

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

Domain Name: isic.ca

Complainant: Canadian Federation of
Students-Services

Registrant: Nameshield Inc.

Registrar: Dot-ca-registry.ca (Burmec
Business Systems Ltd.)

Panellist: Sharon Groom

Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. Canadian Federation of Students-Services (the “**Complainant**”), is a federal not-for-profit corporation under the laws of Canada located in Ontario, Canada.
2. The registrant for the domain name is Nameshield Inc. (the “**Registrant**”), a federal corporation under the laws of Canada located in Prince Edward Island, Canada.

B. The Domain Name and Registrar

3. The disputed domain name is isic.ca (the “**Domain Name**”). The registrar for this domain name is dot-ca-registry.ca (Burmec Business Systems Ltd.) (the “**Registrar**”). The disputed Domain Name was registered on December 17, 2014 by the Registrant.

C. Procedural History

4. This is a proceeding under the Canadian Internet Registration Authority (“**CIRA**”) *Domain Name Dispute Resolution Policy* (Version 1.3) (the “**Policy**”) and the CIRA *Domain Name Dispute Resolution Rules* (Version 1.5) (the “**Rules**”).

5. The history of the proceeding as provided by the dispute resolution service provider, Resolution Canada, Inc. (“**Resolution Canada**”), is that the Complainant filed a complaint on September 20, 2022 against the Registrant with Resolution Canada requesting that the current registration of the Domain Name be transferred to the Complainant.
6. Resolution Canada served notice of the complaint on the Registrant as required by paragraph 4.3 of the Rules to the email address provided by CIRA.
7. The Registrant was given 20 days to file a response and on September 29, 2022 the Registrant requested an extension of time to respond. An extension was granted until October 19, 2022 but no response was filed. The panel was therefore appointed on November 7, 2022.

D. Panel Impartiality and Independence

8. As required by paragraph 7 of the Rules, the panel has submitted to Resolution Canada a declaration of impartiality and independence in relation to this dispute.

E. Canadian Presence Requirements

9. The Complainant is a federal not-for-profit corporation incorporated in Canada. Therefore, the Complainant satisfies the Canadian Presence Requirements under paragraph 2(d) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3.

F. Factual Background

10. The Complainant is the operator in Canada of the International Student Identity Card (ISIC) program. This program issues identity cards for students which prove they are a student and thus entitles them to student discounts and other benefits. The card is available in over 130 countries and has been issued for over 60 years. The card was first offered in Canada in 1998 and in 2014 when the Domain Name was registered there were over 107,000 cards issued in Canada.
11. The trademark ISIC is owned by ISIC Association, which is a non-profit organization based in Denmark. The Complainant has filed an affidavit of Corey Grist, Director of Operations & Services of the Canadian Federation of Students which through its services corporation (the Complainant) operates the ISIC card program in Canada. In his affidavit Mr. Grist states that the Complainant is the exclusive licensee in Canada of the ISIC trademark for use in association with the issue, distribution, promotion and development of the ISIC program and ISIC branded identity cards in Canada and has been the licensee since at least as early as 1998.

12. ISIC Association has registered the ISIC trademark in various design forms in Canada, the earliest of which was registered in 1993 under reg. no. TMA414189.
13. The Complainant has provided evidence that the Registrant is a federal corporation and the sole listed director is Daniel Mullen. Mr. Mullen, either through his own name or through corporations of which he is a director, has been involved in at least 5 previous CDRP decisions where the panel has found against Mr. Mullen or his corporations.
14. The current Domain Name resolves to a pay-per-click website depicting links referring to the ISIC card as well as other products directed to students.
15. The Complainant contacted the Registrant on July 7, 2022 through the Registrant's administrative contact Daniel Mullen and asked if there might be an opportunity to purchase the Domain Name. Mr. Mullen suggested the Complainant make an offer and the Complainant therefore offered \$500 and indicated that it was the holder of trademark rights in ISIC. Upon receiving this information the Complainant indicated that Mr. Mullen stated: "You should have said you had a trade-mark interest as we process them for a flat fee of \$800 USD but since you are coming to us in bad faith, you should proceed to a CDRP."

G. *CIRA Domain Name Dispute Resolution Policy*

16. Paragraph 4.1 of the Policy requires that the Complainant establish 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;
 - b) the Registrant has registered the domain name in bad faith as described in section 3.5; and
 - c) the Registrant has no legitimate interest in the domain name as described in section 3.4.
17. The Complainant must prove points (a) and (b) above on the balance of probabilities and for point (c) it must provide some evidence that the Registrant has no legitimate interest in the domain name. 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 as described in section 3.4 of the Policy.

