

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number: DCA-1768-CIRA
Domain Name: <www.enterprise.ca>
Complainant: Enterprise Holdings, Inc.
Registrant: Terry Wade Davies
Panel: David Wotherspoon
Service Provider: British Columbia International Commercial Arbitration Centre (BCICAC)

DECISION

A. THE PARTIES

1. The Complainant is Enterprise Holdings, Inc. (the "Complainant."). The Complainant's office is located at 600 Corporate Park Drive, St. Louis, Missouri 63105, USA. The Complainant is represented by David R. Haarz of Harness Dickey in Virginia, USA.
2. The Registrant is Terry Wade Davies of Box 276, 130-8191 Westminster Highway, Richmond, British Columbia V6X 1A7, Canada.

B. THE DOMAIN NAME AND REGISTRAR

3. The Domain Name in issue is <enterprise.ca> (the "Domain").
4. The Domain was registered on December 28, 2005.
5. The Registrar of the Domain is Namespro Solutions Inc.

C. PROCEDURAL HISTORY

6. On April 12, 2016, the Complainant submitted a complaint (the "Complaint") to The British Columbia International Commercial Arbitration Centre ("BCICAC") as service provider pursuant to paragraph 1.5 of the Canadian Internet Registration Authority ("CIRA") Domain Name Dispute Resolution Policy v. 1.3 (the "Policy").

7. The BCICAC reviewed the Complaint and found it to be in administrative compliance with the requirements under Rule 4.2 of the CIRA Domain Name Dispute Resolution Rules (the "Rules"). By email dated April 14, 2016, the BCICAC so advised the parties and forwarded a copy of the Complaint to the Registrant.
8. The Registrant did not reply to that communication and did not provide a response to the Complainant.
9. Under Rule 6.5 the Complainant was entitled to elect to convert from a panel of three to a single arbitrator which it elected to do, whereupon the BCICAC proceeded to elect a single arbitrator.
10. The Complainant seeks, as a remedy, that the Domain be transferred to the Complainant.

D. PANELIST IMPARTIALITY AND INDEPENDENCE

11. By letter dated May 10, 2016, the BCICAC selected David Wotherspoon as sole arbitrator.
12. As required by paragraph 7.2 of the Rules, the panelist has submitted to the service provider an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality in relation to this dispute. Accordingly, this panel (the "Panel") concludes it has been constituted in compliance with the Rules.

E. COMPLAINANT'S SUBMISSIONS

13. The Complainant makes the following submissions.
14. The Complainant is the owner of two Canadian registered trade-marks for its ENTERPRISE mark (the "Mark"). The first was registered as number TMA535866 on October 26, 2000 in association with "Car and truck rental and leasing" and "Automotive fleet management services; automotive repair services; short-term rental and leasing of automobiles and trucks; automotive dealership services". The second was registered as number TMA537905 on November 28, 2000 in association with "Operation of an automobile dealership involved in the selling, leasing, renting and servicing of new and used vehicles". The Complainant has used the Mark TMA535866 through licensees in Canada as early as 1984 and the Mark TMA537905 through licensees in Canada as early as June 1981.
15. The Complainant licenses the Mark to Enterprise Rent-A-Car operating entities located in the United States, Canada, Ireland, Germany and the United Kingdom. The Mark has been used in Canada in connection with car rentals and leasing services since at least as early as 1984. The Complainant's Canadian licensee operates an online car rental site at enterprise.ca.

