

ADMINISTRATIVE PANEL DECISION

The Canada Life Assurance Company v. Domains By Proxy, LLC / Biao Yang
Case No. D2022-2644

1. The Parties

The Complainant is The Canada Life Assurance Company, Canada, represented by Aventum IP Law LLP, Canada.

The Respondent is Domains By Proxy, LLC, United States of America ("United States") / Biao Yang, Canada, represented by Wen Wu, Canada.

2. The Domain Name and Registrar

The disputed domain name <mycanadalife.com> (the "Domain Name") is registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 20, 2022. On July 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On July 20, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on July 21, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on July 22, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 17, 2022. Further to the Respondent's request for an extension to file a Response, the Center granted the extension of time until August 26, 2022. The Response was filed with the Center August 25, 2022.

The Center appointed W. Scott Blackmer, Brian J. Winterfeldt, and Dr. Hong Xue as panelists in this matter on September 15, 2022. The Panel finds that it was properly constituted. Each member of the Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant

The Complainant is a Canadian insurance and financial services company headquartered in Winnipeg, Manitoba. It is a wholly-owned subsidiary of Great-West Lifeco, Inc. As described on the Complainant's website at "www.canadalife.com", the original Canada Life Assurance Company was founded in 1847, and "the new Canada Life" is the amalgamation in January 2020 of three companies, Great-West Life, London Life, and Canada Life, now operating under the "Canada Life" brand.

The Complainant claims "substantial common law rights" in Canada for CANADA LIFE as the mark has been associated with life insurance and other financial services in Canada for almost 175 years. "As of 2020, [the Complainant] had over 16,500 employees, with more than [CAD] 500 billion total assets under administration and over 17 million customer relationships", nearly half the population of Canada, as well as operations in the United States, the United Kingdom, the Isle of Man, Ireland, and Germany. "In 2011, the year the Disputed Domain Name was registered, the total assets under administration for the whole Canada Life organization globally was nearly [CAD] 102 billion. [The Complainant's] total net earnings for individual insurance, wealth management and group insurance in Canada were [CAD] 191 million." By the time the Domain Name was registered in 2011, the CANADA LIFE brand had been extensively used and advertised across Canada for 164 years.

In addition to the Complainant's website at "www.canadalife.com", the Complainant uses a website at "www.my.canada.life.com" as a password-access portal for participants in the Complainant's MY CANADA LIFE AT WORK retirement savings and insurance accounts, which are offered as employee benefits under group plans.

The Complainant's Marks

The Complainant holds numerous trademark registrations for CANADA LIFE and formative marks or their French equivalents, including the following:

MARK	JURISDICTION	REGISTRATION NUMBER	REGISTRATION DATE
CANADA LIFE (word mark)	European Union	000291401	August 24, 1998
CANADA LIFE CONTINUUM (word mark)	Canada	TMA565982	August 19, 2002
CANADA LIFE GENERATIONS (word mark)	Canada	TMA565983	August 19, 2002
CANADA LIFE (words and design)	European Union	002331759	February 27, 2003
CANADA LIFE (word mark)	United States	2751879	August 19, 2003
CANADA LIFE (words and design)	Canada	TMA621204	September 30, 2004
CANADA-VIE (word mark)	Canada	TMA642062	June 15, 2005
GENERATIONS CANADA-VIE (word mark)	Canada	TMA656806	January 18, 2006
CANADA LIFE (words and design)	United States	3293495	September 18, 2007
CANADA LIFE CONCOURSE (word mark)	Canada	TMA794361	March 31, 2011

The Complaint lists nearly 30 other trademarks that the Complainant “owns” and “for which applications have been filed in Canada”. These are all pending trademark registration applications at the time of this Decision. These unregistered marks typically include the words CANADA LIFE or CANADA VIE combined with other words and designs; some are transliterated in traditional or simplified Chinese characters. For present purposes, the most relevant unregistered marks are CANADA LIFE (serial number 1954790, application filed April 1, 2019), MY CANADA LIFE AT WORK (serial number 2034164, application filed June 15, 2020), and MY CANADA LIFE (serial number 2119651, application filed July 8, 2021).

