

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

Domain Name: www.mpslu.on.ca

Complainant: Simcoe Muskoka District Health Unit

Registrant: Rado Web Solutions Inc

Registrar: Arvic Search Services Inc

Panellist(s): Myra J. Tawfik

Service Provider: Resolution Canada

DECISION

1. The Parties:

The Complainant is the Simcoe Muskoka District Health Unit, a non-profit corporation incorporated under the authority of the Ontario *Health Protection and Promotion Act* RSO 1990 c. H.7 and administered by the Simcoe Muskoka District Board of Health. It is the successor in title to the Muskoka Parry Sound Health Unit.

The Registrant is Rado Web Solutions Inc. A WHOIS database search indicates the administrative contact as Radoslaw Ciepielowski and a postal address in Calgary, Alberta at Suite 280, 521 3rd Ave SW, Calgary, Alberta

2. The Domain Name and Registrar

The disputed domain name is www.mpslu.on.ca registered on April 13, 2006 and the Registrar is Arvic Search Services Inc, Suite 280, 521 – 3rd Ave SW, Calgary, Alberta

3. Procedural History

On September 27, 2007, the Complainant initiated a complaint with Resolution Canada under the Canadian Internet Registration Authority (CIRA) Dispute Resolution Policy

(CDRP) and the CIRA Domain Name Dispute Resolution Rules (the Rules) in which it requested the transfer of the domain name www.mpshu.on.ca. On October 11, 2007, the Complainant filed an Addendum on the Complaint whereby it requested that the Complaint be submitted for decision in accordance with the CDRP and the Rules.

Resolution Canada is an approved Dispute Resolution Service Provider under the CDRP.

Pursuant to Rule 5.1, the Registrant was notified by Resolution Canada that it had 20 days from October 12, 2007 to file 5 copies of a Response to the Complaint. The hard copy of the Complaint sent on October 12, 2007 by courier by Resolution Canada to the Registrant at the mailing address listed in the WHOIS database was returned by the courier with the notations “bad address” and “not here as per reception at suite 208”.

On October 29, 2007 a further attempt was made by Resolution Canada to reach the Registrant by e-mail at the e-mail address provided in the WHOIS database. Resolution Canada received no reply to this e-mail.

The Registrant did not file a Response within the stipulated delay.

On November 8, 2007, further to Rule 6.5, Resolution Canada appointed Myra J. Tawfik as sole panellist on the complaint after having received from her a declaration of impartiality and independence. A notice of selection of panellist was sent to all parties at that date.

As the Registrant has not responded to the Complaint, according to Rule 5.8, the Panel shall decide the proceeding on the basis of the Complaint.

4. Eligible Complainant

The Complainant is an eligible complainant under either of paragraphs 2(d) or 2(p) of the Canadian Presence Requirements for Registrants (2003) given that it is a non-profit corporation and a provincial government entity, established pursuant to provincial legislation, namely the Ontario *Health Protection and Promotion Act* RSO 1990 c. H.7. The Complainant is the successor in title to the Muskoka Parry Sound Health Unit.

5. Parties' Contentions

A. The Complainant:

Ontario public health units are regulated non-profit corporations set up under the Ontario *Health Protection and Promotion Act* RSO 1990 c. H.7. The name of each health unit in the province is determined by regulation the most current regulation being the *Areas Comprising Health Units*, R.R.O 1990, Reg. 553, amended O. Reg 64/5. The function of

the various provincial health units is to provide, among other things, public health programs and services within their assigned geographic areas

In March 1998, the Muskoka-Parry Sound Health Unit, named pursuant to the *Areas Comprising Health Units* R.R.O 1990, Reg. 553, amended O. Reg 197/01, registered the domain name www.mpslu.on.ca

From March 1998 until March 2005, the Muskoka-Parry Sound Health Unit used the registered domain name as the organization's website as well as the basis for its staff's e-mail addresses and on their business cards. Through use on its website, through e-mail addresses and on business cards, both the name "Muskoka-Parry Sound Health Unit" and its acronym "mpshu" have become known to the public as the public health unit serving Muskoka and Parry Sound.

In March 2005, further to provincial regulatory changes, the Muskoka-Parry Sound Health Unit was dissolved and responsibility for the provision of services in the Muskoka and Parry Sound areas was given to a new entity named the Simcoe Muskoka District Health Unit.

The Complainant, the Simcoe Muskoka District Health Unit retained the domain name www.mpslu.on.ca for one year after the merger to redirect the public to the new health unit. In March 2006, the registration of the domain name www.mpslu.on.ca was discontinued by the Complainant and the website was retired.

