

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

BCICAC FILE NO. DCA-2145-CIRA

DOMAIN NAMES: tdeasyweblogin.ca ; tdonlineologineasyweb.ca
COMPLAINANT: The Toronto-Dominion Bank
REGISTRANT: David Crowe
PANEL: Tina M. Cicchetti
PROVIDER: British Columbia International Commercial Arbitration Centre
(the “Centre”)

**DECISION
22 NOVEMBER 2019**

I. The Parties

1. The Complainant is the Toronto-Dominion Bank, 66 Wellington Street West, Toronto Dominion Tower, 12th Floor, Toronto, Ontario, M5K 1A2, Canada.
2. The Registrant is David Crowe, davidcrowe312@gmail.com.

II. The Disputed Domain Names and Registrar

3. The domain names at issue in this complaint are tdeasyweblogin.ca (registered on 24 September 2018) and tdonlineologineasyweb.ca (registered on 11 September 2019) (collectively, the “Disputed Domain Names”).
4. The registrar through which the Disputed Domain Names are registered is eNom Canada Corp., legal@enom.com.

III. Procedural Background

5. On 1 October 2019, the Complainant filed a Complaint pursuant to the Policy and the Rules with the Centre, which is a recognized Provider.¹
6. On 3 October 2019, the Centre confirmed administrative compliance of the Complaint

¹ All capitalized terms in this decision that are not defined herein have the meaning set out in the Policy and/or the Rules.

with the Policy and the Rules; sent the Complaint to the Registrant in accordance with the Rules; and gave notice of commencement of the Proceeding to the Parties, the Registrar and CIRA.

7. The Registrant did not provide a response within the twenty-day timeframe prescribed by paragraph 5.1 of the Rules.
8. On 24 October 2019, the Centre wrote to the Parties to advise that the Registrant had failed to submit its response and that the Complainant could elect to convert from a three-person panel to a single member panel.
9. As permitted by Rule 6.5 in the absence of a response, the Complainant elected to convert from a panel of three to a single member panel. The Centre appointed Tina M. Cicchetti (the "Arbitrator") as panellist to decide the Complaint (the "Panel").
10. On 5 November 2019, the Arbitrator signed the Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.
11. As the Registrant did not submit a response, in accordance with Rule 5.8, the Panel shall decide the Proceeding on the basis of the Complaint.

IV. The Applicable Law

12. Pursuant to Rule 12.1, the Panel's decision shall be rendered on the basis of the evidence and argument submitted and in accordance with the Policy, the Rules and any rules and principles of the laws of Ontario and the laws of Canada applicable therein.

V. Issues to be Determined and the Positions of the Parties

13. The Complainant alleges that the Registrant is in violation of the Policy in that it has registered domain names that are Confusingly Similar to Marks in which the Complainant had Rights prior to the date of registration of the domain names and continues to have such Rights in bad faith and without a legitimate interest in the domain names.
14. The Complainant seeks a decision transferring the Disputed Domain Names to it.
15. In accordance with paragraph 1.9 of the Policy, the Complainant represented and warranted that it satisfied the Canadian Presence Requirements ("CPR") at the time of submitting the Complaint or the Complaint relates to a trade-mark registered in CIPO and the Complainant is the owner of the trade-mark; and that if CIRA transfers the Registrations that are the subject of the Proceeding to the Complainant, it will satisfy the CPR at the time of transfer.
16. The Complainant submitted evidence that it owns the trademarks TD and EASYWEB, which are registered at the Canadian Intellectual Property Office ("CIPO") with

registration numbers TMA396087, TMA644911 and TMA493469. These Marks are contained in the Disputed Domain Names. Accordingly, the Complainant has established that it satisfies the CPR for Registrants as prescribed by the Policy.

A. Issues to be Determined

17. In order for the Complainant's Complaint to succeed, pursuant to paragraph 4.1 of the Policy, it must establish on a balance of probabilities that:

- a. The Registrant's dot-ca domain names are 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 of the Policy.

The Complainant must also provide some evidence that:

- c. The Registrant has no legitimate interest in the domain name as described in paragraph 3.4 of the Policy.

