

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

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**Domain Name:** CASEWARE.CA

**Complainant:** Caseware International Inc., c/o Mr Alan Charlton  
**Registrant:** Mr John Lee  
**Registrar:** Tucows.com  
**Panelist:** Mr David Lametti  
**Service Provider:** Resolution Canada

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**DECISION**

**A. The Parties**

1. The Complainant is Caseware International Inc. (“Caseware” or “Complainant”), a business corporation registered under the laws of Ontario, with its corporate headquarters at 145 King Street East, Toronto, Ontario, M5C 2Y8. The Complainant is represented by Mr Alan Charlton. Caseware was first incorporated under the name WK Information Systems Ltd, and that name was changed in 1998 to Caseware. The Complainant satisfies Canadian presence requirements under s. 2(q) of the Policy.

2. The Registrant is Mr John Lee. His registered address is 2045 Lakeshore Blvd. W. Suite 2603, Toronto, Ontario, M8V 2Z2.

**B. The Domain Name and Registrar**

3. The domain name at issue is < CASEWARE.CA >. The domain name is registered with Tucows.com.

**C. Procedural History**

4. The Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, Resolution Canada. The Provider served notice of the Complaint to the Registrant as required by paragraph 4.3 of the *CIRA Domain Name Dispute Resolution Rules* [“Rules”], and proof of service was provided. No Response to the Complaint was received from the Registrant. The Provider selected the panelist according to the process outlined in the Rules.

**D. Panel Members’ Impartiality and Independence Statements**

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

## **E. Factual Background**

6. The facts of this dispute are as follows. Caseware International is the registered owner of the registered Canadian trademark CASEWARE registered on 20 October 1999 for wares described as “computer software for preparing trial balances and workpapers for financial statements and associated manuals” and services described as “assistance in use of computer software in preparing trial balances and workpapers for financial statements”. The Complainant’s primary product is called “Caseware Working Papers”, an auditing and bookkeeping package that produces financial statements. The product has significant penetration in the Canadian market, and the complainant also sells directly in the US. It sells its products in Europe, Asia, Australia and Africa via distributors.

7. It had previously owned the domain name in dispute for eleven years, and is currently associated with nine other similar domain names with different TLDs. The Complainant had used the domain name in association with its website, wares and services for a period of eleven years. Due to a mistake (incorrect contact information) and a maternity leave of the person responsible for domain management, the domain name was allowed to lapse in 2006. The lapse was detected in May 2006 and an attempt to re-register was made shortly thereafter on May 18, at which point the domain was listed as available. A subsequent error was made by the Complainant in the re-registration process, whereby an email by the registration authority requesting a confirmation of information was mistaken for a confirmation that the name had been reserved.

8. By the time the Complainant detected the second error, the Registrant had successfully registered the domain name with a different service provider. As used by the Registrant, the domain name resolved to a website showing competing products. (Complainant’s Evidence, Schedule E)

9. An attempt by the Complainant to speak with the Registrant by telephone on 26 June 2006 resulted in the Registrant asserting that he had ‘other clients’ who were interested in the name, but without naming them. When pressed, the Registrant hung up and a subsequent telephone call only minutes afterwards went unanswered.

10. The Complainant then proceeded to initiate this complaint with this dispute resolution provider. The Provider served the Registrant electronically as well as by courier at his known address, on 5 July 2006. He refused to receive by courier and did not respond to the Complaint.

## **F. CIRA Domain Name Dispute Resolution Policy Requirements**

11. The *CIRA Domain Name Dispute Resolution Policy* [“Policy”] sets out at paragraph 4.1 what the Complainant must establish in order to successfully prove the complaint:

To succeed in the Proceeding, 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.

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name . . .

## **G. Is the Registrant's Domain Name Confusingly Similar to the Complainant's Mark?**

### **1) The Complainant's Marks**

12. Paragraph 3.2 of the Policy includes the following in the definition of what constitutes a "mark" for the purposes of the Policy:

A "Mark" is:

(a) a trade-mark . . . or a trade name that has been used in Canada . . . for the purpose of distinguishing the wares, services or business of that person . . . from the wares, services or business of another person; [and]

(c) a trade-mark . . . that is registered in CIPO . . .

13. The Complainant has shown evidence of its current ownership of the registered mark CASEWARE in Canada.

### **2) "Confusingly Similar"**

14. Paragraph 3.4 of the Policy defines "confusingly similar" in the following terms:

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.

