

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

Dispute Number: DCA-2140-CIRA
Complainant: Assiniboine Credit Union Limited
Registrant: 9067-9622 Quebec Incorporated
Disputed Domain Names: acu.ca
Registrar: 10 Dollar Domain Names Inc.
Arbitrator: Mr. Claude Freeman, LL.M. (ADR), C. Med., C. Arb.
Service Provider British Columbia International Commercial Arbitration Centre (the “BCICAC”)

BCICAC FILE NUMBER: DCA-2140-CIRA

On September 3, 2019, the Complainant filed a complaint via electronic transmission against the Registrant, with the BCICAC, seeking that the Registrant’s registration of <acu.ca> be transferred to the Complainant.

In a letter dated September 4, 2019, the BCICAC confirmed that the Complainant was found to be in administrative compliance with the Policy and Rules. In accordance with the provisions of Rule 4.3, the BCICAC, as dispute resolution service provider, so advised the parties and forwarded a copy of the complaint to the Registrant via electronic transmission for their response. Given that the Complaint and related attachments were filed exclusively online, the BCICAC delivered the Complaint to the Registrant only via email. The Registrant has provided no response whatsoever to the BCICAC, with respect to 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 (August 22, 2011). The Registrant submitted a letter to the BCICAC on September 27th, 2019 (though the letter was dated September 30, 2019), after the expiry of the 20 day commencement of the proceeding, requesting a time extension to file a response, but provided no details for the basis of the request, nor the timeline under request. On October 1, 2019 the arbitrator requested that the Registrant provide (within a prescribed timeline) both the basis for the request and the timeline requested. This requested information was not provided to the arbitrator as was requested.

The Complainant did provide a timely response of opposition to the timeline extension request. After careful review of all the information provided, the timeline extension was denied.

Accordingly, in the absence of a response by the Registrant, the Registrant is not in administrative compliance in the following areas:

- 1) failure to nominate candidates from the providers list – per paragraph 5.2(c) of CDRP rules;
- 2) failure to provide a summary of and references to the relevant Canadian Law – per paragraph 5.2(f) of CDRP rules;

- 3) failure to provide a summary of and references to prior CIRA decisions that would be persuasive, and which apply to domain names registered under any other top-level domain – per paragraph 5.2(g) of CDRP rules; and
- 4) failure to conclude with the certification of the Registrant in form set out in Appendix “B”, followed by the signature of the Registrant or its authorized representative – per paragraph 5.2 (j) of CDRP rules.

As provided for by paragraph 5.6 of CDRP rules, the Registrant is permitted 10 days notice in order to remedy all instances of non-compliance.

As permitted under Rule 6.5, the Complainant elected to convert from a panel of three arbitrators to a single arbitrator, to render a decision in this matter. On September 30th, 2019, the BCICAC provided the appointment of the herein arbitration to the sole arbitrator, who accepted same.

Background/Facts

The Complainant (ASSINIBOINE CREDIT UNION LIMITED) – hereafter “ACU”), traces its’ history back to 1943, when the Complainant formed the credit union, and began providing credit union and related financial services in Manitoba. Today, the Complainant has 18 branches in Manitoba and reports assets valued at approximately \$4.7 billion for the year ended 2018, and net income of \$29.4 million. It has an estimated 115,000 members, and approximately 450 employees. It is ranked among the top 10 largest credit unions in Canada (except Quebec), and is well known across Canada in association with its services such as various chequing and savings accounts, retirement funds and plans, credit card and debit services, loans, mortgages, insurance and a host of other financial services. ACU is headquartered in Winnipeg, Manitoba. The Complainant is the owner of the Trademark “ACU”, which it registered in the Canadian Intellectual Property Office (“CIPO”) under registration number TMA 643,916 initially in July 2005 (used in Canada since August 1, 2001) by Apex Credit Union, which is the Complainant’s predecessor in title. The Trademark “ACU Anytime” was registered by the Complainant in October, 2013 for the purpose of registering and promoting their credit union services via mobile networks. Other Trademarks registered by the Complainant include “ACU & Design” registered in Canada July, 11, 2005, and “ACU Anytime and Design” registered in Canada October 3, 2013. The Trademark “ACU & Design” has been in use by the Complainant in Canada since August 1, 2001.

The Complainant displays their Trademarks on their website www.assiniboine.mb.ca. The Complainant also advertises through traditional media channels as well as social media in Canada.

The Registrant registered the Domain Name on November 11, 2002, more than a year after the Complainant began using the ACU and ACU & Design Trademarks.

The Domain Name does not link to any active website, nor has the Registrant established any theme, type of business, product or service through the Domain Name.

The Complainant has been, and is active on social media such as Facebook, and Instagram.

