

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

Domain Name: SCOUTSCANADA.CA  
Complainant: The Corporation of Scouts Canada  
Registrant: Liam Morland  
Registrar: 0756870 B.C Limited  
Panellist(s): Yuri Chumak  
                  Sharon Groom  
                  Myra J. Tawfik (Chair)  
Service Provider: Resolution Canada

DECISION

1. The Parties:

The Complainant is The Corporation of Scouts Canada (“Scouts Canada”) incorporated by an act of Parliament in 1914. Its registered address is 1345 Baseline Road, Ottawa, Ontario K2C 0A7. Its authorized representative is Crease Harmon LLP, 800-1070 Douglas Street, Victoria, B.C. V8W 2S8.

The Registrant is Liam Morland who gives his address as liam@morland.ca.

2. The Domain Name and Registrar

The disputed domain name is SCOUTSCANADA.CA and the Registrar is 0756870 B.C Ltd.

3. Procedural History

On June 10, 2015 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). It filed an amended complaint on July 7, 2015. Both complaint and amended complaint shall be referred to collectively as the Complaint.

A notice of Complaint was sent to the Registrant and the Registrant filed his response within the twenty-day deadline established under the CDRP.

On August 20, 2015, Resolution Canada appointed Yuri Chumak, Sharon Groom and Myra Tawfik (Chair) as panelists on the Complaint after having received from them

declarations of impartiality and independence. A notice of selection of panelist was sent to all parties at that date.

#### 4. Eligible Complainant

The Complainant is incorporated under the laws of Canada by virtue of an act of Parliament namely, *An Act to incorporate The Canadian General Council of the Boy Scouts Association*, 4-5 George V, c. 130 (1914) and therefore meets the Canadian Presence Requirements for Registrants at s. 2(d).

#### 5. Parties' Contentions

##### A. The Complainant:

The Complainant alleges the following:

1. That it holds rights in a Mark in that its name and marks have been advertised by the Canadian Intellectual Property Office pursuant to s. 9(1)(n) of the *Trade-marks Act*
2. That the registered domain name is confusingly similar to its Mark
3. That the Registrant registered the domain name in bad faith under s. 3.7(c) and/or 3.7 (d) of the CDRP
4. The Complainant has filed a sworn affidavit from one of its senior executives attesting to the fact that the Registrant had been involved with the Complainant's organization until May 2012, at which time his involvement was terminated. Subsequently, the Registrant is alleged to have stated to representatives of the Complainant that he wanted to "...make this very, very public and very, very messy affair"
5. That the Registrant is currently involved with a competitor organization, the BPSA, and has contacted families of his previous Scouts Canada group inviting them to BPSA events
6. That the Registrant is a competitor in that he is trying to draw Scouts Canada's members to the BPSA and is intentionally creating a likelihood of confusion.
7. That the Registrant is an active participant in online chat groups on scouting in which he criticizes the Complainant and seeks to affect its public image
8. That while the disputed website is a non-commercial protest site, it is using a domain name that is identical to the Complainant's Mark. This use of the identical name causes confusion and misleads internet users into believing that the website is affiliated with or endorsed by the Complainant
9. That the Registrant has no legitimate interest to use an identical domain name to the Complainant's Mark
10. A WHOIS search conducted identifies the Registrant as Liam Morland. The date of registration of the domain name is February 18, 2009

B: The Registrant:

The Registrant alleges that:

1. He is not a competitor of the Complainant and that any affiliation with BPSA is irrelevant to the present dispute
2. He is not attempting to draw clients away from the Complainant to BPSA as the domain name and website provide no mechanisms for this to occur
3. The domain name was registered and the website established prior to his joining BPSA
4. He did not register the domain name in bad faith and has a legitimate interest in it
5. He is exercising his rights to free expression in that he is operating a non-commercial protest website expressly permitted under the CDRP

## 6. Findings

### 1. Resubmission:

The Complainant previously initiated a complaint against the Registrant on the same facts. The Panel in CIRA Dispute #00277 (January 22, 2015) dismissed the complaint on the basis that the Complainant had not adduced any evidence of rights in a Mark or of bad faith. The Complainant now seeks to resubmit the complaint by correcting the evidentiary deficiencies.

