



**CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE**  
**DOMAIN NAME DISPUTE**  
**ADMINISTRATIVE PANEL**  
**DECISION**

CIIDRC case number:	<b>18331-CDRP</b>	Decision date: October 19, 2022
Domain Name:	<b>xeroxcopier.ca</b>	
Panel:	<b>Douglas M. Isenberg</b>	
Complainant:	<b>Xerox Corporation</b>	
Complainant's representative:	<b>Alastair J. McNish, Chitiz Pathak LLP</b>	
Registrant:	<b>Mark Cataford</b>	

**1. PROCEDURAL HISTORY**

The procedural history of this case was set out in a letter from the Canadian International Internet Dispute Resolution Centre to the Panel, as follows:

“1. On August 26, 2022, Alastair McNish, counsel for Xerox Corporation filed a Complaint pursuant to the CDRP and the Resolution Rules.

“2. On August 26, 2022, CIRA was notified of this proceeding. On August 26, 2022 CIRA transmitted by email to CIIDRC its verification response informing who is the Registrant of the disputed domain name. CIRA also confirmed that the <xeroxcopier.ca> domain name was placed on a Registrar LOCK.

“3. On August 26, 2022, CIIDRC, as Service Provider, confirmed compliance of the Complaint and commencement of the dispute resolution process.

“4. Pursuant to Resolution Rule 4.4, CIIDRC notified the Registrant of this administrative proceeding and forwarded a copy of the complaint and our commencement letter to the Registrant's mailing address.

“5. The Registrant failed to file its response by the due date of September 15, 2022. CIIDRC has received email correspondence from the Registrant, in which he expressed his confusion over the process.

“6. The Complainant in this administrative proceeding has elected for a Panel consisting of a single-member.”

CIIDRC appointed Douglas M. Isenberg as a single-member Panel in this matter on September 29, 2022.

The Domain Name was registered on November 10, 2016.

This matter is conducted pursuant to the Canadian Dispute Resolution Policy (the CDRP) and the Canadian Dispute Resolution Rules (the Resolution Rules) of the Canadian Internet Registry Authority.

## **2. FACTS ALLEGED BY THE PARTIES**

Complainant states that it is “a well-known, arguably the most well-known, brand of photocopiers in the world”; and that it “holds registered trademarks for the word ‘Xerox’ internationally and in Canada,” including Reg. No. TMA699490 (a copy of which was provided with the Complaint, showing a registration date of October 25, 2007, for use in connection with, *inter alia*, “[c]opies of typewritten or printed matter, namely, drawings, maps, or any other records, sold as such, made by an electrophotographic process for use by business/commercial establishments”) (the “XEROX Trademark”).

Complainant states that the Domain Name “directs Internet users to a website that promotes a business offering, ‘Copier Business Solutions serving Canada for all your document management needs.’”

The Registrant did not submit a response.

## **3. CONTENTIONS OF THE PARTIES**

- **Complainant**

Complainant submits that the Domain Name is confusingly similar to the XEROX Trademark because it “resembles the [XEROX Trademark] in appearance, sound or the ideas suggested by the [XEROX Trademark] as to be likely mistaken for the [XEROX Trademark]” and because it “uses the words ‘Xerox’, and ‘copier’ (which is captured in the [goods and services for the XEROX Trademark], and for which the Complainant, owner of the [XEROX Trademark], is commonly known) in a deliberate attempt to be mistaken for the [XEROX Trademark].”

The Complainant further submits that the Registrant has no legitimate interest in the Disputed Domain Name because:

“1. the domain name incorporates the Mark, the Registrant did not use the Mark in good faith, and the Registrant has no rights in the Mark;

“2. the Registrant did not register 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;

“3. the Registrant did not register 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;

“4. the Registrant did not use the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;

“5. the domain name does not and did not comprise the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; and

“6. the domain name is not and was not the geographical name of the location of the Registrant’s non-commercial activity or place of business.”

The Complainant further submits that the Registrant has registered the Domain Name in bad faith because “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”; and because “[t]he Domain Name holds itself out as being part of, or affiliated with, Xerox” since “[i]t has a banner that says ‘Xerox Copier and Printers’ and ‘advertises photocopying and printing services, inviting visitors to contact them at their @xeroxcopier.ca email address, via telephone, or via contact form.’”

- **Registrant**

As stated above, Registrant did not submit a response.

- **Remedy Sought**

Complainant requests the Domain Name be transferred to it.

#### **4. DISCUSSION AND FINDINGS**

##### **4.1 Eligibility**

Complainant is an eligible complainant under paragraph 1.4 of the CDRP, which states: “The person initiating a Proceeding (the ‘Complainant’) must, at the time of submitting a complaint (the ‘Complaint’), satisfy the Canadian Presence Requirements for Registrants (the ‘CPR’) in respect of the domain name that is the subject of the Proceeding unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office (‘CIPO’) and the Complainant is the owner of the trade-mark.” As stated above, Complainant is the owner of CIPO Reg. No. TMA699490 for the XEROX Trademark.

