

**IN THE MATTER OF A COMPLAINT PURSUANT TO
THE CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

Dispute Number: DCA-1450-CIRA
Domain Name : <greypower.ca>
Complainant: Intact Financial Corporation
Registrant: Jack Fagan and Auto-Intelligent Management Systems Inc.
Registrar: DomainsAtCost Corp
Panel: The Honourable Neil Anthony Brown QC
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

THE PARTIES

1. The Complainant in this proceeding is Intact Financial Corporation of 700 University Avenue, Suite 1500-A, Toronto, Ontario, M5G 0A1 ("Intact").
2. The Registrant is Jack Fagan and Auto-Intelligent Management Systems Inc. of 3300 Gregoire Road, Russell, Ontario, K4R 1E5 ("the Registrant").

THE DOMAIN NAME AND REGISTRAR

3. The Domain Name in issue in this proceeding is <greypower.ca> ("the disputed domain name").
4. The Registrar is: DomainsAtCost Corp.
5. The disputed domain name was registered by the Registrant on February 1, 2001.

PROCEDURAL HISTORY

6. The British Columbia International Commercial Arbitration Centre ("BCICAC") is a recognized service provider to the CIRA Domain Name Dispute Resolution Policy ("the Policy") of the Canadian Internet Registration Authority ("CIRA").
7. According to the information provided by the BCICAC :
 - (a) The Complainant filed a Complaint with respect the disputed domain name in accordance with the Policy on December 14, 2012.
 - (b) The Complaint was reviewed and found to be compliant. By letter dated December 18, 2012, the BCICAC as service Provider confirmed compliance of the Complaint and commencement of the dispute resolution process.

(c) The Complaint together with the schedules thereto was sent by BCICAC as service provider to the Registrant by letter on December 18, 2012 and delivered on that date; a successful mail delivery report was subsequently furnished, enabling the Panel to conclude that the Complaint and its schedules were duly delivered to the Respondent. By the same communication the Registrant was informed that it could file a Response in the proceeding on or before

(d) The Registrant did not reply to that communication and did not provide a Response.

(e) As permitted under CIRA Domain Name Dispute Resolution Rules ("the Rules") the Complainant elected under Rule 6.5 to convert from a panel of three to a single arbitrator.

(f) On January 15, 2013, BCICAC named The Honourable Neil Anthony Brown QC as the Panel. On January 18, 2013, the Panel signed an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.

(g) On January 21, 2013 the Registrant wrote to BCICAC by email requesting an extension of time within which to file a Response due to the fact that the Registrant had been out of the country and had been unaware of the proceeding. BCICAC referred that issue to the Panel and the Panel granted an extension of time to the Registrant until 5 PM on Friday February 1, 2013 to file an electronic copy of the Response. The time for the delivery of the decision to BCICAC was also amended by the Panel pursuant to Rule 12.2 to February 8, 2013. BCICAC wrote to the Registrant by email on January 25, 2013 conveying those matters to it. The Registrant did not file a Response by February 1, 2013 or at all.

(h) The Panel has reviewed all of the material submitted by the Complainant and is satisfied that the Complainant is an eligible Complainant under the Policy and the Rules.

(i) In accordance with Rule 5.8, where, as here, no Response is submitted, the Panel shall decide the Proceeding on the basis of the Complaint.

FACTS

8. The facts set out below are taken from the Complaint.

9. The Complainant is Canada's largest insurance organization and owns several well known brands, including GREY POWER, INTACT INSURANCE and belairdirect. The Complainant has provided these insurance services with the mark GREYPOWER since 1993 through its subsidiary Grey Power Insurance Brokers Inc. The Complainant, through its subsidiary, owns the domain name <greypower.com> registered in 1996 and used by the Complainant in its business.

10. The Complainant is the registered owner of the trade-mark GREYPOWER, Registration No. TMA481316, registered in the Canadian Intellectual Property Office (CIPO) on August 22, 1997 and in association with "insurance and financial services, namely the operation of a business providing insurance policies and insurance packages for seniors." Evidence has been submitted by the Complainant of the registration of the GREY POWER trademark and the

Panel accepts that evidence. The GREY POWER trademark has been extensively and continuously used and promoted in Canada for many years and as a result has become very well known and millions of dollars in direct insurance premiums have been written thereunder.

11. The Registrant registered the disputed domain name on February 1, 2001. The disputed domain name does not resolve to an active website.

POSITION OF THE COMPLAINANT

12. The Complainant submits as follows:

(a) **CONFUSINGLY SIMILAR.**

The disputed domain Name is confusingly similar to the Complainant's registered trade-mark GREY POWER.

That is so because the domain name so nearly resembles the trade-mark in appearance, sound and the ideas suggested by the trade-mark as to be likely to be mistaken for the trade-mark.

