

**CANADIAN INTERNET REGISTRATION AUTHORITY  
DOMAIN NAME DISPUTE RESOLUTION POLICY**

**COMPLAINT**

Dispute Number: DCA-885-CIRA  
Domain Name: tdvisa.ca  
Complainant: The Toronto-Dominion Bank  
Registrant: TM WatchDog  
Registrar: DomainAtCost Corp.  
Panel: Michael D. Manson  
Service Provider: British Columbia International Commercial Arbitration Centre

**DECISION**

**A. THE PARTIES**

1. The Complainant is The Toronto-Dominion Bank, Toronto-Dominion Centre, Post Office Box 1, Toronto, Ontario, M5K 1A2, Canada.
2. The Registrant is TM WatchDog, Keith Stewart, 77 Pine Street, Sudbury, Ontario, T3C 1X2, Canada.

**B. THE DOMAIN NAME AND REGISTRAR**

3. The domain name at issue is tdvisa.ca. The domain name is registered with DomainAtCost Corp.

**C. PROCEDURAL HISTORY**

4. The Complainant submitted this complaint to the British Columbia International Commercial Arbitration Centre as service provider in respect of the *CIRA Domain Name Dispute Resolution Policy* of the Canadian Internet Registration Authority (CIRA). The Service Provider served notice of the complaint to the Registrant as required by *CIRA Rules*, paragraph 4.3. No response to the complaint was received from the Registrant. The Complainant elected to have the complaint heard by a single panellist as permitted under paragraph 6.5 of the *CIRA Rules*. The Service Provider selected Michael Manson as the single panel member for this complaint.

**D. PANEL MEMBER IMPARTIALITY AND INDEPENDENCE STATEMENT**

5. As required by the *CIRA Rules*, paragraph 7.1, I, Michael Manson, have declared to the provider that I can act impartially and independently in respect of this matter as there are no circumstances known to me which would prevent me from so acting.

**E. BASIS FOR DECIDING THE COMPLAINT**

6. Since the Registrant has not submitted a response to the complaint, paragraph 5.8 of the *CIRA Domain Name Dispute Resolution Rules* applies, namely that the panel shall decide the proceeding on the basis of the Complaint filed.

**F. FACTUAL BACKGROUND**

7. The BCICAC has certified that the Complainant has complied with the formal requirements of the CDRP under the *Resolution Rules*.
8. The BCICAC has certified and I accept that it has complied with the provisions of the CDRP and the *Resolution Rules* in attempting to deliver the complaint to the Registrar and provided the documentation of delivery attempts by courier and e-mail to this effect. Pursuant to paragraph 2.6 of the *Resolution Rules*, the Registrant is deemed to have received the complaint and Respondent has failed to respond to the complaint.
9. The materials submitted by the Complainant shows that the Complainant satisfies CIRA's Canadian presence requirement for registrants, being a bank chartered under the laws of Canada and the owner of a number of Canadian Trade-mark Registrations containing the element TD, as set out in paragraph 9 of the Complaint.
10. The evidence submitted also establishes, both on the face of the trade-mark registrations relied on by the Complainant and through the Schedules attached to the Complaint, that the trade-mark has been used in Canada by the Complainant since at least as early as 1969 on baking, securities, real estate and computerised data processing services and since the 1970's and 1980's on a variety of other services including insurance services and automotive and travel services. The Complainant has spent hundreds of millions of Dollars in advertising and promoting its TD trade-marks and generated billions of Dollars in revenues using the TD trade-marks (paragraph 13 of the Complaint). I accept that the extensive use and widespread advertising of the TD trade-marks by the complainant has resulted in the TD trade-marks becoming very well known throughout Canada, well before the Registrant's registration of the domain name tdvisa.ca.
11. The Registrant has registered a .ca domain name "tdvisa.ca" (the "Domain Name"), which makes use of the Complainant's registered trade-mark TD and also makes use of the trade-mark VISA owned by Visa International Service Association, which has been licensed to be used by the Complainant since before the Registration of the Domain Name tdvisa.ca. The Registrant's website makes use of the Domain Name tdvisa.ca as the title for the main page and, based on the evidence submitted by the Complainant, gives the impression that the website is associated or connected with the Complainant, or at least authorised by the Complainant in respect of use of the Complainant's TD trade-mark. Further, as shown in Schedules F and G to the Complaint, the Registrant's use of the tdvisa.ca. Domain Name is

such that it provides links directly to competitors of the Complainant, including the Bank of Montreal, CIBC Bank and ICICI Bank.