The Complainant has made significant investments over the years to advertise and promote the Complainant’s Marks (and services) through various forms of media, including the internet.

A Canadian Intellectual Property Office (CIPO) listing provided confirms that the Complainant’s Canadian Trademark Registrations, the first of which pre-dates (2001) the date of the registration of the Domain Name in 2002. The Complainant has regularly updated their trademark

registration information such that they continue to properly safeguard their brand/logo Trademarks. None of the registrations have been abandoned, cancelled or revoked. The Complainant appears to have done what is prudently and legally necessary to register and protect their brand in the jurisdictions in which they operate. Not doing so would be tantamount to corporate injury with regard to brand identification, marketability, and corporate survival.

The Complainant submits that their Trademark is a Mark as defined in paragraph 3.2(c) of the Policy, and it has been used in Canada for the purpose of distinguishing its Products from the goods, services or business from that of others for a long period of time which far pre-dates the date of registration of the Domain Name. The Complainant submits that this unto itself is sufficient to establish "rights" within the meaning of the Policy.

Accordingly, and based on their submissions, the Complainant submits that the registration and use of the domain name falls squarely within the scope of the Policy, and that paragraph 3.1 of the Policy, provides the Jurisdiction requiring the Registrant to submit to a proceeding, covering the tests that the domain name is: a) confusingly similar, b) that the Complainant has a legitimate interest, and c) that the domain name was registered in bad faith.

Past panels and arbitrators have held that there does not have to be any positive act on the part of the Respondent in order to not be held in "bad faith", though simply diverting web traffic to another site that would legitimately belong to another domain owner can be construed as simple hi-jacking of a legitimate trademark/domain.

The submissions provided by the Complainant therefore allege that the Registrant is not only in violation of its trademark but also registered the Domain name in bad faith against the Complainant.

As mentioned earlier, the Complainant has submitted copies of their trademark registrations, in support of their position on prior registration authority. One can also draw a conclusion (or very rational assumption), that a certain amount or percentage of the Complainant's sales income has been devoted (invested) to advertising, promotional and other business development enhancements of their corporate image, and that these financial resources have been carefully measured so as to maximize their return on investment for their advertising and public relations activities (including, but not limited to their website image). These advertising investments are a direct part of the Complainant's corporate growth strategy.

Sites/domain names blatantly infringing on or closely navigating near or to, previously and properly registered, highly visible and well-known domain names, trade-marks (which are clearly owned by those with a demonstrated, and prior, legitimate interest) do not enhance the credibility (for all the tests of legitimate interest/confusingly similar and bad faith) of those Registrants who feel they have some right or licence to freely infringe or compete at will. Attempt(s) by the service provider to notify the Registrant the Complaint was leading/proceeding to arbitration, were met with no response whatsoever.

The Complainant submits that the use of ("acu.ca") is, and can only be attributed to the Complainant, by virtue of its trade name, trademark, and other, prior history attesting to its use, related to its corporate name, and services. Anything to the contrary defies the rationale, reasoning, and legal basis for the filing of trademarks and trade names in the first place.

Anything else would, and will be confusing and distracting – with the results being that internet users/navigators and existing/potential customers will or could be confused with this, thus having a damaging effect to the public image of the Complainant.

In short, the Complainant submits that the disputed domain name is:

- 1) Confusingly similar
- 2) Registrant has no right or legitimate interest in the domain name, and
- 3) The domain name was registered in bad faith.

Reasons

As noted earlier, the Registrant was not only found administratively non-compliant, but has not put forth submissions of any kind by the period prescribed, to be reviewed in any detail. Accordingly, as per paragraph 4.1 of the CDRP policy, the onus is on the Complainant to prove on a balance of probabilities that the disputed domain names as registered by the Registrant are confusingly similar to that of the Complainant, and that they have been registered in bad faith. In addition, the Complainant is required under this paragraph to provide “some evidence” that the Registrant has no legitimate interest in the disputed domain name(s).

1. Confusingly Similar

The first test is whether a Disputed Domain Name is confusingly similar to a Complainant’s domain name.

The evidence before us shows that in Canada, the Complainant has been using the “ACU” Trademark in Canada since 1943, through its predecessor in title (Apex Credit Union).

In order to address the issue of confusion with the standard legal test prevailing in Canada, one can find that in determining whether or not there exists a reasonable likelihood of confusion between the trademarks at issue, the Registrant must have a regard to all the surrounding circumstances, including non-exhaustingly, those specifically enumerated in Subsection 6 (5) of the Canadian Trademarks Act.