In late 2006, it was brought to Complainant's attention that the domain name www.mpslu.on.ca had become an active site registered by the Registrant

In August 2006, the Complainant alleges that it attempted to contact the Registrant by telephone at the telephone number provided in the WHOIS database. The telephone number and contact address listed for the Registrant in the WHOIS database was that of Arvic Search Services Inc in Calgary Alberta, which organization was the Registrant's Registrar. The Complainant was told by the individual who answered the phone at Arvic Search Services Inc that no person by the name of Radoslaw Ciepielowski, the name of the Registrant's administrative contact, was available through that number. In October 2006, the Complainant attempted to e-mail the Registrant using the e-mail address provided in the WHOIS database. No response was received to this e-mail.

The Registrant's domain name www.mpslu.on.ca leads to a website on which appears the name Muskoka-Parry Sound Health Unit and the acronym "mpshu". The website contains web pages copied directly from the former Muskoka-Parry Sound Health Unit website including the home page with its slogan "Working Together for a Healthier Tomorrow". In addition, the Registrant's website provides links to commercial sites namely a pharmaceutical website and a Poland-based travel website.

The Registrant has no legitimate interest in the domain name because health units in Ontario are legislated entities whose full names are prescribed by legislation. Further,

both their designated names and acronyms have historically been used to identify each health unit. The website to which the domain name leads reproduces the full name, acronym and web content of the Muskoka-Parry Sound Health Unit to which the Registrant is not entitled. The Registrant is not a representative of the Complainant nor otherwise associated with it or with the former Muskoka-Parry Sound Health Unit. The Registrant has not obtained permission to use the full name or acronym of the Muskoka-Parry Sound Health Unit.

The Registrant has registered the domain name in bad faith because it consciously copied and retained material previously posted on the Muskoka-Parry Sound Health Unit website. The Registrant is misrepresenting itself as a legislated entity that no longer exists and that can only exist through legislation. Through this misrepresentation, the Registrant is establishing credibility with site visitors for its own financial gain and to disrupt the Complainant's activities. The inclusion of commercial links especially to the pharmaceutical website is in bad faith because it misleads users into thinking that the medical advice and pharmaceutical sales are endorsed or promoted by the Complainant or its predecessor in title.

A WHOIS search reveals that the domain name of the linked travel agency site is owned by a company based in Poland whose administrative contact is the same individual as for the Registrant but with an address in Poland. A WHOIS search of the domain name information relating to the pharmaceutical website is blocked.

Finally, the Complainant questions whether the Registrant meets the CIRA Canadian Presence Requirements for Registrants given that the administrative contact person for Registrant appears to be based in Poland and that the Registrant provided a false physical address in its Registration of the disputed domain name.

B. The Registrant:

The Registrant has not responded to the complaint.

6. Findings

Under paragraph 4.1 of the CDRP, the burden is on the Complainant to prove, on a balance of probabilities, that

- 1) 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
- 2) The Registrant has registered the domain name in bad faith
- 3) Some evidence that the Registrant has no legitimate interest in the domain name

Under Rule 12.1, the Panel shall render its decision based on the CDRP and Rules, the evidence and arguments submitted and any relevant rules and principles of the laws of Ontario and the laws of Canada. Further, inferences can be drawn about the Registrant's motives in registering the domain name from the Registrant's conduct or other surrounding circumstances including the uses to which the domain name is put.¹

6.1. Is the Registrant's domain name confusingly similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and in which Complainant continues to have such Rights?

The Complainant is a non-profit corporation that is the successor in title to the Muskoka Parry Sound Health Unit, the non-profit corporation whose full name and most especially its acronym "mpshu" are the subject of this complaint. The Complainant, like its predecessor in title, engages in the provision of public health information and services pursuant to Ontario legislation and regulations.

The Complainant does not have a registered trademark, official mark or certification mark in either "Muskoka-Parry Sound Health Unit" or "mpshu" in respect of its services and therefore, in order to fall under the definition of Mark under paragraph 3.2 of the CDRP, the Complainant must establish that it has rights in a trademark or trade name that it has used in Canada for the purpose of distinguishing its services from the services of another person.

Use is defined under paragraph 3.5 of the CDRP to include, among other things, using or displaying the Mark in the performance or advertising of services and, in respect of a non-commercial activity, if the Mark is displayed in the carrying out, promoting or advertising of the non-commercial activity.

The Complainant has demonstrated that its predecessor in title had displayed both the full name and the acronym on its website, and has used the acronym "mpshu" on staff business cards and as e-mail addresses in the performance of its services and in the carrying out of its non-commercial activities.

