

**CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

DECISION

Domain Name: kpmg-lawyers.ca
Complainants: KPMG International Cooperative and KPMG LLP
Registrant: Dominique Brassard
Registrar: 10850365 Canada Ltd.
Service Provider: Resolution Canada Inc.
Panelist: Alessandro Colonnier

A. THE PARTIES

1. The complainants are KPMG International Cooperative, having an address at Laan van Langerhuize 1, 1186 DS Amstelveen, Netherlands; and, KPMG LLP, having an address at 333 Bay Street, Suite 4600, Toronto, Ontario M5H 2S5 Canada (together the “Complainants”).
2. According to the record, the registrant is Dominique Brassard (the “Registrant”), having an address at 600 Maisonneuve Blvd W Suite 1500, Montreal, QC, Canada, H3A 0A3.

B. DISPUTED DOMAIN NAME & REGISTRAR

3. The disputed domain name is kpmg-lawyers.ca (the “Domain Name”) and the registrar is 10850365 Canada Ltd (the “Registrar”).

C. PROCEDURAL HISTORY

4. This is a dispute resolution proceeding initiated pursuant to the *CIRA Domain Name Dispute Resolution Policy*, Version 1.3 (August 22, 2011) (the “Policy”) and the *CIRA Policies, Rules, and Procedures - CIRA Domain Name Dispute Resolution Rules*, Version 1.5 (July 28, 2014) (the “Rules”). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of this dispute pursuant to the Policy and the Rules.
5. The Complainants filed their complaint (the “Complaint”) and the proceeding was commenced on January 31, 2020.
6. In accordance with the Rules, Resolution Canada Inc. (the “Provider”) sent an e-mail the Registrant’s e-mail of record on January 31, 2020. No response was received.
7. On March 4, 2020, the Panel was appointed. As prescribed by the Policy, the Panel has declared to the Provider that it can act impartially and independently in connection with this matter, and that there are no circumstances known to the Panel that would prevent it from so acting.

D. CANADIAN PRESENCE REQUIREMENTS: ELIGIBILITY OF THE COMPLAINANTS

8. The Panel must be satisfied that the Complainant is eligible to bring a Complaint with CIRA and fulfills one of the criteria set out in paragraph 2 of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3 (the “CPRR”).
9. The Complainants made no submissions that they are eligible to submit the Complaint.
10. Despite this omission, the Panel has reviewed the evidence and notes that KPMG International Cooperative is eligible to file the Complaint by virtue of being the owner of the trademark having a Canadian Trademark Registration No. TMA394020 for “KPMG” (the “KPMG Mark”). Meanwhile, KPMG LLP is eligible to file the Complaint by virtue of its presence in Toronto, Canada. As such, the Panel will accept that both Complainants are eligible under the CPRR Paragraphs 2(q) and 2(d), respectively.

E. THE POSITIONS OF THE PARTIES

The Complainants’ Position

11. The Complainants are one of the world's leading providers of audit, tax and advisory services. Those services are provided by the KPMG member firms, such as KPMG LLP, under the trademark KPMG. Member firms of the KPMG network of independent firms are affiliated with KPMG International Cooperative. KPMG member firms operate in approximately 148 countries, with over 200,000 employees. KPMG International Cooperative owns the trademark KPMG and licenses its use to the KPMG member firms worldwide. KPMG LLP is licensed to use the Canadian trademark registrations of KPMG.
12. The Complainants have ranked consistently as one of the big four professional service firms and the Complainants’ origin spans three centuries. The combined global revenues of the KPMG member firms in 2018 were USD 28.96 billion.
13. The global and member firm KPMG websites operate under the flagship domain name kpmg.com. The KPMG brand has been consistently ranked among the world's top brands for many years. For example, Fortune magazine has ranked KPMG among the 100 Best Companies to Work For, from 2009 to 2012 and from 2014 to 2017.
14. The Complainants own over 480 trademark registrations containing the name “KPMG”, including the aforementioned KPMG Mark. The Complainants have accordingly established very substantial international rights in the KPMG Mark. The KPMG Mark is inherently distinctive and non-descriptive, and it is famous throughout the world.
15. Meanwhile, the Domain Name was registered on September 10, 2019, many years after the establishment of the Complainants’ well-known KPMG Mark.

16. On October 3, 2019, a telephone call was made to an existing client of KPMG. The caller claimed to be Dominique Brassard, a genuine employee of KPMG LLP, and told the client's personal assistant that *he* (this even though the genuine Dominique Brassard is a female) was working with the president of the client. The caller then claimed that they had to transfer \$500,000 US dollars to complete the transaction for legal fees on a deal.
17. After the call, an email was sent on the same day to the client's personal assistant from dominique.brassard@kpmg-lawyers.ca. This email asked the client for an update regarding the transfer of \$500,000 US dollars to "Scotia Bank".
18. The client suspected that the call and email exchange were fraudulent and contacted the genuine Dominique Brassard by email to alert her of the impersonation and attempted fraud. The client also reported the correspondence to the police.
19. The genuine Dominique Brassard was not aware of the emails that were sent by the impersonator, and so it became apparent that the call and email of October 3, 2019 had been a scam.
20. The Complainants confirm that they have no connection with the Registrant, the Domain Name or the e-mail address dominique.brassard@kpmg-lawyers.ca.
21. The Complainants have requested that the Domain Name be transferred to KPMG International Cooperative; or, in the alternative, to KPMG LLP.

The Registrant's Position

22. The Registrant did not file a response.

F. DISCUSSION & REASONS

23. In accordance with Paragraph 4.1 of the Policy, to succeed in this proceeding, the Complainants must prove on a balance of probabilities that:

- a. the Registrant's Domain Name is Confusingly Similar to a Mark in which the Complainants 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 of the Policy;

and the Complainants must provide some evidence that:

- c. the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.4 of the Policy.

