

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

Dispute Number: DCA-16370-CDRP

Domain Names: <manulifetrustcompany.ca>, <manulifetrust-gics.ca>, <manulife-trust.ca>, <manulife-registrations.ca>, <manulife-application.ca>, <manulifetrust-clients.ca>, <manulifetrust-cdic.ca>, <manulifetrust-gicoffer.ca>, and <manulifetrust-gicoffers.ca>.

Complainant: The Manufacturers Life Insurance Company.

Registrants: Bernhard Weiss, Ashley Thompson and Russell Cox

Registrars: CentralNic Canada and Go Get Canada Domain Registrar Ltd.

Panel: The Honourable Neil Anthony Brown, QC.

Service Provider: Canadian International Internet Dispute Resolution Centre.

DECISION

OVERVIEW

1. This matter concerns a dispute between the Complainant and the Registrants regarding the registration and use of the domain names <manulifetrustcompany.ca>, <manulifetrust-gics.ca>, <manulife-trust.ca>, <manulife-registrations.ca>, <manulifetrust-clients.ca>, <manulife-application.ca>, <manulifetrust-cdic.ca>, <manulifetrust-gicoffer.ca> and <manulifetrust-gicoffers.ca> (“the disputed domain names”).
2. The Canadian International Internet Dispute Resolution Centre (“CIIDRC”) is a recognized service provider to the CIRA Domain Name Dispute Resolution Policy (“the Policy”) of the Canadian Internet Registration Authority (“CIRA”).
3. This is a proceeding under the CIRA Domain Name Dispute Resolution Policy (the “Policy”) in accordance with the CIRA Dispute Resolution Rules (“the Resolution Rules”).
4. The Complainant submits that the Registrants registered the disputed domain names in breach of the Policy and that the domain names should be transferred to the Complainant.

5. The Registrants have been served with and given notice of the proceeding, but they have not filed a Response. The matter is therefore undefended.

THE PARTIES

1. **The Complainant** in this proceeding is a Canadian company, The Manufacturers Life Insurance Company, 200 Bloor Street East, Toronto, Ontario, M4W 1E5, Canada (“the Complainant”). The Complainant’s authorised representative in this proceeding is Korie Walters, CSC Digital Brand Services Group AB of Drottninggatan 92-94, Stockholm, Stockholm, 111 36, Sweden.
2. **The Registrants in this proceeding.** There are nine domain names that are the subject of this proceeding. There are three registrants of the nine domain names and each of them is the domain name holder of one or more of the domain names and hence a respondent in this proceeding (“the Registrants”). CIIDRC has informed the Panel that on November 4, 2021 it notified CIRA of the proceeding and that on November 4 and 18, 2021 CIRA transmitted by email its verification response to CIIDRC, informing it of the registrants of the domain names in question. The registrants and the respective domain names, of which they are the registrants are as follows:

Bernard Weiss – <manulifetrustcompany.ca>; <manulifetrust-gics.ca>; <manulife-trust.ca>; and <manulife-registrations.ca>.

Ashley Thompson – <manulife-application.ca>.

Russell Cox – <manulifetrust-clients.ca>; <manulifetrust-cdic.ca>; <manulifetrust-gicoffer.ca>; and <manulifetrust-gicoffers.ca>.

The address of each of the Registrants is as follows:

Bernhard Weiss:

2100 Central Road
City: Hornby
Province/State: British Columbia
Postal code/Zip code: V0R1Z0 and
Email: bernhardweiss1@outlook.com

Ashley Thompson

1235 Richmond Street
City: London, Ontario

Postal code/Zip code: N6AOC1
Email: moonlight38382@outlook.com

Russell Cox

Organization: trios
Street: 37 trios lane
City: Toronto
Province/State: Ontario
Postal code/Zip code: M5B2L9 and
Email: vlovesjim@outlook.com

As will be seen from the Procedural section of this decision, CIIDRC took steps to have the Complaint with its attachments sent to the registrants at the addresses provided by CIRA, to notify the Registrants of the administrative proceeding and to provide them with a notice containing login information and a link to give them access to the Complaint. However, delivery of the Complaint and its attachments to the Registrants at the addresses provided by CIRA were unsuccessful.

Accordingly, in this matter three separate proceeding have been instituted against three registrants involving nine domain names. This raises the issue of whether the Panel has jurisdiction to hear such a matter and, if there is an issue about that, whether it can be resolved by consolidation of the proceedings, which the Complainant has requested. The Panel now turns to that issue.

CONSOLIDATION

The issue comes about because Paragraph 3 of the Resolution Rules provides *inter alia*:

“Multiple Registrations. A Complaint may relate to more than one Registration provided that the Registration Information for all such Registrations indicates the same Registrant for all the Registrations. For greater certainty, a Proceeding may be between only one Complainant and one Registrant regardless of the number of such Registrations.”

The Complaint clearly relates to more than one registration of a domain name. It relates to nine registrations. One Complaint may not relate to nine domain names unless the registrant is the same registrant of, in this case, all nine of the domain names. That is not the case here as the record shows there are three registrants who are the registrants of one or more of the domain names that the Complainant is seeking in the proceeding.

The problem just raised is sometimes resolved by taking the approach that in a case like this, there may well be only one registrant, that is, one person who has used aliases and given the impression that the domain names have been registered by more than one person. This approach was taken in the well-reasoned decision in *Virgin Enterprises Limited v. LINYANXIAO aka lin yanxiao*, WIPO Case No. D2016-2302.

However, it is noted that the end provision of the rule on multiple registrations adds the additional complexity that “For greater certainty, a Proceeding may be between only one Complainant and one Registrant regardless of the number of such Registrations.” That provision is not contained in the UDRP Rules. It seems therefore than CIRA’s intention, although not necessarily ICANN’s intention, was that there should definitely be only one complainant and one registrant, meaning one individual even if he or she is using aliases.

