

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

Dispute Number: DCA-2012-CIRA

Domain Names: <wd40.ca> and <wd-40.ca>

Complainant: WD-40 Manufacturing Company.

Registrant: Interex Corporate Registration Services Inc.

Registrar: dot-ca-registry.ca (Burmec Business Systems Ltd), admin@ dot-ca-registry. ca

Panel: The Honourable Neil Anthony Brown QC

Service Provider: British Columbia International Commercial Arbitration Centre

**DECISION**

**OVERVIEW**

1. This matter concerns a dispute between the Complainant and the Registrant regarding the registration and use of the domain names <wd40.ca> and <wd-40.ca> (“the disputed domain names”).
2. The British Columbia International Commercial Arbitration Centre (“BCICAC”) is a recognized service provider to the CIRA Domain Name Dispute Resolution Policy (“the Policy”) of the Canadian Internet Registration Authority (“CIRA”).
3. This is a proceeding under the CIRA Domain Name Dispute Resolution Policy (the “Policy”), in accordance with the CIRA Dispute Resolution Rules (the “Rules”).
4. The Complainant claims that the Registrant registered the disputed domain names in breach of the Policy. The Registrant has not filed a Response in this proceeding.

**THE PARTIES**

1. The Complainant in this proceeding is WD-40 Manufacturing Company, 9715 Businesspark Avenue, San Diego, CA 92131, (“the Complainant”) and its Authorised Representative in this proceeding is CSC Digital Brand Services AB Drottninggatan 92-94, 111 36 Stockholm, Sweden.
2. The Registrant in this proceeding is Interex Corporate Registration Services Inc , 582 Beale Avenue Kimberly, BC V1A 2A7, Canada (“the Registrant”).

**REGISTRATION OF THE DISPUTED DOMAIN NAMES**

1. The disputed domain names <wd40.ca> and <wd-40.ca> were registered by the Registrant in the case of the domain name <wd40.ca> on July 23, 2009 and in the case of the domain name <wd-40.ca> on March 30, 2011.
2. The Registrar of the disputed domain names is dot-ca-registry.ca (Burmec Business Systems Ltd), admin@ dot-ca-registry. ca.

## PROCEDURAL HISTORY

According to the information provided by the BCICAC:

- (a) The Complainant filed a Complaint with respect to the disputed domain names in accordance with the Policy on August 24, 2018.
- (b) The Complaint was reviewed and found to be administratively compliant. By letter dated August 27, 2018, the BCICAC as service provider confirmed administrative compliance of the Complaint and, as Notice in accordance with Rules 2.1 and 4.3, forwarded a copy of the Complaint to the Registrant together with its Schedules, by email on August 27, 2018, as the Complaint with attachments had been filed exclusively by email. By the same communication the BCICAC informed the parties that in accordance with Rule 4.4 the date of commencement of the Proceeding was August 27, 2018, and that any Response had to be filed by September 17, 2018.
- (c) On September 17, 2018 the Centre received an email from the Registrant with a blank Response Transmittal Coversheet. The Registrant did not file a Response in this proceeding with the BCICAC by September 17, 2018 or at all.
- (d) The Centre received an email dated September 17, 2018 from counsel for the Complainant advising that both parties agreed to a 20 days extension for filing a Registrant's Response. Therefore, the Registrant had until October 9, 2018 to file its Response. The Registrant did not provide its Response by October 9, 2018 or at all.
- (e) As permitted, given the absence of a Response, the Complainant elected to convert from a three-person tribunal to a single arbitrator.
- (f) On October 12, 2018, BCICAC appointed The Honourable Neil Anthony Brown QC as sole arbitrator in this proceeding. The sole arbitrator has signed and forwarded to the BCICAC an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.
- (g) The Panel has reviewed all of the material submitted by the Complainant and is satisfied on that material that the Complainant is an eligible Complainant under the Policy and the Rules by virtue of its ownership of the trademark registrations referred to hereafter.

## FACTS

The facts set out below are taken from the Complaint, together with related exhibits.

