

THE CANADIAN INTERNET REGISTRATION AUTHORITY

Dispute Number:

Domain Name: candapost.ca

Complainant: Canada Post Corporation

Registrant: Marco Ferro

Registrar: CVO.CA Inc.

Panellist: Hon. Roger P. Kerans FCI Arb

Service Provider: British Columbia International Commercial Arbitration Centre

BCICAC File: DCA871 - CIRA

DECISION

1 PRELIMINARY MATTERS

- 1.1 This is a dispute about the domain name “candapost.ca”
- 1.2 The Canadian Internet Registration Authority (CIRA), which is responsible for operating the dot-ca Internet country code Top Level Domain (ccTLD), established, by its Domain Name Dispute Resolution Policy (CDRP), published November 29, 2001, a mechanism for the resolution of disputes about domain names, established the “CIRA Dispute Resolution Rules: (the “Resolution Rules”), and named the British Columbia International Commercial Arbitration Centre (BCICAC) as a service provider under that that Policy.
- 1.3 A complaint was filed by the complainant at the BCICAC on September 14, 2005.
- 1.4 The BCICAC has certified and I accept that the complaint complied with the formal requirements of the CDRP and the Resolution Rules.
- 1.5 The BCICAC has certified and I accept that it has complied with provisions of the CDRP and the Resolution Rules in giving Notice of the Complaint to the Registrar of record and Respondent on September 14, 2005, and that the Respondent has failed to respond.
- 1.6 The Complainant has elected under Rule 6.5 of the Resolution Rules to have this dispute resolved by a single arbitrator.
- 1.7 On October 17, 2005, I was named as sole arbitrator, and have executed a statement of independence and impartiality as required by BCICAC Rules.

2 POSITIONS OF THE PARTIES

2.1 *The Complainant submits:*

2.1.1 That it has a Canadian presence required by the CDRP and s.2.1.(q) of the Resolution

Rules by virtue of the fact that it is a Crown Corporation, that is to say an enterprise wholly owned by the Government of Canada, carries on the business in Canada of offering postal services, and owns Canadian trade-mark registrations for the mark CANADA POST and others that include this term, and has owned them since 1998.

- 2.1.2 The trade-marks have been used in Canada by the complainant since 1981 in the course of its business of offering letter and parcel delivery services, courier services, times sensitive delivery services and other related activities.
- 2.1.3 The Complainant in connection with its business operates 7,000 post offices across Canada, licenses another 3500 franchise postal outlets, and approximately 11,000 shops selling wares related to its business (stamps, envelopes, packing materials, etc.) offered for sale by the Complainant, and operates a mailbox system, trucking services, and other facilities.
- 2.1.4 The complainants "Visual Identity Procedures" require its staff and franchisees to make extensive and prominent use throughout Canada of the trade-mark CANADA POST on promotional items, pictograms, vehicles, signage, stationery, forms, advertising, including television newspaper, and magazine ads, on posters, uniforms, mailboxes, community service kiosks, postal outlets, and buildings. The trade-mark is also used in radio and internet advertising.
- 2.1.5 The Complainant operates a web page know as CANADAPOST.CA, and the related names CANADAPOST.COM, CANADAPOST.ORG, and CANADAPOST.Net as well as a French language version, POSTESCANADA.CA. This website, in 2003, recorded over a billion hits, and 33 million visits.
- 2.1.6 The domain name in dispute is confusingly similar to the trade-mark. It has no real meaning other than as a mis-spelling of the Complainant's trade-mark.
- 2.1.7 The respondent has no legitimate interest in the domain name in dispute. More particularly, the Complaint adds:

"The Registrant's web site is linked to the commercial services offered by a company called Oversee.net. Oversee.net provides financial benefits to domain name owners who enter into a relationship with it. The server on which the disputed domain name is linked is ns1.proredirect.com and ns2.proredirect.com. Proredirect.com is owned by Oversee.net.