That naturally raises the question of whether the separate proceedings against each registrant may be consolidated, i.e., joined and heard together, so that in the present case the three proceedings would remain three cases but would be heard and determined as one.

This is an issue to which, to its credit, the Complainant is alert, as it has noted the issue in the Complaint and made its own valuable submission of the approach that should be taken, namely that all three proceedings should be consolidated and proceed as if they were one.

The approach taken by the Panel to unravel this difficult situation and taking all of the foregoing into account, is to decide if there is only one registrant because the one person is using aliases and if not, whether the Panel should then exercise its inherent jurisdiction to order consolidation of the three proceedings on foot concerning the specified domain names.

Having regard to the evidence, the Panel finds that it is probably the case that there is only one actual registrant who has contrived to give the impression that several people have registered the domain names, whereas in reality there is only one registrant, meaning the individual who actually effected all of the registrations. The one person may of course have been in cahoots with one or more others. But what influences the Panel to think that these activities have probably been perpetrated by the one person is that the Complainant had been put under a general siege in a short period of time from, more likely than not, one person from August 22, 2021 to October 2, 2021; all of the domain names and those responsible for them have simply purloined a famous trademark as if it were common property and the domain names have all been used to carry out potential frauds and other inappropriate activities roughly at the same time.

The Panel therefore finds that the present proceeding has, within the meaning of Paragraph 3 of the Resolution Rules, been brought against “the same Registrant for all the Registrations...” and that the proceedings are against “one Registrant.”

However, the Panel also finds in the exercise of its jurisdiction that, in so far as there may be separate proceedings on foot against each of the three named Registrants, those proceedings will be consolidated and heard and determined together. The question then is whether consolidation should be allowed.

The Complainant has made out a strong case for consolidation. The evidence shows that a series of the domain names have the same host provider, several of them previously resolved to identical websites, impersonating the Complainant, several of them were registered with CentralNic Canada and the remaining ones were registered with Go Get Canada, several were connected with a discreditable and brazen phishing scam, seven of them added the word “trust” to the Complainant’s trademark and several added the word “registrations” or “application”, suggesting that there was a concerted plan afoot which originated and was being masterminded from the one common source. As the Complainant submitted, it is highly improbable that unconnected third parties would make domain name registrations at issue in this case in such a short span of time. The Panel agrees.

The proceeding may therefore go forward in its present form, on the basis that there is in reality only one registrant, but the Panel will also ORDER that the proceedings initiated by the Complainant against each of the three named Registrants be consolidated into one proceeding and be heard and determined together.

In the remainder of this decision, the expression “the Registrants” is intended to mean one of the three named Registrants or all of them collectively, as the case requires.

REGISTRATION OF THE DISPUTED DOMAIN NAMES

The disputed domain names <manulifetrustcompany.ca>, <manulifetrust-gics.ca>, <manulife-trust.ca>, <manulife-registrations.ca> and <manulifetrust-clients.ca> were registered with CentralNic Canada of *support@hexonet.net*.

The Disputed Domain Names <manulife-application.ca>, <manulifetrust-cdic.ca>, <manulifetrust-gicoffer.ca> and <manulifetrust-gicoffers.ca> were registered with Go Get Canada of *support@namecheap.com*.

The record shows that the disputed Domain Names were registered on the following dates: <manulifetrustcompany.ca > August 22, 2021; <manulifetrust-gics.ca>, August

28, 2021; <manulife-trust.ca>, August 28, 2021; <manulife-registrations.ca>, September 2, 2021; <manulifetrust-clients.ca>, September 25, 2021 ; <manulife-application.ca>, September 15, 2021; <manulifetrust-cdic.ca>, September 27, 2021; <manulifetrust-gicoffer.ca>, October 2, 2021; <manulifetrust-gicoffers.ca>, October 2, 2021.

However, as already indicated, CIRA has provided the actual registrant in the case of each domain name.

PROCEDURAL HISTORY

According to the information provided by CIIDRC and the record made available to the Panel:

- (a) The Complainant filed a Complaint with respect to the disputed domain names in accordance with the Policy on November 4, 2021.
- (b) On November 4, 2021 CIIDRC notified CIRA of the proceeding.
- (c) On November 4 and 18, 2021 CIRA transmitted to CIIDRC its verification response providing the names and contact details of the Registrants of each of the Disputed Domain Names.
- (d) The Complaint was reviewed and found to be administratively compliant. By letter dated November 24, 2021, CIIDRC as service provider confirmed to the parties administrative compliance of the Complaint and that the date of commencement of the Proceeding was November 24, 2021. The Registrants were also notified that the Response was required to be filed by December 14, 2021.
- (e) As the Complaint with the attachments was filed exclusively online, CIIDRC sent the Complaint with its attachments to the registrants at the addresses provided by CIRA.
- (f) Pursuant to Rule 4.4, on November 24, 2021, CIIDRC notified the Registrants of the administrative proceeding and a notice with login information and link to the Complaint.
- (g) Attempts to have the Complaint delivered to the Registrants at the addresses provided by CIRA were unsuccessful.
- (h) The Registrants did not file a Response in this proceeding with CIIDRC by the due date of December 14, 2021 or at all.
- (i) The Complainant in this administrative proceeding elected for a panel consisting of a single member.
- (j) On January 15, 2022, CIIDRC appointed The Honourable Neil Anthony Brown QC as sole arbitrator in this proceeding. The sole arbitrator has signed and forwarded to the CIIDRC an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.

- (k) The Panel has reviewed all of the material submitted by the Complainant and is satisfied on that material that the Complainant is an eligible Complainant under the Policy and the Rules by virtue of its being a Canadian company with its headquarters in Toronto; that the Complainant's trademark for MANULIFE was registered at the Canadian Intellectual Property Office with registration number TMA385240 and set out in Annex 1.1 to the Complaint; and the fact that the dominant part of each Disputed Domain Names is identical to that trademark, as each domain name incorporates as the first word in its string the word MANULIFE the Complainant's principal trademark.

