CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number: TRA-030423-001011
Domain Name: transunion.ca
Complainant: Trans Union LLC
Registrant: 1491070 Ontario Inc.
Registrar: DomainsAtCost Corp.
Panellists: Hugues G. Richard
Service Provider: ResolutionCanada Inc.

DECISION

1. The Parties

Complainant is Trans Union LLC [hereinafter *Trans Union*], a corporation having a principal place of business at 555 West Adams Street, Chicago, Illinois, 60661, United States of America.

Registrant is 1491070 Ontario Inc. a corporation organised under the laws of Ontario with an address of 39 Howbert Drive, Toronto, Ontario, M9N 3L3.

2. The Domain Name and Registrar

The Domain Name at issue [hereinafter the *Domain Name*] is:

"transunion.ca"

The Registrar of the Domain Name is DomainAtCost Corp. with an address at 43 Auriga Drive, Nepean, Ontario, K2E 7Y8.

3. Procedural History

On February 28, 2003, **Complainant** filed a Complaint [hereinafter the *Complaint*] with respect to the Domain Name with ResolutionCanada Inc. [hereinafter the *Centre*].

The Panel believes it was constituted in compliance with the CIRA Domain Name Dispute Resolution Rules [hereinafter the *CIRA Rules*]. The panellist has completed an

Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.

The Panel has received no further submissions from either party since its formation.

The Panel is obliged to issue a decision on or prior to April 23, 2003 in the English language and is unaware of any other proceedings which may have been undertaken by the parties or others in the present matter.

4. Factual Background

The following uncontradicted and unchallenged facts appear from the Complaint and the documents submitted in support thereof:

The **Complainant** in this administrative proceeding, Trans Union, is a diverse corporation with a global presence that serves a broad range of industries including financial, banking and brokerage services, insurance providers, mortgage and real estate services, direct marketers and retailers, collection agencies, communication and energy companies and healthcare facilities.

The **Complainant** owns two registered trademarks in Canada for TRANS UNION [hereinafter the *TRANS UNION Marks*] in association with various wares and services, including, but not limited to, the wares and services listed below:

Trademark	Registration No.	Registration Date	Description of Wares and Services
TRANS UNION	TMA 197,053	January 25, 1974	**Wares:** • Pamphlets, booklets, brochures, reports and news releases. **Services:** • Conducting marketing surveys and arranging for the marketing of goods for others, and performing sales representative services. • Advising and counselling others on the distribution and marketing of their goods and managing the marketing or distribution of goods for others.
TRANS UNION	TMA 206,702	April 25, 1975	Services: • Credit reporting services

The TRANS UNION Marks are licenced for use in Canada to Trans Union's subsidiary, Trans Union of Canada, Inc.

The **Complainant** also owns the global transunion.com domain name.

According to the "WHOIS" databases on the CIRA and Domainatcost websites, the Domain Name was registered by **Registrant** on May 17, 2002.

No information has been provided regarding the **Registrant's** activities other than the fact that the **Registrant** operates a commercial website that offers subscription-based pornographic entertainment services at www.dvdera.com. This website makes no reference to the Domain Name nor to Trans Union, and according to the **Complainant**, is not in any way associated with Trans Union.

5. Parties' Contentions

Over and above the uncontested and unchallenged factual background as noted above, which is hereby incorporated herein by reference, it has been contended by:

A. Complainant

The Domain Name resolves to the **Registrant**'s www.dvdera.com website and that at various times it resolved to another of the **Registrant**'s websites www.smut-video.com. In other words, an Internet user that enters www.transunion.ca into its web browser is automatically redirected to www.dvdera.com. A copy of the web page the **Complainant** contends is displayed when the Domain Name is entered was provided as Schedule K. On April 19, 2003, the Panel took it *proprio motu* upon hitself to verify the website and notes that the website is now a blank white page with the following notice posted: "A Trans-sexual union for canadians coming soon. This website will feature an online dating site and promote the union of trans-sexual people within Canada (*sic*)".

