

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

Domain Names: STATOIL.CA

Complainant: StatoilHydro ASA
Registrant: Rudzenka Maksim
Registrar: Netfirms, Inc.
Panelist: David Lametti
Service Provider: ResolutionCanada

DECISION

A. The Parties

1. The Complainant is StatoilHydro ASA. Statoil ASA is an international energy company originally founded in 1972 in Norway, with a leading position worldwide in the sale of oil (and oil-related products such as gasoline and diesel) and natural gas. Statoil is also a leading distributor of energy equipment for infrastructure, agriculture and industry. StatoilHydro ASA was established in October 2007 after a merger of Statoil and Norsk Hydro ASA. Its head office is in Stavanger, Norway. StatoilHydro has significant interests in Canada, especially in oil sands projects. The Complainant is represented by Cecilia Borgenstam, of Melbourne IT Corporate Brands Services (“MIT CBS”), Saltmatargatan 7, Box 3396, SE 103 68 Stockholm, Sweden. The Complainant has registered trademarks in Canada and thus satisfies Canadian Presence requirements under s. 2(q) of the Policy.

2. The Registrant is Rudzenka Maksim, 409-10511 92nd Street, Edmonton, Alberta. The listed Administrative Contact is Ruslan Viksich, 1605-10140 120th Street, Edmonton, Alberta.

B. The Domain Name and Registrar

3. The domain name at issue is < STATOIL.CA >. The domain name is registered with Netfirms, Inc. of Toronto, Ontario.

C. Procedural History

4. The Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, Resolution Canada, on 4 April 2008. The Provider attempted to serve notice of the Complaint to the Registrant as required by paragraph 4.3 of the *CIRA Domain Name Dispute Resolution Rules* [“Rules”] by courier, all of which is documented by the Provider. The Registrant did, however, respond to a telephone call from the courier (Purolator), saying that they would pick up the documents from the Courier, but they

never did. No Response to the Complaint was received from the Registrant. The Provider selected a single panelist according to the process outlined in the Rules.

D. Panel Members' Impartiality and Independence Statements

5. As required by paragraph 7.1 of the Rules, the panelist has declared to the Provider that he can act impartially and independently in this matter as there are no circumstances known to him which would prevent him from so acting.

E. Factual Background

6. The facts of this dispute are as follows. StatoilHydro ASA is an international energy giant. Among its general interests in the petroleum, natural gas and hydro-electric industries and their respective infrastructure are distinctly Canadian projects: oil sands development. Statoil has used the registered STATOIL mark and logo in Europe for over 30 years, and registered the mark in Canada 1995. That same year it also registered the < statoil.com > domain name, which now resolves to the < statoilhydro.com > website. It has numerous – over 100 – domain name registrations placing the word “statoil” before the generic or country-code TLD.

7. The Registrant first registered the domain name in question on 17 October 2005. On 23 May 2007, the Complainant's representative MIT CBS sent a cease and desist letter to the Registrant. The domain name at that point resolved to a site containing pictures of oil extraction facilities, the Statoil name and a logo very similar to the STATOIL name and logo registered as trademarks in Canada. The site also used colours that had been commonly used by Statoil. The site contained a link to the < statoil.com > website, under the hyperlink “If this is not what you are looking for, please try this link ” and a banner footer that repeated the phrase “open for negotiation”. The Complainant's cease and desist letter requested the immediate transfer of the domain name and offered to pay all monies disbursed to register and maintain the domain name until that point.

8. No formal response to the cease and desist was received from the Registrant. However, changes were made to website: the original text banners “open for negotiation” were removed and replaced with the text “This domain is not for sale”. The link to the < statoil.com > website was removed. Statoil's registered logo was also removed.

9. The Complainant's representative MIT CBS sent a reminder email in 6 November 2007. The Registrant responded to the reminder by claiming:

- i. that their site STAT OIL had nothing to with the trademark STATOIL;
- ii. that the Registrants were embarking on a project entitled “State of the Oil and Gas Industry in Canada” and that the phrase “open to negotiation” was seeking investors;
- iii. that the STATOIL LOGO was not on their website (though the language used in the response does not deny the fact that it once was);

- iv. repeated that the website was not for sale, and indeed asserted that no clients were considering this website, and hence they were not misleading anyone;
- v. claimed that any profits would be put to charitable use in Kyiv and Chernobyl, Ukraine;
- vi. that the colours chosen for the website were among their favourite colours; and
- vii. that they “really are open for negotiation” (sic), and only with the owners of STATOIL®, but our website is not for sale!”

