

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

Domain Names: *capitalonecallcentrejobs.ca* and
emploiscentredappelscapitalone.ca

Complainant: Capital One Financial Corp.

Registrant: Wayne Burns

Registrar: Internic.ca Inc.

Service Provider: Resolution Canada Inc.

Panel: Timothy C. Bourne

A. The Parties

1. The Complainant is Capital One Financial Corp. ("Capital One"), a publicly traded financial institution. Capital One has a place of business at 15000 Capital One Drive, Richmond, Virginia, 23238, United States of America.
2. The Registrant is Wayne Burns.

B. Disputed Domain Names and Registrar

3. The disputed domain names are *capitalonecallcentrejobs.ca* and *emploiscentredappelscapitalone.ca* (collectively the "Domain Names"). The Registrar with which the Domain Names is registered is Internic.ca Inc. (the

“Registrar”). The domain name *capitalonecallcentrejobs.ca* was registered on May 16, 2014 and the domain name *emploiscentredappelscapitalone.ca* was registered on May 23, 2014.

C. Procedural History

4. This is an administrative dispute resolution proceeding pursuant to the *CIRA Domain Name Dispute Resolution Policy*, version 1.3 (dated August 22, 2011) (the “*Policy*”) and the *CIRA Domain Name Dispute Resolution Rules*, version 1.5 (the “*Rules*”).
5. The Complainant filed the Complaint with Resolution Canada Inc. (the “*Provider*”) on October 21, 2016. The Provider subsequently sent by email to the Registrant English and French versions of the Notice of Complaint filed by the Complainant, along with electronic versions of the Complaint and Annexes thereto. The Notice of Complaint explained that the Registrant had twenty (20) days from October 21, 2016 to file a Response to the Complaint with the Provider. No response has been filed.
6. On November 25, 2016, the Provider appointed the Panel.
7. Based on the information forwarded by the Provider, the Panel holds that all technical requirements for the commencement and maintenance of this proceeding have been established.
8. The Panel is not aware of any other legal proceeding or other arbitration in relation to the Domain Names that would create a need to alter the progress of the proceeding pursuant to paragraph 13.2 of the *Rules*.

D. Panellist Impartiality and Independence

9. As required by paragraph 7 of the *Rules*, the Panel, Timothy C. Bourne, has submitted to the Provider a declaration of impartiality and independence for this dispute.

E. Effect of Failure of Registrant to File a Response

10. Paragraph 5.8 of the *Rules* provides that “[i]f a Registrant does not submit a Response within the period for submission of a Response or any extended period... the Panel shall decide the Proceeding on the basis of the Complaint...”. Accordingly, the Panel will decide this matter based on the arguments submitted by the Complainant.

F. Remedy Sought

11. In accordance with paragraph 4.3 of the *Policy* and paragraph 3.2(j) of the *Rules* the Complainant has requested that the registrations for the Domain Names be transferred to the Complainant.

G. Applicable Law

12. In accordance with paragraph 12.1 of the *Rules*, the Panel shall apply the laws of Ontario and the laws of Canada applicable within Ontario. Also, as stated in paragraph 4.2 of the *Policy* and paragraph 3.2(m) of the *Rules*, the Panel will base this decision in accordance with the *Policy* and the *Rules*.

H. Eligibility of the Complainant

13. The Complainant must satisfy CIRA’s *Canadian Presence Requirements for Registrants* (the “CPR”). The Complainant has established that it owns

numerous trademarks corresponding with each of the Domain Names (including the trademark CAPITAL ONE), which trademarks are registered pursuant to Canada's *Trade-marks Act*, R.S.C. 1985, c. T-13 (the "Act"). Accordingly, the Complainant satisfies paragraph 2(q) of the CPR and is an eligible complainant.

14. The Complainant also submits that it satisfies the CPR on the basis that it has a presence in Canada by itself or through one of its subsidiaries. Specifically, it is alleged that the Complainant incorporated Capital One Services (Canada) Inc., which corporation was subsequently dissolved and then revived. That corporation would qualify as a proper complainant under the CPR since it was incorporated under the laws of Canada. However, that corporation is not the Complainant in these proceedings. Additionally, there is no provision under the CPR making a party eligible as a complainant on the basis that its alleged presence in Canada arises from a relationship or affiliation with a company federally incorporated in Canada. Accordingly, the Panel rejects the Complainant's second alleged basis for satisfying the CPR.

