

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

Complainant: Enterprise Rent-a-Car Company
Complainant’s Representative: David R. Haarz
Reston, Virginia USA

Registrant: Supriyo Malaker o/a DotCrafter

Disputed Domain Names: ecar.ca & ecars.ca

Registrar: Sibername Internet and Software Technologies Incorporated

Panel: Paul W. Donovan, Sharon Groom, Denis N. Magnusson (Chair)

Service Provider: Resolution Canada

DECISION

Parties

The Complainant is Enterprise Rent-a-Car Company of St. Louis Missouri USA. The Registrant is Supriyo Malaker o/a DotCrafter of Brampton Ontario Canada.

Disputed Domain Name and Registrar

The disputed domain names are **ecar.ca**, registered January 24, 2002 and **ecars.ca**, registered on February 1, 2001. The Registrar is Sibername Internet and Software Technologies Incorporated.

Procedural History

The Complainant filed a Complaint with the Provider Resolution Canada on September 20, 2007. The Provider finding the Complaint to be in order transmitted the Complaint to the Registrant. The Registrant submitted a Response. The Provider appointed Paul W. Donovan, Sharon Groom and Denis N. Magnusson to the Panel.

Relief Requested

The Complainant requested that the Panel order that the domain name registrations be transferred from the Registrant to the Complainant.

Background Facts

The Complainant

Enterprise-Rent-a-Car Company established its first vehicle rental office in Windsor Ontario in 1993 under the name ECARS. It has operated car rental offices in Canada under the name Enterprise since 1995. It is the largest car rental company in North America.

The Complainant registered the mark <ecar> as a trademark in the Canadian Intellectual Property Office (“CIPO”) for, among other services, “vehicle leasing and rental” on July 21, 2001. The Complainant registered the mark <ecars> in the CIPO as a trademark for, among other services, “vehicle rental” on July 21, 1995.

The Registrant

The Registrant Supriyo Malaker o/a DotCrafter of Brampton Ontario, among other professional and business activities designs and develops websites for clients in Canada and the US. In the course of his business the Registrant has acquired “many” domain names “in bulk without screening in some occasions”. In relation to his business he states that he has “interest in any descriptive [domain names]”. As noted, the Registrant registered the domain name <ecars.ca> on February 1, 2001 and the domain name <ecar.ca> on January 24, 2002.

The Dispute

In 2002 the Complainant contacted the Registrant to ask that the ecar.ca and ecars.ca domain names be transferred to the Complainant. The Registrant refused to transfer the domain names stating that he believed that he was entitled to retain the domain names under the CIRA Policy.

The Complainant filed this Complaint on September 20, 2007.

Eligible Complainant

An eligible Complainant under the Policy includes any person who is the owner of a trademark registered in the CIPO, to which trademark the dispute relates, Policy 1.4. The Complainant is the registered owner of the trademark **ecar** registered in the CIPO on July 18, 2001 and **ecars** in the CIPO on July 21, 1995. As the registered domain names are ecar.ca and ecars.ca, the Complainant’s CIPO trademark registrations are clearly trademark registrations to which this dispute relates. On this basis, as well as other bases not dealt with here, the Complainant is an eligible Complainant under the Policy.

Onus on Complainant

Policy 4.1 requires that:

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 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 3.7;

and the Complainant must provide some evidence that:

- (c) the Registrant has no Legitimate Interest in the domain name as described in paragraph 3.6.

[emphases added]

(a) Confusingly Similar

Marks in Which Complainant Had and Has Rights

Policy, 3.2(c) states a “Mark” includes a trademark registered in the CIPO. CIPO registration constitutes “Rights” in such registered Mark for the trademark registrant, under Policy 3.3.(b). The Complainant registered the trademarks **ecar** and **ecars** for vehicle rental among other services which registrations remained on the CIPO register at the time of the filing of this Complaint. The Complainant has to have acquired such Rights in the Mark prior to the date of

the registration of the disputed domain names. The Complainant had acquired such Rights prior to the registration of the relevant domain names as noted immediately below:

ecars CIPO registered on July 21 1995 *vs.* domain **ecars.ca** registered on February 1, 2001
ecar CIPO registered on July 18 2001 *vs.* domain **ecar.ca** registered on January 24, 2002

Confusingly Similar

Policy 3.4 defines “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.

In assessing similarity, the dot-ca suffix of the domain name is ignored, Policy 1.2. The registered trademarks upon which the Complainant bases its Complaint are **ecar** and **ecars** and the respective domain names without the dot-ca suffix are **ecar** and **ecars**. The Marks and the respective domain names are identical.

