

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

Domain Names: OAKLEYSUNGLASSESFORSALE.CA
OAKLEYSUNGLASSESSTORE.CA
OAKLEYSUNGLASSESHEAP.CA

Complainant: Oakley, Inc.
Registrant: linok leyzhen
Registrar: eNom Canada Corp.

Panel: David Lametti (sole panelist)

Service Provider: ResolutionCanada

DECISION

A. The Parties

1. The Complainant is Oakley, Inc., a company registered in the State of Washington, and whose registered head office address is One Icon, Foothill Ranch, California, 92610, USA. Their authorized representative is David S. Lipkus, of Kestenberg Siegal Lipkus LLP, Barristers and Solicitors, 60 Granby Street, Toronto Ontario M5B 1H8.
2. The Registrant was undisclosed to the Complainant. It was revealed to the Dispute Resolution Provider as linok leyzhen, Sheng Li Road, Putian, Fujian, China, 351100.

B. The Domain Name and Registrar

3. The domain names at issue are OAKLEYSUNGLASSESFORSALE.CA, OAKLEYSUNGLASSESSTORE.CA and OAKLEYSUNGLASSESHEAP.CA.
4. The domain names are registered with eNom Canada Corporation.

C. Procedural History

5. On 22 May 2013, the Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, ResolutionCanada. The Complainant elected to have the matter heard by a single-member panel. The Provider served notice of the Complaint to the Registrant as required by paragraph 4.3 of the *CIRA Domain Name Dispute Resolution Rules* (version 1.4) [“Rules”].

6. No response was received from the Registrant.

7. The Provider therefore moved to have the Complaint treated as uncontested, and appointed a panelist, all as governed by the Rules.

D. Panel Member Impartiality and Independence Statement

8. As required by paragraph 7 of the Rules, the panelist has declared to the Provider that he can act impartially and independently in this matter, as there are no circumstances known to him that would prevent him from so acting.

E. Canadian Presence Requirement

9. Oakley's trademarks OAKLEY, incorporating both the word "Oakley" and various related designs and logos, are registered in Canada and thus satisfy the Canadian Presence Requirement as stated in paragraph 1.4 of the *CIRA Domain Name Dispute Resolution Policy* (version 1.3) ["Policy"].

F. Factual Background

10. Oakley, Inc. ("Oakley") manufactures and distributes high-performance sunglasses, prescription lenses and frames, goggles, apparel, footwear and accessories. Many of these have been sold using the OAKLEY trademarks from as early as 1976. In Canada, many of these products have been sold using the OAKLEY marks since 1979.

11. Oakley owns the OAKLEY marks, which in addition to the OAKLEY word in block letters also comprises associated logos, designs and marks. It holds trademark registrations in over 100 countries. Oakley also has numerous registrations in Canada, all reproduced in the evidence supporting the Complaint, with the oldest trademark registration dating to April 27, 1984 for the word OAKLEY.

12. The Complainant has indeed provided evidence of the fact that the OAKLEY mark is quite well known, with Oakley spending large sums of money in advertising and promoting the mark. It has built extensive goodwill in the mark through its use in various forms of media, including television, the internet and social networking media.

13. The Registrant registered the domain names on 5 June 2012. They are set to expire on 5 June 2013.

14. The Complainant became aware of the oakleysunglassesforsale.ca domain on 3 October 2012. At about that time, the domain resolved to a website that featured Oakley products and gave the impression of being an official Canadian supplier of Oakley products (Complaint Schedule D). On 4 October 2012, a letter was sent to the Registrant through the CIRA message delivery form, advising the Registrant of the Complainant's

rights and seeking a transfer of the oakleysunglassesforsale.ca domain (Complaint Schedule E). No response was received.

15. A letter was also sent on 4 October 2012 to the original ISP (Complaint Schedule F), who removed the content from the website. At some point after 12 October 2012, the Registrant switched ISPs. Another letter was sent by the Complainant to the new ISP (Complaint Schedule G), though no response was received from the ISP.

16. At a point subsequent to these events, the Complainant learned of the registration of the other two domain names at issue, oakleysunglassesstore.ca and oakleysunglassescheap.ca. These domains also resolve to websites that feature exclusively the Complainant's products and give the impression of being linked to the Complainant.

17. The Complainant filed this Complaint on 22 May 2013.

G. CIRA Domain Name Dispute Resolution Policy Requirements

18. The *CIRA Domain Name Dispute Resolution Policy* (version 1.3) ["Policy"] sets out at paragraph 4.1 what the Complainant must establish in order to successfully prove the Complaint:

To succeed in the Proceeding, the Complainant must prove, 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;

and the Complainant must provide some evidence that:

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

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 . . .