FACTUAL BACKGROUND

The factual background set out below is taken from the Complaint, together with related annexures.

1. Founded in 1887, the Complainant is a leading Canadian-based financial services company with international operations. It is now a leading financial services company with a broad range of clients. It has a well-known name and reputation which have been acknowledged by extensive awards and public recognition. It has been operating in Canada for over 125 years.
2. The Complainant owns a series of trademarks registered in Canada and internationally ("the MANULIFE trademarks"). It also owns a series of domain names that resolve to its websites and which are actively used in conducting its business.
3. Prominent among the Complainant's trademarks are registrations for MANULIFE, MANULIFE TRUST, MANULIFE TRUST COMPANY, and other trademarks for MANULIFE with respect to a broad range of goods and services.
4. It has come to the notice of the Complainant that the Registrants have registered nine Canadian .ca domain names which are the subject of this proceeding.
5. The Complainant submits that each of the disputed domain names is confusingly similar to the MANULIFE trademarks.
6. It also submits that the Registrants have no legitimate interest in any of the domain names.
7. It also submits that the Registrants have registered each of the domain names in bad faith.
8. In support of its contentions, the Complainant relies on the fact that the domain names have clearly been registered and used to give the false impression that they either are the domain names of the Complainant or that they are authorised or approved of by the Complainant, neither of which is true. In further support of its case, the Complainant argues that the

Registrants have copied content from the Complainant's official website and used it in their own websites to create the false illusion that they are legitimate, when in fact they are false and intended to perpetrate phishing frauds on customers of the Complainant and other innocent parties.

9. Accordingly, the Complainant is seeking orders that the disputed domain names be transferred to itself to end the tarnishing of its trademarks and the damage that is being done to its business and its reputation by the Registrants.

CONTENTIONS OF THE PARTIES

A. COMPLAINANT

The Complainant made the following contentions

1. CANADIAN PRESENCE REQUIREMENTS

The Complainant submits that it satisfies the Canadian Presence Requirements for Registrants as prescribed by the Policy. That is said to be so for the following reason.

Pursuant to paragraph 1.4 of the Policy, and paragraph 2(d) of the CIRA Policies Procedures and Guidelines: Canadian Presence Requirements for Registrants (version 1.3), the dominant part of the Domain Names is identical to the trademarks for MANULIFE, MANULIFE TRUST, and MANULIFE TRUST COMPANY, owned by the Complainant and registered at the Canadian Intellectual Property Office (CIPO) registered at the CIPO, further particulars whereof will be given later in this decision.

2. THE REGISTRATION OF THE DISPUTED DOMAIN NAMES

The disputed domain names <manulifetrustcompany.ca>, <manulifetrust-gics.ca>, <manulife-trust.ca>, <manulife-registrations.ca> and <manulifetrust-clients.ca> are registered with CentralNic Canada. The Disputed Domain Names <manulife-application.ca>, <manulifetrust-cdic.ca>, <manulifetrust-gicoffer.ca> and <manulifetrust-gicoffers.ca> are registered with Go Get Canada.

The disputed Domain Names were registered between August 22, 2021 and October 2, 2021.

3. THE COMPLAINANT AND THIS ADMINISTRATIVE PROCEEDING

1. Founded in 1887, the Complainant is a leading Canadian-based financial services company with international operations, headquartered in Toronto, Ontario, Canada. It is now a prominent financial services company with a

large number and broad range of clients. It has a well-known name and reputation which have been acknowledged by extensive awards and public recognition. It has been operating in Canada for over 125 years.

2. The Complainant owns a series of trademarks registered in Canada and internationally ("the MANULIFE trademarks"). It also owns a series of domain names that resolve to its websites and which are actively used in conducting its business.
3. Prominent among the Complainant's trademarks are registrations for MANULIFE, MANULIFE TRUST, MANULIFE TRUST COMPANY, and other trademarks for MANULIFE with respect to a broad range of goods and services.
4. It has come to the notice of the Complainant that the Registrants have registered nine Canadian .ca domain names which are the subject of this proceeding.
5. The Complainant submits that each of the disputed domain names is confusingly similar to the MANULIFE trademarks.
6. It also submits that the Registrants have no legitimate interest in any of the domain names.
7. It also submits that the Registrants have registered each of the domain names in bad faith.
8. In support of its contentions, the Complainant relies on the fact that the domain names have clearly been registered and used to give the false impression that they are either the domain names of the Complainant or they are authorised or approved of by the Complainant, which is untrue. In further support of its case, the Complainant argues that the Registrants have copied content from the Complainant's official website and used it in their own websites to create the false illusion that they are legitimate, when in fact they are false and intended to perpetrate phishing frauds on customers of the Complainant and other innocent parties.
9. Accordingly, the Complainant is seeking orders that the disputed domain names be transferred to itself to end the tarnishing of its trademarks and the damage that is being done to its business and its reputation by the Registrants.

4. THE COMPLAINANT'S RELEVANT TRADEMARK RIGHTS AND THEIR USE BY THE COMPLAINANT IN ITS BUSINESS

The Complainant submits that it owns a series of registered trademarks in various jurisdictions including Canada. The registered trademarks on which the Complainant relies and which it submits are relevant to this proceeding are:

1. **MANULIFE** , registered at the Canadian Intellectual Property Office ("CIPO") on May 31, 1991 , being CA Reg. No. TMA385240;

2. **MANULIFE TRUST**, registered at the CIPO on February 25, 2013, being CA Reg. No. TMA844606;
3. **MANULIFE TRUST COMPANY**, registered at CIPO on February 25, 2013 being CA Reg. No. TMA844607;
4. **MANULIFE**, registered at the United States Patent and Trademark Office on August 31, 1993, being US Reg. No. 1790892;
5. **MANULIFE** filed at the United Kingdom Intellectual Property Office on February 18, 1987 and entered in the registry on December 6, 1989, being UK Reg. No. 1301399.
6. **MANULIFE**, registered at the European Union Intellectual Property Office on July 9, 1999, being EUTM 000540989, (collectively “the MANULIFE trademarks.”)

