

According to the rules set forth in CIRA Domain Name Dispute Resolution Policy (Version 1.1 - Effective Date: December 4, 2003) «A Registrant must submit to a Proceeding if a Complainant asserts in a Complaint submitted in compliance with the Policy and the Resolution Rules 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;

(b) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6; and

(c) the Registrant has registered the domain name in bad faith as described in paragraph 3.7.

For the purposes of this Policy, the date of registration of a domain name is the date on which the domain name was first registered in the Registry or the predecessor registry operated by the University of British Columbia».

I will review each of the three branches of the test set out above.

I. - 3(1)a - The domain name « enterprise.ca » is not confusingly similar.

As far as I am concerned this is a difficult issue due to the fact that the Complainant has undeniably acquired rights in the following nominal trade-marks. Evidence filed by the Complainant (Exhibit A of the Complaint) shows registration of three «ENTERPRISE» trade-marks - nominal - car rental services or related services : TMA 535866, TMA 508117, TMA 537905 and two logos «e ENTERPRISE FLEETS INC» and «e ENTREPRISE» trade-marks for same or related services : TMA 535487 and TMA 445 930. In addition, I note that a French version of the trade-mark has been also registered under «ENTERPRISE LOCATION D'AUTOS ET CAMIONS» : TMA 562756. I believe that the distinctiveness of the marks result from the use of the term «ENTERPRISE» which, according to the Complainant's website has been chosen in honour of the *USS Enterprise*, «the aircraft carrier aboard which [Jack Taylor - founder of Enterprise-Rent-A-Car] served as a decorated fighter pilot in World War II» - see, enterprise.com, About Us section. This explains why, in my opinion, the Complainant did not seek to register «ENTREPRISE LOCATION D'AUTO ET CAMIONS» since the meaning and originality of the trade-mark has to be inferred from a historical reference and not from the common sense of «ENTREPRISE» or «ENTERPRISE». Although this reference makes the trade-mark of the Complainant distinctive, it is definitely NOT *inherently* distinctive.

According to the definition of «confusingly similar» found under Section 3.4 "Confusingly Similar", 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". The last part of rule 3.4 sets a test of confusion.

For instance, in the decision CIRA 00034 - MSNSEARCH.ca the panel held that :

“The test of “so nearly resembles the Mark...as to be likely mistaken for the Mark” implies a likely mistake by a person who is aware of the Mark, here “MSN”, prior to looking at the disputed domain name, here “msnsearch.ca”. Commentary on this test has suggested a test of a person with an “imperfect recollection” of the Mark, but the wording clearly contemplates some prior awareness of the Mark. The Policy directs the Panel to consider the near resemblance of the domain name to the Mark in appearance and sound. The first three letters of the domain name are identical in appearance and sound to the entirety of the word portion of four of the six Marks and to the first word portion of the remaining two Marks. The Policy also directs the Panel to consider the impact of “the ideas suggested by the Mark” on a person with a recollection of the Mark, when that person looks at the domain name.”

Neither the idea, nor the recollection test would lead me to conclude that the domain name «entreprise.ca» is confusingly similar. In applying the proper test of imperfect recollection and my personal judgement, I think that a user presented with the domain name «entreprise.ca» would never had made the connection between «entreprise» and «enterprise», meaning the Complainant business Enterprise Rent-A-Car.

The connection could have been inferred from Exhibit 2 of the Complainant which is a print-out of the Respondent's website and which shows under the domain entreprise.ca a search page with at least 20 links (Favorites, Popular Categories) or related links to the rental industry, including competitors' websites, « Enterprise car rental », « Location », « Discount Car Rental »...

This piece of evidence is crucial as it would force the meaning of the trade-mark « ENTERPRISE » into the domain name « ENTREPRISE.CA ». It can almost be interpreted both as an element of bad faith and confusion. However, the Panel is invited to pay attention to the Respondent's contention that: “I have limited control over the content of information provided through the search mechanism which would offer relevant searches and links for popular requests made through the website. I have reasons to believe that the complainant or anyone associated with the complainant could have made repeated requests just days before this complaint was filed, to bring up the claimant's mark and that of it's (sic) competitors in the popular search engine links at “enterprise.ca” ». And, indeed, I understand from Exhibit 6, of the Response, that the search engine software used by the Respondent helps to create targeting links and operates from its selected content - the links appearing on the page - and not at all from the domain name. The user would search information through Google for car rental services and would enter « car rental services » and the Google search engines would show as a result « CAR RENTAL SERVICES - entreprise.ca ». This link points to the Respondent's webpage which, in turn, will offer the user another search engine or would help him/her to define more precisely his/her query (see, Exhibit 6, Response).

The panel should weigh the interests at stake in light of those technical elements and give consideration to the allegation of the Complainant that he « has limited control » over the content and that same content can be changed by repeatedly entering the same query. In fact, the look-and-feel of the entreprise.ca as of April to September 2004 shows substantial differences in its content. Pages of the Respondent's website

archived on the general and public websites archive « archive.org » shows that the Respondent used its search engine and domain name to link to various types of «businesses» or «entreprises», with a particular emphasis on links of a monetary nature (“Money Making Ideas”, “Quick Pay”, “Work from Home”, etc.). The “Car Rental” link (no mention is made of “Enterprise-Rent-a-Car”) accounted for only one (1) of forty-one (41) links on the Respondent’s website during the above mentioned period. (see, www.archive.org, http://web.archive.org/web/*/http://www.entreprise.ca <http://searchportal.information.com/index.mas?epI=UVsPWVALXVUMVV8GVhEUVhFGD0QGG1QAR1RqUVwJBI0M> <http://searchportal.information.com/index.mas?epI=UVsPWVALXVUMVV8GVhEUVhFGD0QGG1QAR1RqUVwJBI0M>)

Those elements lead me to believe that the panel should be careful in weighing the evidence filed by the Complainant and should not discard allegations made by the Respondent in relation with the operation of the website at issue. For all of the above reasons, I would not draw from Exhibit 2 introduced by the Complainant any conclusions as to the elements of confusion or bad faith.

II. - 3.1(b) - Legitimate interest in the domain name as described in paragraph 3.6

I find in favour of the Respondent. Pay-per-click systems based on generic terms or expression is not an illegal, nor a reprehensible commercial practice.

I am of the opinion that the Respondent has a legitimate interest in a domain name under paragraph (b) and/or (c) especially after verifications made through www.archive.org:

« 3.6 (b) the Registrant used 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;

(c) the Registrant used 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 »

I accept the argument that "Respondent's primary purpose for registering the domain was to operate a search service utilizing a generic term that would drive traffic from the Canadian public interested in obtaining information regarding enterprises, businesses and corporations" (Supplemental Response)

III. - 3.1(c) - Good faith

The domain name was not registered in bad faith. For reasons submitted above, exhibit 2 of the Complainant is of a dubious nature and, as such I deem it minor in its relevancy.

Furthermore, I invite the panel to consider the fact that the letter dated January 12, 2004, filed as evidence by the Respondent and which states that « I represent a client who is interested in purchasing the above-referenced domain name - entreprise.ca - from you » is from Schultz and Little, Attorneys at Law, based in Missouri and is or has been the firm representing the Complainant in various litigation files, including domain name disputes, see, for example : <http://www.register.com/udrp/enterprise-v-automart.pdf>.

In the absence of evidence to the contrary 3.7 (a) should not apply : « 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».

I reach the same conclusions for 3.7(b) and (c).

In conclusion, the domain name "enterprise.ca" should not be transferred to the Complainant. I would, however, dismiss the counterclaim for costs presented by the Respondent.

Pierre-Emmanuel Moyse