

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

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Domain Name: vanguardfinancial.ca

Complainant: The Vanguard Group, Inc.

Registrant: Muhammad Shabbir  
Vanguard Financial Services

Registrar: Go Get Canada Domain Registrar Ltd.

Panel: David Allsebrook (Chair), Marcel Mongeon, James Minns

Service Provider: Resolution Canada, Inc.

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**DECISION**

**A. The Parties**

1. The Complainant is The Vanguard Group, Inc., located in Malvern, Pennsylvania.
2. The registrant for the domain name is Muhammad Shabbir operating as Vanguard Financial Services (the “Registrant”) located in Mississauga, Ontario, Canada.

**B. The Domain Name and Registrar**

3. The disputed domain name is vanguardfinancial.ca (the “Domain Name”). The registrar for this domain name is Go Get Canada Domain Registrar Ltd. (the “Registrar”). The disputed Domain Name was registered in February 2010.

**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 history of the proceeding as provided by the dispute resolution service provider, Resolution Canada, Inc. (“Resolution Canada”), is that the Complainant filed a complaint

dated February 28, 2021 with Resolution Canada requesting that the current registration of the Domain Name be transferred to the Complainant.

6. Resolution Canada served notice of the complaint on the Registrant as required by paragraph 4.3 of the Rules.
7. The Registrant replied to the Complaint with a response dated April 24, 2021.

**D. Panellist Impartiality and Independence**

8. As required by paragraph 7 of the Rules, the panellists have submitted to Resolution Canada declarations of impartiality and independence in relation to this dispute.

**E. Canadian Presence Requirements**

9. The Complainant is a corporation headquartered and located in the United States. Since 2003 it has been the registered owner of a registration for the trademark VANGUARD in Canada (registration no. TMA575,755). The Domain Name contains this mark. Therefore, the Complainant satisfies the Canadian Presence Requirements under paragraph 2(q) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3.

**F. Factual Background**

10. According to the Complainant, founded in 1975, Vanguard is one of the world's largest investment companies, with more than 30,000,000 investors in about 170 countries and total assets under management of approximately \$6.9 trillion as of November 30, 2020, with 421 funds worldwide (192 funds in the U.S. and 229 funds in global markets). For decades, Vanguard has invested significant money, time, and resources in the advertisement and promotion its products and services under its VANGUARD mark. It continues to do so every year.
11. The Complainant owns the following Canadian trademark. registrations:
  - a) VANGUARD, CA Registration No. TMA575755, first used in commerce at least as early as 1984, filed February 7, 2000, issued February 17, 2003, covering services in International Class 36 (financial services, investment advisory services, financial management services).
  - b) VANGUARD, CA Registration No. TMA825978, first used in commerce at least as early as 1984, filed July 30, 2009, issued June 11, 2012, covering products and services in International Classes 9, 16, 35, 36, and 41 (e.g., providing an interactive website that provides commercial financial transaction data, transaction capability, account management, financial reporting, accounting features and related reference information; business outsourcing services namely outsourcing of customer service, payroll, human resources, legal, translation and insurance services; business outsourcing and back-office support services, namely, bookkeeping and administration of operational support services for investment advisors).

12. Vanguard has advertised, promoted, and/or offered its products and services under its VANGUARD marks online for many years. Vanguard owns and uses many VANGUARD-formative domain names to advertise, promote, and/or offer Vanguard's products and services including (i) the domain name VANGUARD.COM, which it has used since at least as early as 1997 and (ii) the domain name VANGUARDCANADA.CA, which it has used since at least as early as 2011.
13. According to the Registrant, Vanguard Financial Services ("Registrant") provides tax and accounting services to individuals and businesses. Although the business activities started in 2012, the Registrant did all their business via word-of-mouth marketing and referrals. Since there was no immediate need for a website the Registrant did not register the website until later on when he was approached by a web developer who provided a discounted price to get their website made. The Registrant does not provide financial planning services, or any services that compete with the Complainant.
14. It should be noted that the Registrant filed correspondence in the nature of settlement discussions between the parties. Such discussions are privileged at law and cannot be introduced into evidence in Court proceedings, so as to foster candor and compromise between the parties and promote settlement and reconciliation between disputants. This Panel respects that policy and has not taken account of the correspondence.

**G. *CIRA Domain Name Dispute Resolution Policy***

15. 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) (b) the Registrant has registered the domain name in bad faith as described in section 3.5; and
  - c) (c) the Registrant has no legitimate interest in the domain name as described in section 3.4.
16. 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. 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 section 3.4 of the Policy.

**H. *Analysis***

### Rights to a Mark

17. Under paragraph 4.1(a) of the Policy, the Complainant has to show, on the balance of probabilities, that it had rights (and continues to have rights) in a mark that was confusingly similar to the domain name, prior to the date of registration of the disputed domain name. “Mark” is defined in paragraph 3.2(c) of the Policy as:
- (a) a trade-mark, including the word elements of a design mark, that is registered in CIPO;
18. The Domain Name *vanguardfinancial.ca* was registered in February 2019, after the trademark VANGUARD was registered in Canada by the Complainant. The Complainant has established that it had rights in a mark prior to the date of registration of the Domain Name, and continues to have these rights.
19. The Domain Name consists of the words “vanguard financial” which is the same as the only word of the registered mark for the purposes of the Policy. In determining whether there is confusing similarity as defined by the Policy, the comparison disregards the domain indicator “.ca” and any non-distinctive elements such as the descriptive term “financial”. Applying this test, the Panel finds that pursuant to paragraph 3.3 of the Policy, the Domain Name is confusingly similar to the mark VANGUARD as it so nearly resembles the mark in appearance, sound and in the idea suggested by the mark as to be likely to be mistaken for the mark.

