

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

Domain Name: PRE-PAIDLEGALSERVICESINC.CA
Complainant: PPL Legal Care of Canada Corporation
Registrant: Curtis Patey
Registrar: Tucows.com Co.
Panelist: Teresa Scassa
Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant is PPL Legal Care of Canada Corporation (PPL). PPL was incorporated under the laws of Nova Scotia in 1999. Its corporate headquarters are at 1100-1959 Upper Water Street, Halifax, Nova Scotia. PPL is a wholly owned subsidiary of Pre-Paid Legal Services Inc. (PPLSI). PPLSI is an American company incorporated in 1976, and currently listed on the New York Stock Exchange.

2. The Registrant for the domain name is listed as Curtis Patey. A 'whois' search on CIRA's website lists a British Columbia address for the Registrant.

B. The Domain Name and Registrar

3. The disputed domain name is pre-paidlegalservicesinc.ca. The Registrar for the domain name is Tucows.com Co. The disputed domain name was registered on April 20, 2005.

C. Procedural History

4. On March 7, 2006 the Complainant filed a complaint against the Registrant with Resolution Canada Inc, requesting that the current registration of the domain name pre-paidlegalservicesinc.ca be cancelled and that the domain name be transferred to PPL.

Resolution Canada served notice of the Complaint to the Registrant as required by paragraph 4.3 of the *CIRA Domain Name Dispute Resolution Rules [Rules]*. Service of the Complaint was made by courier. However, the package containing the Complaint, which was sent to the Registrant at the address listed in the 'whois' database, was refused on the basis that there was no such person living at the address. Another copy of the Complaint was sent to an alternate address provided by the Complainant. This copy was also returned. The Registrant has not responded to the Complaint.

5. The Complainant PPL requested that, should the Registrant fail to respond to the Complaint, the dispute be decided by a single panelist. By email dated April 4, 2006 I was named by Resolution Canada, Inc. as the Panel for this arbitration. Pursuant to paragraph 5.8 of the *Rules*, I will decide this proceeding on the basis of the Complaint.

D. Panelist Impartiality and Independence

6. As required by paragraph 7 of the *Rules* I have submitted to the Provider a declaration of impartiality and independence in relation to this dispute.

E. Canadian Presence Requirements

7. The Complainant, PPL is a company incorporated under the laws of Nova Scotia. As such, it meets the Canadian Presence Requirements under paragraph 2(d) of the *CIRA Canadian Presence Requirements for Registrants*, Version 1.3.

F. Factual Background

8. The Complainant provides pre-paid legal services plans. The standard plan benefits include coverage for preventive legal services, motor vehicle legal defence services, trial defence services and tax audit services. The plans also offer a discount on legal services not specifically covered by the plan. Actual legal services are provided by participating law firms.

9. The Complainant's relationship with its U.S. based parent company is relevant to this dispute. PPL is a wholly owned subsidiary of PPLSI, which was first formed in 1976, and which is a U.S. based corporation. PPLSI, the parent company, owns U.S. Trade-mark No. 1168829 for PRE-PAID LEGAL SERVICES & DESIGN. Neither PPL or PPSI owns a registered trade-mark in Canada.

10. The Complainant discloses that PPLSI has two domain name registrations for its U.S. based websites: www.pplsi.com (since 1996) and www.pre-paidlegal.com (since 1999).

11. The Registrant, Curtis Patey, registered the disputed domain name pre-paidlegalservicesinc.ca on April 20, 2005. At the time, the domain name allegedly resolved to a web site which featured a header with the words "Pre-Paid Legal Services, Inc." and information about various pre-paid legal service plans. The Complainant

provided copies of printouts from this site. It should be noted that the domain name printed on the bottom of each page of the printouts is <http://www.acebenefitsyou.com/>. There is no longer an active website at that domain name, and the domain name pre-paidlegalservicesinc.ca currently resolves only to a blank page.

12. The Complainant also provided copies of two online newspaper articles. One is from TheDenverChannel.com, dated September 22, 2004. This article reports that an arrest warrant was issued for one Arthur Curtis Patey. This individual allegedly engaged in fraudulently selling pre-paid legal services. A similar report appears in another article provided by the Complainant from the Commerce City Beacon, dated October 6, 2004.

13. In addition to the two newspaper reports from the United States, the Complainant provided a letter from an independent associate of PPL, Carolyn Schmidt, to the U.S. parent company, PPLSI on August 10, 2005. The letter reported that Ms. Schmidt had received a complaint from a Mr. Querido who had purchased a pre-paid legal service plan from a Curtis Patey, who had held himself out to be the CEO and Chairman of Pre-Paid Legal Services. Mr. Querido never received the services offered and allegedly had to close his bank account to stop withdrawals by Mr. Patey. The Complainant provided a copy of a cheque written on the account of a Don Querido and made out to "Patey Group".

