

CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY

DECISION

Domain Name: manulifedenial.ca
Complainant: The Manufacturers Life Insurance Company
Registrant: Jan Fishman
Registrar: Go Daddy Domains Canada, Inc.
Service Provider: Resolution Canada Inc.
Panel: Peter C. Cooke (chair), Myra Tawfik, Teresa Scassa

THE PARTIES

The Complainant is The Manufacturers Life Insurance Company (the “Complainant”) with an address at 200 Bloor Street East, Toronto, Ontario, M4W 1E5.

The Registrant is Jan Fishman (the “Registrant”) with an address at Fishman Lawyers, 1781 – 808 Nelson Street, Vancouver, British Columbia, V6Z 2H2.

THE DOMAIN NAME AND REGISTRAR

The subject of this proceeding is the domain name manulifedenial.ca (the “Domain Name”), registered on December 7, 2015. The Registrar of the Domain Name is Go Daddy Domains Canada, Inc.

PROCEDURAL HISTORY

This is an administrative dispute resolution proceeding pursuant to the Canadian Internet Registration Authority (“CIRA”) *Domain Name Dispute Resolution Policy* (version 1.3) (the “Policy”) and the CIRA *Domain Name Dispute Resolution Rules* (version 1.5) (the “Rules”). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of this dispute pursuant to the Policy and the Rules.

According to the information provided by Resolution Canada Inc., the dispute resolution service provider, the history of the proceeding is as follows:

The Complainant filed a complaint (the “Complaint”) dated March 18, 2016 with Resolution Canada Inc., requesting that the Domain Name registration be transferred from the Registrant to the Complainant. After having determined that the Complaint was in administrative compliance with the requirements of the Policy and the Rules, Resolution Canada Inc. commenced the dispute resolution process and served notice of the Complaint on the Registrant (as required by paragraph 4.3 of the Rules) by email on March 21, 2016. A response was received from the Registrant dated March 30, 2016.

As required by paragraph 7.1 of the Rules, the panellists have declared to Resolution Canada Inc. that they can act impartially and independently in this matter, as there are no circumstances known that would prevent them from so acting.

PROCEDURAL ISSUES

On April 22, 2016 and again on May 6, 2016, the Panel received unsolicited correspondence from the Complainant’s counsel requesting permission to submit Additional Submissions.

Paragraph 1.1 of the Policy explains that the purpose of the Policy is to provide a forum in which cases of bad faith registration of dot-ca domain names can be dealt with “relatively inexpensively and quickly”.

Consistent with the stated purpose of the Policy, the Rules contemplate that, in most cases, the complainant and the respondent will each have only one opportunity to submit evidence and argument. Paragraph 11.1 of the Rules specifies the limited circumstances in which the parties may submit additional evidence or argument. It reads, in relevant part, as follows:

Further Submissions. *In addition to the Complaint and the Response, the Panel may request, in its sole discretion, further evidence or argument from either of the Parties. Unless the Panel makes such a request, neither Party shall have the right to submit additional evidence or argument except that if the Response contains a claim for costs under paragraph 4.6 of the Policy, the Complainant may respond to the claim in less than one thousand (1000) words within five (5) days after receipt of the Response.*

In response to both requests the Panel determined that it would not invite either party to submit further evidence or argument. Accordingly, the Complainant's requests were refused.

ELIGIBILITY OF COMPLAINANT

The Complainant satisfies Paragraph 2(d) of the CIRA *Canadian Presence Requirement for Registrants*, as the Complainant is "a corporation under the laws of Canada or any province or territory of Canada".

OVERVIEW OF THE POLICY

Paragraph 4.1 of the Policy sets forth the Complainant's burden of proof in order to succeed in the proceeding. The onus is on the Complainant to prove, on a balance of probabilities 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; and

The Registrant has registered the domain name in bad faith as described in paragraph 3.5;

And the Complainant must provide some evidence that:

The Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

COMPLAINANT'S POSITION

The Complainant contends as follows:

The Complainant is the owner of registrations for the trademark MANULIFE in Canada, and has been using the MANULIFE trademark extensively in Canada for over 125 years. The Domain Name is confusingly similar to the MANULIFE registered trademark which the Complainant had rights in prior to the date of registration of the Domain Name, and continues to have rights.

