

IN THE MATTER OF A COMPLAINT PURSUANT TO THE CANADIAN INTERNET
REGISTRATION AUTHORITY (“CIRA”) DOMAIN NAME DISPUTE RESOLUTION
POLICY AND RULES

Domain Name: HESPRESRESEARCHGROUP.CA

Complainant: Simon A.M. Hesp

Registrant: Harrison Gardner

Registrar: Go Get Canada Domain Registrar Ltd.

Panelists: Daniel Anthony (Chair), Eric Macramalla, Marcel D. Mongeon

Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant in this matter is Simon A.M. Hesp, a professor in the Chemistry Department of Queen’s University, in Kingston, Ontario.
2. The Registrant for the domain name is listed as Harrison Gardner, with an address in Winnipeg, Manitoba, Canada.

B. The Domain Name and Registrar

- 3.. The disputed domain name is <HespResearchGroup.ca> (the “Domain Name”). The Registrar for the Domain Name is Go Get Canada Domain Registrar, Ltd. The Domain Name was registered on January 14, 2021.

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, according to the information provided by the dispute resolution provider, Resolution Canada, Inc. (the “Provider”) is as follows:

- The Complainant filed its Complaint against the Registrant with Resolution Canada, Inc. on December 20, 2021, requesting that the registration for the domain name <HespResearchGroup.ca> be transferred to Simon A.M. Hesp.
- The Complainant obtained the identity of the Registrant from CIRA on December 20, 2021. CIRA also provided the Registrant's postal and email addresses to the Complainant.
- The Provider confirmed that locks had been placed on the Domain Name on December 20, 2021.
- On December 24, 2021, the Provider served a Notice of the Complaint to the Registrant as required by paragraphs 4 and 5 of the *Rules*. The Notice of Complaint informed the Registrant that it had 20 days from December 24, 2020, to respond to the Complaint.
- The Registrant did not file a response to the Complaint.
- The Complainant elected to proceed by a three-member panel.

D. Panelist Impartiality and Independence

6. As required by paragraph 7 of the *Rules*, this panel has submitted to the Provider a declaration of impartiality and independence in relation to this dispute.

E. Eligibility

7. The Complainant, Simon A.M. Hesp, is a Canadian citizen and satisfies paragraph 2(a) of the Canadian Presence Requirements for Registrants in respect of the Domain Name. Therefore, the Complainant is eligible to bring this Complaint, pursuant to paragraph 1.4 of the *Policy*.

F. Factual Background

8. According to the Complaint, the Complainant is a professor in the Chemistry Department of Queen's University, in Kingston, Ontario, who researches various aspects of asphalt materials, science, and engineering. On or about 2011, the Complainant adopted and began using HESP RESEARCH GROUP as a trade name and trademark in association with his scientific research services. The Complainant uses and continues to use the HESP RESEARCH GROUP trade name and trademark by displaying it on research papers, slide show presentations, and on his website.

9. The Complainant engaged the services of a design firm in October 2012 to create a website and promote his research. The design firm registered the Domain Name <HespResearchGroup.ca> on October 25, 2012.

10. While the Domain Name was under the Complainant's control, it was used to promote the Complainant's research activities and provide information to current, former, and prospective students. The Complainant also used the Domain Name for obtaining funding for future research projects. The Domain Name remained under the Complainant's control until 2020, but was not renewed.

11. The Registrant registered the Domain Name on January 14, 2021. Because the Registrant did not respond to the Complaint, there is no information from the Registrant regarding its activities. As discussed below, the Complainant provided some information within the Complaint.

12. The Complainant alleges that the Registrant is using the Domain Name to promote gambling and online casino games while also displaying a copy of the content from the original website. Specifically, the Complainant asserts that the Registrant created a website that copies the Complainant's proprietary content and infuses it with links to third-party gambling and online casino websites.

G. CIRA Domain Name Dispute Resolution Policy Requirements

13. Paragraph 3.1 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 no legitimate interest in the domain name as described in paragraph 3.4; and
- c) the Registrant has registered the domain name in bad faith as described in paragraph 3.5.

