



**CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE**  
**DOMAIN NAME DISPUTE**  
**ADMINISTRATIVE PANEL DECISION**

CIIDRC case number:	16873-CDRP	Decision date: February 13, 2022
Domain Name:	dalkia.ca	
Panel:	Steven M. Levy, Esq.	
Complainant:	DALKIA	
Complainant's representative:	IP TWINS SAS, Attn Tristan Verna	
Registrant:	Nhan Nguyen	

## 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, August 22, 2011) (the "Policy") and the Canadian Dispute Resolution Rules (the "Rules") of the Canadian Internet Registration Authority ("CIRA"). On December 30, 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 <dalkia.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 January 4, 2022 and, on the same date, the CIRA transmitted by email to the CIIDRC its verification response confirming the Registrant's identity. On January 10, 2022, 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 January 10, 2022. No Response was submitted by the stated January 31, 2022 due date and, on February 3, 2022, a notice of default was sent to the Respondent via email. No reply was received to this email.

By letter dated February 8, 2022, 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 disputed domain name be transferred to the Complainant.

**Domain Name: daiichisankyo.ca**  
 16873-CDRP

### 3. UNCONTESTED FACTS

- **Complainant**

Complainant is in the business of real estate management, construction, repair, insurance, and finance. It owns multiple registrations of the trademark DALKIA in various countries including Canada and France, the earliest of which issued in 1997. Complainant also owns numerous domain names that incorporate the mark such as <dalkia.com>, <dalkia.fr>.

- **Registrant**

No Response, evidence, or other statement has been submitted.

### 4. DISCUSSION AND FINDINGS

#### Eligibility

The Complainant is an eligible complainant under paragraph 1.4 of the Policy. The Complaint relates to a trademark registered with the CIPO and the Complainant is the owner of such trademark.

#### Requirements

In accordance with Paragraph 4.1 of the CDRP, the onus is on the Complainant to prove, on a balance of probabilities, that:

- a) 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 3.5;
- c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

The Panel will consider each of these requirements in turn.

#### Analysis

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

The definition of a "Mark" is set out in Paragraph 3.2 of the Policy. Most applicable to the present situation, subparagraph (c) thereof states that a "Mark" can be: "a trade-mark, including the word elements of a design mark, that is registered in CIPO".

Complainant asserts that it has obtained many registrations of the DALKIA trademark in various jurisdictions around the world. It provides screenshots from the CIPO and WIPO websites of four of its asserted trade-mark registrations, the earliest of which was registered in 1997. Complainant also submits a written table listing a large number of additional trademark registrations for the DALKIA mark in many other countries and jurisdictions, though no further trademark office printouts or registration certificates are provided for these. Based upon the evidence presented, the Panel finds that the Complainant has established that the DALKIA trade-mark 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 have "Rights" in its Mark. Although the word appears with an initial capital letter, the term "Rights" is not defined in the Policy. However, Complainant has submitted evidence that it has registered the DALKIA trademark, as noted above. From this evidence, and in the absence of any counter argument or evidence from Respondent, the Panel concludes that Complainant has

demonstrated its ownership of “Rights” in the DALKIA mark for the purpose of Paragraph 3.2(a) of the Policy.

Next, Paragraph 4.1(a) of the Policy requires Complainant to demonstrate 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*” (emphasis added). As noted above, one of the submitted registrations of the DALKIA trademark claims a registration date in 1997 and this is prior to the February 19, 2021 date on which the dalkia.ca domain name was registered. Furthermore, Complainant’s cited trademark registrations remain in effect as of the date of this decision.

Since 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 disputed domain name consisting of “dalkia” is the second level domain relevant for consideration here. The second level of the Domain Name consists of the entirety of Complainant’s trademark and thus is not distinguishable therefrom in appearance, sound or the ideas suggested by the mark. In *Loxone Electronics GmbH v. Heinz Kreutz*, 15909-CDRP (CIIDRC Sep. 18, 2021), the Panel found that “the disputed domain name reproduces the trademark in its totality, namely, ‘LOXONE’”. Here, the Panel similarly concludes that the dalkia.ca domain name identically copies the DALKIA trademark and thus, that Complainant has met the Confusingly Similar requirement of Paragraph 4.1(a).

