

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

Domain Name: exxon.ca

Complainant: Exxon Mobile Corporation

Registrant: Oliver Twist

Registrar: Rebel.ca Corp.

Panel: David Allsebrook

Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant is Exxon Mobile Corporation, located in Irving Texas.
2. The registrant for the domain name is Oliver Twist (the “Registrant”) located in Ontario, Canada.

B. The Domain Name and Registrar

3. The disputed domain name is *exxon.ca* (the “Domain Name”). The registrar for this domain name is Rebel.ca Corp. (the “Registrar”). The disputed Domain Name was registered on January 8, 2003.

C. Procedural History

4. This is a proceeding under the Canadian Internet Registration Authority (“CIRA”) *Domain Name Dispute Resolution Policy* (Version 1.3) (the “Policy”) and the CIRA *Domain Name Dispute Resolution Rules* (Version 1.5) (the “Rules”).
5. The history of the proceeding as provided by the dispute resolution service provider, Resolution Canada, Inc. (“Resolution Canada”), is that the Complainant filed a complaint dated December 10, 2019 with Resolution Canada requesting that the current registration of the Domain Name be transferred to the Complainant.

6. Resolution Canada served notice of the complaint on the Registrant as required by paragraph 4.3 of the Rules. Service of the complaint on the Registrant was made by email on December 26, 2019.
7. The Registrant made no response or reply to the Complaint.

D. Panellist Impartiality and Independence

8. As required by paragraph 7 of the Rules, the panellist has submitted to Resolution Canada declarations of impartiality and independence in relation to this dispute.

E. Canadian Presence Requirements

9. The Complainant is a corporation located in the United States. However, since 1976 it has been the registered owner of a registration for the trademark EXXON in Canada (registration no. TMA214016). The Domain Name consists of this mark. Therefore, the Complainant satisfies the Canadian Presence Requirements under paragraph 2(q) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3.

F. Factual Background

10. The Registrant registered the Domain Name on January 8, 2003. The Domain Name resolves to a pay-per-click website displaying sponsored links to competitors of the Complainant, including Chevron and Royal Dutch Shell, and as well as links to sites selling goods and services that compete with, or rival, those offered by the Complainant. The website also provides a means by which end users may search for links to competitor sites of the Complainant. This use of the disputed domain name put the Respondent in a position to reap a financial benefit.
11. The Registrant is the owner of at least 65 dot-ca domain names which closely resemble well known trade names and trademarks of others, including, addidas.ca, alstate.ca, americanitunes.ca, astonmartin.ca, epxedia.ca, fordmotorcompany.ca, gmcdealer.ca, greyhoundcanada.ca, torontoraptors.ca, rbc Dominion Securities.ca, ubeer.ca and www.wallstate.ca.

G. CIRA Domain Name Dispute Resolution Policy

12. Paragraph 4.1 of the Policy requires that the Complainant establish that:
 - a) the Registrant's dot ca domain name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights;
 - b) (b) the Registrant has registered the domain name in bad faith as described in section 3.5; and

- c) (c) the Registrant has no legitimate interest in the domain name as described in section 3.4.

13. The Complainant must establish points (a) and (b) above on the balance of probabilities and for point (c) it must provide some evidence that the Registrant has no legitimate interest in the domain name. Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in section 3.4 of the Policy.

H. Analysis

Rights to a Mark

14. Under paragraph 4.1(a) of the Policy, the Complainant has to show, on the balance of probabilities, that it had rights (and continues to have these rights) in a mark that was confusingly similar to the domain name, prior to the date of registration of the disputed domain name. "Mark" is defined in paragraph 3.2(c) of the Policy as:

- (a) a trade-mark, including the word elements of a design mark, that is registered in CIPO;

15. The Domain Name was registered on January 8, 2003, long after the trademark EXXON was registered in Canada by the Complainant. The Complainant has established that it had rights in a mark prior to the date of registration of the Domain Name, and continues to have these rights.

16. The Domain Name consists of the word Exxon, which is the same as the only word the registered mark. Therefore, pursuant to paragraph 3.3 of the Policy, the Domain Name is confusingly similar to the mark BAREMINERALS as it so nearly resembles the mark in appearance, sound and in the idea suggested by the mark as to be likely to be mistaken for the mark.