- a) inherent distinctiveness of the trademarks, and the extent to which they have become known;
- b) length of time the trademarks have been in use;
- c) nature of wares, services or business;
- d) nature of the trade; and
- e) degree of resemblance between the trademarks in appearance or sound in the ideas suggested by them.

A generally accepted principle when applying the test of confusion is looking at the trademarks from the point of the unwary consumer – comparing similarities as opposed to differences. Can the internet user be easily misled by error or otherwise – and perhaps not even know? Could this confusion also impact not only on any and all other potential commercial relationships in existence or being sought with the Complainant? If this would impact on the commercial relationship sought with the Complainant by the internet users, then by logical corollary, this

confusion would impact (or possibly sabotage) the commercial relationships the Complainant has or is seeking with its' existing client base as well.

The Registrant's dot.ca domain is Confusingly Similar with a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights. Simply put, this assertion was held in BCICAC Case No. 00011, *Government of Canada v. David Bedford*.

The test for "Confusingly Similar" under Policy 3.4 is one of resemblance based on first impression and imperfect recollection. Given that the Trademarks are identical to the Domain Name, a person would inevitably mistake the Domain Name (without the .ca suffix) for the Trademarks. The Complainant submits a person knowing any of the Complainant's Trademarks would likely mistake the Domain Name "for the Complainant's corresponding mark based upon the appearance, sound or ideas suggested by the Mark".

Confusion under the *Trade-marks Act* occurs if the use over the trade-marks is likely to lead to the inference that the wares and services associated with the trade-marks are manufactured, sold or performed by the same person. That being said, even if the Registrant is not marketing/selling, manufacturing products or services of the like the Complainant provides, this can create an intellectual extrapolation.

In this case, the Registrant's registration of the Domain Name does not link to any website, and the registrant has not established any theme, type of business, product or service through the Domain Name. Nonetheless, through registration of the Domain Name, the Registrant has continued to hold the Domain Name captive, in spite of prior Trademark ownership by the Complainant.

Whether the Domain Name currently resolves or not to a website – without intervention by the Complainant, web confusion could very well likely occur in the future, in the event the Registrant decided to link the Domain Name to a website.

In that event, the unwary user of the web could be misled and think that the Registrant really is the Complainant – thus creating a false, "climate", thus impacting directly and negatively on the Complainant.

To this arbitrator, the domain name "acu.ca" is clearly a part of, (and similar in appearance, sound and in the ideas) with the "ACU" Trademark. There appears therefore, not only confusion with, but also misappropriation of the domain name, by the Registrant.

This Arbitrator concludes on this issue that the Complainant has met the onus of demonstrating that the disputed domain name is "confusingly similar" – as also supported in part by the "tests" applied by Subsection 6 (5) of the Canadian Trademarks Act ("a" to "e" above).

2. Legitimate Interest

A sufficient and initial proof brought on by the Complainant and pertaining to the Registrant's lack of legitimate interest forces the Registrant to rebut, explain or otherwise plead this issue, for which the Registrant has not done so. Failing to do so permits the Arbitrator to make a negative inference.

As described above, the Complainant must provide "some evidence" that the Registrant has no legitimate interest in the domain name(s), as described in Policy paragraph 4.1(c).

If the Complainant satisfies this evidentiary burden, the onus shifts to the Registrant to prove on a balance of probabilities that the Registrant has a legitimate interest in the challenged domain name, for which the Registrant has not done so.

Policy paragraph 3.4 sets forth an exhaustive list of criteria for determining whether a registrant has a legitimate interest in a domain name. It provides as follows:

The Registrant has a legitimate interest in a 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 has 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 place of 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 of 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 paragraphs 3.4 (b), (c), and (d) "use" by the Registrant includes, but is not limited to, use to identify a web site.

The legitimate interest criteria set forth in Policy paragraphs 3.4 (a), (b), (c), and (d) are satisfied only if the Registrant's use was in "good faith", a term which is not defined by the Policy. This Arbitrator notes that "good faith" as used in Policy paragraph 3.4 is not necessarily the opposite of "Bad Faith" as defined in Policy paragraph 3.5.

This Arbitrator has reviewed submissions by the Complainant and absent any submissions to not only debate the Complainant's positions, but to provide any historical proof of commercial activities, and fully eliminate confusion between the Registrant and the Complainant, leaves for invalidated support for the Registrant. Furthermore, the history covered by the Complainant's submissions themselves (registration, market and media notoriety et al), speaks volumes about the Complainant's right to their legitimate interest.

The domain name in dispute was registered by the Registrant on November 11, 2002, more than a year after the Complainant began using the ACU and ACU & Design Trademarks, and such,

without any prior or existing written contract, or other form of trade-mark use or licence with the Complainant, who has thus far demonstrated historical and prior Trademark Registration and legitimacy.

