



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE
DOMAIN NAME DISPUTE
ADMINISTRATIVE PANEL
DECISION

CIIDRC case number:	17467-CDRP	Decision date: July 4, 2022
Domain Name:	mscanada.ca	
Panel:	Barry Effler (Chair), Michael Erdle, Thomas Manson, QC	
Complainant:	Multiple Sclerosis Society of Canada	
Registrant:	Manpreet Sidhu	

1. PROCEDURAL HISTORY

The Domain Name was registered on September 4, 2018.

This matter is conducted pursuant to the Canadian Dispute Resolution Policy (the Policy) and the Canadian Dispute Resolution Rules (the Resolution Rules) of the Canadian Internet Registry Authority.

The procedural history of this case was set out in a letter from the Canadian International Internet Dispute Resolution Centre to the Panel:

The particulars of the case are as follows:

1. On May 3, 2022, Mr. Tyler Brownell filed a Complaint on behalf of “Multiple Sclerosis Society of Canada”, the Complainant, pursuant to the Policy and Resolution Rules. The Complaint with the attachments was filed via online CIIDRC’s platform.
2. The identity of the Registrant is not published in the public WHOIS database; therefore, the Registrant’s name was not included in the Complaint.

3. CIRA was notified of this proceeding on May 3, 2022, and, on the same day, CIRA transmitted its verification response disclosing the Registrant's identity. CIRA also confirmed that the disputed domain name was placed on a Registrar LOCK.
4. Under Rule 4.1 "the Provider shall review the Complaint for administrative compliance with the Policy and the Resolution Rules." Upon a review of the Complaint, CIIDRC determined that the Complaint is not in administrative compliance in certain areas. After providing time to address the deficiencies, Mr. Brownell resubmitted the Complaint on May 26, 2022, is in administrative compliance with CIRA's requirements under Rule 3.2.
5. On May 26, 2022, CIIDRC confirmed compliance of the Complaint with CIRA's requirements under Rule 3.2, and commencement of the dispute resolution process.
6. Pursuant to Resolution Rule 4.4, CIIDRC notified the Respondent of this administrative proceeding and forwarded the Complaint to the Registrant on May 26, 2022. CIIDRC delivered the Complaint to the Registrant only by courier.
7. The Registrant delivered its Response, in compliance with the Policy and Resolution Rules, to CIIDRC via email on June 10, 2022.
8. The Complaint and the Response were filed in English, which shall be the language of the proceeding.
9. In accordance with Paragraph 6 of the Resolution Rules, the Provider shall appoint a three-member Panel, with consideration to the nominees of the parties, and select a Chair.
10. The Centre named Michael Erdle and Thomas Manson, QC, as panelists. Barry Effler was named as Chair of the Panel.

2. FACTS ALLEGED

Background facts alleged by the Complainant and accepted by the Panel as probative are summarized here from the Complaint:

The Complainant is referred to as "MS Society of Canada" in the Complaint and that name is apparently used on the society's website.

The MS Society of Canada provides services to people with multiple sclerosis and their families and funds research to find the cause and cure for this disease.

The Complainant owns Canadian Trademark TMA525597 registered March 23, 2000, for "MS CANADA".

Without the permission of the MS Society of Canada, the Registrant registered the Domain Name on September 4, 2018.

The MS Society of Canada states that there is not, and has never been, any relationship between the MS Society of Canada and the Registrant, and the Registrant has never been licensed or otherwise authorized to register or use the MS Society of Canada's MS CANADA trademark in any manner whatsoever, including as part of a domain name.

The Complainant initiated a series of emails asking to purchase the Domain Name starting from an offer of \$250 and a final offer of \$5000. During the exchange the Registrant stated the "*offer would need to exceed \$20K*".

During the period prior to this Complaint, the Domain Name resolved to a parking or landing page displaying ads.

3. CONTENTIONS OF THE PARTIES

- **Complainant**

The Complainant submits the following information from the Complaint:

The Domain Name (mscanada.ca) has been sought after by the MS Society of Canada for some time due to a number of factors. The Domain Name is short, easy to remember, and simple to type. Cognitive impairment, spasticity, and general physical incoordination are but some of the symptoms that a person with MS may experience. The MS Society of Canada is constantly trying to improve the accessibility of web-based content about MS. A short, simple-to-type, easy-to-remember domain, like the disputed domain, is a step to improving the accessibility of the MS Society of Canada's information for people afflicted with MS.

The Domain Name consists of two terms: "MS" and "CANADA". These two terms are some of the most popular used to find the MS Society of Canada's information on multiple sclerosis. Someone else having control over these terms, which we have trademark for, could be negatively effecting how accessible the information on our website is for people afflicted with MS.

- **Registrant**

The Registrant submits the following information from the Response:

For some context, I am not a domain market maker (I don't buy and sell domains). I strategically bought this domain to use as a near future business platform, I hope to launch under my business name, Merchant Services of Canada. I bought mscanda.ca with this vision in mind, as it is a simple and easy to remember domain. In a world where we are bombarded with information, I needed something that my clients and prospects can remember – having a lengthy domain such as merchantservicesofcanada.ca would result in a loss of revenue due to the simple fact, people will not take the time to type this out or will not remember it. I would argue people without multiple sclerosis also have a difficult time remembering, spelling and typing long and confusing string of words, such as Merchant Service of Canada. Losing my domain, would be detrimental to my business ambitions

- **Remedy Sought**

The Complainant requests the Domain Name be transferred to it.

4. DISCUSSION AND FINDINGS

4.1 Eligibility

The Complainant is an eligible complainant under paragraph 1.4 of the Policy. The Complainant is the owner of a registered Canadian trade-mark in which the exact word component of such trade-mark is the same as the Domain name in dispute.

