

ADMINISTRATIVE PANEL DECISION

Carlington Community Health Centre v. Support Tech, New Wave Systems Case No. D2023-3456

1. The Parties

The Complainant is Carlington Community Health Centre, Canada, represented by Gowling WLG (Canada) LLP, Canada.

The Respondent is Support Tech, New Wave Systems, Canada.

2. The Domain Name and Registrar

The disputed domain name <carlingtonchc.org> (the “Disputed Domain Name”) is registered with Webair Internet Development, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 14, 2023. On August 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On September 12, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent (Privacy Protect, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 13, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on September 14, 2023.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 12, 2023.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on October 17, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a registered charity and non-profit community-based health and social services provider incorporated in Canada.

The Complainant is the owner of common-law trademarks, consisting of the word “Carlington”, including CARLINGTON COMMUNITY HEALTH CENTRE, CARLINGTON design, and CARLINGTONCHC.ORG (hereafter the “CARLINGTON Trademarks”).

The Disputed Domain Name was registered on August 12, 2020, by the Complainant’s IT service provider on its behalf and was used by the Complainant to promote its services.

The Complainant and its IT services provider mutually agreed to terminate the managed IT services agreement. As part of the waiver executed by them, the IT services provider has committed to provide to the Complainant the domain user identification and password for the Complainant’s systems. However, the IT services provider did not transfer the Disputed Domain Name to the Complainant. Despite a cease-and-desist letter, the Disputed Domain Name has not been transferred to the Complainant and, at the date of the Complaint, resolves to an inactive website.

5. Parties’ Contentions

A. Complainant

As a preliminary remark, the Complainant indicates that the Respondent is its past IT services provider, who was instructed to register the Disputed Domain Name in the name of the Complainant (but did not), and has refused to transfer the Disputed Domain Name, disabled the website of the Complainant and began blocking certain emails destined for, or dispatched by, the Complainant.

First of all, the Complainant asserts that by virtue of its longstanding use it has rights in the CARLINGTON Trademarks and the Disputed Domain Name is confusingly similar to its CARLINGTON Trademarks.

Secondly, the Complainant submits that the Respondent has no rights or legitimate interest in the Disputed Domain Name, since the Respondent was not authorized to register the Disputed Domain Name in its own name and has committed to restate it to the Complainant under the waiver executed between the parties.

Lastly, the Complainant asserts that the Disputed Domain Name was registered and is being used in bad faith. The Complainant contends that registration of a domain name in the name of an IT support company – despite no permission being given for it to do so, and the instructions being to register the same on the Complainant’s behalf (but instead using a privacy service, thereby making it difficult for the Complainant to ascertain) – and the refusal of that IT support company to transfer the domain name to the rightful owner on account of a contractual dispute amounted to bad faith use under the Policy.

B. Respondent

The Respondent did not reply to the Complainant’s contentions. The Panel notes that the Complainant listed Fox IT Canada Inc. as the Respondent in the Complaint arguing that it was the Complainant’s IT service provider. The Respondent’s phone number identified in the Registrar’s verification response corresponds to the phone number of Fox IT Canada Inc. Therefore, the Panel is of the opinion that these two entities are connected.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant shall prove the following three elements:

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has right;
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

According to the Policy, paragraph 4(a)(i), the Complainant shall prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant relies on its common law rights in the CARLINGTON Trademark. It is constant that the term “trademark or service mark” as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered trademarks. See section 1.1, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). To establish unregistered or common law trademark rights for purposes of the UDRP, the Complainant must show that its trademark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services. See section 1.3, [WIPO Overview 3.0](#).

The Panel finds that the Complainant has provided evidence that it has common law trademarks rights in the CARLINGTON Trademark, since the Complainant demonstrates longstanding use of the CARLINGTON Trademark to designate its services and activities. The Panel moreover notes that the Respondent was aware of the Complainant and its marks and therefore there is no doubt the Respondent was aware of a source identifying capacity in the same.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the Disputed Domain Name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of the UDRP (see section 1.7 of the [WIPO Overview 3.0](#)).

Regarding the Disputed Domain Name, the Panel finds that it is composed of:

- the CARLINGTON Trademark;
- the initials of Community Health Center; and
- the generic Top-Level Domain (“gTLD”) “.org”, it being specified that the gTLD in a domain name is viewed as a standard registration requirement and as such is usually disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

According to prior UDRP panel decisions, it is sufficient that the disputed domain name incorporates the entirety of a trademark, in order to consider the domain name as confusingly similar to that mark for purposes of UDRP standing. The mere addition of descriptive or geographical term to a mark does not prevent a finding of confusing similarity (see section 1.8 of the [WIPO Overview 3.0](#)).

Regarding the Disputed Domain Name, the Panel finds that it incorporates the dominant part of the CARLINGTON Trademark in its entirety and considers that the insertion of the initials of Community Health Center which is part of the name of the Complainant, does not prevent a finding of confusing similarity.

Therefore, the Panel holds that the Disputed Domain Name is confusingly similar to the Complainant's trademark and that the Complainant has established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainant shall demonstrate that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name.

These circumstances are:

- before any notice of the dispute to the respondent, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

According to prior UDRP panel decisions, it is sufficient that a complainant shows *prima facie* that a respondent lacks rights or legitimate interests in a domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, while the overall burden of proof in a UDRP proceeding is on the complainant, previous UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out *prima facie* that a respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see section 2.1 of the [WIPO Overview 3.0](#)).

According to the Panel, the Complainant has shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. Indeed, it appears from the uncontested record that the Respondent should have registered the Disputed Domain Name in the name and on behalf of the Complainant, but that it did not.

Moreover, it appears that the Disputed Domain Name has not been used by the Respondent in connection with a *bona fide* offering of goods or services, nor is the Respondent making a legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain.

Finally, the Panel notes that the Respondent has not contested the Complainant's arguments.

Therefore, according to the Policy, paragraphs 4(a)(ii) and 4(c), the Panel considers that the Complainant has established that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name.

C. Registered and Used in Bad Faith

According to the Policy, paragraph 4(a)(iii), the Complainant shall prove that the Disputed Domain Name has been registered and is being used in bad faith.

Thus, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

First of all, the Panel finds that there is a presumption of bad faith registration of the Disputed Domain Name given that the Respondent did not register the Disputed Domain Name under the Complainant's name even though it was asked to do so and was not given permission to register the same in its own name.

Furthermore, there is no doubt that the Respondent was aware of the Complainant and its CARLINGTON Trademarks and that it has clearly no rights or legitimate interests in respect of the Disputed Domain Name.

The Panel also finds that the Respondent has refused to transfer the Disputed Domain Name to the Complainant after their agreement being mutually terminated and disabling the website of the Complainant to put pressure on the Complainant in a commercial dispute constitutes evidence of bad faith of the Respondent.

In view of the circumstances of the case, the current non-use of the Disputed Domain Name does not change the Panel's finding of the Respondent's bad faith.

Therefore, in view of all the circumstances of this case, the Panel holds that the Respondent has registered and is using the Disputed Domain Name in bad faith according to the Policy, paragraphs 4(a)(iii) and 4(b).

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name, <carlingtonchc.org> be transferred to the Complainant.

/Christiane Féral-Schuhl/

Christiane Féral-Schuhl

Sole Panelist

Date: October 31, 2023