

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number: DCA-1612-CIRA
Domain Name: <www.optrex.ca>
Complainant: Optrex Limited.
Registrant: Nameshield Inc.
Panel: James E. Redmond, Q.C. (Chair), David Wotherspoon, Harold Margles
Service Provider: British Columbia International Commercial Arbitration Centre (BCICAC)

DECISION

A. THE PARTIES

1. The Complainant is Optrex Limited (the "Complainant."). The Complainant, a subsidiary of Reckitt Benckiser plc, is a manufacturer and retailer of eye care products sold in association with the trademark OPTREX. The Complainant's principal office is located at 1 Thane Road West, Nottingham, England, United Kingdom NG2 3AA. The Complainant is represented by Timothy Stevenson of Smart & Biggar in Ontario, Canada.
2. The Registrant is Nameshield, Inc., a Canadian company based in Prince Edward Island. The contact person for Nameshield, Inc. is Daniel Mullen, who is also the sole director of Nameshield. Mr. Mullen filed the response to the Complaint on behalf of the Registrant.

B. THE DOMAIN NAME AND REGISTRAR

3. The Domain Name in issue is <optrex.ca> (the "Domain").
4. The Domain was registered on October 23, 2012.
5. The Registrar of the Domain is rapidregister.ca.

C. PROCEDURAL HISTORY

6. On October 3, 2014, the Complainant submitted a complaint (the "Complaint") to The British Columbia International Commercial Arbitration Centre ("BCICAC") as service provider pursuant to paragraph 1.5 of the Canadian Internet Registration Authority ("CIRA") Domain Name Dispute Resolution Policy v. 1.3 (the "Policy").
7. The BCICAC reviewed the Complaint and found it to be in administrative compliance with the requirements under Rule 42 of the CIRA Domain Name Dispute Resolution Rules (the "Rules"). By letter and email dated October 6, 2014, the BCICAC so advised the parties and forwarded a copy of the Complaint to the Registrant. The letter dated

October 6, 2014 included typographical errors in the name and email address of counsel for the Complainant which were pointed out by the Registrant. The BCICAC corrected the typographical errors immediately and provided a corrected version to the panel.

8. The Registrant submitted a response (the "Response") to the BCICAC on October 27, 2014. The BCICAC reviewed the Response and determined that the Response was not in administrative compliance with paragraph 5.2(d) of the Rules. The BCICAC notified the Registrant of the non-compliance and advised that the Registrant had 10 days to remedy such. The Registrant delivered a Response on November 10, 2014, which the BCICAC reviewed and found to be in compliance.
9. The Complainant seeks, as a remedy, that the Domain be transferred to the Complainant.

D. PANELIST IMPARTIALITY AND INDEPENDENCE

10. By letter dated November 26, 2014, the BCICAC selected James Redmond, Q.C., FCI Arb., Harold Margles, and David Wotherspoon as panelists. James Redmond, Q.C., FCI Arb. was selected as Chair of this panel.
11. As required by paragraph 7.2 of the Rules, the panelists have each submitted to the service provider an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality in relation to this dispute. Accordingly, this panel concludes it has been constituted in compliance with the Rules.

E. COMPLAINANT'S SUBMISSIONS

12. The Complainant's evidence is that it is the owner of the Canadian registered trade-mark OPTREX (the "Mark"), which was registered as number UCA9890 on December 16, 1937 in association with "Produit destine au soin des yeux" (English translation: "eye care products"). The Complainant has used the Mark in Canada since January 1, 1932. The Registrant has challenged the eligibility of the Complainant to bring the Complaint.
13. The Complainant is a part of Reckitt Benckiser, a global manufacturer and supplier of household, healthcare and personal care products. Since 1932, the Complainant has sold eye care products in Canada in association with the Mark. The evidence shows that the Complainant's eye care products are available at drug stores, pharmacies, the drug store and pharmacy sections of grocery stores and department stores across Canada. Further, the evidence shows that Reckitt Benckiser owns and operates a website at the domain name <www.optrex.co.uk>, registered on March 19, 1997, which promotes the Complainant's eye care products in association with the Mark. In each year since 2006, the Complainant has sold in excess of \$500,000 of OPTREX brand products in Canada.
14. The Registrant registered the Domain on October 23, 2012.
15. There is evidence that until at least September 25, 2014, the website available at the Domain was a "pay-per-click" website with an aggregation of hyperlinks to various other websites related to eye washes, eye drops, and LCD displays. There is evidence that those hyperlinks resolved to other websites unaffiliated with the Registrant.

