



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE

DOMAIN NAME DISPUTE

ADMINISTRATIVE PANEL

DECISION

CIIDRC case number:	18093-CDRP	Decision date: 12 September 2022
Domain Name:	fonusmobile.ca	
Panel:	Richard Levy (Chair) Craig Chiasson Barry C. Effler	
Complainant:	Simon Tian	
Registrant:	M Mohammad/ LOOL IPTV Stream Inc.	

1. PROCEDURAL HISTORY

1. The procedural history of this case was set out in a letter dated August 23, 2022, from the Canadian International Internet Dispute Resolution Centre (the "**Provider**") to the Panel, as follows:

1. On July 27, 2022, Simon Tian filed a Complaint pursuant to the Policy and Resolution Rules. The Complaint with the attachments was filed via online CIIDRC's platform.
2. On July 27, 2022, CIRA was notified of this proceeding, and, on the same day, CIRA transmitted its verification response confirming the Registrant's identity. CIRA also confirmed that the disputed domain name was placed on a Registrar LOCK.
3. Under Paragraph 4 "the Provider shall review the Complaint for administrative compliance with the Policy and the Resolution Rules." Upon a review of the Complaint, CIIDRC determined that the Complaint is in administrative compliance with CIRA's requirements under Rule 3.2.
4. On July 27, 2022, CIIDRC confirmed compliance of the Complaint with CIRA's requirements under Resolution Rule 3.2, and commencement of the dispute resolution process.

5. On July 27, 2022, CIIDRC notified the Registrant of this administrative proceeding and forwarded the Complaint to the Registrant via email and Express Post.
 6. The Registrant filed its Response on August 16, 2022.
 7. On August 18, 2022, Zak Muscovitch, counsel retained by the Complainant, filed a supplemental submission, along with appendices, in direct reply to the Registrant's response.
 8. On August 22, 2022, the Complainant filed additional evidence that has developed since the last submission on August 18, 2022.
 9. The Complaint and the Response were filed in English, which shall be the language of the proceeding.
 10. In accordance with Paragraph 6 of the Rules, the Provider shall appoint a three-member Panel, with consideration to the nominees of the parties, and select a Chair.
 11. CIIDRC names Craig Chiasson and Barry Effler, as panelists, Richard levy is named as Chair of the Panel..
2. On August 25, 2022, the Panel provided the following order to the Provider to communicate to the Parties:

ORDER

In accordance with the latest version of the CIRA Domain Name Dispute Resolution Rules, which inter alia, provide that: "(9.1) The Panel shall: (a) conduct the Proceedings in such manner as it considers appropriate in accordance with the Policy and the Resolution Rules;" we have decided to:

1. Accept the Complainant's additional submissions filed on August 18th and on August 22nd, 2022;
 2. Direct the Provider to send these submissions by email to the Registrant or his representative, at the earliest moment possible, if not already sent;
 3. Provide the Registrant with the opportunity to make submissions strictly in response to the Complainant's additional submissions, by no later than 6 pm Eastern Time on Tuesday August 30th;
 4. Direct the Provider to communicate this Order to the Parties.
3. On August 25, 2022, the Provider delivered to the Panel the Complainant's August 18 and 22, 2022 supplemental submissions and additional evidence.
4. The Complainant's August 22, 2022 submission was an email from the Complainant to the Provider which concluded with the following statement:
- If possible, we would like to keep this content strictly confidential (only for the panelists to peruse) as if the Registrant sees it, he may take further action(s) to produce misleading evidence and/or to intervene with us and the case.
5. Our understanding is that the Provider did not deliver the August 22, 2022 submission to the Registrant and therefore the Registrant did not have an opportunity to address its contents in the

Registrant's additional submission. The Panel has not considered the contents of the Complainant's August 22, 2022 submission in reaching its decision.

6. On August 30, 2022, the Provider delivered to the Panel the Registrant's additional submission.
7. No further submissions were permitted or delivered.
8. The Domain Name was registered on June 14, 2021.
9. This matter is conducted pursuant to the Canadian Dispute Resolution Policy (the "**CDRP**" or "**Policy**") and the Canadian Dispute Resolution Rules (the "**Resolution Rules**" or "**Rules**") of the Canadian Internet Registry Authority.

