

**IN THE MATTER OF THE ARBITRATION OF A COMPLAINT PURSUANT TO THE
CANADIAN INTERNET REGISTRATION AUTHORITY (CIRA) DOMAIN NAME
DISPUTE RESOLUTION POLICY (CDRP)**

Domain in Dispute: <cheapmichelintires.ca>
Complainant: Compagnie Generale des Etablissements Michelin
Registrant: Jason Hughes
Registrar: Go Daddy Domains Canada, Inc.
BCICAC File: DCA-1812-CIRA

DECISION

1. The Parties

Complainant is Compagnie Generale des Etablissements Michelin of Clermont-Ferrand, France, represented by Sharyn Costin and Nathan Haldane, of Bereskin & Parr LLP, of Toronto, Ontario Canada.

According to the Complaint, the Registrant's identity is "shielded on the CIRA WHOIS record," but "[b]ased on information obtained from CIRA pursuant to a request for disclosure of registrant information, the owner of the Domain Name is the individual Jason Hughes."

2. The Domain Name and Registrar

The disputed domain name is <cheapmichelintires.ca> (the "Disputed Domain Name"), which was created on March 19, 2015.

3. Governing Policy and Rules

This is a proceeding under the CIRA Domain Name Dispute Resolution Policy, Version 1.3 (August 22, 2011) ("CDRP") and the CIRA Domain Name Dispute Resolution Rules, Version 1.5 (July 28, 2014) ("Rules"). Paragraph 1.8 of the Policy states: "The version of the Policy in effect at the time a Proceeding is initiated will apply to the Proceeding." And, paragraph 1.2 of the Rules states: "The version of the Resolution Rules in effect at the time a Proceeding is initiated will apply to that Proceeding."

4. Procedural History

The history of this proceeding, according to the information provided by BCICAC, is as follows:

- a. On August 24, 2016 the above-named Complainant filed a Complaint pursuant to the CDRP and the Rules.
- b. In a letter dated August 25, 2016, the Centre as Service Provider, confirmed compliance of the complaint and commencement of the dispute resolution process.

- c. Complaint with the attachments was filed exclusively online, therefore, the Centre delivered the Complaint to the Registrant only by email.
- d. The Registrant has not provided a Response. As permitted given the absence of a Response, the Complainant has elected under Rule 6.5 to convert from a panel of three to a single arbitrator.
- e. BCICAC appointed Douglas M. Isenberg as sole arbitrator on September 20, 2016. The undersigned executed a document on the same date titled “Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.”
- f. Absent exceptional circumstances, and pursuant to Rule 12.2, the Panel’s decision is to be delivered to BCICAC by October 11, 2016.

The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Resolution Rules. Based upon the information provided by the BCICAC, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding, unless otherwise noted, have been met.

5. Canadian Presence Requirement

Paragraph 1.4 of the Policy 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.” Paragraph 2 of the CPR sets forth a list of individuals and entities that may “hold and maintain the registration of, a .ca domain name,” which list includes “the owner of a trade-mark which is the subject of a registration under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13 as amended from time to time.” The Complaint states, and provides evidence to support, that Complainant is the owner of Canadian Trademark Reg. No. TMA214191 for the mark MICHELIN (registered June 11, 1976). As a result, the Panel is satisfied that the Complainant meets the Canadian Presence Requirements and is eligible to initiate this proceeding.

6. Factual Background and Parties’ Contentions

Complainant states that it was founded in 1889 and is “one of the world’s largest tire manufacturers” with a presence in 170 countries, 112,300 employees and 68 production plants in 17 different countries, including in Canada. Complainant further states that its stock is traded on the Paris Stock Exchange, commonly known as EuroNext Paris. Complainant further states that it “has been part of the tire industry in North America since 1907” and built a manufacturing plant in Nova Scotia, which opened in 1971. Complainant further states that its “worldwide revenue was over \$30 billion CAD in 2012, which included extensive sales throughout Canada.”

Complainant states, and provides evidence to support, that it is the owner of “numerous Canadian trademark registrations and applications comprised of and containing MICHELIN,”

including Reg. No. TMA214191 (discussed above) for use in connection with, among other things, “repair services and retreading of tires.” These trademarks are referred to herein as the MICHELIN Trademark. Complainant further states, and provides evidence to support, that it is the registrant of the domain names <michelin.com> (created December 1, 1993) and <michelin.ca> (created October 6, 2000).¹

Complainant states, and provides evidence to support, that the Registrant of the Disputed Domain Name is also the registrant of “many domain names containing registered trademarks of third parties, including and in particular, well- known marks in the automotive industry,” including, to cite only a few, <cheapaudiwheels.ca>, <cheapmercedeswheels.ca>, <cheapbmwwheels.ca> and others that follow a similar pattern.

