

**CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

DECISION

Domain Name: amextravel.ca

Complainant: American Express Marketing & Development Corp.

Registrant: Interex Corporate Registration Services Inc.

Registrar: Burmac Business Systems Ltd.

Service Provider: Resolution Canada Inc.

Panelists: David Allsebrook (Chair), Teresa Scassa, Eric Macramalla

A. THE PARTIES

1. The Complainant is American Express Marketing & Development Corp. (the “Complainant”).
2. The Registrant is Interex Corporate Registration Services Inc. (the “Registrant”).

B. DISPUTED DOMAIN NAME & REGISTRAR

3. The disputed domain name is amextravel.ca (the “Domain Name”) and the Registrar is Burmac Business Systems Ltd.

C. PROCEDURAL HISTORY

4. This is a dispute resolution proceeding initiated pursuant to the *CIRA Domain Name Dispute Resolution Policy* (the “Policy”) and the *CIRA Policies, Rules, and Procedures - CIRA Domain Name Dispute Resolution Rules* (the “Rules”). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of this dispute pursuant to the Policy and the Rules.
5. The Complainant filed its complaint (the “Complaint”) on December 5, 2013. The Date of Commencement of the proceeding was December 6, 2013.
6. The Registrant’s Response was issued December 27, 2013.
7. On January 17, 2014, the Panel was appointed. As prescribed by the Policy, the Panel has declared to the Provider that it can act impartially and independently in connection with this matter, and that there are no circumstances known to the Panel which would prevent it from so acting.

D. CANADIAN PRESENCE REQUIREMENTS: ELIGIBILITY OF THE COMPLAINANT

8. In order to make a complaint under the Policy a complainant must satisfy the Canadian Presence Requirements on the day that the complaint is submitted. (Policy, s. 1.4). These Requirements are met where a person who does not meet any of the requirements on ss.2(a) to s2.(p) meets the requirement in section 2(q),

namely that it “is the owner of a trade-mark which is the subject of a registration under the Trade-Marks Act (Canada) R.S.C. 1985, c.T-13 as amended from time to time, but in this case such permission is limited to an application to register a .ca domain name consisting of or including the exact word component of that registered trade mark.” Section 2 states that only the individuals and entities meeting the criteria set out in subsections 2(a) to (r) will be permitted to apply for, hold and maintain the registration of .ca domain names.

9. The Complainant is a Delaware Corporation having its head office in New York, New York.
10. The Complainant is the owner of Canadian registrations for the trade-marks AMEX (Registration No. TMA329413 issued in 1987 and Registration No. TMA464549 issued in 1996) and AMEX TRAVEL ASSURANCE issued in 2008. The Panel is therefore satisfied that the Complainant is eligible to initiate these proceedings.

The Panel concludes that the Complainant does not meet any of the eligibility criteria in ss. 2(a) to (p). The Complainant does meet the eligibility criteria in ss. 2(q). It is the owner of the registered trade mark AMEX, which is included in the domain name in issue, amextravel.ca.

11. The Panel is of the view that the Complaint meets the Canadian Presence Requirements.

E. THE POSITIONS OF THE PARTIES

The Complainant’s Position

12. The Complainant provides a description of its business worldwide and alleges that AMEX has become a famous trade mark around the world. For example it says that it has 97 million holders of credit and other cards worldwide and that its web site at americanexpress.com receives over 60 million visits each month. There is no specificity about activity or reputation in Canada.
13. The Complainant relies upon its three trade mark registrations named above to support its allegation that the domain name is confusingly similar to marks in which the Complainant had rights at the time the domain name was registered and continues to have rights.
14. The Complainant asserts that amextravel.ca was registered in bad faith. It relies upon the totality of the Registrant’s conduct as well as the specific examples of bad faith set out in paragraphs 3.5(b), (c) and (d) of the Policy.
15. The Complaint states the Registrant does not have a legitimate interest in the domain name.
16. The Complainant is seeking the transfer of the Domain Name.

