



**CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE**

**DOMAIN NAME DISPUTE**

**ADMINISTRATIVE PANEL**

**DECISION**

CIIDRC case number:	15860-CDRP	Decision date: October 15, 2021
Domain Name:	<b>alstomconstruction.ca</b>	
Panel:	<b>Michael Erdle (Chair)</b>  <b>Barry Effler</b>  <b>James Plotkin</b>	
Complainant:	<b>ALSTOM</b>	
Complainant's representative:	<b>Bruno Barrette</b>	
Registrant:	<b>Alan Farzami, Alstom Construction Inc.</b>	

**1. PROCEDURAL HISTORY**

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.

The procedural history of this case was set out in a letter from the Canadian International Internet Dispute Resolution Centre to the Panel:

- 1.1. On August 4, 2021, the Complainant was filed with the Canadian International Internet Dispute Resolution Centre (CIIDRC) on behalf of the Complainant, pursuant to the Canadian Internet Registration Authority ("CIRA") Dispute Resolution Policy (the "Policy") and Domain Name Dispute Resolution Rules (the "Resolution Rules").
- 1.2. CIRA was notified of this proceeding on August 4, 2021, and on the same date, CIRA transmitted its verification response confirming Registrant's identity. CIRA also confirmed that the disputed domain name was placed on a Registrar LOCK.
- 1.3. On August 5, 2021, CIIDRC confirmed compliance of the Complaint with CIRA's requirements under Resolution Rule 3.2, and commencement of the administrative proceeding.

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- 1.4. Pursuant to Resolution Rule 4.4, CIIDRC notified the Registrant of this administrative proceeding and forwarded the Complaint to the Registrant on August 5, 2021. As the Complaint with the attachments was filed via online platform; CIIDRC delivered the Complaint to the Registrant by email and by express post. The Registrant was provided with login details to access the CIIDRC online platform, view the Complaint, and work on the Registrant's response.
- 1.5. The Registrant filed its Response, in compliance with the Policy and Resolution Rules, to the Centre on August 24, 2021.
- 1.6. The Complaint and the Response were filed in English, which shall be the language of the proceeding.
- 1.7. CIIDRC named Michael Erdle, Barry Effler and James Plotkin as panelists. Michael Erdle was named as Chair of the Panel. Each of the panelists acceptance of appointment and completed a statement of impartiality and independence as required under Paragraph 7 of the Rules.
- 1.8. On September 18, 2021, following its initial review of the Complaint, Response and evidence submitted by the parties, the Panel requested that the parties provide additional evidence with respect to certain issues raised in the matter. The parties provided further evidence and submissions on October 4 and October 6, 2021.
- 1.9. In light of the request for additional evidence, the time for delivery of the decision in this matter was extended to October 15, 2021.

## 2. FACTS ALLEGED BY THE PARTIES

The Complainant, ALSTOM SA, is a French company. It was created in 1928 and changed its name to Alstom in 1998.

The Complainant carries on business in Canada through two subsidiaries: Alstom Canada Inc. and Alstom Transport Canada Inc. both located in Quebec.

The Complainant is the owner of the trademark "ALSTOM", which it has used since 1998 and registered in Canada on May 23, 2002 in association with a long list of wares and services, including construction services.

The Complainant is also the owner of the domain names **<alstom.com>**, registered January 20, 1998, and **<alstom.ca>**, registered November 25, 2000. It uses the latter domain in connection with its various business activities in Canada.

The Registrant, is identified by CIRA as Alan Farzami, of Aurora, Ontario. He is a director and officer of Alstom Construction Inc., an Ontario company. Alstom Construction Inc. was incorporated on December 9, 2013.

The disputed Domain Name, **<alstomconstruction.ca>** (the "**Domain Name**"), was registered on December 4, 2018. The Domain Name is used by Mr. Farzami and Alstom Construction Inc. in connection with its construction, renovation and contracting business and hosts a website with content related to the business.

## 3. CONTENTIONS OF THE PARTIES

- **Complainant**

The Complainant relies on the evidence in the affidavit of Valerie Dussaussois, the Complainant's Head of Trademarks and Copyrights, and the exhibits attached to the affidavit.

The Complainant states that it is a global leader in transport infrastructure, with operations in more than 60 countries including Canada. The company has been present in Canada for almost 80 years and currently has four sites for its transportation business in Canada (Montreal and Sorel-Tracy, in Quebec; Ottawa and Toronto, in Ontario).

The Complainant is the owner of the registered trademark **ALSTOM** (the “Mark”) in Canada and other countries. Ms. Dussaussois deposes that the Complainant uses the Mark in association with a wide range of products and services, including construction. The Mark is used in Canada by the Complainant’s subsidiaries, namely ALSTOM Canada Inc. and ALSTOM Transport Canada Inc.

The Complainant also owns the domain name **<alstom.ca>** which it uses in connection with its business activities in Canada.

The Complainant became aware of the disputed Domain Name in December 2018.

Although registrant information was redacted for privacy, the corresponding website **<www.alstomconstruction.ca>** shows the activity of the entity ALSTOM CONSTRUCTION INC. (construction, renovation, building services).

