

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

Complainant: The Toro Company, Bloomington MN, USA

Complainant’s Counsel: Linda M. Byrne
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1270 Northland Drive
St. Paul MN 55120

Registrant: Pierre Hannon, Laval QC, Canada

Disputed Domain Name: toro.ca

Registrar: ZiD.com Division of ZYMOS Computer Systems Inc.

Panel: Hugues G. Richard, Denis Magnusson (Chair), Daria Strachan

Service Provider: Resolution Canada

DECISION

Parties

The Complainant is The Toro Company of Bloomington MN, USA. The Registrant is Pierre Hannon of Laval QC, Canada.

Disputed Domain Name and Registrar

The disputed domain name is **toro.ca** which was registered on February 1, 2001. The Registrar is ZiD.com Division of ZYMOS Computer Systems Inc.

Procedural History

The Complainant filed the Complaint with the Provider, Resolution Canada who found the Complaint in compliance with the CIRA *Domain Name Dispute Resolution Rules* (“Rules”) and transmitted it to the Registrant. The Registrant filed a Response. The Complainant filed an amendment to the Complaint and the Registrant filed an amendment to the Response. Under the Rules the Provider appointed Hugues Richard, Denis Magnusson (Chair) and Daria Strachan as the Panel to decide this matter.

Eligible Complainant

An eligible Complainant under the Policy , para. 1.4, includes any person who is the owner of a trademark registered in the Canadian Intellectual Property Office (“CIPO”), to which trademark the dispute relates. The Complainant noted five such trademark registrations of which the Complainant was the owner. Four of these trademarks consist only of the word “toro” and one of these marks consists of the word “toro” and a design. Thus, a dispute over the domain name toro.ca “relates to” each of these registered trademarks, qualifying the Complainant an eligible complainant.

Relief Requested

The Complainant requested that the Panel order that the domain name registration be transferred from the Registrant to the Complainant.

Background Facts

The Complaint states that the Complainant The Toro Company's "business activities focus on lawn and garden care, irrigation, snow removal equipment, etc." The Complaint further states that "the Complainant has sold products in Canada under the TORO trademark since 1915". The Complainant has 300 Canadian distributors and dealers in its products, and products bearing the TORO mark are sold in every province and territory of Canada, estimated at more than \$70 million yearly. The five registered trademarks upon which the Complainant relies were registered in Canada between 1932 and 1998.

The Registrant is Pierre Hannon of Laval, QC. The disputed domain name **toro.ca** was first registered by the Registrant on February 1, 2001. Using an Internet browser to locate www.toro.ca resolves to a page which has only the following statement:

"Votre nom de Famille correspond à ce nom de Domaine? Vous désirez utiliser ce nom de Domaine pour recevoir vos emails? Contractez mois à l'adresse Pierre@Hannon.ca pour en savoir plus . . ."

In his response the Registrant states that he offers a service whereby a person whose family name is, in this case "Toro", can arrange to have email which is addressed to "toro.ca", forwarded to the person's personal email address and mailbox. The Registrant indicates that he offers this service with respect to a list of domain names he has registered and submitted in the Response, which domain names are also readily recognizable as likely family names in Canada. The Registrant also submitted a list of approximately 80 listings of persons in Canada whose family name is "Toro".

Onus on Complainant

Policy para. 4.1 requires that:

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 3.7; and the Complainant must provide some evidence that:
- (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6. [emphasis added]

(a) Confusingly Similar

Marks in Which Complainant Had and Has Rights

Policy, para. 3.2 states a "Mark" includes a trademark registered in the CIPO. The Complaint listed the following trademark registrations owned by the Complainant as related to the Complaint:

<u>Mark</u>	<u>CIPO Reg. No.</u>	<u>Date Registered</u>
TORO	UCA000379	December 9, 1932
TORO	509,904	March 24, 1999
TORO	509,970	March 25, 1999
TORO	481,969	September 3, 1997
TORO design	491,492	March 17, 1998

All of the above registered trademarks are “Marks” in which the Complainant had Rights prior to the date of registration of the disputed domain name February 1, 2001

Confusingly Similar

Policy, para. 3.4 defines “Confusingly Similar”:

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 to be mistaken for the Mark.

In assessing similarity, the “dot-ca” suffix of the domain name is ignored. Thus, four of the Complainant’s Marks and the word element of the fifth of the Complainant’s Mark, each composed of “toro”, are identical to the “toro” element of the **toro.ca** domain name. Such identity clearly qualifies as near resemblance likely to cause the domain name to be mistaken for the Marks.

b) Bad Faith

The CIRA *Policy*, para. 3.7 has a very restrictive definition of what can constitute the Registrant’s necessary Bad Faith in registering the domain name. That definition states that there will be Bad Faith, “*if, and only if*” one or more of three specific circumstances obtain. The Complainant, rightly in the view of the Panel, submitted argument only with respect to the definition of bad faith in subpara. 3.7(c), as claims of bad faith under subparas. 3(a) and (b) could not be supported on the evidence.