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. Inherently prerequisite to a finding of bad faith is some attribution of knowledge of a complainant’s trademark, whether actual or based upon a conclusion that a respondent should have known of the mark. See, *Domain Name Arbitration*, 4.02-C (Gerald M. Levine, Legal Corner Press, 2nd ed. 2019) (“Knowledge and Targeting Are Prerequisites to Finding Bad Faith Registration”); *USA Video Interactive Corporation v. B.G. Enterprises*, D2000-1052 (WIPO Dec. 13, 2000) (claim denied where “Respondent registered and used the domain name without knowledge of Complainant for a *bona fide* commercial purpose.”). See also *WIPO Panel Views on Selected UDRP Questions, Third Edition (WIPO Jurisprudential Overview 3.0)*, par. 3.1.1 (when examining whether “circumstances indicate that the respondent’s intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant’s trademark”, Panels may consider such issues as “the respondent’s likely knowledge of the complainant’s rights”). Here, Complainant asserts that “the DALKIA trademark is arbitrary and intensively used in several countries” and that it has become well-known. As such, “Complainant strongly believes that the Respondent knew or should have known the Complainant’s earlier rights on ‘DALKIA’.” In support of these claims Complainant submits only screenshots evidencing four of its trademark registrations. It has not provided a screenshot of its own website or any other evidence of its actual use of the mark<sup>1</sup>. While trademark registrations certainly demonstrate the existence of trademark rights, they do not speak to the results of any advertising, marketing, promotional, or sales efforts nor the level of reputation with the public claimed by Complainant for the DALKIA mark.

However, the Panel notes that the disputed domain name incorporates Complainant’s mark in its entirety and Complainant has provided the results of a “worldwide trademark search [which] failed to reveal any ‘dalkia’ trademarks other than those in the name of the Complainant or its affiliates.” As Respondent has failed to appear in this case or in any way contest Complainant’s assertions or evidence, the Panel is prepared to accept that it is more likely than not that Respondent knew of the DALKIA mark when it registered the dalkia.ca domain name. Had Respondent appeared and presented plausible evidence that it was unaware of Complainant’s rather specialized business-to-business services and mark, Complainant may have faced some challenges in this case.

Next, the Policy provides four frequently occurring examples of bad faith scenarios in Paragraph 3.5. Of the listed

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<sup>1</sup> The Complaint makes reference to “Annex 23” which is supposedly a “simple search on ‘dalkia’ on the Google search engine, [that] reveals the existence of the Complainant and its subsidiary activities”. However, the Panel is unable to locate this Annex in the file. It does not appear in Complainant’s “LIST OF SCHEDULES” and, while the Complaint and the CIIDRC file for this matter mention and include Annexes 1 through 20, neither make any references to Annexes 21 or 22.

examples, none appear directly applicable to the current situation or have been argued by Complainant. However, these are not exclusive and other situations may still qualify to support a claim of bad faith registration. *NAOS v. Kalithasan Sevasamy*, FA 1978937 (FORUM Jan. 28, 2022) (“The nonexclusive nature of [UDRP] Policy ¶ 4(b) allows for consideration of additional factors in an analysis for bad faith...”)