In support thereof, the Complainant has submitted in Annex 1 to the Complaint, documentary evidence of each of those registrations. That evidence shows that in the case of each trademark, the registered owner is the Complainant.

5. THE GROUNDS ON WHICH THE COMPLAINT IS MADE

Confusingly Similar

Complainant's Marks.

This section of the decision is based on the submissions of the Complainant and do not contain the Panel's opinion, which will be provided later in this decision. Thus, this section consists in large part of extracts from the Complainant's submission.

The Complainant submits that the disputed domain names are confusingly similar to the MANULIFE marks, which are "Marks" within the meaning of subsection 3.2(a) of the CIRA Domain Name Dispute Resolution Policy (the "Policy"), and in which Complainant had rights prior to the date of registration of the disputed domain name, and in which it continues to have rights.

The reasons why the disputed domain names are confusingly similar to the MANULIFE trademarks are said to be as follows.

First, paragraph 1.2 of the Policy states that the presence of the country code top-level domain “.ca” does not alleviate the potential confusion between a trademark and domain name. The addition lacks distinctiveness and is not sufficient to give the Disputed Domain Names an individual meaning. Thus, in determining whether the Disputed Domain Names are confusingly similar with Complainant's trademarks, the “.ca” suffix should be excluded.

The Second Level Domain of the Disputed Domain Names

<manulifetrustcompany.ca> and <manulife-trust.ca> consist solely of Complainant's MANULIFE TRUST COMPANY and MANULIFE TRUST trademarks respectively. Accordingly, those two domain names are identical to the Complainant's MANULIFE TRUST COMPANY and MANULIFE TRUST trademarks and therefore confusingly similar to the trademarks.

The Disputed Domain Names <manulifetrust-gics.ca>, <manulife-registrations.ca>, <manulife-application.ca>, <manulifetrust-clients.ca>, <manulifetrust-cdic.ca>, <manulifetrust-gicoffer.ca>, and <manulifetrust-gicoffers.ca> consist essentially of a combination of Complainant's MANULIFE and/or MANULIFE TRUST trademarks, together with the addition of the generic, descriptive terms "gics", "registrations", "application", "clients", "cdic", "gic offer" and "gic offers", respectively.

Each of those terms is closely linked and associated with Complainant's brands and trademarks. More specifically:

"gics", "gic offer" and "gic offers" – "gic" is an acronym for a product of the Complainant, namely the Guaranteed Investment Certificates that the Complainant offers its clients. Through GICs, clients can invest while knowing exactly how much they will have once investments mature, regardless of market movements. "Offer" and "offers" relate to Complainant's range of GIC products.

"registrations" and "application" – The terms "registrations" and "application" refer to signing up for services, specifically for financial services.

"clients" – the Complainant provides financial advice, insurance and wealth and asset management solutions for clients throughout the world.

"cdic" – this is an acronym for the "Canada Deposit Insurance Corporation", of which Manulife Trust Company is a member. CDIC insures deposits of up to \$100,000.

Thus, the addition of the generic, descriptive terms "gics", "registrations", "application", "clients", "cdic", "gic offer" and "gic offers", respectively, to Complainant's MANULIFE and/or MANULIFE TRUST trademarks creates domain names that are confusingly similar to Complainant's trademark and business. That is so, it is submitted, because the domain names give the impression that they are official domain names of the Complainant dealing with its business with respect to "gics" and the other terms.

Next, the Registrants' addition of a hyphen in most the Disputed Domain Names does not diminish the confusing similarity between the Disputed Domain Names

and Complainant's trademarks and should be disregarded for purposes of making this determination.

Though Complainant's representatives have performed successful takedowns of the previous websites of the Disputed Domain Names <manulifetrustcompany.ca>, <manulifetrust-gics.ca>, <manulife-trust.ca>, <manulife-application.ca>, <manulifetrust-cdic.ca> and <manulifetrust-gicoffer.ca>, the Registrants' previous use of these Disputed Domain Names contributes to the confusion. The Registrants have used the Disputed Domain Names to engage in a phishing scam, specifically targeting Complainant's customers. This suggests that the Registrants intended the Disputed Domain Names to be confusingly similar to Complainant's trademark as a means of furthering consumer confusion. As a result, the Registrants' prior use of the Disputed Domain Names to resolve to websites through which it sought to impersonate Complainant as part of a large phishing scam is further evidence that the Disputed Domain Names are confusingly similar to Complainant's trademark.

Based on the foregoing, it is submitted that the Domain Names are confusingly similar to the MANULIFE trademark, in which the Complainant had rights prior to the date of registration of the Domain Name and continues to have rights. Thereby, the Complainant submits that it satisfies the onus placed on it by clause (a) of Paragraph 3.1(a) of the Policy.

In support of its contentions, the Complainant has cited numerous prior decisions, both CIRA decisions relating to .ca domain names and analogous UDRP decisions.

No Legitimate Interest

The Complainant submits that the Registrants do not have any legitimate interest in the disputed domain name within the meaning of section 3.4 of the Policy.

The mere registration of a domain name does not give a registrant rights or legitimate interest in respect of the domain name. The Complainant has not found anything that would suggest that the Registrants have been using the MANULIFE trademark in any way that would provide legitimate rights in the name. Complainant has not found that the Registrants have any registered trademark corresponding to the Disputed Domain Names.

