

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

Domain Name: JOB-NEWEGG.CA

Complainant: Newegg, Inc.

Registrant: Mimi Mimi

Registrar: Namecheap, Inc.

Panelist: Teresa Scassa

Service Provider: Resolution Canada, Inc.

DECISION

A. The Parties

1. The Complainant in this matter is Newegg, Inc., a U.S.-based company incorporated in the state of Delaware in 2005.
2. The Registrant for the domain name is listed as Mimi Mimi, with an address in Lagos, Nigeria.

B. The Domain Name and Registrar

3. The disputed domain name is <job-newegg.ca> (the Domain Name). The Registrar for the Domain Name is Namecheap, Inc. The Domain Name was registered on October 10, 2019.

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).
5. The history of the proceeding, according to information provided by the dispute resolution provider, Resolution Canada, Inc. (the Provider), is as follows:

- The Complainant filed a complaint against the Registrant with Resolution Canada, Inc. on November 18, 2019, requesting that the current registration of the domain name <job-newegg.ca> be transferred to Newegg, Inc.
- On November 22, 2019, Resolution Canada served notice of the Complaint to the Registrant as required by paragraph 4.3 of the *CIRA Domain Name Dispute Resolution Rules*. An amended Notice of Complaint, correcting an error as to the name of the Registrant, was sent to the Registrant on November 29, 2019. The Notice of Complaint informed the Registrant that they had 20 days from November 22, 2019 to respond to the complaint. No response was filed by the Registrant.
- The Complainant elected to proceed before a panel consisting of only one panelist.
- The notice of the selection of the sole panelist was sent to the Complainant and the Registrant by email on January 8, 2020.

D. Panelist Impartiality and Independence

6. As required by paragraph 7 of the *Rules* I have submitted to the Provider a declaration of impartiality and independence in relation to this dispute.

E. Eligibility

7. The Complainant, Newegg, Inc., is a company incorporated under the laws of Delaware in the United States. It holds the Canadian trademark registration for NEWEGG (TMA1337825), for use with respect to online retail store services relating to computer and computer-related equipment. This mark was registered on August 13, 2009. It also holds a number of different Canadian trademark registrations for its logo, which consists of a combination of a three-egg design featuring the word NEWEGG.COM. The Complainant also holds similar trademarks for the word NEWEGG and for the word and design logo in the United States and in several other countries. The Canadian trademark registration for NEWEGG means that Newegg Inc. is eligible, under Paragraph 1.4 of the *Policy*, to bring this complaint.

F. Factual Background

8. The Complainant describes itself as “an online retailer that offers products and services for sale in eighty countries through the mobile applications and websites that it owns and operates, including, but not limited to, the Newegg.com website and the Newegg.ca website.” As noted above, it holds registered trademarks in several countries, including Canada, for NEWEGG, for its logo, and for other NEWEGG-derived trademarks. The Complainant states that it has used its trademarks extensively since 2001 and that it has generated substantial sales from its activities under those marks.

9. The Registrant registered the domain name <job-newegg.ca> on October 10, 2019. Because the Registrant did not respond to the complaint there is no information from the Registrant regarding its activities.

10. The Complainant alleges that the Registrant has used the domain name as part of a “job phishing scam”. The Complainant provided screen shots of a website to which the domain name resolved. This site featured a photograph of workers in a cubicled work environment and is overlaid with the Newegg logo. In small print below the photograph is the heading “Career Opportunities” as well as a means by which a site visitor can commence to make a job application.

11. The Complainant alleges that it was contacted by individuals who had learned of a job opportunity at Newegg through a LinkedIn post which directed them to the website at <job-newegg.ca> to fill in an application. The Complainant provided screenshots of the LinkedIn page containing the false job posting. It also submitted documents provided to it by an affected individual. These documents include a job offer emailed to an individual who had applied for the posted position and who had been interviewed online. The job offer asked the individual to send clear front and back pictures of a government issued ID document, a proof of address document such as a utility bill or bank statement, and a copy of a cheque from their bank account. The email job offer also came with a PDF employment contract that featured the Newegg trademarked logo. The Complainant provided a copy of this document.

