



## NATIONAL ARBITRATION FORUM

### DECISION

Valiant Trust Company v. Valiant Trust  
Claim Number: FA0611000844658

#### PARTIES

Complainant is **Valiant Trust Company** ("Complainant"), represented by **Larry C. Jones**, of **Alston & Bird, LLP**, Bank of America Plaza, 101 S. Tryon Street, Suite 4000, Charlotte, NC 28280-4000. Respondent is **Valiant Trust** ("Respondent"), Ayala Business Park, Ceby 6000, PH.

#### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**valianttrustco.com**>, registered with **The Name It Corporation** d/b/a **Nameservices.net**.

#### PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

#### PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on November 17, 2006; the National Arbitration Forum received a hard copy of the Complaint on November 20, 2006.

On November 30, 2006, The Name It Corporation d/b/a Nameservices.net confirmed by e-mail to the National Arbitration Forum that the <**valianttrustco.com**> domain name is registered with The Name It Corporation d/b/a Nameservices.net and that Respondent is the current registrant of the name. The Name It Corporation d/b/a Nameservices.net has verified that Respondent is bound by the The Name It Corporation d/b/a Nameservices.net registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On November 30, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of December 20, 2006 by which Respondent could file a response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@valianttrustco.com by e-mail.

Having received no response from Respondent, the National Arbitration Forum transmitted to the parties a Notification of Respondent Default.

On December 28, 2006, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent." Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

#### **RELIEF SOUGHT**

Complainant requests that the domain name be transferred from Respondent to Complainant.

#### **PARTIES' CONTENTIONS**

A. Complainant makes the following assertions:

##### **I. INTRODUCTION**

Complainant Valiant Trust Company (hereinafter "Complainant") is a Canadian financial services company that provides, *inter alia*, registrar and stock transfer services. For several years, Complainant has used extensively the service mark and trade name VALIANT TRUST COMPANY and variations thereof, including VALIANT TRUST CO., to promote its services. Complainant has also used the domain name *valianttrust.com* in conjunction with these services. Respondent Valiant Trust (hereinafter "Respondent"), acting in bad faith, has registered and used the domain name *ValiantTrustCo.com* to attempt to create a false association with Complainant, and to direct users to a website that falsely purports to offer financial services, as part of a "scam" to defraud investors. Respondent's domain name made the subject of this proceeding is confusingly similar to Complainant's VALIANT TRUST COMPANY mark and *valianttrust.com* domain name, and Respondent has no preexisting rights or legitimate interests in respect of said domain name. Respondent's actions fall squarely within the activity ICANN's Uniform Domain Name Dispute Resolution Policy ("UDRP") is intended to remedy.

##### **II. FACTUAL BACKGROUND**

###### **A. Complainant and the VALIANT TRUST COMPANY Mark**

Canadian Western Bank ("CWB") is a Schedule I Canadian chartered bank, formed under the Bank Act of Canada. As such, CWB, directly and through its subsidiaries, provides a

broad spectrum of banking and related financial services to the public. Complainant is a non-deposit taking trust company incorporated under the Loan and Trust Corporations Act of the province of Alberta, Canada. Complainant is also registered as a non-deposit taking trust company in the province of British Columbia, Canada. Complainant is a wholly-owned subsidiary of CWB.

Complainant, operating via offices and other facilities located in the Canadian provinces of Alberta and British Columbia, provides, *inter alia*, registrar and stock transfer services to public and private Canadian corporations. Included among the array of additional services provided by Complainant are various employee plan services, including services relating to employer sponsored stock option plans and stock purchase plans.

On a consolidated basis, CWB is the eighth largest publicly traded Schedule I bank in Canada, and it has operations primarily in western Canada. Although Complainant's physical facilities are located solely within Canada, some of Complainant's customers have their securities registered in the United States. Because Complainant's services pertain to such securities, Complainant is registered as a transfer agent with the Securities and Exchange Commission in the United States (Registration No. 084-061000).