The Complainant did not provide the Registrants any authorization to register the Disputed Domain Names. The Registrants are not commonly known by the Disputed Domain Names, which evinces a lack of rights or legitimate interests, as is verified by the WHOIS data. Furthermore, at the time of filing the Complaint, the Registrants were using a privacy WHOIS service, which indicates a lack of legitimate interest.

The Disputed Domain Names <manulifetrustcompany.ca>, <manulifetrust-gics.ca>, <manulife-trust.ca>, <manulife-application.ca>, <manulifetrust-cdic.ca> and <manulifetrust-gicoffer.ca>, were formerly used by the Registrants to conduct a phishing scam. This shows the Registrants have never had a legitimate interest in the domain names. They simply redirected internet users to websites that copied and attempted to duplicate Complainant's official website by displaying Complainant's logo and copying the layout and colour scheme of Complainant's own website at <manulifebank.ca>.

The Registrants' objective was to deceive internet users into believing that the Disputed Domain Names and their websites were associated with Complainant. Further, inclusion of the Complainant's logo on the Disputed Domain Names' websites is a direct effort to take advantage of the fame and goodwill that Complainant has built in its brand. The Registrants' attempts to pass off the Disputed Domain Names as being affiliated with the Complainant, and/or being the Complainant, is in itself evidence of the fact that Registrants do not have legitimate interests in the Disputed Domain Names.

Such impersonations are contrary to the Policy and its objectives. Thus, the Registrants could not credibly claim that the disputed domain names were intended to be used for any legitimate purpose or interest. See **Annexes 3.1-3.3, 3.5 and 3.7-3.8** for screenshots of these Disputed Domain Names' historical websites; see also **Annex 5.1** for screenshot of Complainant's own website at <manulife.com>.

Due to the takedowns performed by Complainant's representatives, all the Disputed Domain Names currently redirect internet users to websites that resolve to blank pages that lack content, evincing a lack of rights or legitimate interests in the Disputed Domain Names.

On those grounds the Complainant submits that the Registrants have no legitimate interest in any of the domain names.

Bad Faith

The Complainant submits that the Registrants registered each of the disputed domain names in bad faith. That is said to be so for the following reasons.

First, the Complainant and its mark are famous and it has been using the mark in its business since 1887 and thus well before the domain names were registered, which was between August 22 and October 2, 2021. Registering domain names that invoke such a famous trademark as that involved in the present case has long been held by panels to infer bad faith registration.

By registering nine domain names that incorporate Complainant's MANULIFE and/or MANULIFE TRUST/MANULIFE TRUST COMPANY trademarks in their entirety, merely adding related terms, the Registrants have created domain names that are confusingly similar to Complainant's trademark. As such, the Registrants have demonstrated a knowledge of and familiarity with Complainant's brand and business. Indeed, the Registrants have used the Disputed Domain Names in connection with a phishing scam, where they seek to impersonate Complainant, which demonstrates their awareness of Complainant and is clear evidence of bad faith registration.

There can be no legitimate reason for the Registrants to have taken the Complainant's trademarks and use them in its domain names.

Therefore, at the time of registration of the Disputed Domain Names, the Registrants knew, or at least should have known, of the existence of the Complainant's trademarks and that registration of domain names containing well-known trademarks constitutes bad faith *per se*.

After first creating a strong likelihood of confusion by misappropriating the Complainant's trademarks in the Disputed Domain Names, the Registrants have attempted to impersonate Complainant, seeking to trick internet users into revealing the usernames and passwords for their bank accounts. That is clearly bad faith.

Prior to their websites being taken down, the Registrants were using the Disputed Domain Names <manulifetrustcompany.ca>, <manulifetrust-gics.ca>, <manulifetrust.ca>, <manulife-application.ca>, <manulifetrust-cdic.ca> and <manulifetrust-gicoffer.ca> fraudulently to pose as Complainant for purposes of launching a phishing attack, which is evidence of bad faith use. The Registrants displayed Complainant's logo as well as copying the general layout, aesthetic and colour scheme of Complainant's own website, and any internet user with the misfortune of mistakenly landing at the Disputed Domain Names' prior websites could easily have been deceived and misled into believing that the Disputed Domain Names were officially associated with Complainant. Having been deceived into believing that Complainant was the source of the websites, such internet user could unsuspectingly supply the Registrants with personal or financial information as part of the phishing scheme.

This shows that the Registrants intentionally attempted to pass off the websites as belonging to Complainant as part of the Registrants' phishing scheme, thus demonstrating bad faith under Policy ¶ 3.5(d).

The Disputed Domain Names all currently resolve to inactive sites and that also constitutes bad faith.

The Disputed Domain Names can only be taken as intending to cause confusion among internet users as to the source of the Disputed Domain Names, and thus, the Disputed Domain Names must be considered as having been registered and used in bad faith pursuant to Policy ¶ 4(b)(iv), with no good faith use possible. More specifically, where the Disputed Domain Names all incorporate Complainant's MANULIFE trademarks, with the mere addition of a related term in each case, there is no plausible good-faith reason or logic for the Registrants to have registered the Disputed Domain Names

Also, the sheer number of infringing domain names registered by the Registrants demonstrates that they are engaging in a pattern of cybersquatting, which is evidence of bad faith registration and use, under Paragraph 3.5(b).

The Registrants, at the time of initial filing of the Complaint, had employed a privacy service in the WHOIS information of the Disputed Domain Names <manulife-application.ca>, <manulifetrust-clients.ca>, <manulifetrust-cdic.ca>, <manulifetrust-gicoffer.ca> and <manulifetrust-gicoffers.ca> to hide its identity. Past Panels have held that this serves as further evidence of bad faith registration and use. See *Dr. Ing. H.C. F. Porsche AG v. Domains by Proxy, Inc.*, D2003-0230 (WIPO May 16, 2003).

Finally, on balance of the facts set forth above, it is more likely that the Registrants knew of and targeted Complainant's trademark, and they should be found to have registered and used the Disputed Domain Names in bad faith.

