

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

Domain Name: FORESTERCOLLEGE.CA
Complainant: Independent Order of Foresters
Registrant: Noredu Enterprises Canada Inc., operating as Forester College of
Technology
Registrar: Tucows.com Co.
Panellist: Denis N. Magnusson
Service Provider: Resolution Canada

DECISION

A. The Parties

1. The Complainant is The Independent Order of Foresters, 789 Don Mills Rd., Toronto Ontario.
2. The Registrant is Forester College of Technology, a business name adopted by Noredu Enterprises Canada Inc., an Ontario corporation, the registered address of which is 789 Don Mills Rd., Toronto Ontario.

B. The Domain Name and Registrar

3. The domain name at issue is <FORESTERCOLLEGE.CA>. The domain name is registered with Tucows.com Co. of Toronto, Ontario.

C. Procedural History

4. The Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, Resolution Canada. The Provider served notice of the Complaint to the Registrant as required by CIRA Rules, para. 4.3. No Response to the Complaint was received from the Registrant. The Complainant elected to have the Complaint heard by a single panellist as permitted under Rules, para. 6.5. The Provider selected Denis N. Magnusson as the single panel member for this Complaint.

D. Panel Member Impartiality and Independence Statement

5. As required by Rules, para. 7.1, I, Denis N. Magnusson, have declared to the Provider that I can act impartially and independently this matter as there are no circumstances known to me which would prevent me from so acting.

E. Basis for Deciding the Complaint

6. Since the Registrant has not submitted a Response to the Complaint, *CIRA Domain Name Dispute Resolution Rules* ["Rules"], para. 5.8, applies: "the Panel shall decide the Proceeding on the basis of the Complaint".

F. Factual Background

7. The Complainant Independent Order of Foresters, a federally incorporated fraternal benefit society. The Complainant is subject to the federal *Insurance Companies Act*¹. The Complainant has conducted the business of providing insurance and other services to its members in Canada for over 125 years.² The Complaint states that the Complainant “also actively contributes to and supports a number of charitable organizations and projects.”

8. Since 1966 the head office of the Complainant has been located in a building it owns located at 789 Don Mills Rd. in Toronto. That building, of approximately 24 storeys, has a large illuminated sign bearing the word “Foresters” located at the top of the building. The Complaint states that the building “is a landmark in the Don Mills area, and is commonly referred to as the ‘FORESTERS Building’”.

9. The behaviour of the Registrant and the Complainant’s responses to that behaviour leading up to the filing of this Complaint is best stated by reproducing the following excerpt from the Complaint (paras. 14 – 24):

“The Registrant became a tenant at the FORESTERS Building in or about June 21, 2002. The space occupied by the Registrant was part of space leased from the Complainant by Bond Executive Office. Bond Executive Office provides office space and support for small enterprises and therefore, the Registrant has been a subtenant of Bond Executive Office.

Sometime after becoming a tenant in the FORESTERS Building, the Registrant adopted the business name Forester College of Technology (which was registered on February 6, 2003) and the domain name [at issue in the proceeding] FORESTERCOLLEGE.CA (which was registered on June 2, 2003).

In or about early March 2003, it came to the Complainant’s attention that the Registrant was using the FORESTER Marks, FORESTERS trade name and photographs depicting the FORESTER Building in promotional materials for its college.

The Complainant wrote to the Registrant by letter dated March 11, 2003, requesting that the Registrant cease and desist in its use of the Forester name in connection with the Registrant’s college . . .

In response to the Complainant’s letter, the Registrant stated that effective March 11, 2003, the Registrant would cease using the name FORESTER COLLEGE.

However, despite the Registrant’s assurances, the Complainant discovered that the Registrant persisted in using the name FORESTER. On September 22, 2003, the Complainant received a TD Canada Trust Access Card addressed to the Registrant, as a result of confusion with respect to association between the parties.³ By letter dated September 22, 2003, the Complainant repeated its request to the Registrant that it cease and desist from using the name FORESTER in connection with its business.