The Complainant is a United States company with its headquarters in San Diego, California. It was founded in 1953, but since then it has greatly expanded its activities internationally. Its principal product from its early days was WD40, the well-known lubricant, but it has vastly expanded its range of industrial products as the company has expanded. As a result, its name and brand have achieved an international prominence in its field.

The Complainant has a substantial internet presence through its domain names <wd40.com> and <wd-40.com> and their websites that are used in the Complainant's business.

To establish CIRA's Canadian presence requirements, the Complainant relies on the fact that it is the owner of a trademark which is the subject of registration in Canada under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13, namely Canadian Trademark Registration No. TMA127488 registered August 3, 1962.

The Complainant has been selling its products in Canada at least since 1970, which is well before Respondent's registration of the disputed domain names, in 2009 and 2011.

It has come to the notice of the Complainant that the Registrant has registered two domain names in Canada that directly reflect the famous trademarks of the Complainant, its own domain names and its well established name and brand. The Complainant has never given the Registrant permission or authority to use its trademark or name in a domain name or in any other way. The Registrant has allowed or caused the domain names to resolve to the websites of third parties, again without any permission whatsoever. Thus it can be seen that the websites found by redirection of the disputed domain names promote an invitation to join Facebook and the offer of quick money by an undertaking involving Bitcoin.

The Complainant has tried to stop the Registrant's conduct and to have the disputed domain names transferred to the Complainant but to no avail. Nor has the Registrant filed a Response.

The Complainant is particularly concerned that the conduct of the Registrant will induce internet users to believe that the Registrant's business, domain names, website and general conduct are associated in some way with the third parties whose goods and services are being promoted illegally by the Registrant under the Complainant's name and trademark. It is also concerned that the Registrant's conduct will damage the Complainant's goodwill and reputation.

It therefore seeks to have the disputed domain names transferred to the Complainant to protect its good name.

## **CONTENTIONS OF THE PARTIES**

### **A. THE COMPLAINANT**

The Complainant submits as follows: ·

#### **1. CANADIAN PRESENCE REQUIREMENTS**

The Complainant submits that it satisfies the Canadian presence requirement of paragraph 1.4 the Policy in view of the fact that it is the owner of a trademark which is the subject of registration in Canada under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13, namely Canadian Trademark Registration No. TMA127488, registered August 3, 1962.

#### **2. THE REGISTRATION OF THE DISPUTED DOMAIN NAMES**

1. The disputed domain names <wd40.ca> and <wd-40.ca> were registered by the Registrant in the case of the domain name <wd40.ca> on July 23, 2009 and in the case of the domain name <wd-40.ca> on March 30, 2011.
2. The Registrar of the disputed domain names is dot-ca-registry.ca (Burmac Business Systems Ltd), admin@ dot-ca-registry. ca.

#### **3. THE GROUNDS ON WHICH THE COMPLAINT IS MADE**

Basis for the Complaint.

##### **Confusingly Similar**

The Complainant is the owner of a trademark which is the subject of registration in Canada under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13, namely Canadian Trademark Registration No. TMA127488.

The Complainant is the owner of the Canadian WD-40 trademark and has had rights in the WD-40 trademark prior to the date on which the disputed domain names were registered. Respondent registered the disputed domain name <wd40.ca> on July 23, 2009 and the disputed domain name <wd-40.ca> on March 30, 2011, which are significantly after Complainant filed for registration of its WD-40 trademark in Canada in 1962. In determining whether the disputed domain names are confusingly similar with Complainant's trademark, the ".ca" suffix should be excluded. The disputed domain names include, in its entirety, Complainant's WD-40 trademark.

The inclusion of the entire trademark in issue in the disputed domain names will not prevent the disputed domain names from being found to be confusingly similar, even taking account of the fact that the <wd40.ca> domain name omits the hyphen in Complainant's WD-40 trademark.

Further, by incorporating the whole of Complainant's WD-40 trademark in the domain names, there is a considerable risk that the public will perceive them associated with, or connected with the Complainant, which they are not.

