

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

**Domain Names:**        **MOBILEMINI.CA**

**Complainant:**        **Mobile Mini, Inc.**  
**Registrant:**         **Arlene Wyenberg**  
**Registrar:**         **National CA Domains Ltd.**

**Panel:**                **David Allsebrook**

**Service Provider:**   **Resolution Canada**

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**DECISION**

**A. The Parties**

1. The Complainant in this proceeding is Mobile Mini, Inc., a Delaware corporation, having its principal office and place of business at 4646 E. Van Buren, Suite 400, Phoenix, Arizona, 85008, USA. Its authorized representative in this dispute is McMillan LLP, Barristers and Solicitors, Suite 4400, 181 Bay Street, Toronto, Ontario M5J 2T3
2. The Registrant is Arlene Wyenberg of British Columbia. Ms Wyenberg's precise address is omitted to preserve her privacy.

**B. The Domain Name and Registrar**

3. The domain name at issue is **MOBILEMINI.CA**.
4. The domain name is registered with **National CA Domains Ltd.**

**C. Basis for this proceeding**

5. This decision relates to a complaint filed pursuant to the CIRA Domain Name Dispute Resolution Policy (hereafter referred to as the Policy). CIRA is the organization which manages registrations in the .ca domain. In addition to its Policy, CIRA has published CIRA Dispute Resolution Rules ((hereafter referred to as the

Rules) which govern the procedures pertaining to the resolution of disputes under the Policy.

#### **D. Panel Member Impartiality and Independence Statement**

6. As required by paragraph 7 of the Rules, the undersigned has declared to the Provider that he can act impartially and independently in this matter, as there are no circumstances known to me that would prevent me from so acting.

#### **E. Canadian Presence Requirement**

7. To quote paragraph 1.4 of the Policy, “the person initiating a Proceeding (the “Complainant”) must, at the time of submitting a complaint (the “Complaint”), satisfy the Canadian Presence Requirements for Registrants (the “CPR”) in respect of the domain name that is the subject of the Proceeding unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office (“CIPO”) and the Complainant is the owner of the trade-mark.” The CPR is also published by CIRA.
8. The Complainant is a corporation located in the state of Missouri in the United States of America. It is the owner of two Canadian trade-mark registrations which consist of or include the mark MOBILE MINI, namely Canadian Reg. No. TMA395588 for the trademark MOBILE MINI Design, and Canadian Reg. No. TMA395184 for the trademark MOBILE MINI STORAGE SYSTEMS Design (collectively referred to herein as the “Registered Marks”).
9. Paragraph 2 of the CPR begins with a list of complainants who meet the CPR, before reaching paragraph 2(q) which says:

“(q) **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;”
10. Paragraph 2(q) contemplates a domain name which consists of the exact word component of the trade mark. In this case the domain name is the same as the word component of the trade mark registration TMA395588 for the MOBILE MINI Design as shown below:

***mobile mini***

11. The Canadian Presence Requirement as stated in paragraph 2(q) of CPR is satisfied.

## **F. Factual Background**

12. In February the Registrant requested from the Provider, and obtained, a 20 day extension of time to file a Response to the Complaint. No Response has reached me so I assume that none was filed in time.

13. The factual basis of the dispute is provided by the Complainant alone.

14. The Complainant has been using its Registered Marks, and its trademark MOBILE MINI (collectively, the “Complainant’s Marks”), in Canada since at least as early as 1990, and has used the Complainant’s Marks in the United States since 1983. The Complainant’s Marks are used in association with metal containers and pre-fabricated buildings for the storage and transportation of goods, and with the rental of metal containers for the storage and transportation of goods.

15. The Registrant’s web site had the domain name MOBILEMINI.CA prominently across the top of the page, making it the largest lettering on the page. There are two landing pages, each with a single photograph on the page, occupying a about a third of the height of the page and two thirds of the width. One shows the back of a person looking into an open self-storage locker tidily occupied with goods and cardboard boxes. In the screen capture shown to me, the other photo is obstructed by a pop up window selling cell phones but appears to show wooden storage crates in a warehouse. Neither photograph has any branding or other means of identifying whose product we are looking at or how we might obtain it, or any other indicia of advertising the items in the photographs. Nothing else on the web pages refers to the content of the photographs. The rest of the writing on the pages consists of links relating to the sale of cell phones and related products and services, and the links followed by the Complainant all go to pages which reflect that purpose. None relate to containers or buildings or storage.