B. The Positions of the Parties

Complainant's Position

18. The Complainant, The Toronto-Dominion Bank, is the second largest bank in Canada by market capitalization and deposits and the sixth largest bank in North America. The bank was created in 1955 through the merger of two banks founded in the 1800s.
19. Commonly known as TD and operating as TD Bank Group, the bank has over 86,000 employees and over 25 million clients worldwide. In Canada, the retail bank operates as TD Canada Trust and serves more than 13 million customers at over 1,100 branches. EASYWEB is TD Canada Trust's online banking service that allows customers to do online banking at their convenience. In the United States, the bank operates as TD Bank. TD ranks among the world's leading online financial services firms.
20. The Complainant operates numerous websites, chief among them www.tdbank.com and www.td.com. These websites attract millions of visitors, making them some of the most popular websites in Canada (top 15), the United States (top 500) and globally (top 600).
21. The Complainant's brands are ranked as some of the world's most valuable (number 54 on the 2018 Forbes Global 2000 listing, number 118 on the Brand Finance® Brand Directory 2018 Global 500 list and number 66 on the BrandZ list of the 2018 Top 100 Most

Valuable Global Brands).

22. The Complainant's brands also receive recognition from consumers having been named a top employer and a winner for "Customer Service Excellence" among its competitors.
23. The Complainant's brand is well-recognized and the Complainant has made significant investments to advertise, promote and protect its trademarks, which are associated with its brand, through various forms of media, including the Internet. Based on its extensive use and trademark registrations, the Complainant owns the exclusive right to use the TD, TD BANK and EASYWEB marks for banking and related financial services.
24. The Complainant submits that it owns the TD, TD BANK and EASYWEB trademarks and has had these rights for many years and before the Disputed Domain Names were registered.
25. It submits that in determining whether the Disputed Domain Names are Confusingly Similar to its marks, the Policy requires that the ".ca" portion of the domain name be excluded.
26. As to the remaining portion of the Disputed Domain Names, the Complainant submits that the addition of generic terms "login" and "online" to its TD and EASYWEB trademarks does not differentiate those domain names and, instead, makes them Confusingly Similar to its trademarks.
27. Further, the Complainant says that the addition of the particular generic terms "login" and "online" to the Complainant's marks underscores and increases the confusing similarity in light of the Complainant's business – in particular, providing online internet banking through its EASYWEB service. The Complainant submits that the addition of these generic terms to its trademarks creates a considerable risk that the public will perceive the Disputed Domain Names to be associated with the Complainant and its business.
28. In support of its position, the Complainant refers to earlier cases that found the addition of terms that closely relate to and describe a business to that business's mark is confusingly similar (*ExxonMobil Corporation v. mga enterprises limited*, FA 1273445 (NAF Aug. 26, 2009) and that set out the test of confusing similarity as being whether the average Internet user, with an imperfect recollection of the Mark, who wishes to access a website operated by the Complainant would likely be confused as a matter of first impression (*Great Pacific Industries v. Ghalib Dhala*, 00009 (CIRA Apr. 21, 2003).
29. The Complainant submits that by registering domain names that incorporate its TD and EASYWEB trademarks in their entirety, the Registrant has demonstrated a knowledge of and familiarity with Complainant's brand and business. Currently, the Disputed Domain Names link to inactive pages, but the cached websites included the Complainant's address and phone number. The Disputed Domain Names once redirected internet users to websites featuring links to third party websites, some of which directly referenced

Complainant and its competitors. The Complainant says that the use of its marks by the Registrant who had no connection with the Complainant's business strongly implies bad faith pursuant to paragraph 3.5(d) of the Policy.