Although the name "Muskoka Parry Sound Health Unit" is not inherently distinctive, the Panel finds that given that public health units in Ontario are established by legislation, that their full names are assigned by regulation and are exclusive to them and that the Complainant or its predecessor in title used the full name and acronym in association with its services starting in 1998, that both the full name and acronym acquired secondary meaning and have come to distinguish the Muskoka-Parry Sound Health Unit from all other health units in the Province of Ontario.

¹ *Canadian Broadcasting Corp v. Quan* CIRA Dispute #00006 (2003); *Government of Canada v. Bedford* CIRA Dispute #00011 (2003)

The Panel is therefore satisfied that from 1998-2006, the Complainant and its predecessor in title had Rights in the Marks. The Panel is satisfied that the Complainant used the Marks until March 9, 2006, the date upon which the domain name registration expired and was not renewed. The difficulty for the Complainant in this case is in establishing that it continued to have Rights in the Marks at the date of registration of the disputed domain name and that it continues to have such Rights.

The Complainant alleges that the continued use of the Marks in conjunction with the material copied from its former website has led to public confusion. The Complainant further alleges that the use of the Marks by the Registrant coupled with the copied website serve to suggest the continued existence of the Muskoka Parry Sound Health Unit.

The Panel is disturbed by the fact that the Registrant registered the disputed domain name one month after the Complainant retired it and that the disputed domain name is identical to the Complainant's former domain name including the provincial identifier suffix "dot-on" as well as the ccTLD "dot.ca". These factors along with the fact that the disputed domain name leads to a website in which the Registrant has copied material from the Complainant's former website including its Marks falsely suggest that the Muskoka Parry Sound Health Unit continues to serve the residents of Muskoka and Parry Sound.

In other words, the Registrant is relying on subsisting public recognition of the Marks in an effort to pass itself off as the Complainant or its predecessor in title. This fact alone would suggest that there is some residual goodwill attaching to the Marks that the Registrant is attempting to take advantage of.

Canadian trademark law recognizes that residual goodwill can form the basis of a claim in passing-off.² How long this residual goodwill will survive in a given case depends very much on the facts. As stated in the decision of the UK High Court in *Ad-Lib Club Limited v. Granville*:

It seems to me clear on principle and on authority that where a trader ceases to carry on his business he may nonetheless retain for at any rate some period of time the goodwill attached to that business.... It further seems to me clear in principle and on authority that so long as he does retain the goodwill in connection with his business he must also be able to enforce his rights in respect of any name which is attached to that goodwill. It must be a question of fact and degree at what point in time a trader who has either temporarily or permanently closed down his business

² See *Canadian Vapored Ltd v. Leonard* (1972) 6 CPR (2d) 45; *CCH Canadian Ltd v. Butterworths Canada* [1991] 1 FC 3; *Franklin Supply Co. v. Midco Supply Co.* [1995] A.J. No. 765; *Panago Pizza v. 957822 Alberta Ltd* 2003 ABQB 546; *National Process Equipment Ltd v. Sigurdson* 2004 ABQB 566.

should be treated as no longer having any goodwill in that business or in any name attached to it which he is entitled to have protected by law.³

Residual goodwill has also been found in domain name disputes under the ICANN - Uniform Dispute Resolution Policy (UDRP). Although the CDRP is different in a number of respects from the UDRP, the Panel is nevertheless persuaded by the reasoning in the decision in *California Stormwater Quality Association v. Vilma Morales*⁴. That case involved a complainant, non-profit corporation, whose full name was used as its domain name until the organization underwent a name change and it retired the domain name. Within two months of retiring the domain name, the registrant registered the identical domain name as a portal for pornographic websites. In finding that the complainant had residual goodwill in its service mark and therefore continued to have rights in the mark, the Panel pointed to the facts that, among other things, the disputed domain was identical to that of the complainant, the disputed domain name was registered very soon after the complainant's was retired, that members of the public remained confused and continued to associate the domain name with the complainant.

The facts of this case are more egregious. In addition to the timing of the registration and the fact that the disputed domain name is identical to the Complainant's or its predecessor in title, there is the fact that the website to which the domain name refers is a reproduction of the Complainant's former website. The only possible inference to be made is that the Registrant is intentionally riding on the Complainant's or its predecessor's continuing reputation in relation to the Marks.

As a result of the above, the Panel is satisfied on the facts of this case and on the strength of the authorities that the disputed domain name is confusingly similar to a Mark in respect of which the Complainant had Rights prior to the date of registration and in which it continues to have Rights, at least as at the date of this decision.