Bad Faith

17. The Complainant also has to show, on the balance of probabilities, that the Domain Name was registered in bad faith. Paragraph 3.5 of the Policy deals with the grounds which constitute bad faith and it must be noted that these are not exhaustive; it is open to the panel to find other grounds which lead to a conclusion of bad faith conduct.

18. The Complainant argues first that the Registrant's conduct constitutes bad faith pursuant to paragraph 3.5(b) of the Policy which states:

- a) The Registrant registered the domain name or acquired the Registration, in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name; provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern

of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names.

19. In order to succeed on this ground the Complainant has to show, on the balance of probabilities, that the Registrant has engaged in a pattern of registering domain names in order to prevent persons who have rights in marks from registering the marks as domain names.

20. The Registrant's portfolio is comprised of 1598 domain name registrations, includes at least 65 domain names comprised of, or confusing with, third party trademarks to which the Registrant does not appear entitled. These domain name registrations are as follows:

addidas.ca cbcthenational.ca medicaid.ca aepi.ca cessna.ca mlssearch.ca
airbnbmortgage.ca colinjames.ca monvisalus.ca allwaters.ca crisco.ca
motts.ca alstate.ca delo.ca photoshop.ca americanitunes.ca epxedia.ca
ralstonpurina.ca arcterra.ca famousplayer.ca rbc DominionSecurities.ca
arrowecs.ca fordmotorcompany.ca remaxhomes.ca astonmartin.ca
fosterpontiac.ca senstv.ca autocad.ca gmdealer.ca smurf.ca avda.ca
googleearth.ca telusplanet.ca babar.ca googoe.ca toocows.ca barbet.ca
greycuptour.ca torontobluejays.ca batman.ca greyhoundcanada.ca
torontoraptors.ca biao.ca harryrosen.ca travelchannel.ca blurays.ca hoola.ca
twocows.ca bmws.ca jobzilla.ca uber.ca bridor.ca kwrealty.ca viacanada.ca
bwbank.ca macdonalds.ca walmart.ca casis.ca markburnett.ca wwallstate.ca
catwoman.ca maxtel.ca cbcnorth.ca mcdonaldscoupons.ca

21. The Registrant has engaged in a pattern of registering the trademarks and names of others as domain names, and has prevented the Complainant from registering exxon.ca.

22. The Complainant also alleges that the Registrant's conduct constitutes bad faith under paragraph 3.5(d) of the Policy which states:

- a) The Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other online location, by creating a likelihood of confusion with the Complainant's Mark, as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

23. The use of third parties' trademarks, including the Complainants', to generate revenue through "pay per click" web sites falls within the scope of the conduct described in paragraph 3.5(d) of the Policy and also constitutes bad faith.

Legitimate Interest

24. In order to succeed the Complainant has to provide some evidence that the Registrant does not have a legitimate interest in the domain name. Paragraph 3.4 of the Policy lists six possible ways in which a Registrant may have a legitimate interest in a domain name which are as follows:

- (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 registered 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 registered 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.

25. This list is not exhaustive as it is said to be "without limitation".

26. The Complaint need only raise a reasonable challenge to the legitimacy of the domain name registration to establish its case in the absence of a show of legitimacy by the Registrant. The Domain Name, and its use by the Registrant, do not appear to fit in any of the categories listed in paragraph 3.4 and no other ground of legitimacy suggests itself in the circumstances. The Complaint meets its burden and the Registrant has offered no reply.

I. Conclusion and Decision

27. In conclusion, the panel finds that the Complainant has rights in the mark EXXON which predate the registration of the Domain Name. The panel also finds that the Domain Name is confusingly similar to the Complainant's mark EXXON, that the Domain Name was registered in bad faith and that the Registrant has no legitimate interest in the Domain Name.
28. The panel therefore orders, pursuant to paragraph 4.3 of the Policy, that the registration of the Domain Name exxon.ca be transferred to the Complainant.

Dated: February 3, 2020



By: David Allsebrook