16. The Registrant registered the Domain on December 28, 2005.
17. The Complainant provided a screenshot dated January 17, 2016 which showed that on this date the website available at the Domain was a “pay-per-click” website with an aggregation of hyperlinks to various other websites related to car rental services (Complaint Annex 10). The Complainant asserts that some of those hyperlinks resolved to other car rental websites unaffiliated with the Complainant. The Complainant did not provide any indication of the duration for which the Domain resolved to a “pay-per-click” website.
18. The Complainant provided a screenshot dated April 9, 2016 which showed that the Domain redirected to hotwire.com, a website that the Complainant asserts offers vehicle rental services from Enterprise Rent-A-Car and its competitors (Complaint Annex 11). The Complainant did not provide any indication of the duration for which the Domain redirected to the hotwire.com website.
19. The Complainant asserts that the Domain is, on a balance of probabilities, confusingly similar to the Mark as described in paragraph 3.3 of the Policy. The Complainant asserts that the Domain is nothing more than a common misspelling or typo of the Mark and that the Domain, without the dot-ca suffix, consists entirely of the Complainant’s Mark, merely deleting the second “R” from ENTERPRISE. As such, the Complainant asserts that the Domain is so similar in the appearance, sound, or idea suggested by the Mark as to be likely mistaken for the Mark.
20. The Complainant further asserts that the Registrant has no legitimate interest in the Domain as described in paragraph 3.4 of the Policy. In particular, the Complainant asserts that the Registrant does not meet any of the enumerated grounds pursuant to which a Registrant may establish a legitimate interest in the Domain, as follows:
 - (a) The domain name is not a Mark, the Registrant did not and does not use “enterprise” as a Mark in good faith and the Registrant had and has no rights in “enterprise” as a Mark;
 - (b) The Registrant’s use has not been in good faith, as “enterprise” is not descriptive in Canada in English or French of any character or quality of wares or services, the conditions of or the persons employed in producing the wares, performing the services or operation of the business, nor the place of origin of the wares, services or business;
 - (c) “enterprise” is not a generic name for any wares, services or business;
 - (d) The Registrant is not using the domain name in association with a non-commercial activity as the Registrant’s use of the domain name is designed to make a profit from revenue received for having people “click-through” the links on the web page to which enterprise.ca redirects;

- (e) Since the holder's name is "Terry Wade Davies", there is nothing to indicate that "enterprise" is the name or surname or other reference by which the Registrant is known; and,
 - (f) "Enterprise" is not a geographical name corresponding to the Registrant's activity or place or business.
21. The Complainant further asserts that the Registrant has no legitimate interest in the Domain for the following additional reasons:
- (a) The Complainant has not licensed or authorized Terry Wade Davies to use ENTERPRISE or "enterprise" and the Complainant has no relationship whatsoever with Terry Wade Davies. In *General Motors LLC v. DSI Design*, the Panel held that the assertion that the registrant had not received authorization to use the complainant's trade-marks was considered to be "some evidence" that the registrant did not have a legitimate interest under paragraph 3.4(a) of the Policy (*General Motors LLC v. DSI Design* (CDRP Dispute No 231) at paras 39-40.);
 - (b) Neither the Registrant nor anyone else has a trade-mark registration or pending application for "enterprise" in Canada (Complaint Annex 5);
 - (c) Searches in the Canadian Intellectual Property Office ("CIPO") trade-marks database do not return any trade-mark registrations or pending applications in Canada owned by anyone with the name "Terry Wade Davies" or "Terry Davies" (Complaint Annex 6);
 - (d) Google searches for "Terry Wade Davies" and "Terry Davies" did not return any results that indicate that "Terry Wade Davies" or "Terry Davies" has any rights in "enterprise" (Complaint Annex 7);
 - (e) A Google search for "Enterprise Canada" returns no references to "Terry Wade Davies". In fact these search results demonstrate that Google recognizes "enterprise" as a common typographical error made when people are trying to search "enterprise" (Complaint Annex 8); and,
 - (f) The "Box 276, 130-8191 Westminster Highway, Richmond, BC" address used by "Terry Wade Davies" appears to be a post office box at a UPS Store and there clearly is nothing named "enterprise" at that location (Complaint Annex 9).
22. Finally, the Complainant asserts that the Registrant registered the Domain in bad faith as defined in paragraph 3.5(d) of the Policy. In particular, the Complainant asserts that in registering or acquiring the Domain, the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's web site or other online locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's web site or location or of a product or service on the Registrant's web site or location.