On November 10, 2003, the Complainant received a letter from the Ministry of Training Colleges and Universities informing the Complainant that an application was filed for recognition as a Private Career College in Ontario by “Noredu Enterprises Canada Inc., operating as Forester College of Technology and

¹ *Insurance Companies Act*, R.S.C. 1991, c. 47

² The Complainant also conducts business in the United States and the United Kingdom.

³ Appendix J of the Complaint is a photocopy of a form from TD Canada Trust, addressed to “Forester College of Technology” (*sic*) at 789 Don Mills Rd. which form stated, among other things, “. . . Access card: Small Business Banking . . . Welcome to the world . . . banking . . . Your new TD Canada Trust . . . Access Card”. There was a photocopy image of a card attached bearing the name FORESTER COLLEGE FOF TECHNOLOGY.

York College of Technology” and inquired whether the Registrant was associated with the Complainant. . .

. . . [t]he Complainant instructed its counsel, Fasken, Martineau DuMoulin to forward a further cease and desist letter to the Registrant . . . dated November 19, 2003 . . .

In an undated response to . . . the cease and desist letter, the Registrant advised that it had changed its name to the York College of Technology, had ceased all use of the FORESTER [name], or any name or mark confusingly similar to it, and had recalled all promotional materials bearing the name or mark FORESTER or FORESTERS. . . .

A further letter was sent to the Registrant [by Complainant’s counsel], dated December 3, 2003, requesting delivering up of all offending promotional material. To date Registrant has not done so. . . .

The Complainant was also contacted regarding Forester College of Technology by a concerned citizen, Sean Tan, by telephone and email on March 25, 2004. Mr. Tan informed the Complainant that the Registrant recruited students illegally in Canada and China, through advertisement of its “Forester College of Technology” in the Canadian Overseas Students Handbook which has a distribution of 50,000 copies. Mr. Tan also advised the Complainant that every time the Ministry of Training Colleges and Universities visited to investigate the college, the Registrant evacuated the students and hid them from investigation. He also noted that the FORESTERS Building was reproduced [as a photograph] in the Registrant’s material [with its FORESTERS sign clearly visible] with a further sign “FORESTER COLLEGE” in Chinese [superimposed on the photograph] referring to [another, lower] building [immediately] beside the FORESTERS Building. . . .⁴

10. The web page located at the domain name at issue this case, specifically, <http://www.forestercollege.ca/index.html>, opens with a page with the words “FORESTER College” in large print at the top right of the page. To the top left is a video insert showing a series of images, which appears to start with a Chinese-style landscape scene, then a scene panning from top to bottom of the FORESTERS Building, with the FORESTERS sign attached to the top of the building clearly visible, and then scenes of what appear to be modern, well-equipped classrooms or meeting rooms. There are other words in English on this page: “News”, “Employment”, “Course Instruction”, “Education Information”, “Cooperative Partner”, “Students Serve” (*sic*), “About Us”. Adjacent to each English entry are Chinese characters – the latter appear to function as links to pages with further information. Smaller print in a box at the bottom left of the page includes the words: “FORESTER COLLEGE”, then an image of what appears to be a bar code, and below that the words “Copyright 2003, Forester College, All Rights Reserved”.

G. CIRA Domain Name Dispute Resolution Policy Requirements

11. CIRA *Domain Name Dispute Resolution Policy* [“Policy”], para. 4.1, sets out what the Complainant must prove to succeed:

To succeed in the Proceeding, the Complainant must prove, on a balance of probabilities, that:

(a) 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; and

(b) the Registrant has registered the domain name in bad faith as described in paragraph 3.7;

⁴ A photocopy of Mr. Tan’s email and an accompanying photocopy of a page Mr. Tan described as being reproduced from the Canadian Overseas Students Handbook was included in the Complaint as Appendix ‘O’.

and the Complainant must provide some evidence that:

(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6.

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name . . .

H. Is the Registrant's Domain Name Confusingly Similar to the Complainant's Mark?

1) The Complainant's Marks

12. The Policy, para. 3.2, includes the following in the definition of what constitutes a "Mark" for the purposes the Policy:

A "Mark" is:

(a) a trade-mark . . . or a trade name that has been used in Canada . . . for the purpose of distinguishing the wares, services or business of that person . . . from the wares, services or business of another person; [and]

(c) a trade-mark . . . that is registered in CIPO . . .