Moreover, Complainant's services are promoted on its website, which website is accessible via the domain name ValiantTrust.com. Complainant first registered the ValiantTrust.com domain name in January 2002. The ValiantTrust.com domain name has been in continuous use since 2002.

Since October 1, 1999, Complainant has done business under the trade name and service mark VALIANT TRUST COMPANY, which designation is often used by Complainant and the public in abbreviated forms, including VALIANT TRUST CO. and VALIANT TRUST. Those designations (VALIANT TRUST COMPANY, VALIANT TRUST CO., and VALIANT TRUST) are referenced collectively hereinafter as "Complainant's Marks." Complainant has used extensively Complainant's Marks as trade names and service marks to promote, advertise and provide its services to the public.

By reason of its adoption and use, the VALIANT TRUST mark and each of the other variations of Complainant's Marks has a distinctive quality and has acquired special and particular significance and very valuable goodwill as identifying Complainant and its financial services so that members of the public associate each of the VALIANT TRUST designations with Complainant and its services. Consequently, through such usage and recognition, Complainant has acquired common-law rights in Complainant's Marks as proprietary trade names and service marks, which rights extend, without limitation, to the exclusive right to use VALIANT TRUST, VALIANT TRUST COMPANY and VALIANT TRUST CO. and the right to prevent others from using any marks, domain names, or other designations that are confusingly similar thereto.

## **B. Respondent's Unlawful Activities**

On or about August 17, 2006, the CWB organization first became aware of Respondent and its use of the domain name ValiantTrustCo.com. More particularly, CWB was contacted at that time by Jim Daly, a representative of the U.S. Securities and Exchange Commission ("SEC"). Mr. Daly identified himself as an employee of the SEC's fraud department. He indicated that an investor in the United Kingdom had been approached by an off-shore "boiler room" operative who purported to be representing Complainant. Mr. Daly also indicated that the operative appeared to be attempting to perpetrate a fraud on the investor, particularly by representing falsely that "Valiant Trust," for a fee, could remove certain restrictions on stock or other securities that otherwise had such restrictions and/or relatively limited liquidity. Mr. Daly also indicated that the operative was using the email address of *info@ValiantTrustCo.com* and the ValiantTrustCo.com website (*http://www.ValiantTrustCo.com*) in perpetrating this scheme to defraud investors.

Respondent has identified itself to the Registrar for the subject domain name, The Name It Corporation d/b/a Nameservices.net, as Valiant Trust, and as reflected in the printouts from the November 6, 2006 WHOIS database, has provided the Registrar with the following, apparently fictitious, contact information: Mailing Address Ayala Business Park, Cebu, Na 6000 PH, E-mail *valiantrustco@yahoo.com*, Phone (032) 348-6547. It appears from the WHOIS database that Respondent registered the ValiantTrustCo.com domain name on June 27, 2006.

The subject domain name resolves to Respondent's website on which Respondent purports to be offering various employee plan services, including services relating to employer sponsored stock option plans and stock purchase plans. These services are also among the types of services provided by Complainant. Moreover, Respondent represents itself to be "one of the leading providers of employee products and services to public and private companies". Such a description would be an appropriate reference to Complainant – but Complainant does not sponsor and has not authorized this website or this use of its proprietary "Valiant Trust" moniker.

On the fraudulent ValiantTrustCo.com website, Respondent purports to have the following address: "Suite 1800, 7<sup>th</sup> Avenue, Arlington, Washington USA 98223." Although Complainant does have physical offices in British Columbia, in relatively close proximity to Washington state, Complainant has no office or other facility at any address in Arlington, Washington or elsewhere in the state of Washington. A representative of Complainant has contacted the police department for Arlington, Washington, and was informed that the mailing address provided on Respondent's website is fictitious.

Since first becoming aware of the apparently fraudulent scheme being perpetrated by Respondent, Complainant has received several inquiries from investors who have been contacted by Respondent. Fortunately, these particular investors were undertaking appropriate due diligence investigations, and Complainant was able to apprise those individuals of the fraudulent nature of the scheme and its unauthorized use of "Valiant Trust Co." as a domain name and trade name. During that period, Complainant also obtained some materials utilized by Respondent in this scam, and copies of those materials are included with the Complaint.