(B) NO LEGITIMATE INTEREST IN THE DOMAIN NAME

13. The Registrant has no legitimate interest in the disputed domain name as described in paragraph 3.4 of the Policy. That is so because:

(a) The Registrant has not used the domain name as a mark used by the Registrant in good faith with the Registrant having rights in the mark within the meaning of subparagraph 3.4 (a) of the Policy.

(b) There is no evidence that the Registrant registered the domain name in association with any particular wares, services or business and it is therefore not possible to consider whether the term GREY POWER is clearly descriptive of, or a generic name for, any wares, services or business under subparagraphs 3.4(b) and (c) of the Policy.

(c) There is no evidence that the domain name is being used for non-commercial activity, or at all, within the meaning of subparagraph 3.4(d). The evidence is that the domain name is not being used at all.

(d) There is no evidence that the domain name is a legal name of the Registrant or the name or surname or other reference by which the Registrant was or is commonly identified within the meaning of subparagraph 3.4 (e).

(e) Subparagraph 3.4 (f) of the Policy does not apply because the term GREY POWER is not a geographical location.

(c) **REGISTRATION IN BAD FAITH**

14. The Registrant has registered the disputed domain name in bad faith.

(a) The Complainant's case in this regard relies on subparagraph 3.5 (b) of the Policy, although it is submitted that other circumstances may also apply.

(b) Within the meaning of subparagraph 3.5 (b) of the Policy, there has been a pattern of domain name registrations by the Registrant to prevent registration by persons with rights in marks.

(c) The evidence shows that the Registrant Jack Fagan is the registrant of 45 dot-ca domain names, including <greypower.ca>. The Registrant Auto-Intelligent Management Systems Inc. is the registrant of 2 dot-ca domain names. At least 14 of the domain names owned by Jack Fagan and Auto-Intelligent Management Systems Inc. are identical to, or confusingly similar to, trade-marks in use prior to the registration date of the disputed domain name. The evidence suggests that the Registrant must have been aware of the Complainant's mark GREY POWER used in association with insurance services at the time it registered the disputed domain name. The evidence shows that the Registrant has engaged in a pattern of registering domain names in order to prevent persons with rights in the trade-marks from registering the trade-marks as domain names.

(d) Accordingly, the Registrant registered the disputed domain name in bad faith within the meaning of subparagraph 3.5(b) of the Policy.

CONCLUSION

15. The Complainant submits that the constituent elements of the Policy have therefore been made out and the Panel should order that the disputed domain name be transferred to the Complainant.

DISCUSSION

(A) CONFUSINGLY SIMILAR

16. Under paragraph 4.1 of the Policy the Complainant must prove on the balance of probabilities 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; and

(b) the Registrant has registered the domain name in bad faith as described in paragraph 3.5;

and the Complainant must provide some evidence that:

(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in paragraph 3.4.”

17. The Registrant has filed no response to the Complaint and, accordingly, the Registrant has provided no evidence of legitimate use. The Complainant has verified all of the above matters that it relies on by affidavit evidence and the Panel accepts that evidence.

18. The panel finds that the disputed domain name is confusingly similar to the Complainant's GREY POWER mark, being, within the meaning of paragraph 4.1 of the Policy, "a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights". That is so for the following reasons.

29. The Complainant has adduced evidence, which the panel accepts, that the Complainant is the owner of the GREY POWER trademark and accordingly, the Panel finds that the Complainant has rights in the GREY POWER trade-mark and continues to have such rights.

20. The test of whether a domain name is confusingly similar with a mark or trade name, pursuant to paragraph 3.3 of the Policy is if it so nearly resembles same in appearance, sound or in the ideas suggested so as to be likely to be mistaken for the mark.

21. In undertaking that exercise, Paragraph 1.2 of the Policy provides that a domain name is defined so as to exclude the "dot-ca" suffix; see: *Coca-Cola Ltd. v. Amos B. Hennan*, BCICAC Case No. 00014.

22. The Panel has undertaken the comparison between the disputed domain name and the GREY POWER trade mark and finds that the domain name so nearly resembles the trademark in appearance, sound and the ideas suggested as to be likely to be mistaken for the mark. The GREY POWER name is clearly well established and so prestigious that the objective bystander would naturally assume that the "greypower" of the domain name was invoking the GREY POWER of the trademark and that it was an official GREY POWER domain name leading to an official GREY POWER website.

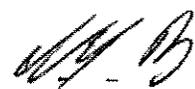
23. Moreover, if the trade-mark is included in the disputed domain name, a Registrant cannot avoid a finding of confusion by appropriating another's entire mark in a domain name: *RGIS Inventory Specialists v. AccuTrak Inventory*, BCICAC Case No. 00053; *Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)*, BCICAC Case No. 00020. Applying that principle to the present case, the disputed domain name incorporates the whole of the registered GREY POWER trade-mark. Accordingly, the Panel finds that the Registrant cannot avoid a finding of confusion as it has misappropriated the entirety of the GREY POWER trade-mark.

24. Accordingly, the Panel finds that the disputed domain name is confusingly similar with the GREY POWER trade-mark in which the Complainant had rights prior to its registration date and continues to have such rights.