The Complainant contends that the Registrant registered and is using the Domain Name in bad faith because the Registrant registered the Domain Name or acquired the registration primarily for the purpose of selling the registration to the Complainant for valuable consideration in excess of the Registrant's actual costs in registering the Domain Name. The Complainant also alleges that the Registrant registered the Domain Name primarily for the purposes of disrupting the business of the Complainant, and further alleges that the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website by creating a likelihood of confusion with the Complainant's Mark.

The Complainant contends that the Registrant has no legitimate interest in the Domain Name, as the Registrant is seeking to trade on the Complainant's trademark for his own commercial gain.

THE REGISTRANT'S POSITION

In support of his position that there is no confusion in the present case, the Registrant relies on the decision in *Insurance Corporation of British Columbia v. Stainton Ventures Ltd.*, in which the domain name icbcadvice.ca was not found to be confusing with the official mark ICBC.

The Registrant denies each of the grounds set out in 3.5 of the Policy that might demonstrate bad faith.

The Registrant is a lawyer actively involved in representing injured persons with claims against the Complainant. The Registrant takes the position that the decision of the Supreme Court of British Columbia in *McMyn v. The Manufacturers Life Insurance Company* confirmed that the Registrant has a legitimate interest in acting for individuals with lawsuits against the Complainant. The Registrant takes the position that it is the Complainant that is interfering with the Registrant's practice, and that the Complaint was not made in good faith.

DISCUSSIONS AND FINDINGS

Confusing Similarity between the Domain Name and the Complainant's Mark

In order to satisfy this branch of the test, the Complainant must demonstrate (i) that it has rights in a mark, (ii) that the rights in its mark predate the registration date of the Domain Name, and (iii) that the mark is confusingly similar with the disputed Domain Name.

As the owner of registrations in Canada for the trademark MANULIFE the Complainant has demonstrated that it has rights in a mark. The Complainant's trademark registrations for MANULIFE issued to registration prior to the registration date of the Domain Name. Therefore the Panel can conclude that the Complainant's rights in the trademark predate the registration of the Domain Name. The Complainant's evidence confirms that the Complainant continues to have rights in the MANULIFE trademark.

As per paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if the domain name so nearly resembles the mark in appearance, sound or in the ideas suggested by the mark so as to be likely to be mistaken for the mark. In applying this definition, it is important to note paragraph 1.2 of the Policy which stipulates that: "For the purposes of this Policy domain name means the domain name excluding the dot-ca suffix..."

The test to be applied when considering whether a mark and domain name are "confusingly similar" is one of first impression and imperfect recollection. The Complainant must prove, on a balance of probabilities, that a person, as a matter of first impression, knowing the Complainant's mark MANULIFE, and having an imperfect recollection of this mark, would likely confuse the Domain Name manulifedenial.ca for the Complainant's mark based upon the appearance, sound or the ideas suggested.

In this case, the Domain Name contains the Complainant's trademark MANULIFE combined with the word "denial". In support of its position that the trademark and Domain Name are confusing the Complainant has provided the Panel with precedents in the form of prior CIRA decisions where the domain names feature a registered trademark combined with additional wording. Confusion was found in these cases, despite the presence of the additional wording.

In support of the position that there is no confusion, the Registrant relies upon a decision of the British Columbia Court of Appeal in *Insurance Corporation of British Columbia v. Stainton Ventures Ltd.* which did not find the domain name icbcadvice.ca to be confusing with the official mark ICBC. However, the Panel cannot easily apply this decision to the present case. In assessing confusion, the Court of Appeal considered more than simply the question of whether the domain name so nearly resembled the mark as to be likely to be mistaken for it, for example commenting that it may be necessary to view a website to determine whose website it is. Further, there was evidence before that court that is not before this Panel, such as evidence of numerous active "ICBC -" domain names held by third parties.

The Panel acknowledges that there may be instances where a domain name features a trademark and additional wording, and the additional wording changes the context of the domain such that the mark and domain name are unlikely to be mistaken for one another. This is not the case here. In the present case it is not difficult to imagine a Manulife customer, faced with the Domain Name, mistakenly assuming that it leads to the Complainant's website, or a website authorized by the Complainant.