2. FACTS ALLEGED BY THE PARTIES

10. The Complainant alleges the following facts (aspects of which are related to its contentions set out in further detail later in this decision):
 - a. The Complainant is a Canadian citizen and resident born in Montreal, Quebec on February 24, 1994 and therefore meets the Canadian Presence Requirements of the CDRP.
 - b. The Complainant owns the CIPO Trademark Application No. 2024908 for Fonus & Design dated April 28, 2020 and has licensed the Trademark to FONUS INC. for commercial use. FONUS INC. is a limited liability company incorporated under the laws of Delaware and operating in California.
 - c. The Complainant has common law trademark rights in Canada for the Mark "FONUS" in connection with SIM cards and telecommunications.
 - d. FONUS INC. was incorporated by the Complainant on February 9, 2017 and the Complainant remains its sole shareholder and director. FONUS INC. is a mobile virtual network operator, providing telecommunications services, namely, cellular data and voice over Internet Protocol services to customers across the world. It has over 10,000 active customers in Canada as of July 22, 2022.
 - e. FONUS INC. has continuously operated its websites at www.fonus.me and www.fonusmobile.com and has received millions of impressions to its advertisements and websites, including hundreds of thousands from Canada. It has sold tens of thousands of Fonus SIM cards throughout the United States and Canada, including 100 to the Registrant on June 13, 2021.

- f. FONUS INC. has spent more than \$100,000 on online advertising platforms, including Google and Facebook, which the Complainant says has made the FONUS brand distinctive throughout Canada. Accordingly, says the Complainant, it enjoys common law trademark rights for the Mark “FONUS” in Canada (discussed later in this decision).
 - g. In the Complaint, the Complainant says that the Registrant has registered the domain name fonusmobile.ca (the “Domain Name” or “Disputed Domain Name”) and reproduced FONUS INC.’s “entire website content, including is code, graphics, text, and look and feel”. In its August 18, 2022 submission, the Complainant acknowledged that the Registrant has changed elements of its website in response to the Complaint, noting that the evidence submitted by the Registrant omitted a portion of its website which the Complainant says shows that the bottom part of the Registrant’s website continues to be a reproduction of FONUS INC.’s website.
 - h. In its August 18, 2022 submission, the Complainant notes that on August 8, 2022, the Registrant applied for a Canadian Trademark for “fonusmobile”.
 - i. According to the Complainant, the Registrant’s “infringing website” impersonates FONUS INC., deceives its customers and potential customers, diverts traffic and business from FONUS INC.’s own website, phishes for personal customer information, interferes with FONUS INC.’s contractual relations and business interests and passes itself off as FONUS INC. for the purpose of unlawfully generating illicit profits.
 - j. The Complainant says that the Registrant’s conduct has caused FONUS INC. to suffer unquantifiable net loss of website visits and sales, and significant customer confusion by deceiving customers into thinking that the Registrant’s website is an official FONUS INC. website, including that existing and potential customers have tried to contact FONUS INC. through the Registrant’s website, effectively siphoning them from FONUS INC.
11. The Registrant alleges the following facts (some of which also relate to its contentions set out in further detail later in this decision):
- a. FONUS INC., being a Delaware company with a business address in California, does not meet the Canadian Presence Requirements.
 - b. FONUS INC. provides the services through its offices in California; the Complainant does not provide the services.
 - c. The Complainant’s application for Trademark Registration in Canada (on April 28, 2020) was for a design Mark and not a word Mark (unlike the United States application of the same date, which was abandoned).

- d. The Complainant owns no registered Trademarks in the United States or Canada, so he cannot license it to FONUS INC.
 - e. The Word Mark “FONUS” is registered in the United States as of April 10, 2012 by another company, IWEBNET Limited Liability Company.
 - f. The Registrant is a Canadian citizen and registered the Domain Name on June 14, 2021, one day after purchasing 100 SIM cards from FONUS INC, and after having reviewed the Complainant’s April 28, 2020 Trademark Application.
 - g. On October 24, 2021, the Registrant conducted a NUANS name search for fonusmobile, which came out negative. The Registrant then incorporated “fonusmobile Incorporated” on October 27, 2021.
 - h. On July 9, 2022, the Complainant received a pre-assessment letter from CIPO stating that the goods and services were not acceptable for pre-approved Trademark Registration.
 - i. The Registrant says FONUS INC. cannot provide telecommunications services in Canada – and therefore cannot use the “Mark” (even if a common law Mark exists) in association with goods and services provided in Canada – because it is not registered with the Canadian Radio-television and Telecommunications Commission (“**CRTC**”).
12. Both Parties refer to WhatsApp messages between the Complainant and the Registrant between approximately July and October 2021 (the contents of which will be addressed later in this decision as appropriate).
 13. On July 18, 2022, the Complainant, through counsel (Muscovitch Law P.C.) sent a demand letter to the Registrant, which included a demand that the Registrant transfer the Domain Name to the Complainant and remove the website from the internet. No response was received.
 14. The Registrant included a “Bill of Costs” dated August 16, 2022 with its Response of the same date.
 15. In the next section of this decision, we set out the Parties respective contentions arising from, and expanding on, the above-described factual background.

