

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

<b>Dispute Number:</b>	<b>DCA-1573-CIRA</b>
<b>Complainant:</b>	<b>DocuSign, Inc.</b>
<b>Registrant:</b>	<b>E-Signature Inc.</b>
<b>Disputed Domain Names:</b>	<b>docusign.ca</b>
<b>Registrar:</b>	<b>Domainsatcost.ca</b>
<b>Arbitrator:</b>	<b>Mr. Claude Freeman</b>
<b>Service Provider</b>	<b>British Columbia International Commercial Arbitration Centre (the “BCICAC”)</b>

**BCICAC FILE NUMBER:**           **DCA-1573-CIRA**

On February 11<sup>th</sup>, 2014, the Complainant filed a complaint against the Registrant, with the BCICAC, seeking that the Registrant’s registration of <docusign.ca> be transferred to the Complainant.

The complaint by the Complainant was received by the BCICAC on February 24<sup>th</sup>, 2014, and on February 25<sup>th</sup>, 2014, was found to be in administrative compliance with the Policy and Rules. In accordance with the provisions of Rule 4.3, and by letter and email dated February 25<sup>th</sup>, 2014, the BCICAC, as dispute resolution service provider, so advised the parties and forwarded a copy of the complaint to the Registrant for their response. The Registrant has provided no response whatsoever to the BCICAC.

Accordingly, in the absence of a response by the Registrant, the Registrant is not in administrative compliance in the following areas:

- 1) failure to nominate candidates from the providers cost – per paragraph 5.2(c) of CDRP rules;
- 2) failure to provide a summary of and references to the relevant Canadian Law – per paragraph 5.2(f) of CDRP rules;
- 3) failure to provide a summary of and references to prior CIRA decisions that would be persuasive, and which apply to domain names registered under any other top-level domain – per paragraph 5.2(g) of CDRP rules; and
- 4) failure to conclude with the certification of the Registrant in form set out in Appendix “B”, followed by the signature of the Registrant or its authorized representative – per paragraph 5.2 (j) of CDRP rules.

As provided for by paragraph 5.6 of CDRP rules, the Registrant is permitted 10 days notice in order to remedy all instances of non-compliance.

As permitted under Rule 6.5, the Complainant elected to convert from a panel of three arbitrators to a single arbitrator, to render a decision in this matter. On March 26<sup>th</sup>, 2014, the BCICAC provided the appointment of the herein, sole arbitrator, who accepted same on March 28<sup>th</sup>, 2014.

## Background/Facts

The Complainant is a San-Francisco based company which was founded in 2003. It provides cloud-based electronic signature technology for facilitating exchanges of contracts, documents and legal materials. DocuSign's main features include authentication services, user identity management and workflow automation. The company was founded by Tom Gonser after leaving NetUpdate, a company he founded in 1998. This is pertinent, since NetUpdate also acquired several companies involved in early-stage e-signature start-up including a company called DocuTouch. DocuTouch held patents on Web-based digital signatures and collaboration. Although at that time, DocuTouch had no material revenues, the world of electronic signature technology and authentication, was being explored and owned by these "father" companies – and by way of their patents, made them the pioneers of this industry.

