

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

Domain Name: AMERICANEXPRESSCREDITCARDS.CA

Complainant: American Express Marketing and Development Corp.

Registrant: Nameshield Inc., c/o Daniel Mullen

Registrar: Dot-ca-registry.ca (Burmac Business Systems Ltd)

Panelists: David Allsebrook, Eric Macramalla, Teresa Scassa (Chair)

Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant is the U.S.-based company American Express Marketing & Development Corp. The Complainant's principal place of business is in New York City, New York.
2. The Registrant is Nameshield, Inc., a Canadian company based in Prince Edward Island. The contact person for Nameshield, Inc. is Daniel Mullen. Daniel Mullen is also the sole director of Nameshield, and it was Daniel Mullen who filed the response to the Complaint on behalf of the Registrant.

B. The Domain Name and Registrar

3. The disputed domain name is <americanexpresscreditcards.ca>. The Registrar for the domain name is Dot-ca-registry.ca (Burmac Business Systems Ltd.). The disputed domain name was registered on January 26, 2011.

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 1.4) (the *Rules*).
5. The Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, Resolution Canada, Inc. The date of commencement of the

proceedings was December 6, 2013. The Provider served notice of the Complaint to the Registrant as required by paragraph 4.3 of the *Rules*, and the Registrant was given a 20 day period in which to file a response to the Complaint. A response was duly filed. This panel was constituted to hear the matter on January 17, 2014.

6. The Complainant requests, as a remedy, that the disputed domain name be transferred to it.

D. Panelist Impartiality and Independence

7. As required by paragraph 7.2 of the *Rules* the panelists have submitted to the Provider a declaration of impartiality and independence in relation to this dispute.

E. Canadian Presence Requirements

8. The Complainant is the owner of two Canadian trademark registrations for AMERICAN EXPRESS (TMA228745 and TMA237656). Because the disputed domain name incorporates this trademark in its entirety, the Complainant is an eligible Complainant within the meaning of clause 1.4 of the *Policy*.

9. Mr. Mullen, on behalf of the Registrant, made a series of arguments that called into question the validity of the Complainant's registered trademarks. He went so far as to suggest that the panel suspend its hearing to refer the issue of validity to the Canadian Intellectual Property Office. The panel notes that, once registered, a trademark is presumed valid. It is not the responsibility of a dispute resolution panel to challenge the validity of a Complainant's trademark, nor is the CIRA dispute resolution process the proper forum for making determinations of trademark validity.

F. Background

10. The Complainant's AMERICAN EXPRESS trademarks were registered in 1978 and 1979 respectively for services ranging from credit card and travel-related services to credit authorization and mail order services. For some of these services, first use dates back to 1891. It is clear that the Complainant's marks have been used in Canada over a substantial period of time. The Complainant maintains that its marks are famous internationally, and has provided evidence to support this position.

11. The Registrant Nameshield, Inc. registered the disputed domain name <americanexpresscreditcards.ca> on January 26, 2011. Daniel Mullen, who responded to this Complaint, is listed as the Administrative Contact for this domain name. He is also listed as the sole Director of Nameshield, Inc. in the registry of Federal Corporation Information. In his response to the Complaint, the Mr. Mullen maintains that the "beneficial registrant" of the disputed domain name is a corporation named Bankrate Corporation. The Federal Corporation Information registry indicates that Daniel Mullen is the sole director of Bankrate Corporation.

12. There might, in other circumstances, be an issue regarding the ability of a Registrant to make arguments on behalf of a non-party company that is alleged to be a 'beneficial owner' of the domain name registration, particularly where there is no documentation from that company regarding the matter. However, because Mr Mullen is the sole director of both Nameshield, Inc. and Bankrate Corporation, and because he is unrepresented by legal counsel, we are prepared to consider his arguments in this case.

13. The disputed domain name <americanexpresscreditcards.ca> resolves to a website that displays the domain name as a banner. The landing page for the website also features a series of links relating to credit card services. Each of these links resolves to another web site. The first link, titled Credit Card Online, resolves to a page that features more links to different credit card-related services. One of these links is titled Accept American Express, and it in turn resolves to an official website of the Complainant. Other links on the page resolve to the websites of other credit card companies, who are naturally competitors of the Complainant.

