

**IN THE MATTER OF A COMPLAINT MADE PURSUANT TO THE CANADIAN
INTERNET REGISTRATION AUTHORITY DOMAIN NAME DISPUTE
REGISTRATION RESOLUTION POLICY (v 1.3) AND ACCOMPANYING RULES**

Complainant: TELUS Corporation
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Scarborough, Ontario M1H 3J3
CANADA
(the “Complainant”)

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Email is the preferred method of
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Registrant: Zahid Contractor
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Brampton, ON L6V 2P6
Canada
Email: zahid.contractor@gmail.com
postmaster@thekoodoguys.ca
(the “Registrant”)

Disputed Domain Name: thekoodoguys.ca
(the “Domain Name”)

Registrar: Go Daddy Domains Canada, Inc.

Single Member Panel: R. John Rogers

Service Provider: British Columbia International Commercial Arbitration Centre (the “BCICAC”)

BCICAC File: DCA-2173CIRA

PROCEDURAL HISTORY

The BCICAC is a recognized service provider pursuant to the Domain Name Dispute Resolution Policy (v 1.3) (the “Policy”) and Rules (the “Rules”) of the Canadian Internet Registration Authority.

On December 9, 2019, the Complainant filed a complaint (the “Complaint”) with the BCICAC. In the Complaint, the Complainant seeks an order in accordance with the Policy and the Rules directing that the registration of the Domain Name be transferred from the Registrant to the Complainant.

The BCICAC determined the Complaint to be in administrative compliance with the requirements of Rule 4.2 and, by way of an emailed letter dated December 10, 2019 (the “Transmittal Letter”), forwarded a copy of the Complaint to the Registrant to serve as notice of the Complaint in accordance with Rules 2.1 and 4.3. The Transmittal Letter determined the date of the commencement of proceedings in accordance with Rule 4.4 to be December 10, 2019. The Transmittal Letter advised the Registrant that in accordance with the provisions of Rule 5, a Response to the Complaint was to be filed within 20 days of the date of commencement of proceedings, or December 30, 2019. Delivery of this email to the Registrant was confirmed by the BCICAC on December 10, 2019.

In an email response dated December 11, 2019, the Registrant emailed the BCICAC to inquire “What do i need to do against this complaint. I can delete this domain completely if needed but it does not allow currently via go daddy”.

In an email of the same date, the BCICAC replied that the reason that the Registrant could not access the Domain Name was that it had been locked by the registrar of the Domain Name until the Complaint had been dealt with. The BCICAC noted that if the Registrant wished to settle the matter that the Registrant should contact the Complainant’s counsel and provided the email for the Complainant’s counsel

By an email dated January 3, 2020, the BCICAC advised the parties that as the BCICAC had not received a Response to the Transmittal Letter by December 30, 2020 as required by Rule 5.1, that pursuant to Rule 6.5, the Complainant had the right to elect that the panel in this matter be converted from a three member panel to a single member panel.

In an email dated January 3, 2020, the Registrant claimed not to have received any previous emails from the BCICAC or the Complainant and requested from the BCICAC an extension of time in order to deal with the Complaint. In an email response to the Registrant on January 6, 2020, the BCICAC advised the Registrant that as the time for the Registrant to submit a response had expired, that the panel would be appointed and the Registrant under the Rules could send a written request to this panel together with the Registrant's response asking that the panel accept the late filed response from the Registrant. The BCICAC noted in this email that it was the sole discretion of this panel as to whether or not to grant the request for an extension of a time and accept the late filed response.

To date, the BCICAC has received no further communication from the Registrant and has not received from the Registrant a response to the Complaint.

The Complainant elected to proceed with a single member panel and the undersigned was appointed by the BCICAC as the Single Member Panel by letter dated January 8, 2020, copies of which letter were sent by email to both the Complainant and the Registrant. The undersigned has confirmed to the BCICAC that he can act impartially and independently as the Single Member Panel in this matter.

The undersigned determines that he has been properly appointed and constituted as the Single Member Panel to determine the Complaint in accordance with the Rules.

