

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

Domain Name: MANULIFE-DENIAL.CA

Complainant: The Manufacturers Life Insurance Company
Registrant: Jan Fishman
Registrar: Go Daddy Domains Canada, Inc.

Panel: David Allsebrook
Service Provider: ResolutionCanada Inc.

DECISION

A. The Parties

1. The Complainant The Manufacturers Life Insurance Company is a multinational insurance and financial services company with its head office in Canada. Its authorized representative in this dispute is CSC Digital Brand Services AB located in Sweden.
2. The Registrant Jan Fishman is a lawyer in British Columbia whose law practice involves representing clients in lawsuits against the Complainant.

B. The Domain Name and Registrar

3. The domain name at issue is MANULIFE-DENIAL.CA.
4. The domain name is registered with Go Daddy Domains Canada, Inc.

C. Panel Member Impartiality and Independence Statement

5. As required by paragraph 7 of the Rules, the undersigned 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.

D. Canadian Presence Requirement

6. The Complainant owns a trade mark registration in Canada for the trade mark MANULIFE, registration number TMA385240, registered in 1991. It therefore complies with the Canadian presence requirements which qualify it to hold .ca domain name registrations and to lodge complaints under the CIRA Dispute Resolution Policy (CDRP or “the Policy”).

E. Factual Background

7. Manulife describes itself as follows: “Manulife is publically listed on the Toronto Stock Exchange (TSX: MFC), the New York Stock Exchange (NYSE: MFC), the Philippine Stock Exchange (PSE: MFC) and on the Stock Exchange of Hong Kong (SEHK: 945). Since its founding in Canada in 1887, Manulife has grown into a global, financial services leader providing financial advice, insurance and wealth and asset management solutions for individuals, groups and institutions.”
8. “Manulife maintains an international network of more than 34,000 employees and 63,000 agents, along with thousands of other distribution partners around the world. In 2014, Manulife earned revenues of \$37.4 billion.”
9. “Manulife’s history in Canada is strong. For over 125 years Canadians have turned to Manulife for the big financial decisions in their lives. The company’s first president was also Canada’s first Prime Minister, Sir John A. Macdonald. Today, Manulife Canada is comprised of a team of more than 9,000 employees, serving one in every five Canadians. More than 16,000 Canadian businesses entrust their employee benefit programs to Manulife’s Group Benefits.”
10. The Canadian **MANULIFE** trade mark registration lists the wares: (1) Periodical publications and manuals, brochures, binders and booklets containing information relating to financial matters, computer programs relating to financial matters, prerecorded audio and video cassettes and discs relating to financial matters. SERVICES: (1) Financial services, namely: life and health insurance and annuity services; reinsurance services; pension fund services; developing, operating and leasing real estate; mortgage issuing services; investment and investment management services; financial planning services; insurance and financial sales support services in the form of computerized sales support services; educational services relating to financial matters; and providing to group health policy holders information and referrals to, and concerning, foreign doctors and foreign medical facilities for use when travelling away from Canada (CA Reg. No. TMA385240)
11. The Registrant, Jan Fishman, is a lawyer practicing law in British Columbia. His practice includes representing clients suing Manulife based upon claims under insurance policies issued by Manulife. Prior to entering in to his own practice, he was employed as in-house counsel by Manulife in British Columbia defending Manulife from such claims. Mr. Fishman served as in-house counsel for Complainant from 2002-2012 and was, according to his LinkedIn profile,

“[r]esponsible for managing a bulk of Manulife’s litigation in BC (primarily life and disability insurance both directly and through the use of external counsel.”