The Registrant's Position

17. The Registrant states that it is the “nominal registrant” and that it manages the registration for its client, whom it does not name. The final words of its submission, which appear beside the signature of Daniel Mullen on behalf of Interex Corporate Registration Services Inc., are “Privacy Protected User”. The Registrant relies on the registration in 2006 and subsequent use unchallenged by the Complainant of the business name Amex Travel by “an entity”. The Registrant’s statement that neither it nor Amex Travel has received communications of any sort from the Complainant prior this Complaint suggests that Amex Travel is the client. No details of the use are given.
18. The Registrant challenges the applicability of the Policy by characterizing it as lesser source of law than the Trade-Marks Act. The Policy applies because Registrants agree to its application as a condition of domain name registration. It is the law between the parties.
19. The Registrant challenges the validity of the Complainant’s trade mark registrations on a number of grounds inspired by concepts derived from the Trade-Marks Act. However the Trade-Marks Act provides that the validity and scope of trade mark registrations is to be determined exclusively by the Federal Court:

“57. (1) The Federal Court has exclusive original jurisdiction, on the application of the Registrar or of any person interested, to order that any entry in the register be struck out or amended on the ground that at the date of the application the entry as it appears on the register does not accurately express or define the existing rights of the person appearing to be the registered owner of the mark.”
20. The Registrant challenges the extent to which the Complainant has used the trade mark in Canada. To the extent that it affects the accuracy of the trade mark registrations, the extent of use is a matter for the Federal Court.
21. The Registrant challenges the terms of the Policy itself, such as the scope of the confusingly similar and test and the Canadian Presence Requirements. Acceptance of the wording of the Policy is part of the terms to which the Registrant agreed when it registered its domain name. This Panel has no authority to revise the Policy.
22. The Registrant challenges the good faith of the Complainant on the basis that the domain name amextravelassurance.ca was registered in 2008 to a company apparently related to the Complainant, American Express Canada Inc., which company was dissolved eleven years earlier in 1997. This incident is too remote from the Registrant and this Complaint to have any relevance.
23. The Registrant states that it did not register the domain name to disrupt the Complainant’s business as contemplated by ss. 3.5(c) of the Policy or to create confusion as contemplated by ss. 3.5(d) of the policy.

24. The domain name resolves to a Google powered web site featuring links to travel insurance advertisements placed by Google customers and links which appear on the site in response to searches conducted by users who reach the site. The Registrant attributes the presence of the links on its web site to these actions of others.

F. DISCUSSION & REASONS

25. In accordance with paragraph 4.1 of the Policy, to succeed in this proceeding, the Complainant must prove, on a balance of probabilities, that:

(a) the Registrant's 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 of the Policy;

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 of the Policy.

CONFUSINGLY SIMILAR - PARAGRAPH 3.3

26. In order to satisfy this branch of the test, the Complainant must demonstrate (i) that it has rights in a mark, (ii) that the rights in its mark predate the registration date of the Domain Name, and (iii) that the Domain Name is confusingly similar with the disputed domain name.

27. The Complainant is the owner of Canadian registrations for the trade-marks AMEX (Registration No. Reg. No. TMA329413 issued in 1987 and Registration No. TMA464549 issued in 1996) and AMEX TRAVEL ASSURANCE issued in 2008. The registrations are still in force. These Complainant's Registered Marks were registered in Canada before the Disputed Domain Name was registered on February 17 2010.

28. As per paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if the domain name so nearly resembles the mark in appearance, sound or in the ideas suggested by the mark so as to be likely to be mistaken for the mark.

29. Pursuant to paragraph 1.2 of the Policy, a domain name is defined as the second level domain (the portion that immediately precedes the dot-ca suffix).

30. The test to be applied when considering "confusingly similar" is one of first impression and imperfect recollection. The Complainant must prove, on a balance

of probabilities, that a person, as a matter of first impression, knowing the Complainant's corresponding marks only, and having an imperfect recollection of the marks, would likely mistake the Domain Name for the Complainant's marks based upon the appearance, sound or the ideas suggested by the mark.