3. CONTENTIONS OF THE PARTIES

- **Complainant**
16. Complainant, Simon Tian, submits he satisfies the Canadian Presence Requirement, having provided evidence of being a citizen and resident of Canada.

17. He submits he has used the trademark FONUS in Canada in association with the sale of SIM cards and the provision of mobile virtual network operator (MVNO) services over VoIP on his websites fonus.me and fonusmobile.com continuously since November 19, 2019 and has provided screen shot evidence of this.
18. Mr. Tian submits that whether or not he has to register with the CRTC to provide telecommunication services in Canada is irrelevant to the current domain name dispute.
19. He submits he filed an application for the mark FONUS design on April 28, 2020 in association with mobile telephone goods and services, and that he has provided evidence of this.
20. Complainant states that he licensed use of the mark FONUS to the Delaware corporation, Fonus Inc., incorporated on February 9, 2017, and that the corporation, of which he is the sole shareholder and director, used the mark in Canada according to this licence.
21. Complainant states that there have been hundreds of thousands of impressions of his websites in Canada, substantial online advertising regarding his sale of SIM cards on Google and Facebook in Canada, tens of thousands of SIM cards sold from his sites in the US and Canada and about 10,000 active customers in Canada.
22. Mr. Tian submits that he alone used the word FONUS in connection with mobile telephone goods and services in Canada until Registrant began to do so beginning with his registration of the Disputed Domain Name on June 14, 2021. He also submits that any use or registration in the United States of FONUS by a third party is irrelevant to this dispute.
23. Complainant states that on June 13, 2021 Registrant purchased 100 SIM cards from Complainant bearing the mark FONUS on them and that therefore Registrant was aware of Complainant's use of that mark in Canada when Registrant registered the Disputed Domain Name on June 14, 2021, the next day.
24. He submits that although he authorized Registrant to be a reseller of FONUS branded SIM carts, he did not authorize Registrant to copy the code, graphics, and text of Complainant's website, fonusmobile.com, which, he submits, is what Registrant did in creating his original website at fonusmobile.ca.
25. Complainant submits he sent a cease-and-desist letter to Registrant on October 24, 2021, following which Registrant admitted "Yes this is my fault" and changed the look and feel of his website.

26. Complainant submits that when he also asked Registrant to transfer the Disputed Domain Name to him, Registrant agreed only to rent the domain name to him, (writing that “renting is better than selling to you”) which Complainant refused to do.
27. Complainant states that Registrant then removed the redirect of the site linked to the Disputed Domain Name to another website and again created a misleading website page replete with elements copied from Complainant’s page.
28. Complainant submits that his customers are confused by seeing the same graphic and word elements in Registrant’s website as in Complainant’s and provides an example of this confusion.
29. Complainant submits, with evidence, that he had his attorney send a final demand letter to Registrant on July 18, 2022.
30. Complainant submits that he had Rights in the marks FONUS and FONUSMOBILE prior to the date of Registrant’s registration of the Disputed Domain Name and that he continues to have such rights.
31. Complainant submits that the Disputed Domain Name so nearly resembles the marks FONUS and FONUSMOBILE in appearance, sound or idea as to be likely to be mistaken for these marks and that he has therefore satisfied the onus of proving the Disputed Domain Name is confusingly similar with his marks, under section 4.1(a) of the Policy and the criteria under section 3.3.
32. Complainant submits that Registrant registered the Disputed Domain Name primarily for the purpose of renting the registration to Complainant for valuable consideration in excess of Registrant’s actual costs, thereby providing evidence under s. 3.5 (a) that he registered the disputed domain name in bad faith.
33. Complainant submits that Registrant registered the Disputed Domain Name to prevent Complainant from registering his mark as a domain name in Canada, and that under s. 3.5 (b), he has shown that Registrant registered the disputed domain name in bad faith.
34. Complainant submits that, as contemplated in s. 3.5 (c), Registrant registered the Disputed Domain Name primarily for the purpose of disrupting the business of Complainant, who is a competitor of Registrant, submitting as evidence that Registrant registered a corresponding CBCA corporate name, Fonusmobile Incorporated, on October 27, 2021 and filed a trademark application at CIPO for FONUSMOBILE in association with “batteries for cell phones” on August 8, 2022.
35. Complainant submits that, as contemplated in s. 3.5 (d), Registrant intentionally attempted to attract for commercial gain users to Registrant’s websites by creating a likelihood of confusion

with Complainant's marks as to source or the endorsement by Complainant of Registrant's websites or the products or services on Registrant's websites, specifically the cellphone accessories that are in the same channels of trade, which are sold on such websites.

