

## CANADIAN INTERNET REGISTRATION AUTHORITY

### DOMAIN NAME DISPUTE RESOLUTION POLICY

#### COMPLAINT

Dispute Number: DCA-829-CIRA  
Domain Name: nomoredebts.ca  
Complainant: Credit Counselling Society of British Columbia  
Registrant: Solutions Credit Counselling Service Inc.  
Registrar: DomainsAtCost Corp.  
Panellists: Edward Chiasson Q.C., Roger Kerans, David Wotherspoon  
Service Provider: British Columbia International Commercial Arbitration Centre

#### DECISION

##### 1. The Parties

**Complainant** is the Credit Counselling Society of British Columbia, a society incorporated under the laws of British Columbia.

**Registrant** is Solutions Credit Counselling Service Inc., a corporation incorporated under the laws of Canada.

##### 2. The Domain Name and Registrar

The Domain Name at issue is nomoredebts.ca (the "Domain Name").

The Registrar of the Domain Name is DomainsAtCost Corp.

##### 3. Procedural History

On February 28, 2005, Complainant filed a Complaint with respect to the Domain Name with the British Columbia International Commercial Arbitration Centre (the "Centre"). The Complaint was reviewed by the Centre and found to be in administrative compliance with the requirements under Rule 4.2 of the CIRA Domain Name Dispute Resolution Rules and Policy.

By letter and E-Mail dated March 2, 2005, the Centre advised the parties of this, and forwarded a copy of the Complaint to the Registrant. The Centre also informed the parties of the commencement of the proceeding as of March 2, 2005 and of the Registrant's 20-day right to respond to the Complaint.

The Registrant's response (the "Response"), was received in the Centre on April 5, 2005, and was in compliance with the Policy and Rules. It was delivered to the Complainant on April 6, 2005.

The Panel has reviewed the submissions provided by the parties and agrees with the Centre's assessment that the Complaint complies with the formal requirements of the CIRA Policy and Rules.

The Panel concludes that it was constituted in compliance with the CIRA Rules. Each of the panellists has completed an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.

On April 14, 2005 the Panel, through the Centre, sought clarification of the Respondent's submission that "it will not further contest the claim regarding the ownership of the name, nomoredebts.ca", and particularly whether the Registrant would consent to the transfer of the Domain Name, or whether it was contesting the Complaint.

The Registrant's response was received on April 21, 2005. The Registrant clarified that it did not consent to a transfer and that it "does not agree that the Complainant has presented a persuasive complaint."

On May 2, 2005 the Panel issued an Order pursuant to Rule 1.4 extending its time to issue its award to May 11, 2005.

#### 4. **Factual Background**

The Complainant in this administrative proceeding is a B.C. non-profit society that claims to help members of the public to resolve debt and financial difficulties. Some of the services said to be provided by the society are budget counselling, credit counselling, debt management programs, debt settlement programs, and information workshops. The Complainant's services are said to be available to any member of the public, regardless of age or income level.

The Registrant is a B.C. corporation that is said to be providing credit education services to members of the public and to corporations. Some of the services said to be provided by the Registrant are credit counselling, debt management programs, and debt reduction proposals.

The Registrant's President, Margaret Johnson, is a former employee of the Complainant.

The Complainant has used the trade-mark NOMOREDEBTS (the "Mark") in Canada since at least as early as September 5, 2001. The Mark is not a registered trade-mark.

The Complainant asserts that on or about January 10, 2005, it became aware of the Registrant's registration of the Domain Name. On January 14, 2005, the Complainant's lawyers sent a cease and desist letter to the Registrant, and to its President and sole director.

The Complainant further asserts that on January 16, 2005, the Registrant amended its registration of the Domain Name to extend the registration expiry date from July 19, 2005, to July 19, 2008.

On January 18, 2005, the Complainant's lawyers received an E-Mail response from the Registrant and its President stating that the Registrant had retained a lawyer. On January

21, 2005, the Complainant's lawyers sent further correspondence to the Registrant demanding compliance with the cease and desist letters. The Registrant replied on the same day that it would not provide a response until legal advice had been obtained.

On January 27, 2005, the Registrant's lawyer telephoned the Complainant's lawyer to indicate that he would respond to the Complainant within a week. No further response was received from the Registrant until the Registrant filed its Response.

## 5. **Parties' Contentions**

### A. **Complainant**

The Complainant alleges use of the Mark in advertising and promotion of its services. The Complainant has used and/or continues to use the Mark in advertising in the following media: telephone directory display advertisements, weekly community newspaper advertisements, radio station advertisements, and television advertisements. The Complainant also alleges use of the Mark in brochures promoting its services.

