



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

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| CIIDRC case number: | 16133-CDRP | Decision date: October 10, 2021 |
| Domain Name: | <walmartrewards.ca> | |
| Panel: | David L. Kreider | |
| Complainant: | Walmart Apollo, LLC | |
| Complainant's representative: | Antonio Turco of CPST Law LLP | |
| Registrant: | Mike Morgan | |
| Registrar | Namespro Solutions Inc. | |

1. PROCEDURAL HISTORY

The procedural history of this case was set out in a letter dated October 8, 2021, from the Canadian International Internet Dispute Resolution Centre (hereinafter the "**Centre**" or "**CIIDRC**") to the Panel:

On September 13, 2021, Mr. Antonio Turco filed a Complaint on behalf of Walmart Apollo, LLC pursuant to the CIRA Domain Name Dispute Resolution Policy (August 22, 2011) (the "**CDRP**" or "**Policy**") and the CIRA Domain Name Dispute Resolution Rules Version 1.5 (July 28, 2014) (the "**Rules**"). The identity of the Registrant is not published in the public WHOIS database; therefore, the Registrant's name was not included in the Complaint.

CIRA was notified of this proceeding on September 14, 2021, and on the same date, CIRA transmitted by email its verification response informing that Mike Morgan, of Box 276, 130-8191 Westminster Highway, Richmond, British Columbia, Canada V6X1A7, is the Registrant of the disputed domain name. CIRA also confirmed that the <walmartrewards.ca> (the "**Disputed Domain Name**") was placed on a Registrar LOCK.

On September 14, 2021, CIIDRC, as Service Provider, confirmed compliance of the Complaint and commencement of the dispute resolution process.

The Complainant did not file any further submissions with respect to the issue of the Registrant's legitimate interest (or lack thereof) in the Disputed Domain Name, as permitted by section 11.1 of the Rules.

As the Complaint with the attachments was filed exclusively by email, CIIDRC delivered the Complaint to the Registrant only by email to the address provided by CIRA and by Xpress Post.

Pursuant to Resolution Rule 4.4, CIIDRC notified the Registrant of this administrative proceeding and forwarded a Notice of Commencement with a copy of the Complaint to the Registrant on September 14, 2021.

The Registrant failed to file its response by the due date of October 4, 2021.

The Complainant in this administrative proceeding has elected for a Panel consisting of a single-member. On October 8, 2021, CIIDRC appointed, David L. Kreider, Chartered Arbitrator (UK), as the single-member Panel ("**Panel**").

Absent exceptional circumstances, and pursuant to Resolution Rule 12.2, the Panel's decision is due by October 29, 2021.

The Disputed Domain Name was registered on February 27, 2018 with the Registrar, Namespro Solutions Inc.

This dispute resolution proceeding is conducted pursuant to the Policy and the Rules of the Canadian Internet Registry Authority ("**CIRA**") (the "**Proceeding**").

2. FACTS ALLEGED BY THE PARTIES

The Complainant, Walmart Apollo, LLC, is the owner of the trademark WALMART REWARDS (the "**Mark**") registered with the Canadian Intellectual Property Office ("**CIPO**") under registration number TMA840325 (the "**Registration**"). The Disputed Domain Name is, except for the <.ca> element in the top-level domain, identical to the Mark. Based on the use of the Mark in Canada since at least as early as August 16, 2011, the Registration issued on January 1, 2013. The Complainant is also the owner of the famous WALMART trademark, and other trademarks which include the element WALMART, used under license by Walmart Inc. and Wal-Mart Canada Corp.

Wal-Mart Canada Corp. ("**Walmart Canada**") is the Canadian subsidiary of Walmart Inc. and is headquartered in Mississauga, Ontario. It was founded in March 1994 and has, since that time, operated the WALMART retail locations in Canada, as well as the online retail store at the website associated with the domain name <www.walmart.ca> (the "**Walmart Canada e-commerce site**").

The Mark is used, among other ways, in association with a customer loyalty point program with Walmart Canada. Consumers earn reward "points" for every dollar that they spend using a WALMART REWARDS

MASTERCARD which are redeemable at WALMART retail locations in Canada, or for purchases made through the Walmart Canada e-commerce site. The Mark is also licensed by the Complainant to Duo Bank of Canada, which offers the WALMART REWARDS credit card to consumers in Canada.

As is noted above, the Registrant, Mike Morgan, of Box 276, 130-8191 Westminster Highway, Richmond, British Columbia, Canada V6X1A7, failed to file a response to the Complaint by the due date of October 4, 2021, or at all.

3. CONTENTIONS OF THE PARTIES

- **Complainant**

The Complainant submits that the Disputed Domain Name <**walmartrewards.ca**> is, except for the <.ca> element, identical to the Complainant's registered Mark.

Users of the public Internet visiting the Disputed Domain Name are directed to a website (the "**Registrant's Website**") which displays a series of links to services which overlap with the services covered by the Registration and include links to the Complainant's competitors, with such headings as "Credit Account", "Applied for Visa Credit Card Online Instant Approval", "Sign Up for Banks Online", and "Banking Account".

