



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

CIIDRC case number:	18865-CDRP	Decision date: December 26, 2022
Domain Name:	monsmile.ca	
Panel:	Claude Freeman, LL.M., C.Med., C. Arb.	
Complainants:	Clinique MonSmile St-Sauveur, Gestion MonSmile Inc., Immobilier MonSmile Inc.	
Registrant:	Studyland	

1. PROCEDURAL HISTORY

The procedural history of this case was set out in a letter dated December 8, 2022, from the Canadian International Internet Dispute Resolution Centre to the Panel.

The particulars of the case are as follows:

On November 7, 2022, Eric Catalogna, on behalf of the Complainant, filed a Complaint pursuant to the CDRP and the Resolution Rules.

On November 7, 2022, CIRA was notified of this proceeding. On the same date, CIRA transmitted by email to CIIDRC its verification response informing who is the Registrant of the disputed domain name. CIRA also confirmed that the <monsmile.ca> domain name was placed on a Registrar LOCK. On the same date, CIRA also transmitted in its verification response the confirmation of the Registrant's identity as follows:

Name: Studyland
 Preferred language: English
 Organization: Studyland
 Email: hamza.fathallah.ca@gmail.com
 Phone: 5145135350
 Fax:
 Country: Canada
 Street: 5370 St-Michel
 City: Montréal

Domain Name: monsmile.ca
18865-CDRP

Province/State: Quebec
Postal code/Zip code: H1Y2C9

CPR category: Corporation
WHOIS privacy: Public
CIRA Registrant Agreement version: 2.2
Agreed by Registrant: 2022-06-23T15:13:03.322Z

On November 7, 2022, CIIDRC, as Service Provider, checked the complaint for compliance and determined that it was deficient.

On November 16, 2022, the complaint was resubmitted.

On November 17, 2022, the Centre reviewed the complaint again and it was found to be compliant, and November 17, 2022, was the commencement of the dispute resolution process.

Pursuant to Resolution Rule 4.4, CIIDRC notified the Registrant of this administrative proceeding and forwarded a copy of the complaint and the commencement letter to the Registrant's mailing address.

On December 6, 2022, the Complainant made additional submissions that arose after the filing of his initial complaint.

The Registrant failed to file its response by the due date of December 7, 2022.

The Complainant in this administrative proceeding elected for a Panel consisting of a single member.

On December 8, 2022, the Centre appointed this panel member to conduct the arbitration of this complaint.

This matter is conducted pursuant to the Canadian Dispute Resolution Policy (the CDRP) and the Canadian Dispute Resolution Rules (the Resolution Rules) of the Canadian Internet Registry Authority.

2. FACTS ALLEGED BY THE PARTIES

The Complainant:

The Complainant has submitted a brief but succinct written history of the Complainant's business history, inclusive of various Annexes as outlined below.

- a) The Complainants: Clinique MonSmile St-Sauveur (which is the operating clinic), Gestion MonSmile Inc. (the holding entity that holds the shares of two clinics), and Immobilier MonSmile Inc. (which holds the buildings that were acquired during the acquisition of a clinic in Montréal). These are intertwined with each other in the practice of dentistry clinic(s) by Dr. Scalia, the owner of these. All these have the branding on "MonSmile".
- b) The history of these clinics, and particularly the MonSmile clinic in St. Sauveur, Québec, dates back to some 35 years as it was operated by a Dr. Durocher for some 35 years prior to the acquisition of this by Dr. Scalia some 5 or so years ago. Since the acquisition by Dr. Scalia, the dentistry practice has branded itself

with a web site (the domain name in dispute), and thus leading to the marketing initiative that has seemingly led to this dispute.