I. Facts

15. The Complainant makes a number of assertions, including the following:
 - the Complainant is a major financial institution that has been publicly traded since 1994 by and through its subsidiaries;
 - the Complainant has consistently used the CAPITAL ONE name since the Complainant was founded;
 - the Complainant's exclusive rights to the trademark CAPITAL ONE are extensive and well-established. The Complaint attaches printouts confirming registration of the trademark CAPITAL ONE and other

trademarks incorporating that phrase in Canada. The Complaint also attaches printouts demonstrating such registrations in other jurisdictions;

- the Complainant has never authorized the Registrant to use the Domain Names;
- the Complainant has never authorized the Respondent to use the trademark CAPITAL ONE; and
- the Complainant regularly conducts business in Canada and has corporate branches in Toronto and Montreal.

J. Complainant's Contentions

i. The Domain Names Are Identical or Confusingly Similar to a Mark in Which the Complainant Has Rights

16. The Complainant submits that the Domain Names consist of its registered trademark CAPITAL ONE and the phrase "call centre jobs" or its French translation. It is submitted that the phrase in both languages directly relates to the Complainant's business since the Complainant employs people who work in call centres. It also is submitted that the Domain Names are thus descriptive of an aspect of the Complainant's business and would lead internet users to mistakenly believe that the Domain Names are associated with the Complainant.

ii. The Registrant Has No Rights or Legitimate Interests in Respect of the Domain Names

17. The Complainant submits that the Complainant has not licensed or otherwise permitted the Registrant to use its trademark CAPITAL ONE or any of its other trademarks.
18. Further, the Complaint incorporates printouts of the websites to which the Domain Names resolve, each of which prominently display one of the Complainant's registered design trademarks incorporating the phrase CAPITAL ONE. This demonstrates that the Registrant was aware of the Complainant's CAPITAL ONE brand, especially since the design trademark incorporates "TM" as an insignia beside the design mark on both websites.
19. The Complainant's submissions address each of the bases for proving rights or legitimate interests under the *Policy* and the Complainant submits that the Registrant does not qualify under any of those grounds. Rather, the Complainant submits that the Registrant has used the Domain Names for only fraudulent purposes, specifically to imitate the Complainant's website and create misleading inferences that the Domain Names are owned and that the websites are operated by the Complainant.

iii. The Domain Names Were Registered and are Being Used in Bad Faith

20. The Complainant submits that the Registrant is using the Domain Names to divert internet customers seeking the Complainant's website to the Registrant's own websites, presumably for commercial gain. It is submitted that the websites to which the Domain Names resolve each have the look and feel of the Complainant's website and contents suggesting that the Registrant is imitating the Complainant's website and is purporting to be the Complainant.

21. The Complainant thus submits that the Domain Names have been registered in bad faith since the Registrant has attempted to attract, for commercial gain, internet users to the Registrant's website:

- by creating a likelihood of confusion (paragraph 3.5(d) of the *Policy*);
- by registering the Domain Names primarily for the purpose of disrupting the Complainant's business. Additionally, it is submitted that the Complainant is a competitor of the Registrant (paragraph 3.5(c) of the *Policy*); and
- because the administrative contact for the Domain Names has a clear pattern of cyber squatting behaviour (presumably meant to satisfy paragraph 3.5(b) of the *Policy*).

K. Discussion and Finding

22. Paragraph 4.1 of the *Policy* provides that, to succeed, 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.

23. Paragraph 4.1(c) of the *Policy* also states that the Complainant must provide some evidence that:

- (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

L. Confusingly Similar – Paragraph 3.3 of *Policy*

- 24. To satisfy this branch of the test, the Complainant must demonstrate that it has rights in marks that predate the registration of the Domain Names. Also, the Complainant must demonstrate that each of the Domain Names is confusingly similar with one of the marks.
- 25. The Complainant has proven that it has numerous Canadian registrations for trademarks consisting of or incorporating the phrase CAPITAL ONE. Each of the registrations predates the dates on which the Domain Names were registered.
- 26. Paragraph 3.3 of the *Policy* provides that when 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 mistaken for the mark. Thus the Panel must not conduct the confusion analysis in the same manner as would occur under subsection 6(5) of the *Act*.
- 27. Each of the Domain Names is confusingly similar with one of the Complainant's marks. Each of the Domain Names wholly incorporates the Complainant's registered trademark CAPITAL ONE and the additional elements added to the Domain Names enhance the likelihood of confusion. The Complainant employs people who work in call centres and thus internet users are likely to mistakenly believe that the Domain Names are associated with the Complainant, possibly in the form of hiring websites sanctioned by the Complainant. Numerous decisions have held that the addition of generic terms to a well-known trademark do not prevent confusion and in fact may enhance the likelihood of

confusion (see, for example *American Express Marketing and Development Corp. v. Nameshield Inc. c/o Daniel Mullen*, CIRA Dispute No. 1143 (Resolution Canada, February 5, 2014) and *Exxon Mobil Corporation v. Wally Akhras*, CIRA Dispute No. DCA-1385-CIRA (BCICAC, July 9, 2012)).

