

**IN THE MATTER OF A COMPLAINT PURSUANT TO THE
CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

Case number: DCA-891-CIRA

Disputed Domain Name: **gmacmortgages.ca**

Complainant: General Motors Acceptance Corporation

Registrant: Bob Woods

Service Provider: British Columbia International Commercial Arbitration Centre

Panel Members: James E. Redmond Q.C. (Chair)
Denis Sauve
Harold Margles

Panel Decision

1. Parties and Disputed Domain Name

The Complainant is General Motors Acceptance Corporation, whose address is 200 Renaissance Center, P.O. Box 200, Detroit, Michigan 48265-3000 USA. The Complainant is represented by Eric Macramalla of the law firm of Gowling Lafleur Henderson LLP, 160 Elgin Street, Suite 2600, Ottawa, Ontario K1P 1C3, Canada.

The Registrant is Bob Woods, of 2733 Concession Road 7, Bowmanville, Ontario L1C 3K6, Canada. The Registrant's Authorized Representative is Clinton D. Banbury, 211 Guelph Street, Suite 2, Georgetown, Ontario, L7G 5B5 Canada.

The disputed domain name is **gmacmortgages.ca**. The Registrar for that domain name is Canadian Domain Name Services Inc., 27-1300 King St. E., Suite 135, Oshawa, Ontario L1H 8J4 Canada.

2. Procedural History

This is a dispute resolution proceeding initiated under the CIRA Dispute Resolution Policy (the "Policy") and the CIRA Domain Name Dispute Resolution Rules (the "Rules"). By registration of the domain name with the Registrar, the Registrant agreed to the resolution of certain disputes pursuant to the policy and the Rules.

According to information provided by the Service Provider, the British Columbia International Commercial Arbitration Centre, the history of this proceeding is as follows:

- (a) The Complainant filed a complaint with respect to the above-referenced domain name in accordance with the Policy on December 7, 2005. The Complaint was reviewed and found to be compliant, and the Service Provider forwarded a copy of the Complaint to the Registrant on December 8, 2005 in accordance with the Rules.
- (b) The Registrant has not provided a Response.
- (c) The Complainant has not elected, as it was entitled under Rule 6.5 to do in the absence of Response from the Registrant, to convert from a panel of three to a single arbitrator, and the Service Provider has therefore appointed a panel of three arbitrators, James E. Redmond Q.C., Denis Sauve, and Harold Margles (collectively "the Panel").
- (d) Each of the members of the Panel has delivered to the Service Provider an Acceptance of Appointment as an Arbitrator and a Statement of Independence and Impartiality, in conformity with the Rules.

Both the Complaint and the Response were filed in English, which is accordingly the language of the proceeding.

The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Rules and that, based upon the information provided by the Service Provider, all procedural requirements for the commencement and maintenance of this proceeding were met.

3. Facts

The Complainant General Motors Acceptance Corporation ("GMAC") has been in operation in Canada since 1919. It is a wholly-owned subsidiary of General Motors ("GM"). GMAC operates worldwide, having a presence in 41 countries. It offers automotive and commercial financing services, mortgage services, insurance services and real estate services. GMAC operates through a number of companies using the GMAC name. These include GMAC Mortgage Operations, which has business units engaged in the provision of residential and commercial mortgages. In March, 2002, GMAC Residential Funding of Canada Limited was incorporated to offer residential mortgage loans across Canada through Mortgage Intelligence.

The Complainant, GMAC, is the registered owner of the Canadian trade-mark GMAC, registration No. TMA 102,889, registered March 16, 1956. The Complainant also is the owner

of the Canadian trade-mark GMAC INSURANCE, registration No. TMA 554,633, registered November 29, 2001 and the Canadian trade-mark GMAC INSURANCE & Design, registration No. TMA 554,630, registered November 29, 2001.

The GMAC trade-mark has been used in Canada in association with financing services, commercial mortgage services, residential mortgage services, real estate services and insurance services, and this use precedes the registration date of the domain name in dispute, and is well known throughout Canada in connection with the provision of such services.

The Complainant GMAC has also used and continues to use GMAC as part of a number of trade names in Canada, including: (i) GMAC Residential Funding of Canada Limited/Financement Residentiel GMAC du Canada Limitee, incorporated in March 2002 and used shortly thereafter; (ii) GMAC Commercial Mortgage of Canada, Limited/Hypothèque Commerciale GMAC du Canada, Limitee, incorporated in June 1998 and used in Canada since at least as early as 1999; and (iii) GMAC Real Estate (Canada), registered in February 2001 and used in Canada in 2001. The GMAC trade names are well known throughout Canada.

GMAC has operated many websites worldwide since 1996, including the website located at **gmacmortgage.com** which operates internationally. It also operates **gmacresidentialfunding.ca** (Canada), **gmacresidentialfunding.com** (international), **gmacrealestate.ca** (Canada) and **gmacrealestate.com** (international), as well as many other websites worldwide which include **gmac**.