The Panel notes that the tone of the response appears to be somewhat contemptuous, and even sarcastic, and the postscriptum nonsensical.

10. Upon receiving the response, the Complainant’s representative sent one more email communication asking for a transfer and warning that legal proceedings would otherwise commence.

11. The Complainant, through MIT CBS, initiated proceedings under the CIRA Policy and Rules on 31 March 2008 and amended finally the proceedings on 4 April 2008.

12. No response to the Complaint from the Registrant has been received.

F. CIRA Domain Name Dispute Resolution Policy Requirements

13. The *CIRA Domain Name Dispute Resolution Policy* [“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 3.7;

and the Complainant must provide some evidence that:

- (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6.

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 . . .

14. The Respondent has made no reply. The Policy and Rules nevertheless allow this complaint to proceed, and the Panel shall proceed by holding the Complainant to the usual burdens of proof and argument incumbent on it in such cases.

G. Is the Registrant’s Domain Name Confusingly Similar to the Complainant’s Mark?

1) The Complainant's Marks

15. Paragraph 3.2 of the Policy includes the following in the definition of what constitutes a “mark” for the purposes of the Policy:

A “Mark” is:

- (a) a trade-mark . . . or a trade name that has been used in Canada . . . for the purpose of distinguishing the wares, services or business of that person . . . from the wares, services or business of another person; [and]
- (c) a trade-mark . . . that is registered in CIPO . . .

16. The Complainant has shown ample evidence of its current ownership of the registered mark STATOIL in Canada.

2) “Confusingly Similar”

17. Paragraph 3.4 of the Policy defines “confusingly similar” in the following terms:

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.

18. STATOIL is a well-known and long-established mark internationally, and is well-known in the oil and gas industry in Canada. It is used for a wide variety of products and services in the oil and natural gas industry, and now hydro-electric power.

19. The substance of the domain name, that is the part of the domain name that precedes the “dot” and TLD, quite simply is identical to the Complainant’s registered mark. The claim that the Registrant’s project was to be called STAT OIL (with a space between STAT and OIL) rings hollow, as no such space appears in the text of the websites to which the domain name resolved. Moreover, the use of the STATOIL LOGO on the initial website design, the use of similar colours, as well as images of oil pump “rocking horses”, would further create confusion.

20. Under these circumstances, it would be difficult, if not impossible, for a reasonable internet user to not be confused by the Registrant’s domain name. On the contrary, such a person would assume quite reasonably that the domain names were linked to the Complainant’s business activities.

21. Interpreting “confusingly similar” under the Policy, the Panel finds the Registrant’s domain name < STATOIL.CA > to be confusingly similar to the Complainant’s mark.

H. Was the Registration of the Domain Name Made in Bad Faith?

22. In order to succeed, the Complainant must show, on the balance of probabilities, that the Registrant registered the domain name in bad faith. Paragraph 3.7 of the Policy states that the Registrant will be considered to have registered the domain name in bad faith if and only if one of the following three conditions is met:

(a) the Registrant registered the domain name . . . primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant [or others related to or competing with the Complainant] for valuable consideration in excess of the Registrant's actual costs in registering the domain name . . . ;

(b) the Registrant registered the domain name . . . in order to prevent the Complainant [or others related to the Complainant] 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; or

(c) the Registrant registered the domain name . . . 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.

23. It is now trite to say that a panel should take into account all surrounding circumstances and draw common sense inferences when delving into the matter of bad faith, given that it is virtually impossible to conclusively show actual bad faith. Nevertheless, a panel should proceed responsibly and not relieve a complainant if the obligation to show bad faith.

24. On the facts and evidence adduced in this dispute paragraph 3.7 (a) appears to be applicable.

25. The Registrant made it obvious that he wished to negotiate with "only Statoil". The intent was to capitalize on the move by the Complainant into the Canadian market and likely the oil sands industry. The use of an identical name, colours and logo on the website, as well as images in line with the Complainant's activities allow the Panel to infer that the Registrant was well aware of the Complainant, its marks, its colours and its operations. The Registrant's own actions thus clearly contradict its claim that it was not aware of the Complainant's marks when it registered the domain name and afterwards.