Oversee.net offers a service called "Domain Sponsor" or "DomainSponsor.com" (hereinafter referred to as "Domain Sponsor") to domain name owners. DomainSponsor is a revenue program which assists domain name owners to maximize revenue from their parked domains by providing a straightforward and easy-to-use money-making system. In this regard, when an Internet user types in

the disputed domain name, he/she is directed to a custom DomainSponsor landing page populated with ads and content relevant to what the Internet user is looking for as well as a search portal at <http://searchportal.information.com> (also operated by Oversee.net). The landing page and search portal provides links to sponsored web sites on a variety of topics including mail services in Canada. The search portal also causes numerous "pop-up" and "pop under" advertisements to be displayed when it is accessed. 50% of all revenues generated from searches, "pop unders" and "pop ups" in respect of Internet users directed to the DomainSponsor landing page web site through the Registrant's domain name is paid to the Registrant.

The operations and commercial benefits offered by the revenue program of DomainSponsor have been the subject of several Uniform Dispute Resolution Policy ("UDRP") proceedings . . .

Minka Lighting Inc. dba Minka Group v. Lee Wongi, WIPO Case No. D2004-0984 at p. 5; *Deloitte Touche Tohmatsu v. Henry Chan*, WIPO Case No. D2003-0584 at p. 2; *Bridgestone Corporation v. Horoshiy Inc.*, WIPO Case No. D2004-0795 at pp. 2 and 4

By choosing to register a domain name that is a misspelling of a well-known trade-mark and trade-name as well as of a highly visited Internet web site, the Registrant is profiting from misdirected Internet traffic that never intended to visit his web site in the first place. This form of activity is commonly known as "typo-piracy" and "typo-squatting". The business of "typo-piracy" or "typo-squatting" has been explained by this Panel to be a business of attracting Internet traffic to a web site and by referring this traffic onto web sites owned by third parties to generate fees.

"Typo-piracy" and "typosquatting" have been the subject of numerous UDRP decisions wherein this type of activity has been highly frowned upon. For example, in *Yahoo! Inc. and GeoCities v. Data Art Corp. et al.*, the WIPO Panel stated that "Respondent is obviously engaging in "typosquatting", a practice that has been condemned and been found to be confusingly similar to the marks which they mimic." (emphasis added)

Yahoo! Inc. and GeoCities v. Data Art Corp. et al., WIPO Domain Name Decision D2000-0587

In *Neuberger Berman Inc. v. Alfred Jacobsen*, the WIPO Panel stated that "there also is considerable evidence Respondent sought to disrupt Complainant's business by confusing the many people who would seek Complainant's web site but would end up at Respondent's website. Complainant has produced convincing evidence regarding the practice of "typo-piracy" whereby bad faith operators

deliberately misspell a famous domain name trademark in hopes of luring search engines to their site in conjunction with searches for the famous name website". (emphasis added)

Neuberger Berman Inc. v. Alfred Jacobsen, WIPO Domain Name Decision D2000-0323

First, the DomainSponsor landing page to which the Registrant's disputed domain name directs, offers links to web sites of competitors of the Complainant and of the Complainant's wares and services. For example, searches conducted for mail related services in Canada on the search portal through the DomainSponsor landing page refer Internet users to third party competitor web sites. . .

Second, through its extensive business (ie. the high revenue generated by the Complainant) as described above and due to the fact that the Complainant is the primary entity responsible for the provision of mail and postal services in Canada, the trade-mark and trade-name CANADA POST is extremely well-known in Canada. Every Canadian citizen or resident of Canada, at one time or another, has been exposed to a product or service of the Complainant. Accordingly, unless the Registrant is not a Canadian citizen or resident of Canada (at which point he would not meet the CPRs and would not be eligible to register the disputed domain name), he must have been aware of the Complainant and the trade-mark and trade-name CANADA POST.

Accordingly, as the Registrant must have been aware of the Complainant and the trade-mark and trade-name CANADA POST when he registered the disputed domain name, it is clear that he took advantage of the reputation of the Complainant and the goodwill associated with the Complainant's trade-marks and trade-names by attempting to exploit Internet traffic that was intended for the Complainant's domain names (including CANADAPOST.CA), but that found its way to the site associated with the misspelled disputed domain name due to a typographical error.

