



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

CIIDRC case number:	21210-UDRP	Decision date: September 3, 2023
Domain Name:	Extenso.org	
Panel:	Hon. Neil Brown, KC	
Complainant:	Université de Montréal	
Complainant's Representative:	Andréa Provencher of Cain Lamarre LLP	
Registrant:	Heinrich Wunder	
Registrant's Representative:	Peter Muller	

1. PROCEDURAL HISTORY

Complainant submitted a Complaint to the CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE (CIIDRC) electronically on July 31, 2023, and the CIIDRC received payment of the appropriate fee on the same date.

The registrar of the disputed domain name was notified of the proceeding on July 31, 2023.

On August 1, 2023, the Registrar by email transmitted its verification response that the registrant of the domain name was the Respondent in this administrative proceeding and that the domain name had been placed in Registrar LOCK. The Panel is satisfied that Respondent is bound by the applicable registration agreement and has thereby agreed to resolve domain name disputes brought by third parties in accordance with the Uniform Domain Name Dispute Resolution Policy (the "Policy") of the Internet Corporation for Assigned Names and Numbers (ICANN), the Rules for Uniform Domain Name Dispute

Resolution Policy (the "Rules"), and the CIIDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

On August 3, 2023, the CIIDRC confirmed to the Complainant that the Complaint was in administrative compliance and that the proceeding had then commenced.

On August 3, 2023, and pursuant to UDRP Rule 4 and Supplemental Rule 5, CIIDRC notified the Respondent of the administrative proceeding and forwarded a Written Notice with the Complaint to the Respondent setting a deadline of August 23, 2023, by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on the registration by Respondent as administrative technical, and billing contacts.

Also, on August 3, 2023, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on the registration by Respondent as technical, administrative and billing contacts.

The Respondent through its Counsel Peter Muller filed its Response on August 21, 2023.

The Complainant and the Respondent elected to have a Panel consisting of a single-member.

On August 30, 2023 pursuant to the parties' request to have the dispute decided by a single-member Panel, the CIIDRC appointed The Honourable Neil Anthony Brown QC as Panelist. The Panelist duly completed and returned to the CIIDRC a statement of acceptance and a declaration of impartiality and independence.

2. PARTIES' CONTENTIONS

A. Complainant

Complainant made the following contentions.

1. The Complainant seeks arbitration of a dispute between itself and the Respondent concerning the disputed domain name which was registered November 19, 2001.
2. In the year 2001, the Complainant's Faculty of Medicine, through its department of Nutrition, set up the "Centre de reference sur la nutrition humaine Extenso" (hereinafter referred to as "Extenso").

3. Extenso developed a reputation as the leading source of scientifically sound information on nutrition.
4. As part of that activity the domain name was registered and used by Extenso, but it later ceased to use the domain name and its registration lapsed.
5. The Respondent subsequently acquired the domain name and it is now registered in the Respondent's name as domain name holder.
6. The Respondent has been using the domain name for a website to promote various fat burning and weight reduction products by redirecting internet users to external websites, but the Complainant maintains that it has not approved of any of those products.
7. The Respondent has also been using a writer named Denise to offer nutrition advice which advice the Complainant maintains it has not approved.
8. In those activities, the Complainant maintains that the Respondent has copied Complainant's website including its description and logo.
9. In those circumstances, the Complainant submits that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.
10. The Complainant also submits that the Respondent has no rights or legitimate interests in the disputed domain name.
11. The Complainant maintains that the disputed domain name was registered and is used by the Respondent in bad faith.
12. The Complainant cites a series of prior Canadian domain name decisions arising from proceedings relating to ".ca" domain names.
13. In light of the foregoing, the Complainant submits that the domain name should be transferred from the Respondent to the Complainant.

B. Respondent

Respondent made the following contentions.

1. As to the allegation that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, the Respondent says that the Complainant has sought to prove a registered Canadian trademark for EXTENSO. However, that

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trademark was not renewed and was deleted from the Canadian trademark registry on December 12, 2019, a date which was prior to the filing of the present Complaint.

