

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

Dispute Number:
Complainant: Enterprise Rent-A-Car Company
Registrant: Ebenezer Thevasagayam
Disputed Domain Name: entreprise.ca
Registrar: Expert.ca aka VBM Technologies

Panellists: Mr. Jacques Leger Q.C.
Mr. Pierre-Emmanuel Moyse
Mr. Claude Freeman (Chair)

Service Provider: British Columbia International Commercial Arbitration
Centre (the “BCICAC”)

BCICAC FILE NUMBER: DCA-857-CIRA

Complainant is well-known in connection with vehicle rental, leasing, sales and related services. Complainant’s business history in Canada dates back to 1993 when it opened its first branch and registered the Enterprise marks and its various business permutations beginning on November 8, 1995 with CIPO and over the years as business needs and volumes dictated.

On June 1, 2005, the Complainant filed a complaint against the Registrant with the BCICAC, seeking that the Registrant’s registration of <entreprise.ca> be transferred to Complainant’s nominee (its Canadian subsidiary), Enterprise Rent-A-Car Canada Ltd.

The complaint filed by the Complainant was reviewed by the BCICAC and found to be in administrative compliance with the Policy and Rules in accordance with the provisions of Rule 4.2. By letter and by mail dated June 3, 2005, the BCICAC, as dispute resolution service provider, so advised the parties and forwarded by express post and email a copy of the complaint to the Registrant for his response.

The Registrant responded to the complaint on June 21, 2005 by email to the BCICAC (and a copy to the Complainant’s counsel). The Registrant made indications of both mitigating circumstances, as well as the need to find and hire counsel to represent him.

By way of a response by the BCICAC on June 21, 2005 (per Rule 5.4 of BCICAC rules), the time for filing a response by the Registrant was extended to July 14, 2005.

Couriered case matter to one of the panellists was delayed due to a return of one of the courier packs due to an address discrepancy. On July 20, 2005, counsel for the Registrant requested the Panel approve the filing of “supplemental information”. The Panel having been convened,

approved the filing of “supplemental information”, provided that same be in the hands of panel members no later than August 4, 2005. This information was received by panel members as requested on August 4, 2005.

Having granted some extra time for the Registrant to find/hire counsel, and for counsel to finalize a response, the Panel is now prepared to review the complaint and response information, and render a decision in this matter.

Facts

According to the complaint, the Complainant has been doing business in Canada beginning in 1993, under the “Enterprise” name and logo. The Complainant has conducted business in vehicle leasing, rental, sales and related services.

The Registrant confirms in its response that they did on December 31, 2003 register <entreprise.ca>, along with a host of 56 other domain names. The Complainant alleges in its pleadings that the Registrant’s domain name <entreprise.ca> is confusingly similar to the Enterprise marks listed and registered since 1995 in as much that it resembles the Complainant’s marks in appearance, sound and idea.

The Complainant alleges further that the Registrant’s registered name is the French language equivalent of Registrant’s famous name. The Complainant also alleges that the minor spelling difference that is related to the language difference is insufficient to create a distinct domain name under CIRA Policy, given the Internet users’ tendency to make typing errors that can easily lead them to a different website than they had intended.

The Complainant relies in its pleadings on CIRA case history of Amazon.com vs. David Abraham, DCA-784-CIRA (BCICAC, July 28, 2004) (<amazons.ca> found to be confusingly similar to the Complainant’s Amazon marks, despite addition of the letter “s”).

The Complainant pleads further that any and all confusion heretofore alleged is compounded by the fact that the Registrant improperly uses the Complainant’s trademarked name on its website in association with car rental services – and does so without the Complainant’s authorization.

Overall, the Registrant’s response cites that: the word “entreprise” in the name <entreprise.ca> is a French generic word and that the Complainant has no registered trademark on the “entreprise” name. The Registrant confirms the registration of <entreprise.ca> by himself on December 31, 2003, by way of a pay-per-click search mechanism.

To the point of complaint, the Registrant alleges to never having been contacted by the Complainant or any of its legal representatives to make changes to the Registrant’s website, and by failing to do so have done nothing to protect any of its interests in its marks.

The Registrant indicates in its response that the Complainant is utilizing its corporate pressure to extricate a domain from an individual in business whose resources are otherwise scant. In its defence, the Registrant relies on CIRA Dispute Case AIR-030415-001009 - Air Products Canada

Ltd. vs. Index Quebec Inc., where the panel found the domain name not confusingly similar to the Complainant's trademark, despite similarities in names and business models.

Reasons

Paragraph 4.1 of the Policy places the onus on the Complainant to prove, cumulatively, on a balance of probabilities that the Disputed Domain Names are confusingly similar to the Enterprise marks and that the Registrant has registered the Disputed Domain Name in bad faith. In addition, the Complainant is required under this paragraph to provide "some evidence" that the Registrant has no legitimate interest in the Disputed Domain Name.

1. Confusingly Similar

The first test is whether the Disputed Domain Name is confusingly similar to Complainant's domain name.

The evidence before us shows that the Complainant has been using the Enterprise marks both corporately from 1993 and by way of CIPO registration since 1995. The registration of the French domain <entreprise.ca> in December 2003 by the Registrant is 10 years after both the registrations by the Complainant of its marks, as well as 10 years after the gradual build-up of the Complainant's notoriety in the car rental business marketplace.

