

ADMINISTRATIVE PANEL DECISION

Edmonton Oilers Hockey Corp. v. Accounts Receivable, edmonstonoilers
Case No. D2024-2186

1. The Parties

The Complainant is Edmonton Oilers Hockey Corp., Canada, represented by Greenberg Traurig, LLP, United States of America (“United States”).

The Respondent is Accounts Receivable, edmonstonoilers, United States.

2. The Domain Name and Registrar

The disputed domain name <edmontonoilers.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 28, 2024. On May 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 31, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 3, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on June 5, 2024.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 11, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 1, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 18, 2024.

The Center appointed Gökhan Gökçe as the sole panelist in this matter on July 24, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant, the Edmonton Oilers Hockey Corp., owns and operates the professional ice hockey team which was formed in 1972 in the National Hockey League.

The Complainant is the owner of several trademark registrations for OILERS and EDMONTON OILERS, including the following:

- United States trademark registration No. 1,567,617 for OILERS (word mark), registered on November 21, 1989, in class 41;
- United States trademark registration No. 1,566,457 for OILERS (figurative mark), registered on November 14, 1989, in class 41,
- United States trademark registration No. 2,840,696 for OILERS (figurative mark), registered on May 11, 2004, in class 25,
- Canada trademark registration No. 328,864 for EDMONTON OILERS (word mark), registered on June 19, 1987, in classes 6, 11, 16, 21, 32,
- Canada trademark registration No. 425,426 for EDMONTON OILERS (word mark), registered on March 18, 1994, in class 41,
- Canada trademark registration No. 330,917 for EDMONTON OILERS (word mark), registered on August 14, 1987, in classes 5, 9, 11, 12, 14, 16, 18, 20, 21, 24, 25, 26, 28, 30, 34.

In addition to the United States and Canada registrations listed above, the Complainant has also obtained trademark registrations incorporating the OILERS and EDMONTON OILERS marks covering over 36 jurisdictions.

The Complainant also asserts common law rights arising from its use of the mark since 1972.

The Complainant operates its website at "www.edmontonoilers.com". The Complainant's website not only features general information about the Edmonton Oilers and its game schedule, but also allows customers to purchase game tickets, view team statistics, and purchase Edmonton Oilers'-branded merchandise.

The disputed domain name was registered on January 26, 2024.

The disputed domain name resolves to an active website which offers website creation services. The Complainant also provided evidence that the disputed domain name has been used in furtherance of a fraudulent email scheme.

The Respondent appears to be based in the United States. The Panel visited the disputed domain name on August 1, 2024, and noted that the disputed domain name is still active and resolves to a parked Zoho Page.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the EDMONTON OILERS trademark in which the Complainant has rights since the disputed domain name is identical to the EDMONTON OILERS mark other than a letter "d" replaced with the letter "b". The Complainant contends that this constitutes typo squatting in which the registrant deliberately wanted to cause confusing similarity. Furthermore, the generic Top-Level Domain ("gTLD") in the disputed domain name is viewed as a standard registration requirement and is disregarded under the first element test.

The Complainant further contends that the Respondent lacks any rights or legitimate interests in respect of the disputed domain name. The Respondent is neither affiliated with the Complainant in any way nor have they been authorized by the Complainant to use and register its trademark, or to seek registration of any domain name incorporating the said trademark. Second, there is no evidence that the Respondent owns any trademark rights on OILERS and/or EDMONTON OILERS nor that they seem to carry out any legitimate activity. Pursuant to Annex 10 of the Complaint, the Respondent is using the disputed domain name to impersonate the Complainant and its employees by creating fraudulent email addresses on it, and using them to send fraudulent messages to the Complainant's corporate clients. The Complainant contends that the Respondent's use of the disputed domain name to mislead Internet users is not a bona fide or legitimate noncommercial or fair use of the disputed domain name. The Complainant has not granted the Respondent any license, permission, or authorization to use their trademarks in any domain name.

