

**CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

DECISION

Domain Name: oakleysunglassessale.ca

Complainant: Oakley, Inc.

Registrant: Corrine Vortsman

Registrar: Hexonet Services Inc.

Service Provider: British Columbia International Commercial Arbitration Centre

Panelist: Eric Macramalla

A. THE PARTIES

1. The Complainant is Oakley, Inc. (the “Complainant”), a Washington State corporation.
2. The Registrant is Corrine Vortsman (the “Registrant”) located in Thornhill, Ontario.

B. DISPUTED DOMAIN NAME & REGISTRAR

3. The disputed domain name is oakleysunglassessale.ca (the “Domain Name”).

C. PROCEDURAL HISTORY

4. This is a dispute resolution proceeding initiated pursuant to the *CIRA Domain Name Dispute Resolution Policy* (the “Policy”) and the *CIRA Policies, Rules, and Procedures - CIRA Domain Name Dispute Resolution Rules* (the “Rules”). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of this dispute pursuant to the Policy and the Rules.
5. The Complainant filed its complaint (the “Complaint”) on March 8, 2012. The Date of Commencement of the proceeding was March 14, 2012.
6. The Registrant was provided 20 days to respond to the Complaint. The Registrant did not file a response.
7. In light of the Registrant’s failure to file a response, the Complainant elected to convert the Panel from three members to a single member.
8. On April 9, 2012, the Panel was appointed. As prescribed by the Policy, the Panel has declared to the Provider that it can act impartially and independently in connection with this matter, and that there are no circumstances known to the Panel which would prevent it from so acting.

D. BASIS FOR DECIDING THE COMPLAINT

9. Since the Registrant has not submitted a response to the Complaint, the Panel shall decide the Proceeding on the basis of the Complaint. Notwithstanding the absence of a response, the proceedings shall be decided on the merits of the case.

E. CANADIAN PRESENCE REQUIREMENTS: ELIGIBILITY OF THE COMPLAINANT

10. The Complainant is the owner of multiple Canadian trade-mark registrations comprised of the element OAKLEY. The Panel is therefore satisfied that the Complainant is eligible to initiate these proceedings.

F. THE POSITIONS OF THE PARTIES

The Complainant's Position

11. The Complainant is a sport and lifestyle brand that manufacturers and distributes high performance sunglasses, prescription lenses and frames, goggles, apparel, footwear and accessories. Since at least 1976, the Complainant has sold many of these products under the OAKLEY brand, and since at least 1979 has sold its OAKLEY branded goods in Canada.
12. The Complainant is the owner of the following Canadian trade-mark registrations: OAKLEY, OAKLEY Design, OAKLEY Design, and O OAKLEY Design, Registration Nos. TMA290,235, TMA397,188, TMA512,668 and TMA559,948 ("OAKLEY Trade-marks").
13. Oakley spends millions of dollars each year in association with the promotion of OAKLEY branded products.
14. The Registrant hyperlinked the Domain Name to discount-oakleysunglasses-sale.ca, which promotes the sale of OAKLEY sunglasses and accessories. The OAKLEY trade-marks are prominently displayed throughout the website. End users may purchase said wares through the website.
15. The Complainant's rights in the OAKLEY Trade-marks precede the Domain Name registration date of July 14, 2011.
16. The Domain Name is confusingly similar with the OAKLEY Trade-marks and the non-distinctive terms "sunglasses" and "sale" only enhance confusion.
17. The Registrant does not have a legitimate interest in the Domain Name. The Registrant has not been authorized to use the OAKLEY Trade-marks in any manner whatsoever, including as a domain name. The Complainant alleges, based upon information and belief, the products sold through the Registrant's website are counterfeit.
18. The Registrant registered the Domain Name in bad faith in that it registered the Domain Name primarily for the purpose of disrupting the business of the

Complainant, a competitor. Further, the Registrant registered the Domain Name to intentionally attempt 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, or endorsement.

19. The Complainant is seeking the transfer of the Domain Name.

G. DISCUSSION & REASONS

20. In accordance with paragraph 4.1 of the Policy, to succeed in this proceeding, the Complainant must prove, on a balance of probabilities, that:

- (a) the Registrant's 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 of the Policy;

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 of the Policy.

CONFUSINGLY SIMILAR - PARAGRAPH 3.3

21. In order to satisfy this branch of the test, the Complainant must demonstrate (i) that it has rights in a mark, (ii) that the rights in its mark predate the registration date of the Domain Name, and (iii) that the Domain Name is confusingly similar with the disputed domain name.

Rights in the Marks & Rights that Predate the Domain Name Registration Dates

22. Where the Complainant relies upon a trade-mark registered prior to the domain name registration date, the Policy does not require or permit a Panel to go behind the registration to determine whether the mark is valid or invalid based upon lack of distinctiveness or non-use. In cases where a trade-mark registration matured to registration after the domain name registration date, or the Complainant is relying on common law rights, it must establish rights that predate the domain name registration.
23. The Complainant's trade-mark registrations for OAKLEY issued to registration prior to the 2011 registration date of the Domain Name. Therefore, the Panel concludes that the Complainant has established rights that precede the registration of the Domain Name.