13. The Complainant relies on a number of its Marks, including its trade name and several trademarks it has registered in the CIPO.

14. The Complainant's trade name is "The Independent Order of Foresters", which the Complainant states that it has used in Canada in association with its business for about 125 years. This trade name is a Mark as defined by Policy para. 3.2 and the Complainant had Rights in this Mark well prior to the date of registration of the domain name, June 2, 2003. The Complainant continues to use this trade name and so continues to have Rights in the trade name.

15. The Complaint states that the Complainant had used "Canadian Forester" in Canada as a trademark at least as early as 1969 and that it had used "IOF Forester" in Canada as a trademark at least as early as 1991. Unregistered trademarks used in Canada qualify as Marks under Policy, para. 3.2, and the dates of the Complainant's first use of the trademarks establish that the Complainant had Rights in such marks prior to the date of the registration of the domain name. The Complainant continues to use these trademarks, and has secured registration of such trademarks which registrations are still in force, thus the Complainant continues to have Rights in such Marks.

16. The Complainant has registered a number of trademarks in the CIPO, including:

"Forester Growth Plus" (TMA 556,736, registered Jan. 22, 2002),

"IOF Foresters" (TMA 439,419, registered Feb. 17, 1995),

"Canadian Foresters" (TMA 309,824, registered Dec. 12, 1985).

17. Such registered trademarks are Marks under Policy para. 3.2, and the registration dates being prior to the date of registration of the domain name, the Complainant has established that it had Rights in such Marks prior to the domain name registration, and registrations being still in force establishes that the Complainant continues to have Rights in such Marks.

2) “Confusingly Similar”

a) “Confusingly Similar” Defined

18. The Policy, para. 3.4, defines “confusingly similar”:

A domain name is “**Confusingly Similar**” to a Mark if the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark.

19. A majority of cases decided to date under the Policy have applied an interpretation of the definition of Confusingly Similar derived from s. 9(1) of the *Trade-Marks Act* [“s. 9(1)”]. This section prohibits the use of what are often referred to as “official” marks, which are not trademarks, as such. This test does not incorporate the “confusion” standard which has informed trademark and trade name law for at least two centuries.

20. A minority of cases under the Policy have interpreted “Confusingly Similar” so as to incorporate the classic trademark and trade name law confusion standard, as far as that can reasonably be done in the typically confined context of domain name disputes.

21. As the Complaint points to facts and makes submissions which engage both of the interpretations of Confusingly Similar, the Panel will consider the requirement of the Registrant’s domain name being “confusingly similar” to the Complainant’s Marks under each of these approaches.

b) “Confusingly Similar” Conforming to *Trade-Marks Act*, s. 9(1)

22. The definition of “Confusingly Similar” in Policy para. 3.4 obviously does parallel the language of the prohibition of official mark use in s. 9(1) of the *Trade-Marks Act*:

23. The Policy, para. 3.4:

A domain name is “**Confusingly Similar**” to a Mark if the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark.

The *Trade-Marks Act*, s. 9(1):

9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for [there follows a list of specific “official marks”]

24. The remaining language of The Policy, para. 3.4:

A domain name is “**Confusingly Similar**” to a Mark if the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark.

mirrors the language of s. 6(5)(e) of the *Trade-Marks Act*, which in that Act sets out one of a number of factors to be considered in determining whether a trade-mark or trade name is confusing with another trademark or trade name:

6(5) In determining whether trade-marks or trade-names are confusing . . . have regard to all the surrounding circumstances including . . .

(e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

25. That this additional language in the Policy definition of “Confusingly Similar” mirrors part of the language of the *Trade-Marks Act* confusion test, arguably is no obstacle to viewing

the Policy definition as exclusively reflecting *Trade-Marks Act*, s. 9(1). The additional language can be seen as simply reflecting what is implicit in the language of the s. 9(1) prohibition: the test of similarity under that prohibition must involve a comparison of any appearance, sound or meaning (ideas) of the official mark and of the other mark being considered in applying the prohibition.

