

# CANADIAN INTERNET REGISTRATION AUTHORITY

## DOMAIN NAME DISPUTE RESOLUTION POLICY

### COMPLAINT

Dispute Number: DCA - 1911 - CIRA  
Domain Names: tdcanadatrusts.ca  
Complainant: The Toronto-Dominion Bank  
Registrant: MARC-Andre Lefebvre  
Arbitrator: Melvyn J. Simburg  
Service Provider: British Columbia International Commercial Arbitration  
Centre

### DECISION

#### The Parties

1. Complainant is The Toronto-Dominion Bank, 66 Wellington Street West, Toronto Dominion Tower, 12<sup>th</sup> floor, Toronto, 0N M5K 1A2, Canada (Complainant).
2. The Registrant is MARC-Andre Lefebvre, Rue Sherbrooke 0, Montreal, QC H4B 1N2, Canada (the Registrant).

#### The Disputed Domain Name and Registrar

3. The Domain Name at issue is tdcanadatrusts.ca (the Disputed Domain Name).
4. The Registrar of record for the Disputed Domain Name is Domain Robot Enterprises, Inc., <info@domainrobot.ca>.
5. The Disputed Domain Name was registered on August 10, 2017.

#### Procedural History

6. The British Columbia International Commercial Arbitration Centre, (BCICAC) is a recognized service provider to the Domain Name Dispute Resolution Policy, (the Policy) and the Rules, (the Rules) of the Canadian Internet Registration Authority, (CIRA).
7. Complainant filed a complaint on September 20, 2017, (the Complaint) with the BCICAC seeking an order in accordance with the Policy and the Rules that the Disputed Domain Name be transferred to Complainant.

8. BCICAC confirmed the Complaint to be in administrative compliance with the Rules and forwarded copy of the Complaint to the Registrant in accordance with the Rules.

9. The Registrant did not provide a response within the timeframe required by the Rules, namely October 10, 2017.

10. Complainant elected to convert to a single arbitrator as permitted by Rule 6.5 and the BCICAC named Melvyn J. Simburg to act as the Arbitrator to determine the matter.

11. On October 13, 2017, the undersigned signed an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.

12. As there was no Response to the Complaint, the Arbitrator shall, in accordance with Rule 5.8, decide the Proceeding on the basis of the Complaint and the fact set out below are taken from the Complaint and related documents.

### **Canadian Presence Requirements**

13. In order for Complainant to be permitted to apply for registration of, and to hold and maintain the registration of a dot- ca domain name, the Canadian Presence Requirements for Registrants, (the Presence Requirements) require that the applicant meet at least one of the criteria listed as establishing a Canadian presence.

14. Complainant is the owner of Canadian trademark registrations for TD, TD BANK, TD & design, and CANADA TRUST, registered in the Canadian Intellectual Property Office (CIPO), has an office in and does business in Canada.

15. The Complaint relates to a Disputed Domain Name, which includes the whole of the exact word components of Complainant's Marks registered in CIPO, pluralized, and which Complainant asserts is identical to or confusingly similar to the Marks owned by Complainant.

16. Accordingly, Complainant is an Eligible Complainant under paragraph 1.4 of the Policy and the Presence Requirements are satisfied.

## **The Position of the Parties**

### **The Position of Complainant**

17. Complainant is the second largest bank in Canada by market capitalization and deposits and is the sixth largest bank in North America. It is commonly known as TD and operates as TD Bank Group, which was created in 1955 through merger of the Bank of Toronto and The Dominion Bank, which were founded respectively in 1855 and 1869.

18. Complainant has over 85,000 employees and 22 million clients worldwide. In Canada, the retail bank serves more than 12 million customers at over 1100 branches.

19. Complainant operates numerous websites, chief among them [www.td.com](http://www.td.com) and [www.tdcanadatrust.com](http://www.tdcanadatrust.com). The latter website has attracted over 9.6 million visitors in July 2017 alone.

20. Complainant has been ranked as high as number 46 on a list of the Top 100 most valuable global brands and as number 6 on a list of the Top 10 Regional Banks in the world. In 2012, TD ranked number 17 on a survey of Canadians to rate the 100 leading global brands on a wide variety of attributes. Interbrand's Best Canadian Brands ranked TD as the number one overall Canadian brand in 2012 and 2014 according to value.

21. In order to maintain the value and distinctiveness of its brand, Complainant devotes significant resources to protect its valuable reputation offline and online and its trademark rights and goodwill by making significant investments over the years to advertise, promote and protect Complainant's Marks through various forms of media, including the Internet.

22. In summary, Complainant's brand is well-recognized by Canadian consumers and has a valuable and effective reputation among Complainant's industry peers and its intended market.

