

## **DISPUTE RESOLUTION SERVICE**

**D00020156**

**Decision of Independent Expert**

The Toronto-Dominion Bank

and

Nick Waters

### **1. The Parties:**

Complainant: The Toronto-Dominion Bank  
66 Wellington Street West  
Toronto Dominion Tower  
12th Floor  
Toronto, ONTARIO  
Toronto  
Canada  
M5K 1A2  
Canada

Respondent: Mr Nick Waters  
PO Box 5  
Newent  
Gloucestershire  
GL18 1YG  
United Kingdom

### **2. The Domain Name:**

tdbank.co.uk

### **3. Procedural History:**

I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as being of such a nature as to call in to question my independence in the eyes of one or both of the parties.

02 May 2018 06:07 Dispute received  
02 May 2018 12:00 Complaint validated  
02 May 2018 12:07 Notification of complaint sent to parties  
22 May 2018 02:30 Response reminder sent  
22 May 2018 14:04 Response received  
22 May 2018 14:04 Notification of response sent to parties  
28 May 2018 02:30 Reply reminder sent  
31 May 2018 17:13 No reply received  
05 June 2018 10:33 Mediator appointed  
07 June 2018 09:57 Mediation started  
29 June 2018 16:27 Mediation failed  
29 June 2018 16:27 Close of mediation documents sent  
11 July 2018 02:30 Complainant full fee reminder sent  
11 July 2018 11:47 Expert decision payment received

### **4. Factual Background**

The following facts appear from the evidence and submissions made by the parties and form the basis of this Decision:

- i. The Complainant is a major retail bank established in Canada but operating in many locations, and having a well known brand in the locations where it operates, which do not include the UK.
- ii. The Complainant has a portfolio of registered trademarks representing its brand including for “TD” and “TD BANK”; for the latter trademark, the Complainant has a US registered trademark with a registered date of 11 May 2010 and a Canadian registered trademark registered on 7 August 2001.
- iii. Because of its extensive presence, especially in North America, the Complainant is very well known among the public in North America and is, at least in North America, a well recognised brand.
- iv. The Respondent is an individual located in the UK who registered the Domain Name on 7 March 2010 and who owns other domain names.
- v. The Respondent was originally interested in setting up some sort of service to cater for parenting issues and has registered a number of domain names for this purpose.
- vi. The Respondent has made no use of the Domain Name or of the other domain names, at least for the purpose of establishing an online parenting service, for the reason that he has had no spare time to do so; however, he wishes to retain the Domain Name for this purpose.

## 5. Parties' Contentions

The Complainant makes the following submissions:

- i. The Complainant is the second largest bank in Canada by market capitalisation and deposits, and the sixth largest in the North America.
- ii. It was created in 1955 by a merger between the Bank of Toronto and the Dominion Bank.
- iii. Worldwide the Complainant has 86,000 employees and 25 million clients and is a leading global financial institution.
- iv. It operates a number of websites including [www.td.com](http://www.td.com) and [www.tdbank.com](http://www.tdbank.com).
- v. It owns a considerable number of trademark registrations around the world, including in the USA and Canada, in respect of "TD" and "TD BANK".
- vi. The Complainant is also a globally recognised brand, which is recognised by credit rating bodies as well as by bodies studying and reporting on brands.
- vii. The Complainant's trademarks thus have considerable distinctiveness and are easily recognised by consumers, industry peers and the broader global community.
- viii. The Complainant's Rights are thus similar to or identical with the Domain Name, ignoring the suffix, which is functional.
- ix. The Domain Name is abusive in the Respondent's hands according to the principles set out in paragraph 5 of the DRS Policy:
  - a. It was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights;
  - b. It has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;
  - c. There are circumstances indicating that the Respondent registered or otherwise acquired the Domain Name primarily as a blocking registration against a name or mark in which the Complainant has Rights or for the purpose of unfairly disrupting the Complainant's business;
  - d. There are circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorized by, or otherwise connected with the Complainant; and
  - e. The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.
- x. The Respondent is not commonly known by the Domain Name and there is no legitimate connection with the Complainant which would enable the Respondent to trade using "TD" or "TD BANK".

- xi. The Respondent registered the Domain Name on 7 March 2010, significantly after the Complainant's registered trademarks, whose first use of "TD" was in 1969.
- xii. Using Google to search for "TD Bank" returns numerous links referring to the Complainant and so the Respondent should have been aware of the Complainant's Rights.
- xiii. The Domain Name resolves to a blank page, but this can still be seen as a blocking registration, especially where the Complainant's trademark is well known.
- xiv. Looking at the Domain Name and the websites to which it has resolved historically has not shown any demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services.
- xv. The Respondent's real reason for registering the Domain Name was to prevent the Complainant from doing so and to take unfair advantage of the Complainant's Rights.

