



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

CIIDRC case number: URDP-12896

Decision date: August 14, 2020

Panel: Peter L. Michaelson, Esq.

Disputed Domain Name: <stantecgroup.com>

Complainant: Stantec Consulting Ltd.; Edmonton, Canada

Respondent: Colin Jackson; Lakemba, New South Wales, Australia

Registrar: GoDaddy.com, LLC

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## **1. PROCEDURAL HISTORY**

The Complaint was filed with the Canadian International Internet Dispute Resolution Centre (the "Centre") on July 7, 2020.

On July 7, 2020, the Centre transmitted, by e-mail, to the Registrar a request for registrar verification in connection with the disputed domain name. On July 8, 2020, the Registrar transmitted, by e-mail, to the Center its verification response disclosing registrant and contact information for the name and confirmed that it placed the name on registrar lock.

Also on July 8, 2020, the Centre verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), 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").

Also on July 8, 2020 and in accordance with the paragraphs 4 of the Rules and 5 of the Supplemental Rules, the Centre formally notified the Respondent of the Complaint and that the proceedings commenced on July 8, 2020. In accordance with the paragraph 5 of the Rules, the Centre set the due date for Response to July 28, 2020. On July 10, 2020, the Respondent replied, by e-mail, to the Centre simply informing the Centre that the disputed domain name "is no more in use by anyone". Later on July 10, 2020, the Centre provided a copy of its standard settlement form to the parties. In response to the form, the Complainant informed the Centre of its election to continue this proceeding.

Other than its July 10th communication to the Centre, the Respondent submitted nothing further to the Centre, whether a further response or otherwise.

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The Center appointed Peter L. Michaelson as the sole panelist in this matter on August 10, 2020. 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 Centre to ensure compliance with paragraph 7 of the Rules.

The Centre set August 24, 2020 as the due date to receive the decision from the Panel.

## 2. FACTS ALLEGED BY THE PARTIES

As reflected in the registration record for the disputed domain name in the public Whois database (a copy of that record appears in Annex C-1 to the Complaint), the disputed domain name <stantecgroup.com> was registered on January 16, 2020 and will expire on January 16, 2021.

### A. The Complainant's STANTEC Marks

As indicated in the Complaint, the Complainant owns several trademark registrations in Canada, United States, European Community, Australia and New Zealand for either the term "STANTEC" in block letters (word mark) alone or a stylized "S" (design mark) (all collectively referred to as the "STANTEC Marks"). The Complainant has provided, in Annexes A-1 through A-5 and B-2 to the Complaint, copies of its registration certificates for these registrations. Pertinent details of its Canadian registrations are as follows:

- (1) STANTEC (word)  
Canadian registration number: TMA537134  
Registered: November 16, 2000

This registration covers the following services in international classes 35, 37, 41 and 42: "Civil, mechanical and electrical engineering, architecture, landscape architecture, planning and related professional services, namely: analysis and consultation, property design, survey, inspection and appraisal, land development, project planning and delivery, computer software development, maintenance service, training and retail and wholesale sales, computer hardware development maintenance service, training and retail and wholesale sales, and design build and technology development, all to private and public sector clients in the fields of: environmental assessment and management; building construction and development; transportation systems and infrastructure; industrial systems and infrastructure; urban land development and management systems." The registrant claims first use of the mark occurred in Canada as early as November 3, 1998.

- (2) S (stylized)  
Canadian registration number: TMA946027  
Registered: August 11, 2016

This registration covers the following services in international classes 36, 37, 41 and 42: "Civil, mechanical and electrical engineering, architecture, landscape architecture, planning and related professional services, namely: analysis and consultation, property design, survey, inspection and appraisal, land development, project planning and delivery, computer software development and maintenance service, training, computer hardware development maintenance service, technology development, all to private and public sector clients in the fields of: environmental assessment and management; building construction and development; design of roadways, bridges, rail systems and other transportation infrastructure; design of industrial buildings; design of urban land development and management systems".

### B. The Parties and their Activities

The Complainant began in 1954, when Dr. Don Stanley founded an engineering practice, D.R. Stanley Associates, in Alberta, Canada. In 1994, the Complainant's parent corporation, Stantec Inc., was listed on the Toronto Stock Exchange and, in 1997, a single brand identity, Stantec, was officially introduced. In 2005, Stantec Inc. was listed on the New York Stock Exchange. As of 2017, the Complainant became one of the top ten global design firms (as ranked by Engineering News-Record magazine and based on revenue for design services). The Complainant, through its parent, subsidiaries and affiliates currently provides professional design consultation services across a wide variety of fields and employs approximately 22,000 employees working in 350 locations across six continents.

The Respondent's website, to which the disputed domain name resolves, uses the STANTEC Marks to identify a construction company, having no relationship to the Complainant. A screenshot of the home page of that site appears in Annex B-1 to the Complaint. Specifically, the page contains two relatively large images, each depicting construction activity, thus implicating services directly related to those furnished by the Complainant. Prominently superimposed on the first image is the name of a business entity, STANTEC GROUP, which incorporates the Complainant's mark STANTEC but which has no relationship whatsoever to the Complainant. To the immediate left of the name, and equally prominently displayed, is a stylized S that appears to be identical to the Complainant's design mark. The address of the company, shown superimposed on the second image as "230 New Found Lane, 8900 New City", is fictitious.

