

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

CASE NO.: DCA-1385-CIRA
DISPUTED DOMAIN NAME: *mobillubeexpress.ca*
COMPLAINANT: Exxon Mobil Corporation
REGISTRANT: Wally Akhras
REGISTRAR: Tucows.com
SERVICE PROVIDER: British Columbia International Commercial Arbitration Centre
PANEL: James E. Redmond (Chair);
Elizabeth Cuddihy;
David Wotherspoon

DECISION

The Parties

1. The Complainant is Exxon Mobil Corporation of 5959 Las Colinas Boulevard, Irving, Texas 75039-2298, USA, represented in this proceeding by Janet M. Fuhrer, Timothy C. Bourne and Jaimie Bordman of the law firm of Rideout & Maybee LLP of 100 Murray Street, 4th Floor, Ottawa, Ontario K1N 0A1. The Registrant is Wally Akhras, of 1003-550 Webb Dr., Mississauga, Ontario, L5B 3Y4.

Procedural History

2. This is an administrative proceeding pursuant to the CIRA Domain Name Dispute Resolution Policy (the "Policy") and the CIRA Domain Name Dispute Resolution Rules (the "Rules"). By registration of the domain name with the Registrar, the Registrant agreed to the resolution of certain disputes pursuant to the Policy and Rules.
3. The Service Provider advises as follows:
 - (a) The Complaint was filed by the Complainant on April 2, 2012;

- (b) The Complaint was reviewed and found to be compliant and on April 4, 2012 the Service Provider so advised the Complainant and the Registrant and forwarded a copy of the Complaint to the Registrant;
 - (c) The Registrant requested an extension for delivery of his Response to May 14, 2012 and the extension was granted as permitted by Rule 5.4;
 - (d) The Registrant delivered a Response on May 14, 2012. The Response was determined not to be in administrative compliance with the Policy and Rules, and the Registrant was given 10 days to correct all instances of non-compliance;
 - (e) The Registrant's Response, as revised, was received on May 25, 2012, was reviewed by the Service Provider and delivered to the Complainant;
 - (f) In accordance with paragraph 6 of the Rules, a three-person Panel was appointed, consisting of James Redmond, as Chair, Elizabeth Cuddihy and David Wotherspoon.
4. The Panel finds that all technical requirements for the commencement and maintenance of this proceeding were met and that the Panel was properly constituted and appointed in accordance with the Policy and the Rules. Absent exceptional circumstances, the Panel was required to deliver its decision no later than July 12, 2012.
5. The Service Provider advised the Panel on June 21, 2012 that the Complainant had filed a Reply, purporting to do so in accordance with Rule 11.1. The Service Provider requested the Panel to advise whether the Reply should be forwarded to the Panel.
6. Following consideration, the Panel directed the Service Provider to send copies of the Reply to the Panel and the Registrant, and to advise the Registrant that the Panel directed that if the he wished to make any submission as to whether the Reply met the requirements under Rule 11.1 for the making of a further submission by the Complainant, he was required to do so not later than 5:00 o'clock p.m. on June 29, 2012.

7. The Registrant then requested that the time for making any further submission respecting compliance of the Reply with the provisions of Rule 11.1 be extended, and the Panel extended the time to July 3, 2012 at 5:00 o'clock p.m. EDT.
8. The Registrant sent a Response to the Complainant's Reply to the members of the Panel, to counsel for the Complainant and to the Service Provider on July 3, 2012, in which he submits that the Reply contains evidence that is new and not relevant to the Registrant's response. The document goes on to make submissions in response to the points made in the Reply on the question of legitimate interest.
9. The Panel has reviewed the Reply and the Registrant's submission in response. The Panel concludes that the Reply was properly filed. The Complainant's evidence shows that the Registrant's identity is not published in the public WHOIS database, and the submissions in the Reply relate to the issue of the Registrant's legitimate interest (or lack thereof) in the Disputed Domain Name.

Complainant's Eligibility

10. Under paragraph 1.4 of the Policy, a person is an Eligible Complainant if the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office (the "CIPO"), and the Complainant is the owner of the trade-mark. In this case, the Complaint relates to several trade-marks registered in the CIPO and owned by the Complainant, so the Complainant is an eligible Complainant.