By using the entire WD-40 trademark in the disputed domain names, the Registrant also exploits the goodwill and the image of the trademark, which may result in dilution and other damage.

Accordingly, the disputed domain names are identical or confusingly similar to Complainant's WD-40 trademark.

Also, Complainant has established its rights to the WD-40 trademark prior to the date of registration of the disputed domain names, and continues to have rights in this trademark. Therefore, Complainant satisfies the onus placed on it by clause (a) of Paragraph 4.1 of the Policy.

#### **No Legitimate Interest**

The Registrant does not have any legitimate interest in the disputed domain names within the meaning of section 3.4 of the Policy.

Registration of a domain name does not give the owner rights or a legitimate interest in respect of the domain names.

The Complainant has not found anything that would suggest that the Registrant has been using WD-40 mark in any way that would provide legitimate rights in the domain names. Complainant has not found that Registrant has any registered trademark corresponding to the disputed domain names.

Complainant has not provided the Registrant with any authorization to register the disputed domain names.

Registrant is not using the name WD-40 as a company name as authorized by the Complainant or has no other legal rights in the name. Complainant submits that it is the fame of the Complainants' trademark and business that has motivated the Registrant to register the disputed domain names.

It is inconceivable that the Registrant would use the WD-40 trademark without being aware of the Complainants' rights to it.

The Registrant uses the disputed domain names to redirect Internet users to various third-party websites. As such, the Registrant is neither using the disputed domain names to provide a *bona fide* offering of goods or services, nor a legitimate non-commercial or fair use as allowed under the Policy.

Numerous past Panels have confirmed that such use does not bestow legitimate rights or interests upon a respondent.

Past Panels have also determined that use of a disputed domain name to redirect internet users to content unrelated to a complainant even if the registrant does not derive commercial benefit from such use, "does not automatically render the use of the disputed domain name legitimate."

Use of a domain name that incorporates Complainant's trademark to redirect Internet user to a third party's website "cannot be only incidental or accident, but rather indicates a general intent to profit from the goodwill and the confusion created by the identical nature of the disputed domain name".

For the reasons set out above, the Complainant submits that the Registrant has no rights or legitimate interest in the disputed domain names.

### **Bad Faith**

Complainant and its WD-40 trademark are known internationally, with trademark registrations across numerous countries. The Complainant has marketed and sold its goods and services using this trademark since 1953, selling in Canada at least since 1970, which is well before Registrant's registration of the disputed domain names.

At the time of registration of the disputed domain names, the Registrant knew, or at least should have known, of the existence of the Complainant's trademark and that registration of domain names containing well-known trademarks constitutes bad faith *per se*.

Complainant has also been in business for over four decades and its WD-40 Multi-Use Product has been a market leader in many countries among multi-purpose maintenance products, which demonstrate Complainant's fame.

Searches across a number of internet search engines for "WD40" and "WD-40" return multiple links referencing Complainant and its business.

Numerous past UDRP Panels have held that a registrant should be considered as possessing actual notice and knowledge of a complainant's marks, and thus having registered the domain name in bad faith, where the complainant's mark is well-known and the circumstances support such a finding. That is the case with the Complainant and its trademarks in the present case.

The facts of the case also bring it within the provisions of the Policy prescribing bad faith, as it can be established that Registrant created a likelihood of confusion with Complainant and its trademark by registering confusingly similar domain names, which incorporate Complainant's trademark.

The Registrant thus demonstrated a nefarious intent to capitalize on the fame and goodwill of the Complainant's trademark in order to increase traffic to the disputed domain names' websites for the Registrant's own pecuniary gain.

The Registrant must have been aware of the rights Complainant had in the WD-40 trademark at the time of the disputed domain names' registration. The Registrant's use of the disputed domain names shows its intent to cause confusion among internet users as to the source of the disputed domain names.

Consequently, the Registrant should be considered to have registered the disputed domain names in bad faith, as described in paragraphs 3.5(a) and 4.1(b) of the Policy.

All of the foregoing propositions are supported by previous domain name panel decisions that are cited by the Complainant and on which it relies.