- c) The Complainant submits as of the date of the November, 2022 complaint, that some months ago that they mandated a company called Starkad Inc. to do some marketing for the dental practices by way of the website and Google suites in which the emails were operated through. The Complainant also submits having paid Starkad well over \$30,000 to fulfil this marketing initiative. The Complainant further submits that some weeks prior to the filing of the complaint that an individual whom they had never met (named Hamza), and who apparently had worked for Starkad approached the Complainant seeking some \$12,000 from the Complainant for the work that Hamza performed for Starkad on this project and for which he alleges he wasn't paid by Starkad. There also ensued various emails and communications between Hamza and the Complainant of which the communications included some in writing, and as submitted by the Complainant in Annexes indicate that Hamza offered the Complainant 2 choices of payment for return of the website. One of these written communications indicate that in the event of non-payment by the Complainant, the Disputed Domain Name (monsmile.ca) would be sold in Europe, the clinic's email and calendar would be destroyed. The communications indicated that upon payment to the Registrant, the disputed domain name would revert back the Complainant.

The Registrant:

No Response has been filed.

3. CONTENTIONS OF THE PARTIES

The Complainant:

The Complainant straightforwardly submits that the Disputed Domain Name (monsmile.ca) is the sole property mark and of the Disputed Domain Name. These include excerpts from the Régistraire des Entreprises du Québec (REQ), attesting to the registration of each of the Complainants with the Québec government business registry. Two of these were registered in 2022 and one in 2020. Another Annexe includes a copy of the employee manual and contract which embeds the MonSmile name and logo. Finally, one Annex submitted by the Complainant and labelled as: Proof of Trademark MonSmile are pictures of the dentistry clinic in St. Sauveur, Québec. The submissions point/allude to clear use and ownership of the "MonSmile" name and logo, and that no licence or other written agreement between the MonSmile dentistry clinic/business has ever existed with the Registrant.

The Complainant's submissions (as below) are very straight to the point:

- a) That the Trademark/Service Mark Information: The (logo) is on all documents, in addition to all contracts/manual for employees, cheques, bank accounts et al.
- b) Trademark/Service Mark Similarities: The gentleman (Hamza) has no brand associated to this name (MonSmile).

- c) Respondent Domain Rights: That the Registrant has absolutely no right or interest in the domain, other than he is trying to extort money from the Complainant, and that they have never conducted any business with this individual, nor ever met him.
- d) Domain Names used in Bad Faith: Extreme bad faith. Emails and text messages attached as Annexes to show that he has no business interest in the name other than trying to reduce his losses from Starkad (the marketing company that the clinic had mandated).
- e) Further, the Complainant submits that the degree of urgency with this proceeding is an extremely crucial time for the clinic where marketing is most important for new patient generation, and without a website, this is extremely difficult to do.

The Registrant:

No Response has been filed.

The Remedy Sought:

The Complainant requests the Domain Name be transferred to it.

4. DISCUSSION AND FINDINGS

4.1 Eligibility

Paragraph 1.4 of the Policy requires that in order to initiate the Complaint, the Complainant at the time of the initiation of the Complaint must satisfy the Canadian Presence Requirements for Registrants v 1.3 ("Canadian Presence Requirements") unless the Complaint relates to a trademark registered in the Canadian Intellectual Property Office ("CIPO") and the Complainant is the owner of that trademark.

The Panel therefore determines that the Complainant has satisfied the provisions of paragraph 1.4 of the Policy, and that the Complainant is an eligible complainant under paragraph 1.4 of the CDRP.

4.2 Requirements

The purpose of the Policy, as stated in Paragraph 1.1 of the Policy as referenced above, is to provide a forum in which cases of bad faith registration of .ca domain names can be dealt with relatively inexpensively and quickly.

Paragraph 4.1 of the Policy puts the onus on the Complainant to demonstrate this "bad faith registration" by proving on a balance of probabilities that:

1. The Mark qualifies as a "Mark" as defined in Paragraph 3.2 of the Policy,
2. The Complainant had "Rights" in the Mark prior to the date of registration of the Domain Name and continues to have "Rights" in the Mark,
3. The Domain Name is "Confusingly Similar" to one or more of the registrations comprising the Mark as the

concept of “Confusingly Similar” is defined in Paragraph 3.3 of the Policy,

4. The Registrant does not have a “legitimate interest” in the Domain Name as the concept of “legitimate interest” is defined in Paragraph 3.4 of the Policy, and
5. The Registrant or an unknown third party has registered the Domain Name in “bad faith” in accordance with the definition of “bad faith” contained in Paragraph 3.5 of the Policy.