In support of its contentions, the Complainant has cited numerous prior decisions, both CIRA decisions relating to .ca domain names and analogous UDRP decisions.

The Registrants registered the Disputed Domain Names from August 22 to October 2, 2021, a date range which is significantly after Complainant filed for registration of its MANULIFE, MANULIFE TRUST and MANULIFE TRUST COMPANY trademarks with the CIPO, USPTO, UKIPO and EUIPO, and also significantly after Complainant's first use in commerce of its trademark in 1887. These dates also fall significantly after the Complainant's registration of its domain names, <manulife.com>, on February 14, 1994, <manulife.ca> on October 13, 2000, <manulifebank.ca> on October 17, 2000, and <manulifetrust.com> and <manulifetrust.ca> on September 24, 2009.

That concludes the submissions of the Complainant.

B. THE REGISTRANTS

The Registrants did not file a Response to this proceeding.

DISCUSSION OF THE ISSUES AND FINDINGS

1. CANADIAN PRESENCE REQUIREMENTS

Paragraph 1.4 of the Policy provides that a complainant initiating a complaint must satisfy the Canadian Presence Requirements for Registrants in respect of the domain name that is the subject of the proceeding.

Paragraph 2 (d) of the Canadian Presence Requirements for Registrants establishes that requirement if the entity concerned is “A corporation under the laws of Canada or any province or territory of Canada;...”. The Panel finds that the Complainant has satisfied the Canadian Presence Requirements because it is, as the Complainant says, “Canada based” with an address in Toronto, making it “A corporation under the laws of Canada or any province or territory of Canada” and, hence, bringing it within the meaning of paragraph 2(d) of the Canadian Presence Requirements for Registrants (version 1.3)”.

Secondly, pursuant to paragraph 2(q) of the guidelines the dominant part of the Domain Names is identical to the trademark for MANULIFE, owned by the Complainant and registered at the Canadian Intellectual Property Office (CIPO).

The Complainant has therefore satisfied CIRA's Canadian Presence Requirement for Registrants in respect of the disputed domain names.

2. REGISTRATION OF THE DISPUTED DOMAIN NAMES

The Panel finds on the evidence that the disputed domain names at issue are <manulifetrustcompany.ca>, <manulifetrust-gics.ca>, <manulife-trust.ca>, <manulife-registrations.ca>, <manulifetrust-clients.ca>, <manulife-application.ca>, <manulifetrust-cdic.ca>, <manulifetrust-gicoffer.ca> and <manulifetrust-gicoffers.ca> (“the disputed domain names”).

The Panel finds on the evidence that each of the disputed domain names has been registered and is subject to this procedure. Particulars of the registration of the domain names, their Registrants and other matters relating to the domain names have already been set out in this decision and the Panel incorporates here the findings made in that regard.

3. GENERAL

The purpose of the Policy, as stated in paragraph 1.1, is to provide a forum in which cases of bad faith registration of .CA domain names can be dealt with relatively inexpensively and quickly.

In accordance with paragraph 4.1 of the Policy, to succeed in the Proceeding, the Complainant must prove, on the 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 3.5 or generally;

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 now deal with each of the three elements.

CONFUSINGLY SIMILAR

As the Complainant correctly submits, it is required to prove that the disputed domain name is confusingly similar to a Mark in which the Complainant had rights prior to the date of registration of the disputed domain name and continues to have such Rights. The Complainant must therefore show that it has rights to a mark, that it had those rights before the domain name was registered, that it still has them and that the disputed domain name is confusingly similar to the marks on which it relies to establish that proposition. The Complainant submits that it can meet those requirements. The Panel agrees.

The Mark

The first question that arises is whether the Complainant has a trademark on which it can rely for the purpose of this proceeding.

The Complainant relies on several trademarks to give it standing to bring this proceeding. The registered trademarks on which the Complainant relies and which it submits are relevant to this proceeding are:

1. **MANULIFE** , registered at the Canadian Intellectual Property Office ("CIPO") on May 31, 1991 , being CA Reg. No. TMA385240);
2. **MANULIFE TRUST**, registered at the CIPO on February 25, 2013, being CA Reg. No. TMA844606;
3. **MANULIFE TRUST COMPANY**, registered at CIPO on February 25, 2013 being CA Reg. No. TMA844607;
4. **MANULIFE**, registered at the United States Patent and Trademark Office on August 31, 1993, being US Reg. No. 1790892;
5. **MANULIFE** filed at the United Kingdom Intellectual Property Office on February 18, 1987 and entered in the registry on December 6, 1989, being UK Reg. No. 1301399.
6. **MANULIFE**, registered at the European Union Intellectual Property Office on July 9, 1999, being EUTM 000540989 (collectively "the MANULIFE trademarks.")

In support thereof, the Complainant has submitted in Annex 1 to the Complaint, documentary evidence of each of those registrations which the Panel accepts. That evidence shows that in the case of each trademark, the registered owner is the Complainant. These trademarks are referred to collectively as "the MANULIFE trademarks."

The question also arises whether the MANULIFE trademarks are "mark(s) "in which the Complainant had rights prior to the date of registration of the disputed domain names and continues to have such rights". Pursuant to the evidence adduced by the Complainant, the Panel finds that each of the MANULIFE trademarks is a mark "in which the Complainant had rights prior to the date of registration of the disputed domain names and continues to have such rights".

Are the disputed domain names Confusingly similar to the MANULIFE trademarks?

Pursuant to paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if it so nearly resembles the same in appearance, sound or in the ideas suggested so as to be likely to be mistaken for the mark. The test to be applied when considering "confusingly similar" is one of first impression and imperfect recollection and the "dot-ca" suffix should be excluded from consideration (see *Coca-Cola Ltd. v. Amos B. Hennan*, BCICAC Case No. 00014).

