

**IN THE MATTER OF A COMPLAINT MADE PURSUANT TO THE CANADIAN
INTERNET REGISTRATION AUTHORITY DOMAIN NAME DISPUTE
REGISTRATION RESOLUTION POLICY (v 1.1) AND RULES (v 1.2)**

Complainant: The Hospital for Sick Children
525 University Avenue, 10th Floor
Suite 1030
Toronto, ON, M5G 2L3
(the “Complainant”)

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Registrant: Toronto Sick Children Society
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Administrative Contact: Bin Ojemma
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Disputed Domain Name: sickchildren.ca
(the “Domain Name”)

Registrar: Netfirms, Inc.

Single Member Panel: R. John Rogers

Service Provider: British Columbia International
Commercial Arbitration Centre (the “BCICAC”)

BCICAC File: DCA-1201-CIRA

PROCEDURAL HISTORY

The BCICAC is a recognized service provider pursuant to the Domain Name Dispute Resolution Policy (v 1.1) (the “Policy”) and Rules (v 1.2) (the “Rules”) of the Canadian Internet Registration Authority.

The Complainant filed a complaint dated November 30, 2009 (the “Complaint”) with the BCICAC seeking an order in accordance with the Policy and the Rules directing that registration of the Domain Name be transferred from the Registrant to the Complainant.

The BCICAC determined the Complaint to be in administrative compliance with the requirements of Rule 4.2 and, by letter of transmittal dated November 30, 2009 (the “Transmittal Letter”), forwarded a copy of the Complaint to the Registrant to serve as notice of the Complaint in accordance with Rules 2.1 and 4.3. The Transmittal Letter determined the date of the commencement of proceedings in accordance with Rule 4.4 to be November 20, 2009, although this appears to be a typographical error intending rather that this date should be November 30, 2009. In any event, the Transmittal Letter advised the Registrant that in accordance with the provisions of Rule 5, a Response to the Complaint was to be filed within 20 days of the date of commencement of proceedings, or December 20, 2009.

By email dated January 7, 2010, the Registrant requested an extension of time for filing its response from December 20, 2009 to February 19, 2010. By letter dated January 8, 2010, the BCICAC advised the Registrant that under the Rules the Registrant should have submitted to the BCICAC prior to December 20, 2009 a written request for an extension of time to file the Response. As the Registrant was past this December 20, 2009 deadline, the BCICAC advised the Registrant that it would not entertain its application for an extension of time and advised the Registrant to seek this extension from the Panel in this matter.

By letter dated January 8, 2010, a copy of which was sent to the Registrant, the BCICAC advised the Complainant that as the BCICAC had not received a Response to the Transmittal Letter within the permitted time limit, that in accordance with the Complainant’s right to elect pursuant to Rule 6.5 the panel in this matter was being converted from a three member panel to a single member panel.

The undersigned was appointed by the BCICAC as the Single Member Panel by letter dated January 8, 2010. The undersigned filed his Acceptance of Appointment as the Single Member Panel and Statement of Independence and Impartiality with the BCICAC on January 8, 2010 and determines that he has been properly appointed and constituted as the Single Member Panel to determine the Complaint in accordance with the Rules.

Following the appointment of the Panel, the Panel sought submissions from the Complainant on the Registrant’s request for an extension of time within which to file its Response. The Complainant objected to granting such an extension.

By email dated January 27, 2010, the Panel confirmed with the Registrant that it would not grant the requested extension to file a Response, but that it would entertain submissions from the Registrant as to why the remedy sought by the Complainant should not be granted by the Panel, provided that such submissions from the Registrant were received by the Panel by February 1, 2010. By email dated January 30, 2010, the Registrant made such submissions to the Panel. The Complainant was asked to respond to the Registrant's submissions and did so by email dated February 4, 2010. These submissions the Panel have included in its consideration of this matter.

CANADIAN PRESENCE REQUIREMENTS

The Canadian Presence Requirements for Registrants v 1.3 ("Presence Requirements") require that to be permitted to apply for registration of, and to hold and maintain the registration of, a .ca domain name, the applicant must meet at least one of the criteria listed as establishing a Canadian presence. Section 2(d) of the Presence Requirements specifies that a corporation incorporated under the laws of Canada or any province or territory of Canada has the requisite Canadian presence.

The Complainant is currently registered in the Province of Ontario as an Ontario Non-share corporation under registration number 5201. The Complainant, therefore, meets the Canadian presence requirements.

