

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

**Complainant:** University of Waterloo

**Registrant:** Brian J. Buchanan

**Domain Name:** UWATERLO.CA

**Registrar:** Namespro Solutions Inc.

**Panelist:** David Wotherspoon

**CIIDRC case number:** 13943-CDRP

**DECISION**

**THE PARTIES**

1. The Complainant is University of Waterloo (the “**University**”), a Canadian university located in Waterloo, Ontario, Canada, and is registered under the *University of Waterloo Act* in Ontario, with an address in this proceeding of Suite 300, 15 – 23<sup>rd</sup> Street East, Saskatoon, SK, S7K 0H6, Canada.
2. The University was founded on July 1, 1957.
3. The Registrant, Brian J. Buchanan, is an individual with a mailing address of 9 Ontario Street, Smith, Alberta, T0G 2B0, Canada.

**THE DOMAIN NAME AND REGISTRAR**

4. The Domain Name at issue is UWATERLO.CA (the “**Domain Name**”).
5. The Registrar of the Domain Name is Namespro Solutions Inc.
6. The Domain Name was registered on August 10, 2005.

**PROCEDURAL HISTORY**

7. The Canadian International Internet Dispute Resolution Centre (“**CIIDRC**”) is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (the “**Policy**”) of CIRA.
8. This is a proceeding under the Policy, in accordance with the CIRA Dispute Resolution Rules (the “**Rules**”).
9. The Complainant filed a complaint with respect to the Domain Name pursuant to the Policy on October 9, 2020 (the “**Complaint**”).
10. In a letter dated October 13, 2020, the CIIDRC confirmed compliance of the Complaint and commencement of the dispute resolution process.
11. The Complaint was delivered to the Registrant on October 13, 2020 and the Registrant was informed that the deadline to submit a Response was November 2, 2020.

12. The Registrant did not provide a Response within the timeframe required by the Rules. As a result, the Complainant elected under Rule 6.5 to convert from a panel of three to a single arbitrator. Subsequently, the CIIDRC appointed David Wotherspoon as sole arbitrator in the Complaint on November 4, 2020.
13. The Arbitrator is obliged to issue a decision on or prior to November 25, 2020.

#### **ELIGIBILITY OF COMPLAINANT**

14. 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.

#### **CANADIAN PRESENCE REQUIREMENT**

15. The Complainant is the owner of the following Prohibited Marks, which are registered in the Canadian Intellectual Property Office (“**CIPO**”):
  - a) UWATERLOO, registered on December 14, 2011 (the “**UWATERLOO Mark**”);
  - b) UNIVERSITY OF WATERLOO, registered on July 13, 1983 (the “**UNIVERSITY OF WATERLOO Mark**”); and
  - c) WATERLOO, registered on April 15, 2015(collectively, the “**Waterloo Marks**”).
16. The Complainant, as the owner of the Waterloo Marks registered in Canada, meets the Canadian presence requirements.

#### **FACTS**

17. The Complainant provides the following facts in support of its Complaint.
18. The Complainant began operating under the names “UWATERLOO” and “UNIVERSITY OF WATERLOO” as early as 1957 when the University was founded.
19. The Complainant has built up a strong reputation and significant goodwill in the Waterloo Marks due to the Complainant’s extensive use and advertisement of the Waterloo Marks and its name in Canada.
20. Although registering the UWATERLOO Mark on December 14, 2011, the Complainant has been using the UWATERLOO Mark since at least as early as September 20, 2000 in connection with the University through online advertising.
21. The Complainant has not licensed or otherwise authorized the Registrant to register or use any of the Waterloo Marks as a domain name or for any other purpose.

## **THE POSITION OF THE PARTIES**

### **The position of the Complainant**

22. The Complainant submits that the Domain Name is confusingly similar to the UWATERLOO Mark, that the Registrant has no legitimate interest in the Domain Name, and that the Domain Name was registered in bad faith.

#### **The Domain Name is confusingly similar to the UWATERLOO Mark**

23. "WATERLOO" is the predominant element in each of the Waterloo Marks.
24. The Complainant and its students, faculty, and staff refer to the Complainant as "UWATERLOO" and "U" has become associated with "university".
25. The Domain Name is confusingly similar to the Complainant's UWATERLOO Mark because the Domain Name is almost identical to the UWATERLOO Mark in appearance and sound such that it is likely to be mistaken for the UWATERLOO Mark.
26. A person, as a matter of first impression, knowing the UWATERLOO Mark, and having an imperfect recollection of it, would likely mistake the Domain Name for the UWATERLOO Mark.
27. The Domain Name is almost identical to the UWATERLOO Mark and merely excludes the second "o" in "WATERLOO". The predominant portion of the UWATERLOO Mark is reproduced almost identically in the Domain Name.