G. *CIRA Domain Name Dispute Resolution Policy* Requirements

14. Paragraph 4.1 of the *Policy* provides that to succeed, a Complainant must establish on a balance of probabilities 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; and

(b) the Registrant has registered the domain name in bad faith as described in paragraph 3.5;

The Complainant is also required to provide "some evidence" that:

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

H. Analysis

Confusingly Similar

15. Under paragraph 3.1(a) of the *Policy*, the Complainant must establish on a balance of probabilities that the disputed domain name is confusingly similar to a mark of the Complainant's; that the Complainant had rights in that mark prior to the date of registration of the domain name; and that it continues to have such rights.

16. The Complainant's AMERICAN EXPRESS trademarks were registered in Canada in 1978 and 1979. As such, these rights substantially predate the registration of the disputed domain name in 2011, and they continue in existence to this day.

17. The test for “confusingly similar” is set out in paragraph 3.3 of the *Policy*. This test requires the panel to consider only “whether the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark.” The test is considered to be one of first impression and imperfect recollection (*Government of Canada v. Bedford*, May 27, 2003, <http://www.cira.ca/assets/Documents/Legal/Dispute/2003/00011govt-of-canada-En.pdf>).

18. The relevant Mark of the Complainant is its registered trademark AMERICAN EXPRESS. The disputed domain name is <americanexpresscreditcards.ca>. The Complainant submits that because the domain name incorporates its trademark in its entirety, the domain name is confusingly similar to its Mark. It also submits that the addition of the words “credit cards” to the trademark enhances rather than diminishes the confusing similarity because American Express is well known for its credit card business. Aside from the arguments relating to the validity of the AMERICAN EXPRESS trademark, which are dealt with in paragraph 9 of this decision, the Registrant did not appear to make any submissions on this point.

19. The panel finds that the disputed domain name <americanexpresscreditcards.ca> is confusingly similar to the Complainant’s AMERICAN EXPRESS trademark. Not only does it incorporate the well-known trademark in its entirety, the panel accepts that the addition of the words “credit cards” is likely only to increase the confusing similarity. (*Americana International Ltd. v. Bench Clothing Store Ltd.*, September 17, 2013. <http://www.cira.ca/assets/Documents/Legal/Dispute/2013/00238-benchclothing-ca.pdf>; *Re Swarovski Aktiengesellschaft*, May 6, 2013, <http://www.cira.ca/assets/Documents/Legal/Dispute/2013/00227-swarovskishop-ca.pdf>).

20. We therefore conclude that the Complainant has succeeded in establishing confusing similarity under paragraph 3.1(a) of the *Policy*.

Bad Faith

21. The Complainant must also establish on a balance of probabilities that the disputed domain name was registered in bad faith. Paragraph 3.5 of the *Policy*, sets out 4 broad categories of bad faith, but this is not a closed list of circumstances in which bad faith registration may be found.

22. The Complainant argues that the Registrant has acted in bad faith within the meaning of paragraphs 3.5(d), 3.5(c) and 3.5(b).

23. Under paragraph 3.5(d), a finding of bad faith will be made where the Complainant establishes that

(d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant’s website 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 the Registrant's website or location or of a product or service on the Registrant's website or location.

24. As noted earlier, the disputed domain name resolves to a website that displays the domain name as a banner. The landing page contains a series of links relating to credit card services. Each of these links in turn resolves to another web site that features more links to financial and credit card services. These include a link to an official website of the Complainant as well as links to the websites of competitors of the Complainant.

25. The Complainant has provided evidence that the website to which the disputed domain name resolves is a pay-per-click service operated by Name Administration Inc. The evidence that the site is operated by Name Administration Inc. includes the fact that the privacy policy that appears on the site is that of Name Administration Inc. The Complainant also cited several decisions under ICANN's Uniform Dispute Resolution Policy, where panelists had found that Name Administration Inc. was engaged in operating pay-per-click services.

26. The Registrant, in response, argues that it does not use the logo or other trade dress of the Complainant. Mr Mullen admits, however, that the URL directs traffic to the Registrant's web site. He denies any relationship with Name Administration Inc., and maintains that Name Administration or NA Media "is a service provider to a company which provides advertising placement services on behalf of Google Inc."