19. The Panel will deal with each criterion in turn.

H. Is the Registrant's Domain Name Confusingly Similar to the Complainant's Mark?

20. Paragraph 3.2 of the Policy includes the following in the definition of what constitutes a “mark” for the purposes of the Policy:

A “Mark” is:

- (a) a trade-mark . . . or a trade name that has been used in Canada . . . for the purpose of distinguishing the wares, services or business of that person . . . from the wares, services or business of another person; [and]
- (c) a trade-mark . . . that is registered in CIPO . . .

21. The Complainant must establish trademark rights that precede the domain name(s) registration date(s). It has clearly done so. Common law rights were asserted as of 1979, and a slew of trademarks registered in Canada with CIPO prior to the domain name registration in June 2012 were also put into evidence.

22. Paragraph 3.3 of the Policy defines “confusingly similar” in the following terms:

In determining whether a domain name is “Confusingly Similar” to a Mark, the Panel shall only consider 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.

23. For the purposes of this proceeding, what must be determined is whether the domain name at issue “so nearly resembles the Mark in appearance, sound or the ideas suggested”. It is now well-established in Canadian domain name dispute resolution: (i) that what is to be considered is the part of the domain name preceding the “dot-ca”; and (ii) that inserted descriptive or generic words such as “for sale” and “store” will not necessarily prevent domain names from being found to be confusingly similar.

24. In this case, the Panel finds that the addition of the words “sunglasses” to the Oakley name and mark in each domain name, with the words “for sale”, “store” and “cheap” subsequently grafted on in turn in the three domains, does not dispel the likely confusion that is created by incorporating the OAKLEY trademark within the domains. Sunglasses are one of the main products for which Oakley is known, and the words “for sale”, “store” and “cheap” do nothing to distinguish a different source or dispel confusion. What stands out, what is distinctive, or indeed what is central or determinative in each domain is the “Oakley” portion of the domain.

25. Moreover, the websites to which the domain names resolve clearly gave or were meant to give the impression that they were linked to Oakley. These websites contained OAKLEY logos and marks, text describing Oakley and its products (the “About Us” section) and words and layout purporting to be or leading to an inference to be either Oakley’s Canadian on-line store, or a discount Oakley store. An average user would clearly be confused by such text and layout, in addition to the initial confusion engendered by the domain names themselves. Thus the domain names are very much confusingly similar in terms of “appearance, sound or the ideas suggested”.

26. Thus the Panel finds that Registrant's domain names OAKLEYSUNGLASSESFORSALE.CA, OAKLEYSUNGLASSESSTORE.CA and OAKLEYSUNGLASSESHEAP.CA are confusingly similar with the Complainant's registered marks in which the Complainant had rights prior to the registration of the substantially similar domain names.

I. Was the Registration of the Domain Name Made in Bad Faith?

27. In order to succeed in the second stage of the test set out in paragraph 4.1, the Complainant must show, on the balance of probabilities, that the Registrant registered the domain name in bad faith. Paragraph 3.5 of the Policy states that the Registrant will be considered to have registered the domain name in bad faith, generally if one of the following four conditions is met:

For the purposes of paragraphs 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:

- (a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration;
- (b) 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;
- (c) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant; or
- (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.

28. These four criteria are exemplars of certain kinds of bad faith behaviour, and thus make possible other acts demonstrating bad faith. In this case, however, the activity clearly falls under the enumerated heads of bad faith. While the Complainant's argument is effectively framed under all of the various heads of Paragraphs 3.5, it is really under Paragraphs (c) and (d) where the Complainant's argument is most clearly persuasive and effective.

29. Paragraph 3.5(d), a product of recent changes to the CDRP, is most directly relevant to this dispute. It adds the practice of *intentionally attempting to attract users* for commercial gain as a listed criterion of bad faith where such is done by "creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement" of what the Registrant has to offer – it seems in the widest sense – on its website.

30. As mentioned above, the websites to which the domain names resolve clearly gave the impression that they were linked to Oakley. They were deliberately tailored to give the impression of "same source" as, sponsorship by, affiliation with, or endorsement from Oakley, thus creating confusion, and all for the purposes of drawing internet traffic to the Registrant's sites for the purposes of commercial gain. This is bad faith behavior falling squarely under paragraph 3.5 (d).

