

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

Complainant: The Standard Life Assurance Company of Canada

Complainant’s Counsel: Hugues G. Richard
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Registrant: Hank Morin

Disputed Domain Name: standard-life.ca

Registrar: SIBERNAME INTERNET AND SOFTWARE TECHNOLOGIES INC

Panel: Denis Magnusson, sole member

Service Provider: Resolution Canada

DECISION

Parties

The Complainant is The Standard Life Assurance Company of Canada. The Registrant is Hank Morin of Mississauga ON, Canada.

Disputed Domain Name and Registrar

The disputed domain name is **standard-life.ca** which was registered on May 24, 2005. The Registrar is Sibername Internet and Software Technologies 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 has not filed a Response.

As the Registrant has not filed a Response, the Panel is required to decide the matter “on the basis of the Complaint”, CIRA Rules, para. 5.8. No Response having been submitted, the Complainant opted to have the matter decided by a single member panel, CIRA Rules, para. 6.5. The Provider appointed the undersigned Denis N. Magnusson as the sole member of the Panel to decide this matter.

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 parent company of the Complainant, The Standard Life Assurance Company of Scotland, began doing business in Canada in 1833. The parent company caused the Complainant company, The Standard Life Assurance Company of Canada to be incorporated in 1989. The Complainant is a wholly owned subsidiary company of the parent company. The Complainant’s products include group and individual life insurance and group health insurance. About 1.2

million Canadians are currently served by the Complainant's products and the Complainant has more than \$30 billion in assets under its management. The parent company of the Complainant registered four trademarks in the Canadian Intellectual Property Office ("CIPO") each comprising the words "Standard Life" alone or together with a design in 1987, 1993, and 2001. The parent company assigned ownership of the four trademarks registered in the CIPO to the Complainant as of January 1, 2005.

The Registrant is Hank Morin of Mississauga ON. The disputed domain name **standard-life.ca** was first registered by the Registrant on May 24, 2005. Using an Internet browser to locate www.standard-life.ca resolves to a page which is headed "standard-life.ca" in large print. Below are the headings "Health Insurance", "Life Insurance" and "Insurance". Below these headings a narrower column to the left has a list of headings, all of which include the word "insurance", such as "life insurance", "health insurance", "life insurance quote", etc. To the right side is a wider column with a heading at the top reading "Sponsored Links" followed by a series of links to sites offering insurance products. Clicking on one of the headings in the narrower left hand column changes the links displayed in the right hand column. For example, when "Insurance" is clicked in the left hand column, the first link under the right hand column heading "Sponsored Links" reads: "Insurance: Save on insurance with Co-operators. Find an agent for a quote. <http://www.cooperators.ca>." Clicking on the URL for this link resolves to a web page of The Co-operators, described there as "the largest, wholly Canadian-owned multi-product insurance company, providing insurance to over two million Canadians."

Eligible Complainant

The Complaint reveals more than one basis under which the Complainant would qualify as an eligible Complainant under the Policy. For example, an eligible Complainant includes any person who is the owner of a trademark registered in the CIPO, to which trademark the dispute relates, Policy, para. 1.4. The Complaint noted four such trademark registrations of which the Complainant was the owner, each of which comprises the words "Standard Life", with and without design material. In particular, TMA328136 consists of the words "Standard Life" alone, registered for the services "assurance". As the registered domain name in dispute is **standard-life.ca**, this registered trademark clearly "relates to" the dispute over this domain name registration under the Policy.

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.
- [emphases 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 four trademark registrations related to the Complaint, owned by the Complainant as a result of the assignment effective January 1, 2005:

<u>Mark</u>	<u>CIPO Reg. No.</u>	<u>Date Registered</u>
Standard Life	TMA328136	1987-05-29
Standard Life & design	TMA420397	1993-12-03
Standard Life Investments	TMA552476	2001-10-17
Standard Life Investments & design	TMA554897	2001-12-03

The Complaint offers ample evidence that the Complainant has extensively used and continues to use these marks in Canada. 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 on May 24, 2005 and in which the Complainant continues to have Rights.

