



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE

DECISION

CIIDRC case number: 15597-CDRP

Decision date: July 12, 2021

Panelist(s): Steven M. Levy, Esq.

Domain(s) in Dispute: fidelityglobal.ca

Complainant: 483A Bay Street Holdings LP

Registrant: Erick Pothold

Registrar: Go Get Canada Domain Registrar Ltd. / Namecheap, Inc.

1. PROCEDURAL HISTORY

The Canadian International Dispute Resolution Centre ("CIIDRC") 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 ("CIRA"). On June 1, 2021, the Complainant filed a Complaint with the CIIDRC seeking an order in accordance with the Policy and the Rules directing that the registration of the disputed domain name <fidelityglobal.ca> (the "Domain Name") be transferred to the Complainant. The Complainant has elected for a Panel consisting of a single member. The CIRA was notified of this proceeding on June 3, 2021 and, on the same date, the CIRA transmitted by email to the CIIDRC its verification response confirming the Registrant's identity. On June 3, 2021, the CIIDRC, as Service Provider, confirmed compliance of the Complaint and commencement of the dispute resolution process.

The CIIDRC determined the Complaint to be in administrative compliance with the requirements of Paragraph 3.2 of the Rules and, pursuant to Resolution Rule 4.4, the CIIDRC notified the Registrant of this administrative proceeding and forwarded a Notice with login information and a link to the Complaint to the Registrant via email and by express post on June 3, 2021. The Registrant failed to file its response by the due date of June 23, 2021 and has not done so as of this writing.

By letter dated June 6, 2021 the undersigned was appointed by the CIIDRC as the single Panelist in this matter pursuant to Paragraph 6 of the Rules. The undersigned has confirmed to the CIIDRC that he can act impartially and independently as the Panel in this matter.

The Panel determines that it has been properly appointed and constituted to determine the Complaint in accordance with the Rules.

2. REMEDY SOUGHT

The Complainant seeks an order from the Panel in accordance with Paragraph 4 of the Policy and Paragraph 12 of the Rules that the Domain Name be transferred to the Complainant.

3. FACTUAL AND LEGAL GROUNDS

Complainant is a subsidiary of FIL Limited and is one of the largest and best-known investment fund managers in the world. It offers investors in Canada and elsewhere a full range of domestic and international mutual funds. FIL Limited was formerly named and traded as Fidelity International Limited but changed its name in 2008. Complainant has invested substantially in advertising and promoting its services under the FIDELITY mark including its operation of the website fidliety.ca. It also owns numerous and currently subsisting Canadian trademark registrations for the marks FIDELITY, FIDELITY INVESTMENTS, FIDELITY INVESTMENTS CANADA, and others (the "FIDELITY marks"), the earliest of which was issued in 1991.

Phishing activities have been carried out by one or more individuals posing as the Complainant using email addresses that incorporate the Domain Name (which, according to the Whois record, was registered on January 14, 2021). Attached to the phishing emails is a brochure which impersonates the Complainant and purports to offer consumers a range of investment bonds. The brochure also includes an Application form in which recipients are invited to fill in a range of sensitive information including their name, address, Social Insurance number, bank account numbers, and the like. The Complainant has been informed that members of the Canadian public have already been defrauded as a result of these activities and warning alerts regarding this specific scam have been published by Complainant and the Canadian Securities Administrators ("CSA").

Complainant contacted the concerned Registrar for the Domain Name to report these phishing activities on 18 May 2021. The Registrar subsequently suspended all services relating to the Domain Name on 24 May 2021.

4. POSITION OF THE PARTIES

- Complainant: Complainant submits that the purpose for registering and using the Domain Name is to impersonate Complainant and attract potential customers attempting to access FIDELITY investment services or the website at <fidliety.ca> by creating a likelihood of confusion with the FIDELITY marks as to the source, sponsorship, affiliation, or endorsement of the emails and brochure with which the Domain Name is used. Complainant seeks an order from the Panel in accordance with Paragraph 4 of the Policy and Paragraph 12 of the Rules that the Domain Name be transferred to the Complainant.
- Respondent: No Response has been filed.

5. DISCUSSION AND FINDINGS

A. Is the Domain Name confusingly similar to a Mark in which the Complainant has Rights per Policy 4.1(a)?

Paragraph 3.2 of the Policy states that for the purpose of the Policy 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;

Complainant asserts that it began trading in Canada over 30 years ago has used the FIDLIETY marks to distinguish its provision of financial services from other providers in its field of business. This use by the Complainant of the FIDELITY marks commenced well before the registration of the Domain Name.

The Panel finds that the Complainant has established that each of the FIDLIETY marks qualifies as a "Mark" for the purposes of Paragraph 3.2(a) of the Policy.

Next, Paragraph 3.1(a) of the Policy requires that the Complainant has "Rights" in its Mark. Unfortunately, the term "Rights" is not defined in the Policy. However, Complainant has submitted evidence of its ownership and use of the FIDELITY marks in Canada in the form of website screenshots from the Canadian Intellectual Property Office ("CIPO") as well as from the fidelity.ca website. From this, the Panel concludes that Complainant has demonstrated its ownership of "Rights" in the FIDELITY marks for the purpose of Paragraph 3.2(a) of the Policy.

As for Policy Paragraph 4.1(a), this provides that "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". 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 "fidelityglobal" is the portion of the Domain Name relevant for consideration here.