The Complaint does not document historical use, associated sales and advertising, media recognition, and consumer awareness so as to support a finding of acquired distinctiveness or “secondary meaning” establishing common law protection or similar legal rights with respect to each of these unregistered marks. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.3 (“What does a complainant need to show to successfully assert unregistered or common law trademark rights?”). The exception is the English word mark CANADA LIFE: the record includes screenshots from the Complainant’s website in 2011 and 2022 and extracts from the Complainant’s 2011 financial report, where details can be found supporting the historical use of the unregistered CANADA LIFE word mark in Canada and related sales and market penetration in Canada. Therefore, the Panel recognizes the probability that the CANADA LIFE mark acquired distinctiveness in the insurance and financial services markets in Canada by 2011. The record does not provide details on the historical use of the asserted common law marks MY CANADA LIFE and MY CANADA LIFE AT WORK or related sales, media recognition, and consumer awareness. The Panel does not find, therefore, that the Complainant has established common law or equivalent rights in those marks or the other unregistered marks listed in the Complaint, for purposes of this proceeding.

The Respondent and the Domain Name

The Registrar reports that the Domain Name was registered on April 16, 2011, using a domain privacy service. After receiving notice of the Complaint in this proceeding, the Registrar identified the underlying registrant as the Respondent Biao Yang, listing no organization and showing a postal address in Ontario, Canada and a “hotmail.com” email address. The Response was filed in the name of Biao Yang “also known as “Bill Yang” or “Billy Yang”, a “Canadian resident who immigrated to Canada with his wife and children from mainland China” in 2001.

According to the Response, the Respondent became a licensed real estate agent in 2002, while his wife began providing consulting services to International students seeking to come to Canada for education. The Respondent says that he and his wife registered the Domain Name with the intention of using it for a noncommercial website where they and others could tell their stories about living in Canada. The Response states that the Respondent has never offered the Domain Name for sale or used it for a “click-per-view webpage”. Nevertheless, the Domain Name resolves to a landing page headed with the Registrar’s name and the message that the Domain Name is “parked free, courtesy of GoDaddy.com”, followed by a button to “Get This Domain” and third-party, pay-per-click (“PPC”) advertising links headed “Related Searches” labelled with such topics as “investment funds” and “insurance plans”.

Communications between the Parties

In 2021 the Complainant contacted the Respondent through the Registrar and offered to purchase the Domain Name, ultimately raising the offer to USD 10,000. The Respondent repeatedly declined and finally countered with a sales price of USD one million. The Parties did not agree to the transfer of the Domain Name, and this UDRP proceeding followed in 2022.

5. Parties' Contentions

A. Complainant

The Complainant asserts that the Domain Name is confusingly similar to its registered and common law CANADA LIFE marks, arguing that the addition of the word "my" merely intensifies the likelihood of confusion, as it creates a "personal identification of consumers with a product or services" (citing *DHL Operations B.V. and DHL International GmbH v. Diversified Home Loans*, WIPO Case No. [D2010-0097](#) and other decisions).

The Complainant denies any association with the Respondent and contends that the Respondent had no permission to use the Complainant's mark in the Domain Name. The Complainant observes that there is no evidence that the Respondent has been known by a corresponding name or has made use of the Domain Name for a *bona fide* commercial offering or noncommercial fair use. The Domain Name has only been used for a PPC landing page and an offer to sell the Domain Name, and these do not reflect rights or legitimate interests. Rather, they represent bad faith in the attempt to sell the Domain Name for an extortionate amount and misdirection of Internet users to unrelated commercial sites.

As the Respondent has not yet developed a website of his own associated with the Domain Name, the Complainant also cites the "passive holding" doctrine articulated in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), and following cases. The Complainant suggests that because the Respondent must be aware that the Domain Name incorporates a particularly distinctive and well-known trademark, "any realistic use" of the Domain Name "must misrepresent an association with the Complainant and its goodwill" and therefore necessarily entails bad faith.

B. Respondent

The Respondent argues that the Domain Name is not identical or confusingly similar to any trademark that the Complainant had registered at the time of the Domain Name registration.¹ The Respondent argues that there is no registered Canadian trademark for MY CANADA LIFE, and the Respondent challenges the Complainant's claim that MY CANADA LIFE has become a distinctive identifier associated with the Complainant. The Complainant's predecessor applied to register CANADA LIFE as a Canadian trademark only in April 2019, and the new Canada Life company applied to register MY CANADA LIFE AT WORK in June 2020 and then MY CANADA LIFE in July 2021.

The Respondent insists that "my Canada life" is a descriptive phrase in English, which the Respondent chose for the Domain Name in 2011 because of its plain meaning. The Respondent claims a legitimate interest in using the Domain Name for a website relevant to that meaning, to describe life in Canada, similar to "www.torontolife.com". The Respondent states that he and his wife planned to create a platform for newcomers to Canada to "share their life experiences in Canada for non-commercial purposes". The Respondent has not done so in the past 11 years because of his "busy work and commitments to his family" but still hopes to do so "in near future, likely in year 2023".