14. The Complainant also provided a photocopy of a business card featuring the name A. Curtis Patey, CEO/Chairman under the heading Pre-Paid Legal Services, Inc. The card listed an address and contact information in Alberta. Also furnished was a brochure advertising pre-paid legal service plans under the name Pre-Paid Legal Services, Inc. and providing the same mailing address as appeared on the business card. I note that these brochures list the domain name pre-paidlegal.ca, which is not the disputed domain name.

G. *CIRA Domain Name Dispute Resolution Policy* Requirements

15. Paragraph 3.1 of the *CIRA Domain Name Dispute Resolution Policy* (CDRP) requires that the Complainant establish 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;

(b) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6; and

(c) the Registrant has registered the domain name in bad faith as described in paragraph 3.7.

16. According to paragraph 4.1 of the CDRP, the Complainant must establish elements (a) and (b) above on a balance of probabilities. The Complainant must also

provide “some evidence” that the Registrant has no legitimate interest in the domain name.

H. Analysis

Confusingly Similar to a Mark in which the Complainant had Rights

17. In order to succeed with the Complaint, the Complainant must first establish that “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.” (CDRP, sub-para. 3.1) The CDRP contains definitions of each of the terms “Mark”, “Rights” and “Confusingly Similar.”

18. The definition of “Mark” is found in sub-paragraph 3.2 of the CDRP. The only part of that definition that is relevant to this dispute is part (a), which reads:

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; [emphasis added]*

The other sub-paragraphs deal with certification marks, Canadian registered trade-marks and marks governed by s. 9(1)(n) of the *Trade-Marks Act*. None of these are relevant here.

19. The facts of this case raise the unusual circumstance where the Complainant is not the owner of the Mark in dispute. PRE-PAID LEGAL SERVICES, INC has not been used as a trade name by the Complainant, Pre-Paid Legal Care of Canada Corp. A trade-name is defined in the *Trade-marks Act* as “the name under which any business is carried on, whether or not it is the name of a corporation, a partnership or an individual.” PRE-PAID LEGAL SERVICES, INC. is the trade-name of the U.S. incorporated parent company; it is not the trade-name of the Complainant in this dispute.

20. The Complainant claims that it has used the mark PRE-PAID LEGAL SERVICES, INC. in Canada since 1999. In particular, the Complainant claims that “PPL makes extensive and prominent use of the Mark on its promotional material, such as its CD-ROM videos and brochure pamphlets.” Photocopies of several brochures and the CD-ROM printed material were included as appendices to the complaint. I will provide a brief description of how the mark is ‘used’ on each of these printed documents.

a) *IdentityTheft Shield* Brochure. This brochure features a cover, with inside pages containing information about this legal services plan. One page of the brochure features the following information in small print: “Marketed by: PPL Legal Care of

Canada Corp.” The company name is bolded. Also in small print are the words: “For more information, please contact your PPL Legal Care of Canada Independent Associate”. The copyright notice on this brochure is 2005, and indicates that PPL is the owner of copyright. The words “Pre-Paid Legal Services, Inc.” do not appear anywhere on this brochure, and I find that there is no use of the Mark on this brochure.

b) *Legal Empowerment for your LIFE* Brochure. This brochure features a cover, with inside pages containing information about this legal services plan. The back of the brochure features the following text: “brought to you by PPL Legal Care of Canada Corporation”. The company name is in bold font. Underneath, in small italicized font, it reads: “a subsidiary of Pre-Paid Legal Services Inc.” with the address of the U.S. parent corporation. The copyright notice below is dated 2004, and indicates that Pre-Paid Legal Services, Inc. is the owner of copyright in the brochure.

c) *Balance of Power* DVD. The back of the DVD cover features a heading on the left side in small font: “Contracts issued by:” Below is a list of companies. The first item in the list reads: “Pre-Paid Legal Services ®, Inc. and subsidiaries”. It is followed by a list of subsidiaries in various states of the United States, and, near the bottom of the list, PPL Legal Care of Canada Corporation. The copyright notice on this DVD cover is 2005. I find that use of the Mark “Pre-Paid Legal Services, Inc.” on this DVD is by PPLSI and not PPL.

21. The Complainant also notes that its parent company PPLSI holds domain name registrations for www.pplsi.com and www.pre-paidlegal.com, and that “[i]nformation relating to the legal service plans offered by PPLSI and PPL are outlined on the website operated at the above URLs.” The Complainant further alleges that the Mark PRE-PAID LEGAL SERVICES, INC. “is prominently displayed throughout the website.” Copies of the web site pages from www.pre-paidlegal.com were provided in an appendix. On the copies provided the site does prominently use the mark. The site also makes frequent references to services provided throughout North America, and there are references to Canada. I did not find any specific reference to the Complainant PPL. I find that any use of the mark PRE-PAID LEGAL SERVICES, INC. on the websites operated by the parent company is use of the mark by the parent company, and not by the Complainant.

