

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

Domain Names: SCOUTSCANADA.CA

Complainant: Scouts Canada
Registrant: Liam Morland
Registrar: 0756870 B.C. Ltd.

Panel: David Allsebrook (Chair)
Alessandro Colonnier
Myra Tawfik

Service Provider: ResolutionCanada

DECISION

A. The Parties

1. The Complainant is Scouts Canada, first incorporated by act of Parliament in 1914. Its address is 1345 Baseline Road, Ottawa, Ontario K2C 0A7. Its authorized representative in this dispute is Crease Harmon LLP, 800-1070 Douglas Street, Victoria, B.C., V8W 2S8.

2. The Registrant is Liam Morland. Mr. Morland gives his address as webmaster@scoutscanada.ca.

B. The Domain Name and Registrar

3. The domain name at issue is SCOUTSCANADA.CA.

4. The domain name is registered with 0756870 B.C. Ltd.

C. Panel Member Impartiality and Independence Statement

8. As required by paragraph 7 of the Rules, each panelist has declared to the Provider that they can act impartially and independently in this matter, as there are no circumstances known to any of them that would prevent them from so acting.

D. Canadian Presence Requirement

9. The Complainant is a Canadian Corporation, thus satisfying the Canadian Presence Requirement as stated in paragraph 1.4 of the *CIRA Domain Name Dispute Resolution Policy* (version 1.3) ["Policy"].

E. Factual Background

10. The positions of the parties are as follows. The factual basis of the Complaint is set out in its entirety in the following two paragraphs taken from the Complaint:

“The basis of this complaint stems from the Registrant's domain name ('scoutscanada.ca') being confusingly similar to the Scouts Canada Mark. The Complainant, Scouts Canada, is Canadian; specifically, it was created, in 1914 by an act of the Parliament of Canada: *An Act to incorporate The Canadian General Council of the Boy Scouts Association*, 4-5 *George V, Chapter 130*. The Mark in question is the Complainant's Mark denoted as application number 0980119. This application was approved on July 17, 1991. The Mark protects the Mark represented by the words 'Scouts Canada'.

“Mr. Morland has no legitimate interest or association with Scouts Canada. Mr. Morland's criticism of Scouts Canada does not require the use of a confusingly similar domain name as a platform. The website tarnishes the good will of the complainant's trademark. The Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant. The Registrant has intentionally attempted to attract internet users to the Registrant's domain by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant. It is clear from the content of the registrant's website that he intends to capture traffic associated with the complainants Mark for his own purposes which detract from the Mark's goodwill.”

11. Apart from a Whois search showing that the domain name was registered on February 18, 2009, no other facts or evidence were submitted by the Complainant.

12. The Registrant, Mr. Morland, states that there is no possibility of confusion because “Anyone visiting the web site at the disputed domain would recognize immediately that the web site is not the Complainant's web site nor affiliated with the Complainant.” [The Panel notes that neither party provided us with a copy of the web site] Mr. Morland notes that no evidence of confusion has been provided.

13. Mr. Morland denies that the domain name was registered in bad faith. He says “...it is clear from looking at the web site that the purpose of the web site us to provide information in the public interest and not to create any disruption. If public knowledge of

Scouts Canada's conduct disrupts their business, then it is that conduct, not the dissemination of information about the conduct, which is disrupting the business.”

14. Mr. Moreland denies that he is a competitor of Scouts Canada. When he registered scoutscanada.ca in 2009, he was a registered Scouts Canada volunteer. He is no longer registered as a volunteer but still spends a fair amount of time supporting Scouts Canada. He maintains the Scouting Camp Directory, advises Scouts Canada Volunteers, and helps to organize events which are attended by Scouts Canada troops. His web site offers nothing for sale and provides no way to make a donation.

15. Mr. Moreland states that he has a legitimate interest in the domain name, and that he is “doing exactly the sort of thing that sub-paragraph 3.4(d) is intended to allow. The web-site is non-commercial. It engages in good faith news reporting and criticism. The site provides and up to date archive of news stories from various media outlets relating to child protection within Scouts Canada, providing the public with ready access to this important information. The articles written for and hosted on the web site are good faith criticism of Scouts Canada's conduct. The web site is providing this information in good faith and in the public interest.”

16. The disputed domain name has been used to identify the web site printed on leaflets that were distributed to the public and on signage displayed in public.

17. The Panel has located the legislative history of the *An Act to Incorporate The Canadian General Council of the Boy Scouts Association*, 4-5 George V, Chapter 130. The current statute is *Scouts Canada Act*, 55-56 Elizabeth II, 2007 Chapter 38 (the “Act”). Subsection 1(1) of the Act provides that the Corporation created by the statute of 1914 is continued under the name “Scouts Canada”. Sub-section 10(a) of the Act provides that Scouts Canada has “the sole and exclusive right (a) to have and use... (ii) the titles ‘Boy Scouts’ and ‘Scouts Canada’; and (b) to have and use any emblem, badge, decoration, and description or designating word or phrase after the coming in force of this Act adopted by the Corporation for carrying out its object, if a statement and description of the emblem, badge, decoration, and descriptive or designating word or phrase is filed with and approved by the Minister of the Crown responsible for trade-marks and designs.”

F. CIRA Domain Name Dispute Resolution Policy Requirements

18. The Policy sets out at paragraph 4.1 what the Complainant must establish in order to successfully prove the Complaint:

To succeed in the Proceeding, the 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 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 . . .

