

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

CASE NO.: DCA-1385-CIRA
DISPUTED DOMAIN NAME: *mobillubeexpress.ca*
COMPLAINANT: Exxon Mobil Corporation
REGISTRANT: Wally Akhras
REGISTRAR: Tucows.com
SERVICE PROVIDER: British Columbia International Commercial Arbitration Centre
PANEL: James E. Redmond (Chair);
Elizabeth Cuddihy;
David Wotherspoon

DECISION

The Parties

1. The Complainant is Exxon Mobil Corporation of 5959 Las Colinas Boulevard, Irving, Texas 75039-2298, USA, represented in this proceeding by Janet M. Fuhrer, Timothy C. Bourne and Jaimie Bordman of the law firm of Rideout & Maybee LLP of 100 Murray Street, 4th Floor, Ottawa, Ontario K1N 0A1. The Registrant is Wally Akhras, of 1003-550 Webb Dr., Mississauga, Ontario, L5B 3Y4.

Procedural History

2. The Panel issued a decision in this Proceeding on July 9, 2012. Subsequently it came to the Panel's attention that the Registrant, as part of his Response, had provided to the Service Provider an unsworn Affidavit (the "Document") which, through inadvertence, had not been provided to the Panel for consideration as part of the evidence in this matter. On the consent of the Complainant and the Registrant, the Panel agreed to vacate the decision rendered on July 9, 2012, and consider the issues afresh, including the

Document. Based on that consent, the Decision of July 9, 2012, was vacated. This is the Panel's decision in this Proceeding.

3. This is an administrative proceeding pursuant to the CIRA Domain Name Dispute Resolution Policy (the "Policy") and the CIRA Domain Name Dispute Resolution Rules (the "Rules"). By registration of the domain name with the Registrar, the Registrant agreed to the resolution of certain disputes pursuant to the Policy and Rules.
4. The Service Provider advises as follows:
 - (a) The Complaint was filed by the Complainant on April 2, 2012;
 - (b) The Complaint was reviewed and found to be compliant and on April 4, 2012 the Service Provider so advised the Complainant and the Registrant and forwarded a copy of the Complaint to the Registrant;
 - (c) The Registrant requested an extension for delivery of his Response to May 14, 2012 and the extension was granted as permitted by Rule 5.4;
 - (d) The Registrant delivered a Response on May 14, 2012. The Response was determined not to be in administrative compliance with the Policy and Rules, and the Registrant was given 10 days to correct all instances of non-compliance;
 - (e) The Registrant's Response, as revised, was received on May 25, 2012, was reviewed by the Service Provider and delivered to the Complainant;
 - (f) In accordance with paragraph 6 of the Rules, a three-person Panel was appointed, consisting of James Redmond, as Chair, Elizabeth Cuddihy and David Wotherspoon.
5. The Panel finds that all technical requirements for the commencement and maintenance of this proceeding were met and that the Panel was properly constituted and appointed in accordance with the Policy and the Rules.
6. The Service Provider advised the Panel that the Complainant had filed a Reply, purporting to do so in accordance with Rule 11.1.

7. Following consideration, the Panel directed the Service Provider to send copies of the Reply to the Panel and the Registrant, and to advise the Registrant that the Panel directed that any submissions the Respondent might wish to make in respect thereof be made within the time frame set by the Panel.
8. On request by the Registrant the Panel extended the time for the Registrant's submissions.
9. The Registrant sent a Response to the Complainant's Reply to the members of the Panel, to counsel for the Complainant and to the Service Provider on July 3, 2012, in which he submits that the Reply contains evidence that is new and not relevant to the Registrant's response. The document goes on to make submissions in response to the points made in the Reply on the question of legitimate interest.
10. After reviewing the Reply and the Registrant's submission in response, the Panel concluded that the Reply was properly filed. The Complainant's evidence shows that the Registrant's identity is not published in the public WHOIS database, and the submissions in the Reply relate to the issue of the Registrant's legitimate interest (or lack thereof) in the Disputed Domain Name.

Complainant's Eligibility

11. Under paragraph 1.4 of the Policy, a person is an Eligible Complainant if the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office (the "CIPO"), and the Complainant is the owner of the trade-mark. In this case, the Complaint relates to several trade-marks registered in the CIPO and owned by the Complainant, so the Complainant is an eligible Complainant.