ALL TECHNICAL REQUIREMENTS MET

Based upon the information provided by the BCICAC, the Panel finds that all technical requirements for the prosecution of this proceeding have been met, and, no Response to the Complaint having been filed by the Registrant within the time limit established by the Rules, the Panel finds that pursuant Rule 5.8 the Panel is to decide this proceeding on the basis of the Complaint, subject only to consideration of the aforementioned submissions by the Registrant and the Complainant.

Rule 12.2 requires that in the absence of exceptional circumstances, the Panel is to forward its decision in this matter to the BCICAC by January 29, 2010. The Panel finds that these exceptional circumstances exist and exercises the authority granted it by Rule 9.1(c) to extend this date from January 29, 2010 to February 10, 2010.

FACTS

The facts put forward by the Complainant are summarized as follows:

1. The Complainant was incorporated on April 14, 1892 under the corporate name THE HOSPITAL FOR SICK CHILDREN.
2. The Complainant is the owner of the following Canadian official marks (the "Official Marks") obtained pursuant to s. 9(1)(n)(iii) of the *Trade-marks Act* of Canada, R.S.C. 1985 c.T-13 (the "Act"):

Official Mark	Reg. No.	Reg. Date
SICKKIDS THE HOSPITAL FOR SICK CHILDREN Design	916244	May 11, 2005
SICK KIDS THE HOSPITAL FOR SICK CHILDREN Design	916241	June 1, 2005
THE HOSPITAL FOR SICK CHILDREN & Design	901990	July 3, 1985

3. The Complainant together with its licensees has used its corporate name and, following at least their registration date, the Official Marks continuously and extensively throughout Canada since June 1995.
4. The use of its corporate name and the Official Marks have been used in connection with fundraising, the hosting of charitable events, and the provision of grants for the benefit of the Complainant's medical services relating to the betterment of the health of children in Canada and worldwide.
5. Over the years since its incorporation, the hospital operated by the Complainant has become known as "Sick Kids".
6. To assist it in its fundraising efforts, the Complainant has established a foundation called the "Sickkids Foundation" (the "Foundation").
7. Pursuant to s. 9(1)(n)(iii) of the Act and commencing in 1999, the Complainant has obtained official marks incorporating the words SICK KIDS and SICK KIDS FOUNDATION (the "Sick Kids Official Marks").
8. The Foundation is a licensee of one or more of the Official Marks and the Sick Kids Official Marks.
9. Since at least October 10, 2000, the Complainant has operated a website, www.sickkids.ca, upon which the Official Marks and the Sick Kids Official Marks are prominently displayed.
10. Similarly, since July 2005, the Foundation has prominently displayed on its website, www.sickkidsfoundation.com, one or more of the Official Marks and the Sick Kids Official Marks.
11. Since June 1995, the Complainant has advertised and promoted one or more of the Official Marks and the Sick Kids Official Marks by distributing promotional materials; and during this time period has had press coverage both in the Canadian and international press referring to one or more of the Official Marks or the Sick Kids Official Marks.
12. The Registrant registered the Domain Name on October 11, 2007.
13. The Domain Name resolves to the Registrant's website which prominently displays the banner of the Complainant's hospital facilities on each of its pages.
14. The Complainant alleges that the Registrant is using one or more of the Official Marks and the Sick Kids Official Marks on its website for the purpose of appearing to be fundraising for the Complainant without the Complainant's knowledge or consent.
15. The Complainant first learned of the Registrant's use of the Domain Name when it received a telephone call from a former employee inquiring about the presence of donation tins found at College Park in the City of Toronto.

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16. On the same day, the Complainant received another inquiry regarding donation tins distributed throughout Yorkdale Mall in the City of Toronto.
17. These donation tins had labels affixed to them which included a picture of a sick child in a hospital setting, the name of the Foundation, the Complainant's toll free telephone number, and the domain name for the Complainant's website, www.sickkids.ca.
18. These labels also included the Registrant's telephone number together with the phrase:

A drop in a Bucket Safes Life!
For a tax receipt drop your check inside".
19. The Complainant has never used nor supported the use of tin cans in raising funds.
20. The Complainant does not support the Registrant's efforts on its behalf and denies at any time authorizing the Registrant to use of the Official Marks and the Sick Kids Official Marks or encouraging the Registrant or any other party to raise funds on its behalf without its prior express authority.
21. The Complainant subsequently filed a police report against the Registrant and on November 27, 2009 following a police investigation, the Toronto Police Service released a public alert through a press release alerting the public to the presence of these donation tins.