12. Mr. Fishman was the solicitor for a plaintiff named McMyn in a lawsuit in the Supreme Court of British Columbia against Manulife, which case alleged a wrongful denial of insurance coverage. Manulife brought a motion seeking to disqualify Mr. Fishman from acting as counsel for the plaintiff by reason of a conflict of interest arising from his previous employment defending similar claims on behalf of Manulife. (I note that had the motion succeeded, Mr. Fishman would likely have been excluded from acting as counsel in lawsuits against Manulife for a period of years.) The Court determined that there was no conflict of interest and dismissed the motion. *McMyn v. The Manufacturers Life Insurance Company*, 2015 BCSC 2205.
13. The Court’s decision was released on November 30, 2016. A week later, on December 7, 2015, the Registrant registered the domain name manulifedenial.ca with CIRA. It differs from the present domain name by a hyphen.
14. A month later, on January 9, 2016 ,the Registrant wrote to the Complainant that “In the aftermath of the decision in *McMyn v. The Manufacturers Life Insurance Company*, 2015 BCSC 2205, I am considering a re-tooling of my business model to focus directly on actions involving Manulife Financial...” The letter includes a calculation of the legal fees Mr. Fishman asserted would be generated over the next five years through the use of the four domain names manulifedenial.ca, manulifedenial.com, manulifedenial.org and manulifedenial.net to attract retainers to pursue claims against Manulife. His estimate was that he would act on 70 such actions during that time, producing legal fees to him of \$1,750,000. He offered to sell the inactive domain names manulifedenial.ca, manulifedenial.com, manulifedenial.org and manulifedenial.net to Manulife for \$250,000 (Cdn) instead. The letter does not specify whether the offer would include an undertaking not to act against Manulife. The offer was stated to be open until January 25, 2016.
15. Manulife did not pay the requested sum and made a complaint under the CDRP, which resulted in May, 2016 in the transfer of the domain name manulifedenial.ca from the Registrant to Manulife. *The Manufacturers Life Insurance Company v. Jan Fishman*, 00313 (CIRA May 9, 2016).
16. Manulife also made a complaint under the UDRP, which resulted in the transfer of the domain names manulifedenial.com, manulifedenial.org and manulifedenial.net to Manulife in April 2016. *The Manufacturers Life Insurance Company v. Jan Fishman, Fishman Lawyers*, D2016-0511 (WIPO April 25, 2016).
17. The CDRP and UDRP complaints were resolved on the basis that the domain names were registered in bad faith for the purpose of selling them to Manulife at a price exceeding their cost.

18. There is no allegation that the present domain name was, or is intended to be, offered to Manulife.
19. The present domain name manulife-denial.ca was registered by Mr. Fishman in April 2016. In addition, he has obtained manulife-denial.com, registered March 29 2016, manulife-denial.info, registered April 18 2016, and manulife-denial.solutions registered April 18 2016. The latter three domain names are subject to a UDRP complaint by Manulife concurrent with this complaint. The UDRP (Uniform Domain-Name Dispute-Resolution Policy) is a policy analogous to CDRP. The UDRP is administered by ICANN to deal with cybersquatting allegations in domains such as .com, .net, .info, .solutions and .org.
20. The Registrant's web site home page at manulife-denial.ca begins with the heading "MANULIFE DENIAL SOLUTIONS" above a photograph of scales of justice. Below that is the heading "Has Manulife Financial terminated or denied your disability benefits?" In smaller italicized print below that is a statement that "We are not associated with Manufacturers Life Insurance Company (Manulife Financial) in any way. We are a law firm dedicated to helping people whose disability claims have been wrongfully terminated or denied." This is followed by further descriptions of Manulife and of "our firm", which is not named.
21. The Complaint further states that the web sites operated under the four new domain names are 'geoblocked' so that they cannot be accessed from certain areas. It is suggested that this blocking is to inconvenience the representatives of Manulife in these proceedings, who are located in Europe and are blocked from viewing the web sites directly from there.

F. Analysis

22. The Complaint alleges that the domain name is Confusingly Similar (as defined in the CDRP) to its trade marks, was adopted in bad faith and that the registrant has no legitimate interest in it. The Complaint requests the transfer of the domain name to The Manufacturers Life Insurance Company.
23. The Registrant's position on earlier complaints is presented by the Complainant and in the reasons for decision resolving the earlier complaints. It was summarized by the previous CDRP panel as:

"The Registrant is a lawyer actively involved in representing injured persons with claims against the Complainant. The Registrant takes the position that the decision of the Supreme Court of British Columbia in *McMyn v. The Manufacturers Life Insurance Company* confirmed that the Registrant has a legitimate interest in acting for individuals with lawsuits against the Complainant. The Registrant takes the position that it is the Complainant that is interfering with the Registrant's practice, and that the Complaint was not made in good faith." *The*

Manufacturers Life Insurance Company v. Jan Fishman, 00313 (CIRA May 9, 2016)

24. To succeed, a CDRP complainant must demonstrate the three factors specified in paragraph 4.1 of the CDRP, namely:

“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.