The Complainant, finally, says that the disputed domain name was registered and has been used in bad faith. The Complainant asserts that long after the Complainant established its rights in its OILERS and EDMONTON OILERS trademarks, and with knowledge of those marks, the Respondent acquired the confusingly similar disputed domain name to impersonate the Complainant by creating email addresses on it which appear to be from the Complainant to send fraudulent email messages to engage in fraudulent financial transactions with the Complainant's corporate partners. In this regard, the Complainant asserts that this unequivocally indicates a bad faith use of the disputed domain name.

The Complainant asserts that additionally, the Respondent's passive holding of the disputed domain name that resolves to a parked web page is a further indication of bad faith use and registration.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed, the Complainant must establish each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(a) of the Policy states that the Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complainant's contentions. *Stanworth Development Limited v. E Net Marketing Ltd.*, WIPO Case No. [D2007-1228](#).

However, concerning the uncontested information provided by the Complainant, the Panel may, where relevant, accept the provided reasonable factual allegations in the Complaint as true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

For the evaluation of this case, the Panel has taken note of the [WIPO Overview 3.0](#) and, where appropriate, will decide consistent with the consensus views stated therein.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

It is recognized that the Complainant's trademarks OILERS and EDMONTON OILERS enjoy thorough protection through several trademark registrations. The Panel finds that the Complainant's above-referenced trademark registrations suffice to demonstrate the Complainant's rights in its mark for the purposes of Policy.

The mark is sufficiently recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

It is also well accepted that a gTLD, in this case ".com", is typically ignored when assessing the similarity between a trademark and a domain name. [WIPO Overview 3.0](#), section 1.11.1.

As for the disputed domain name, it is composed of the exact same letters as the Complainant's trademark, except that the letter "d" is replaced with the letter "b" which has a similar appearance at a quick glance, especially embedded within a word. According to [WIPO Overview 3.0](#), section 1.9, "[a] domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element" and an example of such a misspelling is "substitution of similar-appearing characters". Accordingly, the disputed domain name is confusingly similar to the Complainant's trademark.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The composition of the disputed domain name consists of the Complainant's trademark with the letter "b" replaced by the letter "d". In this Panel's view, the conduct indicates an awareness of the Complainant and its trademark and intent to take unfair advantage of such, which does not support a finding of any rights or legitimate interests.

Panels have held that the use of a domain name for illegal activity, such as sending fraudulent emails, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. In this context the Panel notes that the registrant name "Accounts Receivable, edmonstonoilers" is a clear attempt to falsely suggest an affiliation with the Complainant, and so the Respondent cannot reasonably claim to be commonly known by the disputed domain name or a similar name.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent's use of the disputed domain name to create a false association with the Complainant and to perpetuate fraudulent schemes under a disputed domain name that creates a likelihood of confusion that the disputed domain name is operated by the Complainant constitutes bad faith pursuant to the Policy.

It is highly unlikely for the Respondent to have not known about the Complainant prior to registering the disputed domain name. In fact, a search for "ebmonton oilers" in an Internet search engine will automatically show results for "edmonton oilers" which almost exclusively pertain to the Complainant.

Further, the Respondent provided the "organization" of the registrant on the Whois record as "Accounts Receivable, edmonstonoilers", in a likely attempt to legitimize the registration as being in association with the Complainant. Therefore, the disputed domain name is an obvious misspelling of the Complainant's trademark and it is most likely that the Respondent registered the disputed domain name with the intention of unfairly benefiting from the fame of the Complainant's mark.

Panels have held that the use of a domain name for illegal activity, such as sending fraudulent emails, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The record submitted by the Complainant showing the Respondent's fraudulent email scam indicates that the Respondent most likely registered the disputed domain name for the purpose of using it in an email address to fraudulently obtain personal and financial information from the Complainant's clients. This indicates that the disputed domain name was used for impersonating the Complainant. This unequivocally indicates a bad faith use of the disputed domain name.

The Panel finds that the Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <ebmontonoilers.com> be transferred to the Complainant.

/Gökhan Gökçe/

Gökhan Gökçe

Sole Panelist

Date: August 5, 2024