The **Registrant**'s Domain Name is identical to and, therefore, confusingly similar to the TRANS UNION Marks in which Trans Union had rights by virtue of its trademark registrations more than 25 years prior to the date or registration of the Domain Name by the **Registrant** and continues to have such rights.

The **Registrant** has registered the Domain Name in bad faith because the **Registrant** acquired the registration primarily for the purpose of disrupting the business of Trans Union by diverting Internet users to the **Registrant**'s www.dvdera.com websites where the **Registrant** offers pornographic wares and services for sale.

The **Registrant** is a competitor of Trans Union because the **Registrant** is clearly acting in opposition to Trans Union in that the **Registrant** is competing with Trans Union for the attention of the Internet users.

The **Registrant** has no legitimate interest in the Domain Name because there is no connection between the Domain Name and the **Registrant**, the **Registrant**'s www.dvdera.com website, or the **Registrant**'s pornographic wares or services, and the **Registrant**'s use of the Domain Name does not satisfy any of the criteria for legitimate interest set ou in paragraph 3.6 of the CIRA Domain Name Dispute Resolution Policy [hereinafter the *CIRA Policy*].

B. **Registrant**

The **Registrant** has either chosen to abstain or has failed to file a timely response with the Center. No reasons were given to explain why no Response was provided within the stated period.

6. Discussion and Findings

Paragraph 4.1 of the CIRA 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:

(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;

A **Complainant** must also provide some evidence that:

(c) the **Registrant** has no legitimate interest in the domain name as described in paragraph 3.6.

Paragraph 4.1 of the CIRA Policy further provides that even if a **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 as described in paragraph 3.6. In other words, once the **Complainant** has met its evidentiary burden under sub-paragraphs 4.1 (a) and (b), the onus is shifted to the **Registrant** who must then prove, on a balance of probabilities, that he is making legitimate use of the domain name.

The three elements found in paragraph 4.1 must be proven cumulatively by the **Complainant** albeit with a different burden of proof imposed in sub-paragraph 4.1 (c) (legitimate interest).

These three elements are considered below.

Confusing Similarity

The Panel has reviewed the documentary evidence provided by the **Complainant** regarding its rights in the TRANS UNION Marks and finds that the **Complainant** has satisfactorily shown that it owned such rights prior to the date of registration of the Domain Name and that it continues to own such rights.

Paragraph 3.4 of the CIRA Policy provides a definition of the term Confusingly Similar. It requires a finding that the Mark at issue is likely to be mistaken for the domain name at issue because of the resemblance in "appearance, sound or the ideas suggested by the Mark". As such, the test is not one of confusion, as is normally found in Canadian trade-mark jurisprudence, but of resemblance.

In this case, given the fact that the two are identical, the Panel finds that the Domain Name is confusingly similar to the TRANS UNION Marks. The Panel notes paragraph 1.2 of the CIRA Policy that states that for the purpose of the Policy, a domain name does not include the "dot-ca" suffix.

The Panel is therefore of the opinion that the **Complainant** has met the burden of proof as established by sub-paragraph 4.1 (a) of the CIRA Policy.

Bad Faith

Pursuant to sub-paragraph 4.1 (b) of the CIRA Policy it is first incumbent upon the **Complainant** to prove, on the balance of probabilities, that the **Registrant** has registered the Domain Name in bad faith. Paragraph 3.7 of the CIRA Policy states that a **Registrant** will be considered to have registered the domain name in bad faith <u>if, and only if</u> the **Registrant** registered the domain for one of the purposes identified in sub-paragraphs 3.7 (a), (b) or (c) that state:

> 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;
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> (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**.