The Respondent denies awareness of the Complainant or its claimed marks when he registered the Domain Name in 2011. The Respondent asserts that the Complainant "is not a well-known or a giant insurance company selling life insurance policies in Canada and particularly in Chinese-speaking communities in Canada". The Respondent suggests that the Complainant exaggerates its market presence in Canada, quoting a smaller number of customers for the Complainant's life insurance business from the Complainant's 2020 annual report. (The Respondent uses figures for the Complainant's life insurance business, while the

¹ The Panel notes that CANADA-VIE, the French equivalent of CANADA LIFE, was registered as a word mark in 2005. Translations and transliterations are deemed identical or confusingly similar for purposes of the first element of a Policy complaint (see [WIPO Overview 3.0](#), section 1.14). In any event, for the first element of the Complaint it is necessary only to establish that the Complainant currently holds a relevant trademark or service mark, not that it was acquired before the Domain Name registration, and a complainant may successfully demonstrate rights in an unregistered mark. See [WIPO Overview 3.0](#), sections 1.1.3, 1.3.

Complainant's citation to the annual report aggregates customer relationships from all of the Complainant's lines of business.)

The Respondent denies initiating advertisements for the sale of the Domain Name or receiving any PPC revenues from the Registrar's automatic parking of the Domain Name. The Respondent questions whether the Registrar could be prevented from such parking. He points out that clicking on the "Get This Domain" button simply leads to a message that the Domain Name is "taken" and offering the Registrar's brokering services for a fee. The Complainant evidently followed that route in an attempt to purchase the Domain Name. The Respondent asserts that his million-dollar counteroffer was meant only to "shut down" the interchange with the Complainant, because the Respondent had no desire to sell the Domain Name.

The Respondent states that he has registered only five other domain names, each for a business use:

<mygoldenlife.ca> (2012-present), used for a predominantly Chinese-language website promoting the education consulting services of the Respondent's wife;

<msmacmachinery.com> (2013-present), intended for use in connection with the Respondent's machinery import and export company;

<c21alpharealty.ca> (2017-2021), formerly used for the Respondent's business as a real estate agent and broker;

<816cuisine.ca> (2017-2020), formerly used for a restaurant business until the COVID outbreak;

<billyyang.ca> (2018-present), intended for use in connection with the Respondent's real estate business.

The Respondent emphasizes that there is no pattern of cybersquatting, none of his businesses compete with the Complainant, and the intended use of the Domain Name is noncommercial and relevant to its "generic" or dictionary sense.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and (ii) the respondent has no rights or legitimate interests in respect of the domain name; and (iii) the domain name has been registered and is being used in bad faith. Under paragraph 15(a) of the Rules, "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

A. Identical or Confusingly Similar

The first element of a UDRP complaint "functions primarily as a standing requirement" and entails "a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". [WIPO Overview 3.0](#), section 1.7. The Domain Name incorporates the Complainant's registered and common law CANADA LIFE mark in its entirety, and the addition of the possessive pronoun "my" does not avoid confusion.² See *id.*, section 1.8. (As usual, the Top Level Domain ".com" is disregarded as a standard registration requirement. See *id.*, section 1.11.1.)

The Panel finds, therefore, that the Domain Name is confusingly similar to the Complainant's CANADA LIFE

² See the Factual Background discussion above regarding evidence of CANADA LIFE as a common law mark, as well as footnote 1 regarding the registered mark CANADA-VIE as the French translation of CANADA LIFE. The words "Canada Life" are also the dominant textual element in the registered composite marks listed above that include design elements.

marks and concludes that the Complainant has established the first element of the Complaint.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a domain name, by demonstrating any of the following:

(i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) that the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Because a respondent in a UDRP proceeding is in the best position to assert rights or legitimate interests in a domain name, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

The Complainant has established trademark rights, a lack of permissive use, and the Respondent's failure to make use of the Domain Name to date for the Respondent's proposed noncommercial use relevant to the English meaning of the phrase "my Canada life". Instead, the Domain Name has been used for PPC advertising of third parties. Thus, the Complainant has made a *prima facie* case, and the burden of production shifts to the Respondent.

The Respondent does not claim to be known by a corresponding name or to offer goods or services associated with the Domain Name. The Respondent claims a legitimate interest in the Domain Name for the "common meaning" of the phrase "my Canada life" to create a platform for newcomers to Canada to "share their life experiences in Canada for noncommercial purposes". However, the Respondent has not put the Domain Name to such use, and it is telling that the PPC links to which the Domain Name resolves are predominantly concerned with insurance and financial services, undercutting the Respondent's claims to an interest in a more "common" sense of the phrase that does not relate to the Complainant. Moreover, the Response does not include details concerning any preparations to create the Respondent's planned platform for. The Panel is sympathetic to the demands of work and family; the Respondent is clearly energetic and entrepreneurial. But the Respondent has held the Domain Name for 11 years and offers no proof whatsoever of preparations to make use of the Domain Name in connection with a *bona fide* commercial offering or a noncommercial fair use.