26. Currently, the most cited concise statement of the s. 9(1) prohibition is that it is “a test of resemblance based upon first impression and imperfect recollection”⁵ However, the central thrust of applying a *Trade-Marks Act*, s. 9(1) approach to the Policy requirement of Confusingly Similar is that such test focuses exclusively on a comparison of the Complainant’s Marks and the Registrant’s domain name, *per se*. The Complainant’s Marks and the Registrant’s domain name, both including the word “Foresters”, would be the exclusive focus of the Confusingly Similar test when applied in the same form as the test in the *Trade-Marks Act*, s. 9(1). This approach does not involve any consideration of the broader contextual facts associated with the Complainant’s acquisition of and use of its Marks, and with the Registrant’s actual use of the domain name.⁶ The Complainant has used its trade name, “The Independent Order of Foresters”, in Canada for more than a century. The Complainant has built a substantial Canadian business in the insurance field over that time, in connection with which it has used marks prominently featuring the word “Foresters”.⁷ Of course, under the s. 9(1) approach to Confusingly Similar, such facts which might otherwise be relevant to determining the extent and strength of the Complainant’s reputation as attached to the word “Foresters” when used as a trade designation in Canada, cannot be used in considering whether the Registrant’s domain name might be confusingly similar to the Complainant’s marks. Similarly, though there is uncontroverted evidence that the Registrant is using the domain name including the word “Foresters” in connection with its business and web page in a manner which falsely suggests that the Registrant’s business is connected to the Complainant’s business, such contextual evidence cannot be used under the *Trade-Marks Act*, s. 9(1) approach to interpreting confusingly similar.

27. Under the s. 9(1) approach to confusingly similar, the focus must, in the first instance, be exclusively on the appearance, sound and ideas suggested by the Complainant’s Marks, *per se*⁸. The Complainant’s Marks all include the word “Foresters” or “Forrester”, but always in combination with other words.⁹ In the second instance the s. 9(1) test focuses exclusively on the

⁵ *Canadian Olympic Association v. Health Care Employees Union of Alberta* (1992), 46 C.P.R. (3d) 12 (FCTD).

⁶ The scope of such additional contextual facts is well-illustrated in the *Trade-Marks Act*, s. 6(5):

In determining whether trade-marks or trade-names are confusing, the court . . . , shall have regard to all the surrounding circumstances including

- (a) the inherent distinctiveness of the trade-marks or trade names and the extent to which they have become known;
- (b) the length of time the trade-marks or trade-names have been in use;
- (c) the nature of the wares, services or business;
- (d) the nature of the trade; . . .

⁷ “Foresters™ has total assets over \$6.6 billion, liabilities at \$5.2 billion and surplus of \$1.4 billion.* *Based on Foresters Audited Consolidated Statement of Income as of December 31, 2002 (Canadian \$).”

http://www.foresters.biz/aboutus/fall_2003_financial_strength.asp, visited Sunday, May 23, 2004

⁸ “*per se*: By or in itself; intrinsically, essentially”, *New Shorter Oxford English Dictionary*, 1996.

⁹ The Complainant has applied to the CIPO to register the word “Foresters” alone, as a trademark. However, that application is based on “proposed use” of the word alone as a trademark, and so does not represent a claim by the

appearance, sound and ideas suggested by the Registrant's domain name, FORESTERCOLLEGE¹⁰, *per se*. The Complaint, para. 16, notes that "Foresters" is in the first part of the domain name and refers to trademark jurisprudence which has acknowledged that the first portion of a mark is particularly important in assessing whether two marks are confusingly similar.¹¹ While very relevant, that factor must be considered in the light of the entire comparison of the two marks.