If the Complainant is unable to satisfy this onus, bad faith registration is not demonstrated, and the Complaint fails.

The Panel will consider each of these requirements in turn.

4.3 Analysis

Notice to the Registrant

As noted above, after CIIDRC had determined the Complaint to be in administrative compliance with the requirements of Paragraph 3.2 of the Rules, by way of an emailed Transmittal Letter dated November 17, 2022, CIIDRC forwarded a copy of the Complaint to the Registrant in accordance with Paragraphs 2.1 and 4.3 of the Rules. Paragraph 2 of the Rules entitled “Communications” requires that CIIDRC give to a registrant notice of a complaint being filed against a domain name which is registered in the name of the registrant. Such notice will be deemed to have been given to this registrant provided that CIIDRC uses one of the various methods of communication as listed in Paragraph 2, and provided that such communication is directed to the address shown in the registration information for that registrant for the domain name in question.

The term “Registration Information” is defined in the Rules as:

“Registration Information” means the information of record regarding a Registration in the Registry’s WHOIS database. Though the identity of the Registrant is not publicly published in the WHOIS database, it is clear from the evidence before the Panel that CIIDRC in forwarding a copy of the Transmittal Letter and a copy of the Complaint to the party and to the address set forth as the registration information by CIRA in their database with respect to the Domain Name, that CIIDRC complied with the notice provision contained in Paragraph 2 of the Rules. It is also highly likely that with CIRA placing a Registrar LOCK on the Domain Name, this action served to further alert the Registrant of proceeding.

The Panel, therefore, finds that the Registrant is deemed to have been given notice(s) of the Complaint.

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

The Mark

In the matter at hand, the relevant portions of Paragraph 3.2 of the Policy states that for the purpose of the Policy a “Mark” is: (a) a trademark, including the word elements of a design mark, or a trade name that has been used in Canada by a person, or the person’s predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person;

The information provided indicates the Complainant has used the Mark in Canada to distinguish its services and business from any other provider of similar financial products/services or business.

This use by the Complainant of the Mark commenced before the registration of the Domain Name by the Registrant became known to the Complainant.

The Complainant continues to so use their Mark in Canada.

The Panel finds that the Complainant has established that the Mark qualifies as a “Mark” for the purposes of Paragraph 3.2(a) of the Policy.

Rights

Paragraph 3.1 of the Policy requires that the Complainant has “Rights” in the Mark. Unfortunately, the term “Rights” is not defined in the Policy.

However, given the evidence before the Panel of the Complainant’s ownership and use of the Mark in Canada, the Panel finds that the Complainant has “Rights” in the Mark for the purpose of Paragraph 3.1 of the Policy.

Confusingly Similar

The Policy in Paragraph 3.3 provides that the Domain Name will be found to be “Confusingly Similar” to the Mark only if the Domain Name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as likely to be mistaken for the Mark.

As 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 Domain Name consisting of “MonSmile” is the portion of the Domain Name relevant for consideration.

The Domain Name consists of the word “MonSmile”. To satisfy the onus placed upon it by the Policy, the Complainant must demonstrate that the addition of any word(s) or suffix (such as .ca) to the Mark in the Domain Name is not sufficient to distinguish the Domain Name from the Mark so that the Domain Name can not be said to so nearly resemble the Mark in appearance, sound or the ideas suggested by the Mark as likely to be mistaken for the Mark.

The test to be applied when considering confusing similarity is one of first impression and imperfect recollection. Will a person as a matter of first impression, knowing only the complainant’s corresponding trademark (but having Domain Name “MonSmile.ca”), likely mistake the disputed domain name for the complainant’s trademark based upon the appearance, sound or the idea suggested by the trademark?

In the matter at hand, the Panel finds that the Mark is sufficiently known in Canada as reflecting the goodwill of the Mark by the Complainant who are engaged in their business of dental clinics. The Panel is therefore, satisfied that the Complainant has met the confusingly similar requirement of Paragraph 3.3.

