

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

DECISION

Dispute number: 00005
Domain name: CEOFUNDS.CA
Complainant: ELYSIUM WEALTH MANAGEMENT INC.
Registrant: BRIAN DRISCOLL
Registrar: Webnames.ca
Panellist: David Allsebrook
Service Provider: Resolution Canada

1 Summary

- 1.1 The Complainant owns registered Canadian trade mark CEO FUND for use in association with the provision of financial portfolio management services. It seeks the transfer to it of the domain name CEOFUNDS.CA registered by Brian Driscoll. Mr. Driscoll has filed no response to the complaint. The corporation using the domain name has responded to the complaint to object to the need for a hearing, on the ground that it has already agreed to discontinue using the domain name.

2 Jurisdiction over the parties

- 2.1 The Canadian Internet Registration Authority (CIRA), operates the dot-ca Internet country code Top Level Domain. All registrants of domain names ending ".ca" have agreed through contracts (the Registration Agreement) entered into with CIRA at the time of registration, to abide by a Domain Name Dispute Resolution Policy (the "Policy").
- 2.2 Neither the Registration Agreement in force at the date of registration, March 7, 2002, nor the current Registration Agreement, was included in the evidence filed. These documents are however available on the CIRA web site.
- 2.3 I find that a panel can consider uncontroversial evidence other than that filed by the parties. Subparagraph 4.2 of the Policy and Rule 5.8 (both quoted below) mention the evidence which the panel must consider. It is not apparent that any limitation to the record as filed was intended. I consider that Rule 5.8 means that the panel must determine whether the Complainant has made out its case even in the absence of a response from the Registrant.

"4.2 Decision. The panel appointed to decide the Proceeding (the 'Panel') will consider all the evidence presented in the Proceeding and will render its decision in accordance with the Policy and the Resolution Rules."

" 5.8 No Response. If a Registrant does not submit a Response within the period for submission of a Response or any period extended pursuant to paragraph 5.4 or 5.6, the Panel shall decide the Proceeding on the basis of the Complaint. "

2.4 CIRA requires all its registrants of domain names to enter into a standard Registration Agreement. This policy and the current and preceding versions of the Registration Agreement are posted on CIRA's web site at www.cira.ca.

2.5 The Registration Agreement provides, among other things, that the Registrant submitted to the application of the Policy to his domain name registration.

2.6 The Policy was first published by CIRA November 29, 2001. CIRA has also included in the Policy procedural rules for the disposition of complaints filed under the Policy (the "Rules"). CIRA has named Resolution Canada as one of the service providers (the "Provider") to manage the conduct of complaints under the Policy.

2.7 By submitting a complaint under the Policy, and expressly in its submissions, the Complainant has agreed to be bound by the terms of the Policy (Policy, clause 1.9(a)).

2.8 The Complainant lists a number of respondents in addition to the Registrant. These include CEO Hirsch Opportunistic Canadian Fund, CEO Hirsch Opportunistic Tactical Allocation Fund, CEO Hirsch Opportunistic Natural Resource Fund, CEO Canadian Demographic Fund, and Burgeonvest Securities Limited. The evidence shows that Mr. Driscoll was a director of Burgeonvest when the domain name was registered, that Burgeonvest operates the four mutual funds named as respondents, and that the civic address given in the domain name registration for Mr. Driscoll is Burgeonvest's address. The email address given for Mr. Driscoll in the registration is "brian.driscoll@burgeonvest.com".

2.9 The only evidence of use of the domain name in the Complaint is in a 24 page document entitled "CEO Group of Funds Annual Information Form", dated May 30, 2002. It was filed with the Ontario Securities Commission and published

by Burgeonvest. The form gives operational details of the group of mutual funds named as respondents. It gives the email address of Burgeonvest as "info@ceofunds.ca". This shows that Burgeonvest is using the domain name in connection with its mutual funds.