The Complaint

11. The Complaint alleges that:
 - (a) The Disputed Domain Name, *mobilllubexpress.ca* is confusingly similar to Marks in which the Complainant had Rights prior to the registration of the domain name and in which the Complainant continues to have such Rights;
 - (b) The Registrant registered the domain name in bad faith;
 - (c) The Registrant has no legitimate interest in the domain name.

12. Under paragraph 3.1 of the Policy the filing of the Complaint making these assertions requires that the Registrant submit to a Proceeding in accordance with the Policy.

Background

13. The Disputed Domain Name was registered on October 18, 2006. In support of its Complaint with respect to the registration of the Disputed Domain Name, the Complainant has filed as evidence two Affidavits. One, sworn by Lawrence Kearns, described the development, use and registration by the Complainant of the Marks upon which the complaint is based. The second, sworn by Vince Tieri describes circumstances relating to a Participation Agreement under which the Registrant was permitted to use graphics and signs depicting trade-marks owned by the Complainant, the subsequent termination of the Participation Agreement and the aftermath thereof. The Registrant filed a Response including assertions regarding the facts, although not in sworn affidavit form, and attaching a number of documents including numerous emails relating, inter alia, to the Participation Agreement and its termination.

Discussion and Findings

(a) Confusing Similarity between the Disputed Domain Name and the Complainant's Marks

14. In his Affidavit, Mr. Kearns deposes that the trade-mark **MOBIL** is derived from the trade-marks **MOBILGAS** and **MOBILOIL** used, as early as 1899. By 1934, the trade-mark **MOBIL** was used in both Canada and the United States in association with numerous petroleum products and related services, including lubricating oils. Mr. Kearns further states that the trade-mark **MOBIL 1** was adopted in 1974 in association with a new line of synthetic engine lubricant products, and that Mobil Corporation and its successors, including Exxon Mobil, either themselves or through licensees, have sold **MOBIL 1** engine lubricants in over 76 countries around the world, including Canada, to numerous kinds of end consumers including individuals, automotive service centres and automobile manufacturers.

15. The Kearns Affidavit further deposes that in 2003, Exxon Mobil began offering lubricating services for automobiles in association with the trade-mark **MOBIL 1 LUBE EXPRESS** Design in the United States and offered these services in Canada in association with that trade-mark as early as August 24, 2007. In both Canada and the United States, these services were offered by independent operators of Quick Lube facilities under license from Exxon Mobil or one of its licensed distributors.
16. Mr. Kearns includes in his Affidavit a listing of the Canadian registered trade-marks owned by Exxon Mobil as successor to Mobil Corporation. A copy of the list is attached as Appendix A to this Decision.
17. He also attaches as exhibits copies of CIPO records showing the trade-marks currently registered in the name of the Owner and the dates of their registration. Each of these constitutes a “Mark” under paragraph 3.2 of the Policy.
18. The **MOBIL** Mark was first registered in 1936, and the **MOBIL1** Marks in 1976.
19. Paragraph 3.3 of the Policy provides that:

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.
20. The Disputed Domain Name, *mobillubexpress.ca* incorporates each of the **MOBIL** and **MOBIL 1** Marks, or in the case of the Marks involving a design, the text portions, and adds “lube”, “express”, and “.ca”. There are a number of CIRA cases in which Panels have held that the inclusion of further words, letters or symbols in the disputed domain name along with the trade-mark in issue will not prevent the disputed domain name from being found to be confusingly similar. See for example: *Citrixonline llc v. Media Vision Network Inc.*, CIRA Decision 175 (2011); *The Exite Group Inc. v. Zucker International Marketing Inc.*, CIRA Decision No. 176 (2011); *Enterprise-Rent-A-Car Company v. David Bedford*, CIRA Decision No. 0097 (2008); *Oakley, Inc. v. Zhou Yayang* CIRA Decision No. 188 (2012). The terms “lube” and “express” in the Disputed Domain Name

can reasonably be said to be descriptive of the character and quality of the wares and services to which the Complainant's Marks relate.