The Panel concludes that the Domain Name is confusingly similar with the Complainant's trademark, given that the Domain Name so nearly resembles the trademark in appearance, sound and in the ideas suggested so as to be likely to be mistaken for the mark.

The Panel thus finds that the Domain Name is confusingly similar with a trademark in which the Complainant had rights prior to the registration date of the Domain Name, and continues to have such rights.

Bad Faith Registration

The Complainant's position is that the Registrant registered and is using the Domain Name in bad faith pursuant to 3.5(a) of the Policy because the Registrant registered the Domain Name primarily for the purpose of selling the registration to the Complainant for valuable consideration in excess of the Registrant's actual costs in registering the Domain Name. The Complainant also alleges pursuant to 3.5(c) of the Policy that the Registrant registered the Domain Name primarily for the purposes of disrupting the business of the Complainant, and further alleges under 3.5(d) of the Policy that the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website by creating a likelihood of confusion with the Complainant's Mark.

With respect to the Complainant's first allegation, Paragraph 3.5 (a) of the Policy states that the following circumstance, if found by the Panel to be present, shall be evidence that a Registrant has registered the Domain Name in bad faith:

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.* (emphasis mine)

The Complainant provided evidence in the form of an apparently unsolicited letter from the Registrant dated January 7, 2016 offering to sell the Domain Name to the Complainant together with other ‘manulife’ domain names, for \$250,000. An offer to sell a domain name is not by itself evidence of bad faith. However, the requested \$250,000 would appear to far exceed the Registrant’s actual costs in registering the Domain Names.

It could be argued that the Domain Name was not acquired by the Registrant primarily for the purpose of selling it to the Complainant, as its acquisition was stated in the above letter to be part of a “re-tooling” of the Registrant’s business model to focus directly on actions involving Manulife Financial. However this does not explain why, if the Domain Name was important to the Registrant’s business going forward, the Registrant would make an unsolicited offer to sell it to the Complainant.

In the absence of a reasonable explanation from the Registrant, the Panel concludes that bad faith exists as per paragraph 3.5 (a) of the Policy. The Panel does not need to consider the other grounds for bad faith alleged by the Complainant, although it is noted that a finding of bad faith might have also been successful under 3.5 (c) of the Policy. The Panel finds that the Complainant has established that the Registrant registered the Domain Name in bad faith, pursuant to paragraph 3.5 (a) of the Policy.

No Legitimate Interest in the Domain Name

Paragraph 3.4 of the Policy requires that the Complainant must provide *some* evidence that the Registrant has no legitimate interest in the Domain Name. Once this onus has been discharged by the Complainant, the Registrant may still succeed if it can show, on a balance of probabilities, that it has a legitimate interest in the Domain Name pursuant to paragraph 3.4.

The Complainant has submitted that the Registrant has no legitimate interest in the Domain Name, as the Registrant seeks to trade on the Complainant’s trademark for his own gain.

From the evidence provided, the Domain Name re-directs to the Registrant’s website, such that anyone entering the domain name manulifedenial.ca is led to the website fishmanlawyers.ca. The Complainant’s evidence indicates that the Registrant has no authority to be using the Complainant’s MANULIFE trademark in this manner.

It then becomes incumbent on the Registrant to show that it has a legitimate interest in the Domain Name. The Registrant has provided in support the decision of the British Columbia

Supreme Court in *McMyn v. The Manufacturers Life Insurance Company* confirming that the Registrant has a right to act for individuals with lawsuits against the Complainant. However, this right does not extend to the right to use the Complainant's trademark as part of this enterprise.

In view of the above, the Panel must conclude that the Registrant has no legitimate interest in the Domain Name.

CONCLUSION AND DECISION

The Complainant has proven, on a balance of probabilities, that the 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 in which the Complainant continues to have such Rights.

The Complainant has proven, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith.

The Complainant has adduced some evidence that the Registrant has no legitimate interest in the Domain Name. The Registrant's Response did not legitimize the registration of the Domain Name.

For these reason, the Complaint regarding the Domain Name is successful.

ORDER

The Panel orders, pursuant to paragraph 4.3 of the Policy, the transfer of manulifedenial.ca to the Complainant.



Peter C. Cooke (Chair) for the Panel
Myra Tawfik, Teresa Scassa, Peter C. Cooke,
Dated: May 9, 2016