The Complaint

12. The Complainant alleges that:
 - (a) The Disputed Domain Name, *mobilllubexpress.ca* is confusingly similar to Marks in which the Complainant had Rights prior to the registration of the

Disputed Domain Name and in which the Complainant continues to have such Rights;

- (b) The Registrant registered the Disputed Domain Name in bad faith;
 - (c) The Registrant has no legitimate interest in the Disputed Domain Name.
13. Under paragraph 3.1 of the Policy the filing of the Complaint making these assertions requires that the Registrant submit to a Proceeding in accordance with the Policy.
14. The Registrant alleges that:
- (a) The Disputed Domain Name was registered on October 18, 2006 with the consent of the Complainant by its authorized representative; and
 - (b) The Registrant has a legitimate interest in the Disputed Domain Name and denies the allegations of the Complainant; and
 - (c) The Registrant requests that the Disputed Domain Name remain in the name of the Registrant.

Discussion and Findings

(a) Confusing Similarity between the Disputed Domain Name and the Complainant's Marks

15. The Disputed Domain Name, *mobil1lubexpress.ca*, was registered by the Registrant on October 18, 2006. The Complainant's evidence respecting its Marks shows that the trade-mark **MOBIL** is derived from the trade-marks **MOBILGAS** and **MOBILOIL**, used as early as 1899. By 1934, the trade-mark **MOBIL** was used in both Canada and the United States in association with numerous petroleum products and related services, including lubricating oils. Further, the trade-mark **MOBIL 1** was adopted in 1974 in association with a new line of synthetic engine lubricant products, and Mobil Corporation and its successors, including Exxon Mobil, either themselves or through licensees, have sold **MOBIL 1** engine lubricants in over 76 countries around the world, including

Canada, to numerous kinds of end consumers including individuals, automotive service centres and automobile manufacturers.

16. The Complainant's evidence further shows that at least as early as 2003, Exxon Mobil began offering lubricating services for automobiles in association with the trade-mark **MOBIL 1 LUBE EXPRESS** Design in the United States. The services were advertised using a variety of media including print advertising, and radio and television advertising, and were distributed widely in the United States and Canada. In addition, advertising of the Complainant's automobile lubrication services incorporating the **MOBIL 1 LUBE EXPRESS** Design is also available on the internet, which is available to the public, including internet users in Canada. These advertising efforts using the trade-mark **MOBIL 1 LUBE EXPRESS** Design resulted in a rapid growth in the **MOBIL 1 LUBE EXPRESS** branded facilities showing a sixty-five percent increase in facilities in 2005 in the United States over the year 2004. Due to the success of the **MOBIL 1 LUBE EXPRESS** program in the United States, the Complainant decided to make the service available in Canada and made public this decision in the fall of 2006, launching the first facility in Sarnia in 2007. In both Canada and the United States, these services were offered by independent operators of Quick Lube facilities under license from Exxon Mobil or one of its licensed distributors.
17. A copy of the list of the Canadian registered trade-marks owned by Exxon Mobil as successor to Mobil Corporation is attached as Appendix A to this Decision.
18. Copies of CIPO records evidence the trade-marks currently registered in the name of the Owner and the dates of their registration. Each of these constitutes a "Mark" under paragraph 3.2 of the Policy.
19. The **MOBIL** Mark was first registered in 1936, and the **MOBIL1** Marks in 1976.
20. Paragraph 3.3 of the Policy provides that:

In 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 to be mistaken for the Mark.

21. The Disputed Domain Name, *mobilllubexpress.ca* incorporates each of the **MOBIL** and **MOBIL 1** Marks, or in the case of the Marks involving a design, the text portions, and adds “lube”, “express”, and “.ca”. There are a number of CIRA cases in which Panels have held that the inclusion of further words, letters or symbols in the disputed domain name along with the trade-mark in issue will not prevent the disputed domain name from being found to be confusingly similar. See for example: *Citrixonline llc v. Media Vision Network Inc.*, CIRA Decision 175 (2011); *The Exite Group Inc. v. Zucker International Marketing Inc.*, CIRA Decision No. 176 (2011); *Enterprise-Rent-A-Car Company v. David Bedford*, CIRA Decision No. 0097 (2008); *Oakley, Inc. v. Zhou Yayang* CIRA Decision No. 188 (2012). The terms “lube” and “express” in the Disputed Domain Name can reasonably be said to be descriptive of the character and quality of the wares and services to which the Complainant’s Marks relate.
22. The Panel concludes that, given the prominence, wide-spread use and advertising of the Complainant’s **MOBIL** and **MOBIL 1** Marks, the inclusion in the Disputed Domain Name of the words “lube” and “express” does not prevent the disputed domain name from being found to be confusingly similar to the Complainants’ Marks.
23. As provided in paragraph 1.2 of the policy, the inclusion of the “-ca” suffix does not prevent the disputed domain name from being found to be confusingly similar to the Complainant’s Marks.
24. The Complainant also bases its Complaint on its **Mobil 1 Lube Express** Mark. This Mark was registered as number TMA 782,910 on November 19, 2010. As noted above, the Complainant began advertising lubricating services for automobiles in association with the trade-mark **Mobil 1 Lube Express** Design as early as May, 2003 and has done so continuously since that date. Such services were advertised using a variety of media, including internet, print advertising, radio advertising and television advertising, and that such advertisements had been distributed widely in the United States and Canada. The Complainant has offered and sold lubricating services for automobiles in association with the **Mobil 1 Lube Express** Mark in the United States since at least since 2003, and in Canada since at least 2007.