16. The web site was a pay-per-click structure designed to generate traffic to other websites. The Registrant’s web site transformed at some point to become blank at the time the Complaint was filed.

17. The Registrant has a connection to the B.C. company Ontrack Container Sales Ltd., The Registrant’s address, is the same address listed in the BC Company Summary for Ontrack Container Sales Ltd as being the mailing address for Dale Gordon Olsen, who is the president, secretary and director of that company (see Annex 5). The Canadian Trade Index directory also lists Registrant’s address as the address of Ontrack Container Sales Ltd. itself, and lists “pallets and skids” as products offered by the company (see Annex 6). Pallet storage containers are one of the products offered by the Complainant (see Annex 2, particularly pages concerning “Premium Storage Container (10’ wide)”).

18. Mr. Olsen and Ms. Wyenberg recently provided a joint expression of condolences on a funeral home's online guest book (see Annex 7). According to CIRA's response to request for domain names, Ms. Wyenberg is also the registrant in respect of the domain name <ontrackcontainer.ca> (see Annex 8).

### **G. CIRA Domain Name Dispute Resolution Policy Requirements**

19. The Policy sets out at paragraph 4.1 what the Complainant must establish in order to successfully prove the Complaint:

To succeed in the Proceeding, the Complainant must prove, on a 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;

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.

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 . . .

20. I will deal with each criterion in turn.

### **H. Is the Registrant's Domain Name Confusingly Similar to the Complainant's Mark?**

21. To meet the requirement of 4.1(a) to show confusing similarity, each Complainant must show that it has rights in a "Mark" as "Mark" is defined in the Policy. Paragraph 3.2 of the Policy defines "Mark" as follows:

3.2 Mark A "Mark" is:

(a) 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;

- (b) a certification mark, including the word elements of a design mark, that has been used in Canada by a person or the person's predecessor in title, for the purpose of distinguishing wares or services that are of a defined standard;
- (c) a trade-mark, including the word elements of a design mark, that is registered in CIPO; or
- (d) the alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of which the Registrar of Trade-marks has given public notice of adoption and use pursuant to paragraph 9(1)(n) of the Trade-marks Act(Canada).

22. I find that the Complainant has rights in a Mark by reason of its trade mark registration TMA395588 for the MOBILE MINI Design. It alleges that it has used the trade mark in Canada since at least as early as 1990. The registration was obtained in 1992 and remains in force. The domain name MOBILEMINI.CA was registered in 2006. The trade mark and the domain name are identical, after the suffix .ca is disregarded for the purpose of comparison, as is the practice in CDRP decisions. Accordingly, the Complainant has satisfied its onus under Rule 4.1(a) to show confusing similarity.

### **I. Was the Registration of the Domain Name Made in Bad Faith?**

23. In order to succeed in the second stage of the test set out in paragraph 4.1(b), the Complainant must show, on the balance of probabilities, that the Registrant registered the domain name in bad faith. Paragraph 3.5 of the Policy states that the Registrant will be considered to have registered the domain name in bad faith if one of the following four conditions is met and allows bad faith to be determined outside these conditions as well:

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:

- (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.
24. These four criteria are exemplars of certain kinds of bad faith behavior. As the Complainant notes, bad faith may be found to arise in other circumstances.
25. The Complainant has the onus of showing bad faith at the date of adoption of the domain name.
26. In reliance upon section 3.5(d), the Complaint alleges that the Registrant acted in bad faith, when, knowing of the Complainant's trade mark, she intentionally created a likelihood of confusion by registering it as a domain name.
27. The Complaint alleges that the Registrant knew of the trade mark because of a connection she has to a supposed competitor of the Complainant. This conclusion requires a long chain of supposition. The Registrant's address is presumably shared with someone who operates a company which sells shipping pallets which might be stored by their purchasers in pallet storage containers owned by the Complainant's customers. There is no compelling reason offered as to why the Complainant's name would likely reach the Registrant in that circumstance, or evidence that this reason applied in 2006 when the domain name was adopted.
28. Even if the Registrant knew of the trade mark, it is equally possible that she thought it was a good name for a cell phone reseller. That is what MOBILEMINI.CA is, and there is no evidence that it was ever anything else.
29. The Registrant's web site makes no reference to the Complainant to or its industry, goods or services apart from the pictures. This is a pay-per-click site, whose links change reflect the interests of the users who click on the links that interest them. If the users were interested in the Complainant, at least one link would reflect such interest. But none do. All relate to cell phones. Cell phones can be fairly characterized by the

words “mobile” and “mini”. The evidence is that there is no confusion, despite ten years of parallel use.