3.7(c) Registrant’s Purpose of Disrupting the Business of a Competitor

Policy, para. 3.7(c) sets out this circumstance of bad faith:

(c) the Registrant registered the domain name . . . *primarily* for the purpose of disrupting the business of the Complainant . . . who is a competitor of the Registrant. [emphasis added]

To succeed in showing the Registrant’s bad faith under this subparagraph, the Complainant must, among other things, establish that the Registrant is a *competitor* of the Complainant. The Complainant made the following submissions on this requirement:

“The Complainant’s contention that the Registrant is a “Competitor” is based on Uniform Domain Name Dispute Resolution Policy, as well as case law (see *Mission KwaSiabantu v. Benjamin Post*, WIPO Case No. D2000-0279; *Estée Lauder Inc. v. estelauder.com, estelauder.net and Jeff Hanna*, WIPO Case No. D2000-0869 establishing that (i) a competitor is simply someone who acts in opposition to another, including competing for the attention of internet users and (ii) there is no requirement that the Registrant be a commercial business competitor, or that parties sell competing products.”

In *Trans Union LLC v. 1491070 Ontario Inc.*, CIRA Dispute No. 0008, the Panel considered a very similar submission on the meaning of “Competitor”:

- “The Complainant’s contention that the Registrant is a “competitor” is based on *Uniform Domain Name Dispute Resolution Policy* [hereinafter UDRP Policy] case law (see *Mission KwaSizabantu v. Benjamin Post*, WIPO Case No. D2000-0279; *Estée Lauder Inc. v. estelauder.com, estelauder.net and Jeff Hanna*, WIPO Case No. D2000-0869) establishing that (i) a competitor is simply someone who acts in opposition to another, including competing for the attention of internet users and (ii) there is no requirement that the Registrant be a commercial business competitor, or that the parties sell competing products. The Complainant asserts, in support to its claim that the Registrant is a competitor, that the Registrant is attempting to entice its customers and potential customers to purchase the Registrant’s pornographic wares and/or services.

- The Panel notes, however, that there has been disagreement amongst UDRP panels as to the breadth of the phrase “disrupting the business of a competitor”. The decisions cited by the Complainant have indeed adopted a broad interpretation of the phrase holding, as indicated above, that a competitor is simply someone who acts in opposition to another, including competing for internet users and that there is no requirement that the registrant be a commercial business competitor or someone that sells competing products. However, a number of other decisions have rejected this broad interpretation and have favoured a narrow interpretation holding that a registrant can disrupt the business of a competitor only if it offers goods or services that can compete with or rival the goods or services offered by the trademark owner (see *Tribeca Film Center, Inc. v. Lorenzo Brusasco-Mackenzie*, WIPO Case No. D2000-1772; *Britannia Building Society v. Britannia Fraud Prevention*, WIPO Case No. D2001-0505).
- After review of the referenced decisions, the Panel is of the opinion that the language found in paragraph 3.7(c) of the CIRA Policy must be given a narrow interpretation. The Panel agrees with the findings in *Tribeca Film Center, Inc. v. Lorenzo Brusasco-Mackenzie*, supra, that if paragraph 3.7(c) were given the interpretation advanced by the Complainant, registrants would be found to have disrupted the business of competitors in far too many cases, and the Policy’s bad faith requirement would be diluted beyond recognition.
- The Panel notes that paragraphs 3.7(a) of the CIRA Policy and 4(b)(i) of the UDRP Policy also make reference to a “competitor”. The word “competitor” in those paragraphs should be given the same meaning as in paragraphs 3.7(c) and 4(b)(iii) of the CIRA and UDRP Policies, respectively. It is difficult to conceive that the “competitor” in paragraphs 3.7(a) and 4(b)(i) could be simply “one who acts in opposition to another” without any requirement that the transferee be a commercial business competitor of the Complainant or someone that sells competing products.
- Furthermore, it must also be noted that the CIRA Policy was adopted after the UDRP Policy. While the CIRA Policy and the UDRP Policy are similar in some respect, they do have important differences. For instance, paragraph 4(b) of the UDRP Policy concerning bad faith provides “circumstances [...] without limitation” (emphasis added) which the Panel must consider to determine whether bad faith exists or not. The CIRA Policy in section 3.7 on the same subject is much more restrictive, i.e. the list of circumstances to be considered to determine bad faith is limited to those mentioned. In other words, there is no room under the CIRA Policy for a “broad” interpretation. As long as the CIRA Policy says what it says, the Panel is bound by its explicit limitations.

Conclusion on Bad Faith

For the foregoing reasons, the Panel finds that the Complainant has not satisfied the burden imposed upon it to prove that the Domain Name was registered in bad faith.

c) Legitimate Interest

Since the Complainant cannot establish that the Registrant registered the domain name in bad faith as defined in the CIRA Policy, it becomes unnecessary for the Panel to consider the issue of Legitimate Interest.

Order

For the reasons set out above, the Panel refuses to grant the relief requested by the Complainant, and does not order the transfer or the cancellation of the registration of the domain name.

Date: August 25, 2005

Hugues G. Richard, Denis N. Magnusson, Daria Strachan
Signed

Denis N. Magnusson, Chair of Panel