

**CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

DECISION

Domain Name: dyedurham.ca
Complainant: Dye & Durham Corporation
Registrant: Joseph Fin
Registrar: Sibername Internet and Software Technologies Inc.
Service Provider: Resolution Canada
Panelist: Eric Macramalla

A. THE PARTIES

1. The Complainant is Dye & Durham Corporation (the “Complainant”), which is an Ontario corporation.
2. The Registrant is Joseph Fin (the “Registrant”).

B. DISPUTED DOMAIN NAME

3. The disputed domain name is dyedurham.ca (the “Domain Name”).

C. PROCEDURAL HISTORY

4. This is a dispute resolution proceeding initiated pursuant to the *CIRA Domain Name Dispute Resolution Policy* (the “Policy”) and the *CIRA Policies, Rules, and Procedures - CIRA Domain Name Dispute Resolution Rules* (the “Rules”). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of this dispute pursuant to the Policy and the Rules.
5. The Complainant filed its complaint (the “Complaint”) on March 16, 2020. The Date of Commencement of the proceeding was May 26, 2020.
6. The Registrant failed to file a Response.
7. On July 13, 2020, the Panel was appointed. As prescribed by the Policy, 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 which would prevent it from so acting.

D. CANADIAN PRESENCE REQUIREMENTS: ELIGIBILITY OF THE COMPLAINANT

8. The Complainant is an Ontario corporation. The Panel is therefore satisfied that the Complainant is eligible to initiate these proceedings.

E. THE POSITIONS OF THE PARTIES

The Complainant’s Position

9. The Complainant’s submissions include the following:

10. Dye & Durham is the owner of the Canadian trademark registrations DYE & DURHAM, Registration No. TMA1,004,278, DYE & DURHAM, Registration No. TMA1,018,651 and DYE & DURHAM & Design, Registration No. TMA1,004,287.
11. Dye & Durham has used the trademark DYE & DURHAM since at least as early as 1911. Through continuous use in Canada, the DYE & DURHAM marks have gained reputation, acquired secondary meaning and developed significant goodwill in association with products and services for the legal market, including but not limited to, corporate packages, software, minute books, share certificates, corporate tab sets, seals and stamps for the legal market, and related electronic and filing services.
12. Dye & Durham has over 12,000 clients, including 18 of Canada's top 20 law firms, several Canadian chartered banks, sole-practitioner law firms, and small businesses. Its diversified customer base is anchored by longstanding relationships, and the average customer relationship is 17.5 years.
13. Dye & Durham has developed and sold its software to Canada's top law firms in association with the Dye & Durham Marks. Its clients include Blake, Cassels & Graydon LLP, Gowling WLG (Canada) LLP, Fasken Martineau DuMoulin LLP, Cassels Brock & Blackwell LLP, Stikeman Elliott LLP, Borden Ladner Gervais LLP, Bennett Jones LLP, McCarthy Tétrault LLP, Osler, Hoskin & Harcourt LLP, Miller Thomson LLP, Torys LLP, Dentons Canada LLP, Goodmans LLP, DLA Piper (Canada) LLP, Ownr, Chartahouse Conveyancing Services, and Scotiabank.
14. Dye & Durham offers a cloud-based platform which automates the process of due diligence searches, document creation, and electronic records filing for transactions. Through this platform, Dye & Durham's clients can access its software applications in order to perform various tasks, including execute public records due diligence searches, file electronic records and create legal documents.
15. Dye & Durham's commercial success under the Dye & Durham Marks has been tremendous and it has become one of the largest market participants in Canada for the products and services that it offers. It has successfully grown from a Western Canadian-based business with under 15 employees to a multi-jurisdictional business with 198 employees and \$32.5 million in revenue as of 2018.
16. The Domain Name was registered on January 24, 2018.
17. The Registrant's website describes itself as a non-profit organization that provides "legal and courthouse recourses in Vancouver".
18. The website advertises goods and services the organization offers which include legal software, office products, advisory services, filing systems, and specialty products. However, none of these products are available for purchase online, and are likely not available for purchase anywhere. While the Registrant's website contains a "Contact Us" section, there are no contact details published on the website. Messages sent within the "Contact Us" section have not been answered. The Registrant's website also features a "Blog" tab which contains several posts authored by "Scott M. Attaway". The topics for the blog posts include "How to

choose the best legal software” and “How to get free legal help?”. There have been no blog posts since March 2018.

19. The Domain Name is confusingly similar to the DYE & DURHAM Trademarks, the Registrant has no legitimate interest in the Domain Name and the Registrant registered the Domain Name in bad faith as per Paragraph 3.5(c).

The Registrant’s Position

20. The Registrant did not file a Response.
21. Since the Registrant has not submitted a response to the Complaint, the Panel shall decide the Proceeding on the basis of the Complaint. Notwithstanding the absence of a response, the proceedings shall be decided on the merits of the case.

F. DISCUSSION & REASONS

22. In accordance with paragraph 4.1 of the Policy, to succeed in this proceeding, the Complainant must prove, on a balance of probabilities, that:
 - (a) the Registrant’s 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 of the Policy;

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 of the Policy.