Upon leaving NetUpdate, Gonser negotiated the purchase of certain DocuTouch assets and started DocuSign, using the DocuTouch technology and code base to build the first versions of DocuSign. The company's first URL was "docusign-inc.com". By early 2004, the company had developed a browser-based electronic signature processing system, and was the first with SaaS-based electronic signature services not requiring the use of complex digital certificates. In 2004 DocuSign raised sufficient venture capital to actively launch its' marketing and operating initiatives. In 2005, Complainant's sales began in earnest with the use of their system by zipForms (now zipLogix) into its virtual real estate forms. Between the years of 2006 to 2009, the Complainant raised additional rounds of investment/venture capital allowing it to fund its' growth potential. By mid 2010, the company was contracted to provide support for iPhone, iPad and phone-based user authentication, and by the end of 2010, the company reports having processed 73 percent of the SaaS-based electronic signature market with 80 million signatures processed. Continued growth and expansion allowed for the opening of an office in the U.K., and attracting further interest on the part of investors/venture-capitalists. It also penned service agreements with PayPal, Salesforce, National Association of Realtors, and Google Drive. Fast-forwarding to 2013, the Complainant partnered with Equifax for the transfer of Tax Return Transcripts to the U.S. Internal Revenue Service. Other notable statistics as reported by the company are that by mid 2012, 90% of Fortune 500 companies (many of these in Canada or affiliated with Canadian companies) had signed up with DocuSign, reaching 25 million users, and completing 150 million signatures in 188 countries. The products work with major internet browsers such as Google Chrome, Mozilla, Firefox, Internet Explorer, and Apple Safari, and in 2011 released a mobile application. A web page copy submitted by the Complainant displays such notable users as: Air Canada, Costco, Bayer, AON, and Monsanto to name a few. Since the Complainant appears to be privately held as opposed to "market listed", we do not have any financial details, financial statements or reports to review and to refer to in support of its' financial stature. However, the business volumes reported above, the large range of vertical markets served (such as food & beverage, banking, transportation, travel & leisure, legal, and telecommunications) along with their association with so-called "blue-chip" corporations support the scope of the Complainant's market history, presence and notoriety.

In September, 2013, in an effort to acquire the disputed domain ("docusign.ca") through their agent MarkMonitor using Whois records, Complainant was made aware that an entity by the name of J2 Global Communications Inc. was the owner of the domain. In October 2013, an agreement was reached to sell and transfer the domain to DocuSign. Upon attempting to

complete the transfer of the domain, Registrant contacted the DocuSign and asserted ownership of the domain without any explanation of its relationship to J2 Global Communications Inc. In or around November 2013, Registrant updated the “docusign.ca” domain and ownership information to reflect the registrant name as “E-Signature Inc.,” with “Arnim Vogel” as administrative contact.

Upon discovery of the new asserted Registrant, the Complainant, through their agent MarkMonitor, attempted to negotiate with the Registrant for the sale and transfer for the disputed domain. It is submitted that all negotiation attempts with the new Registrant failed. Shortly after the negotiations failed, it is reported that the “docusign.ca” domain internet traffic was redirected to the website homepage of E-Signature Inc., where the Registrant offers competing e-signature services.

The Complainant submits that the Registrant has no license or other form of authorization to use the DOCUSIGN trade-mark, including as part of the docusign.ca domain.

The Complainant submits being the owner of the Domain name in dispute (the “domain name”) by way of its’ trade-mark DOCUSIGN registration filing of 2005, and revealing such usage as early as March 1, 2004. It has also submitted tables of trade-marks for the U.S.A., European Union, Japan, Mexico, Argentina, Brazil, and Chile.

Although the Registrant displays a notation of: “Copyright 1995-2014 E-Signature.ca All Rights Reserved” at the bottom of its website home page, there is absolutely no information provided by them in support of their trade-marks, copy-rights, etc. Accordingly, there is no way of validating any of their rights, licenses or ownership in any intellectual property or “branding rights” – if any.

The Complainant submits that the Registrant received the registered the domain name immediately following failed, good-faith negotiations, and that the Registrant also is a direct competitor of the Complainant. One might be perplexed by the timing of the transfer of the disputed domain name to E-Signature Inc. as a means or purpose to redirecting the business of the Complainant, by way of attracting Internet users to the Registrant’s website – thereby creating a likelihood of confusion with the Complainant as to source of sponsorship.

DocuSign’s rights in the DosuSign trade-mark prior to the Registrant’s Registration precede and are protectable prior to the Registrant’s Registration (of approximately November, 2013), in light of the fact that DocuSign began using the DocuSign trade-marks and trade name in Canada as early as early as March 2004, for the purpose of distinguishing its wares, services and business, *See Citrix Online LLC v. Mediativison Network Inc.*, CIRA Case No.00175 (2011). As well, the word “Mark” and “Rights” are defined under CIRA POLICIES RULES AND PROCEDURES (Version (1.3) in Paragraph 3, and read together, Paragraphs 3.2 and 3.3 fully support the foregoing.