The Registrant, Bob Woods, was employed by Mortgage Intelligence as a mortgage broker from March, 2001 to December, 2001, when he submitted his resignation. The Registrant registered the domain name **gmacmortgages.ca**, without the permission of the Complainant GMAC, on November 11, 2002. The **gmacmortgages.ca** domain name resolves to a website that advertises the Registrant's services as a mortgage broker for Assured Mortgages, which is a mortgage business competitive with GMAC.

The Complainant GMAC, through its legal counsel, sent a cease and desist letter to the Registrant on January 7, 2005, advising the Registrant of GMAC's rights in its Marks and requesting that **gmacmortgages.ca** be transferred to the Complainant. By a letter dated January 12, 2005, Registrant's counsel stated that the Registrant:

... is a principal of Amazon Developments Corp., which filed a business name registration some time ago to carry on business under the name "Georgetown, Milton, Acton Combined (GMAC) Mortgages". It became apparent that this name was too long in a practical sense and cumbersome with respect to its usage on a day to day basis. Consequently the name was shortened and the business name GMAC Mortgages was registered as a division of Amazon Developments Corp. The domain name **gmacmortgages.ca** is also registered in this regard.

Business Names Reports submitted by the Complainant confirmed that on January 16, 2003 the Registrant registered the business name Georgetown, Milton, Acton Combined (GMAC) Mortgages, indicating that the activity being carried out was "mortgage brokers", and that on

December 16, 2004 the Registrant registered GMAC Mortgages, showing the activity being carried out as “mortgage brokering/life insurance sales.”

4. Claimants Contentions

The Complainant contends that its trade-marks and trade names constitute Marks within the terms of paragraph 3.2 of the Policy, and that by virtue of its use of the Marks in Canada, the Complainant has Rights in the Marks. It further contends that the disputed domain name registered by the Registrant is confusingly similar with the Complainant’s Marks, in particular the registered Canadian trade-mark GMAC.

The Claimant further contends that the Registrant has no legitimate interest in the disputed domain name, and that the domain name has been registered in bad faith. It requests transfer of the disputed domain name to the Complainant.

As previously stated, the Registrant has filed no Response.

5. Canadian Presence Requirements

Under paragraph 1.4 of the Policy, the Complainant must, at the time of submitting a complaint, satisfy the Canadian Presence Requirements for Registrants in respect of the domain name unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office and the Complainant is the owner of the trademark.

In this case, the Complainant is the owner of the registered Canadian trade-mark “GMAC”, and its complaint relates to that trade-mark. Under the Canadian Presence Requirements for Registrants, paragraph 2(q) a person “which is the owner of trade-mark which is the subject of a registration under the Trade Marks Act (Canada) may submit an application to register a .ca domain name but is limited to a domain name consisting of or including the exact word component of that registered trade-mark.” Thus, GMAC, as owner of the registered Canadian trade-mark GMAC, would be permitted to submit a .ca domain name consisting of or including “gmac”, and it is therefore eligible to submit a complaint under paragraph 1.4 of the Policy.

6. Discussion and Reasons

(a) Is gmacmortgages.ca confusingly similar with the Complainant’s Mark?

The registration and use of the trade-mark GMAC, and of the other registered trade-marks and trade names used by GMAC, as referenced above, pre-date the registration of **gmacmortgages.ca** by the Registrant. Under Paragraph 3.4, 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 have been mistaken for the Mark. The trade-mark GMAC registered in the CIPO by the Complainant constitutes a Mark under paragraph 3.2© of the Policy. The other trade-marks and trade-names described above also qualify as Marks under paragraph 3.2 (a) of the Policy, having been used in Canada to distinguish the services or business of the Complainant. Under paragraph 3.3, the Complainant has Rights to the Marks.

The addition of descriptive or non-distinctive terms in a domain name will not prevent it from being found confusingly similar with a Complainant's Mark. In *Quixstar Investments, Inc. v. Dennis Hoffman*, WIPO case number D2000-0253, the Panel held:

The domain name in issue - QUIXSTARMORTGAGE.com - is legally identical to Complainant's Mark QUIXSTAR. The addition of the generic terms "MORTGAGE" and ".COM" to the domain name in dispute has little, if any, effect on a determination of legal identity between the domain name and the Mark.

In *Nikon, Inc. and Nikon Corporation v. Technilab, Inc.* WIPO case number D2000-1774, the Panel said, in part:

Thus, when a domain name wholly incorporates a Complainant's registered Mark, that is sufficient to establish identity or confusing similarity for the purposes of the policy.

The Panel in *SWATCH v. Stefano Manfroi*, WIPO case number D2003 held that the inclusion of the distinctive element of the Complainant's Mark in the disputed domain name was sufficient for a finding of confusion under the Policy, irrespective of the addition of other non-distinctive words:

The addition of the words "news", "discovery" and "research" do not constitute distinguishing elements in the domain names. The Panel finds as previously established in numerous WIPO decisions, *inter alia PepsiCo, Inc. v. Diabetes Home Care, Inc.*, WIPO case number D2001-0174 and *America Online, Inc. v. Chris Hoffman*, WIPO case number D2001-1184, that the addition of common nouns to a famous trade-mark does not change the overall impression of association with the Complainant.