Confusingly Similar

24. As per paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if the domain name so nearly resembles the mark in appearance, sound or in the ideas suggested by the mark so as to be likely to be mistaken for the mark.
25. Pursuant to paragraph 1.2 of the Policy, a domain name is defined as the second level domain (the portion that immediately precedes the dot-ca suffix).
26. The test to be applied when considering “confusingly similar” is one of first impression and imperfect recollection. The Complainant must prove, on a balance of probabilities, that a person, as a matter of first impression, knowing the Complainant’s corresponding marks only, and having an imperfect recollection of the marks, would likely confuse the Domain Name for the Complainant’s marks based upon the appearance, sound or the ideas suggested by the mark.
27. It should be noted that the test for confusion under the Policy is not the same test for confusion set out under the Canadian *Trade-marks Act*. Under the Section 6(5) of the *Trade-mark Act*, when assessing the likelihood of confusion between marks, the factors to consider are as follows: (a) the inherent distinctiveness of the marks and the extent to which they have become known; (b) the length of time the marks have been in use; (c) the nature of the wares, services, or businesses; (d) the nature of the trade; (e) the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them; and (f) the surrounding circumstances.
28. In contrast, the Policy provides that confusion is established if a domain name so nearly resembles a mark in appearance, sound or in the ideas suggested. This is similar to the test set out under Section 6(5)(e) of the *Trade-marks Act*. However, the remaining factors as set out under the *Trade-marks Act* do not apply to the assessment of confusion under the Policy. The Policy’s summary proceedings are ill-suited for the in-depth and traditional confusion analysis contemplated by the *Trade-marks Act*.
29. The Domain Name contains the well known OAKLEY trade-mark, which is the subject of a number of Canadian trade-mark registrations. This by itself is sufficient to establish confusion. The addition of the terms “sunglasses” and “sale” only serve to enhance confusion as end users are likely to be of the view that the Domain Name resolves to a website operated by, or otherwise affiliated with, the Complainant.
30. The Panel concludes that the Domain Name is confusingly similar with the Complainant’s OAKLEY Trade-marks, given that the Domain Name so nearly resembles the OAKLEY Trade-marks in appearance, sound and in the ideas suggested so as to be likely to be mistaken for these marks.

Conclusion - Confusion

31. The Panel finds that the Domain Name is confusingly similar with the OAKLEY Trade-marks in which the Complainant had rights prior to the registration date of the Domain Name, and continues to have such rights.

BAD FAITH REGISTRATION

Paragraph 3.5(c) – Disrupt A Competitor

32. The Complainant has alleged that the Domain Name was registered in bad faith pursuant to paragraph 3.5(c) of the Policy, namely that the Registrant registered the Domain Name 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.
33. Accordingly, the Complainant must establish (i) that the Registrant and the Complainant are competitors, and (ii) that the Registrant's use of the Domain Name is disrupting the Complainant.
34. The Domain Name has been made to hyperlink to discount-oakleysunglasses-sale.ca. The website prominently features the OAKLEY trade-marks and promotes the sale of OAKLEY glasses and accessories. The overall commercial impression created by the website is that the Registrant is an authorized dealer of the Complainant.
35. In light of the misuse of the Domain Name, the Registrant has positioned itself as a competitor of the Complainant, as the website competes with the Complainant and its network of authorized dealers. Further, the use of the Domain Name, which is likely to mislead and confuse potential consumers as to source or sponsorship, is likely to disrupt the Complainant and its dealer network.
36. Accordingly, the Panel concludes that the Complainant has established bad faith as per paragraph 3.5(c).

Paragraph 3.5(d) – Intentionally Diverting Traffic for Commercial Gain

37. The Complainant has alleged that the Domain Name was registered in bad faith pursuant to paragraph 3.5(d) of the Policy, namely that the Registrant registered the Domain Name to intentionally attempt 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, or endorsement.
38. The Domain Name contains the whole of the OAKLEY trade-mark. Further, the Domain Name suggests a connection to the Complainant. Under the circumstances, the Panel is of the view that the Domain Name is likely to confuse potential consumers into believing that the Registrant is somehow affiliated with, or endorsed by, the Complainant.

39. Further, the Domain Name is being used in association with a website that is promoting the sale of OAKLEY sunglasses and accessories. This use of the Domain Name has put the Registrant in a position to reap a commercial or financial benefit.
40. In light of the foregoing, the Panel finds that the Complainant has established bad faith as per paragraph 3.5(d).

LEGITIMATE INTEREST

41. The final element to determine is whether the Registrant has a legitimate interest in the Domain Name.
42. As per paragraph 4.1 of the Policy, the Complainant must provide “some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.6”.
43. Once this onus has been discharged by the Complainant, the Registrant may still succeed if it can show, on a balance of probabilities, that it has a legitimate interest in the Domain Name pursuant to paragraph 3.4.
44. The Panel finds that the Complainant has provided sufficient evidence that the Registrant does not have a legitimate interest in the Domain Name. The Complainant did not authorize the registration and the website is likely to mislead the public into believing that the Registrant is affiliated with, or endorsed by, the Complainant. The Panel, however, is not prepared to make a determination as to whether the goods are counterfeit.
45. As the Registrant has not replied to the Complaint, it has not established, on a balance of probabilities, that it has a legitimate interest in the Domain Name.
46. Accordingly, the Panel finds that the Registrant does not have a legitimate interest in the Domain Name.

DECISION & ORDER

47. For the reasons set out herein, the Panel decides this dispute in favour of the Complainant.
48. Pursuant to paragraph 4.3 of the Policy, the Panel orders the transfer of the domain name oakleysunglassessale.ca.

Dated at Ottawa, Ontario, Canada, this 30th day of April, 2012.



Eric Macramalla
Sole Panelist