19. The Panel will deal with each criterion in turn.

G. Is the Registrant's Domain Name Confusingly Similar to the Complainant's Mark?

20. To meet the requirement of 4.1(a) to show confusing similarity, each Complainant must show that it has rights in a "Mark" as "Mark" is defined in the Policy. Paragraph 3.2 of the Policy defines "Mark" as follows:

3.2 Mark

A "Mark" is:

- (a) a trade-mark, including the word elements of a design mark, or a trade name 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 the person's predecessor in title, for the purpose of distinguishing 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).

21. The Complainant must establish rights in a Mark that precede the domain name(s) registration date(s). The Complaint relies upon the registration of “Scouts Canada” with the Registrar of Trade-Marks. No copy of the registration was provided. The Panel located it in the database maintained online by the Registrar. It is not a trade mark registration, a registration under section 9(1)(n) of the Trade-Marks Act or a certification mark. It is a registration under the authority of a previous version of the Scouts Canada Act. The current version of that authority is quoted in paragraph 17 above. The registration identifies a *sui generis* right created by the Scouts Canada Act which does not fall within one of the categories of rights to which the Policy applies.

22. Paragraph (a) of the definition of Mark includes trade names which have been used by the Complainant. The Complainant does not argue or provide evidence that it has used Scouts Canada as a trade name, which it has the onus of proving. The Scouts Canada Act does make Scouts Canada the Complainant’s name, but is not sufficient to satisfy the use requirement of the Policy. A trade name which has been used enjoys goodwill, which an unused statutory right does not. The Policy does not contemplate protecting *sui generis* rights arising from private statutes.

23. In the absence of evidence that the Complainant has rights in a Mark, the Panel cannot find that the name Scouts Canada and the domain name scoutsCanada.ca are Confusingly Similar.

H. Was the Registration of the Domain Name Made in Bad Faith?

24. In order to succeed in the second stage of the test set out in paragraph 4.1, the Complainant must show, on the balance of probabilities, that the Registrant registered the domain name in bad faith. Paragraph 3.5 of the Policy states that the Registrant will be considered to have registered the domain name in bad faith if one of the following four conditions is met:

For the purposes of paragraphs 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel 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 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.

27. These four criteria are exemplars of certain kinds of bad faith behaviour. Bad faith may be found to arise in other circumstances.

28. The Complainant has the onus of showing bad faith. It has not filed a copy of the web site at scoutscanada.ca or any other evidence from which a finding of bad faith may be made.

29. The Panel considers that the adoption per se of a complainant's trade mark in a domain name does not create a presumption of bad faith for the purposes of the Policy or itself or justify a finding of bad faith. The Policy makes it clear that legitimate uses are possible. For example, in paragraph 3.4(d) it recognizes as legitimate use, use of the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting. The onus is on the Complainant to show that the registration of the domain name was in bad faith, and by failing to show the Registrant's intention at the time, such as may be inferred by showing how the domain name was used after registration, it has failed to meet its onus.

30. Neither party has shown us what appears on the scoutscanada.ca web site yet both rely upon its contents. The Panel is not prepared to go to the web site itself to forage for evidence the parties should have provided. To do so would create the risk that the Panel will locate and act upon evidence which has not been considered by one or both of the parties.

31. Therefore this Panel concludes that the Complaint fails because the Complainant has failed to show that the domain name was adopted in bad faith.

I. Does the Registrant Have a “Legitimate Interest” in the Domain Name?

32. The third element of the test set out in paragraph 4.1 of the Policy is to determine whether or not the Registrant has a legitimate interest in the domain name.

34. The Panel expresses no opinion on this issue.

J. Reverse Domain Name Hijacking

35. The Registrant has raised the question of what is often called “reverse domain name hijacking”. Specifically, the Respondent has asked this Panel to make a finding of Reverse Domain Name Hijacking under paragraph 4.6 of the Policy:

If the Registrant is successful, and the Registrant proves, on the balance of probabilities, that the Complaint was commenced by the Complainant for the purpose of attempting, unfairly and without colour of right, to cancel, or obtain a transfer of any Registration which is the subject of the Proceeding, then the Panel may order the Complainant to pay to the Provider in trust for the Registrant an amount of up to five thousand dollars (\$5000) to defray the costs incurred by the Registrant in preparing for, and filing material in the Proceeding. The Complainant will be ineligible to file another Complaint in respect or any Registration for any Provider until the amount owing is paid in full to the Provider.

36. The Registrant states that he has spent 32 hours on the response to this complaint and that his hourly consulting rate is \$100 per hour. He criticizes the Complaint for not addressing the onus requirements in the Policy and for making no clear argument for the existence of bad faith, and seeks compensation of \$3200.

37. The Complainant clearly does have an interest or “colour of right” in the name Scouts Canada, which the Registrant acknowledged by adopting it in his domain name for use in criticising Scouts Canada. The Panel finds that there has been no attempt at reverse domain name hijacking.

L. Conclusion and Decision

38. The Complainant has not shown that it has rights in a Mark falling within the classes of Mark protected by the Policy.

39. The Complainant has not established that the Registrant registered the domain name SCOUTSCANADA.CA in bad faith.

40. For these reasons, the Complaint regarding the domain name SCOUTSCANADA.CA is dismissed.

41. The Panel also finds that the Complainant did not initiate this Complaint unfairly and without colour of right to obtain the domain name from the Registrant.

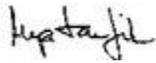
January 22, 2015



David Allsebrook
Chair



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