The Domain Name consists of the word "fidelity" together with the generic term "global". To satisfy the burden placed upon it by the Policy, Complainant must demonstrate that the addition of the word "global" to the FIDELTY mark in the Domain Name is not sufficient to distinguish it from the mark to the point that the Domain Name does not so nearly resemble the mark in appearance, sound or the ideas suggested by the mark as likely to be mistaken for the mark.

In the present case the Panel finds that the Mark is sufficiently known in Canada as reflecting the goodwill of Complainant who is engaged in the business of providing investment fund services. The Panel is, therefore, satisfied that the Complainant has met the Confusingly Similar requirement of Paragraph 4.1(a) despite the addition of the word "global" to the mark. Further, the Panel finds that the addition of the word "global" in the Domain Name increases the likelihood that a person will associate the Domain Name with the mark given the fact that Complainant's business is international in scope.

The Panel finds, upon a balance of probabilities, that Complainant has met its burden under Paragraph 4.1(a) of the Policy and has demonstrated that the fidelityglobal.ca Domain Name so nearly resembles the FIDELITY marks in appearance, sound or the ideas suggested by the marks as to be likely to be mistaken for the marks.

B. Did the Registrant register the domain name in bad faith per Policy 4.1(b)?

Paragraph 4.1(b) of the Policy is satisfied when Complainant demonstrates, by a balance of probabilities, that the Registrant registered the Domain Name in bad faith. The Policy provides four examples of bad faith scenarios in Paragraph 3.5. Of these, the most applicable to the current situation is contained in Paragraph 3.5(d) which 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.

Use of a domain name to perpetuate fraud, e.g., via a phishing scheme, has been held to demonstrate bad faith under an analogous standard set out in the Uniform Dispute Resolution Policy ("UDRP"). See, e.g., *Traxys North America LLC v. Joao Mota / Joao Mota Inc.*, 14373-URDP (CIIDRC Jan. 16, 2021) (bad faith found where "the Domain Name [tarxys.com] is being used to send fraudulent 'spear phishing' emails targeting customers or associates of the Complainant in an attempt to steal money from the Complainant or its customer."); *Nasdaq, Inc. v. kai mi*, FA 1949499 (FORUM July 1, 2021) ("Respondent uses the disputed domain name [nasdaqsvip.com for] a phishing scheme. Specifically, Complainant provides evidence of messages from Respondent in which Respondent refers to the disputed domain name and makes misrepresentations while posing as Complainant, including referring to the customer's account as a 'NASDAQ account'). While no screenshot of the fidelityglobal.ca website is provided, Complainant here does submit into evidence a copy of a brochure which was attached to a phishing email sent to one of Complainant's prospective customers. The brochure copies certain elements of Complainant's fidelity.ca website, mentions Complainant's correct and legitimate postal address, but lists certain email addresses, all of which use the Domain Name. These include info@fidelityglobal.ca, clarity@fidelityglobal.ca, and ombudsman@fidelityglobal.ca. Copies of a May 2021 Investor Alert published by both Complainant and the CSA are also provided. It appears to this Panel that the brochure, the application form contained therein, and the aforementioned email addresses are all designed to impersonate Complainant and gather highly sensitive information from its current and prospective customers for nefarious purposes.

Based upon the evidence before it the Panel finds that Complainant has satisfied the provisions of Paragraphs 3.5(d) and 4.1(b) of the Policy by establishing that that Registrant has intentionally attempted to attract, for commercial gain, traffic to the email addresses used by Respondent and associated with the Domain Name, by creating a likelihood of confusion with Complainant's marks as to the source, sponsorship, affiliation, or endorsement of such online email locations.

C. Does the Registrant have no Legitimate Interest in the Domain Name per Policy 4.1(c)?

Paragraph 4.1(c) of the Policy states that "[t]o succeed in the Proceeding, the Complainant must prove, on a balance of probabilities, that:"

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

Paragraph 3.4 provides seven examples of scenarios, any one of which, if supported by evidence, could lead to the conclusion that Respondent has a legitimate interest in the Domain Name. These are 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 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.

It is to be noted that, in Paragraphs 3.4(a), (b), (c), and (d), there is a requirement that the Registrants act "in good faith". There is no evidence before the Panel that the Registrant used the Domain Name and its associated email addresses in good faith. To the contrary, there is strong evidence that the Respondent used the Domain Name to trade upon the goodwill of the Complainant and its FIDELITY marks in furtherance of an email phishing scheme designed to gather sensitive personal information from Complainant's current and prospective customers, likely to be used for theft and other cyber crimes. Therefore, the Panel finds that the provisions of these four sub-paragraphs do not apply here.

Further, the Registrant's name is listed as "Erick Pothold" and so it would appear not to be included in the Domain Name. Also, the geographical reference to the word "global" in the Domain Name does not identify the location of any non-commercial or legitimately operated place of business by Respondent. As such, the provisions of Paragraphs 3.4(e) and 3.4(f) do not apply. The Panel finds that Complainant has provided adequate evidence that the Registrant has no legitimate interest in the Domain Name and Respondent has chosen not to participate in these proceedings or to otherwise explain its actions in any way.

In light of the submitted evidence, the Panel finds that Registrant has no legitimate interest in the Domain Name.

6. DECISION

The Panel finds that the Complainant has satisfied its burden of proof with respect to all three elements of Paragraph 4.1 of the Policy. For the reasons stated above, and in accordance with Paragraph 4 of the Policy and Paragraph 12 of the Rules, the Panel orders that the domain name <fidelityglobal.ca> be transferred to the Complainant.

Panel:
Steven M. Levy, Esq.