30. The Complainant refers to cases that support a finding of bad faith where a complainant has a worldwide reputation and presence on the Internet and the Registrant was or should have been aware of the marks prior to registering the Disputed Domain Names (citing, among others, *Caesar World, Inc. v. Forum LLC*, D2005-0517 (WIPO Aug. 1, 2005), *Victoria's Secret v. Hardin*, FA 096694 (NAF Mar. 31, 2001) and *GO Local NC Farms, LLC v. Paul Darcy*, FA 1426087 (NAF Mar. 13, 2012)).
31. The Complainant submits that the Registrant has demonstrated a nefarious intent to capitalize on the fame and goodwill of the Complainant's marks for the Registrant's own pecuniary gain by creating a likelihood of confusion between the Complainant's trademarks and the Disputed Domain Names. In any event, the Complainant says that the "use" requirement does not require a positive act and that passively holding a domain name can constitute a factor in finding bad faith registration and use.
32. The Complainant says that registering the Disputed Domain Names, which simply combined its TD and EASYWEB trademarks with generic terms related to its business, can only be explained by the Registrant's intent to cause confusion, mistake and deception and any such use could only be in bad faith.
33. The Complainant also submitted that the Registrant holds registrations for several other domain names that misappropriate the trademarks of well-known brands and businesses and this demonstrates a pattern of cybersquatting/typosquatting, which is evidence of bad faith registration and use of the Disputed Domain Names.
34. Further, the Complainant first sent cease and desist letters to the Registrant in relation to the <tdeasyweblogin.ca> domain name and no response was received. On the date of the third and final cease and desist request, the Registrant registered the second of the Disputed Domain Names <tdonlinelogineasyweb.ca>. The Complainant referred to cases that found that a failure to positively respond to a demand letter provided strong support for a determination of 'bad faith' registration and use.
35. The Complainant says that on a balance of probabilities, it is more likely than not that the Registrant was aware of the Complainant's rights in the trademarks and their value. As a result, the Registrant should be considered to have registered the Disputed Domain Names in bad faith pursuant to the Policy.
36. Finally, the Complainant submits that there is no evidence to suggest that the Registrant has been using the TD, TD BANK and EASYWEB marks in any way that would provide legitimate rights in the names. It submits that the Registrant was motivated by the fame of its trademarks and business to register the Disputed Domain Names and indicates a general intent to profit from the goodwill and confusion created by the Disputed Domain

Names in a way that does not create any legitimate interest in the trademarks. Further, currently, the Disputed Domain Names direct users to blank pages that lack content, which it says also evinces a lack of rights or legitimate interests in the Disputed Domain Names.

Registrant's Position

37. The Registrant did not submit a response.

VI. Analysis and Decision

38. As set out above, in order to succeed in its Complaint, the Complainant must establish on a balance of probabilities that the Disputed Domain Names are Confusingly Similar to a Mark in which it had Rights prior to the date of registration of the Disputed Domain Names and in which it continues to have such Rights. It must also demonstrate that the Registrant has registered the domain name in bad faith, as described in paragraph 3.5 of the Policy. Finally, the Complainant must provide evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.4 of the Policy.

A. Are the Disputed Domain Names Confusingly Similar to Complainant's Marks?

39. Paragraph 3.3 of the Policy provides as follows with respect to what is to be considered "Confusingly Similar":

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.

40. Paragraph 1.2 of the Policy clarifies that "[f]or the purposes of [the] Policy, "**domain name**" means the domain name excluding the "dot-ca" suffix".

41. Thus, the inquiry will focus on whether <tdeasyweblogin> and <tdonlineeasysweb> so nearly resemble the Mark as to be likely to be mistaken for the Mark.

42. The relevant portion of the definition of "Mark", which is found at paragraph 3.2 of the Policy provides as follows:

A "**Mark**" is:

...

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

43. The Complainant has established that its Marks, TD, TD BANK and EASYWEB, are registered in CIPO in connection with goods, services or both. Each of these registrations

is current and were first registered in or before 2001.

44. In addition, the Complainant also provided evidence of the registration of the TD and TD BANK marks with the U.S. Patent and Trademark Office, as well as evidence of its use of the Marks in Canada, the United States and globally in connection with its business.
45. The Disputed Domain Names, which were registered on 24 September 2018 and 11 September 2019, use two of the Complainant's registered Marks, TD and EASYWEB. In light of the Complainant's business of providing banking services, including online banking and financial services over the Internet by way of its EASYWEB services, the Panel finds that the addition of the words "online" and "login" to the Disputed Domain Names does not differentiate those domain names from the Complainant's Marks. In fact, the use of these generic terms that describe aspects of the Complainant's business together with the Complainant's Marks in the Disputed Domain Names serves to increase the resemblance between the Disputed Domain Names and the Complainant's Marks.
46. The Panel also agrees with the Complainant's submission that the Registrant exploits the goodwill and the image of the Marks by using them in the Disputed Domain Names and this may result in initial interest confusion among users of the Internet searching for the Complainant's websites.
47. Accordingly, the Disputed Domain Names are Confusingly Similar to Complainant's Marks. The Panel finds that the Complainant had rights in those Marks for decades before the dates of registration of the Disputed Domain Names. The evidence also establishes that the Complainant continues to have and actively use such rights.