30. In reliance upon section 3.5(c), the Complaint alleges that the parties are competitors and that the Registrant’s web site is meant to disrupt the Complainant’s business by diverting traffic from Complainant’s official Canadian web suite. “...the Registrant is using the attractive power of the Complainant’s Registered Marks to drive Internet traffic to the Registrant’s Website, as a means to generate revenue for the Registrant by directing traffic to other Internet web sites whose operators pay for that traffic consisting of users who were originally seeking the Complainant’s website or information about the Complainant and its services.” The nature of click through ads is that they reflect the interests of visitors to the web site. There is no sign that users came looking for anything other than cell phones.
31. A seller of cell phones and a seller of storage units are not competitors. Nothing in the facts suggests that the success of one business is at the expense of the other. The Complaint alleges essentially that all businesses with web sites are competitors regardless of their line of business because they compete for user traffic. This proposition takes the word “competitor” well beyond the dimensions of utility for the purposes of determining trade mark disputes, which relate to common customers for the same goods and services.
32. The adoption *per se* of a complainant’s trade mark in a domain name does not create a presumption of bad faith for the purposes of the Policy, or itself or justify a finding of bad faith. The Policy makes it clear that legitimate uses are possible and provides a non-exhaustive list of legitimate uses. For example, in paragraph 3.4(d) it recognizes as legitimate use, use of the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting.
33. The Complaint says the photographs of a storage unit on the Registrant’s web site and what may be storage crates arrayed along an aisle indicate a connection to the storage industry. If there is such a connection, it is very thin and its significance is not apparent to any visitor to the web site. At the most, a user seeking storage solutions or transportation help would have seen that all of the options for action on the web site related to cell phones and concluded that their quest had reached a dead end. There is no evidence as to whether the photographs were in use in 2006 when the issue of bad faith must be determined. It would be helpful to have an explanation of their presence but the failure to provide an explanation as to their significance does not amount to bad faith given that the trade mark has legitimate descriptive uses outside the Complainant’s industry and that the web site is devoted to a single and entirely different industry with no hyperlinks or text suggesting any connection to the Complainant’s industry.

34. The onus is on the Complainant to show that the registration of the domain name was in bad faith, and by failing to show the Registrant's intention at the time of the registration, it has failed to meet its onus.

**J. Does the Registrant Have a “Legitimate Interest” in the Domain Name?**

35. The third element of the test set out in paragraph 4.1 of the Policy is to determine whether or not the Registrant has a legitimate interest in the domain name. Section 3.4 provides that:

**3.4 Legitimate Interests.** For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in a domain name:

(b) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of: (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;

36. As noted above, descriptive use of domain name provides a legitimate interest in it. The Registrant's web site is presently devoted to the sale of cell phones. There is no advertisement or promotion of commerce in metal containers and pre-fabricated buildings for the storage and transportation of goods, or of the rental of metal containers for the storage and transportation of goods.
37. The Complaint argues that “Given the use being made of the Disputed Domain Name, the Registrant cannot reasonably demonstrate a good faith use of the Disputed Domain Name as is required by Paragraphs 3.4(a)-(d) of the Policy.” This argument incorrectly presumes that the onus of proof of good faith falls on the Registrant. Good faith is presumed. The onus of providing some evidence to displace the presumption of good faith, and putting the Registrant to the proof of it, is on the Complainant (Policy, s. 4.1(c)). The speculative connection to a palette company is not sufficient to meet this burden. Even if the onus were on the Registrant, good faith can also reasonably be inferred in this case from the very use complained of. The phrase “mobile mini” is descriptive in relation to its use in MOBILEMINI.CA in promoting the sale of used cell phones.

**L. Conclusion and Decision**

- 38. The Complainant has not shown the domain name MOBILEMINI.CA was adopted in bad faith in 2006. Nor has it provided some evidence to cast doubt that the Registrant has a legitimate interest in it, and the evidence available shows that the Registrant has a legitimate interest.
  
- 39. For these reasons, the Complaint regarding the domain name MOBILEMINI.CA is dismissed.

April 22, 2016



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David Allsebrook