Complainant also obtained recently a copy of an email string between Mr. Daly of the SEC and Mr. James Walker, one investor who had been contacted by Respondent. Therein, the SEC informed Mr. Walker that, *inter alia*, Respondent had somehow appropriated information pertaining to Mr. Walker's investments, and the communications indicate that Respondent was offering to buy certain securities under a scheme in which Mr. Walker was being requested by Respondent to pay a fee in advance of any such purchase or service. Mr. Daly described this scheme as "a not uncommon type of 'mirror' fraud" in which "the pseudo-Valiant Trust Co. [Respondent] is playing upon the likeness of its name to the genuine Valiant Trust Company [Complainant], so as to confuse unsuspecting prospective investors."

Among the other communications received recently from potential victims of Respondent's fraud scheme is the September 12, 2006, email from Edward Cheung, an investor who indicated that he is located in Hong Kong. Therein, Mr. Cheung informed Complainant that Respondent, as part of its scheme to pass itself off as Complainant, not only is using the imitative ValiantTrustCo.com domain name, but also is using an SEC Central Index Key designation associated with Complainant's SEC registration number.

### III. ARGUMENT

Pursuant to the UDRP, Complainant must establish the following to obtain the relief requested in this action: (i) the accused domain name (*ValiantTrustCo.com*) is identical or confusingly similar to a trademark or service mark in which Complainant has rights; (ii) Respondent has no rights or legitimate interests in respect of the accused domain name; and (iii) the accused domain name has been registered and is being used in bad faith. (UDRP § 4(a)). As reflected in the accompanying evidence made of record in this proceeding and for the reasons set forth below, Complainant readily satisfies each of these requirements.

#### A. The Accused Domain Name Is Confusingly Similar to Complainant's Marks

Complainant owns valid and enforceable common law rights in the Complainant's Marks, including the VALIANT TRUST CO. mark, by virtue of the continuous use of such marks for several years. The accused domain name is identical to Complainant's VALIANT TRUST CO. mark. Since Respondent registered and began using the accused domain name long after Complainant acquired rights in its mark, Complainant satisfies the first element of proof required under the UDRP.

#### B. Respondent Has No Rights Or Legitimate Interests In The Accused Domain Name

Respondent does not appear to be a legitimate financial services provider, and, in any event, Respondent has no legitimate rights in "Valiant Trust" as a trademark, service mark or trade name. In fact, the available information indicates that Respondent adopted the name Valiant Trust and the domain name *valiantrustco.com* to intentionally deceive investors as to its affiliation with Complainant. Hence, it may be presumed that Respondent has no rights or legitimate interests in "ValiantTrustCo.com" as a domain name.

### **C. Respondent Has Registered And Used The Domain Name In Bad Faith**

The subject domain name is being “used” inasmuch as an active commercial website is accessible via the domain name. All of the available information indicates that Respondent is utilizing this website in furtherance of its scheme designed to defraud investors. Further, the available information suggests that Respondent adopted, registered and used the subject domain name to create the false impression that it is a legitimate business and is affiliated with Complainant. As such, the subject domain name has been used and registered by Respondent in bad faith.

B. Respondent failed to submit a Response in this proceeding.

### **FINDINGS**

Complainant, Valiant Trust Company, is a Canadian financial services company that has extensively used the trade and service mark VALIANT TRUST CO. to promote its well-known services for several years. In connection with these services, Complainant is registered as a transfer agent with the Securities and Exchange Commission in the United States (Registration No. 084-061000).

Respondent registered the <**valianttrustco.com**> domain name June 27, 2006. The disputed domain name resolves to a website which purports to offer similar services as the Complainant’s business.

### **DISCUSSION**

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent’s failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) (“In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.”).

