

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

Domain Name: *gthl.ca*

Complainant: Greater Toronto Hockey League

Registrant: Lars Horner

Registrar: BareMetal.com Inc.

Service Provider: Resolution Canada Inc.

Panel: Timothy C. Bourne

A. The Parties

1. The Complainant is the Greater Toronto Hockey League (the "GTHL"), a corporation established under the laws of Ontario. The GTHL's postal address is in Toronto, Ontario, Canada.
2. The Registrant is Lars Horner.

B. Disputed Domain Name and Registrar

3. The disputed domain name is *gthl.ca* (the "Domain Name"). The registrar with which the Domain Name is registered is BareMetal.com Inc. (the "Registrar"). The Domain Name was registered by the Registrant on January 18, 2004.

C. Procedural History

4. This is an administrative dispute resolution proceeding pursuant to the *CIRA Domain Name Dispute Resolution Policy*, version 1.3 (dated August 22, 2011) (the "*Policy*") and the *CIRA Domain Name Dispute Resolution Rules*, version 1.5 (the "*Rules*").
5. The GTHL filed the Complaint with Resolution Canada Inc. (the "Provider") on November 29, 2017. On December 12, 2017, the Provider sent by e-mail to the Registrant English and French versions of the Notice of Complaint filed by the GTHL, along with electronic versions of the Complaint and Schedules thereto. The Notice of Complaint explained that the Registrant had twenty (20) days from December 12, 2017 to file a Response to the Complaint with the Provider. No Response was filed by the deadline.
6. On January 5, 2018, the Provider appointed the Panel.
7. Based on the information forwarded by the Provider, the Panel holds that all technical requirements for the commencement and maintenance of this proceeding have been established.
8. The Panel is not aware of any other legal proceeding or other arbitration in relation to the Domain Name that would create a need to alter the progress of the proceeding pursuant to paragraph 13.2 of the *Rules*.

D. Panellist Impartiality and Independence

9. As required by paragraph 7 of the *Rules*, the Panel, Timothy C. Bourne, has submitted to the Provider a declaration of impartiality and independence for this dispute.

E. Effect of Failure of Registrant to File a Response

10. Paragraph 5.8 of the *Rules* provides that “[i]f a Registrant does not submit a Response within the period for submission of a Response or any period extended ... the Panel shall decide the Proceeding on the basis of the Complaint ...”. Accordingly, the Panel will decide this matter based on the arguments submitted by the GTHL.

F. Remedy Sought

11. In accordance with paragraph 4.3 of the *Policy* and paragraph 3.2(j) of the *Rules*, the GTHL has requested that the registration for the Domain Name be transferred to the GTHL.

G. Applicable Law

12. In accordance with paragraph 12.1 of the *Rules*, the Panel shall apply the laws of Ontario and the laws of Canada applicable within Ontario. Also, as stated in paragraph 4.2 of the *Policy* and paragraph 3.2(m) of the *Rules*, the Panel will base this decision in accordance with the *Policy* and the *Rules*.

H. Eligibility of the Complainant

13. As the Complainant, the GTHL must satisfy CIRA’s *Canadian Presence Requirements for Registrants* (the “CPR”). According to the Complaint, the GTHL is a corporation incorporated under the province of Ontario’s *Corporations Act* and continues to be organized pursuant to the laws of the province of Ontario. Thus the GTHL qualifies as a “corporation under the laws of Canada or any province or territory of Canada” and satisfies paragraph 2(d) of the CPR.

14. The GTHL also owns Canadian registration No. TMA624214 for the trademark GTHL. The GTHL thus owns a registration for a trademark, the exact word component for which is included within the Domain Name. The GTHL thus satisfies paragraph 2(q) of the CPR.
15. For the reasons set out above, the GTHL is an “Eligible Complainant” pursuant to the *Policy*.

I. Facts

16. The GTHL makes a number of unchallenged assertions, including the following:
 - the GTHL is the largest youth ice-hockey organization in the world, consisting of over 2,500 teams and more than 30,000 players. The GTHL was founded in 1911 and has undergone some name changes since that date;
 - the GTHL has registered the trademarks GTHL, GTHL CANADA, and GTHL CANADA & Design. The trademarks GTHL and GTHL CANADA have been used in Canada since at least as early as December 31, 1998. The GTHL operates the website located at the URL <http://www.gthlcanada.com> and has done so since at least as early as November 28, 1999;
 - the GTHL’s operating budget for its current financial year exceeds \$5,000,000.00 and it has spent over \$200,000.00 on marketing in the 2017 fiscal year;
 - the Registrant registered the Domain Name on January 18, 2004 and operates the website to which the Domain Name resolves (the

“Registrant’s Website”). The Registrant’s Website initially included information purportedly related to the GTHL, including links referencing the acronym GTHL which directed users to pay-per-click advertisements for third party goods, services, and/or websites. The Registrant’s Website has changed over the years. Nonetheless, the display of hockey related advertisements on the Registrant’s Website began on or before February 17, 2006 and continues today. The Registrant’s Website has from time to time offered the Domain Name for sale; and

- the Registrant also has registered sixty other domain names, including *ciniplex.ca*, *purolater.ca*, *royallapage.ca*, and *readerdigest.ca*. The domain name registrations resolve to websites that also include pay-per-click advertisements.