#### **Rights in the Marks prior to the Domain Name Registration and continuing rights**

28. The Complainant registered the UNIVERSITY OF WATERLOO Mark with CIPO on July 13, 1983, well before the Domain Name was registered.
29. The Complainant has been using the UWATERLOO Mark in Canada since at least September 20, 2000, when the uwaterloo.ca domain name was registered and the Complainant began using the UWATERLOO Mark in online advertising.
30. The Complainant submits that its use of the UWATERLOO Mark prior to registration with CIPO establishes common law rights in the UWATERLOO Mark.
31. The Complainant says that it had rights in the UWATERLOO Mark and the UNIVERSITY OF WATERLOO Mark prior to the date of registration of the Domain Name on August 10, 2005. Moreover, the Complainant continues to have such rights in the marks.

#### **The Registrant has no legitimate interest in the Domain Name**

32. The Complainant says that Registrant has no legitimate interest in the Domain Name for the following reasons:
- a) the Complainant has never assigned, granted, licensed, sold, transferred, or in any way authorized the Registrant to use any of the Waterloo Marks;

- b) the Registrant is not using the Domain Name in connection with an active website, but rather to re-direct Internet users to “pay-per-click” websites;
  - c) the Domain Name was not registered in good faith in association with any goods, services, or business in Canada;
  - d) the “UWATERLOO” name is not the generic name of any goods, services, or business in Canada;
  - e) the Registrant has not used the “UWATERLOO” name for non-commercial activity;
  - f) the “UWATERLOO” name is not a reference by which the Registrant is commonly known; and
  - g) the “UWATERLOO” name is not a geographical name of the location of the Registrant’s non-commercial activity or its place of business.
33. As a result of the Complainant’s long-term and continuous ownership and use of the Waterloo Marks, name, and domain name for or incorporating “UWATERLOO” in connection with the University, the Complainant has built a strong reputation and significant goodwill in the Waterloo Marks and names. An objective bystander, including a person accessing the Domain Name, would mistakenly assume that the “UWATERLOO” of the Domain Name was invoking, associated with, or licensed by the “WATERLOO” of the Waterloo Marks, and therefore by the Complainant.
34. The Complainant has never given the Registrant permission to use the Waterloo Marks or names in any manner.
35. Moreover, the Registrant has not used the Domain Name in any manner that would otherwise demonstrate any rights or legitimate interests in using the Domain Name.

**The Domain Name was registered in bad faith**

36. The Registrant’s registration of the Domain Name was in bad faith for the following reasons:
- a) the Registrant registered and is using the Domain Name for the purpose of disrupting the business of the Complainant;
  - b) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Domain Name, creating a likelihood of confusion with the Waterloo Marks as to the source of the Registrant’s website; and
  - c) the Registrant’s actual or constructive knowledge of the Waterloo Marks and the Complainant’s presence and reputation in Canada.
37. Moreover, the Complainant submits that in or around March 2019, the Registrant registered several SSL certificates in association with the Domain Name. Internet users commonly recognize the presence of an SSL certificate as an indication that a website is trustworthy and secure. The Registrant’s registration of such SSL certificates is evidenced through publicly accessible certificate transparency logs.

38. The Registrant has obtained SSL certificates in association with sub-domains of the Domain Name, namely edu.uwaterlo.ca, mail.edu.waterlo.ca, and owa.edu.uwaterlo.ca (the “**Sub-Domains**”). Each of the Sub-Domains mimics sub-domains used by the Complainant.

39. Moreover, in or around September 2019, several members of the University community received an e-mail including a link purporting to be the Domain Name.

#### **The position of the Registrant**

40. The Registrant has failed to file a Response.

#### **DISCUSSION AND FINDINGS**

41. To succeed in the proceeding, the Complainant must prove, on a balance of probabilities, that:

- a) the 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.

42. The Complainant must also provide some evidence that the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.4 of the Policy.

#### **Rights in the mark prior to the Domain Name registration and continuing rights**

43. The Complainant registered the UNIVERSITY OF WATERLOO Mark in Canada with CIPO on July 13, 1983.

44. Although the UWATERLOO Mark was not registered with CIPO until December 14, 2011, the Complainant provided evidence establishing that it used the UWATERLOO Mark as early as September 20, 2000 in online advertising. I am satisfied that the Complainant’s use of the UWATERLOO Mark prior to its CIPO registration on December 14, 2011 establishes common law rights in the UWATERLOO Mark beginning on September 20, 2000.

45. The Registrant registered the Domain Name on August 10, 2005. I am therefore satisfied that the Complainant had rights in the UNIVERSITY OF WATERLOO Mark and the UWATERLOO Mark before the registration of the Domain Name. As the evidence demonstrates that the Complainant’s rights remain in force, the Complainant continues to have such rights.