2. Moreover, the trademark was not registered in the name of the Complainant or give rise to any trademark rights as it is required to be for the purposes of this proceeding.
3. The Complainant has not proved or sought to prove that it has an unregistered or common law trademark for EXTENSO and has made no claim and offered no evidence of secondary meaning in the word "extenso".
4. The Complainant has therefore not established a trademark or service mark as it is required to do for the purposes of paragraph 4 (a) (i) of the Policy and accordingly this proceeding must fail.
5. The Complainant has not demonstrated or attempted to demonstrate that the Respondent has no rights or legitimate interests in the disputed domain name or offered any evidence in that regard.
6. The Complainant has submitted that further substantiation of its case on the issue of rights and legitimate interests is to be found in a document entitled "Application to institute proceedings" which is said to be annexed to the Complaint. However, no such document is attached to the Complaint or otherwise evident.
7. The Complainant has not demonstrated or offered any evidence to show that the Respondent has registered and is using the disputed domain name in bad faith.
8. Moreover, on the evidence there is no trademark to which any such bad faith could have been evinced.
9. The Complainant has also submitted that further substantiation of its case on the issue of bad faith is to be found in a document entitled "Application to institute proceedings" which is said to be annexed to the Complaint. However, no such document is attached to the Complaint or otherwise evident.
10. The Complainant has brought the proceeding without any supporting evidence and in circumstances showing that it has been brought as a case of Reverse Domain Name Hijacking and the Panel should so find. That is particularly so as the Complainant is represented by Counsel.

EVIDENCE

Apart from formal matters, the main evidence in this case comes from a declaration made before a Commissioner for Oaths by Professor Marie Marquis in which she states that she was and is now the President of the Board of Directors of Extenso; that Extenso started its activities in 2001, launched its website at the domain name in Fall 2002, ceased its operations in 2020 and allowed the disputed domain name to expire and not be renewed in November 2022.

Although the Declaration does not say so, it is convenient to mention here that the Centre's trademark for EXTENSO was cancelled on December 12, 2019.

3. FINDINGS

1. The Respondent is the domain name holder of the disputed domain name.
2. The disputed domain name was initially registered by Centre de reference sur la nutrition humaine Extenso on November 19, 2001 and resolved to a website conducted by that Centre from the year 2002. The Centre de reference sur la nutrition humaine Extenso ceased operations in the year 2022.
3. The Centre de reference sur la nutrition humaine Extenso did not renew the registration of the disputed domain name when it became due in or about November 2022.
4. Thereafter, the Respondent became the registrant of the disputed domain name and has remained so.
5. The Complainant has not shown by evidence that it has any rights in a registered or unregistered trademark or service mark for EXTENSO.
6. A trademark for EXTENSO obtained by Centre de reference sur la nutrition humaine Extenso in the Canadian trademark data base was cancelled on December 12, 2019.
7. There is no evidence that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.
8. There is no evidence that the Respondent has no rights or legitimate interests in the disputed domain name.
9. There is no evidence that the Respondent has registered and used the disputed domain name in bad faith.
10. The relief sought is therefore denied.

11. The Panel finds that the Complaint was brought in bad faith in an attempt at Reverse Domain Name Hijacking and primarily to harass the Respondent and declares that the complaint constitutes an abuse of the administrative proceeding

4. DISCUSSION AND FINDINGS

Requirements

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

The Panel will now deal with each of those elements in turn.

Analysis

4.2.1 That the Domain Name is Identical or Confusingly Similar to a Mark in which the Complainant has Rights.

The first question that arises is whether the Complainant has rights in a trademark or service mark on which it may rely in this proceeding. That is so because the first significant provision that determines the Respondent's rights to the domain name and the Complainant's ability to have it transferred to it from the Respondent, says so. The obligation on the Complainant is to show that the domain name it wants is identical to its own trademark or service mark (hereafter "trademark") or confusingly similar to it. By necessary implication, the obligation is therefore on the Complainant to show that it has such a trademark.

