

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

CASE NO.: DCA-1377-CIRA
DISPUTED DOMAIN NAME: www.discount-oakleysunglasses-sale.ca
COMPLAINANT: Oakley, Inc.
REGISTRANT: Zhou yayang
REGISTRAR: GoDaddy.com, Inc.
SERVICE PROVIDER: British Columbia International Commercial Arbitration Centre
PANEL: James E. Redmond

DECISION

The Parties

1. The Complainant is Oakley, Inc. (“Oakley”) of One Icon, Foothill Ranch CA 92610, represented in this proceeding by Randall J. Clement Esq. of the law firm of Clement & Ho, 1440 N. Harbor Blvd., Suite 900, Fullerton, CA 92835. The Registrant is Zhou yayang, Renhlu 731hao, Zhang Shushi, BC., T2Y 3M9.

Procedural History

2. This 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 March 8, 2012;

- (b) The Complaint was reviewed and found to be compliant and on March 14, 2012 the Service Provider so advised the Complainant and the Registrant and forwarded a copy of the Complaint to the Registrant;
 - (c) No response has been received from the Registrant;
 - (d) In the absence of a Response from the Registrant, the Complainant has elected to convert from a Panel of three to a single arbitrator;
 - (e) On April 10, 2012, the Service Provider appointed James E. Redmond as sole arbitrator;
 - (f) The Arbitrator delivered to the Service Provider the required Statement of Impartiality and Independence pursuant to the Rules.
4. Based upon the information provided by the Service Provider, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding were met. The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Rules.
5. Absent exceptional circumstances, the Panel was required to deliver its decision no later than May 1, 2012.

Factual Background

6. The Complainant Oakley manufactures and distributes high-performance sunglasses, prescription lenses and frames, goggles, apparel, footwear and accessories. Since at least 1976, Oakley has sold many of these products under the trademark OAKLEY and since at least 1979 has sold many of these products under the OAKLEY trademark in Canada.
7. Oakley is the owner of the OAKLEY trade name and trademark. It uses numerous logos that employ the OAKLEY trademark, and many marks that incorporate the OAKLEY trademark or are associated with it.
8. The Complainant owns various trademark registrations in over 100 countries, including the United States, for the OAKLEY mark, either in block letters or a stylized pattern.

The Complainant is the owner of the following trademark registrations: TMA290235 OAKLEY, Reg. Date 04/27/1984; TMA397188 Oakley Design, Reg. Date 04/17/1992; TMA512668, Oakley (Stretched) Design, 07/06/199; TMA559948, Oakley Design, Reg. Date 04/04/2002.

9. The Complainant states that Oakley spends millions of dollars each year to advertise and promote OAKLEY branded products throughout the world through a variety of media, including television, radio, print advertisements, and the Internet, as a result of which the OAKLEY trademark has developed extensive goodwill in the market and is extremely valuable to Oakley. Oakley expends substantial effort and expense to protect the OAKLEY trademark and its distinctiveness in the market place. The Complainant further states that it owns and has registered dozens of domain names that include or are associated with its OAKLEY mark including what it describes as its “flagship principal” website *oakley.com*.
10. The Disputed Domain Name, *discount-oakleysunglasses-sale.ca* was registered by the Registrant on December 27, 2011, well after the Complainant established its rights in its OAKLEY mark.

The Complaint

11. In its Complaint the Complainant contends that:
 - (a) The Disputed Domain Name is identical or confusingly similar to the OAKLEY mark, in which the Complainant had Rights prior to the registration of the Disputed Domain Name and in which the Complainant continues to have such Rights;
 - (b) The Registrant registered the Disputed Domain Name in bad faith;
 - (c) The Registrant has no legitimate interest in the Disputed Domain Name.
12. The Registrant has not provided a Response to the Complaint.

Discussion and Findings

(a) Jurisdiction

13. The Complainant is the owner in Canada of the trademark and design marks registered at the Canadian Intellectual Property Office as set out in paragraph 8 above and therefore is an Eligible Complainant under paragraph 1.4 of the Policy.

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

14. The Complainant Oakley is the owner of a trade-mark and of design marks consisting of the word OAKLEY, that are registered in the CIPO, which constitute "Marks" pursuant to paragraph 3.2 of the Policy.