CANADIAN PRESENCE REQUIREMENTS

Section 1.4 of the Policy requires that in order to initiate the Complaint, the Complainant at the time of the initiation of the Complaint must satisfy the Canadian Presence Requirements for Registrants v 1.3 ("Presence Requirements") unless the Complaint relates to a trademark registered in the Canadian Intellectual Property Office and the Complainant is the owner of that trademark.

As the Complainant is a corporation formed under the laws of the Province of British Columbia, in accordance with the provisions of paragraph 2.4 of the Presence Requirements, the Complainant has satisfied the Presence Requirements.

ALL TECHNICAL REQUIREMENTS MET

Based upon the information provided by the BCICAC and the Complainant, I find that all technical requirements for the prosecution of this proceeding have been met.

FACTS OFFERED BY THE COMPLAINANT

The facts in the Complaint might be summarized as follows:

1. The Complainant is Canada's fastest growing national telecommunications company, with \$144 billion of annual revenue and 13.4 million subscriber connections, offering a wide range of communications solutions to customers and businesses, including wireless, data, IP,

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voice, television, entertainment, video, and home security and automation. In addition, it is the leading provider of healthcare technology solutions in Canada.

2. The Complainant is a public company whose shares are traded on the Toronto Stock Exchange and the New York Stock Exchange.
3. The Complainant offers a service called “Koodo”, which service has by J.D. Power been ranked highest in purchase experience satisfaction in Canada for three consecutive years.
4. This service is offered through the use of the domain name <koodomobile.com> which was created on February 20, 2007 and the use of 21 registrations at the Canadian Intellectual Property Office (collectively the “KODOO Trademark”), including the trademark KODOO, Reg. No. TMA711257, which trademark was registered on 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; pictures 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”.
5. In addition to the KODOO Trademark, the Complainant offers its services through the El Tabador design mark (the “El Tabador Mark”) which was registered on February 21, 2013 for use in connection with same services to those offered under the KODOO Trademark.
6. The Registrant registered the Domain Name on August 29, 2019.
7. The Registrant is using the Domain Name in connection with a website (the “Registrant’s Website”) that offers to “help you save over \$800 a year on your Cellphone Bill by setting you up with Canada’s Fastest 4G LTE Data Speed and Cheapest Plans in this market”.
8. The Registrant displays one or more of the KODOO Trademark and the El Tabador Mark prominently throughout the Registrant’s Website.
9. The 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 Canadian provinces in which less expensive rates are available, even when the users are not entitled to those phone plans.
10. The Registrant’s activities, especially the ample use of the KODOO Trademark and the El Tabador Mark on the Registrant’s Website, make it appear as if the Registrant is somehow affiliated or connected with the Complainant or that its service offerings are somehow authorized or approved by the Complainant, when neither is the case.

FACTS OFFERED BY THE REGISTRANT

As was noted above, the Registrant has not filed a Response.

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REMEDIES SOUGHT

The Complainant seeks an order from the Panel in accordance with paragraph 4.3 of the Policy instructing the Registrar of the Domain Name to transfer the Domain Name to the Complainant.

THE POLICY

The purpose of the Policy as stated in paragraph 1.1 of the Policy is to provide a forum in which cases of bad faith registration of .ca domain names can be dealt with relatively inexpensively and quickly.

Paragraph 4.1 of the Policy puts the onus on the Complainant to demonstrate this “bad faith registration” by proving on a balance of probabilities that:

1. One or more of the trademark registrations comprising the KOODO Trademark qualify as a “Mark” as defined in paragraph 3.2 of the Policy;
2. the Complainant had “Rights” in the KOODO Trademark prior to the date of registration of the Domain Name and continues to have “Rights” in the KOODO Trademark,
3. the Domain Name is “Confusingly Similar” to one or more of the registrations comprising the KOODO Trademark as the concept of “Confusingly Similar” is defined in paragraph 3.3 of the Policy;
4. the Registrant has no “legitimate interest” in the Domain Name as the concept of “legitimate interest” is defined in paragraph 3.4 of the Policy; and
5. the Registrant has registered the Domain Name in “bad faith” in accordance with the definition of “bad faith” contained in paragraph 3.5 of the Policy.