Having regard to those principles, the Panel finds that the disputed domain names are confusingly similar to the the MANULIFE trademarks. That is so for the following reasons.

The Domain Names are confusingly similar to the MANULIFE trademarks because they contain the entirety of one of the trademarks in each domain name and an internet user would naturally conclude for that reason that the domain names have been registered by and are primarily dealing with the well-known and well-established MANULIFE mark that is the trademark of a prominent company that has been engaged in business in Canada for over 125 years. Indeed, it must be apparent to an objective bystander making an honest appraisal of the evidence that the domain names were created intentionally to copy the MANULIFE trademarks as part of a sustained campaign to put the Complainant under a cybersquatters' attack by means of a fraudulent phishing fraud.

In particular, the Complainant has submitted and persuasively argued that he Disputed Domain Names <manulifetrust-gics.ca>, <manulife-registrations.ca>, <manulife-application.ca>, <manulifetrust-clients.ca>, <manulifetrust-cdic.ca>, <manulifetrust-gicoffer.ca>, and <manulifetrust-gicoffers.ca> consist essentially of a combination of Complainant's MANULIFE and/or MANULIFE TRUST trademarks, together with the addition of the generic, descriptive terms "gics", "registrations", "application", "clients", "cdic", "gic offer" and "gic offers", respectively.

It is also submitted that each of those terms is closely linked and associated with Complainant's brands and trademarks. More specifically:

"gics", "gic offer" and "gic offers" – "gic" is an acronym for a product of the Complainant, namely the Guaranteed Investment Certificates that the Complainant offers its clients. Through GICs, clients can invest while knowing exactly how much they will have once investments mature, regardless of market movements. "Offer" and "offers" relate to Complainant's range of GIC products. See **Annex 6.6**.

"registrations" and "application" – The terms "registrations" and "application" refer to signing up for services, specifically for financial services.

"clients" – the Complainant provides financial advice, insurance and wealth and asset management solutions for clients throughout the world.

"cdic" – this is an acronym for the "Canada Deposit Insurance Corporation", of which Manulife Trust Company is a member. CDIC insures deposits of up to \$100,000.

Thus, the Panel's conclusion is that the addition of the generic, descriptive terms "gics", "registrations", "application", "clients", "cdic", "gic offer" and "gic offers", respectively, to Complainant's MANULIFE and/or MANULIFE TRUST trademarks creates domain names that are confusingly similar to Complainant's trademark.

Accordingly, the Panel finds that disputed domain names are, for the purposes of the Policy, confusingly similar to the **MANULIFE** trademarks as they so nearly resemble the marks in appearance, sound and in the ideas suggested as to be likely to be mistaken for the marks within the meaning of Paragraph 3.3 of the Policy.

The Panel therefore concludes that each of the disputed domain names is confusingly similar to **MANULIFE trademarks** in which the Complainant had rights prior to the registration date of the disputed domain names and in which it continues to have such rights.

The Complainant has thus made out the first of the three elements that it must prove.

NO LEGITIMATE INTEREST IN THE DOMAIN NAMES

The Panel has examined the evidence submitted by the Complainant and finds that the Registrants do not have any legitimate interest in the disputed domain names within the meaning of section 3.4 of the Policy. Indeed, its actions are those of a party whose motivations are solely to copy the Complainant's trademarks, purloin them, pretend that it is the Complainant and to use the Complainant's trademarks and its fame and reputation to perpetrate an illegal scam and damage the Complainant's reputation to the benefit of the Registrants.

The evidence is that the Complainant has not found anything that would suggest that the Registrants have been using the **MANULIFE** trademark in any way that would provide legitimate rights in the name. The Panel agrees with that conclusion. The Complainant also has not found that the Registrants have any registered trademark corresponding to the Disputed Domain Names. That likewise denies the Registrants a legitimate interest in the domain names.

Moreover, the Complainant has not provided the Registrants with any authorization to register the Disputed Domain Names.

It is clear from the evidence that the Registrants are not commonly known by the Disputed Domain Names, which evinces a lack of rights or legitimate interests. This has been verified by the WHOIS data for the Disputed Domain Names set forth in Annex 3 to the Complaint. In the instant case, the pertinent WHOIS information identifies the Registrants as "Bernhard Weiss", "Ashley Thompson" and "Russell Cox", none of which resemble the Disputed Domain Names in any manner.

Furthermore, at the time of filing the complaint, the Registrants were using a privacy WHOIS service, which indicates a lack of legitimate interest.

These facts negate any suggestion that the Registrants could have any legitimate interest in any of the domain names.

It should also be remembered, because it is part of the basis of the claim by the Complainant, that the Disputed Domain Names <manulifetrustcompany.ca>, <manulifetrust-gics.ca>, <manulife-trust.ca>, <manulife-application.ca>, <manulifetrust-cdic.ca> and <manulifetrust-gicoffer.ca>, were formerly used by the Registrants to conduct a phishing scam. They simply redirected internet users to websites that copied and attempted to duplicate Complainant's official website by displaying Complainant's logo and copying the layout and colour scheme of Complainant's own website at <manulifebank.ca>.

The Registrants' objective was clearly to deceive internet users into believing that the Disputed Domain Names and their websites were associated with Complainant. Further, the Registrants' inclusion of the Complainant's logo on the Disputed Domain Names' websites was a direct effort to take advantage of the fame and goodwill that Complainant has built in its brand. On the evidence, the Registrants attempted to pass the Disputed Domain Names off as being affiliated with the Complainant, and in fact as being the Complainant. That is, in itself, evidence of the fact that the Registrants do not have rights and legitimate interests in the Disputed Domain Names pursuant to ¶3.4(a)-(d) or on any other basis.