28. Thus, the Panel finds that the Complainant had rights in the trademark CAPITAL ONE prior to the date of registration of each of the Domain Names and continues to have such rights. Further, each of the Domain Names is confusingly similar to the Complainant's registered trademark CAPITAL ONE.

L. Bad Faith – Paragraph 3.5 of Policy

29. The Complainant's submissions regarding this element are limited to paragraphs 3.5(b), (c) and (d) of the *Policy*.
30. The Complainant need only demonstrate bad faith under one of the grounds provided in the *Policy*. Thus the Panel will address only the Complainant's submissions made pursuant to subparagraph 3.5(d) of the *Policy*.
31. The Complainant's registered design trademarks appear on the websites to which the Domain Names resolve. Additionally, the English language website states that Capital One is "... an international, Fortune 500 Financial services company and we've been offering a broad range of credit cards to Canadian customers since 1996...". A translation of that text into French appears on the website to which the domain name *emploiscentredappelscapitalone.ca* resolves. The Panel agrees with the Complainant that, as a result, there is a strong likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of the Registrant's websites.
32. Numerous decisions have held that bad faith exists under paragraph 3.5(d) of the *Policy* where the website operator passes itself off as the owner of the

associated trademark (see, for example, *GNLV, Corp. v. Cyber Media Inc.*, CIRA Dispute No. DCA-1703-CIRA (BCICAC, August 30, 2015) and *Carey International, Inc. v. Haroun Saleh*, CIRA Dispute No. DCA-1735-CIRA (BCICAC, February 23, 2016)).

33. The Panel thus concludes that the Registrant registered each of the Domain Names in bad faith pursuant to paragraph 3.5(d) of the *Policy*. The Panel also is persuaded by the fact that, despite receiving notice of the Complaint, the Registrant has not made any submissions to the Panel, including any submissions suggesting that the Domain Names are not registered in bad faith.

M. Legitimate Interest – Paragraph 3.4 of *Policy*

34. Paragraph 3.4 of the *Policy* provides that:

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:

- (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 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;

- (c) the Registrant registered 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.

In paragraph 3.4(d) "use" by the Registrants includes, but is not limited to, use to identify a web site.

- 35. The Complainant's unchallenged submissions are that it did not authorize the Registrant to use the Domain Names or its trademark CAPITAL ONE. Thus the Complainant has provided some evidence that the Registrant has no legitimate interest under paragraph 3.4(a) of the *Policy*.
- 36. The Complainant has made submissions regarding its long-standing use of the trademark CAPITAL ONE and of trademarks consisting of or incorporating the phrase CAPITAL ONE. Even though the trademark CAPITAL ONE consists of dictionary terms, those terms alone and together as a phrase do not describe

any inherent aspect of the Complainant's business. Additionally, the Complainant has provided evidence of numerous registrations for trademarks consisting of or incorporating the phrase CAPITAL ONE. Thus the Complainant has provided some evidence that the Domain Names cannot be "clearly descriptive" pursuant to paragraph 3.4(b) of the *Policy*.

37. Regarding paragraph 3.4(c) of the *Policy*, the Panel has concluded that the Registrant registered the Domain Names in bad faith and thus the Registrant cannot have a legitimate interest pursuant to this provision.
38. The printouts of the websites to which the Domain Names resolve do not suggest that the Domain Names are being used in association with a non-commercial activity or in good faith. The Complainant has met its onus under paragraph 3.4(d) of the *Policy*.
39. The Complainant also has provided some evidence that the Registrant has no legitimate interest under paragraph 3.4(e) of the *Policy*. According to the registrations for the Domain Names, the Registrant is Wayne Burns and thus neither of the Domain Names comprises a legal name of the Registrant or other reference by which the Registrant may be commonly identified. The Complainant has met its onus under paragraph 3.4(e) of the *Policy*.
40. Finally, the Complainant has provided evidence that the Registrant's conduct does not fall within paragraph 3.4(f) of the *Policy*. Specifically, the printouts from the Registrant's websites refer to its "Toronto and Montreal call centre teams" or a French translation of that phrase. Thus neither of the Domain Names, each of which wholly incorporates the trademark CAPITAL ONE, qualifies as the geographical name of the Registrant's place of business. Additionally, neither domain name incorporates a geographical term.

41. The Panel concludes that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Names. The onus thus shifts to the Registrant to prove, on a balance of probabilities, that it has a legitimate interest in the Domain Names. The Registrant has not filed any submissions disputing the Complainant's submissions or justifying its registration or use of the Domain Names.

N. Conclusion and Decision

42. For the reasons set forth above, the Panel concludes that the Complainant has established the three elements of the basis for the Complaint in accordance with their respective onuses. Thus, the Panel orders the transfer of each of the Domain Names to the Complainant.

December 14, 2016



Timothy C. Bourne
Sole Panellist