

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

Domain Name: terminix.ca
Complainant: The Terminix International Company Limited Partnership
Registrant: Eric Dagenais
Registrar: Tucows.com Co.
Panellist: Sharon Groom
Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant, The Terminix International Company Limited Partnership, is a limited partnership registered in Delaware and resident in Memphis, Tennessee, United States.
2. The Registrant for the domain name is Eric Dagenais located in Lemoyne, Quebec, Canada.

B. The Domain Name and Registrar

3. The disputed domain name is terminix.ca. The Registrar for this domain name is Tucows.com Co.. The disputed domain name terminix.ca was registered on November 17, 2006.

C. Procedural History

4. This is a proceeding under the Canadian Internet Registration Authority (“CIRA”) *Domain Name Dispute Resolution Policy* (Version 1.3) (the “Policy”) and the CIRA *Domain Name Dispute Resolution Rules* (Version 1.5) (the “Rules”).
5. The history of the proceeding as provided by the dispute resolution provider, Resolution Canada, Inc., is that the Complainant filed a complaint against the Registrant with Resolution Canada, Inc. requesting that the current registration of the domain name terminix.ca be transferred to The Terminix International Company Limited Partnership. The complaint was dated September 16, 2016.

6. Resolution Canada, Inc. served notice of the complaint on the Registrant as required by paragraph 4.3 of the Rules. Service of the complaint was made by email on October 6, 2016.

7. The Registrant was given 20 days to file a response and no response was filed. As the complaint received no response, the case was remitted to one panellist.

8. After reviewing the complaint the panellist had a question regarding the identity of the Complainant and so on November 16, 2016 requested, pursuant to section 11.1 of the Rules, that the Complainant provide, within 5 days, evidence confirming how the Complainant was related to the owner of the trademarks referred to in the Complainant's evidence. On November 21, 2016 the Complainant provided such further submissions confirming that the full name of the Complainant was The Terminix International Company Limited Partnership, which was the same as the registered owner of the trademarks referred to in the evidence.

D. Panellist Impartiality and Independence

9. As required by paragraph 7 of the Rules, the panellist has submitted to Resolution Canada, Inc. a declaration of impartiality and independence in relation to this dispute.

E. Canadian Presence Requirements

10. The Complainant, The Terminix International Company Limited Partnership, is a limited partnership registered in Delaware, United States. It claims that it satisfies the Canadian Presence Requirements under paragraph 2(q) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3, because it owns a Canadian trademark registration for the mark TERMINIX, registration no. 334,905 registered in 1987 and TERMINIX, registration no. 678,453 registered in 2006. As these marks, which are owned by the Complainant, are both identical to the domain name which is the subject of this dispute, I find that the Complainant has satisfied the Canadian Presence Requirements.

F. Factual Background

11. The Complainant provides pest control services and claims to have provided such services in Canada since at least as early as 1982. The Complainant has registered the mark TERMINIX in Canada, the earliest one filed in 1985 and registered in 1987, and continues to use this mark in Canada. The Complainant provided evidence of such use taken from the website www.terminix.com/Canada/. The Complainant also submits that "terminix" is a fanciful term and has no other connotation other than as a source identifier for the services provided by the Complainant.

12. The disputed domain name terminix.ca was registered on November 17, 2006 and according to the Complainant resolves to a website for a company called Cyberwiz Marketing. Copies of pages from this website are included in the evidence and the site appears to promote pay per click website services as well as other internet marketing options, which the Complainant admits do not compete with the Complainant's business. However, the Complainant submits that the Registrant is associated with a competitor of the Complainant as the Complainant found another

website, <http://insectestech.com>, which offers pest control services and the copyright notice on the site states: "CyberwizMarketing ©. All Rights Reserved."

G. CIRA Domain Name Dispute Resolution Policy

13. Paragraph 4.1 of the Policy requires that the Complainant establish 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;
- (b) the Registrant has registered the domain name in bad faith as described in section 3.5; and
- (c) the Registrant has no legitimate interest in the domain name as described in section 3.4.

14. The Complainant must establish points (a) and (b) above on the balance of probabilities and for point (c) it must provide some evidence that the Registrant has no legitimate interest in the domain name. 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 section 3.4.

H. Analysis

Rights to a Mark

15. Under paragraph 3.1(a) of the Policy, the Complainant has to show that it had rights (and continues to have these rights) in a mark that was confusingly similar to the domain name, prior to the date of registration of the disputed domain name.

16. The domain name was registered on November 17, 2006, therefore this is the relevant date for this analysis.

17. The Complainant has submitted evidence of its registrations for the mark TERMINIX, the earliest of which was registered in 1987, well before the Registrant's registration date. The Complainant has therefore established that it has rights in a Mark that predate the registration date of the domain name. The Complainant has also submitted evidence from its website indicating that it continues to use the mark TERMINIX in Canada.