The Respondent, through use of the name, operates an employment scam. It offers unsuspecting applicants employment at a company, which they would reasonably perceive through the website, to be the Complainant -- when in actuality it is not, and, during the course of doing so, requires those applicants to disclose personal data, complete immigration forms and remit monetary fees to what appears to be a recruiter affiliated with the Complainant -- which, here too, the recruiter is not.

Specifically, upon being contacted by the Respondent, each applicant is told by the recruiter that he/she was being offered employment with the Complainant -- when in fact the Complainant made no such offer. Each applicant was then instructed to provide the recruiter with: personal information by sending the recruiter copies of his/her passport and those of his/her spouse and family members, and various completed immigration forms. Each applicant was also told to remit funds ostensibly required by Canadian immigration authorities to initiate immigration processes, specifically, in one instance, the "Express Entry System and the Permanent Residency Application", through which, once approved by those authorities, the applicant and his/her family could move to Canada and applicant could begin work for an entity which s/he then believed to be the Complainant. Copies of the Complainant's e-mail correspondence with two victims of the Respondent's scam, including messages which each of those victims received from his/her alleged recruiter, are provided in Annexes D-1 and D-2 to the Complaint. One of those messages, dated February 9, 2020 and provided in the e-mail chain in Annex D-2, was sent from an e-mail address, care@stantecgroup.com, having generic top and second level domains identical to those in the disputed domain name. The employment offer letters and the immigration forms provided by the Respondent to the victims were intentionally designed to appear as though they were issued by the Complainant. Further, to bolster the scam, the recruiter states, in a responding e-mail to each applicant, that the applicant would later be reimbursed for those fees.

On April 13, 2020, the Complainant's attorney sent a cease and desist message, by e-mail, to the Respondent through which the attorney demanded the Respondent shut down its website and transfer the disputed domain name to the Complainant. On April 20, 2020, the attorney, noting that the Respondent removed most of the content from its website but that the page still contained the Complainant's marks, inquired, also by e-mail, with the Respondent as to whether the latter initiated transfer of the name to the Complainant and if so what information it might require. On April 30, 2020, the attorney informed the Respondent, also by e-mail, that the Complainant was then aware of the employment scam the Respondent was running using the disputed domain name and demanded transfer of the name by May 8, 2020. No further communication occurred between the parties. On July 7, 2020, the Complainant initiated this proceeding.

### **3. CONTENTIONS OF THE PARTIES**

#### **A. Complainant**

##### **(i) Identical or Confusingly Similar**

The Complainant contends that the Respondent's website, including the disputed domain name, identically includes both the Complainant's word mark STANTEC and its design mark.

From this contention, it is evident to the Panel that the Complainant takes the position that the name itself is confusingly similar to that mark by virtue of the name including the word mark followed by the additional word "group", with the latter imparting no distinctiveness to the name.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy.

Specifically, the Respondent is not affiliated with nor is it authorized by the Complainant to use any of the Complainant's intellectual property, including its STANTEC Marks. Consequently, any use of the disputed domain name by the Respondent would infringe the Complainant's exclusive rights in its marks.

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using the disputed domain name in bad faith in violation of paragraphs 4(a)(iii) and 4(b) (iv) of the Policy.

Specifically, the Respondent is using the name in operating a fraudulent employment scan through which it intentionally attracts, for commercial gain, Internet users to its website. The Respondent has deliberately selected and registered the name, which incorporates the Complainant's mark, to likely confuse those users into believing that the Complainant is operating the website, when, in actuality, the Complainant has no involvement or affiliation with, or sponsorship or endorsement of the site. This reflects bad faith registration.

Through the website, the Respondent is using the name in bad faith, by virtue of making fraudulent employment offers, which are designed to appear as having been issued on behalf of the Complainant, to unsuspecting victims. The Complainant has had interactions with at least two individuals who have been in contact with the Respondent. These individuals reached out to the Respondent either through the contact information contained on the website or responded to job postings created by the Respondent. Subsequently and as shown by their e-mail correspondence with the Respondent -- copies of which appear in Annexes D-1 and D-2 to the Complaint, the Respondent, acting as a recruiter, offered both of them employment under the guise that it would be with the Complainant -- when, in fact, the Complainant made no such offers. As part of the scam and as indicated in the correspondence from the Respondent, the Respondent required each of these individuals to provide it with personal information and pay funds to it for facilitating immigration processes required to allow them and their families to move to Canada and for them to begin working for the Complainant. The Respondent intentionally designed immigration forms for victims to complete as well as employment offer letters, which included the Complainant's STANTEC Marks, to appear as though the Complainant issued them -- when in fact the Complainant did not.

**B. Respondent**

On July 10, 2020, the Respondent informed the Centre that the disputed domain name "is no more in use by anyone". The Respondent submitted nothing further in response to the Complaint. Consequently, the Panel viewed all the Complainant's factual allegations as undisputed and accepted those allegations which the Panel finds are not inherently implausible.

