

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

Domain Name: MENTOS.CA

Complainant: Perfetti Van Melle Benelux B.V.
Registrant: Globe Media International Corporation
Registrar: DomainsAtCost Corp

Panel: David Allsebrook
Jay Josefo
David Lametti (Chair)

Service Provider: Resolution Canada

DECISION

A. The Parties

1. The Complainant is Perfetti Van Melle Benelux B.V., whose corporate address is Zoete Inval, 20, 4815 HK Breda, The Netherlands. The Complainant's authorized representative is Peter J. Pribil, Finlayson & Singlehurst, 70 Gloucester Street, Ottawa, Ontario K2P 0A2.

2. The Registrant is Globe Media International Corporation, a Canadian business corporation with its registered offices in Toronto, Ontario. The Registrant's contact person is Mr. Stefano Venneri. The Registrant's address is 277 Winona Drive, Toronto Ontario, M6C 3S8.

B. The Domain Name and Registrar

3. The domain name at issue is MENTOS.CA

The domain name is registered with DomainsAtCost Corp.

C. Procedural History

4. On 27 April 2010, the Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, Resolution Canada. The Provider served notice of the Complaint to the Registrant as required by paragraph 4.3 of the *CIRA Domain Name Dispute Resolution Rules* ["Rules"]. The Complainant elected to have the Complaint

heard by a panel of three as permitted under paragraph 6.4 of the Rules, and nominated potential panelists. The Registrant also suggested three panelists. The Provider selected panelists David Allsebrook and Jay Josefo, and David Lametti as Chair.

D. Panel Member Impartiality and Independence Statement

5. As required by paragraph 7.1 of the Rules, the panelists have each declared to the Provider that they can act impartially and independently in this matter as there are no circumstances known to them which would prevent any of them from so acting.

E. Canadian Presence Requirement

6. The Complainant's trade-mark MENTOS is registered in Canada thus satisfies the Canadian Presence Requirement under paragraph 3.4 of the Policy.

F. Factual Background

7. The Complainant's trade-mark MENTOS, originally registered in The Netherlands in 1949, has been registered and maintained in Canada since 1961. The Complainant has provided evidence of the strength of the mark in Canada, in terms of the positive association of the mark to mint candies as well as in terms of sales.

8. The Complainant has other generic and country-level domain names beginning with "mentos", such as MENTOS.COM.

9. The Registrant registered the domain name on March 24, 2004, and has maintained the registration to date.

10. The Complainants asked the Registrant, in a letter sent by both registered mail and email on 3 June 2008, to cease and desist using the domain name, to be available to transfer the domain name to the Complainant, to not undertake to try to register the MENTOS name as trademark, domain name or other distinctive sign, and to not simply "delete" the domain name.

11. It does not appear that the Registrant ever responded to that communication, although he did attempt to register WWW.MENTOS.CA as a trademark on 5 June 2008. This process was abandoned voluntarily in 2009.

12. The Complainant filed this Complaint on 27 April 2010. A Response was received from the Registrant on 14 May 2010.

G. 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 . . .

The Panel will deal with each of these criteria in turn.

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

14. 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 . . .

15. The Complainant must establish trade-mark rights that precede the domain name registration date.

16. In this case, the Complainant is the owner of the Canadian trade-mark registration for MENTOS since 1961, well prior to the internet age. The Panel need not go beyond that. It is, however, fair to observe that, on the evidence, the mark is well-known.

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. The domain name at issue is confusingly similar with the Complainant's trade-mark. Except for the addition of the non-distinctive elements "www", ".ca", the domain name and the trade-mark are identical. That the colour of the trade-mark on the wares specified in the trade-mark registration is of no material consequence to differentiating a

domain name, whose primary association is with the word used in the mark and the domain name. For the same reason, the parameters of the trade-mark registration in terms of wares, or the parameters of trade-mark law generally, do not in and of themselves restrict a strict comparison of the word(s) used in the mark and the domain name being made for the purposes of determining whether or not a domain name is confusingly similar to a trade-mark.

19. Thus, the Panel finds that the Registrant's domain name MENTOS.CA is confusingly similar with the Complainant's registered mark in which the Complainant had rights prior given the longstanding registration of the identical trade-mark.