21. The Panel concludes that, given the prominence, wide-spread use and advertising of the Complainants **MOBIL** and **MOBIL 1** Marks, the inclusion in the Disputed Domain Name of the words "lube" and "express" does not prevent the disputed domain name from being found to be confusingly similar to the Complainants' Marks.
22. As provided in paragraph 1.2 of the policy, the inclusion of the "-ca" suffix does not prevent the disputed domain name from being found to be confusingly similar to the Complainant's Marks.
23. The Complainant also bases its Complaint on its **Mobil 1 Lube Express** Mark. This Mark was registered as number TMA 782,910 on November 19, 2010. However, Mr. Kearns deposes in his Affidavit that Exxon Mobil began advertising lubricating services for automobiles in association with the trade-mark **Mobil 1 Lube Express** Design as early as May, 2003 and has done so continuously since that date. He states that such services were advertised using a variety of media, including print advertising, radio advertising and television advertising, and that such advertisements had been distributed widely in the United States and Canada. He provides several exhibits relating to the extent of such advertising. He asserts that the Complainant has offered and sold lubricating services for automobiles in association with the **Mobil 1 Lube Express** Mark in the United States since at least since 2003, and in Canada since at least 2007.
24. As set out in out in paragraph 3.1 of the Policy, the Complainant must establish that it had Rights in the Mark prior to the date of registration of the Disputed Domain Name and continues to have such rights. The evidence respecting the **MOBIL** and **Mobil 1** Marks clearly establishes that the Complainant and its predecessors had Rights in these Marks prior to the date of registration of the Disputed Domain Name and continue to have such rights.
25. However, the **Mobil 1 Lube Express** Mark, and two revised versions of the **MOBIL 1** Design, were registered after the Disputed Domain Name was registered in November,

2006. With respect to these Marks, the Complainant submits that the fact that the current version of the Policy (version 1.3) no longer contains a definition of “Rights” demonstrates the intention to preclude a restrictive interpretation as to what constitutes Rights in a Mark. It submits that a broad interpretation of this concept should be adopted and that the terms “Rights” is intended to include “common law” rights in addition to rights based upon registration at the CIPO. The Complainant cites in this regard the decision in *The Exite Group Inc. v. Zucker International Marketing Inc.*, CIRA Decision 176 (2011) at para. 46.

26. The Kearns Affidavit deposes that the **MOBIL** and **MOBIL 1** Marks have been used in Canada for many years and have been extensively advertised. The **Mobil 1 Lube Express** Mark has been advertised in a variety of media since May, 2003, which includes materials circulated to the fast change oil industry in Canada between 2004 and 2006.
27. The Panel concludes that the Complainant has Rights in its trade-marks as detailed above, both on the basis of registration of the Marks at the CIPO, and with regard to the use of the **Mobil 1 Lube Express** Mark prior to the date of registration of the Disputed Domain Name. The Complainant continues to have such Rights.
28. In the result, the Panel finds that the Complainant has shown that the Disputed Domain Name is Confusingly Similar to Marks in which the Complainant had Rights prior to the date of registration of the Disputed Domain Name and continues to have such Rights.

(b) Registration of the Domain Name in Bad Faith

29. The Complainant asserts that the registration and use by the Registrant of the Disputed Domain Name constitutes bad faith under paragraphs 3.5(d) and 3.5 of the current version of the Policy, version 1.3, which read as follows:

3.5 Registration in Bad Faith. 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:

...

(d) The Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website, or another 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.

30. The Complainant submits that while subparagraphs (a), (b) and (c) of paragraph 3.5 refer to the conduct of the Registrant at the time of registration of the domain name, subparagraph (d) does not restrict the Panel to consideration of the Registrant's conduct only at the time of registration but that the Registrant's conduct after registration of the domain name may also be taken into account. The Complainant cites *Exite Group, Inc. v. Zucker International Marketing Inc.*, CIRA Decision 176 (2011), where the Panel stated in paragraph 74:

If the Registrant has engaged in the behaviour referenced in subparagraph (d), then pursuant to paragraph 3.5 of the Policy this "shall be evidence that a registrant has registered a domain name in bad faith", even if that behaviour occurs subsequent to the actual domain name registration.