The **Complainant** relies on sub-paragraph 3.7 (c) to assert that the **Registrant** has registered the Domain Name in bad faith. More specifically, the **Complainant** contends that the use by the **Registrant** of the Domain Name is disrupting the **Complainant**'s business and that the **Registrant** is a "competitor" of the **Complainant**. The **Complainant**'s contention that the **Registrant** is a "competitor" is based on Uniform Domain Name Dispute Resolution Policy [hereinafter *UDRP Policy*] case law (see *Mission KwaSizabantu* v. *Benjamin Rost*, WIPO Case No. D2000-0279; *Estée Lauder Inc.* v. *estelauder.com, estelauder.net and Jeff Hanna*, WIPO Case No. D2000-0869) establishing that (i) a competitor is simply someone who acts in opposition to another, including competing for the attention of internet users and (ii) there is no requirement that the **Registrant** be a commercial business competitor, or that the parties sell competing products. The **Complainant** asserts, in support to its claim that the **Registrant** is a competitor, that the **Registrant** is attempting to entice its customers and potential customers to purchase the **Registrant**'s pornographic wares and/or services.

The Panel notes, however, that there has been disagreement amongst UDRP panels as to the breadth of the phrase "disrupting the business of a competitor". The decisions cited by the **Complainant** have indeed adopted a broad interpretation of the phrase holding, as indicated above, that a competitor is simply someone who acts in opposition to another, including competing for internet users and that there is no requirement that the registrant be a commercial business competitor or someone that sells competing products. However, a number of other decisions have rejected this broad interpretation and have favoured a narrow interpretation holding that a registrant can disrupt the business of a competitor only if it offers goods or services that can compete with or rival the goods or services offered by the trademark owner (see *Tribeca Film Center, Inc.* v. *Lorenzo Brusasco-Mackenzie*, WIPO Case No. D2000-1772; *Britannia Building Society* v. *Britannia Fraud Prevention*, WIPO Case No. D2001-0505).

After review of the referenced decisions, the Panel is of the opinion that the language found in paragraph 3.7(c) of the CIRA Policy must be given a narrow interpretation. The Panel agrees with the findings in *Tribeca Film Center, Inc.* v. *Lorenzo Brusasco-Mackenzie*, *supra*, that if paragraph 3.7(c) were given the interpretation advanced by the **Complainant**, registrants would be found to have disrupted the business of competitors in far too many cases, and the Policy's bad faith requirement would be diluted beyond recognition.

The Panel notes that paragraphs 3.7(a) of the CIRA Policy and 4(b)(i) of the UDRP Policy also make reference to a "competitor". The word "competitor" in those paragraphs should be given the same meaning as in paragraphs 3.7(c) and 4(b)(iii) of the

CIRA and UDRP Policies, respectively. It is difficult to conceive that the "competitor" in paragraphs 3.7(a) and 4(b)(i) could be simply "one who acts in opposition to another" without any requirement that the transferee be a commercial business competitor of the Complainant or someone that sells competing products.

Furthermore, it must also be noted that the CIRA Policy was adopted after the UDRP Policy. While the CIRA Policy and the UDRP Policy are similar in some respect, they do have important differences. For instance, paragraph 4(b) of the UDRP Policy concerning bad faith provides "circumstances […] without limitation" (emphasis added) which the Panel must consider to determine whether bad faith exists or not. The CIRA Policy in section 3.7 on the same subject is much more restrictive, i.e. the list of circumstances to be considered to determine bad faith is limited to those mentioned. In other words, there is no room under the CIRA Policy for a "broad" interpretation. As long as the CIRA Policy says what it says, the Panel is bound by its explicit limitations.

For the foregoing reasons, the Panel finds that the **Complainant** has not satisfied the burden imposed upon it to prove that the Domain Name was registered in bad faith.

No Legitimate Interest

In view of the Panel's finding that the **Complainant** has failed to demonstrate that the Domain Name was registered in bad faith, it is unnecessary for the Panel to address this issue.

7. Decision

For the foregoing reasons, the Panel concludes that:

- the **Complainant** has not satisfied its burden under section 4.1 of the CIRA Policy in that it has failed to prove, on a balance of probabilities, that the **Registrant** has registered the Domain Name in bad faith.

Consequently, the Panel denies the remedy sought in the Complaint.

Hugues G. Richard

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Sole Panellist

Dated: April 23, 2003