## **B. THE REGISTRANT**

The Registrant did not file a Response to this proceeding.

## **DISCUSSION OF THE ISSUES AND FINDINGS**

### **1. CANADIAN PRESENCE REQUIREMENTS**

Paragraph 1.4 of the Policy provides that a complainant initiating a complaint must satisfy the Canadian Presence Requirements for Registrants in respect of the domain name that is the subject of the proceeding.

Paragraph 2 (q) of the Canadian Presence Requirements for Registrants establishes that requirement in the following circumstance:

“Trade-mark registered in Canada. A Person which does not meet any of the foregoing conditions, but which is the owner of a trade-mark which is the subject of a registration under the *Trade-marks Act* (Canada) R.S.C. 1985, c.T-13 as amended from time to time, but in this case such permission is limited to an application to register a .ca domain name consisting of or including the exact word component of that registered trade-mark;...”

The evidence, which the Panel accepts, is that the Complainant is the owner of a trademark which is the subject of registration under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13, namely Canadian Trademark Registration No. TMA127488 registered August 3, 1962.

The Complainant has therefore satisfied CIRA's Canadian Presence Requirement for Registrants in respect of the disputed domain name and is entitled to initiate the Complaint.

### **2. REGISTRATION OF THE DISPUTED DOMAIN NAMES**

- (a) The disputed domain name <wd40.ca> was registered on July 23, 2009 and the disputed domain name <wd-40.ca> was registered on March 30, 2011.
- (b) The Complainant submits that the Registrant of the domain names is Interex Corporate Registration Services Inc.
- (c) The foregoing matters were established by evidence that the Panel accepts.
- (d) The Panel will therefore proceed with this matter on the basis that the Complainant has made out its standing to file the Complaint and that the Registrant is the proper party against whom the proceeding should be brought.

### **3. GENERAL**

The purpose of the Policy, as stated in paragraph 1.1, is to provide a forum in which cases of bad faith registration of .CA domain names can be dealt with relatively inexpensively and quickly.

In accordance with paragraph 4.1 of the Policy, to succeed in the Proceeding, the Complainant must prove, on the 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 or generally;

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.

The Panel will now deal with each of the three elements.

### **CONFUSINGLY SIMILAR**

As the Complainant correctly submits, it is required to prove that the disputed domain name is confusingly similar to a Mark in which the Complainant had rights prior to the date of registration of the disputed domain names and continues to have such Rights. The Complainant must therefore show that it has rights to a mark, that it had those rights before the domain names were registered, that it still has them and that the disputed domain names are confusingly similar to the mark on which it relies to establish that proposition. The Complainant submits that it can meet those requirements.

#### **The Mark**

The first question that arises is whether the Complainant has a trademark on which it can rely for the purpose of this proceeding.

The Complainant relies on a Canadian trademark in particular which is WD-40 for GOODS: (class 02) Paints, varnishes and lacquers. (CA Reg. No. TMA I27488, Filing Date: February 26, 1962, Registration Date: August 3, 1962) and registered with the Canadian Intellectual Property Office ("CIPO") of Canada.

The Complainant has established that registration and also the registration by the Complainant of other trademarks for WD-40 (hereinafter referred to collectively as "the WD-40 trademarks") by evidence that the Panel accepts.

Copies of the relevant trademark registrations adduced by the Complainant in evidence are annexed to the Complaint as Annex 1.

The Panel also finds that the Complainant adopted the WD-40 trademarks as its trademark in the trade and industry in question from at least March 8, 1962 which was of course well prior to the disputed domain names being registered.

The next question that arises is whether the WD-40 marks are in each case a "mark(s)" in which the Complainant had rights prior to the date of registration of the disputed domain names and continues to have such rights.

Bearing in mind that the Registrant registered the disputed domain name <wd40.ca> on July 23, 2009 and the disputed domain name <wd-40.ca> on March 30, 2011 ("the due dates") the Panel finds that that the Complainant had rights in the WD-40 trademarks from at least March 8, 1962 which was, of course, prior to the due dates.

The Panel also finds that the Complainant continues to have such rights.