In its submissions, the Registrant does not appear to deny any of the facts put forward by the Complainant. Rather, the Registrant's submissions include the following additional matters:

1. The Registrant does not challenge the Complainant's right to the Official Marks or to the Sick Kids Official Marks and confirms the "important roles" the Complainant plays in the Toronto community and nationwide.
2. The address of the Registrant is 415 Oakdale Road, Unit 217, Toronto, Ontario, Canada, M3N 1W7.
3. The Registrant is a grass-root community organization which operates within the City of Toronto. It was incorporated in April of 2004 and was issued supplementary letters patent and approved as a charity on March 3, 2006.
4. The sole corporate object of the Registrant appears to be to support the Complainant. As the Registrant has contact with many members of the community, it seeks to support the Complainant by acting as its advocate, advertiser, marketing office and fundraiser within this community.
5. This support is carried out in various ways, including, but not limited to fundraising, creating publicity and awareness, and encouraging donations for the Complainant.
6. In 2006, the Registrant using the Domain Name launched a website "to facilitate its objects to attract supporters and donations on behalf of the Complainant".
7. Some weeks after its launch, due to a complaint from staff of the Complainant, this website was disabled.
8. In October, 2009, some volunteers from the Registrant's office determined to organize a fundraising effort to benefit the Complainant. One of these volunteers

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- contacted the Complainant's office by telephone and was allegedly given permission to solicit donations for the benefit of the Complainant at food courts and malls using tin cans, provided that these cans contained printed labels with proper information concerning the Complainant. These labels also included the Registrant's telephone number.
9. The Foundation's website, www.sickkidsfoundation.com, invites people to use various methods to raise funds on the Complainant's behalf and in doing so does not impose any condition or the requirement of first receiving permission from the Complainant prior to conducting such fund raising activities.
 10. Based upon the telephone conversation with the Complainant's representative and the content of the Foundation's website, the Registrant believes it has received a form of implied permission from the Complainant to use the Official Marks and the Sick Kids Official Marks.

REMEDIES SOUGHT

The Complainant seeks an order from the Panel in accordance with paragraph 4.3 of the Policy instructing the Registrar of the Domain Name to transfer the Domain Name to the Complainant.

The Registrant, on the other hand, seeks an order from the Panel to transfer the Domain Name to the Complainant "with adequate compensation as both parties may determine, provided that it is used for the furtherance of activities of sick children in the City of Toronto and nationwide".

THE POLICY

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

Paragraph 4.1 of the Policy puts the onus on the Complainant to demonstrate this "bad faith registration" by proving on a balance of probabilities that:

1. the Official Marks qualify as a "Mark" as defined in paragraph 3.2 of the Policy;
2. the Complainant had "Rights" (as "Rights" are defined in paragraph 3.3 of the Policy) in the Official Marks prior to the date of registration of the Domain Name and continues to have "Rights" in the Official Marks,
3. the Domain Name is "Confusingly Similar" to the Official Marks as the concept of "Confusingly Similar" is defined in paragraph 3.4 of the Policy;
4. the Registrant has registered the Domain Name in "bad faith" in accordance with the definition of "bad faith" contained in paragraph 3.4 of the Policy; and
5. the Registrant has no "legitimate interest" in the Domain Name as the concept of "legitimate interest" is defined in paragraph 3.6 of the Policy.

If the Complainant is unable to satisfy this onus, bad faith registration is not demonstrated and the Complaint fails.

MARK

The relevant portion of paragraph 3.2 of the Policy states that for the purpose of the Policy a “Mark” is:

- (d) the alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of which the Registrar of Trade-marks has given public notice of adoption and use pursuant to paragraph 9(1)(n) of the *Trade-marks Act* (Canada).

Since July 1985, the Complainant has used one or more of the Official Marks in Canada to distinguish its provision of services from another provider of similar services. The Complainant continues to use the Official Marks.

The Official Marks clearly qualify as a “Mark” pursuant to paragraph 3.2(d) of the Policy.

RIGHTS

The relevant portion of paragraph 3.3 of the Policy states that for the purpose of the Policy the Complainant has “Rights” in the Official Marks if:

- (c) in the case of paragraph 3.2(d), public notice of adoption and use was given at the request of that person.

As noted above in the examination of the qualification of the Official Marks as a “Mark”, paragraph 3.2(d) of the Policy applies and as public notice of use was given as early as July 1985, the Complainant, therefore, has “Rights” in the Official Marks.