If one wishes to address the issue of confusion with the standard legal test prevailing in Canada, one can find that in determining whether or not there exists a reasonable likelihood of confusion between the trademarks at issue, the Registrar must have a regard to all the surrounding circumstances, including non-exhaustively, those specifically enumerated in Subsection 6 (5) of the Canadian Trademarks Act:

- a) inherent distinctiveness of the trademarks, and the extent to which they have become known;
- b) length of time the trademarks have been in use;
- c) nature of wares, services or business;
- d) nature of the trade; and
- e) degree of resemblance between the trademarks in appearance or sound in the ideas suggested by them.

A generally accepted principle when applying the test of confusion is looking at the trademarks in their entirety, from the point of the unwary consumer – comparing similarities as opposed to differences, having only a vague recollection of the former. Can the consumer be easily misled by error or otherwise – and perhaps not even know?

The majority of the Panel concludes on this issue that the Complainant has met its onus of demonstrating the existence of a "confusingly similar" circumstance.

2. Legitimate Interest

A sufficient and initial satisfactory proof brought on by the Complainant and pertaining to the Registrant's lack of legitimate interest in the present case, forces the Registrant to rebut, explain or otherwise plead this issue. Failing to do so permits, in some circumstances, the panel to make a negative inference.

The Registrant having failed to attempt to successfully / satisfactorily justify its legitimate interest or to explain the presence of Complainant's competitors on its website, the majority of the Panel finds in favour of Complainant on this issue as well.

3. Registration in Bad Faith

The fact that the Registrant has links to the Complainant's competitors such as: Budget, Dollar, Discount, Thrifty and other competitors, and that it writes the name of the domain name in its English version (see exhibit 2 ?) has the effect of disrupting or potentially disrupt the Complainant's business, and in our opinion, meet the requirements set out in Section 3.7(c) of the CIRA Policy, thereby demonstrating the Registrant's bad faith.

The difficulty with being able to clearly show bad faith, at the time of registration and use – and to do so with concrete evidence is not so simple.

The Panel must first rely upon what it feels is the obligation of the Complainant to make out a prima facie case. Once the Panel is presented with what it considers a prima facie case, the Registrant must attempt to respond, and rebut the case advanced by the Complainant.

As in most of these circumstances, any failure to contradict the Complainant's allegations and convince the Panel otherwise, may again lead to a negative inference.

The Panel has reviewed the Registrant's argument that the words "enterprise" and "entreprise" are diluted and not distinctive – the Panel feels that the word "enterprise" is distinctive in the car rental industry. Given that the marks are registered (and presumably by virtue of the Complainant's annual sales volume) the mark is deemed valid and distinctive – for which the Registrant has been unable to otherwise establish.

In its pleadings, at Exhibit "B", the Complainant has presented what the Panel feels is adequate initial proof demonstrating the Registrant's bad faith, with the Complainant noting the links on the Registrant's webpage to competitors of the Complainant.

Language: although French and English are of equal value in Canada, the Trademarks Act applies across Canada, but provides under Paragraph 12(1)(b) that a trademark is not registrable if it is "either clearly descriptive or deceptively misdescriptive in the English or French language of the character of quality of the wares or services...".

In short, if there is risk of confusion in either of the country's two official languages, a trademark cannot be registered. (Pierre Fabre Médicament c. Smith Kline Beecham Corp., 2001 CAF13).

The majority of the Panel therefore concludes that these facts meet the requirements of bad faith (per Section 3.7 of the Policy and finds in favour of complainant.

Balance of Probabilities

Even if a complainant has met the burdens of proof contained in Paragraph 4.1, a complaint will be dismissed if the registrant is able to prove on a balance of probabilities that the registrant has a legitimate interest in the disputed domain name. Again, such “legitimate interest” must meet one or more of the six tests set out in Paragraph 3.6 of the Policy and referred to above.

This balance of probabilities test in Paragraph 4.1 of the Policy deals with the situation where even though a complainant has satisfied all of the burdens of proof contained in Paragraph 4.1, a Panel believes that justice requires the registrant to succeed. In finding against a registrant, the Panel is depriving that registrant of a property interest. Such a decision should not be taken lightly. Therefore, even if a Panel finds that a complainant has satisfied the rather heavy burdens of proof placed on it by Paragraph 4.1, if the Panel is satisfied that on a balance of probabilities the registrant has a legitimate interest in the disputed domain name, the Panel must find for the registrant and dismiss the complaint.

In the case at hand, the Panel is satisfied that on a balance of probabilities, based upon the evidence before it that the Registrant has no legitimate interest in the Disputed Domain name.

Decision and Order

We find that the Complainant, having satisfactorily met its burden on all three elements, should succeed in this proceeding initiated under the Policy.

We therefore direct that the registration of <entreprise.ca> be transferred to the Complainant’s nominee, its Canadian subsidiary: Enterprise Rent-A-Car Canada Ltd.

Dated this 22nd day of August 2005.

For the majority

Claude Freeman, Chair

I concur,

Jacques Leger Q.C.