

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

Complainant: Urban Legal Recruitment Limited
Registrant: Craig Nadeau
Panel: Barry C. Effler (Chair), Thomas Manson, R. John Rogers
Service Provider: British Columbia International Commercial Arbitration Centre
BCICAC File Number: DCA-1497-CIRA

DECISION

The Parties, Domain Names and Registrar

1. The Complainant is Urban Legal Recruitment Limited, an Alberta corporation.
2. The Registrant is Craig Nadeau of Calgary, Alberta.
3. The Domain Name at issue in this dispute is **urbanlegal.ca**.
4. The Registrar is Tucows.com Co.
5. The Domain name was registered by the Registrant on March 10, 2006.

Procedural History

6. The procedural history of this matter was set out in a letter from the British Columbia International Commercial Arbitration Centre to the Panel herein dated June 17, 2013:

The above named Complainant has filed a Complaint with respect to the above-referenced domain name in accordance with the CDRP on May 3, 2013.

The Complaint was reviewed and found to be compliant. By letter and email dated, May 6, 2013, BCICAC as Service Provider, so advised the parties and forwarded a copy of the Complaint to the Registrant by courier. Confirmation of the delivery of the Complaint to the Registrant by courier is enclosed.

The Registrant did not provide a Response by its due date May 27, 2013. The Centre notified the parties that the Registrant failed to file its response. The Centre also advised that the Registrant may send to the Centre a written request to accept the late response and stated that it will be up to the sole discretion of the Panel to elect to accept the late submission.

The Complainant did not wish to convert to a sole arbitrator as permitted by the Rules. In accordance with Paragraph 6 of the Rules, the Provider shall appoint a three-person Panel, with consideration to the nominees of the Complainant, and select Chair.

The BCICAC names Thomas Manson, Q.C., and Robert John Rogers as panelists. Barry C. Effler, LL.M., is named as Chair of the Panel.

7. Following the appointment of the Panel, the Panel issued procedural orders:

July 15, 2013: The Panel hereby orders:

1. The Complainant is hereby given the opportunity to submit additional evidence on the issue of usage of the trade-mark prior to the date of registration of the trade-mark, and in particular, of usage prior to the date of registration of the domain name in dispute.
2. The Complainant shall have until the close of business on Monday, July 22, 2013 to file such submission.
3. The time for issuing an award is hereby extended to Monday, July 29, 2013.

July 18, 2013:

The Panel has received a request from the Complainant's counsel for additional time to respond to the Panel's order of July 15, 2013, based on the Complainant being on vacation until July 22, 2013.

The Panel hereby orders:

1. The Complainant is hereby given the opportunity to submit additional evidence on the issue of usage of the trade-mark prior to the date of registration of the trade-mark, and in particular, of usage prior to the date of registration of the domain name in dispute.
2. The Complainant shall have until the close of business on Monday, July 29, 2013 to file such submission.
3. The time for issuing an award is hereby extended to Monday, August 5, 2013.

July 31, 2013

The Panel has received a submission from the Complainant on July 26, 2013 providing additional supporting material for their submission, as requested by the Panel in its order of July 15, 2013.

After consideration, the Panel wishes to give the respondent an opportunity to respond to this additional material, if the respondent wishes to do so.

The Panel hereby orders:

1. The Respondent is to be sent this order and the additional material filed by the Complainant. This will be done by email from the BCICAC by August 2, 2013.
2. The Respondent shall have until the close of business on Friday, August 9, 2013 to file such submission.
3. The time for issuing an award is hereby extended to Friday, August 16, 2013.

August 22, 2013

Panel members are on vacation and further time is required to complete deliberations.

The Panel hereby orders:

1. The time for issuing an award is hereby extended to Monday, August 30, 2013. [The Panel subsequently notes that Monday and August 30, 2013 do not match. The intent of the order was to Monday, September 2, 2013 and the Panel hereby confirms this].
8. A written submission dated July 25, 2013 was received from the Complainant providing additional evidence of use of the words Urban Legal. The Registrant was notified of the submission of additional material by the Complainant and chose to make no response.
9. As required by paragraph 7.1 of the Rules, each Panellist has declared to BCICAC that he can act impartially and independently in this matter as there are no circumstances known to him which would prevent him from so acting.

10. The Panel is not aware of any other legal proceeding or other arbitration in relation to the Domain Name that would give rise, under paragraph 13.2 of the Rules, to a need to stay or terminate the progress of this proceeding.

Eligibility of Complainant

11. The Panel reviewed the material submitted by the Complainant and is satisfied that the Complainant is an eligible complainant under paragraph 1.4 of the Policy. It is the owner of a registered Canadian trade-mark in which the exact word component of such trade-mark is the same as the Domain name in dispute.

Relief Requested

12. The Complainant requests that the Domain Name in dispute be transferred from the Registrant to the Complainant.

Applicable Law

13. As directed by paragraph 12.1 of the Rules, the Panel will render its decision based upon the rules and principles of the laws of Ontario, and the laws of Canada.

Background Facts

14. Background facts alleged by the Complainant and accepted by the Panel are quoted here from the Complaint:

The Complainant is the owner of Canadian trademark registration TMA 704407 for URBAN LEGAL which registered on January 10, 2008. This registration includes services described as employment counseling and personnel placement services. The registration claims use of these services in Canada since at least May, 2005.

1. Background

ULR is a legal recruitment company focused on recruiting lawyers, associates and staff for law firms, oil & gas, and investment companies. ULR was founded in 2005 by Ms. Stacy Cowan, who was a legal recruiter at Maxim Group prior to her starting her own business. The Complainant, tried to obtain the domain

name urbanlegal.ca in 2006 only to discover that the domain name had already been secured.