25. “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”

26. In light of the conclusion I reach in connection with the issue of legitimate interest, I will not address the issues of confusing similarity and bad faith.

Legitimate Interest Issue

27. The third test under the policy is whether the Registrant has no legitimate interest in the domain name as described in paragraph 3.4. Paragraph 3.4 reads as follows:

“3.4 Legitimate Interests. 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."

28. Paragraph 4.1 deals with the issue of onus of proof:

"...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."

29. Section 3.4 does not purport to be an exhaustive list of kinds of legitimate interests.

30. The threshold question is whether the Complainant has met its burden of showing some evidence that the Registrant has no legitimate interest in the domain name. I have concluded that the Complaint does not discharge this burden. This is not a burden to prove illegitimacy, although Manulife may do so, but a lesser obligation to raise enough evidence to compel Mr. Fishman to prove a legitimate interest.

31. The meaning of manulife-denial.ca is determined from the point of view of a notional typical consumer somewhat familiar with the Manulife brand and somewhat in a hurry. A consumer of Mr. Fishman's services is someone who wants help with a claim against Manulife. Their first impression of the name manulife-denial.ca in this context is likely that the word 'manulife' is being used to refer to Manulife. It is being used as names are ordinarily used, to refer to their owner. Everyone has the right to use others' names for that purpose. That is what names are for.

32. The Complaint couches its argument in the negative: "The Complainant has not found anything that would suggest that the Respondent has been using MANULIFE in any way that would provide legitimate rights in the name." That is not the same as meeting its onus to show evidence of a lack of legitimacy and in fact is not true because it overlooks a legitimate use.

33. The Complaint suggests a number of reasons why it should be presumed that the Registrant has no legitimate interest in the Domain name. They may be condensed to the following:

a) The use of the domain name by the Registrant would violate trade mark rights.

There is no violation of trade mark rights. Trade mark rights arise from the law of unfair competition. There is no infringement as defined in the Trade-marks Act. manulife-denial.ca is not being used in association with the wares and services listed in the trade mark registration. Beyond statutory infringement of the rights conferred by registration of a trade mark, proof of likelihood of confusion is required, which requires proof that consumers are being or are likely to be deceived or misled into thinking that the services of Mr. Fishman come from Manulife. That is not the case here. The Complaint admits the parties are not competitors. Manulife customers seeking to confront Manulife about unsatisfied insurance claims would not hire Mr. Fishman if they thought he was part of Manulife or connected to or approved by Manulife.

Like the CDRP, the Trade-Marks Act recognizes that the mere adoption of a trade mark is not necessarily infringement : s. 20:

“Exception — bona fide use

“(1.1) The registration of a trade-mark does not prevent a person from making, in a manner that is not likely to have the effect of depreciating the value of the goodwill attaching to the trade-mark,

(a) any bona fide use of his or her personal name as a trade-name; or

(b) any bona fide use, other than as a trade-mark, of the geographical name of his or her place of business or of any accurate description of the character or quality of his or her goods or services.

- b) The Registrant has no license or authority to use the trade mark.

Mr. Fishman does not need a license or authority if his use is not infringing. He does however have the right to use the name Manulife to refer to Manulife, as everyone does. Such use is integral to the goodwill that Manulife relies on in making this Complaint.

- c) The intended use is commercial in nature, which precludes a legitimate interest.

There is no prohibition on making money, or on commercial enterprises identifying others by their names. The legitimacy of Mr. Fishman’s law practice was upheld by the *McMyn* decision cited above, which decision is binding on Manulife.

- d) The mere adoption of the name opens the door to potential future abuse which precludes any other legitimate interest.

This is a speculative argument which effectively admits that there is not currently a lack of legitimacy. No abuse has taken place, been threatened or otherwise been demonstrated to be likely to arise. Mr. Fishman operates in a regulated profession and his interactions with Manulife through the litigation process are overseen by the Courts. Manulife is represented by its own lawyers in those proceedings. In the event abuse takes place, Manulife will have its recourses. Abuse is not presumed when legitimate uses are possible.