Complainant notes that Respondent is not making any use of the dalkia.ca domain name for a website and it argues that “the lack of active use of the disputed domain name by the Complainant [sic] should not prevent a finding of bad faith”. It thus “contends that the “passive holding” doctrine applies to this case.” Failure to make active use of a domain name can support a finding of bad faith per Policy ¶ 4(a)(iii). See *Leidos, Inc. v. Ramona Mason*, FA 1959354 (FORUM Sep. 13, 2021) (“Respondent’s failure to actively use the at-issue domain name shows bad faith registration and use of the domain name...”.) The WIPO *Overview 3.0, supra*, states that “[w]hile panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.” See also, *Amazon, Inc., Amazon Technologies, Inc., and Eamazon (Canada) Inc. v. Unknown, but appears to be shi lei or Cheng Luo*, DCA-1600-CIRA (CIRA Sep. 24, 2014) (“Examples of what may be cumulative circumstances found to be indicative of bad faith include include the complainant having a well-known trademark, no response to the complaint having been filed, and the registrant’s concealment of is identity.”) Complainant provides a screenshot of the webpage that resolves from the dalkia.ca domain name and this displays a message “This site is inaccessible”. Complainant states that “‘Dalkia’ is an arbitrary term that has no specific meaning either in the French language, the English language and, to the best of the Complainant’s knowledge, in any other language.” Further, there is no substantive content at the dalkia.ca site and the public Whois record for the disputed domain name lists the Registrant only as “Redacted For Privacy”. Finally, Respondent has not filed a Response or made any other submission in this case. As Complainant has made out a *prima facie* case that has not been rebutted by Respondent, the Panel finds, based on the evidence presented and by a balance of probabilities, that the disputed domain name has been registered in bad faith under Paragraph 4.1(b) of the Policy.

Finally, Complainant notes that there is a mail exchange (MX) record associated with the dalkia.ca domain name and asserts that this indicates Respondent’s bad faith intent. When viewed against all of the circumstances of a given case, the configuration of MX records for a disputed domain name may indicate a probability that it will be used in connection with spam, phishing, or other activity that would be considered bad faith use under Policy ¶ 4(a)(iii). See *Equifax Inc. v. Whois Privacy, Private by Design, LLC / Damien Surray*, D2021-2748 (WIPO Oct. 6, 2021) (“The disputed domain name is also associated with MX records, demonstrating that Respondent has the ability to send from and receive email communications to the disputed domain name. Prior UDRP panels have found the association of MX records with a disputed domain name to be evidence of use in bad faith.”), citing *Swiss Re Ltd v. Domain Administrator, Fundacion Privacy Services LTD*, D2021-1549 (WIPO July 19, 2021) Complainant provides a screenshot from the MXTtoolbox.com website indicating that a mail exchange record has been configured for the dalkia.ca domain name. It asserts that this “may indicate bad faith use since the same represents a real risk that the respondent may be engaged in a phishing scheme, aiming to let Internet users to believe they were dealing with the complainant.” While there is no evidence of actual phishing or misuse in evidence, the Panel is inclined to find that the existence of an MX record for the disputed domain name further supports its finding of bad faith registration in light of the uniqueness and lack of third-party use of the DALKIA trademark.

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 Registrant act "in good faith". There is no evidence before the Panel that the Registrant used the dalkia.ca domain name and its associated website in good faith or that it in any other way fit within the scenarios set out in the above-mentioned sub-paragraphs. In the similar UDRP context, see *CrossFirst Bankshares, Inc. v. Yu-Hsien Huang*, FA 1785415 (FORUM June 6, 2018) ("Complainant demonstrates that Respondent fails to actively use the disputed domain name as it resolves to an inactive website. Therefore, the Panel finds that Respondent fails to actively use the disputed domain name for a bona fide offering of goods or services or legitimate noncommercial or fair use under Policy ¶ 4(c)(i) or (iii).") According to the evidence presented, Respondent has made no website use of the dalkia.ca domain name. Therefore, the Panel finds that the provisions of these four sub-paragraphs do not apply here.

Further, the Registrant's name is listed in the registrar-disclosed Whois record as "Nhan Nguyen". Thus, there is no evidence that Respondent's name bears any resemblance to the disputed domain name. Also, there is no geographical reference in the domain name and it does not identify the location of any non-commercial or legitimately operated place of business by Respondent. As such, the provisions of sub-paragraphs 3.4(e) and 3.4(f) do not apply. Finally, non-use of a domain name that is confusingly similar to a complainant's trademark has been held not to evidence any legitimate interest therein. 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 rebut Complainant's assertions or evidence or to otherwise explain its actions in any way.

In light of the submitted evidence and on a balance of probabilities, the Panel finds that Registrant has no legitimate interest in the domain name.

## 5 DECISION and ORDER

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 dalkia.ca be transferred to the Complainant.

Panel:  
 Steven M. Levy, Esq.  
 Date: February 13, 2022