The Complainant contends that the Domain Name is confusingly similar to the Mark in which the Complainant had rights prior to the Registrant's registration of the Domain Name. The Complainant emphasizes that the Complainant and the Registrant are direct competitors, and that they operate in the same market, namely the Lower Mainland of British Columbia. The Complainant also notes that the Domain Name's second level <nomoredebts> is identical to the Mark.

The Complainant further contends that the Registrant has no legitimate interest in the Domain Name. The Complainant notes that prior to the Registrant's registration of the Domain Name, the Registrant had not used the Mark in good faith, or in association with any of its services or wares. The Complainant also argues that the Domain Name does not comprise any part of the Registrant's legal name, nor does it reflect the Registrant's geographical name. The Complainant further asserts that the Registrant is not a licensee of the Complainant.

The Complainant argues that the Registrant's use of the Domain Name amounts to passing off on the Complainant's goodwill.

Finally, the Complainant contends that the Registrant registered the Domain Name in bad faith.

The Complainant alleges that the Registrant has engaged in a pattern of registering domain names with the aim to prevent persons with rights in the domain names from registering them. The Complainant cites as an example of this pattern of registering domain names the Registrant's registration of the domain name [mydebtsolution.ca](http://mydebtsolution.ca), which is confusingly similar to the domain name of the long-time user of the mark MYDEBTSOLUTION.

**B. Registrant**

The Registrant states that for purely financial reasons, it will not further contest the ownership of the Domain Name. The Registrant confirmed that it does not consent to a transfer.

The Registrant contends that the Complainant's positions blur the lines regarding trademark law, passing off, confusion and distinctiveness.

The Registrant further contends that the Complainant is pursuing the arbitration based on a strategy of ongoing harassment against the Registrant and its President.

The Registrant also asserts that the fact that the Registrant's President was at one time employed by the Complainant is of no relevance to the arbitration. The Registrant states that its President had involvement in the credit business long before she was employed by the Complainant.

**6. Discussion and Findings**

Paragraph 4.1 of the CIRA Domain Name Dispute Resolution Policy (the "CIRA Policy") sets out the Complainant's burden of proof in an arbitration proceeding. The onus is on the Complainant to 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 3.7;

A Complainant must also provide some evidence that:

- (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6.

Paragraph 4.1 of the CIRA Policy further provides that even if a 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 3.6.

The terms Rights, Mark, Confusingly Similar, Use, Legitimate Interest and Registration in Bad Faith are all defined in the Policy and those definitions will be applied in this Award.

*CIRA Policy 4.1(a)*

**(a) Did the Complainant have Rights in a Mark prior to Registration of the Domain Name?**

The Registrant obtained registration of the Domain Name on July 19, 2004. The Complainant must establish Rights in NOMOREDEBTS, as a Mark, prior to that date.

As NOMOREDEBTS is not a certification mark, a registered trade-mark, or an official mark, the Complainant must establish Use (as defined in 3.5 of the Policy) of NOMOREDEBTS as a Mark, as defined by 3.2(a) of the Policy.

The Complainant alleges Use since September 5, 2001. It supports this allegation by providing a variety of information about its advertising expenditures; however, most of that information contains a mere assertion of Use, not information about actual Use. For example, in paragraph 18, the Complainant states “The Complainant used the mark in advertising during the summer of 2004 on two Vancouver area radio stations....” It then attaches invoices as Schedule 8. There is no reference to NOMOREDEBTS in the invoices in Schedule 8. The Complainant could have attached a script, or other such information, demonstrating Use, but it has not done so. Mere assertions of Use are arguably insufficient to establish Use on a balance of probabilities: See *Plough (Canada) Limited v. Aerosol Fillers Inc.* [1981] 1 F.C. 679 (C.A.)

The Complainant has also provided information regarding advertising of its services in association with the domain name [www.nomoredebts.org](http://www.nomoredebts.org), both inside buses, beginning in September 2001 (paragraph 15, Schedule 5), and in the TELUS pages and Superpages directories, beginning with the 2001/2002 publication (paragraph 16, Schedule 6).

The Panel notes that the definition of a Mark does not require that the Complainant establish that its name has acquired distinctiveness, only that it “has been used in Canada...for the purpose of distinguishing its wares, services or business....” This is a relatively low threshold.