28. The word FORESTER appears in the singular in the Registrant's domain name. The Complainant's trade name and numbers of its trademarks include the work "Foresters" in the plural. Others of the Complainant's trademarks feature "Forester" in the singular. In comparing the Registrant's domain name and the Complainant's trade name and trademarks for the purposes of determining whether they are confusingly similar in this case, the Panel finds that the presence or absence of the "s" is not material. The presence or absence of the "s" is not unlike the presence or absence of the hyphen referred to in the earlier decision under the CIRA Policy, Canadian Broadcasting Corporation / Radio-Canada vs. William Quon, Dispute Number DCA 681-CIRA, April 8, 2003.

29. While "Forester" is a prominent part of the Registrant's domain name, the word "college" is also a prominent element of that domain name. The Complainant has submitted that as the element "college" is descriptive of the Registrant's services it should not be regarded as part of the Registrant's mark. That position would not be consistent with trademark jurisprudence¹², though that jurisprudence would countenance weighing the descriptiveness in assessing the likelihood of confusion. However, prior decisions under the CIRA Policy have suggested that the inherent distinctiveness or lack of distinctiveness of elements of the Registrant's domain names and Complainant's Marks¹³ cannot be considered in applying the Confusingly Similar test under the CIRA Policy, such consideration is not consistent with a pure s. 9(1) type interpretation of "Confusingly Similar".¹⁴ If the inherent descriptiveness of elements of the domain name can be considered, as an aspect of the "ideas suggested" by the domain name for example, then the inherent descriptiveness of elements of the Complainant's Mark must also be considered. In this case "Forester" has a common meaning and in that light the Panel would have to consider whether the domain name <FORESTERCOLLEGE.CA> might not be

Complainant that it had used the word "Foresters" alone as a trademark so as to acquire Rights in such an unregistered trademark prior to the date of registration of the domain name.

¹⁰ The ".CA" portion of the domain name is ignored in assessing "confusingly similar".

¹¹ This is on the theory that consumers pay particular attention to the first portion of any mark in identifying that mark – thus similarity in this portion is thought to be particularly relevant to assessing whether there is confusing similarity between two marks.

¹² The jurisprudence indicates that while the registrant of a trademark will be required to disclaim the exclusive right to use a descriptive element of a trademark apart from that mark, the descriptive element remains a part of the mark, for example, for the purpose of assessing whether that mark is confusing with another mark.

¹³ The inherent descriptiveness of "college" means that this element of the domain name is not trademark "distinctive".

¹⁴ "However, distinctiveness of a complainant's mark is not an appropriate consideration in determining whether the challenged domain name is "Confusingly Similar" to the complainant's mark." *Govt. of Canada v. Bedford*, CIRA Dispute Resolution Case 00011, May 27, 2003 at para. 68.

confusingly similar with the Mark as the domain name would be understood as indicating the name of a college for foresters.¹⁵

30. The Complainant cited a decision under the ICANN UDRP, *AT&T Corp. v. Tala Alamuddin*, WIPO Case No. D2000-0249 (May 18, 2000), in which the Panel found the domain name <ATT2000.COM> to be confusingly similar to the Complainant's trade name "AT&T Corp." In that case the Panel noted the name "AT&T" was "well-known . . . as being associated with a very large telephone communications company . . .". The Panel went on to conclude that "most persons in the United States . . . could be confused into thinking that <ATT2000.COM> was some millennium promotion by AT&T." This precedent is of limited guidance for a case under the CIRA Policy when the s. 9(1) approach is applied to the CIRA requirement of Confusingly Similar. The UDRP definition of "confusingly similar" clearly applies the classical trademark and trade name conception of confusion. Thus, in the AT&T case the Panel could give weight to the "world famous" status of the AT&T trade name. Under a s. 9(1) type interpretation of "confusingly similar" in the CIRA Policy, no weight can be given to such contextual facts.