15. 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.

16. Under paragraph 1.2 of the Policy it is provided that for the purposes of the Policy, "Domain Name" means the domain name excluding the ".-ca" suffix and the suffixes associated with all third and fourth level domain names accepted for registration by CIRA. Therefore, in determining whether the Disputed Domain Name is confusingly similar with the Complainant's Marks, the ".ca" suffix is excluded. The Complainant's Mark, "Oakley", is included in the Disputed Domain Name and the issue is whether the inclusion of other elements in the Disputed Domain Name, "discount", "sunglasses" and "sale", along with separating hyphens, prevents it from being found to be confusingly similar to the Complainant's Marks.

17. There are numerous CIRA and WIPO cases which 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. For example, in *Enterprise-Rent-A-Car Company v. David Bedford*, CRIA Decision No. 0097, March 27, 2008, para. 46, the domain names

“*enterpriseautorental.ca*” and “*enterprisetoronto.ca*” (and 10 similar domain names) were found to be confusingly similar to the Complainant’s trademark “ENTERPRISE”. The Panel held that the use of the Complainant’s well-known Mark was likely to confuse or mislead the public to believe that the domain names were somehow affiliated with or owned by the Complainant. Similar conclusions were reached by panels in *Seiko Epson Corporation v. Zokool Technologies, Inc.*, CIRA Case No. 1137 (*epsoninc.ca*; *epsoncartridge.ca*; *epsoninkjet.ca*); *Google Inc. v. 4 Fenix Group Ltd.*, WIPO Case No. D2011-0790, June 23, 2011 (“*googlemontenegro.com*”, “*google-montenegro.com*”; *Staples, Inc. and The Business Depot Ltd. v. Erik Maddeaux*, CIRA Decision No. DCA-1082-CIRA, (domain names “*staplesonlinerebate.ca*, and *staplesonlinerebates.ca*; *General Motors Acceptance Corporation v. Bob Woods*, CIRA Case No. 00051 (“*gmacmortgages.ca*”). These and numerous other cases have held that where the whole of a Complainant’s Mark is incorporated into the domain name, the addition of descriptive or non-distinctive terms in the domain name would not prevent the finding of “confusing similarity”.

18. By incorporating the whole of the Complainant’s well-known and widely used and publicized mark, the Disputed Domain Name is likely to lead persons visiting the website to believe that it is associated with the Complainant. The additional phrases “discount”, “sunglasses” and “sale” do not distinguish the Disputed Domain Name from the OAKLEY Mark, and the inclusion of the word “sunglasses” adds to the likelihood of confusion since the manufacture and sale of sunglasses is a major part of the Complainant’s business.
19. The likelihood of confusion is made obvious by the screenshots of the Respondent’s website, exhibited in the Complaint, which use the name OAKLEY in advertising numerous varieties of sunglasses for sale.
20. The Panel finds that the Complainant has satisfied the onus of establishing that the disputed website is confusingly similar to the Complainant’s Marks.

(c) **Legitimate Interest**

21. The Complainant asserts that the Respondent has no legitimate interest in the domain name. Paragraph 3.4 of the Policy lists six sets of circumstances which, if found by the Panel to be proved based on the Panel's evaluation of all evidence presented shall demonstrate that the Respondent has a legitimate interest in the domain name. None of the circumstances listed exist in this case, based on the facts put before the Panel.
22. Under paragraph 4.1 of the Policy the Complainant must provide some evidence that the Respondent has no legitimate interest in the domain name as described in paragraph 3.4. In its submissions on the question of legitimate interest, the Complainant states that it has no relationship or association with the Respondent, and that the Respondent is not an authorized retailer of Oakley-branded products. The Complainant further states that the Respondent did not register the domain name with the consent or approval of Oakley and that the Respondent has not been licensed or otherwise permitted to use any of the Oakley trademarks, and that Oakley has not authorized the use of its trademark within the domain name at issue or the website to which it resolves. The Complainant says that it has not authorized the use of the OAKLEY trademark in connection with the sale of any of the goods available at such websites. It asserts that the Respondent uses the domain name for commercial gain and not for any legitimate non-commercial or fair use of the domain name. It submits that the Disputed Domain Name is intended "to divert unsuspecting Oakley consumers to the unauthorized website".
23. The Complainant cites *Oakley, Inc. v. Wu Bingjie (USOakleyshop.com)* WIPO Case No. D2010-0093 (March 10, 2010), where it was found, in circumstances similar to the facts of this case, that the Complainant had made a *prima facie* case that the Respondent had no legitimate interest in the domain name, that the domain name was used for commercial gain and not for any legitimate non-commercial or fair use, and that it was used for the purpose of selling goods in a way which disrupted the business of the Complainant.

