

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

Domain Name: WALLYTHOMPSON.CA

Complainant: Mr Wallace Thompson
Registrant: Mr Scott Hannah
Registrar: Go Daddy Domains Canada, Inc.

Panel: David Lametti (sole panelist)

Service Provider: ResolutionCanada

1. This decision was rendered in conjunction with the concurrent Complaint in *Giulia Ahmadi v Scott Hannah*. Both Complaints arose from the same set of interrelated facts and the same Registrant, and both Complaints were launched together. Large substantive parts of the argument advanced in the Complaints were identical or at least similar. Thus, while each case has been decided on its own merits, substantial parts of the reasons, given the same arguments and similar facts in each case, are also similar or identical.

DECISION

A. The Parties

2. The Complainant is Mr Wallace (“Wally”) Thompson. Mr Thompson is Vice-President Client Relationships & Business Development, Manulife Financial Affinity Markets, 2 Queen Street East, Toronto, Ontario M5C 3G7. Mr Thompson is represented by Ms LuAnne Morrow of Borden Ladner Gervais, 1900 – 520 3 Ave SW Calgary, Alberta, T2P 0R3.

3. The Registrant is Mr Scott Hannah. His address as provided to CIRA is 8040 Harvest Crescent, Niagara Falls, Ontario, L2H 3G6.

B. The Domain Name and Registrar

4. The domain name at issue is WALLYTHOMPSON.CA.

5. The domain name is registered with Go Daddy Domains Canada Inc.

C. Procedural History

6. On 19 December 2013, the Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, ResolutionCanada. The Complainant elected to have

the matter heard by a single-member panel. The Provider served notice of the Complaint to the Registrant as required by paragraph 4.3 of the *CIRA Domain Name Dispute Resolution Rules* (version 1.4) [“Rules”].

7. No response was received from the Registrant.

8. The Provider therefore moved to have the Complaint treated as uncontested, and appointed a panelist, all as governed by the Rules.

D. Panel Member Impartiality and Independence Statement

9. As required by paragraph 7 of the Rules, the panelist has declared to the Provider that he can act impartially and independently in this matter, as there are no circumstances known to him that would prevent him from so acting.

E. Canadian Presence Requirement

10. Wallace Thompson is a Canadian resident and thus satisfies the Canadian Presence Requirement as stated in paragraph 1.4 of the *CIRA Domain Name Dispute Resolution Policy* (version 1.3) [“Policy”].

F. Factual Background

11. Wallace Thompson is an insurance professional. He has been active, as per the evidence submitted, in association with management, marketing and business development services in the insurance industry in Canada since 1996. For business purposes he goes by both Wallace and Wally Thompson. He is currently Vice-President Client Relationships & Business Development at Manulife Financial Affinity Markets.

12. The Registrant had dealings with Manulife as a client and purchaser of their services. It is clear from various communications that the Registrant was unhappy with a particular decision take by Manulife as regards his file that allegedly cost the Registrant a sum of money, and while unhappy generally the company, appeared to have a particular focus on Mr Thompson for his personal response to the Registrant’s complaint.

13. The Registrant registered the domain name at issue on 3 October 2013.

14. Thompson became aware of the registration a short time later, around 9 October 2013, along with the registration of another domain, WALLYTHOMPSON.COM.

15. It is fair to say that correspondence between the Registrant and members of the Complainant’s firm Manulife are characterized by a variety of insinuations for how the Registrant planned to register the domain names such that the name and reputation of the company and Wally Thompson might be hurt, allegedly by others using the internet and search engines. It is also fair to say that a number of the threats had a personal tone.

16. The Complainant filed this Complaint on 13 November 2013.

G. CIRA Domain Name Dispute Resolution Policy Requirements

17. The *CIRA Domain Name Dispute Resolution Policy* (version 1.3) [“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 3.5;

and the Complainant must provide some evidence that:

- (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

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 . . .

18. The Panel will deal with each criterion in turn.

H. Is the Registrant’s Domain Name Confusingly Similar to the Complainant’s Mark?

19. The most important issue to be resolved is whether a personal name might be or might become the proper subject matter of this Policy.

20. 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 . . .

21. The Complainant works for a large insurance company that provides a variety of financial services and products. Manulife has its own trade name and trademarks that

embody its business goodwill and distinguish its services and products. There is no doubt that the Complainant benefits from the goodwill in that name and those marks. The question is whether the Complainant's own personal name (in its nickname form, Wally) has become a trade name or trademark in its own right such that it can be protected in turn under this Policy.

22. There is some question of whether a personal name as such might be protected. The wording of the Policy leaves open, and perhaps leads inexorably to, the conclusion that personal names do not acquire protection. The Policy speaks of trade names and trademarks, and not of personal names *simpliciter*. But I need not pronounce on this question.