The Panel finds that the WD-40 trademarks are marks as defined by Paragraph 3.2 of the Policy and that they come within the meaning of “mark” in Paragraph 3.2 (a), as the unchallenged evidence shows that they are “a trade-mark, including the word elements of a design mark, or a trade name that has been used in Canada by a person, or the person’s predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person;...”

The Panel therefore finds that the WD-40 trademarks are marks in which the Complainant had rights before the disputed domain names were registered and in which it still has rights.

### **Confusingly similar**

Pursuant to paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if it so nearly resembles the same in appearance, sound or in the ideas suggested so as to be likely to be mistaken for the mark. The test to be applied when considering “confusingly similar” is one of first impression and imperfect recollection and the “dot-ca” suffix should be excluded from consideration (see *Coca-Cola Ltd. v. Amos B. Hennan*, BCICAC Case No. 00014).

Having regard to those principles, the Panel finds that the disputed domain names are confusingly similar to the WD-40 trademarks.

The Panel finds that the disputed domain name <wd40.ca> registered on July 23, 2009 and the disputed domain name <wd-40.ca> registered on March 30, 2011 (“the due dates”) are confusingly similar to the WD-40 trademarks because they contain the entirety of the trademark in the domain names, with the exception that in the case of the domain name <wd40.ca> , the hyphen in the trademark has been deleted, a feature which is not taken into consideration in domain name practice. The internet user would naturally conclude that both domain names were virtually identical to the trademark and would see them as confusingly similar to the trademarks for that reason.

Moreover, an internet user would also conclude that the idea suggested by the domain names was that they were official domain names that would lead to a website dealing with the Complainant’s business conducted under the WD-40 trademarks.

Accordingly, the disputed domain names are, for the purposes of the Policy, confusingly similar to the WD-40 trademarks as they so nearly resembles the marks in appearance, sound and in the ideas suggested as to be likely to be mistaken for the WD-40 trademarks within the meaning of Paragraph 3.3 of the Policy.

The Panel therefore concludes that the disputed domain names are confusingly similar to the WD-40 trademarks in which the Complainant had rights prior to the registration date of the disputed domain names and in which it continues to have such rights.

The Complainant has thus made out the first of the three elements that it must prove.

### **NO LEGITIMATE INTEREST IN THE DOMAIN NAMES**

The Complainant submits that the Registrant does not have a right or legitimate interest to either of the disputed domain names within Section 3.4 of the Policy. The Complainant’s case in that regard is as follows.

The Registrant has registered the two domain names, but that does not give the owner any rights or legitimate interest in respect of the domain names.



The Registrant has not been using the WD-40 mark in any way that would provide legitimate rights in the name. It has no registered trademark corresponding to the disputed domain names and was not authorised by the Complainant to register them.

The Registrant is not using the name WD-40 as a company name as authorized by the Complainant or has no other legal rights in the name. Rather, it is the fame of the Complainants' trademark and business that has motivated the Registrant to register the disputed domain names.

Moreover, is inconceivable that the Registrant would use the WD-40 trademark without being aware of the Complainants' rights to it, as it is very prominent as a trademark and has been so for many years.

The Registrant is also wrongly using the domain names to redirect Internet users to various third-party websites. The Panel has examined the evidence submitted to that effect and finds that it makes out the Complainant's submissions. As such, on the evidence, the Registrant is neither using the disputed domain names to provide a *bona fide* offering of goods or services, nor a legitimate non-commercial or fair use as allowed under the Policy.

Numerous past Panels have confirmed that such use does not bestow legitimate rights or interests upon a registrant.

Past Panels have also determined that use of a disputed domain name to redirect internet users to content unrelated to a complainant even if the registrant does not derive commercial benefit from such use, does not make the use of the domain names legitimate.

Redirecting an internet user to a third party's website shows an intention to profit from the goodwill of the Complainant and the confusion created by the identical nature of the disputed domain name with the Complainant's marks and this conduct does not show a legitimate interest, but the opposite.