CONFUSINGLY SIMILAR

Policy paragraph 3.4 provides that the Domain Name will be “Confusingly Similar” to the Official Marks if the Domain Name so nearly resembles the Official Marks in appearance, sound or the ideas suggested by the Official Marks as to be likely to be mistaken for the Official Marks.

In the matter at hand, the Domain Name consists of the words contained in the Official Marks, but without the words “SICKKIDS THE HOSPITAL FOR”, without the space between the words SICK and CHILDREN and with out the .ca suffix. As paragraph 1.2 of the Policy defines the Domain Name for the purpose of this proceeding to exclude the .ca suffix, the portion of the Domain Name consisting of “SICKCHILDREN” is the portion relevant for this proceeding.

Therefore, to satisfy the onus placed upon it by the Policy, the Complainant must demonstrate that the “SICKCHILDREN” portion of the Domain Name so nearly resembles the Official Marks in appearance, sound or the ideas suggested by the Official Marks as to be likely to be mistaken for the Official Marks.

To start with the spacing difference between the wording of the Official Marks and the Domain Name. It is clear from decisions of other panels that where, apart from the

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omission of a space, the Mark uses the same words as the domain name under consideration, that the domain name and the mark are considered “identical”. See for example, *Discovery Toys, Inc. v. Ebenezer Therasagayam* (CIRA Dispute Resolution Decision # 00118), and *Extreme Fitness Inc. v. Gutam Relan* (CIRA Dispute Resolution Decision # 0019). The Panel finds that the spacing difference between the wording of the Official Marks and the Domain Name is not sufficient to render the Domain Name different from the Official Marks for the purpose of the Policy.

To deal with the exclusion of the words “SICKKIDS THE HOSPITAL FOR” from the Domain Name.

On the face of it, the Domain Name could very well be taken not to be confusingly similar to the Official Marks in that the Domain Name consists of two generic words “sick” and “children” joined together to make a domain name. Such a domain name could very well be used by the Registrant in a context which has nothing to do with the Complainant and does not in any manner constitute a passing off or a trading upon the goodwill of the Complainant.

However, such is not the case here. The Registrant in its own submissions has acknowledged that its sole corporate object is to support the Complainant. It would appear that it has designed its identity in such a manner so as to facilitate it carrying out this corporate objective by, among other initiatives, including the words “sick children” in both its corporate name and its website through the use of the Domain Name. By its own admission, its intention is to have a website that is confusingly similar to the Complainant’s Official Marks so that the Registrant will be in a position to assist the Complainant in the Complainant’s fund raising activities. Unfortunately, it would appear that the Complainant is not receptive to the Registrant’s efforts on its behalf.

In determining whether or not the Domain Name is confusingly similar to the Official Marks, the Panel must consider the context in which the Domain Name is used. Here the context clearly confirms that the Registrant registered as the Domain Name a name which resembles the Official Marks in appearance, sound or the ideas suggested by the Official Marks so as to be likely to ensure in the mind of the public an intimate relationship with the Complainant and the Official Marks.

The Panel finds considering the Domain Name and the Official Marks in the context of the evidence before it that the omission of the words “SICKKIDS THE HOSPITAL FOR” is not sufficient to distinguish the Domain Name from the Official Marks and finds that the Complainant has satisfied the onus of demonstrating that the Domain Name is “Confusingly Similar” to the Official Marks in accordance with paragraph 3.4 of the Policy.

BAD FAITH

Under paragraph 3.7 of the Policy, the Registrant will be considered to have registered the Domain Name in bad faith if, and only if, the Complainant can demonstrate that the Registrant in effecting the registration of the Domain Name was motivated by any one of

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the three general intentions set out in paragraph 3.7. Of these intentions, the form of intention contained in paragraph 3.7(c) is the one most applicable to the matter at hand.

Paragraph 3.7(c) provides as follows:

(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.

Although there is before the Panel the Registrant's intention to align itself with the Complainant, there is no direct evidence of the Registrant's intention in registering the Domain Name. Such intention must therefore be based upon a common sense inference from the website to which the Domain Name resolves (the "Domain Name Website") and from the Registrant's use of this website.

As well, in determining the Registrant's intention, the Panel must be cognizant of the wording of paragraph 3.7(c) which requires both that the Complainant be a competitor of the Registrant and that the Registrant's *primary* purpose in registering the Domain Name is the disruption of the business of the Complainant.

