

**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: <midea.ca>

Complainants: Midea Group Co., Ltd and Midea America (Canada) Corp.

Registrant: Weiwen Pan

Registrar: Go Daddy Domains Canada, Inc.

BCICAC File: DCA-1854-CIRA

DECISION

1. The Parties

Complainants are Midea Group Co., Ltd of Beijiao, Shunde, Foshan, Guangdong, China; and Midea America (Canada) Corp. of Markham, Ontario, Canada (each, individually as the context may require, "Complainant"; jointly, "Complainants"); represented by Paddy Tam of CSC Digital Brand Services Group AB, of Stockholm, Sweden.

According to the Complaint, the Registrant's identity is "hidden by CIRA." During the course of the proceeding, Provider identified the Registrant as Weiwen Pan.

2. The Domain Name and Registrar

The disputed domain name is <midea.ca> (the "Disputed Domain Name"), which was created on May 3, 2011. The registrar is Go Daddy Domains Canada, Inc. ("Registrar").

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 Provider, is as follows:

- a. On March 8, 2017, Complainant filed a Complaint pursuant to the CDRP and the Rules.
- b. In a letter dated March 8, 2017, Provider confirmed compliance of the complaint and commencement of the dispute resolution process.

- c. Complaint with the attachments was filed exclusively online; therefore, Provider delivered the Complaint to the Registrant only by email.
- d. Registrant did not provide a Response by the deadline of March 28, 2017. As permitted given the absence of a Response “after the time for submission of the Response has expired”, the Complainant elected under Rule 6.5 to convert from a panel of three to a single arbitrator.
- e. On March 31, 2017 the Registrant contacted Provider advising that he would wish to submit a response to this matter. Provider advised the Registrant that it will be up to the sole discretion of the arbitrator to elect to accept the late submission.
- f. Provider appointed Douglas M. Isenberg as sole arbitrator on April 3, 2017. The undersigned executed a document on the same date titled “Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.”
- g. On April 10, 2017, Provider received a response from Registrant dated April 7, 2017 (along with a document titled “Request to Accept Late Response”), which Provider forwarded to the Panel on April 10, 2017.
- h. Absent exceptional circumstances, and pursuant to Rule 12.2, the Panel’s decision is to be delivered to Provider by April 24, 2017.

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 Provider, 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. Nos. TMA570076 (registered October 31, 2002), TMA570589 (registered November 12, 2002), TMA593118 (registered October 27, 2003), TMA602948 (registered February 23, 2004) and TMA724764 (registered September 30, 2008) for marks that contain MIDEA. As a result, the Panel is satisfied that the Complainant meets the Canadian Presence Requirements and is eligible to initiate this proceeding.

6. Preliminary Issue: Late Response

Provider notified the Registrant on March 8, 2017, that the deadline for submission of a Response was March 28, 2017. Although paragraph 5.4 of the Rules allows the Provider to extend the period of time for the filing of the Response, no such extension was granted in this proceeding, and the Response apparently was not submitted until April 10, 2017. Paragraph 5.8 of the Rules states: "If a Registrant does not submit a Response within the period for submission of a Response or any period extended pursuant to paragraph 5.4 or 5.6, the Panel shall decide the Proceeding on the basis of the Complaint unless the Proceeding is terminated by the Complainant pursuant to paragraph 8.1." (Paragraph 5.6 of the Rules is inapplicable here as it relates to the Provider's treatment of "instances of non-compliance" of Responses.) Accordingly, given that the Response was not submitted in a timely manner and that the Rules do not give the Panel authority to accept a late Response, the Panel does not consider the Response in this proceeding.

7. Factual Background and Parties' Contentions

Complainant states that it was "[e]stablished in 1968" and is "an electrical appliance manufacturer, headquartered in Beijiao, Shunde, Foshan, Guangdong, China" that is "well known in Canada and throughout North America for providing a full range of residential and commercial air conditioner products." Complainant further states that it "is a publicly listed and, since July 2016, a Fortune 500 company that offers one of the most comprehensive ranges in the home appliance industry"; that it "specializes in air treatment, refrigeration, laundry, large cooking appliances, large and small kitchen appliances, water appliances, floor care and lighting"; that it has "over 100,000 employees and operations in more than 200 countries" with "21 production facilities and 260 logistics centers worldwide." Complainant further states that it was "incorporated November 2006 in Ontario" and "maintains and operates a Customer Care Center in Toronto."

As noted above, Complainant states, and provides evidence to support, that it is the owner of Canadian Trademark Reg. Nos. TMA570076 (registered October 31, 2002), TMA570589 (registered November 12, 2002), TMA593118 (registered October 27, 2003), TMA602948 (registered February 23, 2004) and TMA724764 (registered September 30, 2008) for marks that contain MIDEA. These trademarks are referred to hereafter as the "MIDEA Trademark."

Complainant states, and provides evidence to support, that the Disputed Domain Name "redirects Internet users to a holding page at the domain name <grandchinaairlines.com>" which contains text "which translates as 'Take off/fly high China'"; that "Respondent is currently offering to sell the Disputed Domain Name"; and that "Respondent has ignored Complainant's attempts to resolve this dispute outside of this administrative proceeding."

Complainant contends that, as the result of the Canadian trademark registrations described above, as well as others, Complainant has rights in the MIDEA Trademark and that "[t]he Disputed Domain Name contains Complainant's MIDEA trademark in its entirety, thus resulting in a domain name that is identical to the Complainant's MIDEA trademark."