27. The panel is of the view that the use of a URL that incorporates the Complainant's registered trademark, and that is confusingly similar to that mark, in order to direct internet traffic to a pay-per-click site, creates a "likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website", within the meaning of paragraph 3.5(d) of the CDRP. We note that it is well-established that the use of domain names that are confusingly similar to registered trademarks to direct internet traffic to pay-per-click sites can amount to bad faith. (See, e.g.: *Trans Union LLC v. 1491070 Ontario Inc.*, CIRA Decision #2003-0008, 2003 LNCIRA 5, 27 C.P.R. (4th) 148, <<http://www.cira.ca/assets/Documents/Legal/Dispute/2003/00008Trans-UnionA.pdf>>, *Omer DeSerres Inc. v. Maddeaux*, CIRA Decision #2007-00088, 2007 LNCIRA 20, <<http://www.cira.ca/assets/Documents/Legal/Dispute/2007/00088-omerdeserres.ca.pdf>>.)

28. Because we have found bad faith registration under paragraph 3.5(d) we see no need to address the other arguments regarding bad faith that were advanced by the Complainant.

Legitimate Interest

29. Under paragraph 4.1(c) of the CDRP, the Complainant must provide *some evidence* that "the Registrant has no legitimate interest in the domain name". Paragraph

3.4 describes six circumstances in which a legitimate interest may arise, although this is not a closed list. The circumstances include:

- (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.*

30. The Complainant is only required to meet the lower threshold of “some evidence” because it will often be difficult for a Complainant to know of all of the circumstances which might support a Registrant’s claim to a legitimate interest. Once the Complainant has provided “some evidence”, the Registrant may provide evidence of its own to establish any *bona fide* interest it might have in the disputed domain name.

31. The Complainant argues that there can be no legitimate interest under the first 4 paragraphs of clause 3.4 because each of these requires the Registrant to have used the domain name in good faith. In a case such as this, where the Complainant’s marks are famous, the Complainant argues that a good faith commercial use is not possible. This is particularly so where the domain name resolves to a pay-per-click service. The Complainant also notes that it has never licensed or authorized the Registrant to use its trademarks. The trademark at issue is not descriptive in any sense, nor is it generic, and it is not being used in relation to any good faith non-commercial activity.

32. Mr. Mullen appears to argue that Bankrate Corporation, which he says is the true Registrant of the disputed domain name, was established in order to provide information

to consumers about various financial services available on the market. Mr. Mullen argues that the reason for the registration of the disputed domain name is that consumers are confused about the financial services offered by American Express.

33. Mr. Mullen also argues that the Registrant holds a significant number of domain name registrations in the .ca domain which incorporate the word “credit”, with a view to offering its credit information services. A random sampling of these domain names showed that many did not resolve to any website at all, while others resolved to websites similar in look and feel to the one to which the disputed domain name resolves, and offering a similar array of links.

34. We find that the Complainant has met its burden of providing “some evidence” that the Registrant has no legitimate interest in the disputed domain name. We note that the Registrant’s arguments regarding Bankrate’s consumer information services are not supported by any documentation. In any event, the disputed domain name resolves to a website that offers no evident services beyond an aggregation of hyperlinks via a pay-per-click service. The very activity that supports a finding of bad faith cannot at the same time reflect a legitimate interest on the part of the Registrant. We find that the Registrant has not succeeded in establishing that it has a legitimate interest in the domain name <americanexpresscreditcards.ca>.

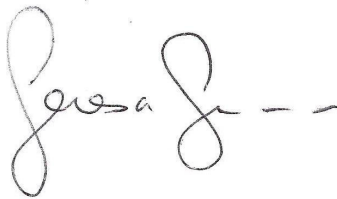
I. Conclusion and Decision

35. In conclusion, we find that the Complainant has rights in the mark AMERICAN EXPRESS, and that the disputed domain name, <americanexpresscreditcards.ca> is confusingly similar with this mark. We also conclude that the Registrant has no legitimate interest in the domain name, and that it registered the domain name in bad faith.

36. We therefore find that the registration of the domain name <AMERICANEXPRESSCREDITCARDS.CA> should be transferred to the Complainant American Express Marketing and Development Corp.

Dated: February 5, 2014

Teresa Scassa (Chair), David Allsebrook, Eric Macramalla

A handwritten signature in black ink, appearing to read "Teresa Scassa". The signature is fluid and cursive, with a long horizontal stroke at the end.

Teresa Scassa (Chair) for the panel