31. Moreover, it also is disruptive of the Complainant's business in Canada, competing with it in a deceptive or misleading fashion, thus falling under Paragraph 3.5(c) as well.

32. Therefore this Panel concludes that the Registrant acquired the domain names OAKLEYSUNGLASSESFORSALE.CA, OAKLEYSUNGLASSESSTORE.CA and OAKLEYSUNGLASSESCHIEAP.CA in bad faith as defined under both paragraphs 3.5(c) and 3.5(d) of the Policy.

J. Does the Registrant Have a "Legitimate Interest" In the Domain Name?

33. The third element of the test set out in paragraph 4.1 of the Policy is to determine whether or not the Registrant has a legitimate interest in the domain name. This inquiry tries to find some more or less objective or ascertainable link between the Registrant and the domain name in question, aside from mere registration, and which is legitimate. Paragraph 3.4 of the Policy, as revised, now states:

For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in a domain name:

- (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.

In paragraph 3.4(d) "use" by the Registrants includes, but is not limited to, use to identify a web site.

34. The first four criteria contain an element of good faith in assessing the behaviour of the Registrant, while the last two point to more objective facts linking the domain name to the Registrant.

35. In terms of the procedure required under the Policy, the Complainant must provide some evidence that none of these or similar interests can reasonably apply to the Registrant. The burden would then shift to the Registrant to show that it has, on the balance of probabilities, any one of these legitimate interests as defined under these subparagraphs, as well as, in the amended version, other legitimate interests not so listed.

36. The Complainant has introduced sufficient evidence of the Registrant having no legitimate interest as exemplified under any of the listed heads. The Complainant has not been able to identify any manner in which the Registrant might have a legitimate interest in the domain name. In particular:

- the Registrant was trying in effect to set up a "Canadian version" of the Complainant's website, but had neither permission nor license, express or implied to use the marks, nor authorization, nor was there acquiescence on the part of the Complainant;

- the domain names were not clearly descriptive, in English or French, of character, quality, origins, etc., of the wares;
- the domain names were not generic terms; and
- the Registrant did not use the domain name in a bona fide offering of non-commercial services or activity, in part (as shown above in the discussion of bad faith) because the activities were commercial, and in part because the Respondent was alleged to be selling counterfeit Oakley products, all of which was in bad faith.

37. The Complainant also provided *prima facie* claims that the Respondent did not fall under any of the objective links to the domain names under Paragraphs 3.4(e) and (f).

38. The Complainant having thus satisfied its initial burden of showing “some evidence” of “no legitimate interest” puts the onus on the Registrant to show a legitimate interest.

39. The Registrant has not responded, and thus fails to meet its burden of showing any legitimate interest in the domain name.

40. The Panel therefore concludes that the Registrant did not have a legitimate interest in the domain names OAKLEYSUNGLASSESFORSALE.CA, OAKLEYSUNGLASSESSTORE.CA and OAKLEYSUNGLASSESHEAP.CA CHEAPMONDAY.CA under paragraph 3.4 of the Policy.

K. Conclusion and Decision

41. The Complainant has established that the Registrant’s domain names OAKLEYSUNGLASSESFORSALE.CA, OAKLEYSUNGLASSESSTORE.CA and OAKLEYSUNGLASSESHEAP.CA are confusingly similar to the Complainant’s registered Canadian OAKLEY trademarks.

42. The Complainant has established that the Registrant had registered the domain names OAKLEYSUNGLASSESFORSALE.CA, OAKLEYSUNGLASSESSTORE.CA and OAKLEYSUNGLASSESHEAP.CA in bad faith, as defined in the Policy.

43. The Complainant has provided some evidence that the Registrant has no legitimate interest, as defined in the Policy, in the domain names OAKLEYSUNGLASSESFORSALE.CA, OAKLEYSUNGLASSESSTORE.CA and OAKLEYSUNGLASSESHEAP.CA. The Registrant has not established, as set out in the Policy, that it does have a legitimate interest.

44. For these reasons, the Complaint regarding the domain names:

OAKLEYSUNGLASSESFORSALE.CA,
OAKLEYSUNGLASSESSTORE.CA and
OAKLEYSUNGLASSESHEAP.CA

is successful.

L. Remedy

44. The Complainant has asked that the domain names at issue be transferred to it. The Panel hereby so orders.

A handwritten signature in blue ink, appearing to read "David Lametti", with a long horizontal flourish extending to the right.

David Lametti
Sole Panelist

July 9, 2013