

**In the Matter of the administrative proceeding of a Complaint pursuant to the
Canadian Internet Registration Authority (“CIRA”) Domain Name Dispute
Resolution Policy**

Disputed Domain Name: **mailchimp.ca**

Complainant: The Rocket Science Group LLC dba Mailchimp

Complainant’s Authorized Representative: Ms. Erin Creber, Gowling WLG (Canada) LLP 160
Elgin Street, Suite 2600 Ottawa, Ontario Canada K1P 1C3

Registrant: Mr. Albert S. Bitton, 1 Main, Toronto, ON, M5G 2C2

Registrar: Tucows.com Co.

Panel: Mr. Richard S. Levy

Service Provider: Resolution Canada Inc.

1.0. PROCEDURAL HISTORY

1. Resolution Canada Inc. is a recognized service provider pursuant to the Domain Name Dispute Resolution Policy (v 1.3) (the “Policy”) and Rules (the “Rules”) of the Canadian Internet Registration Authority (“CIRA”).
2. The Complainant filed a complaint (the “Complaint”) with Resolution Canada. In the Complaint, the Complainant seeks an order in accordance with the Policy and the Rules directing that the registrations of the Domain Name be transferred from the Registrant to the Complainant.
3. Resolution Canada determined the Complaint to be in administrative compliance with the requirements of Rule 3.2 and, by way of an emailed letter (the “Transmittal Letter”), forwarded a copy of the Complaint to the Registrant. The Transmittal Letter determined the date of the commencement of proceedings.
4. By an email, Resolution Canada advised the parties that, as Resolution Canada had not received a Response to the Transmittal Letter by the due date, as required by Rule 5.1, the Complainant had the right to elect that the panel in this matter be converted from a three-member panel to a single member panel, pursuant to Rule 6.5. In a responding email the Complainant advised Resolution Canada that it wished to exercise this right and to have a single member panel appointed.
5. The undersigned was appointed by Resolution Canada as the Single Member Panel by letter dated January 24, 2022, copies of which letter were sent by email to both the Complainant and the Registrant. The undersigned has confirmed to Resolution Canada that he can act impartially and independently as the Single Member Panel in this matter.
6. The undersigned determines that he has been properly appointed and constituted as the Single Member Panel to determine the Complaint in accordance with the Rules.

2.0. CANADIAN PRESENCE AND TECHNICAL REQUIREMENTS

7. Section 1.4 of the Policy requires that in order to initiate the Complaint, the Complainant, at the time of the initiation of the Complaint, must satisfy *the Canadian Presence Requirements for Registrants*, version 1.3 (“CPR.”).
8. The evidence before the Panel is that the Complainant is the owner of two Canadian trademark registrations for the mark MAILCHIMP, which fulfills the requirements of paragraph 2(q) of the CPR. The Panel therefore determines that the Complainant has satisfied the provisions of section 1.4 of the Policy.
9. Based upon the information provided by Resolution Canada and the Complainant in the Complaint, the Panel finds that all technical requirements for the prosecution of this proceeding have been met.