16. The Complainant asserts that the Domain is identical to the Complainant's trade-mark and thus is, on a balance of probabilities, confusingly similar to the Mark.
17. The Complainant submits that it had rights to and used the Mark prior to the registration of the Domain, and continues to have such rights.
18. The Complainant further asserts that the Registrant has no legitimate interest in the Domain as described in paragraph 3.4 of the Policy. The Complainant asserts that the Registrant and its sole director have been the subject of numerous CDRP and UDRP complaints in which they have been found to have registered a domain name in bad faith. In particular, the Complainant asserts that the Registrant does not meet any of the enumerated grounds pursuant to which a Registrant may establish a legitimate interest in the Domain, as follows:
 - (a) The Registrant has no Rights in the trade-mark OPTREX, and does not hold any valid trade-mark registrations for the mark OPTREX. Further, the Registrant has not used the Mark in good faith or at all, as the website available at the Domain resolved to a pay-per-click website;
 - (b) The Domain does not resolve to a website where the Registrant is offering goods or services in association with the Mark, and the Domain name is neither descriptive or generic in any sense;
 - (c) There is no evidence that the Domain is being used for non-commercial activity;
 - (d) The evidence does not indicate that the Domain name is a legal name of the Registrant, or is a name, surname or other reference by which the Registrant is commonly identified; and,
 - (e) The Domain name is not a geographical name.
19. The Complainant finally asserts that the Registrant registered the Domain in bad faith as defined in paragraphs 3.5(b) and (d) of the Policy. In particular, the Complainant asserts that the Registrant 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. According to a CIRA Response to Request for Domain Name Information, the Registrant, along with the sole director of the Registrant, collectively hold 4,664 dot-ca domain names, of which a large number are identical to, or confusingly similar to, trade-marks in use prior to the registration date of the domain.
20. The Complainant seeks that the Domain be transferred from the Registrant to the Complainant.

F. REGISTRANT'S RESPONSE

21. The Registrant asserts that the Complaint is invalid on the basis that the Complainant has not complied with the Rules. Specifically, the majority of the Registrant's response consisted of a series of arguments questioning the identity of the Complainant, going so

far as to suggest that the Complainant is a third party with no standing to bring a Complaint. In support of this, the Registrant made a series of arguments, including but not limited to:

- (a) The Complainant failed to comply with the Rules as it did not provide any actual contact information for the Complainant;
- (b) That the notification document supplied by the service provider contained errors in the name and email address for counsel for the Complainant, and consequently it may be inferred that the service provider may not have a comprehensive understanding of the Rules;
- (c) That Internet searches conducted by the Registrant suggest that the Complainant's address in the CIPO record does not correspond to the Complainant's address in the UK Companies House registration, which also lists the Complainant as a non-trading company;
- (d) That the CIRA does not permit representatives to stand in for parties acting as the Registrant for the purposes of voting in elections for CIRA positions;
- (e) That the Complainant did not provide a telephone number and email address for someone attached to the Complainant, and consequently the Complainant must not have any employees, officers, or directors;
- (f) That the Complainant has not brought evidence that it is the exact entity shown at CIPO; and,
- (g) That the Complainant did not transfer its rights in the Mark, if it had any, to Reckitt Benckiser.

- 22. The Registrant did not make any submissions as to whether the Domain is confusingly similar to the Mark.
- 23. Mr. Mullen, on behalf of the Registrant, asserts that he relied upon the public record in registering the Domain, and that he had cleared the name for use in LCD computer display panels. The Registrant further asserts that subsequently, Optrex Corporation was purchased by Kyocera, and "the request to establish the mark was shelved". There is no documentary evidence to show that the Registrant was affiliated with Optrex Corporation or with Kyocera. Further, there is no documentary evidence that any application was made for the trade-mark OPTREX in association with LCD computer display panels.
- 24. The Registrant asserts that the Domain resolves to a website showing a complete listing of all Optrex display products, priced in Canadian funds. The Registrant further asserts that any user of the website can determine the specifications and suitability of purpose for each display model. There is documentary evidence from the Registrant dated November 10, 2014 that the Domain resolves to a website for Mouser Electronics with links to view Optrex/Kyocera products, including displays, engineering tools, and engineering

development tools. No evidence was submitted to indicate whether the site is comprised of more than a single page, or to list any products or wares for sale.

25. The Registrant further asserts that the total value of display panel products sold in Canada under Optrex is "many times the value of that alleged to be from the Complainant or the third party which appears to have truly brought the Complaint". There is no documentary evidence to show the value of display panel products sold in Canada under Optrex.
26. The Registrant did not provide any explanation in response to the evidence that the Registrant and its sole director hold 4,664 domain name registrations, some of which appear to be trade-marks owned by other entities. Further, Mr. Mullen on behalf of the Registrant did not make any submissions regarding previous CDRP and UDRP complaints against himself and the Registrant.

