.3 of the Policy, I order that the registration of the domain name steinbachcreditunion.ca be transferred to the Complainant.

Dated 5 April 2019



**Craig R Chiasson**  
**Sole Arbitrator**

