

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

Domain Names: albertagovernment.ca

Complainant: Government of Alberta, on behalf of Her Majesty the Queen in Right of Canada

Registrant: Advantico Internet Solutions Inc.

Registrar: Internic.ca Corp.

Panellist(s): Edward C. Chiasson

Service Provider: British Columbia International Commercial Arbitration Centre

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

ADMINISTRATIVE DECISION

Her Majesty the Queen in Right of Alberta v. Advantico Internet Solutions Inc.

BCICAC File No. DCA-689 CIRA

1. The Parties

The Complainant is Her Majesty the Queen in right of the Province of Alberta, Edmonton, Alberta, Canada.

The Respondent is Advantico Internet Solutions Inc., Barrie, Ontario, Canada.

2. The Domain Name and Registrar

The disputed domain name <albertagovernment.ca> is registered with Internic.ca Corp.

3. Procedural History

The British Columbia International Commercial Arbitration Centre (BCICAC) is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy of the Canadian Internet Registration Authority (CIRA).

On February 25, 2003, the Complainant filed a Complaint pursuant to the CDRP and the Rules.

By way of letter dated February 26, 2003, the BCICAC as Service Provider confirmed compliance of the Complaint and commencement of the dispute resolution process.

Attempts by the BCICAC to communicate with the Respondent using the addresses and contact information provided have not been confirmed as successful. Courier attempts to deliver documents have been returned as undeliverable. E-mail messages to the addresses provided have been returned as undeliverable. The phone number provided is out of service. Fax transmission has been completed, but with indication that the recipient is not the named Registrant. The Respondent has not provided a Response.

As permitted given the absence of a Response, the Complainant elected under Rule 6.5 to convert from a panel of three to a single panellist.

On March 24, 2003, the BCICAC appointed David M. Robinson, as sole panellist in the above-referenced matter.

By way of Procedural Order 2, dated April 9, 2003, and as permitted under Paragraph 11.1 of the Rules, Mr. Robinson requested additional submissions by the complainant. The complainant provided additional submissions on May 5, 2003, in compliance with Procedural Order 2.

On May 5, 2003, Mr. Robinson delivered to the BCICAC notice of his withdrawal as a panellist, citing concerns related to issues of apprehension of bias and the integrity of the dispute resolution process. A copy of Mr. Robinson's notice of withdrawal has been provided to the complainant and to CIRA.

In accordance with Paragraph 7.3 of the Rules, on May 26, 2003, the BCICAC appointed, Edward C. Chiasson, Q.C. as panellist to replace Mr. David Robinson.

The Administrative Panel decided to consider all of the material delivered by the parties. An examination of the material confirms that all technical requirements for the prosecution of this proceeding were met.

4. Factual Background

The following information derives from the Complaint and Supplemental Complaint.

The Complainant, as one of ten Provinces in Canada, uses its Mark ALBERTA GOVERNMENT to distinguish itself from all other Canadian provincial governments. It has developed a well-known reputation and acquired substantial goodwill in the Mark in Canada. It has used the Mark ALBERTA GOVERNMENT extensively in association with all its services since September 1, 1905, when the Complainant was created by Federal Act of Parliament.

The Complainant has registered marks pursuant to paragraph 9(1)(n) of the *Trade-Marks Act* (Canada) which contain the alphanumeric elements "Alberta" or "government" or any combination of those elements.

The Complainant has used the Mark ALBERTA GOVERNMENT in association with all services it provides as a government body to the residents of Alberta. This includes the provision of services the Complainant provides through its own web-site. The Complainant's Mark is marked plainly on the web-site.

The Complainant, as a provincial government, produces for the public numerous informational materials. The Complainant's Mark is plainly marked on these materials.

Through the Complainant's extensive and long-term use of the Mark GOVERNMENT OF ALBERTA in association with its services, the Mark has come to be associated with the Complainant, as distinct from the services provided or carried on by others.

The Complainant has developed a well-known reputation and acquired substantial goodwill in the Mark GOVERNMENT OF ALBERTA.

The subject domain name was registered by the Respondent on November 9, 2000.

The Respondent uses the subject domain name in connection with a pornographic website which attracts Internet users intending to contact the Alberta Government.

The Respondent produces no wares and provides no services in which the Mark is displayed. It does not advertise or promote its business or non-commercial activities using the Mark. The Respondent's sole use of the Mark is to direct Internet users to a pornographic web-site.

The Respondent's use of the subject domain name does not describe its pornographic website or the operation of its business and it does not describe the place of origin of its services. The website offers to provide numerous services for a fee. It also provides links to other sites which also charge fees.

The Mark ALBERTA GOVERNMENT is not the generic name of any wares, services or business. It was created specifically by statute to distinguish the Claimant from all other provincial bodies in Canada.

The Respondent is a corporation, incorporated pursuant to the laws of Ontario. Neither the corporation's name nor any of its shareholders have used the subject domain name in their names.

The Respondent has registered not only the subject domain name, but has also the domain name <ontariogovernment.ca>.

The Respondent did not participate in this proceeding.

5. Parties' Contentions

A. Complainant

The Complainant relies on its long use of the Mark GOVERNMENT OF CANADA and asserts that the subject domain name is confusingly similar to it.

Bad faith is said to be shown by the Respondent's use of the subject domain name to attract customers by confusing them into thinking that they are contacting the Complainant.

The Complainant asserts that the Respondent does not have a legitimate interest in the subject domain name because it does not use the subject domain name in its business or name. The Complainant also relies on the type of use made of the subject domain name the Respondent.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

To succeed in its submission, the Complainant is required to prove the following:

- A. the subject domain name is confusingly similar to a mark of the Claimant;
- B. the Respondent has no legitimate interest in the subject domain name;
- C. the Respondent has registered and is using the subject domain name in bad faith.

A. Identical or Confusingly Similar

It is clear that the Complainant has rights to the words "Government of Alberta" both through long use and registration. The subject domain name differs only by the absence of a space between the words "alberta" and "government" and by the addition of "ca". The latter is of no consequence. The former does nothing to distinguish the subject domain name from the Complainant's mark

The Administrative Panel is satisfied that the Complainant has met the first requirement.

B. Rights or Legitimate Interests

The Respondent uses the subject domain name to direct members of the public to a pornographic web-site. While the operation of a pornographic web-site does not in and of itself lead to a conclusion that the registrant does not have a legitimate interest in a domain name, the lack of use of the name in issue and its relationship to the mark of another are factors which can support such a result.

There is no information before the Administrative Panel that suggests any association between the Respondent or its business and the subject domain name.

The Administrative Panel is satisfied that the Complainant has met the second requirement.

C. Registered and Used in Bad Faith

A finding that a respondent has no legitimate interest in a domain name that is confusingly similar to the mark of another does not lead automatically to a conclusion of bad faith, but the facts that support the finding may be relevant to the bad faith issue.

The Complainant's name and mark are notorious. There can be little doubt that the Respondent knew of them when it registered the subject domain name. Using the subject domain name to attract customers to a pornographic web-site in the circumstances of this case, is a bad faith use. As noted, the operation of such a site is not *per se* bad faith, but the context of the use in this case – the Complainant's notoriety, confusion, non-use, etcetera - makes it so.

The Administrative Panel is satisfied that the Complainant has met the third requirement.

7. Decision

Based on the information provided to it and on its findings of fact, the Administrative Panel concludes that the Complainant has established its case. The Complainant seeks transfer of the subject domain name to it. The Administrative Panel so orders.

Edward C. Chiasson, Q.C.
Presiding Panellist

Dated: June 6, 2003