### Bad Faith

20. The Complainant also has to show, on the balance of probabilities, that the Domain Name was registered in bad faith. Paragraph 3.5 of the Policy deals with the grounds which constitute bad faith and it must be noted that these are not exhaustive; it is open to the panel to find other grounds which lead to a conclusion of bad faith conduct.
21. The Complainant alleges that the Registrant’s conduct constitutes bad faith under paragraph 3.5(d) of the Policy which states:
- a) The Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant’s website or other online location, by creating a likelihood of confusion with the Complainant’s Mark, as to the source, sponsorship, affiliation, or endorsement of the Registrant’s website or location or of a product or service on the Registrant’s website or location.
22. The Complainant says that the Registration is a deliberate attempt to cause confusion. The domain name includes all of the mark VANGUARD and is used for related services. The Registrant disregarded a cease and desist letter. The Complainant cites *Papa John’s International, Inc. v. McGrath*, 00403 (CIRA 2015) (complainant satisfied its burden of demonstrating bad faith because the disputed domain name wholly incorporated complainant’s trademark, was registered ten years after complainant’s trademark registration, and was registered in connection with services highly related to complainant’s services).

23. The Respondent says there is no likelihood of confusion or actual confusion. Its business provides tax and accounting services to individuals and businesses and is unrelated to and does not compete with the Complainant's. Its customer base is very different. The noun "vanguard" is commonly used as a business name. The Registrant has a statement on its web site disclaiming any connection with the Complainant. The Registrant has a Master Business License issued in Ontario for the name "Vanguard Financial Services".
24. The Registrant says "The Registrant's name Vanguard Financial Services is to reflect their Accounting & Tax services and the Registrant's vision of leading their clients in the future of accounting and tax by utilizing technology to reduce time spent and to save their clients money in fees and time. This is in line with the noun Vanguard as in the Registrant and their clients are leading the way in new development and ideas related to tax and accounting."
25. The Panel considers that bad faith has been shown on the balance of probabilities. The Complainant is very well known and would come to the mind of Internet users as acknowledged by the existence of the disclaimer. Disclaimers do not necessarily prevent or cure confusion and confusion has likely already taken place before the disclaimer is encountered.
26. There is overlap between the respective businesses of the parties. For example, the services listed in the registration of the trademark VANGUARD (TMA825,978) include "accounting and bookkeeping services," "tax ... ..consulting" services, and a very extensive list of financial services. The Registrant added the word "financial" to VANGUARD rather than a descriptor more specifically related to its tax or accounting business.
27. None of the other businesses named "Vanguard" identified by the Registrant is in a financial, accounting or tax related field of activity. If the registered trademark is invalid or weakened by reason of descriptiveness, the remedy is an application to the Federal Court. This body has no authority to limit the exclusive right to use the trademark VANGUARD throughout Canada conferred by the trademark registrations under the Trademarks Act. The Registrant is not using the word "Vanguard" in a descriptive manner. There is, for example, no allusion to innovation or leadership on its web site at vanguardfinancial.ca. Rather, according to the web site, "Our focus has always been to provide affordable and reliable services for our clients."

#### Legitimate Interest

28. In order to succeed the Complainant has to provide some evidence that the Registrant does not have a legitimate interest in the domain name. Paragraph 3.4 of the Policy lists six possible ways in which a Registrant may have a legitimate interest in a domain name which are as follows:
- (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.

29. This list is not exhaustive as it is said to be "without limitation".

30. The Complaint need only raise a reasonable challenge to the legitimacy of the domain name registration to establish its case in the absence of a show of legitimacy by the Registrant. The Domain Name, and its use by the Registrant, do not appear to fit in any of the categories listed in paragraph 3.4 and no other ground of legitimacy suggests itself in the circumstances. The Complaint, resting upon two trademark registrations, is sufficient to raise a reasonable challenge.

31. The Registrant says it has a legitimate interest in the domain name. It says it uses a different colour scheme, it provides different products and services (in particular it does not provide financial planning services), it uses the word Vanguard for its meaning "a group of people leading the way in new developments or ideas" and it has a Master Business License issued in the name "Vanguard Financial Services" and that it registered the domain name in good faith.

32. The Panel finds that the Registrant has no legitimate interest in the domain name for the reasons given in paragraphs 25 to 27 above. As to the use of colour, the rights conferred by the trademark registrations are not constrained by the colour of the trademarks or of the media on which the trademarks appear.

## **I. Conclusion and Decision**

33. In conclusion, the Panel finds that the Complainant has rights in the mark VANGUARD which predate the registration of the Domain Name. The Panel also finds that the Domain

Name is confusingly similar to the Complainant's mark VANGUARD, that the Domain Name was registered in bad faith and that the Registrant has no legitimate interest in the Domain Name.

34. The Panel therefore orders, pursuant to paragraph 4.3 of the Policy, that the registration of the Domain Name vanguardfinancial.ca be transferred to the Complainant.

Dated: May 20, 2021



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By: David Allsebrook (Chair)



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By: Marcel Mongeon



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By: James Minns