23. The Complainant also asserts and there is evidence that the Registrant owns numerous other dot-ca domain names that are typos of well-known marks registered in Canada, including aircanada.ca, americanepress.ca, bugerking.ca, homedpeot.ca, and ieka.ca (Complaint Annex 12).
24. The Complainant seeks that the Domain be transferred from the Registrant to the Complainant.

F. REGISTRANT'S RESPONSE

25. The Registrant did not file a response in this proceeding.

G. DISCUSSION AND FINDINGS

Complainant Eligibility Requirements

26. 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.

27. The Complainant satisfies the latter part of this test because the Complaint relates to trade-marks TMA535866 and TMA537905, which are both registered in CIPO and owned by the Complainant. The Complainant meets the eligibility requirements.

Basis for Complaint

28. According to paragraph 4.1 of the Policy, the Complainant must 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 the 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.

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in paragraph 3.4.

29. Because the Registrant did not file a response in this proceeding, only the Complainant's arguments will be assessed.
30. The Policy is based on the principle that, without more, the first party to register a domain has priority over the domain. A complainant does not have automatic rights to a domain name simply because it registered a trade-mark earlier than a registrant registered a domain name. A complainant must establish its rights to the domain name.

Confusingly similar

31. At paragraph 3.2 of the Policy, a "Mark" is defined:

3.2 Mark. A "Mark" is:

...

(c) a trade-mark, including the word elements of a design mark, that is registered in CIPO;
32. Given the evidence presented by the Complainant, the Panel finds that it has established that ENTERPRISE is a "Mark" under the definition in paragraph 3.2(c) of the Policy.
33. For the purpose of determining whether a domain name is confusingly similar to a mark, paragraph 1.2 of the Policy indicates that the "dot-ca" suffix of the domain name should not be considered. Absent the "dot-ca" suffix, the Complainant's trade-mark and the Domain are nearly identical, with the Domain only missing the second "R" in ENTERPRISE.
34. Paragraph 3.3 of the Policy provides that a domain name is "confusingly similar" to a Mark if 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.
35. The Domain "enterprise" is nearly identical to the Complainant's trade-mark ENTERPRISE in appearance and sound save a minor spelling error and is thus confusingly similar thereto within the requirements of the Policy.
36. The Registrant did not dispute that the Domain is confusingly similar to the ENTERPRISE trade-mark as no response was filed.
37. The Complainant's registration of its trade-marks on October 26, 2000 and November 28, 2000 pre-dates the registration date of the Domain on December 28, 2005.

38. The Panel therefore finds that the Complainant has met its burden under paragraph 3.1(a) that the Registrant's Domain is confusingly similar to a Mark in which the Complainant had rights prior to the date of registration of the Domain.

Bad faith

39. Paragraph 3.5 of the current Policy now provides that the Registrant has registered a domain name in bad faith if any of the following circumstances, in particular but without limitation, are found by the Panel:

(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.

40. The Complainant relies on paragraph 3.5(d) of the Policy, and asserts that the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Domain by creating a likelihood of confusion with the Complainant's Mark. The Complainant relies on *Hasbro Inc. v. 1550507 Ontario Inc.* (CDRP Dispute No 141) at paras. 58 and 59:

58. Cybersquatters routinely register multiple domain names that constitute intentional misspellings of owner marks (i.e., typosquatting), or register domain names that may not otherwise appeal to a mark owner. In these cases, a registrant has not sought to "prevent" a complainant mark owner from registering certain domain names, nor has a complainant been prevented from registering said domains. Rather, the registrant may be stockpiling these domains, or using them to redirect end users to unaffiliated

sites with a view to reaping a commercial advantage by capitalizing on end user confusion.

59. In such a case, to conclude that a registrant could escape the reach of [then] paragraph 3.7(b) [now paragraph 3.5(b)] of the Policy on the basis that an intention to deprive the mark holder of the domain name cannot strictly be shown only encourages a registrant to misappropriate third party marks as domain names that would not have otherwise been sought to be secured by a complainant.