31. The Domain Name begins with "amex", which is a coined word, and which is inherently distinctive. The wholesale inclusion of the trade mark in the domain name is sufficient to establish confusing similarity. *Carey International, Inc. v. Fabio Simonetti*, 2013 CIRA-241 <careymontreal.ca>. The presence of the additional generic word "travel" in amextravel.ca will not lessen the likelihood of confusion.
32. The Panel finds that the Domain Name is confusingly similar with the AMEX Trade-mark in which the Complainant had rights prior to the registration date of the Domain Name, and continues to have such rights.

BAD FAITH REGISTRATION

33. The Complainant has alleged that the Domain Name was registered in bad faith.
34. As defined in section 3.5 of the current Policy, version 1.3, four examples of bad faith are given but it is not necessary to fall precisely within one or more of them to establish bad faith.
35. The domain name resolves to a click-through advertising site. By their nature these sights are dynamically populated with links which reflect the interests of the users who reach the site and use it to search and click through to other sites on the Internet. They are thus adapted to reflect the interests of the users. If users reach the site influenced by the reputation of the AMEX trade mark in the amextravel.ca domain name the site is adapted to reflect that through the links generated as a result of user choices. The links here clearly reflect the influence of the goodwill of the Complainant's trade mark. Because each user click generates advertising revenue for the owner of the domain name, the owner has a mechanism to profit from the users who reach the site.
36. The Registrant says that it is the users whose choices determine which links are included on the page. The links include "AmEx Travel Insurance" and "American Express Business Card". The other seven links are generic terms which include the word "travel". The Registrant attributes the presence of some of the travel and insurance links to searches conducted by the Complainant. In the Panel's view the bad faith lies in creating a trap to capture and profit from the goodwill of others. It is not necessary for anyone to fall into it for bad faith to be established. The degree of parasitism may be small in respect of any one domain name (the Registrant says there have been seven visitors) but this practice is capable of being used on a large scale with many domain names, a practice called click farming. The amextravel.ca domain name is part of this parasitic trade. The use of click through advertising pages with domain names incorporating famous brands

is an established basis on which domain name dispute resolution panels have found bad faith.

37. The Registrant also provides a list of businesses apparently unrelated to the Complainant whose names begin with AMEX. In the absence of a Federal Court ruling that use of these names has rendered the Complainant's trade mark registrations invalid, the list only suggests that the trap laid by the Registrant may also catch customers of other Amex businesses. Bad faith in relation to others than the Complainant is nonetheless bad faith.
38. The Panel finds that the Complainant has established bad faith as per paragraph 3.5(d).

LEGITIMATE INTEREST

39. The final element to determine is whether the Registrant has a legitimate interest in the Domain Name.
40. As per paragraph 4.1 of the Policy, the Complainant must provide "some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.6".
41. Once this onus has been discharged by the Complainant, the Registrant may still succeed if it can show, on a balance of probabilities, that it has a legitimate interest in the Domain Name pursuant to paragraph 3.4.
42. The Panel is of the view the Complainant has discharged its onus of showing some evidence of a lack of legitimate interest by showing the use of the domain name in the click farming scheme described above. The only apparent purpose of the web page to which the domain name resolves is to grasp the attention of people seeking Amex. It has thus put the onus on the Registrant to demonstrate a legitimate interest in the domain name.
44. The Registrant has not attempted to assert any interest in the domain name. On the contrary, it says it administers it for a client whom it does not name. It has therefore failed to discharge its onus.
45. The Panel finds that the Registrant does not have a legitimate interest in the Domain Name.

DECISION & ORDER

46. For the reasons set out herein, the Panel decides this dispute in favour of the Complainant.
47. Pursuant to paragraph 4.3 of the Policy, the Panel orders the transfer of the domain name amextravel.ca.

Dated at Toronto, Ontario, Canada, this 4th day of February, 2014.

David Allsebrook (Chair), Teresa Scassa and Eric Macramalla

A handwritten signature in black ink, appearing to read "David Allsebrook", with a long horizontal flourish extending to the right.

David Allsebrook (Chair) for the panel