Complainant contends that Registrant has no legitimate interest in the Disputed Domain Name because, *inter alia*, Registrant redirects the Disputed Domain Name to a website at <grandchinaairlines.com>, which shows that Registrant “has failed to make use of this Disputed Domain Name’s website and has not demonstrated any attempt to make legitimate use of the domain name and website, which evinces a lack of rights or legitimate interests in the Disputed Domain Name” and which further shows that “Respondent is not using the Disputed Domain Name to provide a bona fide offering of goods or services... nor a legitimate noncommercial or fair use”; “[t]he Disputed Domain Name is being offered for sale in an amount that far exceeds the Respondent’s out-of-pocket expenses in registering the domain, which serves as further evidence of Respondent’s lack of rights and legitimate interests”; and “Respondent has used the Disputed Domain Name [to] host a website featuring multiple pay-per-click links where Respondent is presumably profiting from the click-through fees.”

Complainant contends that the Registrant should be considered as having registered the Disputed Domain Name in bad faith because, *inter alia*, given that the MIDEA Trademark is “known internationally” and has been used in Canada since 2006, its use by Registrant “suggests opportunistic bad faith”; Registrant had constructive or actual notice of the MIDEA Trademark as the result of Complainant’s reach and online presence (including via the domain name <midea.com>); Registrant’s use of a “holding page” connected to the Disputed Domain Name nevertheless constitutes bad faith use under the passive holding doctrine set forth in decisions under the Uniform Domain Name Dispute Resolution Policy (UDRP); by offering the Disputed Domain Name for sale, “Respondent has demonstrated an intent to sell, rent, or otherwise transfer the Disputed Domain Name for valuable consideration in excess of his out-of-pocket expenses”; “Respondent has ignored Complainant’s attempts to resolve this dispute outside of this administrative proceeding”; and “it is more likely than not that the Respondent knew of and targeted Complainant’s trademark.”

Complainant requests that the Disputed Domain Name be transferred from the Registrant to the Complainant Midea Group Co., Ltd.

8. 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 that Complainant had rights prior to the date of registration of the Disputed Domain Name and continues to have such rights.

As to whether the Disputed Domain Name is confusingly similar to the MIDEA 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 MIDEA Trademark – and *only* the MIDEA Trademark – in its entirety. Although Complainant's registrations for the MIDEA Trademark also contain design elements, the Panel agrees with paragraph 1.11 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), which states: "as figurative, stylized or design elements in a trademark are generally incapable of representation in a domain name, such elements are typically disregarded for the purpose of assessing identity or confusing similarity, with such assessment generally being between the alpha-numeric components of the domain name, and the dominant textual components of the relevant mark."¹

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. By failing to submit a timely Response that the Panel could consider (as discussed above), the Registrant 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, nor is there any evidence that the Panel has considered that demonstrates Registrant has a legitimate interest in the Disputed Domain Name. 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.

¹ Although WIPO Overview 2.0 addresses the UDRP, Paragraph 3.2(l) of the CIRA Domain Name Dispute 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."

Bad Faith

As an initial matter, the Panel notes that the Complaint cites repeatedly to various requirements of the UDRP rather than the CDRP in its arguments regarding bad faith. While the bad faith element appears in both the CDRP as well as the UDRP – and while the Panel already has noted that citation to relevant UDRP decisions in a CDRP proceeding is appropriate – the element is not defined identically in both policies, and citation to specific paragraphs of the UDRP, as if those paragraphs were directly applicable here, is improper. Fortunately for Complainant, these citations are simply sloppy and not fatal.

In any event, despite the Complaint's misplaced references to the UDRP, the Panel evaluates whether the Complaint 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.

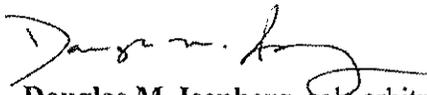
Complainant does not specifically refer to any of these paragraphs by number (citing instead to various sections of the UDRP), but it is apparent that Complainant believes bad faith exists pursuant to, at least, paragraphs 3.5(a) and 3.5(d). The Panel is unconvinced that Registrant intended to sell the Disputed Domain Name for "valuable consideration in excess of the Registrant's actual costs in registering the domain name," given that the Complaint contains no evidence of a price at which Registrant indicated he would sell the Disputed Domain Name. Instead, Complainant has provided only a printout from the web page to which the Disputed Domain Name redirects, which states, "If you would like to purchase this domain, please make an offer." Therefore, the Panel does not find bad faith pursuant to paragraph 3.5(a).

However, the Panel is persuaded that bad faith exists pursuant to paragraph 3.5(d), given the strength of the MIDEA Trademark, which has been used by Complainants for many years prior to Registrant's registration of the Disputed Domain Name and which is protected by multiple trademark registrations, including in Canada. Under similar circumstances, panels have found bad faith given "the uniqueness of the name and its previous use over a long period by the Complainant." *Caseware International Inc., c/o Mr Alan Charlton v. Mr John Lee*, CIRA Case No. 00057. See also, e.g., *The Terminix International Company Limited Partnership v. Eric Dagenais*, Resolution Canada Case No. 00327 (finding bad faith where complainant registered trademark 19 years prior to registrant's registration of the disputed domain name and where the trademark is "a fanciful term that does not have any other meaning"); and *OSIM International Ltd. v. Yulian Hariyanto*, BCICAC Case No, DCA-1789-CIRA (finding bad faith where "the domain name was registered at a time by which the Complainant and its [trademark] brand had become entrenched internationally and had established an active and physical presence in Canada")

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 Policy.

9. Decision

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



Douglas M. Isenberg, sole arbitrator

Dated: April 24, 2017