Originally, a search on the Internet for urbanlegal.ca revealed that the domain name was being redirected to her former employer's website (www.maximgroup.com) who registered the Domain Name to prevent the Complainant from using the Domain Name for its business, A letter dated August 29, 2006 from ULR's legal counsel was sent to the Registrant stating that he obtained the Domain Name in bad faith and asked the Registrant to release the Domain Name (Schedule 4), The Registrant stopped redirecting the Domain Name but would not transfer the Domain Name to ULR. At the time, the Complainant understood that the Domain Name had been sold to another party by the Registrant.

Since that time the Complainant has been actively trying to obtain the Domain Name, On several occasions ULR asked it's IT contractors to look at trying to obtain the Domain Name, but they could not obtain the registered owner information on urbanlegal.ca as it was showing as privately listed. The Complainant was unaware of the CIRA Domain Name Dispute Resolution Policy and procedure, which is why there has been a delay in taking further action against the Registrant. The Complainant has been waiting to see if the Registrant would renew the Domain Name in 2016,

As the Complainant's business is expanding and the need to own the Domain Name has become crucial. ULR contacted the owner of the Domain Name through CIRA's Interested Party Form (no copies available) and no response was received, It was then ULR's agent made a request for information from CIRA for the name of the owner of the Domain Name, Upon being advised of the name of the owner of the Domain Name, Ms. Cowan confirmed that the Registrant was the person she worked for at Maxim Group, It is noted that the Registrant no longer works for Maxim Group and has moved to a new company.

ULR is the owner of the registered trademark URBAN LEGAL, URBAN LEGAL is the primary elements in the name of the recruitment company and the Complainant would like to own the Domain Name, urbanlegal.ca for the business' website.

Discussion and Findings

15. Policy paragraph 4.1 sets forth the onus on a complainant. It provides as follows:

4.1 **Onus.** *To succeed in the Proceeding, the Complainant must prove, on a balance of probabilities, 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; and*

(b) *the Registrant has registered the domain name in bad faith as described in paragraph 3.5;*

and the Complainant must provide some evidence that:

(c) *the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.*

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 paragraph 3.4.

16. The Policy provides a definition of the term "Mark" (but as amended no longer defines Rights):

3.2 **Mark.** *A "Mark" is:*

(a) *a trade-mark, 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; ...*

17. The Complainant is the owner of a registered Canadian trade-mark in which the exact word component exactly matches the Domain Name excluding the dot ca portion of the domain name. The Complainant claims that it has rights in a trade-mark that was a

“Mark” prior to the date on which the Domain Name was registered. The trade-mark was registered January 10, 2008, which is significantly later than the March 10, 2006 date of registration of the Domain Name.

18. The Complainant claimed in its trade-mark application:

Claims/Revendications: Used in Canada since at least May 2005.

19. The Panel requested and received additional evidence by submission dated July 25, 2013 from the Complainant about its usage of the Mark Urban Legal. Sixteen statements of account from “Urban Legal Recruitment” to various clients, dated between June 10, 2005 and March 7, 2006 were provided. All other evidence provided was showing usage after the March 10, 2006 date of registration of the Domain Name.
20. Based on the usage evidence submitted and the claim of usage in the registered trade-mark, the Panel is satisfied that the Complainant had rights in the mark prior to the registration of the Domain Name.
21. The Panel is satisfied that the Domain Name is confusingly similar to the Complainant’s Mark. The relevant key words “Urban Legal” in the Domain Name are the same words as in the Mark, with the exclusion of the dot ca in the Domain Name. The lack of a space between the two words does not change this.
22. The Panel is satisfied that the Complainant has established bad faith by the Registrant for the purposes of paragraphs 4.1 of the Policy by showing circumstances meeting paragraphs 3.5 (c) and (d) of the Policy.

Paragraph 3.5 of the Policy:

3.5 Registration in Bad Faith. *For the purposes of paragraphs 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:*

...

(c) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant; or

(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.

23. The Complainant's evidence is that the website to which the Domain Name refers was originally established to send traffic to the website of the Complainant's former employer. As quoted earlier in paragraph 14:

Originally, a search on the Internet for urbanlegal.ca revealed that the domain name was being redirected to her former employer's website (www.maximgroup.com) who registered the Domain Name to prevent the Complainant from using the Domain Name for its business. A letter dated August 29, 2006 from ULR's legal counsel was sent to the Registrant stating that he obtained the Domain Name in bad faith and asked the Registrant to release the Domain Name (Schedule 4), The Registrant stopped redirecting the Domain Name but would not transfer the Domain Name to ULR.

24. In the circumstances described above, the Panel finds the tests for bad faith in paragraph 3.5 (c) and in (d) of the Policy has been met.
25. The Complainant states it has no business relationship with the registrant, from page 5 of the Complaint:

There is not, and has never been, any business relationship between the Complainant and the Registrant. The Registrant is not, and has never been, authorized or permitted to use any of the URBAN LEGAL trademark. Moreover, the Registrant is not, and has never been, authorized by the Complainant to register or be the registrant of the Domain Name.

26. There is no evidence that any of the circumstances outlined in paragraph 3.4 of the Policy regarding legitimate interest apply and the Panel is satisfied that the Registrant has no legitimate interest in the Domain Names.

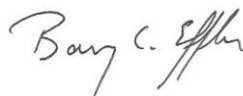
27. The Panel is satisfied that the Complainant has met the onus on it to succeed, as required by paragraph 4.1 of the Policy.

Order

28. For the reasons set forth above, we order the Domain Name in issue to be transferred to the Complainant.

Dated: September 2, 2013

Barry C. Effler, Thomas Manson, R. John Rogers,



Barry C. Effler (Chair) for the Panel