3 Procedural History

3.1 A complaint was filed by the Complainant with Resolution Canada on December 16, 2002.

3.2 Notice of the complaint was sent electronically on December 16 to a general email address at Burgeonvest, info@burgeonvest.com. This is not the address the Registrant had given in the registration. A courier copy was sent to Mr. Driscoll at the business address of Burgeonvest in Hamilton, which was also the postal address given by Mr. Driscoll in the registration. However Mr. Driscoll no longer worked there. This change of employment is reflected in the evidence filed by the Complainant, the CEO Group of Funds Annual Information Form, dated May 30, 2002.

3.3 The Complainant has elected under paragraph 6.5 of the Resolution Rules to have this dispute resolved by a single arbitrator. The undersigned was appointed sole Panellist on January 14, 2003. Prior to my appointment as a Panellist in this proceeding, I submitted to the Provider a declaration of my impartiality and independence in this matter.

3.4 I was advised that no response had been received from the Registrant. I requested that the Provider advise me as to what steps had been taken to give notice of the Complaint pursuant to Rule 2.1. The Provider instructed me on January 21 2003 not to proceed with the matter until I had heard from it further.

3.5 On February 17, 2003 I was given a letter from the Provider reappointing me as sole Panellist and summarizing the steps taken to serve the Complaint. In

addition, I was provided at that time with a copy of an email dated January 22, 2003 from Lynn Travis, Operations Manager of Burgeonvest, to the Provider. It states that:

"With regard to the email sent January 14, 2003. We have no objection to the person named."

"Please be aware that we have agreed to cease using the CEOFUNDS.CA website name as of March 31, 2003. It is our belief that it is not necessary for the hearing to take place."

3.6 The Provider tracked down Mr. Driscoll at his new place of employment, Scotia Capital Markets, and gave him notice of the complaint both by electronic mail and by courier on January 20, 2003. Notice of the complaint was given in both English and French. Based on the information submitted by the Provider, I find that adequate notice of the complaint has been given to Mr. Driscoll. He has not responded.

3.7 The Complaint asserts each of the elements required in sub-paragraph 3.1 of the Policy to bring the complaint within the scope of the Policy. The Registrant is required to submit to this proceeding.

3.8 The Complaint states that "an action for trademark infringement, inter alia, has been commenced in connection with the domain names in the Federal Court of Canada, Trial Division." With no more information than this to go on, and in the absence of objection from the Registrant or Burgeonvest, I decided to proceed to a decision.

4. Positions Of The Parties And Findings

Canadian presence

4.1 The Complainant submits that it has a Canadian presence as required by the Policy and by Section 2(q) of the Canadian Presence Requirements For Registrants. It is a Manitoba corporation, and is the owner of the registered Canadian Trade mark CEO FUND (registration number TMA 554, 158).

4.2 I find that the complainant satisfies the Canadian Presence Requirements.

Confusing Similarity

4.3 The Complainant submits that, pursuant to clause 3.1(a) of the Policy, the 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 (as such terms are defined in the Policy). The trade mark CEO FUND was registered on November 21, 2001. The domain name was registered thereafter, on March 7, 2002.

4.4 I find that by reason of its registration CEO FUND is a Mark under clause 3.2(c) of the Policy and that the Complainant has Rights in the Mark pursuant to clause 3.3(b) of the Policy.

4.5 The Policy defines "Domain Name" in sub-paragraph 1.2 as the domain name, excluding the ".ca" suffix. The Policy specifies that "a Domain Name is 'Confusingly Similar' to a Mark if 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." (Sub-Paragraph 3.4) Accordingly, the comparison is

between CEO FUND and CEOFUNDS. When used in the context of mutual fund services, the terms are Confusingly Similar. They are effectively identical. They are highly likely to be mistaken for each other by persons seeking information about mutual fund service providers on the Internet.

No Legitimate Interest

4.6 The Complainant submits that the Registrant has no legitimate interest in the domain name. Classes of recognized legitimate interests are listed in sub-paragraph 3.6 of the Policy. None of the six listed classes contemplates use of the domain name by someone other than by the registered owner. However the Registration Agreement permits the Registrant to permit others to use the domain name in certain circumstances (Clause 3.1(m)). The clause has not changed in the current version of the Registration Agreement (Clause 3.1(j)). Accordingly I will assume for the moment that it is possible for use authorized under the Registration Agreement to be legitimate.