3.0. FACTS ALLEGED BY THE COMPLAINANT

(i) The Complainant’s Business and its Trademarks

10. The Complainant was founded in 2001 and is headquartered in Atlanta, GA, USA. It also has locations in Brooklyn, NY, USA, Oakland, CA, USA and Vancouver, BC, Canada.
11. While the Complainant began as an email marketing tool, it has grown to become an incredibly successful all-in-one marketing platform, offering goods and services primarily directed to small businesses to assist them with the advertising, promotion and marketing of their business. For example, in 2014, the Complainant was sending over 10 billion emails per month on behalf of its users and, in 2016, it was ranked number 7 on the Forbes Cloud 100 list, which recognizes the top 100 private cloud companies in the world.
12. The Complainant offers its MAILCHIMP branded goods and services through its website located at www.mailchimp.com.
13. The Complainant’s www.mailchimp.com website has been accessible to Canadians since at least as early as July 2001. At all times, the MAILCHIMP trademark has been prominently displayed on the Complainant’s www.mailchimp.com website.
14. Over the years, there have been a significant number of Canadian users of the Complainant’s MAILCHIMP branded goods and services. An analysis of the Complainant’s current customers located in Canada indicates that nearly 1,100 such customers began using the MAILCHIMP branded goods and services prior to October 11, 2009.
15. The Complainant has also advertised its MAILCHIMP branded goods and services extensively within Canada and to Canadian customers. As one example, a method that the Complainant uses to advertise its MAILCHIMP branded goods and services in Canada is through Google Ads. In the period 2007 to 2009, the Complainant spent over \$60,000 on various Google Ad campaigns, which accumulated over 21,000 clicks.
16. In addition to its website, the Complainant also actively promotes its business and the goods and services offered in association with the MAILCHIMP mark through social

media platforms, to which Canadians have been able to access at all relevant times, i.e., Twitter, Facebook, and YouTube.

17. In Canada, the Complainant owns the following registrations for MAILCHIMP:
 - a. Canadian Trademark Registration No. TMA931093 for MAILCHIMP, filed on July 23, 2014, issued on March 9, 2016 and used in Canada since at least as early as August 20, 2001; and
 - b. Canadian Trademark Registration No. TMA1089181 for MAILCHIMP, filed on October 25, 2017, issued on December 4, 2020 and used in Canada since at least as early as August 20, 2001.

(ii) The Registrant's Unauthorized Activities

18. Without the permission of the Complainant, the Registrant registered the Domain Name on October 11, 2009.
19. The Domain Name currently resolves to the website:
<https://canadiandealsandcouponsassociation.org/> (the "CDCA Website").
20. The webpage that users are presented with when they click on the "Subscribe Right Now" link at the bottom of the CDCA Website homepage displays a logo, which is a trademark of the Complainant.
21. When a user clicks on the Complainant's logo, they are sent directly to the Complainant's www.mailchimp.com website.
22. The Registrant is a serial cyber-squatter in that the Registrant has registered numerous unauthorized dot-ca domain name registrations that are comprised of, contain, or are confusing with third party trademarks to which he does not appear entitled. A listing of these domain names is set out in the Complaint with a sample listing of third party trademarks and registrations corresponding to these unauthorized domain name registrations:
23. A number of the above-noted domain names (grouponcanada.ca, hautelook.ca, savearound.ca, shopkick.ca and verticalresponse.ca) also currently resolve to the CDCA Website.
24. The Registrant is identified as the "Founder" of the Canadian Deals and Coupons Association on his LinkedIn Profile.
25. The Complainant seeks an order from the Panel in accordance with paragraph 4.3 of the Policy instructing the Registrar of the Domain Name to transfer it to the Complainant.

3.1. FACTS ALLEGED BY THE REGISTRANT

26. As was noted above, the Registrant has not filed a Response.

4.0. ELEMENTS OF PROOF AND ONUS

27. In accordance with paragraph 4.1 of the Policy, 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.

28. If the Complainant is unable to satisfy this onus, the Complaint fails.

ANALYSIS

5.0. CONFUSINGLY SIMILAR

29. The Complainant submits (i) that it has rights in a mark that predate the registration date of the Domain Name, and (ii) that the Domain Name is confusingly similar with the Complainant's mark.

(i) Rights in the Mark and Rights that Predate the Domain Name Registration Date

30. The Complainant is the owner of numerous trademark registrations comprised of or containing MAILCHIMP and has used MAILCHIMP as a trademark in Canada for nearly 20 years in association with its business.

31. The Complainant's rights in the MAILCHIMP trademark precede the October 11, 2009 registration date of the Domain Name. At the time the Registrant registered the Domain Name, the Complainant had already been offering its MAILCHIMP branded goods and services in Canada for nearly a decade, it had acquired a significant amount of customers located in Canada that it retains today, and it had invested significantly in the advertising of its MAILCHIMP branded goods and services in Canada.