This entity was known to the Complainant. When the Complainant in 2016 became aware of the incorporation of Alstom Construction Inc., it sent a letter to the Ontario Ministry of Government Services objecting to the name. The Complainant submitted copies of correspondence with the Ministry which state that the Ministry tried to contact the corporation, without success, and that the corporation was cancelled as of May 9, 2017.

Mr. Farzami registered the domain name **<alstomconstruction.com>** in 2014 and used it in connection with the website of the construction business. The Complainant filed a UDRP complaint regarding that domain name and the domain was ordered transferred to the Complainant [*ALSTOM v. Alan Farzami, Royal Lepage Realty Inc.* WIPO case N° D2017-2002, Nov 19, 2017].

Mr. Farzami registered the disputed Domain Name in December 2018. The Complainant submits that he did so in bad faith, being aware of the Complainant’s rights in the ALSTOM trademark and its prior objections to the corporate name and its complaint in respect of the .com domain name.

Complainant sent a cease and desist letter in April 2019, demanding the transfer of the disputed Domain Name. It received no response to that letter or to further letters sent in May 2019.

The Complainant states that neither Mr. Farzami nor Alstom Construction Inc. is affiliated with the Complainant in any way, and neither of them is licensed or authorized to use the ALSTOM trademark.

The Complainant submits that:

1. It meets the Canadian Presence Requirements of the CDRP by virtue of its ownership of the registered trademark ALSTOM in Canada;
2. It has Rights in the Mark and the disputed Domain Name is Confusingly Similar to the Mark; as those terms are used paragraphs 3.2 and 3.3 of the CDRP;
3. The Registrant does not have any legitimate interest in the disputed Domain Name, as described in paragraph 3.4 of the CDRP; and
4. The Registrant registered the disputed Domain Name in bad faith, as described in paragraph 3.5 of the CDRP.

For those reasons, the Complainant submits that the panel should find in its favour and order the transfer of the disputed Domain Name.

- **Registrant**

The Registrant’s response was submitted by Mr. Farzami on behalf of Alstom Construction Inc.

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The Registrant states that Alstom Construction Inc. is a legal company which was registered in Ontario on December 9, 2013. (Ontario Corporation No. 002399138). It has a Business Number with the Canada Revenue Agency. It has legally carried on business in Ontario since 2013.

The Domain Name **<alstomconstruction.ca>** is a lawful domain name based on the registered name of the company.

The Registrant submits that the disputed Domain Name is not confusingly similar to the Complainant's trademark or other domain names.

Mr. Farzami states that he was not aware of the ALSTOM trademark or company name in Canada when he chose the name Alstom Construction Inc. He states that the name was derived from two letters of his name (A and L), the first letter of his mother's name (Sara), two letters of his father's name (Tofigh), and the first letter of his daughter's name (Mona). The word "Construction" was chosen because he is a construction engineer.

The company has been in operation for eight years, offering construction, renovation and general contracting services in the greater Toronto area.

The Registrant says the disputed Domain Name is a lawful domain name based on the legal name of the Corporation. It has been used in connection with the business website, promoting its renovation, design, construction and construction management services.

The Registrant submits that it has a legitimate interest in the disputed Domain Name and that it did not register the Domain Name in bad faith.

- **Additional Evidence and Submissions**

On September 20, 2021, the Panel requested additional evidence and submissions from the parties on the following points:

- A. the corporate status and corporate name of the Registrant on the date of registration of the domain name <alstomconstructution.ca>;
- B. the corporate status and corporate name of the Registrant currently; and
- C. if Alstom Construction is a registered business name of the Registrant and if so, evidence of registration and current status.

The parties submitted the following in response to the Panel's request.

With respect to points A and B, the Complainant referred to the evidence previously filed of the letter from the Ontario Ministry of Government Services stating that the corporation had been "cancelled". In reference to point C, it submitted a certificate of non-registration from the Ministry, dated August 27, 2021, stating that there is no record of the registration of the business name "Alstom Construction" under the *Business Names Act* or the *Limited Partnerships Act*.

The Registrant submitted a copy of the Certificate of Incorporation dated December 9, 2021, a copy of the information page from the corporation's 2020 income tax return (without financial information) showing the corporate name and business number, and an email from the domain registrar GoDaddy confirming the domain was registered December 4, 2018 under the organization/business name of alstomconstruction.ca.

In response to a further request to both parties for clarification of the current status of the corporation, the Registrant provided a Certificate of Status from the Ministry, dated October 6, 2021, stating that the current name of the corporation is Alstom Construction Inc., that it came into existence on December 9, 2013 and that it has not been dissolved.

The Complainant did not respond the Panel's request for clarification or to the certificate of status submitted by the Registrant.

- **Remedy Sought**

The Complainant seeks an order transferring the Domain Name to the Complainant.

The Respondent seeks an order dismissing the Complaint.