The Panel finds that the Respondent has failed to meet its burden of production and concludes that the Complainant prevails on the second element of the Complaint.

C. Registered and Used in Bad Faith

The Complainant has established that the CANADA LIFE marks are well-known and long-established in Canada. The Respondent denies prior awareness and states that the Complainant is not well-known, particularly in Chinese-speaking communities, but offers no supporting evidence. The Complainant has a customer relationship of some kind with half of the population of the country and has advertised extensively to the public since the 19th century. When the Respondent registered the Domain Name, he had lived in the largest metropolitan area in Canada for ten years, spoke English, and worked as a licensed real estate agent. The Panel considers it unlikely that he had not been exposed to the Complainant's advertising, even if he was not "in the market" for life insurance or for one of the Complainant's other financial services.

The Policy, paragraph 4(b), furnishes a non-exhaustive list of circumstances that “shall be evidence of the registration and use of a domain name in bad faith”, including the following (in which “you” refers to the registrant of the domain name):

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

“(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location.”

Some of these examples of bad faith are more apt than others in the current circumstances. If the Respondent registered the Domain Name primarily to sell it to the Complainant, the Respondent was very patient. He did not initiate communications with the Complainant and held the Domain Name for a decade before the Complainant contacted him. There is no evidence of a “pattern” of cybersquatting by the Respondent, and there is no evidence that the Complainant was using a MY CANADA LIFE mark in 2011. The Respondent insists that he is not a competitor of the Complainant, and there is no evidence that he was motivated to disrupt the Complainant’s business. Nevertheless, allowing the Domain Name incorporating the Complainant’s mark to be used over a period of years to attract Internet users to commercial websites operated by third parties, including competitors, has a detrimental impact on the Complainant and potentially affects its reputation and business. (See [WIPO Overview 3.0](#), section 3.1.3, on the broader view of a “competitor” under the Policy as a person who acts “in opposition to another”.)

Importantly, the Respondent has allowed the Registrar to park the Domain Name on a landing page with PPC advertising. The Respondent protests that he does not control this parking and receives no revenues from it. Nevertheless, the Respondent remains responsible under the registration agreement for the use of the Domain Name in a manner that does not impair the rights of others. UDRP panels have sometimes declined to find bad faith in circumstances where a registrar automatically parked a domain name similarly with PPC advertising links and an advertisement for the registrar’s services, if the respondent acted within a reasonably short time to redirect the domain name (e.g., to the respondent’s website or to a landing page with an “under construction” message). But registering a Domain Name incorporating a well-known trademark and then ignoring it for 11 years, allowing it to be exploited by others for commercial gain, must be considered a disregard of the rights of others that amounts to bad faith within the meaning of the Policy. The Respondent relies on the apparent belief that the CANADA LIFE mark was not registered at the time and therefore not protected, or that the Domain Name was not confusingly similar because it added the word “my”, but this is a misplaced understanding. He cites other similar domain names that are “available” to be registered; this does not mean that they would not also violate the Policy.

As the Respondent has not yet associated the Domain Name with an active website, the Complainant also suggests that this case falls within the ambit of the “passive holding” doctrine ([WIPO Overview 3.0](#), section 3.3), given the reputation of the mark, the failure of the Respondent to use the Domain Name or to submit evidence of preparations for use, and the unlikelihood of a use that would not be falsely associated with the Complainant. The Respondent counters that the Domain Name is an English phrase for which he had a legitimate planned use; he provided his correct contact details; and he responded to the Complainant’s communications and to this Complaint, unlike the respondents in the cited “passive holding” decisions. This

is true; the facts here are perhaps not classic “passive holding” circumstances. The issue is that the Respondent did nothing in over a decade to make a legitimate fair use of the Domain Name and meanwhile allowed others to use the Domain Name to exploit the Complainant’s marks. This is not an entirely “passive” use, but it is similarly bad faith within the meaning of the Policy.

The Panel finds bad faith in the registration and use of the Domain Name in the totality of these circumstances and concludes that the Complainant has established the third element of the Complaint.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name, <mycanadalife.com>, be transferred to the Complainant.

/W. Scott Blackmer/

W. Scott Blackmer

Presiding Panelist

/Brian J. Winterfeldt/

Brian J. Winterfeldt

Panelist

/Dr. Hong Xue/

Dr. Hong Xue

Panelist

Date: September 29, 2022