36. Complainant submits that Registrant has not demonstrated any of the circumstances enumerated, without limitation, in section 3.4 of the Policy, which would prove that that Registrant has a legitimate interest in the Disputed Domain Name, Complainant stating specifically that:
- a. He rather than Registrant has common law rights in FONUS and FONUSMOBILE;
 - b. FONUS and FONUSMOBILE are not clearly descriptive in Canada under the criteria in paragraph (b)
 - c. FONUS and FONUSMOBILE are not generic names in any language under the criteria in paragraph (c);
 - d. Registrant used the marks in association with commercial activities;
 - e. The domain name did not comprise any of the names of Registrant under the criteria in paragraph (e)
 - f. The domain name was not the geographic name or location of Registrant's non-commercial activity
37. Complainant submits that Registrant has not proved any other circumstances, based on evaluation of all evidence presented, that demonstrates that Registrant has a legitimate interest in the Disputed Domain Name.
38. Complainant submits that he has met his onus to prove on a balance of probabilities under section 4.1 of the Policy that (a) the domain name is confusingly similar with his marks, (b) Registrant registered the domain name in bad faith and (c) Registrant does not have a legitimate interest in the domain name.
39. Complainant submits that Registrant is not entitled to be awarded its submitted costs by the Panel, as he did not make an actual request for such costs, as required under section 5.2(g) of the Rules.
- **Registrant**
40. Registrant, Mohammad Mohammad, submits that the Complainant is merely the agent of Fonus Inc, a Delaware Corporation, which is the user of the word FONUS as well as the domain name FONUSMOBILE.COM and that Fonus Inc. does not meet the Canadian Presence Requirement.

41. Registrant states that Complainant has no common law rights in the word mark FONUS, that such word is not distinctive in Canada regarding the goods and services of Complainant, that Fonus Inc. has rights only in a distinctive design version of the word and that Complainant's application for such design version was denied pre-approval by CIPO of the listed goods and services.
42. Registrant submits that on August 8, 2022, it applied for registration of the mark FONUSMOBILE in association with batteries for cellphones.
43. Registrant submits that Complainant cannot provide telecommunication services in Canada without the involvement of the CRTC, but that Registrant need not register with the CRTC as he is in a completely different business selling cellphone accessories.
44. Registrant submits that neither of the invoices to Complainant from Google and Facebook for online advertising indicates whether the ads were for the Canadian or US markets.
45. Registrant submits that Complainant has not shown that he or his company has an established goodwill in the word FONUS in the Canadian market.
46. Registrant submits, that on October 27, 2021, he incorporated FONUSMOBILE INCORPORATED under the CBCA and that the NUANS search accompanying his Federal Reservation Report had negative results with respect to other parties using a similar name to Fonusmobile.
47. Registrant submits that that many other suppliers use the term FONUS in Canada, citing as evidence a registration for FONUS F & Design in the U.S., which he submits, and use by Fonus Accessories in Canada, for which he does not submit evidence.
48. Registrant submits that there is precedent for denial of Complainant's claim in a previous decision under the CDRP in which the Panel found the complainant in that case did not have rights to the term CMI, as there were many other users of that term in the Canadian market.
49. Registrant submits that Complainant authorized him to be a reseller of SIM cards in Canada at the time he registered the Disputed Domain Name and that the goods and services he now sells on his website are very different from those of Complainant.
50. Registrant contends that fonusmobile is not confusingly similar with a mark Complainant has rights to and that accordingly Complainant has not met its onus under 4.2(a) of the Policy.
51. Registrant contends that he did not register the Disputed Domain Name in bad faith, as contemplated under section 4.1 (b) of the Policy, and that it was not his intention at the time of registration to rent the Disputed Domain Name to Complainant for valuable consideration.

52. Registrant contends that he had no intention of diverting users from Complainant's website to his own, as demonstrated by his having removed any resemblance to Complainant's website after their conversations.