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, Policy para. 1.2. Thus, the first of the above-noted registered trademarks, consisting of the words “standard life”, differs from the registered domain name **standard-life.ca** only in the placement of a hyphen between the two words. The Complaint noted:

It has been held by several CIRA Dispute Resolution Decisions that differences in syntax or punctuation have little or no impact on whether or not a domain name is Confusingly Similar with a Mark : see *Canadian Broadcasting Corporation / Societe Radio-Canada v. William Quon* (CIRA Dispute Resolution Decision # 00006), *Coca-Cola Ltd. v. Amos B. Hennan* (CIRA Dispute Resolution Decision # 00014), *Sleep Country Canada Inc. v. Pitfold Ventures Inc.* (CIRA Dispute Resolution # 00027) and *Reitmans Canada Limited v. Pitfold Ventures Inc.* (CIRA Dispute Resolution # 00032).

Thus, the domain name greatly resembles the Complainant’s Mark, in the form of the registered trademark “Standard Life”. The Panel finds that the resemblance is so near that the domain name is likely to be mistaken for the Mark, and so the domain name is Confusingly Similar to the Complainant’s Mark.

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 submitted argument with respect to the definition of bad faith in subparas. 3.7(b) and (c).

3.7(b) Registrant's Purpose of Preventing Complainant Registering Mark as Domain Name

Policy, para. 3.7(b) defines this instance of bad faith:

(b) the Registrant registered the domain name . . . in order to prevent the Complainant . . . from registering the Mark as a domain name, provided that the Registrant . . . has engaged in a pattern [of such activity];

With respect to establishing the Registrant's pattern of registering domain names for the purpose of preventing the owners of Marks from registering their Marks as domain names the Complaint submitted a list of dot-ca domain names registered by the Registrant.¹ This list has 98 dot-ca domain names. A few of those domain names are identical, apart from the dot-ca suffix, to recognizable trademarks or trade names, *e.g.* "sharpie.ca"². A much larger number of these registrations are very similar to recognizable trademarks or trade names, typically varying by one or two letters, by the addition of a hyphen, or by the addition of the letters "www" at the beginning of the domain name. For example:

<u>Domain Name</u>	<u>Apparent Trademark or Trade name</u>
coke-cola.ca	Coca-Cola ³
vedeotron.ca	Videotron ⁴
wwwshoppersdrugmart.ca	Shoppers Drug Mart ⁵
royalpage.ca	Royal LePage ⁶
wwwwallmart.ca	Walmart ⁷
wwwradio-canada.ca	Radio-Canada ⁸

There are many other such examples in the list of 98 domain names.

However, the difficulty for the Complainant in establishing the domain name Registrant's Bad Faith under Policy para. 3.7(b) is that as the registered domain name differs slightly from the Mark -- in this case the difference is the hyphen inserted between the two words of the Mark -- the domain name registration does not prevent the registration of the Mark, as such, as a dot-ca domain name. This is shown by the fact that that Complainant has registered **standardlife.ca** as a domain name.⁹ The fact of this domain name registration by the Complainant contradicts the claim that the Registrant has registered its domain name with the effect, and thus for the

¹ This list was generated using the webnames.ca site at <http://www.webnames.ca>. On that page click on "Transfer Services" in the right column. On the next page click on "Transfer of a .CA Domain". On the next page under "Registrar Transfer" enter the dot-ca domain name, in this case **standard-life.ca**, and click on "Transfer". The next page shown will, apparently, list not just the owner of the standard-life.ca domain name (in this case Paul Morin), but other (all?) dot-ca domain names owned by that same owner.

² The word "Sharpie" and design is a registered trademark of Sanford for marking and writing pens, TMA152068.

³ TMDA055268.

⁴ TMA277281.

⁵ TMA163615.

⁶ <http://www.royalpage.ca/>.

⁷ TMA430385.

⁸ *Trade-Marks Act*, s. 9(1)(n)(iii) prohibited mark, application 0914738, advertised 2003-04-09.

⁹ Similarly, in relation to the list of the other domain names registered by the Registrant, Coca-Cola has registered coke-cola.ca; Videotron has registered vedeotron.ca; Shoppers Drug Mart has registered [shoppersdrugmart.ca](http://wwwshoppersdrugmart.ca); Royal LePage has registered royalpage.ca; Walmart had registered [walmart.ca](http://wwwwallmart.ca); and Radio-Canada has registered [radio-canada.ca](http://wwwradio-canada.ca);

purpose¹⁰, of preventing the Complainant from registering its trademark or trade name as a domain name.

