

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

Domain Name: INTERTEKOIL.CA

Complainant: Intertek Testing Services NA Ltd.

Registrant: Intertek Oil and Gas and/or Canada Oil & Gas Recruitment Agency

Registrar: PublicDomainRegistry.com Inc

Panellist(s): Myra J. Tawfik

Service Provider: Resolution Canada

DECISION

1. The Parties:

The Complainant is Intertek Testing Services NA Ltd, a legal person incorporated under the Canada Business Corporations Act with its registered office at 6225 Kenway Dr., Mississauga, Ontario L5T 2L3

The Complainant is represented by McCarthy Tétrault LLP, Suite 5300 Toronto Dominion Bank Tower, Toronto, Ontario M5K 1E6

The Registrant is Intertek Oil and Gas and/or Canada Oil & Gas Recruitment Agency. A WHOIS database search indicates its address as 7999 Boulevard Les Galeries d'Anjou, Anjou, Quebec H1M 1W6 and its administrative contact as Dr. David Raymond. There is no telephone number listed for the Registrant

2. The Domain Name and Registrar

The disputed domain name is INTERTEKOIL.CA and the Registrar is PublicDomainRegistry.com

3. Procedural History

On September 23, 2013, the Complainant initiated a complaint with Resolution Canada under the Canadian Internet Registration Authority (CIRA) Dispute Resolution Policy (CDRP) and the CIRA Domain Name Dispute Resolution Rules (the Rules).

Resolution Canada is an approved Dispute Resolution Service Provider under the CDRP.

Pursuant to Rule 5.1, the Registrant was notified by Resolution Canada that it had 20 days from September 23, 2013 to file 5 copies of a Response to the Complaint.

The Registrant did not file a Response within the stipulated delay.

On October 25, 2013, Resolution Canada appointed Myra J. Tawfik as sole panelist on the complaint after having received from her a declaration of impartiality and independence. A notice of selection of panelist was sent to all parties at that date.

As the Registrant has not responded to the Complaint, the Panel shall decide the proceeding on the basis of the Complaint.

4. Eligible Complainant

The Complainant is a legal person under the *Canadian Business Corporations Act* and therefore meets the Canadian Presence Requirements for Registrants at s. 2(d).

5. Parties' Contentions

A. The Complainant:

The Complainant alleges the following:

It is the registered owner in Canada of the trademark INTERTEK (the Mark) in association with a number of wares and services relating to testing, inspection and consultancy services for a wide range of industries. The trademark was registered on September 20, 2007 based on use at least as early as January 1, 1998. The Complainant acquired the trademark by assignment from Intertek Group Plc (the "Parent Company") on January 8, 2007. The Complainant is also the registered owner in Canada of a number of other trademarks incorporating the INTERTEK trademark. In addition, the Complainant has registered and uses the domain name intertek.ca.

The Mark has become widely known in Canada for quality testing, inspection and consultancy services in a number of industries but most especially within the oil and gas industry.

A WHOIS search conducted by the Complainant identifies the Registrant as Intertek Oil & Gas with its head office in Anjou, Quebec and with a registration date for the domain name INTERTEKOIL.CA of May 21, 2013. Further investigations by the Complainant revealed that another entity - Canada Oil & Gas Recruitment or Recruitment [sic] Agency was associated with the Registrant. The Complainant considers this company and the Registrant as having a joint and several interest in the disputed domain name.

The Complainant has no relationship with the Registrant or Canada Oil & Gas Recruitment Agency.

The Registrant's website reproduces verbatim the content of various websites in the oil and gas industry and that, through its website, it is suggesting that the services it offers are being provided by the Complainant. In one instance, a job offer was issued by Canada Oil & Gas Recruitment Agency using the email address jobs@intertekoil.ca and the name Intertek Oil Servicing Company Ltd without the knowledge or authorization of the Complainant.

On June 26, 2013, the solicitor for the Parent Company sent a cease and desist letter to the Registrant at info@intertekoil.ca on June 26, 2013. Not receiving a reply, the solicitor sent a similar letter on July 11, 2013 to jobs@canoilgasrecruit.ca. The solicitor received an unsigned response on July 13, 2013 that threatened to hack the website of the Parent Company and to 'trace and kill' the solicitor. The email further threatened that the solicitor would be 'a dead man' should anything happen to the Registrant's website.

The Registrant's domain name INTERTEKOIL.CA 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. The Complainant further alleges that the Registrant has registered the domain name in bad faith and that the Registrant had no legitimate interest in the domain name.

