

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

Domain in Dispute: <tdeasyweb.ca>  
Complainant: The Toronto-Dominion Bank  
Registrant: Undisclosed  
Registrar: Go Daddy Domains Canada, Inc.  
BCICAC File: DCA-1854-CIRA

**DECISION**

**1. The Parties**

Complainant is The Toronto-Dominion Bank of Toronto, Ontario, Canada (“Complainant”), represented by CSC Digital Brand Services Group AB, of Stockholm, Sweden.

According to the Complaint, the Registrant’s identity is “hidden by CIRA.”

**2. The Domain Name and Registrar**

The disputed domain name is <tdeasyweb.ca> (the “Disputed Domain Name”), which was created on July 30, 2010. The registrar is BareMetal.com inc. (“Registrar”).

**3. Governing Policy and Rules**

This is a proceeding filed with the British Columbia International Commercial Arbitration Centre (“BCICAC”) under the CIRA Domain Name Dispute Resolution Policy, Version 1.3 (August 22, 2011) (“CDRP”) and the CIRA Domain Name Dispute Resolution Rules, Version 1.5 (July 28, 2014) (“Rules”). Paragraph 1.8 of the Policy states: “The version of the Policy in effect at the time a Proceeding is initiated will apply to the Proceeding.” Paragraph 1.2 of the Rules states: “The version of the Resolution Rules in effect at the time a Proceeding is initiated will apply to that Proceeding.”

**4. Procedural History**

The history of this proceeding, according to the information provided by BCICAC, is as follows:

- a. On September 12, 2017 Complainant filed a Complaint pursuant to the CDRP and the Rules.
- b. 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. As the Complaint with the attachments was filed exclusively online, therefore, the Centre delivered the Complaint to the Registrant only by email.

- c. The Complainant did not file any further submissions with respect to the issue of the Registrant's legitimate interest (or lack thereof) in the disputed domain name, as permitted by section 11.1 of the CIRA Domain Name Dispute Resolution Rules Version 1.4.
- d. The Registrant has not provided a Response. As permitted given the absence of a Response, the Complainant has elected under Rule 6.5 to convert from a panel of three to a single arbitrator.
- e. The Centre hereby appointed Douglas M. Isenberg, Esq., as sole arbitrator in the above-referenced matter on October 18, 2017.
- f. Absent exceptional circumstances, and pursuant to Rule 12.2, the Panel's decision is to be delivered to BCICAC by November 8, 2017.

The Panel finds that it was properly constituted and appointed in accordance with the CDRP and the Resolution Rules. Based upon the information provided by BCICAC, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding, unless otherwise noted, have been met.

## **5. Canadian Presence Requirement**

Paragraph 1.4 of the CDRP states: "The person initiating a Proceeding (the 'Complainant') must, at the time of submitting a complaint (the 'Complaint'), satisfy the Canadian Presence Requirements for Registrants (the 'CPR') in respect of the domain name that is the subject of the Proceeding unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office ('CIPO') and the Complainant is the owner of the trade-mark." Paragraph 2 of the CPR sets forth a list of individuals and entities that may "hold and maintain the registration of, a .ca domain name," which list includes "the owner of a trade-mark which is the subject of a registration under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13 as amended from time to time." The Complaint states, and provides evidence to support, that Complainant is the owner of Canadian Trademark Reg. Nos. TMA644911 (registered July 26, 2005), TMA396087 (registered March 20, 1992), TMA549396 (registered August 7, 2001) and TMA493469<sup>1</sup> (registered April 22, 1998) for marks that contain TD, TD BANK, or EASYWEB. As a result, the Panel is satisfied that the Complainant meets the CPR and is eligible to initiate this proceeding.

## **6. Factual Background and Parties' Contentions**

Complainant states that it is "the second largest bank in Canada by market capitalization and deposits, and the sixth largest bank in North America"; that it was "created in 1955 through the merger of the Bank of Toronto and The Dominion Bank, which were founded in 1855 and 1869, respectively"; and that it "has over 85,000 employees and over 22 million clients worldwide."

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<sup>1</sup> The Panel notes that this trademark is registered to TD Bank Financial Group, not to Complainant, and the Complaint does not explain the relationship between these entities. Given the other Canadian trademark registrations that have been cited, this registration is irrelevant for purposes of the CPR.

As noted above, Complainant states, and provides evidence to support, that it is the owner of Canadian Trademark Reg. Nos. TMA644911 (registered July 26, 2005), TMA396087 (registered March 20, 1992), TMA549396 (registered August 7, 2001) for marks that contain TD or TD BANK. These trademarks that contain TD or TD BANK are referred to hereafter as the “TD Trademark.”<sup>2</sup>

Complaint states, and provides evidence to support, that the Disputed Domain Name “redirect[s] Internet users to other commercial websites” and that “[t]he impression given by the Disputed Domain Name and its website would cause consumers to believe the Registrant is somehow associated with Complainant when, in fact, it is not.”