J. Complainant’s Contentions

i. Domain Name is Confusingly Similar to a Mark in Which the Complainant Had Rights Prior to the Domain Name Registration Date and Continues to Have Such Rights

17. The GTHL submits that the Domain Name is identical to the GTHL’s registered trademark GTHL. Additionally, the GTHL’s rights in that mark arose through use in Canada at least as early December 31, 1998. Such use has continued uninterrupted since that date and an application to register the trademark was filed on January 24, 2003 prior to the registration of the Domain Name. The GTHL thus submits that it had rights in the trademark GTHL prior to the Domain Name registration date.

ii. The Registrant Has No Legitimate Interest in the Domain Name

18. The GTHL submits that the Registrant's revenue generating advertisements on the Registrant's Website do not constitute a good faith commercial activity nor a legitimate interest. The GTHL also submits that none of the enumerated circumstances constituting a legitimate interest from paragraph 3.4 of the *Policy* exist with respect to the Registrant and Domain Name.

iii. The Domain Name Was Registered in Bad Faith

19. The GTHL submits that each of the circumstances enumerated in paragraph 3.5 of the *Policy* exist. The Complainant has provided detailed arguments in support of each bad faith ground.

K. Discussion and Finding

20. Paragraph 4.1 of the *Policy* provides that, to succeed, the GTHL must prove, on a balance of probabilities, that:

- (a) the Domain Name is Confusingly Similar to a Mark in which the GTHL 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.

21. Paragraph 4.1(c) of the *Policy* also states that the GTHL must provide some evidence that:

- (c) the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.4.

L. Confusingly Similar – Paragraph 3.3 of the Policy

22. To satisfy this branch of the test, the GTHL must demonstrate that it had Rights in a Mark that predate the registration of the Domain Name. Also, the GTHL must demonstrate that the Domain Name is confusingly similar with the Mark.
23. The GTHL references three trademark registrations, each consisting of or incorporating the acronym GTHL (registration Nos. TMA624214, TMA625499, and TMA852449). None of those registrations issued prior to the January 18, 2004 date on which the Domain Name was registered. Thus, the GTHL's registered trademarks do not predate the Domain Name registration date and the GTHL's registered trademark rights are not a proper basis for finding that the GTHL had Rights in a Mark prior to the date on which the Domain Name was registered.
24. However, the GTHL's submissions incorporate sworn affidavit evidence pertaining to its use of the trademark GTHL in Canada. Paragraph 3.2(a) of the Policy includes the following as the definition of the term "Mark":

"a trade-mark ... that has been used in Canada by a person ... for the purpose of distinguishing the ... services ... of that person ... from the ... services ... of another person".
25. Included as an exhibit to the affidavit of Mr. Scott Oakman, the Executive Director and Chief Operating Officer of the GTHL, are printouts of historical versions of the website located the URL <http://www.gthlcanada.com> operated by the GTHL. The website prominently displayed the trademark GTHL at least as early as November 28, 1999. The Panel is prepared to accept, based on these submissions, that the GTHL had common law trademark rights in

Canada pertaining to the mark GTHL prior to the Domain Name registration date.

26. The website printouts included as exhibits to Mr. Oakman's affidavit demonstrate that the GTHL had used the trademark GTHL prior to the Domain Name registration date and thus has trademark rights recognized by the Policy which precede the Domain Name registration date.
27. The Panel now turns to the question of whether the Domain Name is confusingly similar with one of the Complainant's marks. Paragraph 3.3 of the *Policy* provides that when 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. Thus the Panel must not conduct the confusion analysis in the same manner as would occur under subsection 6(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 by addressing all of the "surrounding circumstances" including those enumerated within that provision.
28. The Domain Name wholly incorporates the Complainant's trademark GTHL and thus the Domain Name is confusingly similar to the trademark GTHL used by the GTHL prior to the Domain Name registration date.

M. Bad Faith – Paragraph 3.5 of the *Policy*

29. The GTHL need only demonstrate bad faith under one of the grounds provided in paragraph 3.5 of the *Policy*. Thus, the Panel will address only whether bad faith exists under paragraph 3.5(d) of the *Policy*. That provision provides that the following circumstance constitutes registration of a domain name in bad faith:

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.