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

20. In order to succeed in the second stage of the test, 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.

21. As the Complainant has shown, the Registrant is now well-known in Canadian domain name circles for not only registering domain names in bad faith for the purposes of re-selling the names to legitimate right-holders, but also for the practice of subsequently attempting to register trademarks in order to attempt to justify previous domain name registrations. Both of these practices have been noted by CIRA CDRP Panels (*ZANTAC.CA* [*Johnson & Johnson v. Globe Media International Corporation*, CIRA Decision 00098 (2008)], *FORSALE.CA* [*Globe Media International Corporation v. Bonfire Development, Inc.*, CIRA Decision 00135 (2009)], as well as by commentators (Mr. Dan Cera in DomainCop.com).

22. Both of these bad faith elements appear to be part of the behaviour of the Registrant in the instant case. MENTOS.CA is one of a number of well-known trade-marks

registered as domain names, and indeed the MENTOS.CA registration had been cited as an example, along with other well-known marks, in other cases as evidence of a pattern of bad faith registration of domain names in order to prevent persons who have marks from registering the marks as domain names (ZANTAC.CA, paras 46-48; FORSALE.CA, para. 40).

23. Moreover, in this case as well, the Registrant attempted to register *ex post* a trademark similar to the domain name, though as noted, the trademark registration was later abandoned. The Panel notes that the attempted trademark registration appears, in terms of timing, to have been a reaction to the cease and desist letter sent by the Complainant's lawyer.

24. The Registrant states that it has moved, voluntarily, to transfer some of its domain names the owners of identical, well-known trade-marks. The Registrant does not explain how he came to be the registered owner of LONGINES.CA, MOVADO.CA, SMIRNOFF.CA and MOVADO.CA. As the Registrant did not choose to transfer the domain name at issue to the Complainant, these gestures are not sufficient to reverse the initial bad faith registration in this case, nor are they sufficient to ground a claim that the pattern of bad registration no longer exists. Indeed, in this case the Registrant did not respond to the transfer request in the Complainant's cease and desist letter.

25. Therefore this Panel concludes that the Registrant acquired the domain name MENTOS.CA in bad faith under paragraphs 3.7 (a) and 3.7(b) of the Policy.

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

26. 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. This inquiry tries to find some more or less objective or ascertainable link between the Registrant and the domain name in question, aside from mere registration, and which is legitimate. 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.

27. Once again, this definition is restrictive – only the interests listed in subparagraphs (a) to (f) below can be considered legitimate interests. In terms of procedure the Complainant must provide some evidence that none of these interests applies 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.

28. The Complainant has introduced sufficient evidence of the Registrant having no legitimate interest. On the evidence submitted, the Registrant does not appear to be using the domain name in conjunction with any active website. The Registrant says it ceased using the domain name after receiving a threatening letter from the complainant "out of an abundance of caution". However the Registrant does not say what it was using the domain name for, before it received the letter. Moreover, the Complainant argues that the Registrant does not fall into any of the six categories listed above.

29. The Complainant having thus satisfied its initial burden of showing "some evidence" of "no legitimate interest" puts the onus on the Registrant to show a legitimate interest.

30. The Registrant argues that "Mentos" is a common surname. However, the Registrant fails to establish in any credible manner that it had a link to the surname Mentos or that it was planning to use the website for any purpose related to the surname.

31. The Panel therefore concludes that the Registrant did not have a legitimate interest in the domain name MENTOS.CA under paragraph 3.6 of the Policy.

K. Conclusion and Decision

32. The Complainant has established that the Registrant's domain name MENTOS.CA is confusingly similar to the Complainant's registered Canadian mark.

33. The Complainant has established that the Registrant had registered the domain name MENTOS.CA in bad faith, as defined in the Policy.

34. The Complainant has provided some evidence that the Registrant has no legitimate interest, as defined in the Policy, in the domain name MENTOS.CA. The Registrant has not established, as set out in the Policy, that it does have a legitimate interest.

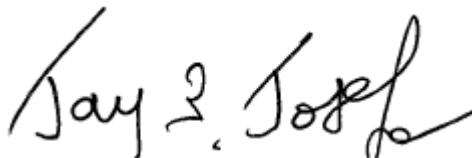
35. For these reasons, the Complaint regarding the domain name MENTOS.CA is successful.

L. Remedy

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



David Allsebrook
Panelist



Jay Josefo
Panelist



David Lametti
Chair

June 1, 2010