41. The observations of the panels in *Hasbro Inc. v. 1550507 Ontario Inc.* are applicable to this Complaint. The Domain constitutes a misspelling of the Complainant's ENTERPRISE Mark and therefore creates a likelihood of confusion with said Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website. Further, the documentary evidence shows that the website associated with the Domain previously resolved to a "pay-per-click" website which aggregated hyperlinks to an assortment of car rental websites (Complaint Annex 10).
42. Accordingly, the Panel finds that the Complainant has established, on a balance of probabilities, that the Registrant has registered the Domain in bad faith as described in paragraph 3.5 (d)¹.

Legitimate interest

43. Paragraph 3.4 of the Policy lists 6 non-exclusive criteria upon which the Panel may find that the Registrant has a legitimate interest in the Domain:
 - (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;

¹ The Panel notes that this is consistent with other CDRP decisions where bad faith was found as a result of a domain name that is confusingly similar to a registered trade-mark resolving to a "pay-per-click" website, such as *American Express Marketing and Development Corp v. Nameshield Inc c/o Daniel Mullen* (CDRP Dispute No 249) at para. 27:

The panel is of the view that the use of a URL that incorporates the Complainant's registered trademark, and that is confusingly similar to that mark, in order to direct internet traffic to a pay-per-click site, creates a "likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website", within the meaning of paragraph 3.5(d) of the CDRP. We note that it is well-established that the use of domain names that are confusingly similar to registered trademarks to direct internet traffic to pay-per-click sites can amount to bad faith.

- (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.
44. As outlined in paragraphs 20 and 21 of this decision, the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain as required by Paragraphs 3.1(b) and 4.1(c) of the Policy. The Registrant has provided no response.
45. Therefore, the Panel finds that the Registrant does not have a legitimate interest in the Domain.

Transfer of the Domain to the Complainant

46. The Complainant seeks, as a remedy, that the Domain be transferred to the Complainant.
47. Although the Complainant meets the eligibility requirements with respect to this proceeding, the Complainant does not meet the Canadian Presence Requirements ("CPR") which must be met in order to transfer the Domain to the Complainant. Paragraph 2(q) of the CPR states that a person meeting the following criteria will satisfy the CPR:

A Person which does not meet any of the foregoing conditions, but which is 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, but in this case such permission is limited to an application to register a .ca domain name consisting of or including the exact word component of that registered trade-mark.

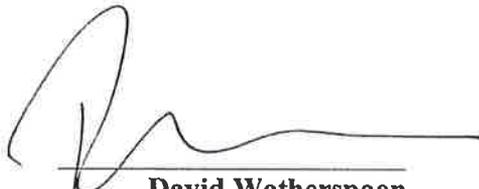
48. Because the "enterprise" Domain does not consist of or include the exact word component of the Complainant's registered ENTERPRISE Mark, the Panel does not have authority to transfer the Domain to the Complainant. Previous versions of the Policy allowed for transfer of a Domain to an eligible nominee of the Complainant if the Complainant itself were not eligible. However, this mechanism for remedy is no longer available under the Policy. As such the Domain in dispute cannot be transferred directly to the Complainant or an eligible nominee of the Complainant.
49. The arbitrator does, however, have authority to cancel the registration of the Domain under paragraph 4.3 of the Policy.

H. CONCLUSION AND DECISION

50. The Panel has found that the Complainant has met the burden under paragraph 4.1 of the Policy, and has demonstrated on a balance of probabilities that:
- (a) The Domain registered by the Registrant is confusingly similar to the trade-mark in which the Complainant has rights;
 - (b) The Registrant has no legitimate interests in respect of the Domain; and
 - (c) The Registrant registered the Domain in bad faith.
51. Pursuant to paragraph 4.3 of the Policy, the Panel orders that the registration of the domain name

enterprise.ca

be cancelled forthwith.



David Wotherspoon
May 27, 2016