(B) NO LEGITIMATE INTEREST IN THE DOMAIN NAME

25. 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.

26. The Panel finds that the Complainant has provided such evidence. The Complainant's case in this regard is as follows: the Registrant has no legitimate interest in the disputed domain name as described in paragraph 3.4 of the Policy because:



- (a) The Registrant has not used the domain name as a mark in good faith with the Registrant having rights in the mark within the meaning of subparagraph 3.4 (a).
- (b) There is no evidence that the Registrant registered the domain name in association with any particular wares, services or business and it is therefore not possible to consider whether the term GREY POWER is clearly descriptive of, or a generic name for, any wares, services or business under subparagraphs 3.4(b) and (c) of the Policy.
- (c) There is no evidence that the domain name is being used for non-commercial activity, or at all, within the meaning of subparagraph 3.4(d). The evidence is that the domain name is not being used at all.
- (d) There is no evidence that the domain name is a legal name of the Registrant or the name or surname or other reference by which the Registrant was or is commonly identified within the meaning of subparagraph 3.4 (e).
- (e) Sub-paragraph 3.4 (f) of the Policy does not apply because the term GREY POWER is not a geographical location.

27. The Panel accepts the submission of the Complainant and the evidence adduced in its support and concludes that these matters constitute evidence that the Registrant has no legitimate interest in the disputed domain name.

28. Moreover, the Registrant has not filed a response to the Complaint or sought to rebut the above evidence and has thus provided no evidence of legitimate use. In addition, in view of the facts set out above, it is inherently unlikely that the Registrant has or could establish a legitimate interest in the domain name.

(C) REGISTRATION OF GREYPOWER.CA IN BAD FAITH

29. The Panel now turns to consider whether the disputed domain name was registered in bad faith. The Panel finds that, on the ground relied on by the Complainant and generally, the Registrant registered the disputed domain name in bad faith.

1. THE GROUND RELIED ON BY THE COMPLAINANT THAT THERE HAS BEEN A PATTERN OF DOMAIN NAME REGISTRATIONS BY THE REGISTRANT TO PREVENT REGISTRATION BY PERSONS WITH RIGHTS IN MARKS WITHING THE MEANING OF PARAGRAPH 3.5 (B) OF THE POLICY.

30. The Complainant's argument is set out above. In support of its submission the Complainant adduced evidence that it filed a Request for Domain Name Information with CIRA for domain names registered to John Fagan, Jack Fagan or Auto-Intelligent Management Systems Inc. It has exhibited to the Complainant the results of that request which show that the current Registrant Jack Fagan is the registrant of 45 dot-ca domain



names including <greypower.ca>. Auto-Intelligent Management Systems Inc was shown to be the registrant of 2 dot-ca domain names. At least 14 of the domain names owned by Jack Fagan and Auto-Intelligent Systems are identical to, or confusingly similar to, trademarks in use prior to the registration date of the domain name.

31. The Panel accepts the evidence adduced by the Complainant and also the conclusion which the Complainant invites the Panel to reach, namely that because of the Registrant's business interest he would be likely to be exposed to home insurance policies and aware when he registered the disputed domain name of the Complainant's GREYPOWER trademark used in association with insurance services.

32. The Complainant has verified all of the above matters by affidavit evidence and the Panel accepts that evidence. The Registrant has filed no response to the Complaint and, accordingly, the Registrant has provided no evidence on the issue of bad faith.

33. The only conclusion that can be reached on this evidence is that the Registrant has engaged in a pattern of registering domain names in order to prevent persons with rights in the trademarks from registering the trademarks as domain names.

2. GENERAL

34. The Panel has also had regard to all of the circumstances revealed by the case presented by the Complainant and finds that quite apart from and in addition to the liability of the Registrant pursuant to paragraph 3.5 (b) of the Policy the Registrant registered the disputed domain name in bad faith within the generally accepted meaning of that expression.

35. In particular the accumulated facts are that : (a) the Complainant's trademark is well known; (b) millions of dollars worth of insurance has been written under it over many years; (c) the Registrant has taken the Complainant's trademark to use as a domain name without the approval or consent of the Complainant; (d) this calls for an explanation unless an adverse inference is to be drawn from it; (e) the Registrant has not put in a Response or sought to explain itself by some other means; and (f) the Registrant has accumulated a stock of domain names that raise the suspicion that it is a serial offender in this regard.

36. Those being the facts, the Panel finds that the Registrant registered the disputed domain name in bad faith within the generally accepted meaning of that expression.

DECISION

37. The Panel finds that the Complainant has satisfied the requirements of Paragraph 4.1 of the Policy and that it is entitled to the remedy it seeks.

ORDER

The Panel directs that the registration of the Domain Name <greypower.ca> be transferred from the Registrant to the Complainant.



Date: February 11, 2013

A handwritten signature in black ink, appearing to read 'N. A. Brown', written in a cursive style.

The Honourable Neil Anthony Brown QC