G. *CIRA Domain Name Dispute Resolution Policy* Requirements

12. Paragraph 3.1 of the *CIRA Domain Name Dispute Resolution Policy* (CDRP) 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 no legitimate interest in the domain name as described in paragraph 3.4; and
- (c) the Registrant has registered the domain name in bad faith as described in paragraph 3.5.

13. According to paragraph 4.1 of the CDRP, the Complainant must establish elements (a) and (b) above on a balance of probabilities. The Complainant must also provide “some evidence” that the Registrant has no legitimate interest in the Domain Name.

H. Analysis

Confusingly Similar

14. The Complainant must first establish that the disputed domain name is confusingly similar to a mark of the Complainant's, and that the Complainant had rights in that mark prior to the date of registration of the Domain Name, and that it continues to have such rights.

15. The Complainant's trademark is NEWEGG and the Domain Name is <job-newegg.ca>. The Complainant's rights in this trademark arose well before the date of registration of the Domain Name, and it continues to have rights in its Mark.

16. According to para. 3.3 of the *Policy*, a domain name is confusingly similar to a mark when it "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." In this case, the Domain Name consists of the Complainant's trademark with "job-" as a prefix. The Complainant's trademark, which is incorporated in its entirety in the Domain Name, is inherently distinctive. In addition, the mark has been in use for many years and has some degree of renown on a global scale. It constitutes the most distinctive part of the domain name. Given the online presence of the Complainant, the addition of "job-" to the trademark, far from eliminating confusing similarity, could enhance it by creating the impression that the website relates to the recruiting practices of the Complainant. The fact that the site appears to have been used precisely to lure unsuspecting job-seekers only reinforces the confusing similarity. As noted in *Kijiji International Limited v. [privacy protected]*, CIRA Dispute No. 1211 (2017), "the Registrant cannot avoid confusion while appropriating the entire mark in the domain name. And, the addition of a descriptive or non-distinctive term (in this case "app") to a domain name does not mitigate against a finding of confusion." I find that the complainant has met its burden of establishing, on a balance of probabilities, that <job-newegg.ca> is confusingly similar with the Complainant's trademark NEWEGG.

Legitimate Interest

17. Under sub-paragraph 4.1(c) of the *Policy*, the Complainant must provide "some evidence" that "the Registrant has no legitimate interest in the domain name". Paragraph 3.6 identifies six circumstances in which a legitimate interest may arise. These are:

- (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.

18. The Complainant has provided "some evidence" of the Registrant's lack of a legitimate interest in the domain name. It is clear that the domain name itself is not a mark of the Registrant, and that the Registrant does not have any rights in the distinctive portion of that domain name, "NEWEGG". As will be discussed below, the Complainant has satisfied its burden of showing on a balance of probabilities that the domain name was registered in bad faith, thus eliminating any potential claims to a legitimate interest under 3.4(b), (c), or (d). In any event, the domain name is neither descriptive or generic in the ways required by 3.4(b) or (c), nor is it used in association with non-commercial activities as per 3.4(d). It is not the name or a common identifier of the Registrant, nor is it the geographical name of the Registrant's place of business.

Bad Faith

19. The exclusive bases for a finding of bad faith registration are set out in subparagraph 3.5 of the *Policy*. The Complainant alleges that, pursuant to paragraph 3.5(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.

20. The evidence provided by the Complainant, which includes screen shots of the landing page for the Domain Name, the false job posting, the false job contract, and the request for sensitive personal information, along with the email correspondence set to Newegg, Inc. by an individual who had applied for the posted false job, all support the conclusion that the disputed domain name was registered in bad faith in order to impersonate the Complainant for the purposes of perpetrating a "job phishing scam". I am satisfied that the Complainant has established on a balance of probabilities that the Domain Name was registered in bad faith. This falls within the category of bad faith described in paragraph 3.5(d).

I. Conclusion and Decision

21. In conclusion, I find that the Complainant has rights in the Mark “NEWEGG”. I find that the disputed domain name is confusingly similar to the Mark, that the Registrant had no legitimate interest in the Mark, and that the domain name was registered in bad faith.

J. Remedy

22. The Domain Name should be transferred to the Complainant in accordance with Paragraph 4.3 of the Policy.

Dated January 15, 2020

Teresa Scassa
January 15, 2020