Complaint states, and provides evidence to support, that the Disputed Domain Name “resolve[s] to a separate website at <getcheapparts.ca>, which advertises the sale of, and operates as an e-commerce site for, a wide variety of auto parts, including Michelin tires, alongside the products of Michelin’s direct competitors.”

As stated above, the Registrant has not provided a Response.

Complainant contends that the Disputed Domain Name is confusingly similar to the MICHELIN Trademark; and that Complainant has rights in this mark that pre-date the registration date of the Disputed Domain Name and that Complainant continues to have such rights. In support thereof, Complainant cites Canadian Trademark Reg. No. TMA214191 and states that “the [Disputed] Domain Name incorporates the whole of the Complainant’s MICHELIN [T]rademark, only adding descriptive words, namely ‘cheap’ and ‘tires’ to the [Disputed] Domain Name, which only add to the likelihood of confusion.” Complainant adds that “[t]he word ‘tires’ in the [Disputed] Domain Name describes the very goods for which the Complainant’s MICHELIN [Trade]mark is well- known and protected.”

Complainant further contends that Registrant has no legitimate interest in the Disputed Domain Name because, *inter alia*, “Respondent has never been licensed or authorized to use the MICHELIN mark in any manner, in Canada or otherwise, including in, or as part of a domain name, nor has the Complainant provided its consent to the use or display of its MICHELIN mark on the Respondent’s <getcheapparts.ca> website”; “Respondent does not own any trademarks that include MICHELIN or any similar mark”; “as an auto parts retailer, there is no plausible way that the Registrant was not familiar with and knowledgeable of the Complainant’s business and trademarks”; “MICHELIN does not have any clearly descriptive meaning in either English or French in regards to tires, and rather is the last name of the Complainant’s founders”; “the [Disputed] Domain Name is not the geographical name of the Registrant’s activity or place of business”; “‘MICHELIN’ is not the generic name for anything in any language, nor is it understood to be the generic name for any goods, services, or business in Canada”; “‘MICHELIN’ is also not the legal name of the Respondent, Jason Hughes, nor is it a name, surname, or other reference by which the Respondent, or its retail operation ‘Get Cheap Parts’, is

¹ The Panel notes that the registrant of the domain name <michelin.ca> is identified in the Whois database as Michelin North America (Canada) Inc., not Compagnie Generale des Etablissements Michelin. Complainant states that the registrant is its “Canadian subsidiary.”

commonly identified”; and “there is no evidence that the Respondent has used, is using, or is preparing to use, the [Disputed] Domain Name in good faith in connection with legitimate non-commercial use” because “the Respondent is using the [Disputed] Domain Name to attract users to its e-commerce website through consumer confusion with the Complainant’s well-known MICHELIN trademark, brand and website(s), and to obtain revenue by directing prospective customers to the Respondent’s own retail website and business.”

Complainant further contends that the Registrant should be considered as having registered the Disputed Domain Name in bad faith because, *inter alia*, “there is a reasonable inference of bad faith when a Registrant uses a domain name featuring a well-known trademark”; “registering a domain name to redirect Internet traffic to a commercial website does not constitute a use in good faith”; “Respondent registered or acquired the [Disputed] Domain Name primarily for the purpose of disrupting the business of the Complainant, who is not affiliated in anyway with the Respondent”; “Respondent is taking advantage of the reputation of the Complainant and the goodwill associated with the MICHELIN [Trade]mark by exploiting the Internet traffic that was intended for a domain name corresponding to the Complainant’s mark and business”; and “Respondent plainly registered and maintained the [Disputed] Domain Name registration to prevent the Complainant from registering the [MICHELIN Tradem]ark or its close variant as a domain name, as demonstrated by the Respondent’s engagement in a pattern of registering domain names consisting of third-party trademarks.”

Complainant requests that the Disputed Domain Name be transferred from the Registrant to the Complainant.

7. Discussion and Findings

To obtain a transfer of the Disputed Domain Name, Complainant must, as set forth in paragraph 4.1 of the Policy, prove “on a balance of probabilities” 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; and
- (b) the Registrant has registered the domain name in bad faith as described in paragraph 3.5;

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.