The Registrant's practice of registering domain names which differ from well known trademarks or trade names merely by the insertion of a hyphen or the alteration of a letter or two could be described as a practice of registering domain names which are, in the terms of the Policy, Confusingly Similar with such trademarks. However, as Policy para. 3.7(b) is worded such a practice cannot be found to constitute the required Bad Faith under that paragraph.

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. [emphases added]

Purpose

Para. 3.7(c) requires the Panel to make a finding about the Registrant's purpose in registering the domain name. A logical, reasonable and long-standing element of legal decision-making is that inferences about an actor's intentions can be drawn from the effect of the action, particularly when the effect is a reasonably foreseeable result of the action. When there is evidence of the Registrant's manner of actual use of the registered domain name, as in this case, it is reasonable to infer that the Registrant's actual use of the domain name informs us as to the Registrant's purpose in registering that domain name. When the Registrant submits no Response to the Complaint, and thus no direct testimony about the Registrant's actual intent, the Panel is left with no alternative but to draw inferences about the Registrant's intent from the foreseeable consequences of the Registrant's actions in registering that domain name and in the Registrant's use of that domain name.

Disrupting

"Disrupting" is not expressly defined in the Policy. The ordinary dictionary meaning of "to disrupt" is to "interrupt the normal continuity of (an activity etc.)"¹¹ Using a domain name which is Confusingly Similar to a Complainant's Mark, causing would-be customers who were seeking the Mark owner's web site to be confused into locating the Registrant's web site, at which site there are links to web sites of competitors of the Mark owner, raises the prospect that business may be diverted from the Mark owner to competitors of the Mark owner as a result of the original deception or confusion created by the Registrant's use of the Confusingly Similar domain name. This constitutes disrupting the Mark owner's business under the ordinary meaning of "to disrupt".

Some uncertainty might arise about the meaning of "disrupting" in Policy, para. 3.7(c). This uncertainty could reflect the fact that the Policy as a whole appears to have been derived, though

¹⁰ The only evidence of the Registrant's purpose in registering the domain name would be inferences as to that purpose drawn from the foreseeable effects of that registration. As the effect of the domain name registration was not to deny the Complainant's registration of its trademark and trade name as a domain name, it would be unreasonable to infer that the Registrant's purpose was to prevent the Complainant from registering its trademark or trade name as a domain name.

¹¹ *New Shorter Oxford English Dictionary*, 1997, electronic edition.

with important modifications, from the ICANN *Uniform Dispute Resolution Policy* (“UDRP”). The parallel provisions in the UDRP which define a domain name Registrant’s necessary Bad Faith, UDRP paras. 4.b.(i),(ii) and (iii), have essentially the same three definitions of “Bad Faith” as Policy paras. 3.7(a),(b) and (c). The UDRP includes para. 4.b.(iii): “[the Registrant has] registered the domain name primarily for the purpose of disrupting the business of a competitor”, which closely parallels the Policy para. 3.7(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.”.

The uncertainty in interpreting the Policy might arise because the UDRP definition of “Bad Faith” includes a fourth express definition of Bad Faith which does not appear in the Policy. That fourth definition of Bad Faith in the UDRP is: “using the domain name . . . [to create] a likelihood of *confusion* with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the Registrant’s] web site . . . or of a product or service on your web site . . .” [emphasis added].¹² In the UDRP context, the interpretational approach to “Bad Faith” might be that since causing confusion is expressly covered by the fourth definition of Bad Faith, then “disrupting” in the third definition of Bad Faith must mean something other than causing confusion.¹³ However, in the context of the Policy, this interpretational approach is not applicable, there being no express inclusion of a causing-confusion-test of Bad Faith in the Policy.

Further, the purpose of the Policy is to protect the owners of established trademarks and trade names against unfair and unreasonable predation by others’ registrations of domain names Confusingly Similar with those trademarks or trade names. Five hundred years of legal consideration of the misuse of trademarks and trade names has focused on causing confusion as the paradigm instance of such misuse. Thus, though the Policy may be clumsily drafted in this regard, the Panel must interpret “disrupting” as including the causing of trademark and trade name confusion.

In this case, the Registrant’s use of its Confusingly Similar domain name with web sites featuring links to sites offering products in competition with the Complainant constitutes “disrupting” the Complainant’s business in the form of causing classic trademark or trade name confusion.