G. DISCUSSION AND FINDINGS

Validity of the Complaint

27. As detailed above, the Registrant made a series of arguments calling into question the validity of the Complaint.
28. The Registrant's submissions in respect of the Complainant's corporate addresses, corporate structure as an entity of Reckitt Benckiser, and the CIRA election rules have no bearing on the validity of the Complaint.
29. In accordance with paragraph 4.1 of the Rules, the service provider reviewed the Complaint for administrative compliance with the Policy and the Rules, and found the Complaint was in administrative compliance. Further, the notification document supplied by the service provider contained typographical errors in the name and email address for counsel for the Complainant. Upon notification, the typographical errors were immediately corrected, and the panel rejects the Registrant's submission that such typographical errors give rise to the inference that the service provider does not have a comprehensive understanding of the Rules.
30. Further, in accordance with paragraph 1.9 of the Policy, the Complainant has represented, warranted and certified to CIRA and the Registrant that the Complaint relates to a trade-mark registered in CIPO and that the Complainant is the owner of the trade-mark. The panel notes that CIPO approved the registration of the Mark and the renewals thereof. It is not the role of the panel in this dispute to question how the Complainant structures its corporate affairs, or to look behind CIPO's trade-mark registration process.
31. This panel is satisfied that Complaint is in administrative compliance and not in breach of the Rules or Policy, and that the Complainant is the owner of the registered trade-mark OPTREX. Accordingly, at the time the Complaint was submitted, the Complainant satisfied the Canadian Presence Requirements and is an eligible Complainant within the meaning of clause 1.4 of the Policy.

Basis for Complaint

32. According to paragraph 4.1 of the Policy, the Complainant must prove on a balance of probabilities that:

(a) The Registrant's dot-ca Domain is confusingly similar to a Mark in which the Complainant has Rights prior to the date of the registration of the domain name, and continues to have such Rights;

(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 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 as described in paragraph 3.4

33. The Policy is based on the principle that, without more, the first party to register a domain has priority over the domain. A complainant does not have automatic rights to a domain name simply because it registered a trade-mark earlier than a registrant registered a domain name. A complainant must establish its rights to the domain name.

Confusingly similar

34. At paragraph 3.2 of the Policy, a "Mark" is defined:

3.2 Mark. A "Mark" is:

...

(c) a trade-mark, including the word elements of a design mark, that is registered in CIPO;

35. Given the evidence presented by the Complainant, the Panel finds that it has established that OPTREX is a "Mark" under the definition in paragraph 3.2(c) of the Policy.

36. For the purpose of determining whether a domain name is confusingly similar to a mark, paragraph 1.2 of the Policy indicates that the "dot-ca" suffix of the domain name should not be considered. Absent the "dot-ca" suffix, the Complainant's trade-mark and the Domain are identical.

37. Paragraph 3.3 of the Policy provides that 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.
38. The Domain “optrex” is identical to the Complainant’s trade-mark “OPTREX” in appearance and sound and is confusingly similar thereto within the requirements of the Policy.
39. The Registrant did not dispute that the Domain is confusingly similar to the OPTREX trade-mark other than to say that users would not confuse eye lotion for LCD products. This distinction is not a relevant factor under paragraph 3.3 of the Policy. This is not a defence to the definition of confusingly similar under the Policy.
40. The Complainant’s registration of its trade-mark on December 16, 1937 pre-dates the registration date of the Domain on October 23, 2012.
41. The Panel therefore finds that the Complainant has met its burden under paragraph 3.1(a) that the Registrant’s Domain is confusingly similar to a Mark in which the Complainant had rights prior to the date of registration of the Domain.

Bad faith

42. Paragraph 3.5 of the current Policy now provides that the Registrant has registered a domain name in bad faith if any of the following circumstances, in particular but without limitation, are found by the Panel:
 - (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.