The Respondent makes the following submissions:

- i. The Respondent registered the Domain Name on 7 March 2010 for use he hoped to make of it in connection with parenting services.
- ii. Since then, the Complainant has been awarded various trademark registrations in respect of "TD BANK", but these postdate the registration of the Domain Name.
- iii. The Complainant's registrations of "TD" are too broad to assist it in this case, as there are other uses made of these letters including the TD Group and TD Autocare.
- iv. "Bank" as a word is widely understood not only as referring to a financial institution but also in a sense different from the financial services sector, such as a repository for information, or topographical features or groups of things.
- v. The Respondent intends one day to create a parenting website and has a number of registrations including the Domain Name for this purpose, but currently has no spare time to achieve this.
- vi. "Toronto Dominion" and "TD Bank" are not household names in the UK nor widely recognised by the public, and a Google search for "TD Bank UK" returns no relevant search results related to the Complainant or any of its subsidiaries: the Complainant does not have a UK-facing brand.
- vii. The Respondent has no intention of trading in any of the sectors in respect of which the Complainant has acquired trademark registrations.
- viii. There is no evidence that the Complainant in fact operates in the UK and the Complaint is unfair and intimidatory concerning the registration of a domain name which took place some eight years ago.

The Complainant did not make any Reply.

## 6. Discussions and Findings

### ***Rights***

According to paragraph 2.1.1 of the DRS Policy, the Complainant must show that it has “*Rights in respect of a name or mark which is identical or similar to the Domain Name*”. “*Rights*” is defined in paragraph 1 of the DRS Policy as “... *rights enforceable by the Complainant, whether under English law or otherwise ...*”. It is clear that registered trademark rights fall within the definition of “*Rights*” and I am satisfied that the Complainant has produced evidence of a number of trademarks, including for “TD”, comprising both the letters alone and the letters in a stylised form where the top stroke of the T is continued around in a loop to create the D, and also for “TD BANK” (see the registration granted by the United States Patent and Trademark Office registration number 77529427 and dated 11 May 2010 and also the registration granted in Canada with registration number 1028244 and dated 7 August 2001).

The Complainant has also produced a good deal of material in Annex 2 to its Complaint to show that it has a strong reputation in the marketplace, at least in North America, which would also constitute Rights as defined, being evidence of goodwill which could be the basis for legal actions in the nature of passing off or unfair competition.

That being so, it is clear that the Complainant has Rights as defined both identical with and similar to the Domain Name, thus satisfying the requirement set out in paragraph 2.1.1 of the DRS Policy.

The Respondent of course takes issue with some of the Complainant’s registrations of “TD BANK” as postdating the registration of the Domain Name by the Respondent. There are two points to make to this: first, the DRS Policy only looks to the existence of Rights as at the time of the Complaint and, secondly, this might be relevant to the question of Abusive Registration, which I something I consider below. In any case, the Canadian trademark registration I referred to above which the Complainant has included in Annex 1 to its Complaint is quite clearly a trademark for “TD BANK” predating the Respondent’s registration of the Domain Name.

The Respondent has also taken issue with whether the Complainant has any sort of reputation in the UK: again, this is not relevant to whether the Complainant has Rights as defined by the DRS Policy, which expressly refers to Rights “*whether under English Law or otherwise*”. Again, it is a matter which may be relevant to Abusive Registration, which I consider below.

### ***Abusive Registration***

An Abusive Registration is defined in the DRS Policy as being “*a Domain Name which either (i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly*

*detrimental to the Complainant's Rights; or (ii) is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights".*

There is no evidence that the Domain Name has been used at all. The Respondent states that he acquired it for possible use in connection with an online service and still intends to use it when he has spare time (albeit the planned use will be in the field of parenting, a field far removed from financial services). This seems to be borne out by the Complainant's evidence, showing use to consist either of nothing or a holding page holding some sort of click through advertisements or banners: in this connection paragraph 8.5 of the DRS Policy states that sale of traffic is not of itself objectionable, while various other factors can be taken into account as set out in that paragraph. However, the point is that the second limb is not satisfied – there is no usage of the Domain Name either in the present or, as far as I am aware, at any time in the past. This throws the emphasis on the first limb, focusing attention on the time of registration.

I will begin by addressing the linguistic points made by the Respondent. The Respondent asserts – correctly – that the word “bank” can be used in a number of different senses. It could mean a topographical location, as in “bank of earth”, a physical thing. It could also mean other things too: it could refer to some sort of collection of items, as in “bank of lifts”; it could refer to some sort of repository for things, as in food bank, recycling bank, seed bank and, finally, it could refer to a collection of intangibles, as in a knowledge bank.

All this is perfectly correct, but when someone says, “I am going to the bank” the normal inference is that they are going to the branch of a financial services institution, not to any of the other types of bank listed above. If the individual were going to a recycling bank, they would say so specifically in order to avoid confusion. When “bank” is used in a specific sense different from financial services, it is used with other words to make the point clear – food bank, recycling bank, seed bank and so on. Just using “bank” on its own strongly implies some sort of financial services in the absence of some sort of qualification. If one uses “bank” with some sort of prefix or suffix, then that becomes important as limiting what type of bank one is talking about. So when one talks about “td bank”, it implies some sort of bank connected with “td” or “td's”.