15. Regarding < CASEWARE.CA >, discounting as one should the .ca portion of the domain name, the CASEWARE mark is identical to the disputed domain name.

16. The fact that the domain name had been used by the Complainant for eleven years further strengthens the link between the registered mark and the domain name. Moreover, the other registered domain names used by the Complainant are identical to

the domain name in question, again discounting the TLDs: .com, .info, .biz, .cn, .us, .co.uk, etc.

17. Finally there is no evidence on the record that shows that the domain name was generic in any sense – rather it has a high level of fancy or uniqueness – or that it was used in a manner by the Respondent that attempted to dispel confusion or otherwise distinguish the use of the domain name from the Complainant’s mark, the Complainant’s wares and service offered. Indeed, the opposite conclusion can be inferred by looking at the Respondent’s website to which the domain name resolved.

18. Interpreting “confusingly similar” under the Policy, the Panel finds that the Registrant’s domain name < CASEWARE.CA > is confusingly similar to the Complainant’s mark.

#### **H. Was the Registration of the Domain Name Made in Bad Faith?**

19. In order to succeed, the Complainant must show, on the balance of probabilities, that the Registrant registered the domain name in bad faith. Like the ICANN UDRP, the inquiry into bad faith in the Policy requires making findings on what one might consider to be the subjective behaviour of the Registrant. The Policy, however, unlike the UDRP, has expressly and purposely adopted a restricted definition of “bad faith”. Paragraph 3.7 of the Policy states that the Registrant will be considered to have registered the domain name in bad faith, if and only if one of the following three conditions is met:

(a) the Registrant registered the domain name . . . primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant [or others related to or competing with the Complainant] for valuable consideration in excess of the Registrant’s actual costs in registering the domain name . . . ;

(b) the Registrant registered the domain name . . . in order to prevent the Complainant [or others related to the Complainant] from registering the Mark as a domain name, provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names; or

(c) the Registrant registered the domain name . . . primarily for the purpose of disrupting the business of the Complainant, or the Complainant’s licensor of licensee of the Mark, who is a competitor of the Registrant.

20. On the facts and evidence adduced in this dispute two of the three tests may be applicable: subparagraphs 3.7 (a) and (c).

21. First, the Registrant is alleged to have violated subparagraph 3.7 (a), that is, it has “registered the domain name . . . primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant [or others related to or

competing with the Complainant] for valuable consideration in excess of the Registrant's actual costs in registering the domain name . . . ”

22. There is some evidence on the record that the Registrant by his admission was interested in selling the name to other interested parties. Given the uniqueness of the name and its previous use over a long period by the Complainant, it is indeed a fair inference based on the Registrant's conduct, based always on common sense, that these 'other clients' are competitors of Caseware. Further, when one takes into account that the website was used by the Registrant to point to competitors of Caseware, this too points to the ultimate motives of the Registrant. Finally, it is also fair to infer from the Registrant's apparent unwillingness to disclose a good faith motive to the Complainant when asked over the telephone, and avoiding a subsequent attempt at telephone contact, that the Registrant was not likely acting in good faith.

23. Second, the Registrant is alleged to have violated subparagraph 3.7 (c), that is, of having registered the domain name "primarily for the purpose of disrupting the business of the Complainant", who is also a competitor of the Registrant. This disruption is not the normal disruption that one associates with the usual dictates of business practice in a competitive market; rather, it is a disruption whose deleterious effects are the primary purpose of the Registrant.

24. CIRA Policy, subparagraph 3.7(c) requires more than that the *effect* of the Registrant's registration and use of the domain name disrupt the business of its Complainant competitor. The Panel must be able to find that the *primary purpose* of the Registrant in registering that domain name was to disrupt the business of Complainant competitor.