The Complainant alleges, given that (i) the Disputed Domain Name is identical to the Mark, (ii) the Mark is the subject of the Registration which pre-dates the registration of the Domain Name, and (iii) the Mark has been used, and has developed goodwill, throughout Canada; there can be little doubt that consumers would likely mistake the Disputed Domain Name for the Mark. Internet users who wish to access a website operated by the Complainant either by entering a domain name including the Mark into the address bar of the Internet browser, or by entering the key term of the Disputed Domain Name into an Internet search engine, would likely be confused, and misled, by the Disputed Domain Name as a matter of first impression (a situation sometimes termed "initial interest confusion").

The Complainant submits that the Registrant is using the Domain Name to attract users to the Registrant's Website through consumer confusion with the Mark and to obtain advertising revenue by posting various third-party links, including to direct competitors of the Complainant, on the Registrant's Website to re-direct consumers as the Disputed Domain Name currently resolves to a website that appears to be associated with a pay-per-click service. The Registrant is unfairly and illegally exploiting the goodwill attached to the Complainant's Mark.

The Registrant has used and registered the Domain Name in bad faith, because it registered the Disputed Domain Name to exploit the goodwill of, and cause confusion with, the Mark, and to disrupt the business of the Complainant. The Registrant's use of the Mark in the Disputed Domain Name to attract users to the

Registrant's Website through consumer confusion with the Mark, thereby creating traffic to its own website and obtaining advertising revenue from third parties, is evidence of bad faith use and registration.

Finally, the Complainant alleges that the Registrant has no legitimate interests in or to the Disputed Domain Name, in that the Registrant has never been licensed or authorized to use the Mark, is not commonly known or identified by the name WALMART REWARDS, nor is WALMART REWARDS a geographical name.

- **Registrant**

The Registrant, Mike Morgan, failed to file a response to the Complaint by the due date of October 4, 2021, or at all.

- **Remedy Sought**

The Complainant requests the Domain Name be transferred to it.

4. DISCUSSION AND FINDINGS

4.1 Eligibility

The Panel finds that the Complainant is an Eligible Complainant under paragraph 1.4 of the CDRP, as the Complaint relates to the Mark, which is registered with CIPO, and the Complainant is the owner of the Mark.

4.2 Requirements

In accordance with Paragraph 3.1 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 The Domain Name is Confusingly Similar to a Mark in which the Complainant has Rights

The Disputed Domain Name <**walmartrewards.ca**> is, except for the <.ca> element, identical to the Complainant's registered Mark. Policy para. 1.2 provides that for the purposes of the Policy, the term "domain name" means the domain name excluding the "dot-ca" suffix.

Thus, the Disputed Domain Name is, for the purposes of the Policy, identical to the Complainant's Mark. Moreover, the registration of the Mark with CIPO establishes, *prima facie*, the Complainant's "rights" within the meaning of the Policy as a matter of law.

The Complainant has succeeded in proving the first element under Policy para. 4.1(a).

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

The Panel finds that the Registrant has never been licensed or authorized to use the Mark, is not commonly known or identified by the name WALMART REWARDS, nor is WALMART REWARDS a geographical name. Moreover, there is no evidence that the Registrant has used, is using, or is preparing to use, the Domain Name in good faith in connection with any *bona fide* goods or services, or for a legitimate non-commercial use. Rather, the Disputed Domain Name is "parked" on a "pay-per-click" website advertising the credit card services of the Complainant's competitors.

The Complainant has succeeded in proving the second element under Policy para. 4.1(c).

4.3.3 that the Registrant has Registered the Domain Name in Bad Faith

The Panel finds that the Disputed Domain Name was registered and used to mislead Internet users into believing that the Registrant's business associated with the Disputed Domain Name is a business of the Complainant, or is at least endorsed, sponsored, or approved by the Complainant, which is not the case.

It beggars belief that the Registrant was not aware of the Complainant's rights in the Mark, or at least the element WALMART, prior to registering the Disputed Domain Name, in view of its well-established reputation in Canada and elsewhere. Through extensive use and advertising by the Complainant, the Mark has become distinctive of the Complainant's services. Accordingly, the Panel finds on a balance of probabilities that the Registrant was aware of the Complainant, and of the likely confusion that would be generated by the Disputed Domain Name and the Registrant's Website.

The Panel finds, on a balance of probabilities, that the Registrant sought to take unfair advantage of the reputation of the Complainant and the goodwill associated with the Mark to attract and exploit the Internet traffic that was intended for a domain name corresponding to the Complainant's mark, to confuse the Complainant's potential customers and divert those customers to the Registrant's Website for the primary purpose of disrupting the Complainant's business, or for the Registrant's own commercial gain, or both. Therefore, the Domain Name was not registered in good faith. Further, the Registrant's use of the Disputed

Domain Name to divert Internet traffic to the Registrant’s Website and thereafter to the Complainant’s competitors is antithetical to “good faith”.

The Complainant has succeeded in proving the third element under Policy para. 4.1(b).

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 Disputed Domain Name <**walmartrewards.ca**> be transferred to the Complainant.

Made as of October 10, 2021

DAVID L. KREIDER