25. As set out in out in paragraph 3.1 of the Policy, the Complainant must establish that it had Rights in the Mark prior to the date of registration of the Disputed Domain Name and continues to have such rights. The evidence respecting the **MOBIL** and **Mobil 1** Marks clearly establishes that the Complainant and its predecessors had Rights in these Marks prior to the date of registration of the Disputed Domain Name and continue to have such rights.
26. However, the **Mobil 1 Lube Express** Mark, and two revised versions of the **MOBIL 1** Design, were registered after the Disputed Domain Name was registered in November, 2006. With respect to these Marks, the Complainant submits that the fact that the current version of the Policy (version 1.3) no longer contains a definition of “Rights” demonstrates the intention to preclude a restrictive interpretation as to what constitutes Rights in a Mark. It submits that a broad interpretation of this concept should be adopted and that the terms “Rights” is intended to include “common law” rights in addition to rights based upon registration at the CIPO. The Complainant cites in this regard the decision in *The Exite Group Inc. v. Zucker International Marketing Inc.*, CIRA Decision 176 (2011) at para. 46.
27. The **MOBIL** and **MOBIL 1** Marks have been used in Canada for many years and have been extensively advertised. The **Mobil 1 Lube Express** Mark has been advertised in a variety of media since May, 2003, which includes materials circulated to the fast change oil industry in Canada between 2004 and 2006.
28. The Panel concludes that the Complainant has Rights in its trade-marks as detailed above, both on the basis of registration of the Marks at the CIPO and the advertisement and use of the Marks. In the case of the two revised versions of the **MOBIL 1** design marks, and the **Mobil 1 Lube Express** Mark although the registration of those marks occurred after the Disputed Domain Name was registered, they were widely used and advertised prior to the date of registration of the Disputed Domain Name. At the present time, the Complainant continues to have such Rights.

29. In the result, the Panel finds that the Complainant has shown that the Disputed Domain Name is Confusingly Similar to Marks in which the Complainant had Rights prior to the date of registration of the Disputed Domain Name and continues to have such Rights.

(b) Registration of the Domain Name in Bad Faith

30. The Complainant asserts that the registration and use by the Registrant of the Disputed Domain Name constitutes bad faith under paragraphs 3.5(d) and 3.5 of the current version of the Policy, version 1.3, which read as follows:

3.5 Registration in Bad Faith. 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:

...

(d) The Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website, or another 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.

31. The Complainant submits that while subparagraphs (a), (b) and (c) of paragraph 3.5 refer to the conduct of the Registrant at the time of registration of the domain name, subparagraph (d) does not restrict the Panel to consideration of the Registrant's conduct only at the time of registration but that the Registrant's conduct after registration of the domain name may also be taken into account. The Complainant cites *Exite Group, Inc. v. Zucker International Marketing Inc.*, CIRA Decision 176 (2011), where the Panel stated in paragraph 74:

If the Registrant has engaged in the behaviour referenced in subparagraph (d), then pursuant to paragraph 3.5 of the Policy this "shall be evidence that a registrant has registered a domain name in bad faith", even if that behaviour occurs subsequent to the actual domain name registration.