The Registrant submits that the Complainant’s legal theory is “the casual blurring of the logic and language between trade mark law, passing off law, and the domain name disputes, especially in this situation where the Complainant’s name is limited for use in British Columbia.” This appears to be an admission on the part of the Registrant that it is aware of the Complainant’s use of NOMOREDEBTS. The Panel does not rely on this admission in deciding this matter.

The Panel accepts the Complainant’s submission that it had rights in NOMOREDEBTS as a Mark prior to the registration of the Domain Name, and that it continues to have those rights.

**(b) Is the Complainant's Mark Confusingly Similar to the Domain Name?**

The CIRA Policy provides a definition of the term 'Confusingly Similar.' Paragraph 3.4 states 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."

The Domain Name [www.nomoredebts.ca](http://www.nomoredebts.ca) contains the Mark NOMOREDEBTS. The addition of the dot-ca country code does not serve to distinguish the Domain Name from the Complainant's Mark. The fact that the Domain Name contains the Mark in identical terms makes the Domain Name confusingly similar to the Mark.

For these reasons, the Panel concludes that the Domain Name is confusingly similar to the Complainant's Mark.

The Complainant has met its onus under 4.1(a) of the Policy.

***CIRA Policy 4.1(b)***

**(a) Was the Domain Name registered in Bad Faith?**

The Complainant alleges that the Registrant registered the Domain Name in bad faith. Bad Faith is defined in 3.7 of the Policy. Bad Faith can only be found "if and only if" the Complainant establishes, on a balance of probabilities, one of the three types of bad faith defined in subsections (a) to (c).

The Complainant has failed to establish, on a balance of probabilities, that the Registrant's registration of the Domain Name constituted Bad Faith as defined in 3.7(a) or (b) of the Policy.

The Complainant alleges that the President of the Registrant is a former employee of the Complainant, and that the Registrant provides a service that is competitive to the Complainant. The Panel notes as well that the Registrant was advertising its services in the TELUS Pages and Superpages referred to above (Schedule 6), as early as the 2001/2002 directory.

We infer that the Registrant was aware of the Use by the Complainant. Indeed, the Registrant has not denied this knowledge and, as noted above, in a fashion admitted it. The Registrant has failed to provide any explanation for its registration of the Domain Name. We therefore infer that it registered the Domain Name with a view to attract to itself business from those who had come to recognize the Complainant's Mark, that is, primarily for the purpose of disrupting the business of the Complainant.

It is well established in awards under the CIRA Policy that knowing registration by one trader of a dot-ca domain name incorporating the Mark of a competitor constitutes Bad

Faith as defined in 3.7(c) of the Policy. This is precisely what the Registrant has done and the Panel finds that the Domain Name was registered in Bad Faith.

The Complainant has met its onus under 4.1(b) of the Policy.

***CIRA Policy 4.1(c)***

**(a) Does the Registrant have a Legitimate Interest in the Domain Name?**

The Complainant alleges that the Registrant has no Legitimate Interest in the Domain Name. The Complainant must provide some evidence that the Registrant does not have a Legitimate Interest. This burden is light.

It is then open to the Registrant to demonstrate on a balance of probabilities that it has a Legitimate Interest in the Domain Name. The Registrant can only be found to have a Legitimate Interest in the Domain Name "if and only if" it establishes on a balance of probabilities one of the six types of Legitimate Interest defined in subsections (a) to (f) of 3.6 of the Policy.

The Complainant has established, for example, that the Registrant did not use the name NOMOREDEBTS prior to the registration of the Domain Name (3.6(a)), that the Registrant has not used the name in association with a non-commercial activity (3.6(d)), and that the Domain Name is not the legal name of the Registrant (3.6(e)).

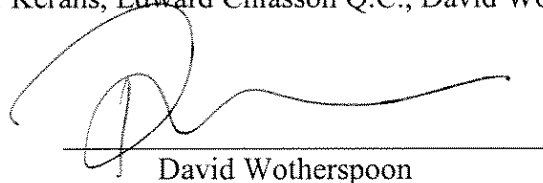
The Registrant has not provided any information or explanation to suggest that it had a legitimate interest in the Domain Name. The Panel concludes that the Registrant has failed to prove on a balance of probabilities that it had a Legitimate Interest in the Domain Name.

For these reasons, the Panel concludes that the Registrant has no Legitimate Interest in the Domain Name.

**7. Decision**

For the foregoing reasons, the complaint is successful and the Panel orders that the Registrar, DomainsAtCost Corp transfer the registration of the Domain Name www.nomoredebts.ca to the Complainant.

Roger Kerans, Edward Chiasson Q.C., David Wotherspoon



David Wotherspoon  
Chair, for the Panel  
Dated: May 11, 2005