Accordingly, and based on their submissions, the Complainant submits that the registration and use of the domain name falls squarely within the scope of the Policy, and that paragraph 3.1 of the Policy, provides the Jurisdiction requiring the Registrant to submit to a proceeding, covering the tests that the domain name is: a) confusingly similar, b) that the Complainant has a legitimate interest, and c) that the domain name was registered in bad faith.

The submission by the Complainant that the Registrant is a direct competitor is supported by the fact that the Registrant’s website e-signature.ca markets the very similar wares/services as does the Complainant. Clearly, both the Complainant and Registrant are involved in the same or

similar product line offerings and are direct competitors with each other. The Complainant has submitted a copy of their prior trade-mark registration "DocuSign" confirming the filing of this in April, 2005 and noting the first use "at least as early as March 01, 2004 on services". One can also draw a rational conclusion (or at the very least, a comfortable assumption), that a certain amount or percentage of the Complainant's sales income has been devoted to advertising, promotional and other business development enhancements of their corporate image, and that these financial resources have been carefully measured so as to maximize their return on investment for their advertising and public relations activities (including, but not limited to their website image).

Sites/domain names blatantly infringing on or closely navigating near or to, previously and properly registered, highly visible and well-known domain names, trade-marks (which are clearly owned by those with a demonstrated, and prior, legitimate interest) do nothing to enhance the credibility (for the tests of legitimate interest/confusingly similar/bad faith) of those Registrants who feel they have some free right or licence to infringe.

The Complainant submits that the use of ("docusign.ca") is, and can only be attributed to the Complainant, by virtue of its trade name, trade-mark, and other history attesting to its use, related strictly to its corporate name and wares and services. Further, anything to the contrary defies the rational, reasoning and legal basis for filing for trade-marks and trade names in the first place. Anything else would, and will be confusing and distracting – with the results being that internet users, and existing/potential customers, will be confused, and this will have a damaging effect to the public image of "DocuSign".

In short, the Complainant submits that the disputed domain name is:

- 1) Confusingly similar
- 2) Registrant has no right or legitimate interest in the domain name, and
- 3) The domain name was registered and used in bad faith.

### **Reasons**

As noted earlier, the Registrant was not only found administratively non-compliant, but has not put forth any submissions to be reviewed in any detail. Accordingly, as per paragraph 4.1 of the CDRP policy, the onus is on the Complainant to prove on a balance of probabilities that the disputed domain names as registered by the Registrant are confusingly similar to that of the Complainant, and that they have been registered in bad faith. In addition, the Complainant is required under this paragraph to provide "some evidence" that the Registrant has no legitimate interest in the disputed domain name(s).

#### **1. Confusingly Similar**

The first test is whether the Disputed Domain Names are confusingly similar to Complainant's domain name.

The evidence before us shows that in Canada, the Complainant has been using the DocuSign name in Canada since as early as 2004, and by way of Registration filing of 2004.

In order to address the issue of confusion with the standard legal test prevailing in Canada, one can find that in determining whether or not there exists a reasonable likelihood of confusion between the trademarks at issue, the Registrant must have a regard to all the surrounding circumstances, including non-exhaustingly, those specifically enumerated in Subsection 6 (5) of the Canadian Trademarks Act.

- a) inherent distinctiveness of the trademarks, and the extent to which they have become known;
- b) length of time the trademarks have been in use;
- c) nature of wares, services or business;
- d) nature of the trade; and
- e) degree of resemblance between the trademarks in appearance or sound in the ideas suggested by them.

A generally accepted principle when applying the test of confusion is looking at the trademarks from the point of the unwary consumer – comparing similarities as opposed to differences. Can the consumer be easily misled by error or otherwise – and perhaps not even know? Could this also impact not only on the consumer, but also on other potential commercial relationships being sought with the Complainant? If this would impact on the commercial relationship sought with the Complainant by the consumers, then by logical corollary, this would also impact (or sabotage?) the commercial relationships the Complainant is seeking with its' potential client base.