32. The Complainant further quotes from paragraph 76 of that decision where the Panel stated:

... subparagraph (d) therefore explicitly permits consideration of the Registrant's conduct after the disputed domain name has been registered as a means to determine if the Registrant has *registered* the disputed domain name in bad faith. (emphasis in the original)

33. In further support of its argument that the conduct of the Registrant after registration of the Domain Name may be taken into account in determining whether it was registered in bad faith, the Complainant cites *UVA Solar GmbH & Co. K.G. v. Mads Kraigh*, WIPO Case No. D2001-0373, at para. 6.6.7. The Complainant submits that the Registrant's conduct in continuing to use the Disputed Domain Name after termination of the Participation Agreement is a further indication of registration in bad faith.
34. The Complainant asserts that after registering the domain name, the Registrant entered into a Participation Agreement, dated March 8, 2007, permitting him to use graphics and signs depicting at least some of the **MOBIL** and **MOBIL 1** trade-marks and the **Mobil 1 Lube Express** Mark. After the Participation Agreement had been terminated, on January 26, 2009, on the grounds of violation by the Registrant of certain of its terms, the Registrant continued to operate the website to which the domain name *mobil1lubexpress.ca* resolved, at which website the Complainant's trade-marks continued to be prominently displayed in association with lubricants and quick lube services without authorization.
35. The Complainant submits that the Registrant intentionally attempted to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with the Complainant's Marks as to the source, sponsorship, affiliation and endorsement of the Registrant's website, products and services as set out in paragraph 3.5(d) of the Policy, the likelihood of confusion arising from the suggestion on the Registrant's website that the operator of the website continues to offer services sponsored and/or endorsed by the Complainant, and that the Registrant's website and/or physical location are affiliated with the Complainant.
36. The Registrant argues that a representative of the Complainant authorized the Registration of the Disputed Domain Name by the Registrant before he entered into the Participation Agreement.

37. The Panel notes that while the Participation Agreement gave the Registrant certain limited rights to the use of the Complainant's Marks, there is nothing in the Participation Agreement to substantiate that the limited rights granted therein would include the registration of the Disputed Domain Name. It appears to the Panel unlikely that the Complainant would authorize the registration of the Disputed Domain Name to an operator in preference to other operators in the **MOBIL 1 LUBE EXPRESS** program.
38. In addition, the Panel notes that once the Participation Agreement had been terminated, the Registrant's limited right to use of the Complainant's Marks came to an end, unless the Complainant or some other authorized licensee or agent extended the Registrant's right to such use. The Registrant argues that after the cancellation of the Participation Agreement in January of 2009, he and his company kept running the business and using the Disputed Domain Name. He alleges that this was done under a verbal agreement with an entity named Chalmers Fuel, with approval from Imperial Oil. However, the Registrant has failed to produce any documentation of any kind to show what relationship may have existed as between the Complainant or Imperial Oil and Chalmers Fuel, or that Chalmers Fuel had any authority to authorize the use of the Complainant's Marks either in a domain name or otherwise, or the nature of the alleged agreement.
39. For the reasons explained below, the Panel does not find it necessary to make any finding as to which version of the facts to accept as to whether the Complainant did or did not authorize the initial registration of the domain name by the Registrant. In the Panel's view, even if it were to accept that the Registrant had been authorized to register the Disputed Domain Name, this would not affect the Panel's conclusions on the issues of bad faith or legitimate interest. The Panel concludes that the behaviour of the Registrant *subsequent to the date of registration of the Disputed Domain Name, in continuing, after the Participation Agreement was terminated in January, 2009, to operate the website to which the Disputed Domain Name resolved, where the Complainant's trade-marks continued to be prominently displayed in association with lubricants and quick lube services, is sufficient to demonstrate that the Disputed Domain Name was registered and used in bad faith.*

40. There is disagreement between the Complainant and the Registrant concerning offers made by the Registrant to sell the Disputed Domain Name to the Complainant. The Complainant argues that when the Registrant was asked in November in 2008 to transfer the Disputed Domain Name to Imperial Oil, the Registrant indicated that he wanted \$1 million or some other offer from Imperial Oil. The Registrant argues that on a number of occasions he offered to transfer the Disputed Domain Name at no cost but he appears to concede that later he was asking to be paid for it, which lends some further support to the Complainant's submissions regarding registration of the Disputed Domain Name in bad faith.
41. The Complainant points out that the language of paragraph 3.5 of the Policy was amended in version 3.1 to provide that the list of circumstances under which registration in bad faith will be found is *inclusive* rather than *exclusive*, and cites the following passage from *Glen Raven Inc. v. Tomislav Kotarac*, CIRA Decision 173 (2011) where the Panel said:

... This introductory language means that the four expressly specified circumstances of Bad Faith inform a Panel not only of these specific instances, but also by inference of the general nature of the Bad Faith impugned by the Policy. A panel has an obligation to consider whether there is Bad Faith of this general nature though the facts may not fall strictly within the language of the four expressly specified circumstances.