If the Complainant is unable to satisfy this onus, bad faith registration is not demonstrated and the Complaint fails.

MARK

In the matter at hand, the relevant portions of paragraph 3.2 of the Policy states that for the purpose of the Policy a “Mark” is:

- (a) a trademark, 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;

Since April 8, 2004 the Complainant has used at least one of the trademark registrations included in the KOODO Trademark in Canada to distinguish its provision of wares, services or business from another provider of similar wares, services or business.

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This use by the Complainant of the KOODO Trademark commenced well before the registration of the Domain Name on August 29, 2019.

The Complainant continues to so use the KOODO Trademark.

I find that the Complainant has established that the one or more of the trademark registrations included in the KOODO Trademark collectively qualify as a “Mark” for the purposes of paragraph 3.2(a) of the Policy.

RIGHTS

Paragraph 3.1 of the Policy requires that the Complainant have “Rights” in the KOODO Trademark. Unfortunately, the term “Rights” is not defined in the Policy.

However, given the evidence before me of the Complainant’s ownership and use of the KOODO Trademark in Canada, I find that the Complainant has “Rights” in the KOODO Trademark for the purpose of paragraph 3.1 of the Policy.

CONFUSINGLY SIMILAR

The Policy in paragraph 3.3 provides that the Domain Name will be found to be “Confusingly Similar” to the KOODO Trademark only if the Domain Name so nearly resembles one or more of the trademark registrations included in the KOODO Trademark in appearance, sound or the ideas suggested by the KOODO Trademark as likely to be mistaken for one or more of the registrations included in the KOODO Trademark.

As paragraph 1.2 of the Policy defines the Domain Name for the purpose of this proceeding to exclude the .ca suffix, the portion of the Domain Name consisting of “thekoodoguys” is the portion relevant for consideration.

The Domain Name consists of the word “koodo” together with the words “the” and “guys”. The word “koodo” alone is contained in the KOODO Trademark owned by the Complainant.

To satisfy the onus placed upon it by the Policy, the Complainant must demonstrate that the “thekoodoguys” portion of the Domain Name so nearly resembles the KOODO Trademark in appearance, sound or the ideas suggested by the KOODO Trademark as likely to be mistaken for the KOODO Trademark.

In the matter at hand, this Confusingly Similar test is the most difficult portion of the Complainant’s Complaint to establish.

The Complainant faced a similar challenge in *Telus Corporation v. Unknown* CDRP Case No. DCA-1903-CIRA (BCICAC) where the domain name in dispute was <koodotel.ca> and a

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registrant offered phone plans in the black market similar to those offered by the Registrant as alleged by the Complainant in the Complaint. In this earlier matter, in finding for the complainant, the panel noted that the word fragment TEL “in common parlance may be referenced for telephone and telecommunications, both of which areas are services under the KOODO Mark.” In addition, the panel noted that the addition of TEL to the KOODO Mark did not give the disputed domain name any distinctiveness.

Similarly, in *L’Oreal SA & L’Oreal Canada Inc. v. Interex Corporate Registration Services Inc.* DCA-1478-CIRA, the panel considered whether or not the domain name <myloreal.ca> was confusingly similar to the trademark L’OREAL. The panel noted that “it is a well established principle that a domain name that wholly incorporates a Mark, in particular one as famous as the one in this case, will be found to be confusingly similar to the Mark despite the fact that the domain name may also contain a descriptive or generic term”.

The test to be applied when considering confusing similarity is one of first impression and imperfect recollection. Will a person as a matter of first impression, knowing only the complainant’s corresponding marks, and having imperfect recollection of these marks, likely mistake the disputed domain name for the complainant’s marks based upon the appearance, sound or the idea suggested by the mark?

In addition, it is one thing for a disputed domain name to include without an ulterior motive a portion of the complainant’s mark and another where it is clear that the party owning and using the disputed domain name is doing so in what appears to be a deliberate attempt to encourage a party coming across the disputed domain name to mistakenly assume that it is within the purview of and authorized by the complainant.