CONFUSINGLY SIMILAR - PARAGRAPH 3.3

23. In order to satisfy this branch of the test, the Complainant must demonstrate (i) that it has rights in a mark, (ii) that the rights in its mark predate the registration date of the Domain Name, and (iii) that the Domain Name is confusingly similar with the disputed domain name.

Rights in the Marks & Rights that Predate the Domain Name Registration Dates

24. Where the Complainant relies upon a trademark registered prior to the domain name registration date, the Policy does not require or permit a Panel to go behind the registration to determine whether the mark is valid or invalid based upon lack of distinctiveness or non-use. In cases where a trademark registration matured to registration after the domain name registration date, or the Complainant is relying on common law rights, it must establish rights that predate the domain name registration.
25. The Domain Name was registered on January 24, 2018.

26. The DYE & DURHAM Trademarks issued to registration after the registration date of the Domain Name. The Complainant has established to the satisfaction of the Panel that it is the owner common law trademark rights that predate the Domain Name registration date. Therefore, the Panel concludes that the Complainant has established rights that precede the registration of the Domain Name.

Confusingly Similar

27. As per paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if the domain name so nearly resembles the mark in appearance, sound or in the ideas suggested by the mark so as to be likely to be mistaken for the mark.
28. Pursuant to paragraph 1.2 of the Policy, a domain name is defined as the second level domain (the portion that immediately precedes the dot-ca suffix).
29. The test to be applied when considering “confusingly similar” is one of first impression and imperfect recollection. The Complainant must prove, on a balance of probabilities, that a person, as a matter of first impression, knowing the Complainant’s corresponding marks only, and having an imperfect recollection of the marks, would likely confuse the Domain Name for the Complainant’s marks based upon the appearance, sound or the ideas suggested by the mark.
30. It should be noted that the test for confusion under the Policy is not the same test for confusion set out under the Canadian *Trade-marks Act*. Under the Section 6(5) of the *Trade-marks Act*, when assessing the likelihood of confusion between marks, the factors to consider are as follows: (a) the inherent distinctiveness of the marks and the extent to which they have become known; (b) the length of time the marks have been in use; (c) the nature of the wares, services, or businesses; (d) the nature of the trade; (e) the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them; and (f) the surrounding circumstances.
31. In contrast, the Policy provides that confusion is established if a domain name so nearly resembles a mark in appearance, sound or in the ideas suggested. This is similar to the test set out under Section 6(5)(e) of the *Trade-marks Act*. However, the remaining factors as set out under the *Trade-marks Act* do not apply to the assessment of confusion under the Policy. The Policy’s summary proceedings are ill-suited for the in-depth and traditional confusion analysis contemplated by the *Trade-marks Act*.
32. The Panel concludes that the Domain Name is confusingly similar with the Complainant’s DYE & DURHAM Trademarks, given that the Domain Name so nearly resembles the DYE & DURHAM Trademarks in appearance, sound and in the ideas suggested so as to be likely to be mistaken for these marks. The Domain Name is comprised of the DYE & DURHAM Trademark apart from the exclusion of the ampersand. The ampersand of course cannot form part of the second level domain and its exclusion does not materially alter the domain name.

Conclusion - Confusion

33. The Panel finds that the Domain Name is confusingly similar with the DYE & DURHAM Trademarks in which the Complainant had rights prior to the registration date of the Domain Name, and continues to have such rights.

LEGITIMATE INTEREST

34. As per paragraph 4.1 of the Policy, the Complainant must provide “some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.6”.
35. Once this onus has been discharged by the Complainant, the Registrant may still succeed if it can show, on a balance of probabilities, that it has a legitimate interest in the Domain Name pursuant to paragraph 3.4.
36. The Panel finds that the Complainant has provided sufficient evidence that the Registrant does not have a legitimate interest in the Domain Name. The Complainant did not authorize the registration and the Domain Name is likely to mislead the public into believing that the Registrant is affiliated with, or endorsed by, the Complainant. Indeed, the Registrant has rather shamelessly misappropriated the Complainant’s trademark rights. Furthermore, the Registrant’s website does not appear to offer legitimate services and appears designed to target the Complainant.
37. Accordingly, the Panel finds that the Registrant does not have a legitimate interest in the Domain Name.

BAD FAITH REGISTRATION

38. There is little doubt that the Registrant’s activities fall squarely within Paragraph 3.5(c) as the Registrant registered the Domain Name with a view to disrupting the Complainant, a competitor. The Registrant has misappropriated a longstanding trademark with a view to intentionally disrupting the Complainant. The Registrant’s activities qualify as bad faith.
39. In light of the foregoing, the Panel finds that the Complainant has established bad faith as per paragraph 3.5(c).

DECISION & ORDER

40. For the reasons set out herein, the Panel decides this dispute in favour of the Complainant. Pursuant to paragraph 4.3 of the Policy, the Panel orders the transfer of the domain name dyedurham.ca to the Complainant.

Dated at Ottawa, Ontario, Canada, this 12th day of August, 2020.



Eric Macramalla