Rights and Confusingly Similar

With respect to paragraph 3.1(a) of the Policy, it is obvious based on Complainant’s reference to its Canadian trademark registrations, including Reg. No. TMA214191, that Complainant had rights prior to the date of registration of the domain name and continues to have such rights.

As to whether the Disputed Domain Name is confusingly similar to the MICHELIN Trademark, paragraph 3.3 of the Policy 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 MICHELIN Trademark in its entirety plus words that are either generic (“cheap”) or closely associated with the MICHELIN Trademark (“tires”). Accordingly, the Panel agrees with the decision cited by Complainant, *Oakley v. Zhou Yayang*, CIRA Case No. 00188, in which the panel found the disputed domain name <discount-oakleysunglasses-sale.ca> confusingly similar to the trademark OAKLEY because “[b]y incorporating the whole of the Complainant’s well-known and widely used and publicized mark, the Disputed Domain Name is likely to lead persons visiting the website to believe that it is associated with Complainant” and “[t]he additional phrases ‘discount’, ‘sunglasses’ and ‘sale’ do not distinguish the Disputed Domain Name from the OAKLEY Mark, and the inclusion of the word ‘sunglasses’ adds to the likelihood of confusion since the manufacture and sale of sunglasses is a major part of the Complainant’s business.”

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

No Legitimate Interest

With respect to paragraph 3.1(b) of the Policy, regarding a lack of legitimate interests, the Panel is satisfied that the Complainant has established, on a balance of probabilities, that the Registrant does not have a legitimate interest in the Disputed Domain Name. The Registrant, by failing to submit a Response, has not made any attempt to rebut Complainant’s allegations or argue that it has a legitimate interest in the Disputed Domain Name under any of the six elements described in paragraph 3.4 of the Policy. Under these circumstances, the lack of a response is fatal to the Registrant. See, e.g., *Cointreau v. Netnic Corporation*, CIRA Case No. 00180 (“[t]here is no evidence from the ‘customer’ about its ‘interest’ in the Domain Name”); and *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 Policy.

Bad Faith

With respect to paragraph 3.1(c) of the Policy, regarding bad faith, the Panel agrees with Complainant’s observation that the enumerated list of bad faith examples in paragraph 3.5 is not exhaustive, as the Policy specifically says that the examples are “in particular but without limitation.” Accordingly, a Panel may find bad faith even in the absence of any of the examples set forth in paragraph 3.5(a)-(d).

Pursuant to paragraph 3.5 of the Policy, the following “shall be evidence that a Registrant has registered a domain name in bad faith”:

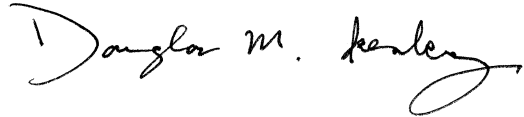
- (a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant’s licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee 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.

Here, Complainant has provided evidence and arguments with respect to three of these factors, that is, under paragraphs 3.5(b), (c) and (d). While the Panel has no hesitation agreeing with any or all of these arguments, the Panel is especially persuaded by the fact that the Disputed Domain Name is being used in connection with a website that offers for sale products from Complainant’s competitors. Such use of the Disputed Domain Name clearly demonstrates an intention by the Registrant to attract Internet users for commercial gain by creating a likelihood of confusion with the MICHELIN Trademark. See, e.g., *Americana International Ltd. v. Bench Clothing Store Inc.*, CIRA Case No. 00238 (transfer of < benchclothing.ca >). In that case, the panel found bad faith where the disputed domain name was used to sell clothing in competition with complainant. As a result, the panel there wrote that “the Registrant would appear to be motivated by commercial gain to attract to its websites internet users who are searching for the Complainant’s products” and that “[i]t has done so by creating a likelihood of confusion not only in its choice of domain name, but also in the presentation of information on its website.” The same is true here.

In light of the above, as well as the registrant’s failure to respond to Complainant’s communications or the Complaint in this proceeding, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(c) of the Policy.

8. Decision

For all the foregoing reasons, in accordance with paragraph 4.3 of the Policy, the Panel orders that the Disputed Domain Name <cheapmichelintires.ca> be transferred to Complainant.

A handwritten signature in black ink that reads "Douglas M. Isenberg". The signature is written in a cursive style with a large, looping initial 'D' and a long, sweeping underline.

Douglas M. Isenberg, sole arbitrator
Dated: October 9, 2016