## **4. DISCUSSION AND FINDINGS**

### **4.1 Eligibility**

As the owner of the registered trademark ALSTOM (TMA562412), the Complainant meets CIRA's Canadian Presence Requirement and is an eligible complainant under paragraph 1.4 of the CDRP.

### **4.2 Requirements**

In accordance with Paragraph 3.1 of the CDRP, the Complainant must show that:

The Domain Name is Confusingly Similar to a trademark or service mark in which the Complainant has rights;

The Registrant has no legitimate interest in the Domain Name; and

The Domain Name has been registered in bad faith.

The onus is on the Complainant to prove that the Domain Name is Confusingly Similar and was registered in bad faith. The Complainant must also provide some evidence that the Registrant has no legitimate interest. The onus is then on the Registrant to prove that it does have a legitimate interest on a balance of probabilities.

### **4.3 Analysis**

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

The Complainant rights in the ALSTOM Mark precede the Domain Name's registration. This is demonstrated by the Complainant's use of the Mark in Canada and elsewhere since 1998, as well as the registration of the Mark in Canada in 2002.

The disputed Domain Name includes the entirety of the Mark, as well as the word "construction."

Under the CDRP, in determining whether a domain name is "Confusingly Similar" to a Mark, "the Panel shall only consider whether 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." (Paragraph 3.3)

The Complainant submits that the word "construction" is "merely an indication of one of the fields of activity in which ALSTOM is well known, namely construction of transport infrastructure." It should not be considered a distinctive element of the Domain Name.

The Complainant also submits that ALSTOM has been considered to be well-known throughout the world (WIPO Case *ALSTOM v. Daniel Bailey* N° D2010-1150).

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It submits that Internet users and consumers will recognize the Complainant's trademark in the Domain Name and will believe that it has been registered by ALSTOM.

The Registrant submits that the disputed Domain Name is not confusingly similar. It is a reflection of its corporate name, which it says was derived without any knowledge of or reference to the Complainant or its trademark.

The distinctive element of the Domain Name is "alstom" which is identical to the Mark. The addition of the word "construction", which describes the services of both the Complainant and the Registrant, is not sufficient to remove the similarity inherent in the use of "alstom".

The Panel finds that the disputed Domain Name is confusingly similar to the Mark.

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

Under the CDRP, the Complainant is required to provide "some evidence" that the Registrant does not have a legitimate interest in the disputed Domain Name. It has done so.

The Complainant submits that the Registrant does not meet any of the criteria listed in Paragraph 3.4 of the CDRP. In particular, it submits that the Domain Name is not the Registrant's legal name.

The Complainant relies on the letter it received from the Ontario Ministry of Government Services in 2017, stating that the corporation was "cancelled", as well as the certificate it obtained on August 27, 2021, stating that there is no business name registration for "Alstom Construction."

Under the CDRP, the onus is then on the Registrant to prove, on a balance of probabilities, that it does have a legitimate interest in the disputed Domain Name.

The Registrant submitted evidence that it was incorporated under the name "Alstom Construction Inc." in 2013 and that is its current legal name, as shown in the Certificate of Status dated October 6, 2021. It also submitted evidence of its 2020 income tax filing, under the name Alstom Construction Inc. And it submitted evidence that it is commonly known by the name "Alstom Construction", as shown on its website.

The evidence submitted by the Registrant directly contradicts the statement in the 2017 letter from the Ministry that the corporation was "cancelled".

The Panel notes that, while the Complainant was represented by legal counsel, the Registrant was self-represented in responding to the Complaint.

From the materials submitted, it is apparent to the Panel that the Registrant was not well-versed in the finer points of corporate or trademark law. However, the Registrant made an effort to be responsive to the Panel's request for further evidence on the issues relating to its legitimate interest in the Domain Name.

The Panel is deeply troubled that the Complainant merely relied on the 2017 letter from the Ministry and did not provide further evidence of the current status of Alstom Construction Inc. or the full corporate history. This evidence would have been disclosed by a routine corporate search.

Other than the current Certificate of Status, the Panel has no evidence of the corporate history between 2017 and 2021. The reasonable inference that the Panel draws from this is that the company's legal name is and always has been "Alstom Construction Inc."

The Registrant has proven, to the satisfaction of the Panel, that its legal name and the name by which it is commonly identified at the time it registered the Domain Name was (and remains) "Alstom Construction Inc."

Accordingly, the Panel finds that the Registrant has proven, on a balance of probabilities, that it has a legitimate interest in the disputed Domain Name, as contemplated in paragraph 3.4(e) of the CDRP.

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

In light of the Panel's finding on the previous element of the Complaint, we do not find it necessary to make any determination with respect to the allegation that the disputed Domain Name was registered in bad faith.

## 5 DECISION and ORDER

For the above reasons, in accordance with Paragraph 4 of the CDRP, Paragraph 12 of the Resolution Rules, the Panel finds in favour of the Registrant. The Complaint is dismissed.

Made as of October 15, 2021

### SIGNATURES OF PANEL

*"Michael Erdle"*

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Michael Erdle (Chair)

*"Barry Effler"*

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Barry Effler

*"James Plotkin"*

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James Plotkin