In the matter at hand, I find, similar to the situation in the *L’Oreal* decision, that the Koodo Trademark is sufficiently famous that for the Domain Name to wholly incorporate the word “koodo” satisfies the confusingly similar requirement of paragraph 3.3 despite the fact that the Domain Name contains the article “the” and the noun “guys”.

However, more compelling is what appears to be the deliberate attempt by the Respondent to create a first impression for a visitor to the Respondent’s Website, the website to which the Domain Name resolves, that the Complainant has somehow authorized the use of the Koodo Trademark by the Respondent. The free use in this website of one or more of the Koodo Trademark and the El Tabador Mark confirms this appearance and clearly constitutes an attempt by the Registrant to confuse visitors to the Respondent’s Website into believing that the Registrant’s service offering is somehow authorized or approved by the Complainant.

I therefore find that the Complainant has satisfied the onus placed upon it by paragraph 3.3 of the Policy and has demonstrated that the Domain Name so nearly resembles the Complainant’s Koodo Trademark in appearance, sound or the ideas suggested by the Complainant’s Koodo Trademark as to be likely to be mistaken for the Complainant’s Koodo Trademark.

NO LEGITIMATE INTEREST

Paragraph 4.1 of the Policy requires that to succeed in the Complaint, the Complainant must provide some evidence that the Registrant has no legitimate interest in the Domain Name as the concept of “legitimate interest” is provided for in paragraph 3.4 of the Policy.

Paragraph 3.4 of the Policy provides that the Registrant has a legitimate interest in a domain name if:

- 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 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 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 web site.

It is to be noted that in paragraphs 3.4(a), (b), (c), and (d), there is a requirement that the Registrant use the Domain Name “in good faith”. The evidence before me, as referenced above, is not that the Registrant used the Domain Name in good faith, but rather to the contrary, that the Registrant used the Domain Names to disrupt and trade upon the goodwill of the Complainant without a license to do so. Therefore, the provisions of these paragraphs do not apply.

The Registrant’s name is not included in the Domain Name nor is there a geographical reference so the provisions of paragraphs 3.4(e) and 3.4(f) do not apply.

I therefore find that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name.

BAD FAITH

Under paragraph 3.5 of the Policy, the Registrant will be considered to have registered the Domain Name in bad faith if, and only if, the Complainant can demonstrate that the Registrant in effecting the registration of the Domain Name was motivated by any one of the four general intentions set out in paragraph 3.5.

Of these intentions, the form of intention contained in paragraph 3.5(d) is the one most applicable to the matter at hand.

Paragraph 3.5(d) provides as follows:

- (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.

Based upon the evidence before me and my finding of the deliberate attempt by the Respondent to create a first impression for a visitor to the Registrant's Website, the website to which the Domain Name resolves, that the Complainant has somehow authorized the use of the Koodo Trademark by the Respondent, I find that the Complainant has satisfied the provisions of paragraph 3.5 (d) of the Policy by establishing that that the Registrant has intentionally attempted to attract for commercial gain traffic to the Registrant's Website, by creating a likelihood of confusion with the Complainant's Koodo Trademark as to the source, sponsorship, affiliation, or endorsement of the Registrant's Website.

DECISION

As was above set out, paragraph 4.1 of the Policy provides that to be successful in the Complaint the Complainant has the onus of proving on a balance of probabilities three specific items and of providing some evidence that the Registrant has no legitimate interest in the Domain Name.

I find that the Complainant has satisfied this onus with respect to all three of these items by demonstrating that the Koodo Trademark qualifies as a Mark in accordance with paragraph 3.2 of the Policy; that the Domain Name is Confusingly Similar to the Complainant's Koodo Trademark; and that the Registrant has registered the Domain Name in bad faith in accordance with the provisions of paragraph 3.5 of the Policy.

I have also found that the Complainant has shown some evidence that the Registrant does not have a legitimate interest in the Domain Name in accordance with the provisions of paragraph 3.4 of the Policy.

I therefore find that the Complainant has satisfied the onus placed upon it by paragraph 4.1 of the Policy and is entitled to the remedy sought by it.

ORDER

I order that the domain name <thekoodoguys.ca> be transferred to the Complainant.

Dated: January 17, 2020.

“R. John Rogers”

R. John Rogers
Single Member Panel