In this connection, the Complainant's evidence shows that the **Mobil 1 Lube Express** Mark was made known in Canada in 2004, and that the **MOBIL1** Marks and the **MOBIL** Marks were registered, used and well known in Canada prior to the registration of the Disputed Domain Name. The Registrant's expression of interest in the program in July, 2006 raises the reasonable inference that he was aware of the **MOBIL**, **MOBIL1** and **Mobil 1 Lube Express** Marks when he registered the Disputed Domain Name in November 2006.

42. The Panel finds that the Registrant registered the domain name *mobillubexpress.ca* in bad faith within the meaning of the Policy.

(c) Legitimate Interest

43. Paragraph 3.4 of the Policy lists six sets of circumstances which, in particular but without limitation, shall demonstrate that the Registrant has a legitimate interest in a domain name. Paragraph 4.1 of the Policy sets out the onus of proof a Complainant must meet in order to succeed in the complaint. While the onus with respect to confusing similarity and to registration in bad faith is proof on a balance of probabilities, with regard to the issue of legitimate interest, the Complainant must provide only “some evidence” that the Registrant has no legitimate interest in the domain name.

44. Clearly, none of the circumstances described in subparagraphs 3.4 (c), (d), (e) and (h) apply in this case. However, it is necessary to consider whether subparagraph (a) or (b) applies. These subparagraphs read:

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:

(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, performances of the services or operation of the business; or (iii) the place of origin of the wares, services or business; ...

45. With regard to paragraph 3.4(a) the Panel has already concluded that the Registrant used the Disputed Domain Name in bad faith. Further, the evidence submitted by the Complainant shows that by notice on January 26, 2009, the Participation Agreement was terminated, so that to the extent that the Agreement provided certain specified rights to the Registrant to use the Complainant’s Marks, those rights came to an end when the Agreement was terminated.

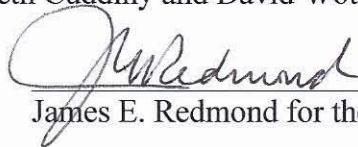
46. The Registrant argues that after the Participation Agreement was cancelled, he attempted, unsuccessfully, to enter into a direct contract with Imperial Oil and that he then entered into a verbal agreement with “Chalmers Fuel”, and that he continued operating his business until November 3, 2010 at which time the business closed. However, as set out in paragraph 38 above, the Registrant has produced no documentation or corroboration to show the existence of such an agreement, what such agreement contained, or that Chalmers Fuel had any authority whatever to authorize him to use the Complainant’s Marks.
47. The Panel concludes that the Registrant has failed to satisfy the onus of proof upon him to demonstrate that he has a legitimate interest in the Disputed Domain Name. The lack of any legitimate interest in the Disputed Domain Name is further illustrated by the fact that the Registrant at one point offered to sell the domain name to Imperial Oil, for a price of \$1 million, and that after the business had been shut down, the website to which the Disputed Domain Name resolved contained for some period of time an offer to sell the domain name.

Decision and Order

48. The Panel finds, for the reasons given above, that the Complaint is successful, and it is ordered and directed that the registration of the Disputed Domain Name be transferred to the Complainant.


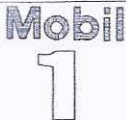




Dated this 15 day of August, 2012.

James E. Redmond (Chair), Elizabeth Cuddihy and David Wotherspoon



James E. Redmond for the Panel

Appendix A

Trade-Mark	Registration Number	Wares and Services
Mobil  Lube Express	TMA782,910	Lubricating services for automobiles
MOBIL 1	TMA228,832	Synthesized engine lubricant
 (colour claimed as a feature of the mark)	TMA230,291	Synthesized engine lubricant
 Mobil 	TMA811,364	Synthetic motor oils
 Mobil  (colour claimed as a feature of the mark)	TMA811,355	Synthetic motor oils
MOBIL	UCA7308	Lubricating oils and greases
Mobil	TMA337,229	Automatic transmission fluid; brake fluid; circulating oil, engine oil, greases, lubricating oil, machinery oil, metal processing oil, motor oil, top cylinder lubricant; travel maps, travel guides.