14. According to paragraph 4.1 of the *Policy*, the Complainant must establish elements (a) and (b) above on a balance of probabilities. The Complainant must also provide "some evidence" that the Registrant has no legitimate interest in the Domain Name.

H. Analysis

Confusingly Similar to Complainant's prior Mark

15. The Complainant must first establish that the disputed Domain Name is confusingly similar to a Mark in which the Complainant has rights in Canada prior to the date of registration of the Domain Name, and that it continues to have such rights as of the date of the Complaint.

16. The Complainant's asserted trade name and trademark is HESP RESEARCH GROUP ("the Hesp Mark"). Subparagraph 3.2(a) of the *Policy* defines a Mark as a trademark or trade name used in Canada to distinguish a person's wares, services or business from those of another. The Complainant submits he adopted and has been using the Hesp Mark since at least 2011 in association with his scientific research services. The evidence establishes use since at least May 15, 2013 (if not earlier), such as through printouts from Internet Archive's Way Back Machine. Those printouts show the Hesp Mark displayed on the website in association with scientific research services. Additional evidence is provided of scientific papers, presentations, and several million dollars of research funding. The Complainant commenced use of the Hesp Mark well before the Registrant registered the Domain Name on January 14, 2021. Accordingly, this panel

finds that the Complainant has established that the Hesp Mark is a “Mark” pursuant to subparagraph 3.2(a) of the *Policy* and that he enjoys prior rights and continues to have such rights.

17. According to paragraph 3.3 of the *Policy*, a domain name is confusingly similar to a Mark when it “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.” The Domain Name in dispute is <HespResearchGroup.ca>. As noted in *Coca-Cola Ltd v Amos B Hennan*, BCICAC Case No 00014, “[f]or the purposes of this Policy, ‘domain name’ means the domain name excluding the ‘dot-ca’ suffix.” Applying that definition, the domain name is identical to the Complainant’s Mark. Therefore, this panels finds that the Complainant has met his burden of establishing, on a balance of probabilities, that the Domain Name is confusingly similar to the Hesp Mark, in which the Complainant had rights prior to the date of the registration of the Domain Name and continues to have rights.

Legitimate Interest

18. The Complainant submitted that he has never authorized the Registrant to register or use the Hesp Mark in any manner, including as a domain name. In the absence of any responding submissions, this panel accepts the Complainant’s evidence.

19. Under subparagraph 4.1(c) of the *Policy*, the Complainant must provide “some evidence” that “the Registrant has no legitimate interest in the Domain Name.” Paragraph 3.4 of the *Policy* enumerates six circumstances in which a legitimate interest may arise.

20. This panel finds that the Complainant has provided more than just “some evidence” of the Registrant’s lack of a legitimate interest in the Domain Name. The Complainant has provided supporting evidence of longstanding use of the Hesp Mark. Further, the Complainant has demonstrated that since the Registrant registered the Domain Name, it has engaged in activities indicative of impersonation and bad faith, discussed in greater detail below. In the absence of any responding submissions, this panel accepts the Complainant’s evidence. Thus, subparagraphs 3.4(a) to (d) of the *Policy* – all requiring good faith – cannot be met.

21. Subparagraphs 3.4(e) and (f) of the *Policy* do not apply. The Domain Name is not the legal name provided by the Registrant, nor does it appear to be the way the Registrant is commonly identified. The Domain Name is not a geographical name of the Registrant’s non-commercial activity or place of business.

22. No other legitimate interest can be made out from the evidence. Therefore, this panel finds that the Complainant satisfied his burden of providing “some evidence” that the Registrant has no legitimate interest in the Domain Name.

Bad Faith

23. Several non-exhaustive bases for a finding of bad faith are set out in paragraph 3.5 of the *Policy*. The Complainant has advanced arguments under bad faith set out in subparagraphs 3.5(b) and 3.5(d) of the *Policy*. Each argument is addressed below.