The Registrant's dot.ca domain is Confusingly Similar with a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights. Simply put, this assertion was held in *Veuve Clicquot Ponsardin v. Boutiques Clicquot Ltée*. 2006 SCC 23, [2006] 1 SCR 824 (2June 2006). Confusion under the *Trade-marks Act* occurs if the use over the trade-marks is likely to lead to the inference that the wares and services associated with the trade-marks are manufactured, sold or performed by the same person. See *LEGO Juris A/S v. James Carswell*, CIRA CASE No. 00150 (2010). The fact that the Registrant is competing for web traffic with DocuSign makes the Registrant a competitor of DocuSign. As well, as per paragraph 1.2 of the Policy, and per BCICAC Case No. 00014 (*Coca-Cola Ltd. v. Amos B. Hennan*), the domain name is defined as follows: "domain name" means the domain name excluding the "dot-ca" suffix and suffixes associated with all third and fourth level domain names accepted by CIRA. Further, a Registrant cannot avoid confusion by appropriating another's entire mark in a domain name per *RGIS Inventory Specialists v. AccuTrak Inventory*, BCICAC Case No. 00053, and *Glaxo Group Limited v. Defining Presence Marketing Group Inc.* (Manitoba), BCICAC Case No. 00020.

To this arbitrator, the domain name "DocuSign.ca" is a part of, (and similar in appearance, sound and in the ideas) with the "DocuSign" Trade-mark. There appears therefore, not only confusion with, but also misappropriation of the domain name if hijacked elsewhere – especially in the hands of a competitor.

This Arbitrator concludes on this issue that the Complainant has met the onus of demonstrating that the disputed domain name is "confusingly similar" – as also supported in part by the "tests" applied by Subsection 6 (5) of the Canadian Trademarks Act ("a" to "e" above).

## 2. Legitimate Interest

A sufficient and initial proof brought on by the Complainant and pertaining to the Registrant's lack of legitimate interest forces the Registrant to rebut, explain or otherwise plead this issue, for which the Registrant has not done so. Failing to do so permits the Arbitrator to make a negative inference.

As described above, the Complainant must provide "some evidence" that the Registrant has no legitimate interest in the domain name(s), as described in Policy paragraph 4.1(c). If the Complainant satisfies this evidentiary burden, the onus shifts to the Registrant to prove on a balance of probabilities that the Registrant has a legitimate interest in the challenged domain name, for which again the Registrant has not done so.

Policy paragraph 3.4 sets forth an exhaustive list of criteria for determining whether a registrant has a legitimate interest in a domain name. It provides as follows:

*The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a complaint was submitted.*

- (a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant has Rights in the Mark;*
- (b) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of: (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;*
- (c) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;*
- (d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review of news reporting;*
- (e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or*
- (f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.*

*In paragraphs 3.4 (b), (c), and (d) "use" by the Registrant includes, but is not limited to, use to identify a web site.*

The legitimate interest criteria set forth in Policy paragraphs 3.4 (a), (b), (c), and (d) are satisfied only if the Registrant's use was in "good faith", a term which is not defined by the Policy. This Arbitrator notes that "good faith" as used in Policy paragraph 3.4 is not necessarily the opposite of "Bad Faith" as defined in Policy paragraph 3.5.

This Arbitrator has reviewed submissions by the Complainant and absent any submissions to not only debate the Complainant's positions, but to provide any historical proof of commercial activities, and fully eliminate confusion between the Registrant and the Complainant, leaves for invalidated support for the Registrant. Furthermore, the history covered by the Complainant's submissions themselves (registration, sales volumes et al), speaks volumes about the Complainant's right to a legitimate interest.

The Complainant filed for the trade-mark "DocuSign" in Canada in April, 2005, and this matured into a full Registration in May, 2008, however the domain name in dispute was not registered by the Registrant until November, 2013, as we know, and such, without any prior or existing written contract, or other form of trade-mark use or licence with the Complainant. There has never been any commercial or relationship of any sort between the parties, permitting the use etc. of any of the Complainant's trade-marks or domain name by the Registrant, which could give rise to any confusion. It is quite important to note that the disputed domain name appears to have been inactive for a lengthy period of time and its activity has only surfaced at the time of the failed negotiations. Absent any rebuttal, this unto itself demonstrates a clear, historical lack of interest in the disputed domain name by the Registrant..

The Registrant has not provided any justification whatsoever to justify its claim to a legitimate interest in the disputed domain name.