H. Analysis

Rights to a Mark

18. Under paragraph 4.1(a) of the Policy, the Complainant has to show, on the balance of probabilities, that it had rights (and continues to have rights) in a mark that was confusingly similar to the domain name, prior to the date of registration of the disputed domain name.
19. The Domain Name was registered on December 17, 2014, therefore this is the earliest possible relevant date for this analysis.
20. A “Mark” is defined in paragraphs 3.2(a) and (c) of the Policy as:
 - (a) a trade-mark, including the word elements of a design mark...that has been used in Canada by a person...for the purpose of distinguishing the wares, services or business of that person... or a licensor of that person... from the wares, services or business of another person;
 - (c) a trade-mark, including the word elements of a design mark, that is registered in CIPO;
21. The Complainant has submitted evidence of its licensor’s registration of the trademark ISIC design that was obtained in Canada in 1993. A subsequent registration for ISIC design was obtained in 2010 and in 2018 an application was filed for a new version of the ISIC design. The Complainant has also provided evidence of current use of the ISIC design mark on student cards and on its website isiccanada.ca. Given the active registrations for design marks the word elements of which, ISIC, match the Domain Name, and given the evidence of current use of the word element ISIC as part of the current design mark, the panel finds that the Complainant has established that it had rights in the mark ISIC prior to the date of registration of the Domain Name, and continues to have these rights.
22. The Domain Name (apart from the .ca component) consists solely of the term ISIC, which is the same as the Complainant’s trademark. Therefore, pursuant to paragraph 3.3 of the Policy, the panel finds that the Domain Name is confusingly similar to the mark ISIC as it so nearly resembles the trademark in appearance, sound and in the idea suggested by the trademark as to be likely to be mistaken for the trademark.

Bad Faith

23. The Complainant also has to prove, on the balance of probabilities, that the Domain Name was registered in bad faith. Paragraph 3.5 of the Policy deals with the grounds

which constitute bad faith and these are not exhaustive; it is open to the panel to find other grounds which lead to a conclusion of bad faith conduct.

24. The Complainant argues that the Registrant's conduct constitutes bad faith pursuant to paragraph 3.5(b) of the Policy which states:
 - (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.
25. The Complainant asserts that on June 16, 2022 it obtained a list of domain names owned by the Registrant and that these numbered over 4400. Many of the domain names closely corresponded to marks registered in Canada to third parties such as air-miles.ca, balenciaga.ca, century21homes.ca and dolceandgabbana.ca. The Complainant also relies on the findings in previous CDRP decisions where those panels found that the Registrant had engaged in a pattern of registering unauthorized domain names containing third party trademarks.
26. Based on the evidence submitted, this panel concludes that the Registrant has engaged in a pattern of registering domain names in order to prevent persons who have rights in the marks from registering those marks as domain names. Therefore, the panel finds that the Complainant has proven, on the balance of probabilities, that the registration of the Domain Name was done in bad faith, as set out in paragraph 3.5(b) of the Policy
27. The Complainant also argues that the Registrant's conduct constitutes bad faith pursuant to paragraph 3.5(d) of the Policy which states:
 - (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.
28. With regard to paragraph 3.5(d) of the Policy, the Complainant asserts that the Registrant has intentionally registered a domain name that is confusingly similar with the Complainant's mark ISIC in order to attract users to its website which is a pay-per-click site. The Registrant prominently features ISIC.CA as a banner for the website, and refers to "ISIC card" in the body of the website, as well as listing "Credit cards for students". These references to ISIC and cards for students is designed to create an association with the Complainant's goods and services, thus creating confusion in the mind of the user

with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Registrant's website.

29. The panel finds that the registration of the domain name ISIC.ca, which so nearly resembles the Complainant's mark in appearance and sound as to be likely to be mistaken for it, and which leads to a pay-per-click website, was done in bad faith to intentionally create a likelihood of confusion for commercial gain.
30. Therefore, the panel finds that the Complainant has proven, on the balance of probabilities, that the registration of the Domain Name was done in bad faith, as set out in paragraph 3.5(d) of the Policy.

Legitimate Interest

31. In order to succeed the Complainant has to provide some evidence that the Registrant does not have a legitimate interest in the Domain Name. Paragraph 3.4 of the Policy lists six possible ways in which a Registrant may have a legitimate interest in a domain name which 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 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.

This list is not exhaustive as it is said to be "without limitation". Therefore neither party is bound by only those criteria.

32. The Complainant has established that it has rights in the mark ISIC, which comprises the Domain Name, and the Registrant has not shown that it had any interest in this trademark. Therefore there can be no legitimate interest under subsection (a). The term ISIC has not been used in good faith by the Registrant in association with any wares, services or business and the term is not clearly descriptive as referred to in subsection (b) as it is an acronym for “International Student Identity Card”, nor is it a generic term, therefore subsection (c) does not apply either. There is no evidence that the Registrant has used the term in good faith for a non-commercial activity including, criticism, review or news reporting, so subsection (d) is not applicable. Finally, the Domain Name is not the name of the Registrant, nor is it the name of a geographic place, therefore neither subsections (e) or (f) apply.
33. The onus is on the Complainant to show “some evidence” that there is no legitimate interest. In this case, the Complainant has demonstrated that none of the criteria set out in paragraph 3.4 are applicable here. Therefore, the panel finds that the Complainant has provided some evidence that the Registrant does not have a legitimate interest in the Domain Name.
34. The Registrant has not rebutted the Complainant’s evidence with any evidence of its own, therefore it has not proven, on the balance of probabilities, that it has a legitimate interest in the Domain Name.

I. Conclusion and Decision

35. In conclusion, the panel finds that the Complainant has rights in the mark ISIC which predate the registration of the Domain Name. The panel also finds that the Domain Name is confusingly similar to the Complainant’s trademark, that the Domain Name was registered in bad faith and that the Registrant has no legitimate interest in the Domain Name.
36. The panel therefore orders, pursuant to paragraph 4.3 of the Policy, that the registration of the Domain Name isic.ca be transferred to the Complainant.

Dated: November 14, 2022

A handwritten signature in black ink, appearing to read "Sharon Groom", written over a horizontal line.

By: Sharon Groom (Sole Panellist)