It is curious therefore why the Complainant does not say in its complaint, which is supposed to set out its argument and evidence, that it has a trademark and state what that trademark is, or words to that effect. But no such words appear. Instead, the section of the Complaint headed "Trademark/Service Mark information" is devoted to an exegesis on how the Respondent has been promoting allegedly dubious weight-loss products and how it has been relying on Denise, a journalist who has been giving advice on nutrition of which the Complainant does not approve. Those matters have nothing to do with a trademark in which the Complainant has rights, which the Complainant is supposed to be establishing at this stage of the proceeding.

The Complainant does, however, annex a list of attachments to the Complaint and one of them is described as "Copy of Service Mark Records dated June 2002." The Panel has therefore looked at the attachment to see if it fills the evidentiary gap that has appeared in the Complainant's material at this early stage.

The document certainly reveals a Canadian trademark (not a service mark as claimed) which is certainly recorded in the Canadian trademark database and it is a trademark for EXTENSO. But there are two

difficulties with it. The first difficulty is that it is dead, being in that state because as the registry states, it has been "cancelled or invalidated and removed from the registry".

The registry reveals that the EXTENSO trademark was deleted from the Canadian registry on December 12, 2019. The current proceeding was filed on July 31, 2023 on which date there was therefore no registered trademark for EXTENSO or at least no Canadian trademark. The Panel has looked at the USPTO to see if that can help fill the gap, but there is no relevant trademark to be found there either. No evidence has been submitted to show that there is or was at any other time a trademark for EXTENSO.

The second difficulty with the trademark on which the Complainant apparently relies is that it is not registered in the name of the Complainant, the University of Montreal but in the name of the "CENTRE DE RÉFÉRENCE SUR LA NUTRITION HUMAINE EXTENSO" which is not the Complainant in this proceeding. Nor is there any evidence showing that the University of Montreal, the Complainant in this proceeding, ever had any rights in the mark.

The Complainant has thus not proved that it has a registered trademark for EXTENSO or that it had one when the Complaint was filed.

It is universally accepted in this field that if a complainant cannot show a registered trademark, it will be sufficient if it can prove a common law or unregistered trademark. But the Complainant has not alleged that it has common law trademark rights in EXTENSO and it has certainly not set about proving any.

The Panel has no wish to create difficulties for the Complainant, but the fact is that paragraph 4 of the Policy provides that with respect to this element, as with the other elements of the Policy, "the complainant must prove that each of these elements are present". The word "prove" can only mean "proved by evidence."

The Complainant has thus not established by evidence this, the first leg of the first of the three elements of the Policy.

Nor has it proved or even submitted that the domain name it is seeking in this proceeding is identical or confusingly similar to any such trademark and accordingly, as it must prove all three elements, it cannot succeed in this proceeding.

The Complainant has therefore not made out the first of the three elements that it must establish.

4.2.2 That the Respondent has No Rights or Legitimate Interest in the Domain Name

As has already been seen and as is common sense, the Complainant has to prove that the Respondent, the present registrant of the domain name, has no right to the domain name and no legitimate interest in it. But as this amounts to the sometimes difficult task proving a negative, it has come to be accepted in domain name circles that the Complainant need only start off by making out a *prima facie* case and then, if it succeeds, the onus of proof moves over to the Respondent who then has to rebut that *prima facie* case and prove that it actually does have a right and legitimate interest in the domain name¹.

¹ That process is explained in more detail in *Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its *prima facie* case and satisfy Policy ¶ 4(a)(ii)); see also *Neal & Massey Holdings Limited v. Gregory Ricks*, FA 1549327 (FORUM Apr. 12, 2014) ("Under Policy ¶ 4(a)(ii), Complainant must first make out a *prima facie* case showing that Respondent lacks rights and legitimate interests in respect of an at-issue domain name and then the burden, in effect, shifts to Respondent to come forward with evidence of its rights or legitimate interests").

That process clearly makes it easier or at least more practical for the Complainant to prove its case. It only has to show a *prima facie* case that the Respondent has no right to have the domain name and no legitimate interest in it, and this would get it to first base.