Competitor

To succeed in showing the Registrant’s Bad Faith the Complainant must establish that the Registrant is a *competitor* of the Complainant. The Complaint made the following submission:

In the *Glaxo* Dispute Resolution Decision¹⁴, a broad interpretation of disrupting a Complainant’s business which includes “someone who acts in opposition to another, including competing for

¹² This, of course, is confusion which is the core of the common law passing off tort, and of the protection of trademarks under the *Trade-marks Act* cf. ss. 7(b), 20, 2 “confusing”, and 6.

¹³ Thus, in the UDRP context, “disrupting” may be interpreted to cover activities such as those prohibited by the Canadian *Trade-Marks Act*, s. 7(a): “No person shall (a) make a false or misleading statement tending to discredit the business, wares or services of a competitor”, which is a statutory extension of the common law torts of slander of title and injurious falsehood. *S&S Industries v. Rowell* (1966), 48 C.P.R. 193 (SCC).

¹⁴ CIRA Dispute 0020, *Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)* concerning the domain name *zyban.ca*.

Internet users and that there is no requirement that the Registrant be a commercial business competitor or someone that sells competing products". The Registrant becomes a competitor of the Complainant by redirecting Internet users through hyperlinks to websites offering insurance quotes and other types of insurance services, possibly from one of the Complainant's direct competitor.

In the view of the Panel, this statement must be qualified or understood in the context of this statement interpreting Policy para. 3.7(c) "competitor" in earlier CIRA domain name dispute decisions:

It is difficult to conceive that the "competitor" in paragraphs 3.7(a) . . . could be simply "one who acts in opposition to another" without any requirement that the [domain name registrant] be a commercial business competitor of the Complainant or someone that sells competing products.¹⁵

In this case, the registrant is not itself a direct business competitor of the Complainant (the registrant is not in the business of providing insurance services to insureds). However, the Registrant does use the Confusingly Similar domain name on a site which contains links directly to the web sites of competitors of the Complainant where the competitors are offering insurance products in competition with the Complainant. The web site which the Registrant operates at the disputed domain name features these links under the heading "Sponsored Links". A reasonable inference is that the Registrant receives compensation for featuring these links on its web site.¹⁶ The Registrant is a joint venturer in selling competing products with the enterprises located at the links on the Registrant's web site. The Registrant is acting as a competitor of the Complainant for the purposes of Policy para. 3.7(c).

Conclusion on Bad Faith

For the foregoing reasons, the Panel finds that the Complainant has satisfied the burden imposed upon it to prove that the Domain Name was registered in bad faith.

c) Legitimate Interest

The Complainant has the burden of providing some evidence that "the Registrant has no legitimate interest in the domain name as described in paragraph 3.6". Paragraph 3.6 stipulates that the Registrant has a Legitimate Interest in a domain name "if, and only if" the Registrant has one or more of the six specific interests set out in subparas 3.6(a) to (f).

The Complaint, in the view of the Panel, aptly summarizes why the Registrant must be found to have no Legitimate Interest in the domain name.

The Complainant submits that under paragraph 3.6 of the Policy, the Registrant has clearly no "Legitimate Interest" in the domain name, **standard-life.ca** since:

- a) the Registrant has never used the domain name as a Mark in good faith with any wares, services of business and the Registrant has clearly no rights in the Mark;
- b) the domain name was not clearly descriptive of the character, quality, condition or place of origin for the Registrant's wares, service or business;
- c) the domain name is not understood in Canada to be a generic name thereof in any language;
- d) the Registrant has never used the domain name in association with a non-commercial activity;

¹⁵ *Trans Union LLC v. 1491070 Ontario Inc.*, CIRA Dispute No. 0008 and *The Toro Company v. Pierre Hannon*, CIRA Dispute No. 0039.

¹⁶ A dictionary definition of "to sponsor" includes: "[to] contribute to or bear the expenses of (an event or performer), esp. in return for advertising", *New Shorter Oxford Dictionary*, 1997, electronic edition.

- e) the domain did not and does not comprise the legal name of the Registrant or was not the name, surname or other reference by which the Registrant was promptly identified; and
- f) the domain name is not the geographical name of the location of the Registrant's non-commercial activity or place of business.

Conclusion

The Complainant has satisfied the burden of proof in establishing Confusing Similarity, Bad Faith, and no Legitimate Interest necessary to succeed in the Complaint.

Order

For the reasons set out above, the Panel grants the relief requested by the Complainant, and orders that the registration of the domain name be transferred to the Complainant.

Date: November 16, 2005

Signed

Denis N. Magnusson, Sole Panel Member