Here, the disputed domain name includes the whole of the Complainant's registered trade-mark GMAC. The Panel finds that the fact that the domain name includes in addition the word "mortgages" and ".ca" does not prevent a finding that the domain name and the Complainant's mark are confusingly similar. The fact that the whole of the distinctive element of the GMAC Marks, namely GMAC, is incorporated in the domain name, is sufficient to support a finding of confusing similarity. In fact, as the Complainant submits, the addition of the word "mortgages" in the domain name enhances the likelihood of confusion. The Complainant GMAC offers mortgage services, which is likely to lead potential consumers to believe that the impugned domain name is a reference to the Complainant GMAC. The existence of the Complainant's other trade-marks and trade names incorporating GMAC further adds to the likelihood of confusion. Accordingly, the Panel finds that the domain gmacmortgages.ca is confusingly similar to the Complainant's Mark GMAC.

(b) Did the Registrant register the domain name in bad faith?

Under the provisions of paragraphs 3.1, 3.7 and 4.1 of the Policy, a Complainant is required to establish that the Registrant registered the domain name in bad faith. The grounds for a finding

of registration in bad faith are set out in subparagraphs (a), (b) and (c) of paragraph 3.7. The Complainant in this case relies on paragraph 3.7(c) which provides that a Registrant will be considered to have registered a domain name in bad faith if:

(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.

The Complainant submits that the Registrant registered gmacmortgages.ca primarily for the purpose of disrupting the business of the Complainant GMAC, who is a competitor of the Registrant. The Complainant refers to *Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)*, BCICAC case number 00020 for the proposition that a Registrant disrupts the business of a competitor if it offers goods or services that compete with, or rival, the goods or services offered by the trade-mark owner. In further support of this proposition, the Complainant cites:

- *CanadaDrugs.com Partnership v. NC Britton Holdings Ltd. o/a Minit Drugs*, BCICAC case number 00028
- *Browne & Co. Ltd./Lteé v. Bluebird Industries*, BCICAC Case No. 00002
- *Elysium Wealth Management Inc. v. Brian Driscoll*, Resolution Canada case number 00005
- *Sleep Country Canada Inc. v. Pilfold Ventures Inc.*, Resolution Canada case number 00027
- *Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)*, *supra*
- *Credit Counselling Society of British Columbia v. Solutions Credit Counselling Service Inc.* BCICAC case number 00031.

The Complainant and the Registrant are competitors, in that each offers mortgage services and insurance services. Several factors in this case strongly support the conclusion that the domain name was registered primarily for the purpose of disrupting the business of the Complainant. The use of GMAC in the domain name is likely to redirect internet users to the Registrant's website. The Registrant no doubt would understand, particularly given his former employment with Mortgage Intelligence, that including the very well known name GMAC in his website was likely to mislead customers or would be customers of the Complainant and to direct them to the Registrant's website.

The following comment by the Panel in *Sotheby's (Canada) Inc. v. PII Technologies Inc. and Keith Lihou* BCICAC case number 0026 is pertinent here:

The Registrant is using the domain name in association with services that are similar if not identical to services offered by

the Complainant. Internet users who come upon the Registrant's website may reasonably believe that it is the Complainant's website or is endorsed, sponsored or approved by the Complainant.

The Panel finds that the Registrant registered the domain name in bad faith.

(c) Does the Registrant have a legitimate interest in the contested domain name?

Paragraph 3.6 of the Policy defines the circumstances under which the Registrant has a legitimate interest in a domain name. It provides:

3.6 Legitimate Interests. The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a Complaint was submitted:

(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 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;

(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.

In paragraphs 3.6 (b), (c), and (d) "use" by the Registrants includes, but is not limited to, use to identify a web site.

There is no evidence that the terms "GMAC" or "gmacmortgages" constituted a Mark owned by the Registrant. The Registrant operated as a mortgage broker for Assured Mortgages. Although the business name "Georgetown, Milton, Acton Combined (GMAC) Mortgages" was registered by Amazon Developments Corp., a company with which the Registrant may be connected, this is obviously a thinly-veiled attempt to try to justify the use of the acronym GMAC. The Panel notes that while the letters gmac in the domain name may purport to have been derived from the first letters of three place names in Ontario, (this doesn't explain "Combined"), it is unlikely that users of the internet would recognize these letters in the domain name as an acronym for those places - it is more likely that they would recognize them as being associated with the Complainant GMAC.

Rather than showing any legitimate reason for using the term GMAC, this simply constitutes more evidence that the Registrant was not acting in good faith when he registered the domain name and that he had no legitimate interest in that name.

The Tribunal concludes that the evidence before it does not reveal that the Registrant has a legitimate interest in the domain name under any of the subsections of section 3.6 of the Policy.

7. Conclusion

The Panel has decided this dispute in favour of the Complainant. The Complainant is an entity which is permitted under the Canada Presence Requirements for Registrants to hold and maintain the registration of a domain name, and the Panel therefore directs that the domain name **gmacmortgages.ca** be transferred to the Complainant

Dated this ____ day of January, 2006.

James E. Redmond Q.C, Chair


Denis Sauve

Harold Margles