23. Rather, what is in issue is a personal name that has become or developed into a trademark or trade name in and of itself. As a trademark, it has in effect acquired a secondary meaning in that it distinguishes the Complainant from others competing to provide the same kinds of services. It is clear from the evidence, that the Complainant has promoted his own name in this industry over a long period of time and while employed with three distinct companies within the industry. There appears to have been a great effort made to develop good will in his name, the name under which he is known in the industry and does business. To put in in current terms, the Complainant has developed, over a period of fifteen years, his "brand" through marketing, through a web presence and on social networks, through association with new products, services and business developments and through involvement with professional associations and at least one charity.

24. This accords with current practice and expectations in many professions in which professionals use personal names as their business identifiers, where these names and reputations go to distinguish the quality and nature of the professional services offered. The Complainant points out, rightly in my view, that the current climate in which much of this creation of good will, promotion, branding and such of professional reputations takes place within the context of social media and through the use of one's own name emphasizes the business name. Thus professionals themselves treat their personal names as trade names or trademarks.

25. In my view, the Complainant's evidence makes it clear that he has developed common law rights in the trademark WALLY THOMPSON over a marked period of time, and which is no longer simply his personal name but in effect is his trade name. It thus can in my view be brought safely under the auspices of the Policy.

26. We then move to a discussion of whether the registered domain name is confusing similar to the trademark. Paragraph 3.3 of the Policy defines "confusingly similar" in the following terms:

In determining whether a domain name is "Confusingly Similar" to a Mark, the Panel shall only consider whether 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.

27. In this case the domain name is effectively identical to the trademark, its two component words being the same as the two words of the trademark, and thus “confusingly similar” is established.

28. Thus the Panel finds that Registrant’s domain name WALLYTHOMPSON.CA is confusingly similar with the Complainant’s unregistered WALLY THOMPSON mark in which the Complainant had rights prior to the registration of the substantially similar domain name.

I. Was the Registration of the Domain Name Made in Bad Faith?

29. In order to succeed in the second stage of the test set out in paragraph 4.1, the Complainant must show, on the balance of probabilities, that the Registrant registered the domain name in bad faith. Paragraph 3.5 of the Policy states that the Registrant will be considered to have registered the domain name in bad faith, generally if one of the following four conditions is met:

For the purposes of paragraphs 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a 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;
- (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;
- (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; or

- (d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

30. I note that these criteria are not exhaustive by the explicit wording of the Policy. Other exemplars of bad faith are possible.

31. Paragraph 3.5(c) and (d) are most directly relevant to this dispute. The domain resolves to an adult website that displays adult or pornographic images. Under paragraph 3.5(c) it could be argued that the re-direction is for the purpose of disrupting the business of the Complainant. However, the wording of paragraph 3.5(c) seems to necessitate that the Registrant be a competitor of the Complainant or his licensor or licensee.

32. The better argument lies in paragraph 3.5(d), specifically confusion as to "sponsorship" or "affiliation". The Complainant has made the argument that such is the case in this instance, where the Registrant has linked the domain to a website that puts the goodwill of the Complainant in a bad light. The Complainant has, with reason in my view, argued that the Registrant has tarnished the trademark of the Complainant by associating it with the name. And, given the evidence of email exchanges with persons in the Complainant's company, has done so precisely with this goal in mind.

33. The challenge for the plaintiff is that in terms of Canadian trademark law, as set out in the Trade-Marks Act, the concepts of *confusion* or more precisely *likelihood of confusion* as to the source of the wares or services under s. 20 and *depreciation* or diminution (as to association, affiliation or endorsement), which would include a specific conception like tarnishing, under s. 22 are different legal standards. This distinction was articulated by the Supreme Court of Canada in the *Veuve Clicquot* case [*Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée*, [2006] 1 S.C.R. 824, 2006 SCC 23]. In my view, the Complainant has not sufficiently shown that the average internet user would be confused or would likely be confused in any way such that he or she think that the products or services offered on the adult website would be or could be from Wally Thompson of Manulife. In strict terms, I do not believe that the confusion standard can be met in this instance, eliminating paragraph 3.5(d).

34. Canadian trademark law does, however, independent of confusion include protection from depreciation of a trademark, and in my view the fact that the instantiations or categories are bad faith are not closed under paragraph 3.5 – they enumerate "circumstances, in particular but without limitation" – allows one to conclude that a deliberate attempt at depreciating a trademark is also a possible type of bad faith registration under paragraph 3.5. Depreciating the mark is certainly the more rare case than the usual damage to the mark through confusion, but in certain circumstances it can serve as evidence of bad faith.

35. As the *Veuve Clicquot* case noted, the independent concept of depreciation is difficult to define exactly, especially as distinct from confusion. The brand must be weakened, by association or affiliation or a presumed endorsement between the adult website and the Complainant or his business. On merely this basis, it is hard to derive that result in this case, from the perspective of the average internet user, who will presume something is amiss, but likely not much more than that. It is unlikely that the average user will see an affiliation or an endorsement, but rather an error.

36. However, the more limited conception of tarnishment, as a class of the larger concept of depreciation through association, is more easy to define and has found favour in US trademark cases in particular, as noted by the Canadian Supreme Court in *Veuve Clicquot*. It is the most easily identifiable category of depreciation, and most easily distinguishable from the confusion standard of s. 20 of the TMA.