23. Complainant submits that the Disputed Domain Name registered on August 10, 2017, is confusingly similar to Complainant's Marks in which Complainant had rights prior to the registration of the Disputed Domain Name and continues to have such rights, and further that the Registrant has no legitimate interest in the Disputed Domain Name and that the Disputed Domain Name was registered in bad faith in accordance with paragraph 3.5 of the Policy.

24. Accordingly, Complainant requests that the Disputed Domain Name be transferred to Complainant.

## The Position of the Registrant

25. The Registrant did not file a Response.

### Analysis and Findings

26. The purpose of the Policy as stated in paragraph 1.1 is to provide a forum by which cases of bad faith registration of dot-ca domain names can be dealt with relatively inexpensively and quickly. The Policy does not apply to other types of differences between owners of trade-marks and Registrants of Domain names.

### *Relevant provisions of the Policy are provided below*

27. Paragraph 4.1 of the Policy provides:

**4.1 Onus.** To succeed in a Proceeding, Complainant must prove, on a balance of probabilities, that:

(a) the Registrant's dot-ca domain name is Confusingly Similar to a Mark in which 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 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 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.

28. Paragraph 3.2 of the Policy provides in part:

**3.2 Mark. A "Mark" is**

(a) a trade-mark, including the word elements of a design mark, or a tradename that has been used in Canada by a person, or the person's predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person;

(b) a certification mark, including the word elements of a design mark that has been used in Canada by a person or that person's predecessor in title, for the purpose of distinguishing the wares or services that are of a defined standard;

(c) a trade-mark, including the word elements of a design mark, that is registered in CIPO; or

(d) the alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of which the Registrar of Trade-

marks has given public notice of adoption and use pursuant to paragraph 9(1)(n) of the *Trade-marks Act* (Canada).

29. Paragraph 3.3 provides:

**3.3 Confusingly Similar:** In determining whether a domain name is “Confusingly Similar” to a Mark, the Arbitrator shall only consider whether the domain name 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.

30. Paragraph 3.4 provides:

**3.4 Legitimate Interest:** For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all the evidence presented, shall demonstrate that the Registrant has a legitimate interest in the domain name:

(a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;

(b) the Registrant registered the domain name in Canada in good faith in association with 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 registered 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 or 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 paragraph 3.4(d) “use” by the Registrant includes, but is not limited to, use to identify a website.

31. Paragraph 3.5 provides:

**3.5 Registration in Bad Faith.** For the purposes of paragraph 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence that a Registrant has registered a domain name in bad faith:

(a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or

otherwise transferring the Registration to Complainant, or Complainant's licensor or licensee of the Mark, or to a competitor of Complainant, or the licensor or licensee for valuable consideration in excess of the Registrant's actual costs in registering the domain name or acquiring the Registration;

(b) the Registrant registered the domain name or acquired the Registration in order to prevent Complainant, or Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone 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;

(c) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of Complainant, or Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant; or

(d) the Registrant has intentionally attempted to attract, for commercial gain, internet users to the Registrant's website or other location, by creating a likelihood of confusion with 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.

32. In summary, to succeed in a proceeding, Complainant must prove on a balance of probabilities that:

1. The dot-ca domain name is confusingly similar to a Mark in which Complainant had Rights prior to the registration of the Disputed Domain Name and continues to have such Rights;
2. The Registrant has registered the Disputed Domain Name in bad faith; and
3. Complainant must provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Name.
4. Notwithstanding the evidence presented that the Registrant has no legitimate interest in the Disputed Domain Name, the Registrant will succeed if the Registrant proves on a balance of probabilities that he has a legitimate interest in the Disputed Domain Name.

### ***Confusingly Similar to a Mark***

33. Evidence shows that Complainant is the owner of Complainant's Marks, and Complainant's Marks were registered in CIPO as Nos TMA644911, TMA396087, TMA549396, TMA409300 and TMA447666, well before the Disputed Domain Name.

34. In accordance with paragraph 3.3 of the Policy, a domain name is confusingly similar to a Mark if the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely mistaken for the Mark. In

assessing the domain name, the dot-ca suffix is ignored. It is the narrow resemblance that is applied.

35. The Disputed Domain Name incorporates by combination the entire words of Complainant's Marks. The only difference between the Disputed Domain Name and Complainant's Mark is the "s" added to pluralize the combined marks.

Complainant submits that prior arbitrators deciding under the Policy have held that where a domain name merely combines several of a complainant's trademarks does not differentiate that domain name from those Marks. Complainant cites previous decisions to support its position.

36. The Disputed Domain Name identically reproduces Complainant's Marks as used by Complainant in its website, adding only the letter "s" at the end.

Complainant submits that prior arbitrators deciding under the Policy have held that where a domain name merely adds the letter "s" to a complainant's mark does not change the overall impression of confusing similarity. Complainant cites a previous decision to support its position.