For the reasons set out above, the Complainant submits that the Registrant has no rights or legitimate interest in the disputed domain names. The Panel agrees with those submissions and finds accordingly that the Registrant had no right to register the domain names and has no legitimate interest in either of them. The Panel also concludes that the decisions cited by the Complainant are cogent examples of the principles involved.

The submissions of the Complainant also accord with the following analysis of this issue that the Panel has had occasion to make in several prior cases when it has constituted the Panel. Under the Policy, the question whether the Registrant has a legitimate interest in a disputed domain name is to be decided in the following framework. First, there must be an assertion that the Registrant has no legitimate interest in the domain name. That criterion has been satisfied because the Complainant has made such an assertion in the Complaint. Secondly, the Complainant must provide some evidence that "... (c) the Registrant has no legitimate interest in the domain name *as described in paragraph 3.4 (emphasis added)*." Each of the sub-paragraphs of paragraph 3.4 describes a situation which, if made out, would give the Registrant a legitimate interest in the domain name. The obligation on the Complainant is therefore to show that the Registrant cannot make out any of the successive tests in the sub-paragraphs of 3.4. Thirdly, the Panel has to decide whether the evidence as a whole shows on the balance of probabilities that the Registrant has a legitimate interest in the domain name. Fourthly, the Registrant is not confined to the criteria set out in that paragraph, for those criteria are "without limitation". In other words, a registrant may try to bring itself within any of the specified criteria, but it may also rely on any other fact or argument it wishes to rely on to show that it has a legitimate interest. If it does do this, the role of the Panel is to decide if the registrant has made out its case and to make that decision on the balance of probabilities. The Registrant, however, has waived that right by not filing a Response.

The first task of the Panel is therefore to see if the Complainant has provided "some evidence" that the Registrant has not brought itself within any of the specific criteria in paragraph 3.4.

Applying that test, the Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the disputed domain names. In particular, the Complainant has shown by the evidence that, as the Complainant submitted and as the Panel agrees:

The Registrant cannot have used the domain names in good faith under section 3.4(a).

The Registrant cannot have used the domain names in good faith under section 3.4(b).

The Registrant cannot have used the domain names in good faith under section 3.4(c).

The Registrant cannot have used the domain names in good faith under section 3.4(d).

Moreover, in each of the criteria mentioned above, the facts as they are known simply cannot be accommodated in any of those provisions.

The Registrant also cannot have used the domain names under section 3.4(e) as it is not the legal name of the Registrant.

The Registrant also cannot have used the domain names under section 3.4(f) as it is not the geographical location of the Registrant as defined.

The Complainant has shown very persuasively that on the available evidence and inferences that can be drawn from it, that the Registrant has no legitimate interest in either of the disputed domain names.

The Panel has also examined each of the circumstances set out in the various sub-paragraphs of paragraph 3.4 of the Policy. It is apparent to the Panel that the Registrant could not conceivably bring itself within any of the circumstances in those sub-paragraphs. In this regard it must be remembered that the Registrant has in effect taken the Complainant's trademark without permission, set itself up as having an interest in the trademark, caused the domain names to resolve to the website of third parties and caused or allowed them to be used in the Registrant's own interest and thereby damaged the Complainant's good name.

These facts have two effects. First, they show that the Complainant has shown some persuasive evidence that the Registrant has no legitimate interest in the domain names, so that the Complainant has met its obligations under this section of the Policy. Accordingly, the Complainant has provided evidence that the Registrant cannot bring itself within any of the specified criteria in paragraph 3.4 that would show a legitimate interest in the domain names and the Panel so finds.

They also show that the Registrant has in fact no such legitimate interest, for such conduct of the Registrant described above could never give rise to a legitimate interest in a domain name. It is illegal and unprincipled in every respect and cannot possibly justify the registration or use of the domain names.

Finally, and underlying all of these considerations is the fact that the Registrant had an unlimited opportunity of presenting its case, but has forfeited that opportunity by not filing a Response and has not tried in any way to show it has a legitimate interest in the domain names.

The Complainant has thus established the second of the three elements that it must prove.