**4. DISCUSSION AND FINDINGS**

In accordance with Paragraph 4 of the Policy, the Complainant has the burden to prove that:

- i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- ii) the Respondent has no rights or legitimate interests in the disputed domain name; and
- iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will now address each of these elements in turn.

## A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's mark STANTEC.

From a simple comparison of the disputed domain name to the Complainant's mark, no doubt exists that the disputed domain name is confusingly similar to it. The name consists of the term "STANTEC", followed by the word "group" to form a composite term "stantecgroup" to which the generic Top-Level Domain ("gTLD") ".com" has been appended, with the addition of a gTLD generally being ignored in assessing confusing similarity/identity. Well-established UDRP precedent holds that "[t]he applicable Top Level Domain ("TLD") in a domain name (e.g., ".com", ".org", ".net") is viewed as a standard registration requirement and as such is disregarded under the first element [paragraph 4(a)(i)] confusing similarity test." See WIPO Overview 3.0, section 1.11.

It is now very well-established in prior UDRP cases, including numerous decisions previously rendered by this Panel, that a minor variation to a mark is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to prevent confusing similarity. The Respondent's addition of the word "group" to the Complainant's mark to form the disputed domain name unquestionably constitutes such a minor variation. See, e.g., *Praxis Capital, Inc. v. John C. Martinez, The Praxeology Group LLC*, WIPO Case No. D2019-0254, *Kumfs Brand Limited v. George*, WIPO Case No. D2016-1272; *Dubizzle Limited BVI v. Rana Anabtawi*, WIPO Case No. D2016-0843; *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill*, WIPO Case No. D2015-1842; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D-2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D-2009-1286; and *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148.

Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

## B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize the Complainant's STANTEC Marks and has no relationship, affiliation or connection whatsoever with the Respondent.

Further, the Respondent's use of the name in connection with running an illicit activity, here being an employment scam through which unsuspecting applicants are defrauded of monetary fees, does not constitute use of the name in connection with a *bona fide* offering of goods or services or reflect any prior demonstrable preparations to do so. Moreover, using a domain name that intentionally infringes the exclusive trademark rights of another, as is the case here, also fails to qualify as a *bona fide* use. Also, such use does not constitute a legitimate non-commercial or fair use either. Accordingly, the Respondent fails to qualify under either paragraph 4(c)(i) or (iii) of the Policy.

Given the Complainant's exclusive rights in its STANTEC Marks, which predate, by approximately 22 years, the date (January 16, 2020) on which the Respondent registered the disputed domain name, the Respondent could not legitimately acquire such a public association with any mark similar to those of the Complainant — at least for the services provided by the Complainant under its STANTEC Marks — without interfering with the exclusive trademark rights of the Complainant. See, e.g., *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. D2015-1527; *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 62520014085963*, WIPO Case No. D2015-0787; and *Praxis Capital, Chicago Mercantile Exchange Inc., Cummins Inc. and Staatliche Porzellan-Manufaktur*, all cited *supra*. Consequently, the Respondent is not commonly known by the disputed domain name or the Complainant's mark and accordingly fails to qualify under paragraph 4(c)(ii) of the Policy.

Hence, the Respondent fails to demonstrate that it has any rights or legitimate interests in the disputed domain name.

### **C. Registered and Used in Bad Faith**

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

The Panel finds that, under the facts of record, it is simply undeniable that, in all likelihood, the Respondent was well aware of: (a) the Complainant, its reputation and goodwill in its STANTEC Marks, and the exclusive rights which the Complainant then had in that marks when the Respondent registered the disputed domain name, and (b) the potential for that name to cause confusion in the minds of Internet users with those marks. Yet, in spite of that knowledge and in the absence of any authority to do so from the Complainant, the Respondent intentionally registered the name for its use in implementing an employment scam through which the Respondent could deliberately cause and exploit that confusion for its own pecuniary benefit. This constitutes bad faith registration.

Not only did the Respondent use the name, which included the Complainant's mark STANTEC, to address its website and cause confusion, it heightened the potential for such confusion by prominently incorporating the STANTEC Marks into the content into that site. It did all this to accomplish a critical aspect of its fraudulent scam: convincing unsuspecting Internet users, by exploiting their knowledge of the Complainant and its reputation, into reasonably thinking that the Respondent's website was affiliated, endorsed or associated, in some manner, with the Complainant, and as such the offers of employment, and the request for personal information and monetary fees emanated from the Complainant and were all legitimate -- when, in fact, they were all fraudulent. This clearly reflects bad faith use.

Thus, the Respondent has violated paragraphs 4(a) (iii) and 4(b)(iv) of the Policy.

Accordingly, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

## **5. DECISION and ORDER**

For the above reasons, in accordance with Paragraph 4 of the Policy, Paragraph 15 of the Rules and Rule 10 of the Supplemental Rules, the Panel grants the relief sought by the Complainant.

The Panel now orders that the disputed domain name <stantecgroup.com> be transferred to the Complainant.

Signed this day August 14, 2020.

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Peter L. Michaelson, Esq., Panelist