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

### **Identical and/or Confusingly Similar**

Under Policy ¶4(a)(i), Complainant is not required to hold a trademark registration to establish rights in the VALIANT TRUST CO. mark. *See British Broad. Corp. v. Renteria*, D2000-0050 (WIPO Mar. 23, 2000) (noting that the Policy “does not distinguish between registered and unregistered trademarks and service marks in the context of abusive registration of domain names” and applying the Policy to “unregistered trademarks and service marks”); *see also SeekAmerica Networks Inc. v. Masood*, D2000-0131 (WIPO Apr. 13, 2000) (finding that the Rules do not require that the complainant's trademark or service mark be registered by a government authority or agency for such rights to exist). Complainant has established common law rights in the VALIANT TRUST CO. mark through continuous and extensive use of the mark in connection with its financial services business since October 1, 1999. The Panel finds Complainant has generated substantial goodwill under the VALIANT TRUST CO. mark and is well-known in connection with its financial services. Therefore, the Panel finds Complainant's VALIANT TRUST CO. mark has acquired secondary meaning sufficient to establish common law rights in the mark. *See Tuxedos By Rose v. Nunez*, FA 95248 (Nat. Arb. Forum Aug. 17, 2000) (finding common law rights in a mark where its use was continuous and ongoing, and secondary meaning was established); *see also Keppel TatLee Bank v. Taylor*, D2001-0168 (WIPO Mar. 28, 2001) (“[O]n account of long and substantial use of [KEPPEL BANK] in connection with its banking business, it has acquired rights under the common law.”).

Complainant asserts Respondent's <valianttrustco.com> domain name is identical to Complainant's mark. Respondent's disputed domain name contains Complainant's mark in its entirety and adds the two letters “co” and the generic top-level domain (‘gTLD’) designation “.com.” The Panel finds the addition of “co” and the gTLD “com” is not sufficient to adequately distinguish a domain name from a mark pursuant to Policy ¶4(a)(i). *See Pomellato S.p.A v. Tonetti*, D2000-0493 (WIPO July 7, 2000) (finding <pomellato.com> identical to the complainant's mark because the generic top-level domain (gTLD) “.com” after the name POMELLATO is not relevant); *see also Gardline Surveys Ltd. v. Domain Fin. Ltd.*, FA 153545 (Nat. Arb. Forum May 27, 2003) (“The addition of a top-level domain is irrelevant when establishing whether or not a mark is identical or confusingly similar, because top-level domains are a required element of every domain name.”).

The Panel finds Policy ¶4(a)(i) satisfied.

### **Rights or Legitimate Interests**

Complainant asserts Respondent lacks rights or legitimate interests in the <valianttrustco.com> domain name. In instances where the Complainant has made a *prima facie* case under Policy ¶4(a)(ii), the burden shifts to Respondent to bring forth substantial evidence indicating that it possesses rights or legitimate interests in the disputed domain names. See *Compagnie Generale des Matieres Nucleaires v. Greenpeace Int'l*, D2001-0376 (WIPO May 14, 2001) (“Proving that the Respondent has no rights or legitimate interests in respect of the Domain Name requires the Complainant to prove a negative. For the purposes of this sub paragraph, however, it is sufficient for the Complainant to show a *prima facie* case and the burden of proof is then shifted on to the shoulders of Respondent. In those circumstances, the common approach is for respondents to seek to bring themselves within one of the examples of paragraph 4(c) or put forward some other reason why they can fairly be said to have a relevant right or legitimate interests in respect of the domain name in question.”); see also *G.D. Searle v. Martin Mktg.*, FA 118277 (Nat. Arb. Forum Oct. 1, 2002) (“Because Complainant’s Submission constitutes a *prima facie* case under the Policy, the burden effectively shifts to Respondent. Respondent’s failure to respond means that Respondent has not presented any circumstances that would promote its rights or legitimate interests in the subject domain name under Policy ¶4(a)(ii).”).