There is no known commercial or business relationship of any sort between the parties, permitting the use etc. of any of the Complainant's trade-marks or domain name by the Registrant, which could give rise to any confusion. Absent any rebuttal, this, unto itself demonstrates a clear, historical lack of interest in the disputed domain name by the Registrant.

The Registrant has not provided any justification whatsoever to justify its claim to a legitimate interest in the disputed domain name. The Domain Name is identical to a Mark in which the Complainant has rights, and for which the Registrant has demonstrated no legitimate interest.

3. Registration in Bad Faith

The following facts lead this Arbitrator to conclude that the disputed domain names were registered in bad faith:

- 1) The Registrant has, (after considerable historical and past name and product branding by the Complainant) registered (or acquired) a confusingly similar name and not responded to any Complainant requests/communications.
- 2) The registration of the disputed domain name infringes directly with the Complainant's trade-mark, and services. The disputed domain name is also embedded as a component of the Complainant's trade-mark.
- 3) The disputed name could have a confusingly and negative public image impact/confusion about affiliation or sponsorship with the complainant, not to mention the diversion of commercial activity away from the Complainant (if the Registrant were to so desire) - refer to *Bell Canada v. Archer Enterprises*, BCICAC Case No. 00038, and *Yamaha Corporation and Yamaha Motor Canada Inc. v. Jim Yoon*, BCICAC Case No. 00089.
- 4) The Registrant did not respond to BCICAC's timeline opportunity to submit a response to provide answers, rebuttals, support or evidence for the registration/acquisition of the disputed domain name.
- 5) Where the Registrant would seemingly have some justification for the registrations, the Registrant has to put forward some form of evidence to support their conduct, but has not done so. See *Musician's Friend Inc. v. Lowcost Domains Inc.*, CIRA Dispute No. 00074, citing in turn *Canadian Broadcasting Corporation/Société Radio-Canada*.

All of the foregoing is irreconcilable, and sustains the conclusion that there appears to be no compelling need (or right) for the Registrant to register and keep the disputed domain name. Had there been a sound business and legal reason to do so, supported by a business and contractual arrangement with the Complainant, it might be logical for the Registrant to counter-argue all of this. This does not in any way suggest that any counter-argument would be successful. Websites (not to mention trade-names) are to be seemingly purchased/registered, designed and maintained for some legitimate purpose, and certainly no sound reasons have been advanced by the Registrant to support their acquisition of the Disputed Domain Name. At the very least, any use made valid by any arguments that might be raised by the Registrant would (or might have been) less confusing at the outset, if they were to register a name which would not be confusing and

infringing on the Complainant's Trade-mark. Very importantly, the potential for future redirection/resolving of traffic from one web site ("acu.ca") to other sites competitive with ACU can only create a clear impression of causing confusion, disruption and hijacking of the Complainant's business. See *Intesa Sanpaolo S.p.A. v. Interex Corporate Registration Services Inc.*, CIRA Case No. 01130 (2013).

Balance of Probabilities

Even if a complainant has met the burdens of proof contained in Paragraph 4.1, a complaint will be dismissed if the registrant is able to prove on a balance of probabilities that the registrant has a legitimate interest in the disputed domain name. Again, such "legitimate interest" must meet one or more of the six tests as set out in Paragraph 3.4 and referred to above.

This balance of probabilities test in Paragraph 4.1 of the Policy deals with the situation where even though a Complainant has satisfied all of the burdens of proof contained in Paragraph 4.1, an Arbitrator believes that justice requires the Registrant to succeed. In finding against a Registrant, the Arbitrator is depriving that Registrant of a property interest. Such a decision should not be, and is not taken lightly. Therefore, even if an Arbitrator finds that a Complainant has satisfied the rather heavy burdens of proof placed on it by Paragraph 4.1, if the Arbitrator is satisfied that on a balance of probabilities the Registrant has a legitimate interest in the disputed Domain Name, the Arbitrator must find for the Registrant and dismiss the complaint. The Registrant has manifestly provided no argument of any sort, to either refute the allegations made by the Complainant or at the very least, support the registration (and any rights) in the disputed Domain Name.

In the case at hand, this Arbitrator is satisfied that on a balance of probabilities, and based upon the evidence before him, and rules, that the Registrant has no legitimate interest in the disputed Domain Name ("acu.ca")

Decision and Order

I find that the Complainant has succeeded in this proceeding, as initiated under the Policy. I therefore direct that the registration of ("acu.ca") be transferred to the Complainant: Assiniboine Credit Union Limited.

Dated this 16th day of October, 2019



Claude Freeman, LL.M. (ADR), C.Med., C.Arb.