## 4.2 Requirements

In accordance with Paragraph 4.1 of the CDRP, the onus is on the Complainant to prove:

That the Domain Name is Confusingly Similar to a trademark or service mark in which the Complainant has rights:

That the Registrant has no legitimate interests in the Domain Name; and

That the Domain Name has been registered in bad faith.

The Panel will consider each of these requirements in turn.

## 4.3 Analysis

### 4.3.1 That the Domain Name is Confusingly Similar to a Mark in which the Complainant has Rights

With respect to paragraph 3.1(a) of the CDRP, the Panel concludes that Complainant had rights in the XEROX Trademark prior to the date of registration of the Domain Name, as a result of the registration described above.

Paragraph 3.3 of the CDRP states: “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.” It is apparent that the Disputed Domain Name contains the XEROX Trademark in its entirety. “[I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark.” WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 1.7.<sup>1</sup> Further, “[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity.” WIPO Overview 3.0, section 1.8.

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<sup>1</sup> Although WIPO Overview 3.0 addresses the Uniform Domain Name Dispute Resolution Policy (“UDRP”), Paragraph 3.2(l) of the Resolution Rules expressly allows references to “dispute resolution proceedings which apply to domain names registered under any other top level domain which the Complainant considers persuasive.”

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(a) of the CDRP.

#### **4.3.2 That the Registrant has No Legitimate Interest in the Domain Name**

With respect to paragraph 3.1(b) of the CDRP, regarding a lack of legitimate interests, Registrant has not made any attempt to rebut Complainant's allegations or argue that it has a legitimate interest in the Domain Name under any of the six elements described in paragraph 3.4 of the CDRP, nor is there any evidence that demonstrates Registrant has a legitimate interest in the Domain Name. See, e.g., *General Motors LLC v. Tony Wilson*, CIRA Case No. 00182 ("the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name and this evidence has not been rebutted by the Registrant").

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(b) of the CDRP.

#### **4.3.3 That the Registrant has Registered the Domain Name in Bad Faith**

The Panel evaluates whether the Complainant has established that Registrant has registered the Disputed Domain Name in bad faith, as defined by the CDRP. Pursuant to paragraph 3.5 of the CDRP, the following "shall be evidence that a Registrant has registered a domain name in bad faith":

"(a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration;

"(b) the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names;

"(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; or

"(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."

The Panel is persuaded that bad faith exists pursuant to paragraph 3.5(d), given that Registrant has used the Domain Name in connection with a website that, as described by Complainant, “directs Internet users to a website that promotes a business offering, ‘Copier Business Solutions serving Canada for all your document management needs.’” Although Complainant did not include any evidence of this usage in the Complaint, such as by providing a screenshot as is customary in domain name dispute proceedings, Registrant has not rebutted this assertion and the Panel has confirmed Complainant’s description by visiting the website associated with the Domain Name for himself.<sup>2</sup> This usage creates a likelihood of confusion pursuant to paragraph 3.5(d). See, e.g., *Emerson Vulcan Holding LLC v. Dan Thompson*, BCICAC Case No. DCA-2060-CIRA (“the very definition of bad faith” exists where “Registrant is using a domain name comprising a third-party brand to attract web traffic for that brand... for his own commercial gain by creating a likelihood of confusion in the mind of the public as to source, sponsorship, affiliation or endorsement of the Registrant’s website”); and *Birkenstock Sales GmbH v. Vytas Klimavicius/Litamber Media Corporation*, BCICAC Case No. 2246-CIRA (“[t]he Registrant has no business relationship with the Complainant and the Registrant’s website is clearly aiming to profit from an implication that it is a website of the Complainant or an authorized dealer”).

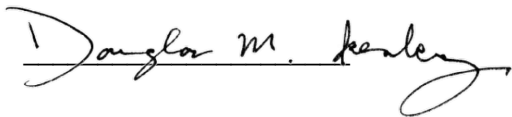
In light of the above, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(c) of the CDRP.

## 5 DECISION and ORDER

For the above reasons, in accordance with Paragraph 4 of the CDRP, Paragraph 12 of the Resolution Rules, the Panel orders that the Domain Name <xeroxcopier.ca> be transferred to Complainant.

Made as of October 19, 2022

SIGNATURE OF PANEL

A handwritten signature in black ink, reading "Douglas M. Kealey". The signature is written in a cursive style and is positioned above a horizontal line.

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<sup>2</sup> As set forth in section 4.8 of WIPO Overview 3.0, “a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision.”