4.2 Requirements

In accordance with paragraph 4.1 of the Policy, the onus is on the Complainant to prove:

- (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 3.5;

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.:

The Panel will consider each of these requirements in turn.

4.3 Analysis

4.3.1 That the Domain Name is Confusingly Similar to a Mark in which the Complainant has Rights

The Complainant is the owner of a registered Canadian trade-mark in which the exact word component exactly matches the Domain Name excluding the dot ca portion of the domain name and the space between MS and Canada. The space is not a legal character within any domain name. The Complainant claims that it has rights in a trade-mark that was a “Mark” prior to the date on which the Domain Name was registered. The trade-mark was registered March 23, 2000, which is significantly earlier than the September 4, 2018 date of registration of the Domain Name.

The Panel is satisfied that the Domain Name is confusingly similar to the Complainant’s Mark.

4.3.2 That the Registrant has registered the Domain Name in Bad Faith

The Registrant registered the Domain Name on September 4, 2018 and there is no evidence of any use of the Domain Name beyond the creation of a landing page selling advertising per click of internet traffic.

The Complainant submitted the following in its Complaint:

In view of the long-term registration of the MS Society of Canada’s MS CANADA trademark in Canada, the Registrant had actual or constructive knowledge of the MS Society of Canada’s rights in the Domain Name at the time of registration.

The Registrant has had the Domain Name parked during the entire time they have had access to it. They currently have “related links” displaying on the Domain Name parking page and are not using it for a legitimate purpose.

In particular, the parking page (Annex 2) has “related links” for “Check Symptoms” and “MS Symptoms. These cannot have anything to do with Merchant Services of Canada, but must relate to the Complaint’s focus on “multiple sclerosis” and “symptoms” of MS. This directly contradicts the Registrant’s assertion that “my services / product offering do not resemble those of the society in any way”.

The Registrant goes on to assert that “the most important thing here is that the products/services offered by me and the society are not similar in the slightest”. In fact, the Registrant has directed the Domain Name to a landing or parking page with links for “Check Symptoms”, an apparent medical reference, and “MS Symptoms”, an apparent disease reference, which are similar to the Complainant’s services.

Pursuant to paragraph 3.5 of the Policy, there is bad faith if the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the MS Society of Canada. Evidence of this is seen in the correspondence between Registrant and the MS Society of Canada on September 24, 2021, where Registrant stated a purchase offer would need

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to exceed \$20,000, or have the MS Society of Canada's credit card processing to Registrant's business for a lower purchase price.

The Registrant has submitted that it "strategically bought this domain to use as a near future business platform, I hope to launch under my business name, Merchant Services of Canada. I bought mscanda.ca with this vision in mind, as it is a simple and easy to remember domain."

The Panel carefully considered the Registrant's submission. However, the Registrant provided no evidence of any active use of the Domain Name in connection with a business called "Merchant Services of Canada" or any other business carried on by the Registrant. This, coupled with the demand for over \$20,000 for the Domain Name, leads the Panel to the conclusion that the Registrant acquired the Domain Name primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant as set out in paragraph 3.5 (a) and accordingly registered the Domain Name in bad faith.

4.3.3 That the Registrant has No Legitimate Interest in the Domain Name

Paragraph 3.4 of the Policy sets out circumstances which if found by the Panel would show the Registrant has a legitimate interest in the Domain Name'

3.4 Legitimate Interests. For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in a domain name:

- (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.

In paragraph 3.4(d) "use" by the Registrants includes, but is not limited to, use to identify a web site.

The Panel considered each provision and determined that none apply. Paragraph 3.4 (a) does not apply as the Registrant has no rights in the trademark of the Complainant or any other relevant mark placed into evidence

for this hearing. The Registrant provided no evidence regarding its wares or services beyond a reference to a business name of "Merchant Services of Canada" and so paragraphs (b) and (c) do not apply. The Complainant says that there is no evidence presented within the content of the website hosted at Domain Name, or the context of the Domain Name itself, that the domain was used in association with a non-commercial activity, e.g., criticism, review or news reporting. Indeed, the Registrant's evidence is that the domain was bought "to use as a near future business platform". So, this is not a case of good faith use in association with a non-commercial activity, including criticism, review or news reporting, paragraph 3.4 (d) does not apply.

The Domain Name does not comprise the legal name of the Registrant, who is an individual; nor is the Domain Name another reference by which the Registrant was commonly identified. There is no evidence as to the legal (if any) status of "Merchant Services of Canada" which the Registrant refers to as their "future business platform". Therefore, the provisions of paragraph 3.4 (e) do not apply.

The Domain Name does include the word Canada but MSCANADA is not a place name and so 3.4 (f) does not apply.

Accordingly, the Panel finds that the Complainant has provided "some evidence" that the Registrant has no legitimate interest in the Domain Name. Accordingly, the Panel finds that the Complainant has satisfied the provisions of paragraph 4.1(c) of the Policy.

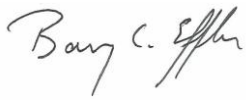
The Registrant then has the onus under the Policy to prove that they do have a legitimate interest in the Domain Name. The Registrant has not done so.

5 **DECISION and ORDER**

For the above reasons, in accordance with paragraph 4 of the Policy, Rule 12 of the Resolution Rules, the Panel orders that the registration of the Domain Name in issue be transferred to the Complainant.

Made as of July 4, 2022

SIGNATURE OF PANEL



Barry Effler C. Arb. (chair) For the Panel

Michael Erdle C.Arb.

Thomas Manson, Q.C.