31. The Complainant further quotes from paragraph 76 of that decision where the Panel stated:

... subparagraph (d) therefore explicitly permits consideration of the Registrant's conduct after the disputed domain name has been registered as a means to determine if the Registrant has *registered* the disputed domain name in bad faith. (emphasis in the original)

32. The Complainant asserts that after registering the domain name, the Registrant entered into a Participation Agreement permitting him to use graphics and signs depicting at least some of the **MOBIL** and **MOBIL 1** trade-marks and the **Mobil 1 Lube Express** Mark. After the Participation Agreement had been terminated on the grounds of violation of certain of its terms, the Registrant continued to operate the website to which the domain name *mobil1lubexpress.ca* resolved, at which website the Complainant's trade-marks continued to be prominently displayed in association with lubricants and quick lube services without authorization. The Complainant's evidence further also shows that upon being requested to cease use of the Complainant's trade-marks and to transfer the

Disputed Domain Name to the Complainant, the Registrant responded by requesting that the Complainant purchase it, at one point suggesting a price of \$1,000,000.

33. The Complainant submits that the Registrant intentionally attempted to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with the Complainant's Marks as to the source, sponsorship, affiliation and endorsement of the Registrant's website, products and services as set out in paragraph 3.5(d) of the Policy, the likelihood of confusion arising from the suggestion on the Registrant's website that the operator of the website continues to offer services sponsored and/or endorsed by the Complainant and products sourced from the Complainant, and that the Registrant's website and/or physical location are affiliated with the Complainant.
34. The Panel agrees that these facts respecting the Registrant's conduct indicate bad faith conduct on the Registrant's part.
35. The Panel further notes that, according to the Affidavit of Vince Tieri, the Registrant, Mr. Akhras, contacted Imperial Oil, the Licensee of the Complainant in July, 2006, regarding the possibility of participating in the **Mobil 1 Lube Express** program. Negotiations continued until November 2006, when a representative of NOCO Lubricants, a sub-licensee of the Complainant, was asked to continue the negotiations. The Participation Agreement was entered into on March 8, 2007, between NOCO Lubricants and Mr. Akhras, permitting Mr. Akhras to participate in the **Mobil 1 Lube Express** program. The Participation Agreement gave Mr. Akhras only limited rights to the use of the Complainant's Marks. It did not authorize him to use the Marks in a domain name. The fact that Mr. Akhras registered the Disputed Domain Name and used it months before he had even the limited rights to the use of the Marks given to him under the Participation Agreement undermines the credibility of Mr. Akhras' assertion that he was given any such authority. The Panel considers that Mr. Akhras' use of the Complainant's Marks in a domain name registered months before he had reached any agreement permitting him to use the Complainant's Marks constitutes further evidence of bad faith conduct.

36. The Complainant points out that the language of paragraph 3.5 of the Policy was amended in version 3.1 to provide that the list of circumstances under which registration in bad faith will be found is *inclusive* rather than *exclusive*, and cites the following passage from *Glen Raven Inc. v. Tomislav Kotarac*, CIRA Decision 173 (2011) where the Panel said:

... This introductory language means that the four expressly specified circumstances of Bad Faith inform a Panel not only of these specific instances, but also by inference of the general nature of the Bad Faith impugned by the Policy. A panel has an obligation to consider whether there is Bad Faith of this general nature though the facts may not fall strictly within the language of the four expressly specified circumstances.

In this connection, the Complainant notes that the evidence in the Kearns Affidavit shows that the **Mobil 1 Lube Express** Mark was made known in Canada in 2004, and that the **MOBIL1** Marks and the **MOBIL** Marks were registered, used and well known in Canada prior to the registration of the domain name. Mr. Akhras' expression of interest in the program in July, 2006 raises the reasonable inference that he was aware of the **MOBIL**, **MOBIL1** and **Mobil 1 Lube Express** Marks when he registered the Disputed Domain Name in November 2006.