18. The Complainant has therefore established rights in the mark TERMINIX since prior to November 17, 2006, and has demonstrated that it continues to have these rights. The question then becomes whether this mark is confusingly similar to the domain name terminix.ca. The test for this is whether the domain name in question so nearly resembles the mark in appearance, sound or in the ideas suggested by it as to be likely to be mistaken for the mark.

19. In this case the domain name consists of the entire mark TERMINIX, and it is well established that the addition of the .ca suffix should be excluded from consideration in making the determination of potential confusion. I therefore find that the domain name does so nearly resemble the mark in appearance, sound and in the idea suggested by it so as to be likely to be mistaken for the Complainant's mark. Therefore the Complainant has established, on a balance of probabilities, the facts required to support the requirements of paragraph 4.1(a) of the Policy.

Bad Faith

20. The Complainant has to show, on the balance of probabilities, that the domain name was registered in bad faith. Paragraph 3.5 deals with the grounds which constitute bad faith and it must be noted that these are not exhaustive; it is open to the panel to find other grounds which lead to a conclusion of bad faith conduct.

21. The Complainant argues that the Registrant's conduct constitutes bad faith under paragraph 3.5(c) or 3.5(d). These subsections are reproduced below:

(c) the Registrant registered the domain name or acquired the Registration 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;

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

22. The Complainant has presented evidence which indicates that the Registrant is associated with another website which offers services that compete with those of the Complainant. It is not clear how the Registrant is involved, but the fact that it is listed as the owner of the copyright on that site implies that it has a commercial interest in the website. The Complainant has also demonstrated that it registered the mark TERMINIX 19 years before the Registrant registered the domain name and that the word TERMINIX is a fanciful term that does not have any other meaning. If one considers all this evidence together, then it appears likely that the Registrant has registered the domain name terminix.ca primarily for the purpose of disrupting the business of the Complainant, who is a competitor of the Registrant in that the Registrant is associated with a website that offers competing services.

23. I With regard to section 3.5(d), the fact that the Registrant has registered terminix.ca does not attract Internet users to the website <http://insectestech.com> as there are no links between the sites. It is also unlikely that the Registrant would try and use the potential confusion with the TERMINIX mark owned by the Complainant to attract users to terminix.ca where it promotes its marketing services, as potential purchasers of those services would not logically search TERMINIX in order to find such services. Therefore, on the balance of probabilities, I do not find that the Complainant has demonstrated bad faith pursuant to section 3.5(d).

24. I therefore find that the Complainant has demonstrated, on the balance of probabilities, that the Registrant has registered this domain name for the purpose of disrupting the business of the Complainant, who appears to be a competitor of the Registrant, and that this use therefore constitutes evidence of bad faith under paragraph 3.5(c).

Legitimate Interest

25. In order to succeed the Complainant has to provide some evidence that the Registrant does not have a legitimate interest in the domain name. Paragraph 3.4 lists six possible ways in which a Registrant may have a legitimate interest in a domain name which are as follows:

- (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, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;
- (c) the Registrant registered 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.

This list is not exhaustive as it is said to be "without limitation". Therefore neither party is bound by only those criteria.

26. In addressing the subject of legitimate interest the Complainant points out that the Registrant is not affiliated with or related to the Complainant, nor has the Complainant licensed the Registrant to use this mark in Canada. Therefore there can be no legitimate interest under subsection (a). The term TERMINIX is not clearly descriptive as referred to in subsection (b), but rather is a fanciful term used by the Complainant. It is not a generic term nor has the Registrant used it for a non-commercial activity including, criticism, review or news reporting, so subsections (c) and (d) are not applicable. Finally, the domain name is not the name of the Registrant nor is it the name of a geographic place, therefore subsections (e) and (f) do not apply

either. I therefore find that the Complainant has provided some evidence that the Registrant does not have a legitimate interest in the domain name.

27. The Registrant has not rebutted this evidence with any evidence of its own, therefore it has not shown, on the balance of probabilities, that it has a legitimate interest in the domain name.

28. Therefore, I find that the Complainant has presented some evidence that the Registrant does not have a legitimate interest in the domain name, which has not been rebutted by the Registrant.

I. Conclusion and Decision

29. In conclusion, I find that the Complainant has rights in the mark TERMINIX which predate the registration of the domain name. I also find that the domain name is confusingly similar to the Complainant's mark, that the Registrant registered the domain name in bad faith and that the Registrant has no legitimate interest in the domain name.

30. I therefore order, pursuant to paragraph 4.3 of the Policy, that the registration of the domain name terminix.ca be transferred to the Complainant, The Terminix International Company Limited Partnership.

Dated November 23, 2016

A handwritten signature in black ink, appearing to read "Sharon Groom", written over a horizontal line.

By: Sharon Groom (Sole panellist)