The first inquiry is thus whether the Complainant has made out the *prima facie* case it must establish that the registrant of the domain name, i.e., the Respondent, does not have a right or legitimate interest in the domain name.

The Panel finds that the Complainant has not made out that *prima facie* case.

The Complainant's approach on proving its *prima facie* case was to include in the Complaint 3 lines of type and nothing else, which is clearly inadequate on any test. The 3 lines of type assert that the Respondent has no rights or legitimate interests in the domain name, which is not an argument or evidence of anything, but a conclusory assertion which is of virtually no value.

In any event, the material submitted by the Complainant on this issue is not in compliance with the Policy or the Rules under which this proceeding is governed. The Panel has already pointed out that paragraph 4 of the Policy, speaking of the elements that a complainant must establish, provides that "the complainant must prove that each of these three elements are present". That can only mean proved by evidence. But the Complainant has produced nothing by way of evidence on this issue at all.

Secondly, Rule 3 (b) (ix) provides that a Complaint "shall...describe...why the Respondent (domain-name holder) should be considered as having no rights or legitimate interests in respect of the domain name...". The Complainant's task could not be expressed in clearer language. But none of the Complainant's submissions describe why that conclusion should be reached in this case.

The Complainant ends the 3 lines of type on this issue (as it later also does on the issue of bad faith) by submitting that further substantiation of its case on this issue is to be found in a document entitled "Application to institute proceedings" which is said to be annexed to the Complaint. However, no such document is attached to the Complaint or otherwise evident to the Panel. Nor has the Respondent been able to find it, which raises at least a question as to whether it is being given a fair opportunity to defend itself if it cannot have access to the evidence that the Complainant apparently relies on.

In any event, there is a serious obstacle in the way of the Complainant ever being able to prove that the Respondent in this case has no right to the domain name or any legitimate interest in it. That obstacle is to be found in the Declaration of Professor Marquis to which reference has already been made. Professor Marquis' declaration shows that the Extenso Centre lost interest in the domain name in November 2022 by allowing it to expire and not renewing its registration. Indeed, its trademark for EXTENSO was cancelled on December 12, 2019. In those circumstances the Respondent would seem to have every right to acquire it and retain it and use it for its own purposes, giving it a very real right and legitimate interest in the domain name.

Accordingly, the result is that the Complainant has not made out a *prima facie* case on this issue because it has simply not produced an evidentiary case.

The Complainant has therefore not made out the second of the three elements that it must establish.

4.2.3 That the Respondent has Registered and Used the Domain Name in Bad Faith

It is clear that to establish bad faith for the purposes of the Policy, Complainant must show that the disputed domain name was registered in bad faith and has been used in bad faith. It is also clear that the criteria set out in Policy ¶ 4(b) for establishing bad faith are not exclusive, but that Complainants in UDRP proceedings may also rely on conduct that is bad faith within the generally accepted meaning of that expression.

Those criteria are:

"b. Evidence of Registration and Use in Bad Faith. For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location."

But a complainant is at large to rely on and prove any other situation that amounts to bad faith registration and use in addition to the grounds specified above.

Having regard to those principles, the Panel finds that it has not been shown that the disputed domain name was registered and used in bad faith either under the specific grounds set out above or on any other ground showing what could fairly be described as bad faith. Indeed, it has not been shown that the Respondent either registered or used the domain name in bad faith.

The Complainant's argument is that the Respondent is using the domain name to promote weight loss products of which the Complainant does not approve and is relying on nutritional advice from the writer "Denise" of whose writings the Complainant also does not approve. The Complainant thus has to show that this conduct is in bad faith both in the Respondent's registration of the domain name and its use. But neither of those conclusions can be reached on the case and the evidence presented by the Complainant. It is simply not bad faith to buy a domain name and use it for your own purposes if that

conduct does not impinge in some way on the complainant's trademark. The Complainant has shown no evidence that this is what the Respondent has done.