I then look at the Respondent's explanation for what he has done. He says that he has acquired a number of domain names for the purpose of his planned service in providing a parenting related website. I can accept that he would be justified in registering “thedadbank.co.uk” and “thedadchild.com” or “dadathome.org” but the Domain Name has no obvious connection with parenting. It could be seen as an abbreviation of “the dad bank” where “td” stands for “the dad”, but this is not obvious, and does not follow the other very descriptive domain names the Respondent has given by way of example. The Respondent has not really explained why he would want to use the Domain Name for a parenting service, as there is no

obvious connection between the Domain Name and his plans for parenting related services.

With that by way of background, I then come to paragraph 5.1.6 of the DRS Policy. I am conscious that the introductory words to paragraph 5.1 direct me to consider all the elements of this whole paragraph as a non-exhaustive list of factors, factors which “may” be evidence of an Abusive Registration. Paragraph 5.1.6 states,

*“The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant’s mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.”*

The point is that the Complainant may have been slow off the mark in registering “TD BANK” in the UK, but it has clearly been trading under that name and is known by and referred to by that name and has built up a reputation under that name. It is not just a question of registered trademarks but also a question of rights in the trading name “TD BANK” and I take from Annex 2 to the Complaint that the Complainant is commonly referred to as “TD Bank” as well as just “TD”, giving it unregistered rights in that name. Unregistered rights are still Rights as defined by the DRS Policy, and it does not matter that the rights are acquired by virtue of activities carried out in a foreign (i.e. non-UK) jurisdiction as the DRS Policy expressly provides for this possibility.

The conclusion I have reached, therefore, is that the Respondent has not shown to me that he has a reasonable justification for registering the Domain Name. I cannot see that “TDBANK” has any sort of obvious connection with parenting, and trying to read “TD” as an abbreviation for “the dad” is too slender a thread in my view to support the Respondent’s choice of this Domain Name. As I say, paragraph 5.1.6 is only “evidence” that the Domain Name “may” be an Abusive Registration but, after considering the matter, I have concluded that the Complaint is made out: the Domain Name was registered in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights because the Domain Name is an exact match to the Complainant’s Rights and there is no reasonable justification or really any cogent explanation emanating from the Respondent for his having done so.

This conclusion suffices to dispose of the matter, but the Complainant has made other allegations and I will deal with them briefly:

- i. Given that the Respondent has made no use whatsoever of the Domain Name to host some sort of active website, I do not see any circumstances indicating that he registered it as a blocking registration or for the purpose of unfairly disrupting the Complainant’s business; and
- ii. Again, given that there is no usage of the Domain Name, and no evidence of threatened usage contrary to the Complainant’s interests, I cannot see any

circumstances evidencing confusion or likely confusion. It is true to say that the Experts' Overview<sup>1</sup> at paragraph 1.3 does provide some support to the proposition that non-use can constitute a threatened abuse in some circumstances, such as where the brand is well known, the Respondent has no obvious justification for having chosen the name and has provided no explanation. I do not think the brand "TD BANK" was well known either in the UK or to the Respondent personally when he registered the Domain Name and so I do not think in this case that simply possessing the Domain Name, without more, is a "threatened" abuse by the Respondent.

The story does not end there because paragraph 8 of the DRS Policy gives another non-exhaustive list of factors which "may" be evidence that the Domain Name is not an Abusive Registration. Looking at paragraph 8:

- i. Paragraph 8.1.1 does not apply, as the Respondent has not made any "demonstrable preparations" to use the Domain Name in connection with a genuine offering of goods or services, he is not known by the Domain Name and there is no question of non-commercial or fair use (as there has been no use at all);
- ii. The Domain Name is not generic or descriptive (paragraph 8.1.2 refers);
- iii. There is no written agreement (paragraph 8.1.3 refers);
- iv. Paragraph 8.1.4 does not apply on its terms;
- v. There is no site at all so paragraph 8.2 cannot apply;
- vi. Paragraph 8.3 does not apply on its terms;
- vii. For the purposes of paragraph 8.4, the Respondent has admitted to owning some other domain names, but these are descriptive and not of any help in deciding this matter; and
- viii. As to paragraph 8.5, there is no evidence of extensive sales of traffic, and the evidence points to zero use at this moment in time.

I have considered the matter more generally and cannot see any other reason, not listed in paragraph 8, why the Domain Name is not an Abusive Registration.

## **7. Decision**

I therefore find that the Complainant has Rights in a name or mark which is identical to the Domain Name and that the Domain Name is an Abusive Registration in the hands of the Respondent and direct that it be transferred to the Complainant.

**Signed Richard Stephens**

**Dated 30 July 2018**

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<sup>1</sup> The Experts' Overview is a useful collection of decisions by Experts on various aspects of the DRS Policy illustrating how the Policy is applied in particular circumstances.