The Panel finds that the Complainant has met the onus placed upon it by Paragraph 3.3 of the Policy and has demonstrated that 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.

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

Paragraph 4.1 of the Policy requires that to succeed in the Complaint, the Complainant must provide some evidence that the Registrant has no legitimate interest in the Domain Name as the concept of “legitimate interest” is provided for in Paragraph 3.4 of the Policy.

Paragraph 3.4 of the Policy provides that the Registrant has a legitimate interest in a domain name if:

- 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.

In Paragraph 3.4(d) “use” by the Registrant includes, but is not limited to, use to identify a website. It is to be noted that with respect to the matter at hand, in Paragraphs 3.4(a), (b), (c), and (d), there is a requirement that the Registrants act “in good faith”.

There is no evidence before the Panel that the Registrant used the Domain Name and the website to which the Domain Name resolves in good faith. Further, the Complainant submits that the Registrant has no license or contract allowing him to use their Name/Mark, and that the Registrant’s name appears not to be included in the Domain Name, nor in any official Government of Québec business filing records in connection with the Domain Name in Dispute or of any of the Complainants herein.

The Panel finds that the Complainant has provided evidence that the Registrant has no legitimate interest in the Domain Name.

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

Under Paragraph 3.5 of the Policy, the Registrant will be considered to have registered the Domain Name in bad faith if, and only if, the Complainant can demonstrate that the Registrant in effecting the registration of the Domain Name was motivated by any one of the four general intentions set out in Paragraph 3.5.

Of these intentions, the form of intention contained in Paragraph 3.5(d) is the one most applicable to the matter at hand.

Paragraph 3.5(d) provides as follows:

- (d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant’s website or other on-line location, by creating a likelihood of confusion with the Complainant’s Mark as to the

(d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website 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 the Registrant's website or location or of a product or service on the Registrant's website or location.

Based upon the evidence before the Panel and especially the Registrant's failure to provide any response or accurate information in the registration information with respect to the Domain Name, the Panel finds that the Complainant has satisfied the provisions of Paragraph 3.5 (d) of the Policy by establishing that that the Registrant has intentionally attempted to attract/redirect for commercial or other gain, traffic to the website to which the Domain Name resolves by creating a likelihood of confusion with the Mark as to the source, sponsorship, affiliation, or endorsement of such website.

5 DECISION and ORDER

Decision:

As was above set out, Paragraph 4.1 of the Policy provides that to be successful in the Complaint the Complainant has the onus of proving on a balance of probabilities three specific items and of providing some evidence that the Registrant has no legitimate interest in the Domain Name.

The Panel finds that the Complainant has satisfied this onus with respect to all three of these items by demonstrating that the Mark qualifies as a Mark in accordance with Paragraph 3.2 of the Policy; that the Domain Name is Confusingly Similar to the Mark; and that the Registrant has registered the Domain Name in bad faith in accordance with the provisions of Paragraph 3.5 of the Policy.

The Panel also finds that the Complainant has shown evidence that the Registrant does not have a legitimate interest in the Domain Name in accordance with the provisions of Paragraph 3.4 of the Policy.

The Panel therefore finds that the Complainant has satisfied the onus placed upon it by Paragraph 4.1 of the Policy and is entitled to the remedy sought by it.

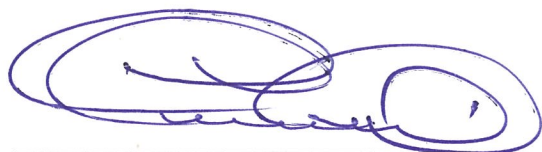
Order:

The Complainant in the Complaint seeks an order in accordance with the Policy and the Rules directing that the registration of the Domain Name be transferred from the Registrant to the Complainant.

For the above reasons, in accordance with Paragraph 4 of the Policy and Paragraph 12 of the Rules, the Panel orders that the Domain Name (monsmile.ca) be transferred to the Complainant.

Made as of December 26, 2022

SIGNATURE OF PANEL

A handwritten signature in blue ink, appearing to be 'Claude Freeman', written over a horizontal line.

Claude Freeman, LL.M., C.Med., C. Arb.