24. The Panel concludes that the Complainant has met the requirement of paragraph 4.1 of the Policy that it provide “some evidence” that the Registrant has no legitimate interest in the domain name.

(d) Registration in Bad Faith

25. The Complainant asserts that the registration and use by the Respondent of the Disputed Domain Name **discount-oakleysunglasses-sale.ca** constitutes bad faith under the provisions which are now found in paragraph 3.5(c) and (d) of the Policy, 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:

...

(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.

26. With regard to Complainant’s assertion that the Respondent registered the domain name primarily for the purpose of disrupting the business of the Complainant, the evidence submitted by the Complainant shows that the Respondent is a competitor of the Registrant in the business of selling sunglasses.
27. In *Great Pacific Industries Inc. v. Ghablib Dhalla*, CIRA Case No. 00009, the Panel found that the disputed domain name was likely to lead internet users who were customers or would-be customers of the Complainant to be confused into believing that the domain name would connect them to a website of the Complainant and that this

would disrupt the business of the Complainant in that it would interrupt the flow of customers to the Complainant.

28. In *Sitter City Incorporated v. Mile Mocilac*, CRIA Decision No. DCA 00169, the Panel said, at p. 8:

Furthermore, “disruption” for the purpose of Policy subparagraph 3.7(c) occurs when internet users encountering a domain name are misled into believing that a registrant’s business associated with the domain name is a business of the complainant, or at least endorsed, sponsored or approved by the complainant.

29. It is clear from the evidence in this case that the requirement in paragraph 3.5(c), that the Registrant of the Disputed Domain Name be a competitor of the Complainant, is met by the fact that the domain name is used by the Registrant to direct visitors to the Respondent’s website offering sunglasses for sale.
30. The facts before the Panel also bring the case within the provisions of paragraph 3.5(d) of the Policy, that is that the Respondent has “intentionally attempted to attract, for commercial gain, Internet users to the Registrant’s website ... 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.” Attracted to the Respondent’s website by the use in the domain name of the OAKLEY trademark, a visitor is likely to be confused and misled as to the source, sponsorship, affiliation or endorsement of the Registrant’s website and the products offered for sale on the website. (The Complainant alleges, on an “information and belief” basis that the products offered for sale on that website under the OAKLEY name are counterfeit).
31. The Complainant has cited the case of *Oakley, Inc. v. Kate Elsberry, et al*, WIPO Case No. D2009-1286 (November 18, 2009) (*Oakleyvenezuela.com*), where the Panel found bad faith registration and use of the Disputed Domain Name. After pointing out that OAKLEY-branded products were sold only to authorized retailers, that the Respondent was not an authorized retailer, but was nevertheless offering those products on its website, the Panel went on to say:

[Bad faith] is rather evident in the Respondent having actually used the disputed domain name in conjunction with its website through which it offered the Complainants OAKLEY-branded products for sale, even though the Respondent knew it was not authorized by the Complainant to do so and had no legitimate relationship whatsoever with the Complainant. Obviously, the Respondent did so to divert sales from the Complainant and disrupt the Complainant's business and, by so doing, monetarily benefit from that exploitation to the detriment of the Complainant and the Complainant's authorized retailers.

32. The Panel concludes that the Registrant has proven, on a balance of probabilities, that the Registrant registered the Dispute Domain Name in bad faith, within the wording of paragraphs 3.5(c) and 3.5(d) of the Policy.

Decision and Order

33. The Panel finds, for the reasons given above, that the Complaint is successful, and it is ordered and directed that the registration of the Disputed Domain Name be transferred to the Complainant.

James E. Redmond, Sole Panelist

DATED April ____, 2012