

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

---

Case number: DCA-1038-CIRA  
Disputed Domain Name: **rapidrefund.ca**  
Complainant: HRB Royalty, Inc.  
Registrant: 4083121 Inc. (Taxman)  
Registrar: Tucows.com  
Service Provider: B.C.I.C.A.C.  
Panel: James E. Redmond Q.C., FCI Arb

---

**Panel Decision**

**1. Parties and Disputed Domain Name**

The Complainant is HRB Royalty, Inc. whose address is P.O. Box N-8220, Suite 101, TK House, Bayside, Executive Park, West Bay Street and Blake Road, Nassau, Bahamas. The Complainant's authorized representative is the firm of Berkowitz Oliver Williams Shaw & Eisenbrandt LLP, 2600 Grand Boulevard, Suite 1200, Kansas City, Missouri, 64108.

The disputed domain name is **rapidrefund.ca**. The Registrar with whom the domain name is registered is Tucows.com, 96 Mowat Avenue, Toronto, ON Canada M6K 3M1.

**2. Procedural History**

This is a dispute resolution proceeding initiated under the CIRA Dispute Resolution Policy (the "Policy") and the CIRA Domain Name Dispute Resolution Rules (the "Rules"). By registration of the domain name with the Registrar, the Registrant agreed to the resolution of certain disputes pursuant to the Policy and the Rules.

As set out by the Service Provider, the British Columbia International Commercial Arbitration Centre, the history of this proceeding is as follows:

- (a) The Complainant filed a Complaint against the Registrant with respect to the above referenced domain name in accordance with the Policy on December 13, 2006. The Complaint was reviewed by the Service Provider and was found to be in administrative compliance with the Policy and Rules. The Service Provider forwarded a copy of the Complaint to the Registrant on December 13, 2006 by Express Post and email, in accordance with the Rules. A hard copy of the Complaint was also sent by courier to the Complainant and delivery was confirmed by FedEx.
- (b) The Registrant has not provided a Response.
- (c) The Complainant elected under Rule 6.5 to convert from a panel of 3 to a single arbitrator.
- (d) The single arbitrator has delivered to the Service Provider an Acceptance of Appointment and a Statement of Independence and Impartiality in conformity with the Rules.

The Claimant has provided evidence to show that the Complaint is an Eligible Complaint under Rule 1.4 by filing a copy of the Certificate of Registration and additional documentation which establishes that the Complainant is the owner of the trademark "Rapid Refund", and related marks containing this phrase, registered as number TMA509,858 with the Canadian Intellectual Property Office.

The Panel finds that it was properly constituted and appointed, and that all procedural requirements for the commencement and maintenance of this proceeding were met, in accordance with the Policy and the Rules.

### **3. Facts**

As set out in the Complaint, the Complainant is one of the "H & R Block family of companies" which "collectively make up the largest provider of individual income tax preparation services in Canada and the United States and also provide other tax services internationally." H & R Block opened its first franchised operation in Canada in 1964 and its first company-owned operation in 1965. Today, H & R Block Canada Inc. prepares two million tax returns annually, making its Canada's leading tax preparation firm. H & R Block is in the primary business of preparing tax returns for consumers through office locations operated by the H & R Block family of companies and/or their franchisees and through proprietary tax preparation software. H & R Block additionally provides electronic filing, monthly bookkeeping support, and small business accounting for its customers. Entities within the H & R Block family also provide personal financial planning, mortgage services and banking services. H & R Block, Inc., Complainant's ultimate parent company, is a Fortune 500 company and is currently listed on the New York Stock Exchange as "HRB".

The Complainant further states that “Complainant, itself and through its direct and indirect licensees, has used and owned the “Rapid Refund” trademark and related marks (the “Marks”), since at least 1986 in connection with H &R Block’s tax services business.”

The Complainant provided as an annex to the Complaint screenshots of the **rapidrefund.ca** website which begin with the words “TAXMAN - Halifax’s Tax Authority” and that show that “TAXMAN” offers to provide general tax information and services related to tax preparation.

The Complainant states that it discovered the Respondent’s offending domain name through a reverse “whois” search and that it sent a “cease and desist” letter to the Respondent notifying it that it was violating the Complainant’s trademark, demanding that it cease using the domain name at issue, and that it transfer the domain name to the Complainant. ANNEX 5 to the Complaint is a copy of an email to “ask the taxman at hotmail.com” dated August 4, 2007. This email states that it had come to the sender’s attention that the addressee was using the website associated with the domain name **rapidrefund.ca** to market services in direct competition with those offered by HRB Royalty, Inc. and its affiliates and demanding that the addressee immediately cease and desist using the domain name and transfer ownership of the domain name to HRB Royalty Inc.

ANNEX 6 to the Complaint, on the letterhead of H & R Block, was sent to the Respondent on October 11, 2007, requesting that the Respondent immediately cease and desist using the offending domain name and immediately transfer ownership of it to HRB Royalty, Inc. The Complainant says that it has not received any response from the Respondent.

#### **4. Discussion and Reasons**

Paragraph 3.1 of the Policy provides as follows:

##### **3.1 Applicable Disputes**

The Registrant must submit to a Proceeding if a Complainant asserts in a Complaint submitted in compliance with the Policy and the Resolution Rules 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.

Assertions to the above effect are contained in the Complaint.

The onus of proof to be met by a Complainant in order to obtain relief is set out in paragraph 4.1 as follows:

#### 4.1 Onus

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 ...