#### **Confusingly similar**

46. To succeed in satisfying paragraph 4.1(a) of the Policy, the Complainant must show that it has rights in the any or all of the Waterloo Marks and that the Domain Name is confusingly similar to one or all of the Waterloo Marks.

47. A “Mark” includes:

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 purposes

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.

48. Pursuant to paragraph 3.3 of the Policy, in determining whether a domain name is confusingly similar to a Mark, the Arbitrator shall only consider whether the domain name resembles the Mark in appearance sound, or ideas suggested by the Mark as to be likely to be mistaken for the Mark.
49. Where the domain name incorporates the whole of the Mark, confusion will be established (see *Omer De Serres Inc. v. 10 Dollar Domain Names Inc.*, DCA-1005-CIRA).
50. I am satisfied that the Domain Name incorporates essentially the entire UWATERLOO Mark. The fact that Domain Name merely excludes the second "o" in "WATERLOO" is sufficient to support a finding of confusing similarity.
51. An Internet user who has only an imperfect recollection of the UWATERLOO Mark would easily mistake the Domain Name as being somehow affiliated to or owned by the Complainant (see *Canadian Broadcasting Corporation/Société Radio-Canada v. William Quon*, BCICAC Case No. 00006).
52. I am satisfied that the Complainant has established, on a balance of probabilities, that the Domain Name is confusingly similar to the UWATERLOO Mark. The Registrant has failed to provide any evidence to rebut this conclusion.

#### **Bad faith registration**

53. Pursuant to paragraph 3.5 of the Policy, any of the following circumstances will be evidence that a Registrant has registered a domain name in bad faith:
  - 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, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration;
  - b) the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided 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;
  - c) the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided 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; or
  - 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.

54. As noted in paragraph 3.5 of the Policy, the list provided above is not exhaustive and the Arbitrator must have regard for the totality of the circumstances (see *BASF SE v. Jean-Yves Collin*, DCA-1999-CIRA).
55. A Registrant's use of a domain name that is confusingly similar to the Complainant's registered marks for the purpose of directing Internet traffic to pay-per-click websites can amount to bad faith under paragraph 3.5(d) of the Policy (see *American Express Marketing and Development Corp. v. Nameshield Inc. c/o Daniel Mullen*, CDRP Dispute No. 249).
56. The evidence establishes that the Registrant solely uses the Domain Name, which is confusingly similar to the UWATERLOO Mark, to re-direct Internet users to pay-per-click websites for commercial gain. I am satisfied that the Registrant has registered the Domain Name in bad faith under paragraph 3.5(d) of the Policy.
57. Moreover, the Complainant has provided evidence that the Registrant has obtained SSL authentication certificates in association with the Sub-Domains, which are similar to sub-domains used by the Complainant.
58. I find that the Complainant has established, on a balance of probabilities, that the Registrant has registered the Domain Name in bad faith. The Registrant has failed to provide any evidence to rebut this conclusion.

#### **No legitimate interest in the Domain Name**

59. Pursuant to paragraph 3.4 of the Policy, any of the following circumstances will demonstrate that the Registrant has a legitimate interest in a domain name:
  - 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.

60. In subsection (d), "use" by the Registrant includes, but is not limited to, use to identify a website.

61. The Complainant has provided the following evidence to establish that the Registrant has no legitimate interest in the Domain Name:

- a) the Complainant has never assigned, granted, licenced, sold, transferred or in any way authorized the Registrant to use the UWATERLOO Mark, or any of the Waterloo Marks;
- b) the Registrant is not using the Domain Name in connection with an active website;
- c) the Domain Name was not registered in good faith in association with any wares, services or business that is clearly descriptive;
- d) neither the names "UNIVERSITY OF WATERLOO" nor "UWATERLOO" are the generic names of any goods, services, or business in Canada;
- e) the Registrant has not used the "UWATERLO" name for non-commercial activity;
- f) the "UWATERLO" name is not a reference by which the Registrant is commonly known; and
- g) the "UWATERLO" name is not a geographical name of the location of the Registrant's non-commercial activity or its place of business.

62. I am satisfied that the Complainant has provided evidence that the Registrant has no legitimate interest in the Domain Name. The Registrant has failed to provide any evidence to rebut this conclusion or submit a Response at all.

## ORDER

63. I conclude that the Complainant has met the requirements of paragraph 4.1 of the Policy.

64. Accordingly, and pursuant to paragraph 4.3 of the Policy, I order that the Registrar, Namespro Solutions Inc., transfer the registration of the Domain Name *uwaterlo.ca* to the Complainant.

Dated: November 25, 2020



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**David Wotherspoon**  
Sole Arbitrator