37. Tarnishment is in my view applicable in this case. Whatever depreciation might be according the SCC in *Veuve Clicquot* in its fullest context it includes at least this: the mere association of legitimate services with those that many in the community, and perhaps many more in the target market for services, would find at least distasteful, if not offensive. Hence linking a person's business moniker to an adult website tarnishes that good will, lack of confusion regardless, for a large segment of the population.

38. Moreover, in this case there is clear and deliberate intent to inflict such damage on the Complainant. The Registrant on the evidence had had a dispute with Manulife and certain elements of service provided by them, as well as with the Complainant's personal response (or alleged lack thereof) to that situation. In the course of numerous exchanges or correspondence, provided in the evidence of the Complainant, the Registrant made it clear that the registration of the domain name was meant to and would cause harm to the Complainant, even if not necessarily by the Registrant's own actions.

39. The simple and stated intention to cause intentional harm to a trademark holder, coupled with tarnishment and the clear intent through actions to tarnish in my view is a type of bad faith consistent with the larger purposes of paragraph 3.5. This is bad faith pure and simple: the tarnishing action is undertaken for no other legitimate purpose, such as a legitimate critique of products or services. As such, at least this particular species of larger concept of depreciation – namely, tarnishment – undertaken for its own sake, suffices for a finding of bad faith registration under the Policy.

40. Therefore this Panel concludes that the Registrant acquired the domain name WALLYTHOMPSON.CA in bad faith as defined under both paragraph 3.5 of the Policy.

J. Does the Registrant Have a “Legitimate Interest” in the Domain Name?

41. The third element of the test set out in paragraph 4.1 of the Policy is to determine whether or not the Registrant has a legitimate interest in the domain name. This inquiry tries to find some more or less objective or ascertainable link between the Registrant and

the domain name in question, aside from mere registration, and which link is legitimate. Paragraph 3.4 of the Policy states:

For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in a domain name:

- (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 registered 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 registered 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.

In paragraph 3.4(d) "use" by the Registrants includes, but is not limited to, use to identify a web site.

42. The first four criteria contain an element of good faith in assessing the behaviour of the Registrant, while the last two point to more objective facts linking the domain name to the Registrant.

43. In terms of the procedure required under the Policy, the Complainant must provide some evidence that none of these or similar interests can reasonably apply to the Registrant. The burden then shifts to the Registrant to show that it has, on the balance of

probabilities, either any one of these legitimate interests as defined under these subparagraphs, or any other potential legitimate interests not so listed.

44. The Complainant has introduced sufficient evidence of the Registrant having no legitimate interest as exemplified under any of the enumerated heads. The Registrant has by his own words admitted to registering the domain solely for the purpose of making the Complainant vulnerable to some undetermined risks or dangers on the internet. And the explicit linking of the Complainant's name to adult websites indicates a desire to tarnish. Moreover, in terms of the Policy, the Complainant has not been able to identify any manner in which the Registrant might have a legitimate interest in the domain name. In particular:

- the domain name was not a trademark of the Registrant, and the Registrant had no good faith rights in the trademark;
-
- the Registrant was not using the domain name in good faith association with any wares or services;
- the Registrant is not operating any legitimate business which might give rise to circumstances where the registration of the domain might be considered legitimate;
- the Registrant is not using the domain name in good faith with a non-commercial activity, and cannot rely on the good faith exception for criticism as the sole intent was to tarnish the good will of the Complainant's trademark, and neither within the letter nor spirit of criticism, review or news reporting; and
- the domain name was not the name or surname of the Registrant, or otherwise associated with the Registrant, and was not linked geographically to any place of business.

45. The Complainant having thus satisfied its initial burden of showing "some evidence" of "no legitimate interest" puts the onus on the Registrant to show a legitimate interest.

46. The Registrant has not responded, and thus fails to meet its burden of showing any legitimate interest in the domain name.

47. The Panel therefore concludes that the Registrant did not have a legitimate interest in the domain name WALLYTHOMPSON.CA under paragraph 3.4 of the Policy.

K. Conclusion and Decision

48. The Complainant has established that the Registrant's domain name WALLYTHOMPSON.CA is confusingly similar to the Complainant's unregistered WALLY THOMPSON trademark that had been established by use in Canada.

49. The Complainant has established that the Registrant had registered the domain name WALLYTHOMPSON.CA in bad faith, as defined in the Policy.

50. The Complainant has provided some evidence that the Registrant has no legitimate interest, as defined in the Policy, in the domain name WALLYTHOMPSON.CA. The Registrant has not established, as required by the Policy, that it does have any legitimate interest.

51. For these reasons, the Complaint regarding the domain name WALLYTHOMPSON.CA is successful.

L. Remedy

52. The Complainant has asked that the domain name at issue be transferred to it. The Panel hereby so orders.

A handwritten signature in black ink, appearing to read "David Lametti", with a long horizontal flourish extending to the right.

David Lametti
Sole Panelist

March 17, 2014