25. This inquiry allows me to examine the conduct of the Registrant after the registration to infer his motives. Previous decisions under the CIRA Policy have considered that re-directing internet traffic to the websites of competitors, absent other considerations such as the furnishing of legitimate information on a service-oriented website, did in fact constitute a bad faith attempt to disrupt the business of the mark-holder:

The Complainant submitted that the "a Registrant's purpose in registering a disputed domain name should be determined by common sense inferences from the Registrant's conduct and other surrounding circumstances".<sup>11</sup> The Panel finds that it is reasonable to infer the Registrant's intention in registering a domain name from the use to which the Registrant puts the domain name after registration. The Registrant used the Confusingly Similar domain name on a web site that was dominated by links to mattress and bedding retailers who might compete for business with the Complainant. The adverse impact on, or disruption of, the Complainant's business from the Registrant so using the Confusingly Similar domain name should have been obvious to the Registrant. I infer that this intention was formed by the Registrant as the domain name was first registered. Further, the dominant use on that web site of links to businesses competing with the Complainant supports the further inference that the Registrant registered the

domain name “primarily for the purpose of disrupting the business of the Complainant”. [*Sleep Country Canada Inc. v. Pilfold Ventures Inc.*, CIRA Dispute 00027, March 14, 2005 at para 21.]

This is on all fours with the current facts. In the instant matter, a glance at the website leads to the reasonable conclusion that this re-direction seems to have been the only discernable, clearly primary, purpose of the registration, and the registrant clearly knew what he was doing. There appears to be nothing but competitors listed. Moreover, the inference made above under subparagraph 3.7(a) also applies here: given the uniqueness of the name and its previous use over a long period by the Complainant, it is indeed a fair inference based on the Registrant’s conduct, based always on common sense, that the Registrant was targeting Caseware and simply and merely attempting to re-direct internet traffic away from it.

26. Finally, as noted above under subparagraph 3.7(a), once again it is also fair to infer from the Registrant’s apparent unwillingness to disclose a good faith motive to the Complainant when asked over the telephone, and his apparent avoiding a subsequent attempt at telephone contact, that the Registrant was not likely acting in good faith.

27. The Panel therefore concludes that the Registrant did indeed register the domain name < CASEWARE.CA > in bad faith under subparagraphs 3.7 (a) and (c) of the Policy.

### **I. Does the Registrant Have a “Legitimate Interest” In the Domain Name?**

28. The final element of the test set out in the Policy is to determine whether or not the Registrant has a legitimate interest in the domain name. Paragraph 3.6 of the Policy states:

The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint was submitted

- (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 used 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 used 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.

29. This definition is restrictive – only the interests listed in subparagraphs (a) through (f) below can be considered legitimate interests. In terms of procedure the Complainant must provide some evidence that none of these interests applied to the Registrant. The burden would then shift to the Registrant to show that it has, on the balance of probabilities, any one of these legitimate interests as defined under these subparagraphs.

35. The Complainant has asserted that the Registrant has no legitimate interest. It has, on the common sense interpretation of the facts, argued that the Registrant does not have any rights in the mark [subparagraph 3.6(a)], that the domain name is not the official or common trade name of the Registrant [subparagraph 3.6(e)], and that the Registrant does not provide any wares or services clearly described by the mark [subparagraph 3.6(b)]. The mark is not a generic term [subparagraph 3.6(c)] or a geographical name [subparagraph 3.6(f)]. Nor is the Registrant's use a good-faith non-commercial use [subparagraph 3.6(d)] as understood in the Policy: the use made in this case of pointing to competitive sites is highly commercial as a purpose, and absent any other explaining factors is clearly its primary purpose.

36. The Panel therefore concludes that the Complainant has borne its burden of showing some evidence that the Registrant did not have a legitimate interest in the domain name < CASEWARE.CA > under paragraph 3.6 of the Policy. As the Registrant has declined to respond to these contentions and show a legitimate interest in the contested domain name, the Panel concludes that the Registrant had no legitimate interest in the domain name at issue.

## **K. Conclusion and Decision**

37. The Complainant has established on the balance of probabilities that the Registrant's domain name < CASEWARE.CA > is confusingly similar to the Complainant's mark.

38. The Complainant has established on the balance of probabilities that the Registrant had registered the domain name < CASEWARE.CA > in bad faith, as defined in the Policy.

39. The Complainant has provided some evidence that the Registrant has no legitimate interest, as defined in the Policy, in the domain name < CASEWARE.CA > and the Registrant, in not responding, has provided no evidence to the contrary.

40. For these reasons, the complaint regarding the domain name < CASEWARE.CA > is successful.

**Disposition**

41. The Registrar is hereby ordered to transfer the domain name to the Complainant.

Dated 20 August 2006,

David Lametti

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David Lametti  
20 August 2006