Accordingly, the Registrant is clearly competing with the Complainant for Internet traffic.

Moreover, it is submitted that the activities of the Registrant are equivalent to the theft of Internet traffic intended for the Complainant through typo-piracy. Therefore, the primary purpose for registering the disputed domain name was to disrupt the business of the Complainant who is a competitor of the Registrant for all of the foregoing reasons.

We therefore submit that it is clear that the Registrant has registered the disputed domain name in bad faith pursuant to paragraph 3.7(c) of the Policy and that the

Complainant satisfies the onus placed on it by clause (b) of Section 4.1 of the Policy.”

The Respondent filed no submissions.

3 DECISION

3.1 Canadian Presence.

- 3.1.1 The CDRP rule 1.3 requires that a Complainant have a Canadian presence as defined by the CIRA Policy called Canadian Presence Requirements For Registrants (RPPG 05-20001108-00006 Version 1.2 Effective Date: November 8, 2000).
- 3.1.2 Both rule 1.3 and rule 2(q) exempt a Complainant from those rules if it holds a registered trade-mark in Canada that is related to the domain name in dispute.
- 3.1.3 I accept that the evidence offered by the Complainant that it has registered the trade-mark CANADA POST in Canada, and, in any event, I infer from the evidence that the trade-mark is widely used and known in Canada.

3.2 Confusing Similarity

- 3.2.1 Paragraph 3.1(a) of the CDRP requires that the complainant establish that the domain name in dispute 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.”
- 3.2.2 I accept the evidence that the Complainant has a valid and subsisting registered trade mark in Canada respecting the phrase “CANADA POST” which has subsisted since 1998. In my view this creates rights in the mark within the meaning of Paragraph 3.3 of the CDRP.
- 3.2.3 In my view, and because “CANADA POST” is a coined term, with little or no meaning in English except in relation to the Complainant and its business, a person familiar with the trade-mark and searching the web for the Complainant or its products would find the domain name in dispute confusingly similar.

3.3 No legitimate Interest

- 3.3.1 Paragraph 3.1(b) of the CDRP requires that the complainant establish that the Registrant has no legitimate interest in the domain name.
- 3.3.2 I accept the evidence from the Complainant that the sole use by the Respondent of the domain name in dispute is to refer the visitor to websites of other business offering products and services for sale, and that it would appear that the respondent has not and is not carrying on any other business in connection with this domain name - or at all.
- 3.3.3 In my view, the Complainant has no legitimate interest in the domain name in dispute. The Complainant has established that the Respondent use of the name failed to fall within any of the six matters of legitimate interest spelled out in paragraph 3.6 of the CDRP.

3.4 *Bad Faith*

3.4.1 Paragraph 3.1(b) of the CDRP requires that the complainant establish that the Registrant has registered the domain name in bad faith.

3.4.2 Paragraph 3.7 of the CDRP provides three possible ways in which bad faith may be inferred: 1) if the Respondent “registered the domain name . . . primarily for the purpose of sale to the Complainant . . . or a competitor . . .”, 2) if the Respondent “registered the domain name . . . to prevent the Complainant from registering the mark in a trade name, or 3) if the Respondent “registered the domain name . . . for the purpose of disrupting the business of the Complainant.”

3.4.3 In my view, having regard to the total lack of any evidence of any legitimate interest in the name on the part of the Respondent, his failure to reply to the Complaint, and the fact that the domain name contains a phrase that is meaningless in English unless understood as a misspelling of the trade name of the Complainant, the only rational conclusion is that it was and is employed for one reason and only one reason: to attract the sloppy typers amongst the millions of Canadians who seek to contact the website of the Canada Post Corporation each year and divert them to the websites of other business, some of whom offer competing products and services. In other words, the only available and reasonable inference is that the Respondent is guilty of at least one of the three tests for bad faith. This is a classic case of “typo-squatting”.

4 **FORMAL ORDER**

4.1 I hereby order and direct that the domain name in dispute be transferred to the Complainant.



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Hon. Roger Philip Kerans FCI Arb
Sole Arbitrator
October 22, 2005
Victoria, B.C., Canada.