37. Complainant points out that in the case of *Great Pacific Industries v. Ghalib Dhala*, 00009 (CIRA Apr. 21, 2003), the Panel stated that the test of confusing similarity is whether the average Internet user, with an imperfect recollection of the Mark who wishes to access a website operated by Complainant, either by entering a domain name including the Mark into the address bar of an Internet browser or by entering the key terms of the domain name into an Internet search engine, would likely be confused as a matter of first impression.

38. The Arbitrator agrees with the conclusions above and with Complainant's contention that the likelihood of confusion stems from Respondent's misappropriation of Complainant's TD and CANADA TRUST Marks in their entirety, which drives an obvious association of the Disputed Domain Name with Complainant and its two Marks. Thus there is a considerable risk that the public will perceive the Disputed Domain Name as associated with Complainant. Internet users seeing the Disputed Domain Name, even without being aware of the content, are likely to think that the Disputed Domain Name is in some way connected to Complainant, creating an "initial interest confusion."

39. Accordingly for the reasons stated above, the Disputed Domain Name is confusingly similar to Complainant's Mark.

***Rights in the Mark prior to the Disputed Domain Name registration and continuing Rights***

40. The Disputed Domain Name was registered on August 10, 2017.

41. Complainant's Marks were registered in Canada in CIPO on August 7, 2001 for TD BANK. March 20, 1992 and July 26, 2005 for TD, March 12, 1993 and September 15, 1995 for CANADA TRUST.

42. The Arbitrator is satisfied that Complainant's Marks were registered well before the registration of the Disputed Domain Name and accordingly had Rights in Complainant's Marks well before the registration of the Disputed Domain Name and as the evidence shows that Complainant's rights are active, Complainant continues to have such Rights.

***Was the Disputed Domain Name registered in bad faith?***

43. Complainant relies on paragraph (d) of 3.5 of the Policy in support of bad faith registration of the Disputed Domain Name by the Registrant. The Arbitrator notes that the Policy provides that "if any of the circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence that a Registrant has registered a domain name in bad faith."

44. Complainant alleges that the Registrant registered the Disputed Domain Name primarily for the purpose of passing itself off as Complainant's actual site, with the intention of obtaining personal and sensitive information from Complainant's clients.

45. Further, Complainant submits that based on Complainant's publicly well-known brand and reputation in Canada and the online presence of Complainant's Marks, the Registrant could not plausibly assert that Complainant's Marks were unknown to the Registrant when the Registrant registered the Disputed Domain Name.

46. Evidence shows that at the time of registration of the Disputed Domain Name, the Respondent knew, or should have known, of the existence of the Complainant's Marks.

47. Complainant further submits that the Registrant, registered the Disputed Domain Name in order to fraudulently pose as Complainant for purposes of launching a phishing scheme by creating a website that replicated Complainant's actual website, thereby deceiving and misleading Internet users to unsuspectingly supply Respondent with personal and financial information. Complainant submits that prior arbitrators deciding under the Policy have held that where a registrant passes itself off as another entity, it represents bad faith registration and use for the purposes of Policy 4(a)(iii). Complainant submits that prior arbitrators deciding under the Policy have held that where a domain is used in a phishing scheme, it demonstrates bad faith use and registration.

48. Evidence further shows that the Registrant has failed to respond to Complainant's cease and desist letters. Complainant submits that prior arbitrators



deciding under the Policy have held that a Respondent's failure to respond to cease and desist letters may properly be considered a factor and strong support for finding bad faith registration and use of a domain name.

49. Based on all the circumstances demonstrated in the material and all the evidence provided by Complainant, the Arbitrator is satisfied that Complainant has proven bad faith registration of the Disputed Domain Name as required by the Policy.

### ***Legitimate Interest of the Registrant***

50. Paragraph 3.4 of the Policy sets out a non-exhaustive list of criteria upon which the Arbitrator may find, based on all the evidence, that the Registrant has a legitimate interest in the Disputed Domain Name. Paragraph 4.1 of the Policy places the onus on Complainant to provide "some evidence" that the Registrant did not have a legitimate interest in the Disputed Domain Name. Although "some evidence" is not defined, it imposes, in the Arbitrator's view, a lower threshold than on a balance of probabilities. The onus on Complainant is to provide "some evidence" of a negative.

51. Complainant has provided evidence in respect of the non-exhaustive list contained in paragraph 3.4 of the Policy that the Registrant has no legitimate interest in the Disputed Domain Name and in fact that the Registrant's interest was for an illegitimate use. The Registrant did not provide a Response and accordingly Complainant's evidence is not refuted.

52. Based on the evidence provided, which has not been refuted by the Registrant, the Arbitrator is satisfied that the Registrant has no legitimate interest in the Disputed Domain Name.

### **Decision**

53. For the reasons set out herein, the Arbitrator decides in favor of Complainant and orders the transfer forthwith of the Disputed Domain Name to Complainant.

Dated October 23, 2017



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Melvyn J. Simburg, Arbitrator