As the decisions in *Bowring & Co Inc v. Maddeaux* CIRA Dispute #00166 (2008) and *American Girl LLC v. Page* CIRA Dispute # 00239 (2013) recognized, nothing in the CDRP or its rules prohibits the resubmission of a complaint involving the same facts and the same parties. In the *Bowring* case, resubmission was permitted to correct evidentiary lapses in the first complaint. As well, the earlier CIRA decision involving the *Bowring* parties did not address the substantive merits of the Complainant's claim. The Panel will therefore allow the resubmitted Complaint to proceed.

### 2. The Merits of the Complaint:

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;

And to provide some evidence that:

3) 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. *See Canadian Broadcasting Corp v. Qan* CIRA Dispute #00006 (2003); *Government of Canada v. Bedford* CIRA Dispute #00011 (2003)

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?

3.2 Mark. A "Mark" is:

- (a) a trade-mark, including the word elements of a design mark, or a trade name that has been used in Canada by a person, or the person's predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person;
- (b) a certification mark, including the word elements of a design mark, that has been used in Canada by a person or the person's predecessor in title, for the purpose of distinguishing wares or services that are of a defined standard;
- (c) a trade-mark, including the word elements of a design mark, that is registered in CIPO; or
- (d) the alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of which the Registrar of Trade-marks has given public notice of adoption and use pursuant to paragraph 9(1)(n) of the *Trade-marks Act* (Canada).

The Complainant has established rights in a Mark prior to the date of registration of the disputed domain name as contemplated by paragraph 3.2 (d) of the CDRP. In 1993, public notice was given of the Complainant's official mark SCOUTS CANADA in conformity with s. 9(1)(n) of the *Trade-marks Act*. The Complainant has also established that the Registrant's domain name is confusingly similar to its Mark given that it is identical excluding the spacing between the two words and the dot-ca suffix. Paragraph 1.2 of the Policy provides that the domain name is to be compared without reference to the dot-ca suffix. Elimination of the spacing does not alter the appearance, sound or meaning of the domain name at all, a point that is well supported by past Panels.

The Registrant has registered the domain name in bad faith

While we find that this case does not fit squarely within the enumerated examples of bad faith in paragraph 3.5 of the CDRP, these categories are not exhaustive. Panels can assess other factors in making determinations of bad faith. We find that the Registrant registered and used the domain name in bad faith. By registering and using a domain name that was, in effect, identical to the Mark, the Registrant knew that the domain name was likely to catch Internet users by surprise and create a misleading representation as to its source. Even though engaged in non-commercial criticism, the Registrant created a false and misleading impression by utilizing a domain name that would, at least initially, lead the public to think that this website was operated by the Complainant. In this respect, we agree with the CIRA Panel in *McKee Homes Ltd v. Honsek* CIRA Dispute #00079 (2007) that the use of a domain name identical to a Mark can constitute bad faith because it competes with and capitalizes on consumer confusion, even where the registrant is using the domain name as a non-commercial criticism site.

Legitimate Interest in the Domain Name

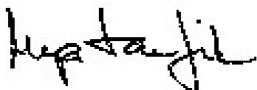
Given that the Panel has found bad faith on the part of the Registrant, we need not consider the elements in paragraph 3.4 of the CDRP relating to legitimate interest, given that these are contingent upon a finding of good faith. However, we agree with those decisions that have held that non-commercial criticism sites that adopt domain names identical to complainants' marks are presumed to be without legitimate interest. See *Diners Club International Ltd v. Planet Explorer Inc* CIRA Dispute #00016 (2004) and similar decisions under the UDRP such as, for example, *Skattedirektoratet v. Eivind Nag*, WIPO Case No. D2000-1314.

7. 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 of the domain name SCOUTSCANADA.CA and the Panel so orders.

Dated: September 10, 2015

On behalf of the Panel



Myra J. Tawfik (Chair)