22. The Complainant alleges that it has used the Mark in the following terms: “PPL and its parent company PPLSI have used the Mark for the purpose of distinguishing its wares and services from the wares and services of other businesses.” This sentence is indicative of the way in which the corporate identities of the two companies appear to be fused in the Complaint.

23. On my reading of the CDRP, the fact that PRE-PAID LEGAL SERVICES, INC. is the trade-name of a company other than the Complainant is not fatal to the Complaint. This is because of the particular wording of sub-paragraphs 3.2 and 3.3 of the CDRP. I note that sub-paragraph 3.2 does not require that the Mark be used in Canada by the *Complainant*, simply that it be used in Canada “by a person...for the purpose of distinguishing the wares, services or business of that person”. Based on the facts

discussed above, I find that PRE-PAID LEGAL SERVICES, INC. is a “Mark” within the meaning of sub-paragraph 3.2 in that it is a trade-name that has been used in Canada by PPLSI for the purpose of distinguishing its services from those of others.

24. The Complainant is also required to establish that it has rights in the mark, as set out in sub-paragraph 3.3 of the CDRP. To have rights in the mark, the Complainant must show that the mark was either “used in Canada by that person. . . or a licensor of that person”.

25. I find that the Complainant, PPL, has not used the trade-name PRE-PAID LEGAL SERVICES, INC. in its own right in Canada. However, I do find that PPLSI has used this trade name in Canada for the purposes of distinguishing its services from those of others. I also find that PPLSI is a licensor of PPL. As a result, according to my interpretation of sub-paragraph 3.3 of the CDRP, the Complainant has rights in the Mark because the Mark has been used in Canada by a licensor of the Complainant.

26. As the Mark PRE-PAID LEGAL SERVICES, INC. is virtually identical to the disputed domain name pre-paidlegalservicesinc.ca, I find that the Registrant’s domain name is Confusingly Similar to the Mark in which the Complainant has rights.

Registrant has No Legitimate Interest in the Mark

27. Under sub-paragraph 4.1(c) of the CDRP, the Complainant must provide some evidence that “the Registrant has no legitimate interest in the domain name”. The Complainant has satisfied this burden of providing some evidence that the Registrant had no legitimate interest in the Mark, as defined in sub-paragraph 3.6 of the CDRP. Indeed, the Complainant provided evidence that the Registrant’s interest was not legitimate, and that the domain name was being used as part of a scheme to deceive individuals into purchasing non-existent legal services plans.

Registration in Bad Faith

28. The exclusive bases for a finding of bad faith registration are set out in sub-paragraph 3.7 of the CDRP. Sub-paragraph 3.7(c) is particularly relevant here. It allows for a finding of bad faith registration where:

- (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.

29. The Complainant provided evidence that the Registrant used the domain name to attract persons seeking pre-paid legal service plans to its web site. This deception or passing off could be found to constitute bad faith in the context of competition between two legitimate businesses. In this case, the deception was aggravated by the fact that

there was evidence that the confusion was being created between PPLSI and an apparently fraudulent business.

30. As noted above, the evidence provided by the Complainant does not directly establish that the disputed domain name was used “primarily for the purpose of disrupting the business of the . . . Complainant’s licensor . . . of the Mark, who is a competitor of the Registrant.” The web pages provided by the Complainant indicate that they come from a web site with the domain name www.acebenefitsyou.com. Nevertheless, the Complainant has provided enough evidence of bad faith actions by an individual named Curtis Patey in relation to its business and that of PPLSI to satisfy me, on a balance of probabilities, that the domain name pre-paidlegalservicesinc.ca, which was registered by Curtis Patey, was registered in bad faith. I am satisfied, on a balance of probabilities, that the disputed domain name was registered for the purpose of disrupting the business of the Complainant, and that the Registrant was “competing” with the Complainant for the attention of persons seeking pre-paid legal service plans.

I. *Conclusion and Decision*

31. In conclusion, I find that the Complainant has rights in the Mark, which is the trade name of PPLSI. I find that the disputed domain name is Confusingly Similar to the Mark, that the Registrant had no Legitimate Interest in the Mark, and that he registered the Mark in bad faith.

32. I therefore order, pursuant to paragraph 4.3 of the CDRP that the registration of the domain name pre-paidlegalservicesinc.ca be transferred to the Complainant PPL Legal Care of Canada Corporation.

Dated April 24, 2006

Teresa Scassa

Teresa Scassa
April 24, 2006