The Complainant submits and the Panel agrees, that such impersonations are contrary to the Policy and its objectives. Thus, the Registrants could not credibly claim that the disputed domain names were intended to be used for any legitimate purpose or interest. The evidence submitted in Annexes 3.1-3.3, 3.5 and 3.7-3.8 to the Complaint by way of screenshots of these Disputed Domain Names' historical websites and Annex 5.1 of screenshot of Complainant's own website at <manulife.com> establish the point.

Due to the takedowns performed by Complainant's representatives, all the Disputed Domain Names currently redirect internet users to websites that resolve to blank pages that lack content, evincing a lack of rights or legitimate interests in the Disputed Domain Names. See **Annex 3**.

The Complainant has therefore provided not only "some evidence" that the Registrants have not brought themselves within any of the specific criteria in paragraph 3.4, which it is obliged to do, but a great deal of evidence which, to the Panel's mind, is very strong. Moreover, in each of the criteria, the facts simply cannot be accommodated in any of those provisions.

The Complainant has shown very persuasively that on the available evidence and inferences that can be drawn from it, the Registrants have no legitimate interest in any of the disputed domain names.

The Panel has also examined each of the circumstances set out in the various sub-paragraphs of paragraph 3.4 of the Policy. It is apparent to the Panel that the Registrants could not conceivably bring themselves within any of the circumstances in those sub-paragraphs. The Registrant has in effect taken the Complainant's trademark, set itself up as a competitor of the Complainant, tried to pass itself off as the Complainant, and laid the foundations for perpetrating a fraud on customers of the Complainant and no doubt others innocent parties who might fall for the trap set by the Registrants.

The conduct revealed by the evidence could never give rise to a legitimate interest in a domain name. It is illegal and unprincipled in every respect and cannot possibly justify the registration or use of the domain names.

Finally, and underlying all of these considerations is the fact that the Registrant had an unlimited opportunity of presenting its case, but has forfeited that opportunity by not filing a Response and has not tried in any way to show it has a legitimate interest in the domain names.

The Complainant has thus established the second of the three elements that it must prove.

REGISTRATION IN BAD FAITH

The Panel now turns to consider whether the disputed domain name was registered in bad faith. In that regard, the Panel notes that, consistent with the decision in *Canadian Broadcasting Corporation? Societes Radio-Vanada v. William Quon*, CIRA Dispute Number 00006(April 8, 2003), pp.13-14, surrounding circumstances may be considered in assessing whether the disputed domain name has been registered in bad faith.

Having regard to the evidence, the Panel finds that the Complainant has proved, within the meaning of clause 3.1 of the Policy, that:

“(a)...;

(b)...;

(c) 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;

- (d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other on-line 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."

The evidence brings the Registrants within those provisions. The registrants became competitors of the Complainant by their own acts and they sought to create confusion by their thinly veiled pretence of providing services to the public while they were really intent on perpetrating a fraud. The Panel has examined all of the evidence carefully and has concluded that it shows that the Registrants also registered the domain names in circumstances that can fairly be described as bad faith within the generally accepted meaning of that expression. Indeed, there is no other interpretation that can be placed on the evidence.

The Panel finds that the intention of the Registrants was to register the domain names because they reflected the Complainant's established trademarks in the financial market and to use them for an illegal purpose to further their own interests and for a purpose that would benefit the Registrants financially by taking away some of the Complainant's potential business. That conduct constitutes bad faith registration on any test.

In particular, the Panel agrees with the contentions of the Complainant. First, the Registrants copied the Complainant's famous mark, long held by panels to infer bad faith registration. The Registrants created domain names that are confusingly similar to the Complainant's trademark. The Registrants thereby demonstrated a knowledge of and familiarity with Complainant's brand and business. The Registrants used the Disputed Domain Names in connection with a phishing scam, where it sought to impersonate Complainant, which demonstrated its awareness of the Complainant, which is clear evidence of bad faith registration.

The Panel also agrees with the Complainant that the Registrants created a strong likelihood of confusion by misappropriating the Complainant's trademarks in the Disputed Domain Names, attempted to impersonate Complainant, sought to trick internet users into revealing the usernames and passwords for their bank accounts, copied the general layout, aesthetic and colour scheme of Complainant's own website, sought to engender the notion that the Disputed Domain Names were officially associated with Complainant and tried to induce internet users to give up their personal or financial information as part of this phishing scheme, attempted to pass off their websites as belonging to Complainant as part of their phishing scheme

and clearly intended to cause confusion among internet users as to the source of the Disputed Domain Names. Thus, the Disputed Domain Names must be considered as having been registered and used in bad faith with no good faith use possible. There is also no plausible good-faith reason or logic for the Registrants to have registered any of the Disputed Domain Names. Moreover, the sheer number of infringing domain names registered by the Registrants demonstrates that they have engaged in a pattern of cybersquatting, which is evidence of bad faith registration and use, under Paragraph 3.5(b).

The evidence therefore does not admit of any conclusion other than that the Registrants registered all of the disputed domain names in bad faith.

In support of its contentions on this and other issues, the Complainant has effectively cited numerous prior decisions, both CIRA decisions relating to .ca domain names and analogous UDRP decisions.

The Complainant has thus made out the third of the three elements that it must establish.

CONCLUSION AND DECISION

The Panel finds that the constituent elements of the Policy have all been made out and that the Complainant is entitled to the relief it seeks. The Panel will therefore order that the disputed domain names be transferred to the Complainant.

ORDERS

The Panel orders that the registration of the disputed domain names <manulifetrustcompany.ca>, <manulifetrust-gics.ca>, <manulife-trust.ca>, <manulife-registrations.ca> , <manulifetrust-clients.ca> , <manulife-application.ca>, <manulifetrust-cdic.ca>, <manulifetrust-gicoffer.ca> and <manulifetrust-gicoffers.ca> be transferred from their respective Registrant to the Complainant.

Date: January 20, 2022

The Honourable Neil Anthony Brown, QC