## **REGISTRATION IN BAD FAITH**

The Panel now turns to consider whether the disputed domain names were registered in bad faith. In that regard, the Panel notes that, consistent with the decision in *Canadian Broadcasting Corporation? Societes Radio-*

*Vanada v. William Quon*, CIRA Dispute Number 00006(April 8, 2003), pp.13-14, surrounding circumstances may be considered in assessing whether the disputed domain name has been registered in bad faith.

By clause 3.1 of the Policy, the Complainant is obliged to prove that:

“(c) the Registrant has registered the domain name in bad faith as described in paragraph 3.5.”

### **Section 3.5(a)**

Section 3.5 provides that “(f) or the purposes of paragraphs 3.1(c) ... 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...” and then goes on to provide four such circumstances. The Complainant relies in particular on Section 3(5)(a) which provides:

“(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; ...”.

The Panel finds that the facts of the case bring it within that provision. It is clear that the Registrant was motivated by considerations that were inimical to the interests of the Complainant and to promote the Registrant’s own interests by whatever means available.

The Panel therefore finds that the Registrant has registered the domain names in bad faith by committing a breach of Section 3.5(a).

### **Section 3.5(c)**

The evidence also brings the case within the provisions of Section 3.5 (c), namely that:

“(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;...”

The Registrant made itself a competitor of the Complainant by its conduct in the use of the trademarks and such conduct has been found by previous panels to constitute bad faith. The Registrant was clearly motivated by a desire to use the Complainant’s trademarks for its, the Registrant’s, own interests and that, by definition, must disrupt the Complainant’s own business.

The Panel therefore finds that the Registrant has registered the domain names in bad faith by committing a breach of Section 3.5(c).

### **Section 3.5(d)**

The matter also comes within Section 3.5 (d) which provides that:

“(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.”

Clearly, the Registrant wanted to cause confusion and set about it by causing the domain names to resolve to the websites of third parties in an attempt to give the impression that the Complainant was by some means lending its good name to promoting the goods and services of those third parties. Moreover, if the domain names remain with Registrant, further disruption is probable. That is because the Registrant has taken the Complainant's trademark, used it in its domain names and sought by that means to divert some of the Complainant's business to itself and its illegal business. The confusion created is as to whether the internet user has arrived at the Complainant's site or not and whether the services being offered are those of the Complainant or not.

The Panel therefore finds that the Registrant has registered the domain names in bad faith by committing a breach of Section 3.5(d).

### **Bad Faith in General**

It is to be noted that the criteria for bad faith are not exclusive, but that complainants may rely on circumstances other than those enumerated to show bad faith registration.

Bad faith registration may also be shown by conduct other than the conduct specified in the various criteria mentioned above. This is made clear by Section 3.5 providing as it does, that "(f) or the purposes of paragraphs 3.1(c) ... 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..." (emphasis added). This provision is included, as bad faith conduct may take many forms and it is frequently used to find bad faith registration and (under the Uniform Domain Name Dispute Resolution Policy) bad faith use.

The Panel has examined all of the evidence carefully and has concluded that it shows that the Registrant registered the domain names in circumstances that can fairly be described as bad faith within the generally accepted meaning of that expression. Indeed there is no other interpretation that can be placed on the evidence.

The Panel finds that the intention of the Registrant was to register the domain names because they reflected the Complainant's established trademarks in the lubricant and related industries and to use them for an illegal purpose, namely to further its own interests and for a purpose that would benefit the Registrant financially. That conduct constitutes bad faith registration on any test.

The Complainant has thus made out the third of the three elements that it must establish.

### **CONCLUSION AND DECISION**

The Panel finds that the constituent elements of the Policy have all been made out and that the Complainant is entitled to the relief it seeks. The Panel will therefore order that the disputed domain names be transferred to the Complainant.

### **ORDER**

The Panel directs that the registration of the disputed domain names <wd40.ca> and <wd-40.ca> be transferred from the Registrant to the Complainant WD-40 Manufacturing Company.

Date: October 15, 2018



The Honourable Neil Anthony Brown QC.