12. The Complainant has submitted that, firstly, tdvisa.ca is confusingly similar to the Complainant's TD trade-marks as used in association with Visa International's VISA trade-mark, which has been licensed to TD to be used as a "co-branded" trade-mark. I find that, notwithstanding one should not dissect a trade-mark when considering likelihood of confusion, that nevertheless the Registrant's use of the Complainant's TD mark in association with the Visa International VISA mark, is confusingly similar to both the Complainant's TD trade-marks and the Complainant's TD marks when used in association the licensed VISA mark. I am able to come to this conclusion, in part, having regard to the amendments to the *Trade-marks Act* made in 1993 that specifically permit a licensee to institute an infringement action under the *Trade-marks Act* in respect of licensed rights provided in respect of registered trade-marks.
13. I also accept that the likelihood of confusion is increased when the trade-mark at issue is well-known, as is the TD mark in this case.

*Coca-Cola Co. v. Garry Skaggs Co. and Garry Skaggs*, Case No. D-200-1806, July 11, 2001
14. The Complainant also alleges that the Registrant has no legitimate claim or interest in the domain name, as described in paragraph 3.6 of the *Policy*.
15. For the reasons submitted by the Complainant's agent in this regard, namely, that the Registrant has no rights in the trade-mark in Canada, the domain name is not clearly descriptive, is not a generic name, it is not a name or surname of the Registrant, or a geographical name, and given that the domain name links to a site offering competitors' products for sale, I find that there is no evidence that the Registrant had or has a legitimate interest in the domain name, as set out in paragraph 3.6 of the *Policy*, which would constitute a legitimate interest of the Registrant in the domain name.
16. The Complainant has also established, on a balance of probabilities, that the Registrant has registered the domain name in bad faith. Not only has the Registrant registered the domain name for the purpose of directing potential customers of the

Complainant to a website that advertises and offers for sale competing products of competitors, but the Registrant has, at least on one other occasion, registered a domain name that contains or is comprised of a registered trade-mark of another.

*Canadian Broadcasting Corporation/Société Radio-Canada v. William Quon*, Case No. 0006.

*Glaxo Group Ltd. v. Defining Presence Marketing Group Inc. (Manitoba)* BCICAC, Case No. 00020

While I am not prepared to consider a single instance of a registrant registering a trade-mark of another party as a “pattern” of conduct, the fact that the Registrant has done so in at least one other case, combined with the clear and convincing evidence that the Registrant has registered the domain name tdvisa.ca primarily for the purpose of disrupting the business of the Complainant, by directing potential customers of the complainant to a website that advertises and offers for sale competing products of competitors, I find that bad faith has been established.

17. Furthermore, I find that any person encountering the domain name tdvisa.ca would conclude that the Registrant’s business, products and/or services was either a business of the Complainant or at least endorsed, sponsored or approved by the Complainant. Accordingly, the Complainant’s business reputation would be put at risk by the Registrant’s business conduct in making use of the domain name tdvisa.ca.

*I.O.F. v. Norendu (Forester College of Technology)*, CIRA  
Dispute Resolution Case 00017

## **G. CONCLUSION/DECISION**

18. The Complainant has proven, on a balance of probabilities, that the domain name tdvisa.ca is confusingly similar to the Complainant’s registered TD trade-marks and the Complainant’s TD trade-marks when used in association with the licensed trade-mark VISA, in which the Complainant had rights prior to the date of registration of the domain name and the Complainant continues to have such rights. The Complainant has also produced evidence that the Registrant has no legitimate interest in the domain name and has proven on a balance of probabilities that the Registrant acted in bad faith, pursuant to paragraph 3.7 of the *Policy*. For all these reasons, the Complainant is successful. However, the Complainant has requested that the registration for the tdvisa.ca domain name be transferred to the Complainant. I find that I cannot make such an Order, given that the domain name makes use of both the Complainant’s TD registered trade-mark(s) and Visa International’s registered trade-mark VISA, in which Complainant has no ownership. I also find no evidence that would permit the Complainant to have a transfer of the VISA trade-mark, as part of any licensed right from Visa

International Service Association. Accordingly, the Panel orders and directs that the registration of tdvisa.ca be cancelled by the Registrar DomainAtCost Corp.

Dated at Vancouver, British Columbia, Canada, this 15<sup>th</sup> day of December, 2005.

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Michael D. Manson  
Sole Panel Member