Complainant contends that, as the result of the Canadian trademark registrations described above, as well as others, Complainant has rights in the TD Trademark and the EASYWEB trademark and that the Disputed Domain Name “must be considered confusingly similar to each of these trademarks because, *inter alia*, it “drives an obvious association of the Disputed Domain Name with Complainant and its TD and EASYWEB trademarks.”

Complainant contends that Registrant has no legitimate interest in the Disputed Domain Name because, *inter alia*, “[n]o license or authorization has been given by the Complainant to Registrant to use the TD or EASYWEB trademarks”; “TD and EASYWEB are famous trademarks worldwide”; and “Registrant is using the Disputed Domain Name to redirect internet users to various third party websites unrelated to Complainant presumably for commercial gain.”

Complainant contends that the Registrant should be considered as having registered the Disputed Domain Name in bad faith because, *inter alia*, “by registering a domain name comprised of the exact terms ‘td’ and ‘easyweb’ Registrant has demonstrated a thorough knowledge of the TD brand and business”; “at the time of registration of the Disputed Domain Name, the Registrant knew, or at least should have known, of the existence of the Complainant's trademarks and that registration of domain names containing well-known trademarks constitutes bad faith per se”; “Registrant creates a likelihood of confusion with Complainant and its trademarks by registering a confusingly similar domain comprised of Complainant’s exact TD and EASYWEB trademarks, with Registrant then attempting to profit from such confusion by using the Disputed Domain Name to redirect Internet users to other commercial websites”; “[t]he impression given by the Disputed Domain Name and its website would cause consumers to believe the Registrant is somehow associated with Complainant when, in fact, it is not”; Registrant is “using the fame of the Complainant’s trademarks to improperly increase traffic to the website listed at the Disputed Domain Name for Registrant’s own commercial gain”; “where the Disputed Domain Name incorporates Complainant’s famous TD and EASYWEB trademarks in their entirety, there is no plausible good-faith reason or logic for Registrant to have registered the Disputed Domain Name”; and “Registrant has ignored Complainant’s attempts to resolve this dispute outside of this administrative proceeding.”

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<sup>2</sup> As noted above, Complainant also states that it is the owner of Canadian Trademark Reg. No. TMA493469 (registered April 22, 1998) for the mark EASYWEB, but this trademark is registered to TD Bank Financial Group, not to Complainant, and the Complaint does not explain the relationship between these entities.

Complainant requests that the Disputed Domain Name be transferred from the Registrant to the Complainant, The Toronto-Dominion Bank.

## **7. Discussion and Findings**

To obtain a transfer of the Disputed Domain Name, Complainant must, as set forth in paragraph 4.1 of the CDRP, prove “on a 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.

### **Rights and Confusingly Similar**

With respect to paragraph 3.1(a) of the CDRP, it is obvious based on Complainant’s reference to its Canadian trademark registrations that Complainant had rights in the TD Trademark prior to the date of registration of the Disputed Domain Name and continues to have such rights. However, as stated above, it is unclear from the Complaint and the annexes submitted by Complainant whether, or how, Complainant has rights in and to the EASYWEB trademark. As already noted, the single trademark registration for EASYWEB identified by Complainant, TMA493469, is owned by TD Bank Financial Group, not by Complainant, and Complainant has not explained its relationship with this entity. Therefore, for purposes of this proceeding, the Panel cannot find that Complainant has rights in the EASYWEB trademark.

Therefore, the Panel will determine only whether the Disputed Domain Name is confusingly similar to the TD Trademark. Paragraph 3.3 of the CDRP states: “In determining whether a domain name is ‘Confusingly Similar’ to a Mark, the Panel 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.” It is apparent that the Disputed Domain Name contains the TD Trademark in its entirety. “[I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark.” WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 1.7.<sup>3</sup>

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<sup>3</sup> Although WIPO Overview 3.0 addresses the Uniform Domain Name Dispute Resolution Policy (“UDRP”), Paragraph 3.2(l) of the CIRA Domain Name Dispute Resolution Rules expressly allows references to “dispute resolution proceedings which apply to domain names registered under any other top level domain which the Complainant considers persuasive.”

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(a) of the CDRP.

### **No Legitimate Interest**

With respect to paragraph 3.1(b) of the CDRP, regarding a lack of legitimate interests, the Panel is satisfied that the Complainant has established, on a balance of probabilities, that the Registrant does not have a legitimate interest in the Disputed Domain Name. By failing to submit a Response, the Registrant has not made any attempt to rebut Complainant's allegations or argue that it has a legitimate interest in the Disputed Domain Name under any of the six elements described in paragraph 3.4 of the CDRP, nor is there any evidence that demonstrates Registrant has a legitimate interest in the Disputed Domain Name. See, e.g., *Cointreau v. Netnic Corporation*, CIRA Case No. 00180 (“[t]here is no evidence from the ‘customer’ about its ‘interest’ in the Domain Name”); and *General Motors LLC v. Tony Wilson*, CIRA Case No. 00182 (“the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name and this evidence has not been rebutted by the Registrant”).