6.2 The Registrant has registered the domain name in bad faith

The Complainant alleges that the Registrant registered the domain name in bad faith primarily with a view to disrupting the business of the Complainant under paragraph 3.7(c) of the CDRP.

In this regard, the Complainant alleges that the Registrant is misrepresenting itself as the Complainant in the provision of public health services in the province of Ontario. The Complainant further alleges that bad faith is shown by the mere fact that the Registrant has copied a number of the Complainant's web pages so that it appears as if the Muskoka

³ [1972] 2 All ER 300 at p303 – This passage was cited with approval by Canadian courts– see *Canadian Vapotred Ltd v. Leonard* and *Franklin Supply Co. v. Midco Supply Co* (see note 2)

⁴ UDRP - WIPO Arbitration and Mediation Centre – Case Number: D2004-0617 (2004).

Parry Sound Health Unit continues to exist. In addition, the website invites the public to click on a hyperlink that takes the user to a commercial pharmaceutical website that announces “Read Reviews. Buy Drugs.” The inference created is that the Complainant has endorsed this site.

The Panel agrees with the Complainant that the Registrant has intentionally caused confusion in reproducing the Marks in its domain name as well as in copying the Complainant’s former website including its home page, Marks and slogan.⁵ This attempt by the Registrant to pass itself off as the Complainant or its predecessor in title is more than sufficient to constitute bad faith⁶. In addition, providing a link to a commercial pharmaceutical website is in effect providing a link to a competitor of the Complainant in the provision of public health programs and services in Ontario and renders the Registrant a competitor for the purposes of the CDRP.⁷ The Registrant is deliberately riding on the Complainant’s or its predecessor’s reputation in order to attract consumers seeking legitimate and impartial non-commercial health information and is duping them into thinking that the linked website is affiliated with or endorsed by the Complainant. In addition to demonstrating bad faith intent to disrupt the Complainant’s business, this misrepresentation raises grave public health safety concerns that the Complainant is entirely justified in seeking to prevent.

The activities of the Registrant were clearly calculated to deceive and were primarily intended to disrupt the business of the Complainant in the provision of public health programs and services to the residents of Muskoka and Parry Sound. As a result, the Panel finds that the Registrant registered the domain name in bad faith.

6.3 The Registrant has no legitimate interest in the domain name

The Complainant must provide some evidence that the Registrant had no legitimate interest in the domain name. A Registrant has a legitimate interest in the domain name for the reasons set out in paragraph 3.6 of the CDRP. Paragraphs 3.6 (a)-(d) each require good faith use of the Marks or the domain name. Paragraphs 3.6(e) –(f), though not expressly tied to good faith, require that the domain name comprise the legal name of the Registrant or the geographical name of the location of the Registrant’s non-commercial activity or place of business.

The Complainant alleges that the Registrant has no legitimate interest in the domain name because health units in Ontario are legislated entities and their full names are established by regulation. Further, their acronyms have historically come to identify them

⁵ Although outside the scope of the CDRP, such copying also raises questions of copyright infringement. *British Columbia Automobile Assn. v. Office and Professional Employees' International Union, Local 378* 2001 BCSC 156

⁶ *Elysium Wealth Management Inc v. Driscoll* CIRA Dispute #00005 (2003)

⁷ *Sleep Country Canada Inc v. Pilford Ventures Inc* CIRA Dispute #00027 (2005)

in the minds of the public. The Complainant further alleges that the Registrant is not affiliated in any way with it and is not a regulated public health unit within the province of Ontario.

The Panel finds that by passing itself off as the Complainant, the Registrant is clearly using the Marks and the domain name in bad faith. Further, the disputed domain name is not the legal name of the Registrant nor is it the geographical name of the location of the Registrant's non-commercial activity or place of business. As a result, the Panel finds that the Registrant did not have a legitimate interest in the domain name.

7. Allegation that Registrant does not meet the CIRA Canadian Presence Requirements:

Regarding the Complainant's argument that the Registrant does not meet the CIRA Canadian Presence Requirements for Registrants, the Panel can only adjudicate on the grounds for complaint set out in paragraphs 3 and 4 of the CDRP although the Complainant has raised some serious questions especially in relation to the Registrant's contact information being that of its Registrar with the latter disavowing any knowledge of the Registrant at that address. In any case, in light of the Panel's decision on the Complaint, it is not necessary to deal with this question any further.

8. Decision:

The Panel concludes that the Complainant has established its entitlement to a remedy under paragraph 4.3 of the CDRP. The Complainant has requested a transfer to it of the domain name www.mpslu.on.ca and the Panel so orders.

Myra J. Tawfik
Sole Panellist
December 10, 2007