(ii) Confusingly Similar

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

33. 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).

34. In this case, the relevant part of the Domain Name is "mailchimp" which is identical to the Complainant's MAILCHIMP trademark. Accordingly, the Domain Name is confusingly similar with the Complainant's mark given that

the Domain Name so nearly resembles the Complainant's mark in appearance, sound and in ideas suggested as to be likely to be mistaken for it.

6.0 BAD FAITH REGISTRATION

35. Only in rare cases will there be direct evidence of a registration in bad faith. In most cases, as case law attests, such a finding is based on "common sense inferences from the registrant's conduct and other surrounding circumstances."

(i) Pattern of Unauthorized Domain Names Registrations

36. The Registrant appears to have engaged in a pattern of unauthorized domain name registrations containing third party trademarks to which he is not entitled, and has prevented the Complainant from registering the Domain Name.

37. It has been held that as few as two domain name registrations, including the disputed domain name, is sufficient to establish that a registrant has engaged in a "pattern" of abusive registrations. *Yamaha Corporation et al v Yoon, DCA-1020-CIRA* at paras 53-54.

38. The Policy does not impose a temporal limitation on which unauthorized domain name registrations the Complainant may rely upon when establishing a "pattern" of registrations. The Complainant may therefore rely upon domain names previously owned by the Registrant to establish a "pattern".

39. There is evidence of bad faith registration as per paragraph 3.5(b).

(ii) Intentionally Attracts Traffic For Commercial Gain

40. Pursuant to paragraph 3.5(d) of the Policy, bad faith is indicated where the Registrant registered the Domain Name to intentionally attempt 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 source, sponsorship, affiliation, or endorsement.

41. The Domain Name is comprised exclusively of the MAILCHIMP trademark. Under the circumstances, the Domain Name is likely to confuse potential consumers into believing that the Registrant is somehow affiliated with, or endorsed by, the Complainant.

42. The act of resolving the Domain Name to the CDCA Website, in which the Registrant has an interest as the "Founder" of the CDCA, constitutes further evidence of bad faith. The Registrant is using the Domain Name to increase website traffic to the CDCA Website and advance his business interests.

43. The use of the MAILCHIMP logo on the "Subscribe Right Now" webpage on the CDCA Website further creates a likelihood of confusion among consumers.

44. Where a disputed domain name redirects to a third party website, the fact that the third party website may not be offering goods or services that compete with the Complainant will not serve to preclude a finding of bad faith.

45. Accordingly, there is also evidence of bad faith as per paragraph 3.5(d) of the Policy.

(iii) Surrounding Circumstance

46. In view of the long-term use and registration of the Complainant's MAILCHIMP trademark in Canada, the Registrant had actual or constructive knowledge of the Complainant's rights in the Domain Name at the time of registration; this also supports a finding of bad faith registration.

7.0 LEGITIMATE INTEREST

47. Paragraph 4.1 of the Policy requires that to succeed in the Complaint, the Complainant must provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Name "as described in paragraph 3.4".

48. The Complainant states that there is not, and has never been, any relationship between the Complainant and the Registrant, and the Registrant has never been licensed or otherwise authorized to register or use the Complainants MAILCHIMP trademark in any manner whatsoever, including as part of a domain name.

49. There is no evidence presented that, with reference to paragraph 3.4, the Registrant had rights in the Mark, that the Disputed Domain Name was clearly descriptive or that it was a generic name, that it was used in association with a non-commercial activity, e.g., criticism, review or news reporting, that it comprised a reference by which the Registrant was commonly identified, or that it was the geographical name of the location of the Registrant's business.

50. The Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name.

6.0. DECISION AND ORDER

51. The Panel therefore finds that the Complainant has satisfied the onus placed upon it by paragraph 4.1 of the Policy and is entitled to the remedy sought by it.

52. The Panel orders that the Domain Name **mailchimp.ca** be transferred to the Complainant.

Dated: January 25, 2022



Signed: Richard S. Levy