43. The Complainant relies first on paragraph 3.5(b), and asserts that the Registrant 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. As few as two domain name registrations is sufficient to establish that a Registrant has engaged in a pattern of registering domain names in bad faith: *Canadian Broadcasting Corporation v. William Quon*, CDRP Dispute No. 00006; *Volvo Trademark Holding AB v. Cup International Limited*, WIPO Case No. D2000-0338.
44. There is evidence that the Registrant and/or its sole director, Mr. Mullen, have been the subject of numerous CDRP and UDRP cases, in which Nameshield Inc. and/or Mr. Mullen have been found to have registered a domain name in bad faith, including but not limited to: *American Express Marketing and Development Corp v. Nameshield Inc c/o Daniel Mullen* (CDRP Dispute No. 249), *Cointreau v. Netnic Corporation* (CDRP Dispute No. 180), *Burberry Limited v. Daniel Mullen c.o.b.a. Virgin Enterprises Limited* (CDRP Dispute No. 114), *Westinghouse Electric Corporation v. Daniel Mullen* (CDRP Dispute No. 83), *Vector Aerospace Corporation v. Daniel Mullen* (WIPO Case No. D2002-0878), and *American Online Inc. v. Daniel Mullen dba MSN and MSN Networks* (WIPO Case No. D2000-1605).
45. Further, there is evidence that the Registrant and/or its sole director, Mr. Mullen, are currently the registrants for 4,664 dot-ca domain names. The Complainant asserts that a large number of these domain names are identical to, or confusingly similar to, trademarks in use prior to the registration of the domain name. Some of the domain names held by the Registrant include, but are not limited to, *dolceandgabbana.ca*, *majorleaguesoccer.ca*, *make-a-wish.ca*, and *thenewyorktimes.ca*, for which the Complainant has provided documentary evidence of trade-mark registrations held by other entities.
46. The Panel finds that, on a balance of probabilities, the Complainant has established that the Registrant has engaged in a pattern of registering domain names identical to, or confusingly similar to, trade-marks owned by other entities and in use prior to the registration of the domain name. The Registrant did not provide any response or explanation in respect of its conduct and failed to rebut the evidence presented by the Complainant.
47. The Complainant also relies on paragraph 3.5(d) of the Policy, and asserts that the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Domain by creating a likelihood of confusion with the Complainant's Mark. The Complainant relies on *American Express Marketing and Development Corp v. Nameshield Inc c/o Daniel Mullen* (CDRP Dispute No 249), which was a complaint against the same Registrant as this case, where the panel held:

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.

48. The observations of the panel in *American Express Marketing and Development Corp* are applicable to this Complaint. While the Domain no longer resolves to a pay-per-click website, the documentary evidence shows that the website associated with the Domain only changed after the submission of the Complaint, and that the Domain previously resolved to a pay-per-click website. Further, the evidence shows that the pay-per-click website that was parked at the Domain aggregated hyperlinks to an assortment of eyecare products, including those manufactured and sold by the Complainant and by its competitors.
49. Accordingly, the Panel finds that the Complainant has established, on a balance of probabilities, that the Registrant has registered the Domain in bad faith as described in paragraphs 3.5(b) and (d).

Legitimate interest

50. Paragraph 3.4 of the Policy lists 6 non-exclusive criteria upon which the Panel may find that the Registrant has a legitimate interest in the Domain:
 - (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.

51. The Panel finds that under paragraph 3.4(a), the Registrant has not used the Mark in good faith and the Registrant had no Rights in the Mark. There is no documentary evidence to show that the Registrant owns any Rights in the Mark. Further, as this panel has already found that, on a balance of probabilities, the Registrant registered the Domain in bad faith, the corollary is that the Registrant has not registered or used the Mark in good faith.
52. The Registrant has asserted that it registered the Domain in association with the provision of LCD goods. While the Registrant has provided evidence that the Domain currently resolves to a website for Mouser Electronics that offers Optrex/Kyocera LCD goods for sale, this appears to only have occurred following the submission of the Complaint to the service provider. There is evidence that prior to the filing of the Complaint, the Domain resolved to a pay-per-click website. Further, the Registrant did not provide any explanation or evidence to indicate what association, if any, the Registrant has with Mouser Electronics or Optrex/Kyocera, and whether the Registrant itself offers LCD goods for sale. Accordingly, the panel is of the opinion that under Paragraphs 3.4(b) and (c), the Registrant did not register the Domain in good faith in association with any wares, services or business of which the Domain was clearly descriptive or of which the Domain was the generic name thereof.
53. The panel finds that paragraph 3.4(d) of the Policy does not apply as the Domain is being used either for a commercial pay-per-click service or in association with LCD goods.
54. The panel finds that under paragraph 3.4(e), the Domain name is clearly not the Registrant's legal name, or a name, surname or other reference by which the Registrant is commonly identified.
55. The panel finds that under paragraph 3.4(f), the Domain is not the geographical name of the location of the Registrant's place of business.
56. In the result, the Panel finds that the Registrant does not have a legitimate interest in the Domain.

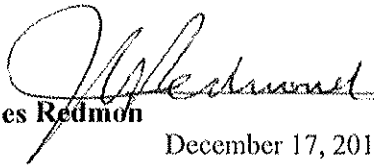
H. CONCLUSION AND DECISION

57. The Panel has found that the Complainant has met the burden under paragraph 4.1 of the Policy, and has demonstrated on a balance of probabilities that:
 - (a) The Domain registered by the Registrant is confusingly similar to the trade-mark in which the Complainant has rights;
 - (b) The Registrant has no legitimate interests in respect of the Domain; and
 - (c) The Registrant registered the Domain in bad faith.

58. Accordingly, pursuant to paragraph 4.3 of the Policy, the Panel orders that the registration of the domain name

optrex.ca

be transferred forthwith to the Complainant by the Registrar, rapidregister.ca.
d, Q.c., FCI Arb. (Chair)


James Redmon
December 17, 2014