24. Subparagraph 3.5(b) of the *Policy* provides:

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 has submitted ample evidence supporting a pattern of the Registrant registering domain names and appropriating the trademarks, business names, personal names, and likenesses of others to promote third-party gambling and online casino websites. The Complainant supplied a list of dot-ca domain names owned by the Registrant, identified by CIRA, demonstrating that the Registrant owns over 290 domain names. Many of the listed domain names are stated to link to active websites displaying information about the person or business legitimately associated with the name that forms the domain name, with additional text added by the Registrant to promote gambling. The Complainant provided numerous exemplary screen captures showing that these domain names link to websites prominently displaying text and hyperlinks to online casino websites. The same online casino websites whose hyperlinks are displayed on the website associated with the Domain Name at issue.

26. As few as two registrations, including the domain(s) at dispute, have been found sufficient to establish a pattern under subparagraph 3.5(b) of the *Policy*: e.g. *Great Pacific Industries Inc v Ghalib Dhalla*, BCICAC Case No. 00009; *Canadian Broadcasting Corporation/Société Radio-Canada v William Quan*, BCICAC Case No. 00006; *Allergan Inc v Hiebert Net Inc*, BCICAC Case No. 00058. The Complainant provided a list generated by CIRA of over 290 domain names owned by the Registrant. The Complainant also provided three examples of the Registrant using these domain names to appropriate the likenesses of persons, businesses, and marks to compel visitors to navigate to online gambling and casino websites. This panel finds that the Complainant has demonstrated that the Registrant has engaged in a pattern of registering domain names to prevent the Complainant and others from registering domain names corresponding to Marks in which they have rights. Bad faith is therefore established pursuant to subparagraph 3.5(b) of the *Policy*.

27. Subparagraph 3.5(d) of the *Policy* provides:

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. The Complainant argues that the Registrant's website creates a likelihood of confusion with the Complainant's Hesp Mark as to the source, sponsorship, affiliation, or endorsement of online casinos promoted on and linked to the Registrant's website. The Complainant provided screen captures demonstrating that, when he held the registration to the Domain Name between at least 2013 and 2020, he linked the Domain Name to a website to display his Mark, identifying information, research services, and updates on his research activities. The Complainant supplied additional screen captures of the website currently linked to the Domain Name. These images demonstrate that the Registrant's website copies most of the Complainant's original website. Indeed, the Complainant's photograph, address, phone number, and Hesp Mark are prominently featured on the Registrant's website. The Registrant uses this website to link visitors to third-party gambling and online casino websites by adding additional in various places throughout the website. In the absence of evidence to the contrary, this panel finds that a significant number of individuals navigating to this website are likely to be confused as to whether the website hosted at the disputed Domain Name is affiliated with or endorsed by the Complainant. Therefore, the Complainant's evidence establishes bad faith under subparagraph 3.5(d) of the *Policy*.

29. Since the bad faith factors are non-exhaustive, it is also open to the panel to make a general finding of bad faith. In this regard, the conduct of the Registrant suggests numerous potential grounds of illegal activity, which could constitute bad faith, including copyright infringement (by copying the photos and text of the original website without permission), misappropriation of personality, and promoting unregulated online gambling in association with the Complainant's Mark. The panel would have been open to considering these issues had they been plead.

I. Conclusion and Decision

30. This panel finds that the Complainant has prior rights in the mark HESP RESEARCH GROUP. The Domain Name is confusingly similar to the Mark, the Registrant had no legitimate interest in the Domain Name, and the Domain Name was registered in bad faith.

J. Remedy

31. The Domain Name should be transferred to the Complainant in accordance with paragraph 4.3 of the *Policy*.

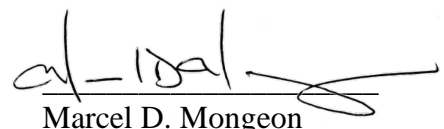
Dated February 4th, 2022.



Daniel Anthony (Chair)



Eric Macramalla



Marcel D. Mongeon