The Complainant requests the transfer to it of the domain name INTERTEKOIL.CA

B: The Registrant

The Registrant has not filed a Response to the Complaint.

6. Findings

Under paragraph 4.1 of the CDRP, the burden is on the Complainant to prove, on a balance of probabilities, that

1) 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

2) The Registrant has registered the domain name in bad faith

And to provide some evidence that:

3) The Registrant has no legitimate interest in the domain name.

Under Rule 12.1, the Panel shall render its decision based on the CDRP and Rules, the evidence and arguments submitted and any relevant rules and principles of the laws of Ontario and the laws of Canada. Further, inferences can be drawn about the Registrant's motives in registering the domain name from the Registrant's conduct or other surrounding circumstances including the uses to which the domain name is put. *See Canadian Broadcasting Corp v. Quon* CIRA Dispute #00006 (2003); *Government of Canada v. Bedford* CIRA Dispute #00011 (2003)

6.1. Is the Registrant's domain name confusingly similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and in which Complainant continues to have such Rights?

The Complainant has established that its registered trademark INTERTEK is a Mark in which it had Rights prior to the date of registration of the disputed domain name and in respect of which it continues to have such rights. The registration of the trademark INTERTEK predates the Registrant's domain name registration date of May 21, 2013. In addition, the registrations in Canada of the various INTERTEK family of marks also predate the Registrant's domain name registration.

According to Paragraph 3.3 of the CDRP a domain name is confusingly similar to a Mark "...if 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 Panel finds that the Registrant's domain name INTERTEKOIL.CA is confusingly similar to the Mark INTERTEK in appearance, sound and idea so as to be likely to be mistaken for it. The Complainant has established that the Mark is well-known in Canada within the oil and gas industry and, as such, the addition of the word 'oil' to the Registrant's domain name only serves to reinforce the confusing similarity.

6.2 The Registrant has registered the domain name in bad faith

The Complainant must prove bad faith on a balance of probabilities. The Complainant alleges that the Registrant registered the domain name primarily to disrupt its business and to attract, for commercial gain, internet users by creating a likelihood of confusion under paragraph 3.5(c) and (d) of the CDRP. The Panel considers that the Complainant has discharged its onus on both counts.

The Complainant has shown that the Registrant's website contains large portions of content copied from the Complainant's website and those of its competitors in the oil and gas industry. The domain name and the website clearly have the effect of disrupting the business of the Complainant. The website itself identifies the Registrant's business as "Intertek Oil and Gas". An individual searching for the Complainant and ending up on the Registrant's website would be easily confused. The fact that the Registrant is competing for web traffic with the Complainant makes the Registrant a competitor of the

Complainant. *LEGO Juris A/S v. James Carswell* Resolution Canada, CIRA Dispute No. 00150

Further, as the Complainant has amply demonstrated, the Registrant's domain name and its website suggest to unsuspecting customers and potential employees that it is somehow associated with the Complainant. The Registrant purports to offer services through its website in a manner that suggests that it is either the Complainant or acting on its behalf. The Complainant has adduced evidence to demonstrate that at least one individual was misled by the Registrant into thinking that an offer of employment had been made by the Complainant.

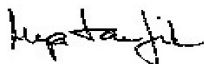
Finally, the conduct of the Registrant in attempting to intimidate the Complainant by issuing a death threat in response to the Complainant's legitimate attempt to safeguard its rights is a factor to be taken into account in the determination of bad faith.

6.3 The Registrant has no legitimate interest in the domain name

The Complainant must provide some evidence that the Registrant had no legitimate interest in the domain name. A Registrant has a legitimate interest in the domain name for the reasons set out in paragraph 3.4 of the CDRP. None of the six legitimate uses identified in this paragraph apply in this case. The Registrant had no right in the Mark at the time of registration of the domain name, it was not acting in good faith in registering the domain name and it is making a commercial use of the domain name. Finally, the domain name is not the legal name of the Registrant nor is it the geographical name of the location of its business.

7. Decision:

The Panel concludes that the Complainant has established its entitlement to a remedy under paragraph 4.3 of the CDRP. The disputed domain name is confusingly similar to a Mark in which the Complainant has and continues to have rights. The Registrant registered the domain name in bad faith and without legitimate interest. The Panel orders the transfer of the disputed domain name INTERTEKOIL.CA to the Complainant.



Myra J. Tawfik
Sole Panellist
November 15, 2013