34. Contrary to the assertions in the Complaint, there is no presumption that a reference to someone else's trade mark or name is illicit. Everyone has a name. It is the nature of names that they are used to identify their owners. That is a public benefit. Similarly, the goodwill enjoyed by a trade mark is for the very purpose of allowing the public to use the trade mark to identify goods and services from the trade mark owner.

35. The message given by Mr Fishman's use of manulife-denial.ca is that he acts for litigants suing Manulife because of a denial of insurance benefits. There is no deception in that message. *Red Label Vacations Inc. (Redtag.ca) v. 411 Travel Buys Limited (411 Travel Buys Limited)*, 2015 FCA 290. That is what he does, and the Court has endorsed his right to do so. His right to so act is enhanced by his ability to name Manulife in his advertising. The enjoyment of a right endorsed by the Court cannot be taken as establishing a lack of legitimate interest.

36. In reaching this conclusion I have departed from the conclusion of a most learned panel in *The Manufacturers Life Insurance Company v. Jan Fishman*, 00313 (CIRA May 9, 2016) In their opinion,

"From the evidence provided, the Domain name re-directs to the Registrant's web site, such that anyone entering the domain name manulifedenial.ca is led to the website fishmanlawyers.ca. The Complainant's evidence indicates that the Registrant has no authority to be using the Complainant's MANULIFE trademark in this manner."

"The Registrant has provided in support the decision of the British Columbia Supreme Court in *McMyn v. The Manufacturers Life Insurance Company* confirming that the Registrant has a right to act for individuals with lawsuits against the Complainant. However, this right does not extend to the right to use the Complainant's trademark as part of this enterprise".

37. The domain name forwarding referred to in decision 00313 is not found in the evidence of this Complaint. It is not clear why this finding led the Panel to the conclusion that the Registrant needed permission to use the domain name manulifedenial.ca. Presuming the need for a permission in the present decision would relieve the Complainant of its onus to show some evidence of a lack of legitimate interest.

38. The starting point of all law governing expression in Canada is the right to freedom of expression conferred by The Constitution Act, 1982, Schedule B to the Canada Act 1982 (UK), 1982, c 11, s.2(b). The CDRP recognizes that legitimate uses of others' trade marks are possible in section 3.4 as does the Trade-Marks Act in subsection 20(1.1), both cited above.
39. I note that the specific instance of legitimate interest in section 3.4 (b), of the Policy, that "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;" requires a finding of good faith, and I make no finding as to good or bad faith. The list of instances of legitimate interests in s. 3.4 is illustrative and not exhaustive. It is open to me to find that a legitimate interest may exist even in bad faith. The exercise of freedom of expression does not require good faith.
40. With the Court having found that there is public benefit in having Mr. Fishman at liberty to act in litigation adverse to Manulife, there is presumably public benefit in Mr. Fishman having the ability to communicate to the public that this is the nature of his law practice. He is *prima facie* within his rights to use Manulife's name to make this point. Manulife has not in this complaint named any specific illicit harm it has suffered by Mr. Fishman's current use of manulife-denial.ca or any specific harm Mr. Fishman has threatened to inflict outside of the legitimate boundaries of a law practice.
41. It is clear that the Complainant does not approve of Mr. Fishman's career helping Manulife customers sue Manulife, which is understandable, e.g., "The Respondent is not using the domain name in connection with a bona fide offering of goods or services." This is simply not the case. Mr. Fishman is operating a legal and licensed business. Being sued by policy holders is a standard part of the insurance business of Manulife and other insurance companies. There is no depreciation of the value of the goodwill of the trade mark as contemplated by section 22 of the Trade-Marks Act, and none is alleged.
42. Mr. Fishman is accurately describing his business pursuing denied claims against Manulife by means which include a reference to the name of Manulife. He is not, on the evidence filed, deceiving clients into believing that he operates with the authority of Manulife.
43. The rights given to trade mark and trade name owners do not extend to a right to control everything that is said or done by others in reference to by their trade marks and trade names.

G. Conclusion and Decision

44. I find that the Complainant has failed to discharge its onus of showing some evidence that the Registrant has no legitimate interest in the domain name manulife-denial.ca, and further that the Registrant has a legitimate interest in the accurate descriptive use of the domain name.

45. The Complaint is dismissed.

September 16, 2016

Panelist



David Allsebrook