**Confusingly Similar.** The Complainant's registered trademark **Rapid Refund** constitutes a "Mark" under paragraph 3.2 of the Policy. The Complainant and its affiliates have used that Mark in Canada before the registration of the disputed domain name, and continue to use it. Considerable effort and extensive expenditures have been made to market the Mark and the attendant tax services offered in connection with the Mark and related Marks in Canada and the United States and around the world. The Respondent's domain name is identical to the Complainant's Mark except for the punctuating dot and the letters ca.

Paragraph 1.2 of the Policy provides that "domain name" means the domain name excluding the "dot-ca" suffix. Cases decided under the Policy, such as *Coca-Cola Ltd. v. Hennan*, case number 14, *Government of Canada v. Bedford*, case number 11, and *Biogen, Inc. v. Xcalibur Communication*, case number 3, have held that the dot-ca suffix is to be disregarded in determining confusing similarity.

Accordingly, I find that the disputed domain name, **rapidrefund.ca** is Confusingly Similar to the Claimant's registered Canadian Trade Mark **Rapid Refund**.

**Bad Faith.** In the absence of a Response from the Respondent, the Panel is directed by Rule 5.8 to decide the Proceeding on the basis of the Complaint. The Complainant submits that, as stated by the Panel in the *Coca-Cola* case "[t]he Registrant's purpose in registering the Domain Name may be determined by common sense inferences from the Registrant's conduct and other surrounding circumstances." It goes on to submit that given the similarity between the domain name and the Complainant's Trade Mark, a presumption must be made that the Respondent was obviously aware of the existence of the Complainant and its Marks at the time it registered the domain name. The Complainant further submits that the registration of the domain name constitutes an intentional attempt to attract, for commercial gain, internet users to the Registrant's website and that this creates "a likelihood of confusion with Complainant's Mark as

to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location. The Complainant also points to the Respondent's lack of any answer to the cease and desist letters sent to the Respondent by the Complainant.

Paragraph 3.7 of the Policy reads as follows:

### **3.7 Registration in Bad Faith**

For the purposes of paragraph 3.1(c), a Registrant will be considered to have registered a domain name in bad faith if, and only if:

- (a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the registration;
- (b) the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, 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 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.

Subparagraphs (a) and (b) of paragraph 3.7 do not apply, on the basis of the facts before the Panel in this case. However, it has been held in previous cases that a Registrant disrupts the business of a competitor if it offers goods or services that compete with, or rival, the goods or services offered by the trademark owner. *Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)*, case number 20; *Sotheby's (Canada) Inc. v. PII Technologies Inc. and Keith Lihou*, case number 26; *General Motors Acceptance Corporation v. Bob Woods*, case no. 51.

As established by the evidence tendered by the Complainant, the Respondent carries on a business which competes directly with the H & R Block companies, and a person going to the Respondent's "**rapidrefund.ca**" website will see material promoting the Respondent's competing services. In the circumstances, I conclude that it is reasonable to make the inference that the Respondent, whose business competes directly with the Complainant's, was aware of the Complainant's Mark and that the Respondent acted in bad faith by attempting to use that trade mark to the Respondent's commercial benefit by registering the disputed domain name. The

basis for making this inference is strengthened by the failure of the Respondent to provide any response to the Complainant's cease and desist letters or to the Complaint itself. While the Respondent is under no obligation to respond or to provide any explanation, it is open to the Panel to draw an appropriate inference from that silence.

The Panel therefore concludes on the balance of probabilities, that the Respondent registered the disputed domain name in bad faith within the meaning of paragraph 3.7(c).

**Legitimate Interest.** Under section 4.1 of the Policy, the onus on the Complainant is to provide "some evidence" that the Registrant has no legitimate interest in the domain name as described in paragraph 3.6. None of the criteria for a legitimate interest in a domain name set out in paragraph 3.6 apply in this case with the possible exception of subparagraph (b). However, that paragraph begins with the requirement that the Registrant used the domain name "in good faith". While "good faith" in this paragraph is not necessarily the precise converse of "bad faith" in paragraph 3.7, the considerations which apply to a determination of bad faith under paragraph 3.7 in this case appear to be equally applicable to a determination as to whether the Respondent acted in good faith under paragraph 3.6 in registering the domain name. Making the same reasonable inference, that the Respondent, given his involvement in a business competing directly with the Claimant, was aware of the Complainant's trademark, one is led to the conclusion that most probably the reason for the registration of the domain name was to trade on and take commercial benefit from the use of the Claimant's long-standing trademark. Again, the lack of any explanation from the Respondent is significant.

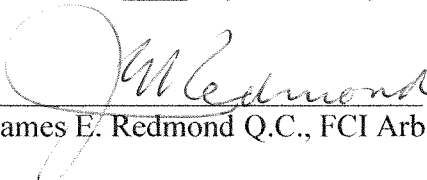
The Panel therefore concludes that the Respondent has no legitimate interest in the domain name **rapidrefund.ca**.

## 5. Conclusion and Decision

The Complainant has proven, on a balance of probabilities that the domain name **rapidrefund.ca** 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 that the Registrant registered the domain name in bad faith as described in paragraph 3.7 of the Policy. The Complainant has adduced some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.6, and the Registrant has not proven, on a balance of probabilities, that it has a legitimate interest in the domain name.

For these reasons, the Complaint is successful and the Panel orders and directs that the registration of **rapidrefund.ca** be transferred to the Complainant.

DATED this 21 day of January, 2008

  
James E. Redmond Q.C., FCI Arb