4.7 Sub-paragraph 3.6 of the Policy is restrictive in confining the definition of "legitimate Interest" to the classes defined there. The onus of proof is on the Complainant to show "some evidence" that the Registrant has no legitimate interest.

4.8 The first class of legitimate interest arises where "(a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark". In my view, the Registrant cannot have Rights in the domain name as against the Complainant so long as the domain name is Confusingly Similar to a registered trade mark owned by the Complainant. The Complainant would normally have the right to have a Court enjoin further use of the domain name under the Trade Marks Act, R.S., c. T-10, s. 19. The Registrant cannot have Rights in a trade mark which it cannot lawfully use. This is the same

conclusion reached in the second decision under the Policy, Re: browneco.ca (00002).

4.9 None of the other classes of legitimate interest apply. Neither the Registrant nor Burgeonvest has attempted to address this point. Accordingly, I find that the Registrant has no legitimate interest in the domain name.

Bad Faith

4.10 The Complainant submits that the Registrant has registered the domain name in bad faith, in that it was registered for the purpose of disrupting the business of the plaintiff. The onus is on the Complainant to show the existence of bad faith on the balance of probabilities. Under the Policy, a registration is considered to have been in bad faith if "the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant." (Clause 3.7(c)).

4.11 The Complainant states that it believes that the Registrant knew of, or had constructive knowledge of the Complainant's rights when it chose this domain name. However the Complainant has filed no evidence of its own use of its trade marks. It cannot be inferred that the Registrant knew of them. Further, the Complainant filed no evidence at all as to whether CEOFUNDS.CA links to a web site, and if so, what can be found there.

4.12 I take the phrase "disrupting the business of the Complainant" to include trade mark infringement and passing off. In my opinion the Registrant is permitting the domain name to be used to infringe the Complainant's trade mark, contrary to section 19 of the Trade Marks Act. As the complainant has filed no evidence of the manner of use of its trade marks, I make no finding as to passing off or deemed infringement under section 20 the Trade-Marks Act.

4.13 The Complainant asserts that there is a duty to do trade mark searches before adopting a domain name, and that the failure to do so, or to heed them, constitutes bad faith. In the absence of evidence showing the manner and extent of use of the Complainant's trade mark, and of evidence of what a search report would have revealed, I am not prepared to infer that no searches were conducted or that they were improperly ignored.

4.14 The test of bad faith quoted above refers to the Registrant's primary "purpose" in the context of competing with the Complainant. I find that Mr. Driscoll was a competitor of the Complainant at the material time. He was a director of a competing mutual fund operator. He registered the domain name CEOFUNDS.CA for his company's use in promoting mutual funds and permitted it to be used to compete with the Complainant. In my view it is sufficient "purpose" to constitute bad faith under the policy to knowingly use or permit the use of a domain name, when the result of the use is trade mark infringement within the meaning of section 19 of the Trade-Marks Act. It is not necessary to specifically intend to usurp the goodwill in the Complainant's Mark.

4.15 The Registrant has not responded to this Complaint, despite his obligation to do so. (Rule 5.1). The Burgeonvest response comes from an interested person and does not contest any of the allegations made in the Complaint.

4.16 Accordingly, I find that Mr. Driscoll registered the domain name in bad faith.

Submission of Burgeonvest

4.17 Burgeonvest submitted that it had agreed to cease using CEOFUNDS.CA as of March 31, 2003. There is no evidence to suggest that the Complainant had agreed to forbear in pursuing its Complaint. Burgeonvest did not indicate that the

registration of the domain name would be cancelled or transferred. In any event, this proceeding may not be terminated except by the consent of both parties (Rule 8.1). Burgeonvest is not a party to the proceeding, and in any event Elysium has not consented to such termination.

5 Formal Order

5.1 Having considered all evidence and submissions filed in the proceeding, and in accordance with the reasons given above, I hereby order and direct that the domain name CEOFUNDS.CA be transferred to the Complainant.

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David Allsebrook, B.B.A., M.B.A., LL.B., B.C.L.
Sole Panellist
February 28, 2003
Toronto, Ontario, Canada.