

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

Domain Name: TDMOBILEBANKING.CA

Complainant: The Toronto-Dominion Bank
Registrant: Catherine Johnston
Registrar: GoDaddy Domains Canada, Inc.
Panelist: David Allsebrook
Service Provider: Resolution Canada

DECISION

A. The Parties

1. The Complainant is The Toronto-Dominion Bank. It was created in 1955 by the merger of the Bank of Toronto and the Dominion Bank.

2. The Registrant is Catherine Johnston, whose given address is in Haliburton, Ontario .

B. The Domain Name and Registrar

3. The domain name at issue is TDMOBILEBANKING.CA. The Registrar is GoDaddy Domains Canada, Inc.

C. Governing law

4. By the terms of the registration of .ca domain names, registrants agree to be bound by the CIRA Domain Name Dispute Resolution Policy (referred to hereafter as the “Policy”) and the CIRA Domain Name Dispute Resolution Rules (referred to hereafter as the “Rules”). The Complainant agrees in its Complaint to be bound by the Policy and Rules.

D. Panel Member’s Impartiality and Independence Statement

5. As required by paragraph 7.2 of the Rules, the undersigned panelist has declared to the Provider that he can act impartially and independently in this matter as there are no circumstances known to him, which would prevent them from so acting.

E. Factual Background

6. The Complainant states the following facts.

7. The Complainant is the second largest bank in Canada and the sixth largest bank in North America. Its shares are listed on the Toronto and New York stock exchanges. It has over 85,000

employees. Its retail bank is called TD Canada Trust in Canada and TD Bank in the United States.

8. The Complainant owns Canadian trade mark registration TMA396087 for the trade mark TD for use in association with banking services, among other things. It also owns registration TMA 640911 for the trade mark TD for use in association with, among other things, computerized data processing.

9. The Registrant has filed no response to the Complaint.

F. CIRA Domain Name Dispute Resolution Policy Requirements

10. The Complaint falls to be decided under the current version of the **CIRA Domain Name Dispute Resolution Policy** (“the Policy”), version 1.3, which came into effect on August 22, 2011. The Policy sets out at paragraph 4.1 what the Complainant must establish in order to succeed:

" **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 3.5;

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 as described in paragraph 3.4. "

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

11. The Policy provides:

“3.3 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.”

12. The practice in applying the confusion test under the Policy is to disregard the .ca domain as a distinguishing factor. The words “mobile banking” add no distinguishing element to the letters TD. On the contrary, they are descriptive of the banking services for which the TD mark is known and reinforce the likelihood that the domain name will be mistaken for the mark TD. The domain name and TD mark are Confusingly Similar within the meaning of the Policy.

13. The domain name was registered on September 16 2013, according to the whois search provided by the complainant. The trade mark TD for banking services was registered before that, in 1992. The complainant had rights in the mark before the domain name was registered. The Complainant has satisfied the test set out in 4.1(a) of the Policy.

H. Was the domain name registered in bad faith as defined in article 3.5 of the Policy?

14. Article 3.5 sets out a non-exhaustive list of circumstances which constitute evidence that the domain name was registered in bad faith. The first of these reads as follows:

“ (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;”

15. The tdmobilebanking.ca web page prominently offers “Would you like to buy this domain?” and below that in larger letters “ON SALE”. It is reasonable to infer that the Registrant contemplates that the parties listed in article 3.5(a) are the most likely purchasers and that any sale price would exceed the domain name registration fee. Domain name registration fees tend to be extremely small – a price of \$2.99 for a .com name is given on the tdmobilebanking.ca web page. It is hard to imagine a transfer price not exceeding the registration fee. The domain name has been registered in bad faith.

16. Paragraph (d) of article 3.5 provides another instance of evidence of registration in bad faith:

“(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.”

17. The domain name tdmobilebanking.ca resolves to a web page which features click through advertisements. Eight of the nine advertisements are for loans and other financial services. The Complaint states that the Registrant earns a fee for click-throughs from these advertisements. The use of the TD brand in a third party domain name to siphon off web traffic for this parasitic purpose also establishes registration in bad faith.

I. Legitimate interest in the domain name

18. The Complainant must provide some evidence that the Registrant has no legitimate interest in the domain name. The Complainant has done that by showing that the domain name embodies its trade mark, is used for services for which the TD trade mark is registered, and is not a descriptive term. Article 3.4 of the Policy provides a number of safe harbours for domain name registrants but the Registrant has not replied to the Complaint and thus has not claimed the benefit of any of them, and none would appear to be

applicable.

J. Remedy sought

19. The Complaint requests the transfer of the domain name to the Complainant.

20. The Policy requires that all complainants meet the Canadian presence requirements.

“1.4 Eligible Complainants. The person initiating a Proceeding (the “**Complainant**”) must, at the time of submitting a complaint (the “**Complaint**”), satisfy the [Canadian Presence Requirements for Registrants](#) (the “**CPR**”) in respect of the domain name that is the subject of the Proceeding unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office (“**CIPO**”) and the Complainant is the owner of the trade-mark.”

21. The Complainant satisfies the Canadian presence requirements by reason of its trade mark registrations and is eligible to own the domain name TDMOBILEBANKING.CA.

K. Disposition

22. The Panel has concluded that the domain name and Complaint’s marks are Confusingly Similar, that the domain name was registered in bad faith, and that the Complaint shows some evidence that the Registrant has no legitimate interest in the domain name, which evidence the Registrant has left unanswered. The Panel orders the transfer of the domain name TDMOBILEBANKING.CA to the Complainant .

Dated November 19, 2014



David Allsebrook