First, it must be remembered that the notion of bad faith in these proceedings means bad faith directed or aimed at the complainant trademark owner and/or its trademark to do it some sort of harm. Once this is understood, it will be seen why the Complainant's case has not been made out. It has no trademark relevant to this case and it is difficult to see how it ever had such a trademark. Its associated body the "CENTRE DE RÉFÉRENCE SUR LA NUTRITION HUMAINE EXTENSO", which is not the Complainant, apparently did have a trademark for EXTENSO, but that trademark is dead and was dead when this proceeding was commenced, being in that state because as the registry states, it has been "cancelled or invalidated and removed from the registry". Nor is there any evidence showing that the University of Montreal, the Complainant in this proceeding, ever had any rights in the mark.

Accordingly, it cannot be that the mere assertion of non-existence trademark rights can have the result that the Respondent was acting in bad faith when it registered the domain name and has used it in a manner that the Complainant finds objectionable. It simply cannot be bad faith impinging on a trademark if there is no trademark.

Secondly, although the Complainant never owned the disputed domain name, the CENTRE DE RÉFÉRENCE SUR LA NUTRITION HUMAINE EXTENSO did own it and it owned it from 2001 or thereabouts until, it seems, November 2022 when it was allowed to expire. The Extenso Centre and /or the University did not renew the registration and it was taken up by the Respondent when it, and anyone else, was entitled to acquire it and pay the registration fees, which it obviously did. In other words, the complainant can scarcely complain that the respondent picked up the domain name when it became available and when the Extenso Centre and /or the University had virtually abandoned any interest in it.

There is a disturbing and complete lack of evidence produced showing bad faith. Some assertions have been made on behalf of the Complainant, but they are not evidence and the Policy is quite clear that each of the constituent elements must be proved, which means proved by evidence. In any event they do not explain why the acts complained of amount to bad faith. Showing that the Complainant does not like having given up control of the domain name voluntarily and seeing it now being used for a purpose of which the Complainant does not approve is not bad faith.

Again, the Complainant submitted that further substantiation of its case on bad faith is to be found in a document entitled "Application to institute proceedings" which is said to be annexed to the Complaint. However, no such document is attached to the Complaint or otherwise evident to the Panel. Nor has the Respondent been able to find it, which raises at least a question as to whether it is being given a fair opportunity to defend itself if it cannot have access to the evidence the Complainant apparently relies on.

Thus, the Complainant's case fails on the lack of any evidence to show that the Respondent registered and used the domain name in bad faith.

REVERSE DOMAIN NAME HIJACKING

The Respondent submits that the Panel should find that the Complaint was brought in bad faith in an attempt at Reverse Domain Name Hijacking and primarily to harass the Respondent and declare that the complaint constitutes an abuse of the administrative proceeding.

Reverse Domain Name Hijacking is defined in Rule 1 as using the UDRP Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name. That is a fair description of this proceeding. The Policy has been used in this case in bad faith because the Complainant must have known that it had no case or, alternatively, that it could not prove one and yet it went ahead.

The Panel's impression is that the Complainant has been motivated by regret that it voluntarily surrendered the domain name and now does not like the way it is being used. In that regard it is motivated by reasons that have nothing to do with issues arising under the UDRP and cannot have anything to do with the Complainant's trademarks because it has none.

Nevertheless, it went ahead with a baseless case and has put the Respondent, the Panel and the Provider to time and trouble in processing it. In particular, it is scarcely believable that all concerned should be sent off to look for a document entitled "Application to institute proceedings" where the Complainant's case is said to be found, but where there is apparently no such document.

This whole unsatisfactory situation is in a jurisdiction where the Panel has no power to award legal costs or damages against a failed Complainant. Had it had such power, the panel as presently constituted would have awarded both damages and costs against the Complainant.

As the Respondent's counsel points out, as part of a well-argued submission, this is made all the worse by the fact that the Complainant is legally represented.

The Panel therefore finds that the Complaint was brought in bad faith in an attempt at Reverse Domain Name Hijacking and primarily to harass the Respondent and declares that the Complaint constitutes an abuse of the administrative proceeding.

4 DECISION and ORDER

Having not established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

Accordingly, it is Ordered that the domain name be **RETAINED** by the Respondent.

