

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

Domain Name: myadp.ca
Complainant: ADP, LLC
Registrant: David H Jones
Registrar: Namespro Solutions Inc.
Panelist: Alessandro Colonnier
Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant, ADP, LLC is a corporation located in the United States.
2. The Registrant for the domain name is David H Jones located in Burnaby, B.C.

B. The Disputed Domain Name and Registrar

3. The disputed domain name is myadp.ca. The Registrar for this domain name is Namespro Solutions Inc. The disputed domain name was registered on May 20, 2009.

C. Procedural History

4. This is a proceeding under the Canadian Internet Registration Authority (“CIRA”) *Domain Name Dispute Resolution Policy* (Version 1.3) (the “Policy”) and the CIRA *Domain Name Dispute Resolution Rules* (Version 1.5) (the “Rules”).
5. The Complainant filed its complaint (the “Complaint”) on May 10, 2017.
6. The provider, Resolution Canada, Inc. served notice of the Complaint on the Registrant as required by Paragraph 4.3 of the Rules. Service of the Complaint was made by e-mail on May 16, 2017.
7. The Registrant did not file a response.

8. On July 7, 2017, the Panel was appointed. As required by Paragraph 7 of the Rules, the Panel has declared to the provider that it can act impartially and independently in connection with this matter, and that there are no circumstances known to the Panel that would prevent it from so acting.

D. Canadian Presence Requirements

9. The Complainant, ADP, LLC is a U.S. company. However it owns a Canadian trade-mark registration for the mark ADP, registration no. TMA684,063, which is included in the disputed domain name. As such it meets the Canadian Presence Requirements under Paragraph 2(q) of the CIRA *Canadian Presence Requirements for Registrants*.

E. The Position of the Complainant

10. The Complainant is one of the world's largest providers of business outsourcing solutions. Since at least 1977, the Complainant has continuously used its famous ADP trade-mark in association with educational services, training programs, research and analytical services, and information services for use in connection with its various businesses (among others). The ADP trade-mark is also used in connection with a full suite of human resource, payroll, tax and benefits administration services, worldwide integrated computing solutions, and integrated securities transactions processing and investor communications services for the financial services industry. As a result of its long-standing use of the ADP trade-mark, the public has come to associate the Complainant with the high quality services that it offers. In addition to the trade-mark identified above, the Complainant is also the owner of Canadian trade-mark registration nos. TMA180,628 (ADP Design), TMA262,384 (ADP Design) as well as other numerous trade-marks identified in the Complaint (the "ADP Marks").

11. The Complainant uses the ADP trade-mark as the second level of a top level domain name both in the .com and .ca domains (adp.com and adp.ca, respectively). The Complainant launched its website adp.com in June 1991, while adp.ca was launched in September 2000. The Complainant's website adp.com has received over 200 million page views since 2008, and the Complainant stated that in 2013 alone, it spent over \$26 million in advertising its ADP Marks worldwide.

12. The Complainant notes that it also uses the domain name "my.adp.ca", and that such a domain name turns up on search engines when searching for the term "ADP".

13. The disputed domain name myadp.ca was registered on May 19, 2009. As shown in the Complaint, myadp.ca routes users to a parked website containing links to the Complainant's competitors. Moreover, the disputed domain name is currently being offered for sale.

14. The Complainant alleges that it has rights in the ADP Marks, and that the disputed domain name is confusingly similar with the Complainant's ADP Marks as it comprises the entirety of the word "adp". The Complainant further contends that the use of the prefix "my" before the term "adp" in the disputed domain name is not sufficiently distinctive, and cites two previous decisions by this Panel in support of this position.

15. The Complainant submits that the Complainant has no legitimate business interest in the disputed domain name. The Complainant states that the Registrant does not have any rights in the word “adp”, and that the Complainant has not licensed or otherwise permitted the Registrant to use any of the ADP Marks.

16. Finally, the Complainant submits that the Registrant registered the disputed domain name in bad faith. The Complainant relies on Paragraphs 3.5(a) and (d) of the Policy, stating that the Registrant is selling myadp.ca on an auction site and that the Registrant is attracting users to the domain name and creating a likelihood of confusion for the purposes of commercial gain. The Complainant has also provided a non-enumerated ground of bad faith; stating that the Registrant has knowingly and willingly engaged in conduct that benefits itself while harming the Complainant.

F. CIRA Domain Name Dispute Resolution Policy

17. Paragraph 4.1 of the Policy requires that the Complainant establish 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;
- (b) the Registrant has registered the domain name in bad faith as described in section 3.5; and
- (c) the Registrant has no legitimate interest in the domain name as described in section 3.4.

18. The Complainant must establish points (a) and (b) above on the balance of probabilities and for point (c) it must provide some evidence that the Registrant has no legitimate interest in the domain name.

G. Discussion and Reasons

Confusingly Similar

19. The Complainant has to show that it has rights in a mark (and continues to have these rights) that is confusingly similar to the disputed domain name and that these rights pre-date the date of registration of the disputed domain name.