31. While "Foresters" is a prominent element in the Complainant's Marks, it is only a part of each such Mark. While the Complainant invited the Panel to discount the COLLEGE element of the domain name, the Panel in the *AT&T* case cited by the Complainant makes this statement: "Although the marks must be compared as a whole in determining confusion, when each mark has a common feature, greater attention needs to be focused on the remaining parts of the marks *re Broadhead's Application* (1950), 67 RPC 209, 215." In none of the Complainant's Marks do the words other than "Forester" make any reference to colleges, teaching or education. Thus, while there is a prominent common element in the word "Foresters" in the Complainant's Marks and in the Registrant's domain name, there is no resemblance in appearance, sound or ideas suggested by the remaining prominent elements of the Complainant's Marks on the one hand, and the Registrant's domain name on the other hand. Even allowing for the qualification of finding similarity under a test of "first impression and imperfect recollection" under the s. 9(1) approach, under this approach the Panel cannot find that the Registrant's domain name, <FORESTERCOLLEGE.CA> is confusingly similar to any of the Complainant's Marks containing the word "FORESTER".

c) "Confusingly Similar" Conforming to *Trade-Marks Act* Confusion

32. If the requirement that the domain name be Confusing Similar to the Complainant's Mark were interpreted in the light of the classic trademark and trade name conception of confusion, in this case the Panel could find that the domain name <FORESTERCOLLEGE.CA> was Confusingly Similar to one or more of the Complainant's Marks featuring the word FORESTER. Finding confusing similarity in the trademark confusion sense would mean finding that the use of Registrant's domain name would likely suggest that any enterprise associated with such domain name was the same enterprise as, or was at least sponsored, endorsed or approved by the same enterprise as was identified by the Complainant's Marks. In considering whether there was confusing similarity in this sense, the Panel could give some weight to the evidence in the Complaint of the extent of use by the Complainant over 125 years of its Marks containing the

¹⁵ See, for example, College of Alberta Professional Foresters, http://www.professionalforesters.ab.ca/news/ASRD_Directive_Attached_E-Mail.pdf, visited May 23, 2004.

word “Foresters”, including use such as the prominent signage on its Foresters Building. The Panel could draw inferences, based on that evidence, about the prominence of the Complainant’s reputation associated with its Foresters Marks. Further, the Panel could give some weight to the evidence in the Complaint about the actual use of the domain name by the Registrant for any illumination such actual use might provide about possible confusion.

d) Conclusion on Confusingly Similar

33. Under the s. 9(1) interpretation of “confusingly similar”, the Panel finds that the Registrant’s domain name FORESTERCOLLEGE.CA is not confusingly similar to any of the Complainant’s Marks featuring the word FORESTERS. This finding would be sufficient to dismiss the Complaint, and there would be no need to consider the next requirement of the Complaint process, i.e., whether the Registrant registered the domain name in “bad faith” as defined in the Policy.

34. Under the trademark confusion interpretation of “confusingly similar”, the Panel could find that the Registrant’s domain name FORESTERCOLLEGE.CA is confusingly similar to the Complainant’s Marks featuring the word FORESTER. Such a finding would require the Panel to proceed to consider whether the Registrant registered the domain name in “bad faith”.

I. Was the Registration of the Domain Name Made in Bad Faith?

35. To succeed in this complaint the Complainant must show, on the balance of probabilities, that the Registrant registered the domain name in bad faith. Unlike the UDRP policy, the CIRA Policy has a restricted definition of “bad faith”. Policy, para. 3.7, states that the Registrant will be considered to have registered the domain name in bad faith, “if, and *only if*”¹⁶ one of three conditions is met:

- (a) the Registrant registered the domain name . . . primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant [or others related to or competing with the Complainant] for valuable consideration in excess of the Registrant’s actual costs in registering the domain name . . . ;
- (b) the Registrant registered the domain name . . . in order to prevent the Complainant [or others related to the Complainant] 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
- (c) the Registrant registered the domain name . . . primarily for the purpose of disrupting the business of the Complainant [or others related to or competing with the Complainant] . . .

36. On the facts of this case the only one of these three exclusive tests of bad faith which might apply is (c), a registration “primarily for the purpose of disrupting the business of the Complainant”. This disruption could occur only in the sense that persons encountering the domain name might conclude that the Registrant’s business, associated with the domain name, was a business of the Complainant or was at least endorsed, sponsored or approved by the Complainant. Thus, the Complainant’s business reputation would be put at risk by the Registrant’s business conduct, over which the Complainant had no control.

