

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

Domain Name: EBATES.CA

Complainant: Ebates Canada, Inc.
Registrant: Cranhill & Company
Registrar: Webserve Canada(Canada Technology Enterprise Inc.)
Panelists: David Allsebrook, Eric Macramalla, Tim Bourne
Service Provider: Resolution Canada

DECISION

A. The Parties

1. The Complainant is **EBATES CANADA, INC.** It was incorporated under the laws of New Brunswick in 2011. The Complainant states that it is the exclusive Canadian licensee of the name and trade-mark EBATES, which is owned by its corporate parent Ebates Performance Marketing, Inc.

2. The Complainant is represented by the law firm Heenan Blakie LLP.

3. The Registrant is CRANHILL & COMPANY, with its registered address in Ottawa, Ontario. It is the alter ego of a Mr. John H. (Jack) Fagan.

4. The Complainant's parent company and Mr. Fagan both have applications pending in Canada to register the trade mark EBATES. Opposition proceedings are beginning on the application by Ebates Performance Marketing, Inc. The Fagan application was filed on March 28, 2012, and has not yet been advertised so as to become open to opposition.

5. A previous Complaint respecting ebates.ca was brought by the same Complainant in January but did not proceed for reasons unknown to this Panel. The parties have nonetheless requested that this Panel adjudicate this Complaint.

B. The Domain Name and Registrar

6. The domain name at issue is EBATES.CA. The Registrar is DomainsAtCost Corp.

C. Panel Member's Impartiality and Independence Statement

7. As required by paragraph 7.2 of the Rules, the undersigned panelists have 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 them from so acting.

E. Factual Background

8. The Complainant states the following facts.

9. The Complainant is a subsidiary and trade-mark licensee of a U.S. corporation called Ebates Performance Marketing, Inc. The U.S. parent corporation operates a cash back shopping web site at the domain name ebates.com. The trade mark EBATES has become widely recognized in Canada and internationally in connection with the ebates.com web site. The first use of the EBATES trade mark in Canada was at least as early as August 1999. An application by the parent company to register EBATES as a trade mark in Canada is pending.

10. The Registrant strongly disputes that the trade mark EBATES has been used in Canada by the Complainant and its parent company/licensor, and makes its own assertions of prior use of the trade mark EBATES.

11. The parties' submissions cover a number of issues which are not discussed in this decision. This panel takes no position with respect to them. This Complaint is being resolved on a single issue and some of the remaining issues will likely be pursued between the parties in other proceedings.

F. CIRA Domain Name Dispute Resolution Policy Requirements

12. The Complaint falls to be decided under the current version of the **CIRA Domain Name Dispute Resolution Policy** ("the Policy"), version 1.3, which came into effect on August 22, 2011. The Policy sets out at paragraph 4.1 what the Complainant must establish in order to succeed:

" **4.1 Onus.** 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 as described in paragraph 3.4. "

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

13. The Policy provides:

“4.1 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” [emphasis added].

14. The parties agree that the trade mark EBATES and the domain name ebates.ca are confusingly similar.

15. Did the Complainant have rights prior to the date of registration of the domain name? The domain name was registered in October, 2000. The Complainant did not state its date of incorporation, and has thereby not discharged its onus of proving that it had rights at the material date. According to the Registrant, the Complainant was not incorporated until 2011, 11 years after the domain name was registered.

16. The Registrant filed two forms filed under the New Brunswick Corporations Act in March 2012 by the Complainant, giving its address and naming its directors. The forms do not give the date of incorporation. They do double duty, being designed to be used both for initial filing and for filing notice of changes. The forms are called FORM 2, NOTICE OF REGISTERED OFFICE OR NOTICE OF CHANGE OF REGISTERED OFFICE (SECTION 17) and FORM 4, NOTICE OF DIRECTORS OR NOTICE OF CHANGE OF DIRECTORS. The insertion of “N/A” in the blank spaces on each form seeking the effective date of the change being registered, suggests that these are the initial forms filed by the company.

17. The Complainant does not address the issue directly but tacitly acknowledges it by framing its complaints as if its parent company/licensor were a co-Complainant. The parent company/licensor is not a Complainant, likely because it does not meet the Canadian presence requirements. The Policy requires that all complainants meet the Canadian presence requirements.

“1.4 Eligible Complainants. 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.”

18. The Complainant relies upon a license from its parent company to back date its rights. The Complainant’s license from its parent company does not endow it with an earlier date of incorporation. It cannot meet the test set out in 4.1(a) of the Policy. To find otherwise would allow an ineligible complainant to proceed by proxy.

J. Bad faith Complaint

19. The Registrant has requested an award of costs of \$4, 851.09 from the Complainant on the basis that the Complaint was made in bad faith.

“4.6 Bad Faith of Complainant. If the Registrant is successful, and the Registrant proves, on a balance of probabilities, that the Complaint was commenced by the Complainant for the purpose of attempting, unfairly and without colour of right, to cancel

or obtain a transfer of any Registration which is the subject of the Proceeding, then the Panel may order the Complainant to pay to the Provider in trust for the Registrant an amount of up to five thousand dollars (\$5000) to defray the costs incurred by the Registrant in preparing for, and filing material in the Proceeding.”

20. The Registrant has the onus of proving that the Complaint is unfair and without colour of right. The Registrant does not deny that the Complainant’s parent operates an online business in the United States at Ebates.com. What is disputed is the extent to which the operation has served to create trade mark rights in EBATES in Canada and when that might have occurred.

21. The Complainant says its licensor has used the trade mark EBATES in Canada since fourteen months before the domain name was registered, and the Registrant denies that trade mark use took place. The Registrant’s arguments of non-use acknowledge connections to Canada on the ebates.com web site, such as that “Whereas its’ ebates.com web site features thousands of coupons from hundreds of U.S. retailers, there are presently only 5 Canada coupons as shown on the attached printout...” The Registrant has not met the difficult burden of proving the absence of colour of right or that the Complaint is unfair.

22. We find that the Complainant cannot satisfy the first of three necessary criteria for its complaint to succeed, namely that 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, because the Complainant corporation did not exist at that time.

23. For the reasons set out above, the Complaint seeking the transfer of the domain name EBATES.CA is dismissed without costs.

April 30, 2012

For the Panel, David Allsebrook, Eric Macramalla and Tim Bourne