20. The date of registration of the domain name is May 20, 2009; therefore, this is the relevant date for this analysis.

21. The Complainant registered the trade-mark “ADP Design” (TMA262,384) in 1981, and has provided evidence demonstrating its use, as well as substantial marketing figures indicating that the mark is still in use in Canada. The trade-mark “ADP Design” (TMA262,384) therefore satisfies the definition of a "mark" in Paragraph 3.2(a) of the Policy.

22. The Complainant has "rights" in this mark as it is the party that has used and registered it in Canada. These rights predate the date of registration of the disputed domain name as the mark was registered in 1981, which is well before the relevant date of May 20, 2009.

23. The Complainant has thus established rights in the mark ADP since prior to 2009, and has demonstrated that it continues to have these rights. The question then is whether this mark is confusingly similar to the domain name myadp.ca. The test for this is whether the domain name in question so nearly resembles the mark in appearance, sound or in the ideas suggested by it as to be likely to be mistaken for the mark.

24. The Panel notes that the disputed domain name uses the mark "ADP" in its entirety; however, the domain name also incorporates the prefix "my". The Complainant has provided the Panel with prior decisions, such as *L'Oréal SA & L'Oréal Canada Inc. v. Victor Silva* 2013 (CIRA-00226), where this Panel found that the use of such a prefix is not sufficiently distinctive to distinguish the disputed domain name from the Complainant's trade-mark.

25. The Panel accepts this position, and finds that the disputed domain name is likely to be mistaken for the Complainant's trade-mark ADP, despite the use of the prefix "my". Therefore the Complainant has established, on a balance of probabilities, the facts required to support the requirements of Paragraph 4.1(a) of the Policy.

Legitimate Interest

26. Paragraph 3.4 provides six possible ways in which a Registrant may have a legitimate interest in a domain name, which shall be discussed below.

27. The Complainant has adduced evidence that the disputed domain name resolves to a parked pay-per-click website. The Panel does not believe that such use shows that the disputed domain name was a mark, used in good faith by the Registrant and that the Registrant had rights in the mark. Therefore, Paragraph 3.4(a) is not satisfied. The Panel also does not believe that the disputed domain name was registered in good faith in association with any wares, services or business, so the Registrant's use cannot fall under Paragraphs 3.4(b) or (c). The Registrant was not using the disputed domain name in good faith in association with criticism, review or news reporting (Paragraph 3.4(d)). Finally, the disputed domain name is not the legal name or a name, surname or other reference by which the Registrant was commonly identified (Paragraph 3.4(e)), nor is it the geographical name of the location of the Registrant's place of business (Paragraph 3.4(f)). Therefore, none of the criteria in Paragraph 3.4 have been satisfied and the Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the disputed domain name.

Bad Faith

28. The Complainant has to show, on the balance of probabilities, that the disputed domain name was registered in bad faith. Paragraph 3.5 deals with the grounds that constitute bad faith and it must be noted that these are not exhaustive; it is open to the Panel to find other grounds that lead to a conclusion of bad faith conduct.

29. The Complainant argued that the Registrant's conduct constituted bad faith under Paragraphs 3.5(a) and 3.5(d), and the Complainant has also provided the Panel with an alternate ground to show bad faith.

30. As noted earlier, the Complainant provided evidence that the disputed domain name resolves to a website that displays the domain name as a banner. The landing page contains a series of links related to employment and payroll services, and clicking any of these links resolves to another page having further links to employment and payroll services. The Complainant submits that many of these links resolve to competitors of the Complainant.

31. The Complaint refers to another decision by this Panel, which found that "the use of a URL that incorporates the Complainant's registered trade-mark, that is confusingly similar to that mark, in order to direct traffic to a pay-per-click website creates a "likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website", within the meaning of Paragraph 3.5(d) of the Policy" (see Paragraph 27, *American Express Marketing and Development Corp. v. Nameshield Inc.* 2014 CIRA-00249). The Complainant also notes, and the Panel accepts, that it is well-established that the use of domain names that are confusingly similar to registered trade-marks to direct internet traffic to pay-per-click websites can amount to bad faith.

32. As such, the Panel is of the view that the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other online locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website, in accordance with Paragraph 3.5 of the Policy.

33. As the Panel has found bad faith exists in accordance with Paragraph 3.4(d), it sees no need to address the other arguments regarding bad faith that were advanced by the Complainant.

H. Conclusion and Decision

34. In conclusion, the Panel finds that the Complainant does have rights in the mark ADP, which predate the registration of the disputed domain name. It also finds that the disputed domain name is confusingly similar to the Complainant's mark and that the Registrant had no legitimate interest in the domain name. Finally, it finds that the Complainant has shown that the Registrant registered the domain name in bad faith pursuant to Paragraph 3.5(d).

35. The Panel therefore orders, pursuant to Paragraph 4.3 of the Policy, that the registration of the domain name myadp.ca be transferred to the Complainant, ADP, LLC.

Dated July 28, 2017



Alessandro Colonnier for the Panel