¹⁶ Emphasis added.

37. However, the language of Policy para. 3.7 makes it very clear that the scope of the necessary bad faith is intended to be strictly construed. The clear limiting language governing the entire definition of bad faith, “if and only if”, was noted above. The Panel also notes the further limiting language in each of the three sub-paragraphs defining bad faith: subparagraphs (a) and (c) limit their applications only if the impugned effect was the primary purpose of the Registrant, and subparagraph (b) limits its application to Registrants who have repeatedly engaged in the impugned behaviour.

38. Particularly in the context of this intended strict construction of Policy para. 3.7, the Panel must conclude that the kind of business disruption which occurred in this case is not a form of business disruption included in the language of Policy para. 3.7(c). The CIRA Policy was drafted after, and with knowledge of the prior UDRP. The two policies have a similar general structure and the language of some parts of the two policies is very similar, confirming that the CIRA Policy was drafted with the UDRP before the drafters of the CIRA Policy. However, there are a number of obvious differences, in which the CIRA Policy clearly departs from the pattern of the UDRP precedent, and these differences must be seen as deliberate policy departures. The differences in the two policy definitions of bad faith becomes especially clear when the two definitions are considered in parallel, as set out in the two columns below.

CIRA POLICY**3.7 Registration in Bad Faith.**

For the purposes of paragraph 3.1(c), a Registrant will be considered to have registered a domain name in bad faith if, and only if:

(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; or

(c) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant.

[NO EQUIVALENT PROVISION]

ICANN UDRP POLICY**4(b) Evidence of Registration and Use in Bad Faith.**

For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location.

39. There are two obvious and very material differences in these two provisions which determine the appropriate finding in this case. First, the CIRA Policy definition of "bad faith" is expressly restrictive while the UDRP Policy definition is expressly not restrictive.¹⁷ Second, the UDRP Policy includes sub-paragraph (iv) which defines "bad faith" to include intentionally creating confusion with the complainant's mark as to source, sponsorship, affiliation or endorsement. This paragraph (iv), of course, would apply to the Registrant's conduct in this case were the UDRP applicable, which it is not. However, there is no parallel to UDRP subparagraph

¹⁷ CIRA: "if and only if [one of the following three conditions is met]" vs. UDRP: "the following [four conditions]. . . in particular but without limitation [to the following four conditions in particular]"

(iv) in the CIRA Policy. This omission strongly suggests that the drafters of the CIRA Policy intended the conduct described in UDRP subparagraph (iv), which covers classic trademark and trade name confusion, to be excluded from the CIRA Policy definition of bad faith. This conclusion requires that the CIRA Policy subparagraph 3.7(c) reference to “disrupting the business” not be interpreted so as to include conduct like that of the Registrant in this case, intentionally causing confusion about his business affiliation.

40. Furthermore, the express language of CIRA Policy subparagraph 3.7(c) precludes that paragraph from applying to the Registrant’s conduct in this case. That subparagraph impugns only domain name registrations made “primarily for the *purpose* of disrupting the business of the Complainant”. The Panel might be able to find that the *effect* of the Registrant’s registration and use of the domain name was, in some broad sense, to disrupt the Complainant’s business. However, para. 3.7(c) does not say that a Mark is registered in bad faith if the purpose *or effect* of registration is to disrupt the business of the Complainant, but that the Mark is registered in bad faith only if the *purpose* is to disrupt the Complainant’s business. In some cases in which the effect of disruption can be proved, and such effect is a clearly foreseeable consequence of the domain name registration and use, it might be appropriate to infer that the Registrant intended such effects, and thus could be said to have had the purpose of disrupting the Complainant’s business. However, the Panel concludes that this case is not one in which such an inference of purpose can be made simply from the foreseeable effects of conduct. A more reasonable inference from the facts is that the Registrant’s intent was simply to promote its own business by falsely associating it with the Complainant’s positive business reputation. The inference is that the Registrant was indifferent as to the effect of its registration and use of the domain name on the business of the Complainant and did not act with the purpose of disrupting the Complainant’s business.