30. There are numerous precedents wherein panels have concluded that bad faith exists where a registrant adopts a domain name incorporating a well-known mark and uses the domain name for directing internet traffic to third party advertisements (see *Papa John's International Inc. v. McGrath* (CIRA Decision No. 00299, September 9, 2015), *Victoria's Secret Stores Brand Management, Inc. v. Poustie* (CIRA Decision No. 00263, June 20, 2014), *General Motors LLC v. Wilson* (CIRA Decision No. 00182, March 21, 2012), and *Dixie Consumer Products LLC v. Alexander* (CIRA Decision No. 00266, August 14, 2014)).
31. The Registrant has intentionally attempted to attract Internet users to the Registrant's website by creating a likelihood of confusion with the GTHL's mark as to the affiliation or endorsement of the Registrant's Website or alternatively one of the third party websites for which links are provided on the Registrant's Website. The Panel agrees with Mr. Oakman's testimony that hyperlinks on the current version of the Registrant's Website ultimately direct Internet users to websites providing goods or services that relate to or are ancillary to the game of hockey, such as hockey training services and sports team website design. These services relate to the GTHL's core mandate and thus Internet users may erroneously conclude that the GTHL is affiliated with the providers of such services and/or endorses the providers and/or their services.
32. The Panel also is satisfied that the pay-per-click links that have occupied the Registrant's Website over the years, and continue to occupy the Registrant's

Website, exist for the Registrant's commercial gain. There is precedent for panels to infer that individuals derive financial benefit by using domain names which promote third party businesses (*Calgary Exhibition and Stampede Ltd. v. Squires* (CIRA Decision No. 00229, May 10, 2013)). Additionally, it has been held that actual profit need not be established for a panel to conclude that the Registrant's efforts are for commercial gain (*Victoria's Secret Stores Brand Management, Inc. v. Poustie* (CIRA Decision No. 00263, June 20, 2014)).

33. The Panel thus concludes that the Registrant registered the Domain Name in bad faith pursuant to paragraph 3.5(d) of the *Policy*. The Panel also is persuaded by the Registrant's failure to respond to a cease and desist letter sent by counsel for the GTHL and that the Registrant has not made any submissions to the Panel, including submissions suggesting that the Domain Name is not registered in bad faith.

N. Legitimate Interest – Paragraph 3.4 of the *Policy*

34. Paragraph 3.4 of the *Policy* provides that:

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 Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in a 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 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 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 Registrants includes, but is not limited to, use to identify a web site.

- 35. The GTHL's unchallenged evidence is that the GTHL has never had a relationship with the Registrant and that the GTHL has never granted a licence or provided any authorization to the Registrant to use or display the acronym GTHL. Thus, the GTHL has provided some evidence that the Registrant has no legitimate interest in the Domain Name under paragraph 3.4 of the *Policy*.
- 36. The Registrant clearly did not register the Domain Name in Canada in good faith. There is no evidence before the Panel that the Registrant had Rights in the trademark GTHL. Additionally, the Domain Name does not clearly describe any aspect of the Registrant's services or business, nor is there any evidence before the Panel that the Domain Name is understood to be the generic name of such services or business in any language. Accordingly, the

Registrant has no legitimate interest pursuant to paragraphs 3.4(a), 3.4(b) or 3.5(c) of the *Policy*.

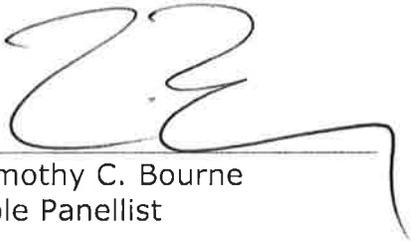
37. There also is no evidence before the Panel that the Registrant has used the Domain Name for a non-commercial activity. Indeed, according to the evidence, the links from website to which the Domain Name resolves resolve to websites for a hockey training service, a designer of sports team websites, a purveyor of sports and recreation based management software, and a purveyor of sports league and club management solutions.
38. In accordance with the finding regarding bad faith, the Panel repeats that the evidence demonstrates that the Registrant used the Domain Name for profit and thus the Registrant has no legitimate interest under paragraph 3.4(d) of the *Policy*.
39. The Domain Name is not the legal name of the Registrant Lars Horner. Nor is there any evidence or suggestion that the Domain Name is a name, surname, or other reference by which the Registrant is commonly identified. Thus, the Registrant has no legitimate interest under paragraph 3.4(e) of the *Policy*.
40. Finally, the Domain Name is not a geographical name and thus cannot constitute the geographical name of the Registrant's place of business. Accordingly, the Registrant has no legitimate interest under paragraph 3.4(f) of the *Policy*.
41. The Panel thus concludes that the GTHL has provided some evidence that the Registrant has no legitimate interest in the Domain Name. The onus thus shifts to the Registrant to prove, on a balance of probabilities, that it has a legitimate interest in the Domain Name. The Registrant has not filed any

submissions disputing the GTHL's submissions or justifying its registration or use of the Domain Name and thus has failed to meet its onus.

O. Conclusion and Decision

42. For the reasons set forth above, the Panel concludes that the GTHL has established the three elements of the basis for the Complaint in accordance with their respective onuses. Thus, the Panel orders the transfer of the registration for the Domain Name to the Complainant, the GTHL.

January 24th, 2018

A handwritten signature in black ink, appearing to read 'TCB', written over a horizontal line.

Timothy C. Bourne
Sole Panellist