It is clear from the evidence before the Panel that the Registrant is intent in trading off the goodwill and reputation of the Complainant. The Panel was provided with numerous examples where the Registrant has used the both the Complainant's Official Marks and the Sick Kids Official Marks on the Domain Name Website without the approval of the Complainant or the Foundation. Indeed, as noted above, in its submissions the Registrant suggests that the "sole" purpose of the Registrant is to support the Complainant.

It is also clear from the evidence before the Panel that the Registrant is in competition with the Complainant. This evidence is that the Registrant has placed donation tins seeking donations in areas where the Complainant was fundraising.

Common sense suggests that a person familiar with the Complainant, its work, and the Official Marks and Sick Kids Official Marks would believe that the Domain Name Website displaying the Official Marks and the Sick Kids Official Marks was that of the Complainant's and, wishing to support the Complainant's work, would make donations through the Domain Name Website.

It is obvious that the Domain Name Website is designed to compete directly with and to disrupt the business of the Complainant by trading off the goodwill and reputation of the Complainant. The Panel finds that the Registrant registered the Domain Name primarily for the purpose of disrupting the business of one of its competitors, the Complainant, and that the Complainant has, therefore, demonstrated that the Registrant registered the Domain Name in bad faith.

NO LEGITIMATE INTEREST

Paragraph 4.1 of the Policy requires that to succeed in the Complaint, the Complainant must provide some evidence that the Registrant has no legitimate interest in the Domain Name as the concept of “legitimate interest” is provided for in paragraph 3.6.

Paragraph 3.6 of the Policy provides that:

The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint was submitted:

- (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 used 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 used 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 paragraphs 3.6 (b), (c), and (d) “use” by the Registrants includes, but is not limited to, use to identify a web site.

In its submissions, the Registrant appears to rely on the provisions of paragraph 3.6(e) of the Policy in submitting that the name of the Registrant includes the words “Sick Children” which is part of the Domain Name.

It is to be noted that in paragraphs 3.6(a), (b), (c), and (d), there is a requirement that the Registrant use the Domain Name “in good faith”. The evidence before the Panel is not that the Registrant uses the Domain Name in good faith, but rather to the contrary, that

the Registrant uses the Domain Name to trade upon the goodwill of the Complainant. Therefore, the provision of these paragraphs do not apply.

Paragraph 3.6(f) doesn't apply as there is no geographical reference in the Domain Name.

The Domain Name does comprise some of the elements of the Registrant's corporate name, but not the entire corporate name. The Registrant's corporate name includes the geographic descriptor of "Toronto" and the organizational descriptor of "society" as well as the two words "sick children" which are included in the Domain Name.

There is no evidence before the Panel that the Registrant is commonly identified as "sick children". Indeed, it would appear that these words would rather be used to commonly identify the Complainant.

The Panel finds that these differences in the legal corporate name of the Registrant is sufficient so that the provisions of paragraph 3.6(e) do not apply.

The Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name.

However, even if the Complainant has satisfied the onus on it to prove that the Domain Name is Confusingly Similar to the Official Marks, that the Registrant has registered the Domain Name in bad faith, and that the Registrant has no legitimate interest in the Domain Name, Paragraph 4.1 of the Policy grants the Registrant the opportunity still to succeed in the Complaint if the Registrant is able to prove on a balance of probabilities that it has a legitimate interest in the Domain Name as the concept of "legitimate interest" is described in paragraph 3.6.

The Registrant through its submissions has not demonstrated to the Panel that it has such a legitimate interest in the Domain Name. To the contrary, it would appear from the evidence before the Panel that the Registrant's interest in the Domain Name is merely to assist it in its efforts to pass itself off on the goodwill of the Complainant.

The Registrant has requested an order mirroring that of the Complainant's, namely that the Domain Name be transferred to the Complainant. In making this request, the Registrant has stipulated that such an order by the Panel include a condition as to the future use of the Domain Name by the Complainant upon its transfer and a requirement that "adequate" compensation be paid by the Complainant to the Registrant concurrently with the transfer. Without attempting to determine whether or not the Panel has the jurisdiction to order compensation be paid or to include conditions as part of an order to transfer the Domain Name, the Panel finds no merit in the stipulations included by the Registrant in its request to transfer the Domain Name.

DECISION

The Panel finds that the Complainant has satisfied the onus placed upon it by paragraph 4.1 of the Policy and is entitled to the remedy sought by it.

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ORDER

The Panel orders that the domain name, <sickchildren.ca> be transferred to the Complainant.

Dated: February 8, 2010.

R. John Rogers
Single Member Panel