41. Policy para. 3.7(c) has a further express constraint in that it requires that the Registrant have registered the domain name “*primarily* for the purpose of disrupting the business of the Complainant” [emphasis added]. It would be even more difficult for the Panel to conclude that the Registrant in this case registered its domain name *primarily* for the *purpose* of disrupting the Complainant’s business. The facts suggest that the Registrant’s primary purpose was to advance its own business interests, regardless of any effects on the business of the Complainant.

42. Thus, whether or not the Registrant’s domain name is seen as Confusingly Similar to the Complainant’s domain name, the Registrant cannot be found to have registered the domain name in bad faith within the restricted definition of bad faith in Policy para. 3.7.

J. Does the Registrant Have a “Legitimate Interest” In the Domain Name?

42. Since the Panel has found that the Registrant did not register the domain name in bad faith in the limited sense in which bad faith is defined in the Policy, it is unnecessary to consider the third element required for a successful Complaint, *i.e.*, that “the Registrant has no legitimate interest in the domain name as described in paragraph 3.6.”, for which the Complainant would have to offer some evidence¹⁸. Nevertheless, the Panel will address that issue as the Complainant did make submissions on the issue in the Complaint.

¹⁸ Policy, para. 4.1(c).

44. Had it been necessary to consider the issue of legitimate interest, the Panel would have found that the Registrant had provided some evidence that the Registrant had no legitimate interest in the domain name. Further, the Panel would have found that the Registrant had not proved, on the balance of probabilities, that the Registrant had a legitimate interest in the domain name as defined in Policy, para. 3.6. Below, the Panel suggests how it would have come to these conclusions by briefly commenting on the language of Policy, para. 3.6

45. **3.6 Legitimate Interests.** 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:

This definition is restrictive – only the interests listed in subparagraphs (a) – (f) below can be considered legitimate interests. The Registrant cannot demonstrate any legitimate interest under those subparagraphs.

46. (a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;

While good faith is not expressly defined in the Policy, the Panel would find that use which was intended to cause confusion is not good faith use.

47. (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;

The Registrant's Mark is not clearly descriptive of its business or services.

48. (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;

The Registrant's Marks is not the generic name of its business or services.

49. (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;

The Registrant does not use the domain name in association with a non-commercial activity.

50. (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

The legal name of the Registrant is Noredu Enterprises Canada Inc. It appears that the Registrant registered the name Forester College of Technology as a business name under the Ontario *Business Names Act*.¹⁹ Such registration by a corporation of an alternative business name style under that Act does not constitute “the *legal name* of the Registrant” corporation as referred to in CIRA Policy 3.6(e). Further, the Panel would have concluded that the domain name “FORRESTERCOLLEGE” could not be regarded as a name by which the Registrant was commonly identified because name was confusing with the Complainant's business names and thus did not successfully commonly identify the Registrant.

¹⁹ *Business Names Act*, R.S.O. 1990, c. B-17. Section 2(1) of that Act states: “No corporation shall carry on business or identify itself to the public under a name other than its corporate name unless the name is registered by that corporation.”

51. (f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

The domain name is not the *geographical* name of the location of the Registrant's place of business. "Foresters Building" is not a geographical name.

K. Conclusion and Decision

52. The Complainant did not establish on the balance of probabilities that the Registrant's domain name was Confusingly Similar to the Complainant's Marks under the predominant interpretation of "Confusingly Similar" in the CIRA Dispute Resolution cases decided to date.

53. If the Complainant had been able to establish that the Registrant's domain name was Confusingly Similar to the Registrant's Marks, the Complainant did not establish on the balance of probabilities that the Registrant had registered the domain name in Bad Faith, as defined in the Policy.

54. For these reasons, the complaint regarding the <FORESTERCOLLEGE.CA> domain name is not successful and is dismissed. The Panel will not make any order regarding the registration of the < FORESTERCOLLEGE.CA> domain name.

Denis N. Magnusson
Sole Panel Member

Denis N. Magnusson

Date: May 25, 2004