53. Registrant contends that the Disputed Domain Name comprised the distinctive portion of his corporation, Fonusmobile Incorporated, and that therefore he had a legitimate interest in the Disputed Domain Name under sections 4.1(c) and 3.4 of the Policy

54. Registrant submits a Bill of Costs for \$6,545.25, that includes the sentence, "A Claim for fees is being made with respect to the following professionals", presumably doing so under section 4.6 of the Policy and Rule 5.2(g) which provides a remedy in the event the Panel finds bad faith on the part of a complainant.

- **Remedy Sought**

55. The Complainant requests the Disputed Domain Name be transferred to it.

56. The Registrant submits a Bill of Costs with a claim in it for fees of \$6,545.25, to be paid by the Complainant.

4. DISCUSSION AND FINDINGS

4.1 Eligibility

57. We find that the Complainant is an eligible complainant under paragraph 1.4 of the CDRP. The Complainant is a Canadian citizen of the age of majority under the laws of the province or territory in Canada in which he or she resides or last resided.

4.2 Requirements

58. In accordance with Paragraph 4.1 of the CDRP, the onus is on the Complainant to prove:

- That the Domain Name is Confusingly Similar to a trademark or service mark in which the Complainant has rights:
- That the Registrant has no legitimate interests in the Domain Name; and
- That the Domain Name has been registered in bad faith.

59. We will consider each of these requirements in turn.

4.3 Analysis

4.3.1 That the Domain Name is Confusingly Similar to a Mark in which the Complainant has Rights

60. The Complainant claims that it has rights in a common law mark that was a “Mark” prior to the date on which the Domain Name was registered. As discussed, we have found that the Complainant has rights in the Mark “fonus”. The word “mobile” is a common word and adds no unique information. Thus, fonusmobile contains the Complainant’s exact Mark and the inclusion of the word “mobile” does nothing to distinguish the Domain Name.

61. We are satisfied that the Domain Name is confusingly similar to the Complainant’s Mark.

4.3.2 That the Registrant has No Legitimate Interest in the Domain Name

62. Paragraph 3.4 of the CDRP sets out circumstances which if found by the Panel would show the Registrant has a legitimate interest in the Domain Name:

3.4 Legitimate Interests. For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall 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.

63. In pParagraph 3.4(d) “use” by the Registrant includes, but is not limited to, use to identify a web site.

64. We considered each provision and determined that none apply. Paragraph 3.4 (a) does not apply as the Registrant has no rights in the Mark of the Complainant or any other relevant mark placed

into evidence for this hearing. No evidence supports the application of any of the other subparagraphs.

4.3.3 That the Registrant has Registered the Domain Name in Bad Faith

65. We find, on a balance of probabilities, as contemplated in Paragraph 3.5 (c), taking into consideration the facts that Registrant registered a corresponding CBCA corporate name, Fonusmobile Incorporated, on October 27, 2021, and filed a trademark application at CIPO for FONUSMOBILE in association with “batteries for cell phones” on August 8, 2022, that Registrant registered the Disputed Domain Name primarily for the purpose of disrupting the business of Complainant, who is a competitor of Registrant, and that this constitutes evidence that Registrant has registered the Disputed Domain Name in bad faith.
66. We find, on a balance of probabilities, as contemplated in Paragraph 3.5 (d), taking into consideration the facts that Registrant copied the look and feel of Complainant’s website and retained many of the copied elements even after protest by Complainant and used the Complainant’s marks FONUS and FONUSMOBILE on its website in association with similar goods in the same channel of trade, that Registrant intentionally attempted to attract for commercial gain users to Registrant’s website by creating a likelihood of confusion with Complainant’s marks as to source or the endorsement by Complainant of Registrant’s websites or the products or services on Registrant’s websites, and that this constitutes evidence that Registrant has registered the Disputed Domain Name in bad faith.

5 Costs

67. As noted above, the Registrant included a “Bill of Costs” dated August 16, 2022 with its Response of the same date.
68. Given that the Complainant has been successful in this proceeding, the Registrant is not entitled to costs and none are awarded.

6 DECISION and ORDER

69. For the above reasons, in accordance with Paragraph 4 of the CDRP, Paragraph 12 of the Resolution Rules, the Panel orders that: the Disputed Domain Name fonusmobile.ca be transferred to the Complainant

Made as of 12 September 2022

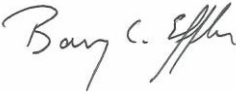
SIGNATURE OF PANEL



Richard Levy (Chair)



Craig Chiasson



Barry C. Effler