G. CONFUSINGLY SIMILAR – PARAGRAPH 3.3

24. In accordance with paragraph 3.1(a) of the Policy, to satisfy this branch of the test, the Complainants must demonstrate that: i. they have rights in a mark; ii. the rights in its mark predate the registration date of the Domain Name; and iii. the Domain Name is confusingly similar with the mark.
25. The Complainants have shown that KPMG International Cooperative is the owner of the KPMG Mark, which has been registered in Canada since February 7, 1992. These rights long predate the September 2019 registration date of the Domain Name.
26. As per Paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark only if the domain name so nearly resembles the mark in appearance, sound or in the ideas suggested by the mark so as to be likely to be mistaken for the mark.
27. Pursuant to Paragraph 1.2 of the Policy, a domain name is defined as the second level domain (the portion that immediately precedes the dot-ca suffix).
28. In this case, the relevant part of the Domain Name is “kpmg-lawyers”. The difference between the Domain Name and KPMG Mark is the “-lawyers” suffix. The first element of the Domain Name is identical to the distinctive and famous KPMG Mark. As the Complainants point out, “kpmg” is the first element of the Domain Name and is therefore the Domain Name’s dominant and principle component. Including the “-lawyers” suffix after “kpmg” suggests that the Domain Name relates to the Complainants’ legal services and business activities.
29. In addition, the Panel notes that the “-lawyers” suffix is a common word and does little to distinguish the overall appearance of the Domain Name from the KPMG Mark.
30. As such, the Panel finds that the Domain Name so nearly resembles the KPMG Mark in appearance as to be mistaken for the KPMG Mark. The Domain Name is therefore confusingly similar to the KPMG Mark.

H. BAD FAITH REGISTRATION

31. To succeed, the Complainants must prove on a balance of probabilities that the Domain Name was registered in bad faith. Paragraph 3.5 of the Policy sets out a non-exhaustive list of criteria that may establish bad faith registration.
32. The Complainants have provided evidence that the Registrant registered and acquired the Domain Name to deceive the Complainants’ clients for commercial gain. As evidenced by the October 3, 2019 emails sent to the Complainants, the deception was carried out by attempting to fool the client that the sender, dominique.brassard@kpmg-lawyers.ca, was an employee of the Complainants using a domain name that was confusingly similar to the KPMG mark.

33. Although there is no direct link between the sender of the fraudulent e-mail and the Registrant, the Panel accepts, given the evidence before it, that the Registrant and the sender are the same person. The Registrant listed its name as “Dominique Brassard” – the same name that was used in the sender’s email address and mimicking the name of a genuine employee of the Complainants.
34. While it is clear to the Panel that the Registrant registered the Domain Name to defraud at least one client of the Complainants, they did so by using the domain in an e-mail address; the actual “kpmg-lawyers.ca” Domain Name does not appear to ever have been used.
35. In view of the above, the Panel notes that the evidence and arguments on file do not fit squarely into one of the specific examples of bad faith enumerated in Paragraph 3.5 of the Policy.
36. The Panel cites a statement originally made in Spanish but since translated by another Panel in [WIPO Domain Name Decision D2005-1338](#), which held that “whosoever acts in bad faith when registering a domain name will inevitably use it in bad faith, because bad faith is linked to the perpetrator’s awareness at the time of registration that a third party’s rights would be damaged”.
37. Indeed, although the Registrant does not appear to have ever used the Domain Name, the Registrant knew of the Complainants and at least one of their clients. The Registrant’s purpose to register the Domain Name was clearly to create e-mail addresses designed to fool and defraud clients of the Complainants.
38. In view of the foregoing, the Panel concludes that the Registrant has registered the Domain Name in bad faith pursuant to Paragraph 3.5 of the Policy.

I. LEGITIMATE INTEREST

39. The final element to determine is whether the Registrant has a legitimate interest in the Domain Name. Paragraph 4.1(c) of the Policy requires the Complainant to provide some evidence that “the Registrant has no legitimate interest in the domain name as described in paragraph 3.4”.
40. The Panel finds that the Complainants have provided some evidence that the Registrant has no legitimate interest in the Domain Name.
41. In particular, the Complainants note that the Domain Name does not direct to a live website, and that it was created to impersonate an email of an employee of the Complainant. As evidence of the latter, the Complainants pointed to the fraudulent emails sent on October 3, 2019 to one of the Complainants’ clients.
42. With specific reference to list of legitimate interest circumstances as provided in Paragraph 3.4 of the Policy, the Panel finds that the Registrant did not use the Domain Name in good faith. The Domain Name is not a clearly descriptive or generic name associated with wares or services. The Registrant did not use the Domain Name in good faith in association with a non-commercial activity. The

Domain Name does not appear to be the legal name of the Registrant or some other name by which it was commonly identified. Finally, the Domain Name is not the geographic name of the location of the Registrant's non-commercial activity or business.

43. Clearly, none of the criteria in Paragraph 3.4 of the Policy have been satisfied and the Panel finds that the Complainants have provided some evidence that the Registrant has no legitimate interest in the Domain Name.

J. CONCLUSION AND ORDER

44. For the reasons set out above, the Panel decides this dispute in favour of the Complainants.
45. Pursuant to Paragraph 4.3 of the Policy, the Panel orders the transfer of the Domain Name "kpmg-lawyers.ca" to KPMG LLP, the registrant of the KPMG Mark.



Alessandro Colonnier for the Panel

March 24, 2020