37. The Complainant further argues that the conduct of the Registrant after registration of the Domain Name may be taken into account in determining whether it was registered in bad faith and cites *UVA Solar GmbH & Co. K.G. v. Mads Kraigh*, WIPO Case No. D2001-0373, at para. 6.6.7. The Complainant submits that the Registrant's conduct in continuing to use the Disputed Domain Name after termination of the Participation Agreement is a further indication of registration in bad faith.
38. The Panel finds that the Registrant registered the domain name *mobillubexpress.ca* in bad faith within the meaning of the Policy and that its continued registration also constitutes bad faith within the meaning of the Policy.

(c) Legitimate Interest

39. Paragraph 3.4 of the Policy lists six sets of circumstances which, in particular but without limitation, shall demonstrate that the Registrant has a legitimate interest in a domain

name. Paragraph 4.1 of the Policy sets out the onus of proof a Complainant must meet in order to succeed in the complaint. While the onus with respect to confusing similarity and to registration in bad faith is proof on a balance of probabilities, with regard to the issue of legitimate interest, the Complainant must provide only “some evidence” that the Registrant has no legitimate interest in the domain name.

40. Clearly, none of the circumstances described in subparagraphs 3.4 (c), (d), (e) and (h) apply in this case. However, it is necessary to consider whether subparagraph (a) or (b) applies. These subparagraphs read:

3.4 Legitimate Interests. 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, performances of the services or operation of the business; or (iii) the place of origin of the wares, services or business; ...

41. With regard to paragraph 3.4(a) the Panel has already concluded that the Registrant registered the Disputed Domain Name in bad faith. Further, the evidence submitted by the Complainant shows that by notice on January 26, 2009, the Participation Agreement was terminated, so that to the extent that the Agreement provided certain specified rights to the Registrant to use the Complainant’s Marks, those rights came to an end when the Agreement was terminated.
42. In his Response and in his further submission responding to the Complainant’s Reply, the Registrant makes reference to attempts to enter into a direct relationship with Imperial Oil to participate in the express lube program, which were unsuccessful. He also refers to a verbal agreement with “Chalmers Fuel” which, he states, “expressed their pleasure to

supply the Registrants' when re-opened the business". However he provides no particulars as to what rights Chalmers Fuel allegedly has respecting use of the Complainant's Marks, or as to the terms of the "verbal agreement". The Registrant has failed to meet the onus on him to prove the existence of any agreement giving him the right to use in any fashion any of the Complainant's Marks after the cancellation of the Participation Agreement.

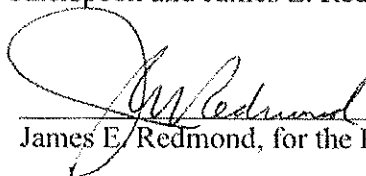
43. The Panel finds that the evidence before it fails to demonstrate that the Registrant has a legitimate interest in the Disputed Domain Name. As the Panel has found, the Registrant did not register or use the Disputed Domain Name in good faith, and he did not, either at the time of registration of the Disputed Domain Name nor after the termination of the Participation Agreement, have any right to use the Complainant's Marks. Accordingly, there is sufficient evidence to establish that the Registrant has no legitimate interest in the Disputed Domain Name.

Decision and Order


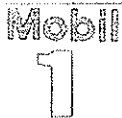
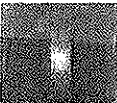




44. The Panel finds, for the reasons given above, that the Complaint is successful, and it is ordered and directed that the registration of disputed domain name be transferred to the Complainant.

Dated this 9th day of July, 2012.

Elizabeth Cuddihy, David Wotherspoon and James E. Redmond (Chair)


James E. Redmond, for the Panel

Appendix A

Trade-Mark	Registration Number	Wares and Services
Mobil  Lube Express	TMA782,910	Lubricating services for automobiles
MOBIL 1	TMA228,832	Synthesized engine lubricant
 <p>(colour claimed as a feature of the mark)</p>	TMA230,291	Synthesized engine lubricant
 <p>Mobil </p>	TMA811,364	Synthetic motor oils
 <p>Mobil </p> <p>(colour claimed as a feature of the mark)</p>	TMA811,355	Synthetic motor oils
MOBIL	UCA7308	Lubricating oils and greases
	TMA337,229	Automatic transmission fluid; brake fluid; circulating oil, engine oil, greases, lubricating oil, machinery oil, metal processing oil, motor oil, top cylinder lubricant; travel maps, travel guides.