### **3. Registration in Bad Faith**

The following facts lead this Arbitrator to conclude that the disputed domain names were registered in bad faith:

- 1) The Registrant has, (after considerable historical and past name and product branding by the Complainant) registered (or acquired) a confusingly similar name, and this, in quick succession after some failed, good-faith negotiations attempted by the Complainant.
- 2) The registration of the disputed domain name competes directly with the Complainant's trade-mark, and wares/services, and appears to redirect traffic away from the Complainant to the Registrant. The disputed domain name is also embedded as a component of the Complainant's trade-mark.
- 3) The disputed name could have a confusingly and negative public image impact/confusion about affiliation or sponsorship with the complainant, not to mention the diversion of commercial activity away from the Complainant. Refer to Bell Canada v. Archer Enterprises, BCICAC Case No. 00038, and Yamaha Corporation and Yamaha Motor Canada Inc. v. Jim Yoon, BCICAC Case No. 00089.
- 4) No attempt whatsoever has been made by the Registrant to provide any answers, rebuttals, support or evidence for the registration/acquisition of the disputed domain name.
- 5) Where the Registrant would seemingly have some justification for the registrations, the Registrant has to put forward some form of evidence to support his conduct, but has not done so. See Musician's Friend Inc. v. Lowcost Domains Inc., CIRA Dispute No. 00074, citing in turn Canadian Broadcasting Corporation/Société Radio-Canada.

All of the foregoing is irreconcilable, and sustains the conclusion that there appears to be no compelling need (or right) for the Registrant to register and keep the disputed domain name. Had there been a sound business and legal reason to do so, it would be logical for the Registrant to counter-argue all of this. This does not suggest that any counter-argument would be successful. Websites (not to mention trade-names) are to be seemingly purchased/registered and designed for some legitimate purpose, and certainly no sound reasons have been advanced by the Registrant to support their recent acquisition of the domain name. At the very least, any use made valid by any arguments that might be raised by the Registrant would have been less confusing at the outset, if they were to register a name which would be more original with their own corporate name, so as to not create any confusion, and infringe on the Complainant's Trade-mark. Very importantly, the redirection of traffic from one web site (docusign.ca) to another (e-signature.ca) can only create a clear impression of causing confusion, disruption and hijacking of the Complainant's business. See Intesa Sanpaolo S.p.A. v. Interex Corporate Registration Services Inc., CIRA Case No. 01130 (2013).

### **Balance of Probabilities**

Even if a complainant has met the burdens of proof contained in Paragraph 4.1, a complaint will be dismissed if the registrant is able to prove on a balance of probabilities that the registrant has a legitimate interest in the disputed domain name. Again, such "legitimate interest" must meet one or more of the six tests set out in Paragraph 3.4 and referred to above.

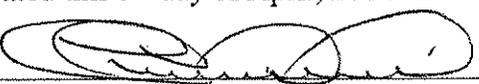
This balance of probabilities test in Paragraph 4.1 of the Policy deals with the situation where even though a complainant has satisfied all of the burdens of proof contained in Paragraph 4.1, an Arbitrator believes that justice requires the Registrant to succeed. In finding against a Registrant, the Arbitrator is depriving that Registrant of a property interest. Such a decision should not be taken lightly. Therefore, even if an Arbitrator finds that a complainant has satisfied the rather heavy burdens of proof placed on it by Paragraph 4.1, if the Arbitrator is satisfied that on a balance of probabilities the registrant has a legitimate interest in the disputed domain name, the Arbitrator must find for the registrant and dismiss the complaint. The Registrant has manifestly provided no argument, solid, or otherwise, to either refute the allegations made by the Complainant or at the very least, support the registration (and any rights) in the disputed domain name.

In the case at hand, this Arbitrator is satisfied that on a balance of probabilities, based upon the evidence before him, that the Registrant has no legitimate interest in the Disputed Domain name ("docusign.ca")

### **Decision and Order**

I find that the Complainant has succeeded in this proceeding, initiated under the Policy. I therefore direct that the registration of ("docusign.ca") be transferred to the Complainant: DocuSign, Inc.

Dated this 5<sup>th</sup> day of April, 2014

  
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Claude Freeman, LL.M. (ADR), C. Med., C. Arb.