Thus, the domain names are likely to be mistaken for the relevant Marks and are therefore Confusingly Similar.

b) Bad Faith

Policy, 3.7 has a restrictive definition of what can constitute the Registrant’s necessary Bad Faith in registering the domain name. That definition states that there will be Bad Faith, “*if, and only if*” one or more of three specific circumstances obtain. The Complainant submitted that the Registrant had registered the domain names in Bad Faith under Policy 3.7(c):

(c) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant . . . who is a competitor of the Registrant.

Decided cases under the CIRA Policy, with which this Panel concurs, have stated that the purpose of a Registrant in registering a domain name can reasonably be inferred from the uses to which the Registrant puts the registered domain name.

The Complaint noted that the Registrant’s domain name ecar.ca resolves:

“. . . to a website with the heading

Search Results for:

cheap car rental

What you need, when you need it

The main portion of the web page at ecars.ca contains “Sponsored Links”. Those links are to the main web pages for a number of Complainant’s direct competitors, Avis Rent A Car, Dollar Rent a Car, and Budget Rent A Car.”

The Complaint noted that the Registrant’s domain name ecars.ca resolves:

“ . . . to a website with the heading:

Usedcar-newcar-rentalcar.ca
What you need when you need it

The main portion of the web page at ecars.ca contains a list of links labelled “hot”. Among the links are to main web pages for Budget Car Rental, one of the Complainant’s direct competitors and Cheap Car Rental a travel site that offers car rentals from a number of car rental companies, including both the Complainant and its competitors.”

Decided CIRA cases have ruled that the Registrant’s creating a web site at the disputed domain name from which there are links to competitors of the Complainant constitutes the Registrant a “competitor” of the Complainant for the purposes of Policy 3.7(c). Further, those cases have ruled that so linking to competitors of the Complainant, at a web site reached through a domain name which has been found Confusingly Similar to the Complainant’s Mark, constitutes “disrupting the business” of the Complainant.¹

On the noted facts of this dispute and the above analysis concerning inferences about the Registrant’s intent in registering the domain name, the Panel finds that the Registrant did register the domain name in Bad Faith as defined in Policy 3.7(c).

c) Legitimate Interest

Complainant’s Burden

The Complainant has the burden of providing “some evidence” that “the Registrant has no Legitimate Interest in the domain name[s] as described in paragraph 3.6”. The Complainant made submissions, based on the facts of this dispute, endeavouring to satisfy the requirement of submitting *some* evidence that the Registrant has no Legitimate Interest in the domain names. The Panel finds that the Complainant has provided *some* such evidence in its Complaint.

Registrant’s Burden

Policy 4.1 provides:

Even if the Complainant proves (a) [Confusingly Similar] and (b) [Bad Faith] and provides some evidence of (c) [No Legitimate Interest], 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 3.6.

Paragraph 3.6 stipulates that the Registrant has a Legitimate Interest in a domain name “if, and only if” the Registrant has one or more of the six specific interests set out in Policy 3.6(a) to (f). The Registrant submitted that he had an Legitimate Interest under Policy 3.6(b) and 3.6(c):

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

¹ CIRA case 00027, *Sleep Country Canada Inc. v. Piffold Ventures Inc.* at note 10, and cases cited there.

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;

- 3.6(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;

The Registrant submitted that the prefix “e” had become a “universal prefix of the Internet age”. Effectively, he submitted that the prefix “e” added to any descriptive term or any generic name of wares, services or business, or at least when added to the generic terms “car” or “cars” would itself constitute a clearly descriptive term or a generic name.

While the Registrant may well be right that “e” has become often used prefix for commercial terms in the Internet age, that does not make any term prefixed by “e” either a clearly descriptive term or a generic name. The prefix “e” is not clearly descriptive of anything. It *suggests* some kind of connection to the “electronic” age, but what that connection is, is far from clear merely from the use of the “e” prefix. The mere use of the “e” prefix certainly falls short of the Policy test of “*clearly* descriptive” [Policy 3.6(b)] or the Policy test, when the “e” is prefixed to a common noun, of being “understood in Canada to be the *generic name*” of anything [Policy 3.6(c)].

Thus, the Panel finds that the Registrant has not shown, on a balance of probabilities, that the Registrant has a Legitimate Interest in the domain names as defined by the Policy.

Conclusion

The Complainant has satisfied the Complainant’s burden under the Policy of establishing Confusing Similarity, Bad Faith, and some evidence that the Registrant does not have a Legitimate Interest in the domain names. The Registrant has failed to show that it has a Legitimate Interest in the domain names.

Order

For the reasons set out above, the Panel grants the relief requested by the Complainant and orders that the domain name registrations for ecar.ca and ecars.ca be transferred to the Complainant.

Date: December 4, 2007

Signed:

Paul W. Donovan

Denis N. Magnusson (Chair)

Sharon Groom