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(b) of the CDRP.

### **Bad Faith**

The Panel evaluates whether the Complainant has established that Registrant has registered the Disputed Domain Name in bad faith, as defined by the CDRP. Pursuant to paragraph 3.5 of the CDRP, the following “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 the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor 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 the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone or 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 the Complainant, or the 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 on-line location, by creating a likelihood

of confusion with the 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.

Among other things, Complainant specifically refers to paragraph 3.5(d), stating that "Respondent creates a likelihood of confusion with Complainant and its trademarks by registering a confusingly similar domain comprised of Complainant's exact TD and EASYWEB trademarks, with Respondent then attempting to profit from such confusion by using the Disputed Domain Name to redirect Internet users to other commercial websites." Screenshots provided by Complainant indicate that the Disputed Domain Name directs Internet users to a website for Edmunds (at <https://www.edmunds.com/>), which provides information about automobiles.

On the one hand, redirecting Internet users to a website about automobiles when those users may be expecting to find a website for a bank may not immediately appear to create a likelihood of confusion. The facts of this case are different from those in which a registrant uses a domain name to redirect Internet users to a website that offers goods or services similar to those offered by the complainant or to a website that offers (typically affiliate) links to other websites offering such goods or services. In those cases, Internet users may end up purchasing goods or services from a party other than the trademark owner they were seeking.

On the other hand, domain name dispute decisions frequently find confusion or bad faith where, as here, a registrant uses a domain name containing a complainant's trademark in connection with an unrelated website. See, e.g., *Research in Motion Limited v. One Star Global LLC*, WIPO Case No. D2009-0227 ("promot[ing] the sale of... unrelated products... is... unfair exploitation of another's trade mark"); *Harry Winston Inc. and Harry Winston, S.A. v. Harry Pluviose*, WIPO Case No. D2010-0210 ("even if it is clear to Internet users when they reach the Respondent's site that the site is unconnected with the Complainants, it does not really matter"); *Univision Communications Inc. v. Acme Mail*, Forum Claim No. 1322077 (finding bad faith "without regard to the goods and/or services offered at [respondent's] site"); and *Activision Blizzard, Inc. / Activision Publishing, Inc. / Blizzard Entertainment, Inc. v. Cimpress Schweiz GmbH*, Forum Claim No. 1737429 ("[u]sing a disputed domain name to create an initial interest confusion, in and of itself, supports a finding of bad faith").

While the decisions cited in the preceding paragraph all applied the UDRP, the "likelihood of confusion" test set forth in paragraph 3.5(d) of the CDRP is analogous to the "likelihood of confusion" test set forth in paragraph 4(b)(iv) of the UDRP. Plus, this Panel already has noted that paragraph 3.2(1) of the CIRA Domain Name Dispute Resolution Rules expressly allows references to "dispute resolution proceedings which apply to domain names registered under any other top level domain which the Complainant considers persuasive."

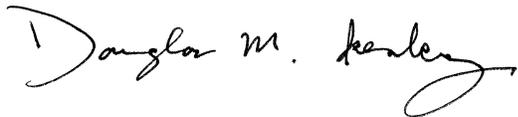
Further, a number of decisions under the CDRP have found bad faith under the doctrine of "initial interest confusion." For example, one panel wrote that paragraph 3.5(d) "appears to imply that while some degree of initial interest confusion might still be tolerated (i.e., when not intentional and not done 'by creating a likelihood of confusion'), it will only be tolerated where it is clear on reaching the site of the domain name in question that the use of domain name was

done effectively in good faith and not done to simply piggyback on the domain name's popularity for the purposes financial gain." *General Motors LLC v. Ryan Thompson*, CIRA Dispute No. 0191 (transfer of <chevroletorlando.ca>). Here, the Panel sees no explanation for Registrant's conduct other than to simply piggyback on the popularity of the TD Trademark, and hence the Disputed Domain Name, for financial gain.

In light of the above, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(c) of the CDRP.

## **8. Decision**

For all the foregoing reasons, in accordance with paragraph 4.3 of the CDRP, the Panel orders that the Disputed Domain Name <tdeasyweb.ca> be transferred to Complainant, The Toronto-Dominion Bank

A handwritten signature in black ink that reads "Douglas M. Isenberg". The signature is written in a cursive style with a large, looping initial 'D'.

**Douglas M. Isenberg**, sole arbitrator  
Dated: November 8, 2017