26. The context of the email exchange with the Respondent following the notice of 6 November 2007 seems to indicate that the Respondent would indeed negotiate with StatoilHydro for the domain name, but was waiting for an offer that was more than what the Complainant had offered already: namely, the costs of registering and maintaining the site. That the Registrant has not been shown to have been engaging in the activity of registering and selling domain names is not a pre-requisite to a finding the Registrant's clear intention was to sell this website back the trademark holder, as per paragraph 3.7 (a).

27. This is sufficient to find bad faith. I need not pronounce on the whether paragraphs 3.7 (b) and (c) of the Policy's test for bad faith were also met.

28. The Panel therefore concludes that the Registrant did in fact register the domain name < STATOIL.CA > in bad faith under paragraph 3.7 (a) of the Policy.

I. Does the Registrant Have a “Legitimate Interest” In the Domain Name?

29. The final element of the test set out in the Policy is to determine whether or not the Registrant has a legitimate interest in the domain name. Paragraph 3.6 of the Policy states:

The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint was submitted

- (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.

30. This definition is restrictive – only the interests listed in subparagraphs (a) through (f) below can be considered legitimate interests. These all point to some legitimate activity and objective link in assessing the relationship between the domain name and the Registrant. In terms of procedure the Complainant must provide some evidence that none of these interests applied to the Registrant. The burden would then shift to the Registrant to show that it has, on the balance of probabilities, any one of these legitimate interests as defined under these subparagraphs.

31. The Complainant has asserted in a relatively concise fashion that the Registrant has no legitimate interest in the domain name. The Complainant's assertion rests on the fact the Registrant has never appeared to have made any use of the domain name in the roughly two years following the registration and website other than to say the site was "open for negotiation". It also points out that STATOIL is an invented word, so is not the subject-matter of some generic site: a non-trademark holder would only choose it for non-legitimate reasons. In the context of its registration and use, the Complainant can find no links between the domain name and the Registrant, and his or her names and activities.

32. I am inclined to accept these contextual arguments in this particular set of circumstances. The Complainant has met its initial burden of showing that the Registrant has no objective link to or legitimate activity associated with the domain name. That is, it does not appear that the domain name was ever used as part of a legitimate activity that was in some way objectively linked to the name, person, business activities, location or possible trademarks of the Registrant. Nor is the domain name linked to a description of goods or services, a generic product or other legitimate use offered by the Registrant under this paragraph, as inferred by the Complainant.

33. The Panel therefore concludes that the Complainant has shown some evidence that the Registrant did not have a legitimate interest in the domain name < STATOIL.CA > and has met the initial burden under paragraph 3.6 of the Policy.

34. Under the Policy, the burden now shifts to the Registrant to show that it has a legitimate interest in the domain name as defined under the Policy. Here, the Registrant has not chosen to reply, and thus the assertions of the Complainant are accepted by the panelist. The Panel also notes that the reasons offered by the Registrant in the email exchange following the email of 6 November 2007, i.e., that it was looking for investors for a project entitled "State of the Oil and Gas Industry of Canada" and that there was a charitable goal – supporting a children's charity in Kyiv (Kiev) and Chernobyl, Ukraine – is simply not in any way supported by additional evidence or context. It is more than reasonable to conclude that such projects for this domain name did not in fact exist, and in any event, if they did, the Registrant might have chosen to respond to support such claims by proving their existence.

35. The Panel thus concludes that the Registrant did not have a legitimate interest in the domain name < STATOIL.CA > under paragraph 3.6 of the Policy.

J. Conclusion and Decision

36. The Complainant has established on the balance of probabilities that the Registrant's domain name < STATOIL.CA > is confusingly similar to the Complainant's mark.

37. The Complainant has established on the balance of probabilities that the Registrant had registered the domain name < STATOIL.CA > in bad faith, as defined in the Policy.

38. The Complainant has provided some evidence that the Registrant has no legitimate interest, as defined in the Policy, in the domain name < STATOIL.CA>. The Registrant has chosen not to question this evidence in the proceeding, and assertions made by the Registrant in correspondence prior to the proceeding are both unconvincing and unsupported. The Panel thus accepts the assertions of the Complainant as having been established.

39. For these reasons, the Complaint regarding the domain name < STATOIL.CA > is successful.

K. Remedy

40. The Complainant has asked that the domain name at issue be transferred to it. The Panel hereby so orders.

Dated 16 May 2008,

David Lametti (Sole Panelist)

David Lametti
16 May 2008