B. Were the Disputed Domain Names Registered in Bad Faith?

48. The Complainant has established the value and notoriety of its brand in the Canadian market, as well as in the United States and globally. The Complainant has satisfied the Panel that it is more likely than not that the Registrant was aware of the Complainant's Marks when it registered the Disputed Domain Names.
49. Paragraph 3.5 of the Policy sets out a non-exclusive list of circumstances that "shall be evidence that a Registrant has registered a domain name in bad faith" for the purposes of paragraphs 3.1(c) (basis for complaint) and 4.1(b) (onus).
50. The specific circumstances set out in paragraph 3.5 of the Policy that the Complainant alleges are present are the following:
 - (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.

51. The Complainant notes that the current Disputed Domain Names redirect Internet users to blank pages that lack content and that there is no evidence of a legitimate use of the Disputed Domain Names. It says that this evinces a lack of rights or legitimate interests in the Disputed Domain Names and that passively holding a domain name can constitute a factor in finding bad faith registration and use.
52. The Complainant also submits that cached screenshots from Google establish that the Registrant was using the Disputed Domain Names to redirect internet users to websites featuring links to third party websites, some of which directly reference the Complainant and its competitors. The Complainant submits that the use of its Marks in this way created a likelihood of confusion leading to misperceptions as to the source, sponsorship, affiliation or endorsement of the Disputed Domain Names and that this demonstrates a nefarious intent to capitalize on the fame and goodwill of the Complainant's Marks for the Registrant's own pecuniary gain.
53. Further and in any event, the Complainant submits that the Registrant has engaged in a pattern of cybersquatting by currently holding registrations for several other domain names that misappropriate the trademarks of well-known brands and businesses, which also evinces bad faith registration and use. The other domain names held by the Registrant include the use of the names of a number of the Complainant's competitors (other of the largest and well-known Canadian financial institutions).
54. Finally, the Complainant submits that it issued cease and desist letters to the Registrant and that the Registrant not only failed to respond to these letters, it also registered the second of the Disputed Domain Names on the date that the third such letter was sent.
55. The Panel finds that each of the circumstances identified by the Complainant is sufficient to establish that the Disputed Domain Names were registered in bad faith. The combination of these circumstances makes this conclusion inescapable – there is no plausible good faith reason or logic for the Registrant to have registered the Disputed Domain Names. These circumstances clearly establish that it was more likely than not that the Registrant had the Complainant's Marks in mind when registering the Disputed Domain Names.

C. Is there Evidence that the Registrant has No Legitimate Interest?

56. The Policy provides that, even if the Complainant establishes that the Disputed Domain Names are Confusingly Similar and registered in bad faith and provides some evidence that there is no legitimate interest on the part of the Registrant, the Registrant will be successful if it proves on a balance of probabilities that it had a legitimate interest in the Disputed Domain Names.
57. As noted above, the Registrant has not provided a response and therefore has not submitted any proof of a legitimate interest pursuant to paragraph 3.4 of the Policy in the

Disputed Domain Names.

58. Thus, in order to be successful, the Complainant must simply provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Names. The Complainant makes the following submissions in this regard:

- a. There is no evidence that the Registrant has been using TD, TD BANK and EASYWEB in any way that would provide legitimate rights in the names and there is no basis to claim any rights establish rights by common usage.
- b. The Complainant has not given any license or authorization to the Registrant to use its Marks.
- c. The Marks are famous trademarks worldwide and any use of them in domain names would violate the Complainant's rights in them.
- d. It is the fame of the Complainant's trademarks and business that have motivated the Registrant to register the Disputed Domain Names.
- e. Use of the Disputed Domain Names, which redirected Internet users to Registrant's websites, indicates an intent to profit from the goodwill and confusion created by the use of the Marks, which is not a legitimate interest.
- f. Registrant's redirection of the Disputed Domain Names to pages that are blank and lack content indicate a failure to make legitimate use of the Disputed Domain Names and evidences a lack of rights or legitimate interests.

59. In the Panel's view, the Complainant has provided ample evidence that the Registrant has no legitimate interest in the Disputed Domain Names to meet the onus at paragraph 4.1 of the Policy.

VII. Decision

60. For the reasons stated above, the Panel decides in favour of the Complainant and, in accordance with paragraph 4.3 of the Policy and Rule 9.1, orders that the Disputed Domain Names: <tdeasyweblogin> and <tdonlineologineasyweb> be transferred to the Complainant, the Toronto-Dominion Bank.

Dated this 22nd day of November 2019

/signed/

Tina M Cicchetti, Panellist