Respondent is using the disputed domain name to resolve to a website that is likely to confuse Internet users into believing the website is associated with Complainant’s business. The Panel finds Respondent’s attempt to pass itself off as Complainant’s business is neither a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i) nor a legitimate noncommercial or fair use pursuant to Policy ¶4(c)(iii). See *Crow v. LOVEARTH.net*, FA 203208 (Nat. Arb. Forum Nov. 28, 2003) (“It is neither a *bona fide* offerings [sic] of goods or services, nor an example of a legitimate noncommercial or fair use under Policy ¶¶4(c)(i) & (iii) when the holder of a domain name, confusingly similar to a registered mark, attempts to profit by passing itself off as Complainant . . . .”); see also *Am. Int’l Group, Inc. v. Busby*, FA 156251 (Nat. Arb. Forum May 30, 2003) (finding that the respondent attempts to pass itself off as the complainant online, which is blatant unauthorized use of the complainant’s mark and is evidence that the respondent has no rights or legitimate interests in the disputed domain name).

Complainant asserts Respondent is neither commonly known by the <valianttrustco.com> domain name nor authorized to register domain names featuring Complainant’s VALIANT TRUST CO. mark in any way. Respondent cannot gain any rights to the “Valiant Trust” name by impersonating the real Valiant Trust (Complainant). In recognition of the lack of evidence suggesting otherwise, the Panel finds Respondent has not established rights or legitimate interests pursuant to Policy ¶4(c)(ii). See *Gallup, Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that the respondent does not have rights in a domain name when the respondent is not known by the mark); see also *RMO, Inc. v. Burbridge*, FA 96949 (Nat. Arb. Forum May 16, 2001) (interpreting Policy ¶4(c)(ii) “to require a showing that one has been commonly known by the domain name prior to registration of the domain name to prevail”).

The Panel finds Policy ¶4(a)(ii) satisfied.

### **Registration and Use in Bad Faith**

Respondent's use of the <valianttrustco.com> domain name will likely cause confusion with regard to Complainant's sponsorship of and affiliation with the resulting website. The Panel finds that such use of a domain name for Respondent's own commercial gain is evidence of Respondent's bad faith registration and use in accordance with Policy ¶4(b)(iv). *See Hewlett-Packard Co. v. Ali*, FA 353151 (Nat. Arb. Forum Dec. 13, 2004) ("Respondent [used "HP" in its domain name] to benefit from the goodwill associated with Complainant's HP marks and us[ed] the <hpduhai.com> domain name, in part, to provide products similar to those of Complainant. Respondent's practice of diversion, motivated by commercial gain, constitutes bad faith registration and use pursuant to Policy ¶4(b)(iv)."); *see also Utensilerie Assoc. S.p.A. v. C & M*, D2003-0159 (WIPO Apr. 22, 2003) ("The contents of the website, offering Usag products, together with the domain name may create the (incorrect) impression that Respondent is either the exclusive distributor or a subsidiary of Complainant, or at the very least that Complainant has approved its use of the domain name.").

Respondent has also given fictitious or false WHOIS information. This raises the presumption of bad faith registration and use, *Agent Host v. Host Dot Com Investments* AF-0343 (10/16/2000), *The Procter & Gamble Company v. Hong Gil Dong*, FA0510000572962 (11/16/2005), *Mattel, Inc. v. RanComp Ltd.*, FA0510000579563 (11/29/2005), *Zappos.com, Inc. v. RENATA Svensdotter*, FA0601000624407 (2/22/2006), *Delta Corporate Identity, Inc. and Delta Air Lines, Inc. v. Yong Li*, FA0510000576550 (3/27/2006), *Ulysses Learning Corporation v. G. Sone and Associates, Inc.*, FA0602000645878 (3/27/2006), *Microsoft Corporation v. Marine Safety Network Weather*, FA0603000655480 (4/26/2006), *Target Brands, Inc. v. Domains Ventures*, FA0603000671035 (5/15/2006) and *Ebynum Enterprises, Inc. v. Tag-Board.com Corporation*, FA0610000817104 (12/15/2006). Respondent's address on the web site itself is also fictitious. This Panel elects to accept that presumption of bad faith.

The Panel finds Policy ¶4(a)(iii) satisfied.

### **DECISION**

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <valianttrustco.com> domain name be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.  
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator,, Panelist  
Dated: January 11, 2007

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