

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

Dispute Number: DCA-1020-CIRA
Domain Name: yamahamotors.ca
Complainant: Yamaha Corporation and Yamaha Motor Canada Ltd.
Registrant: Jim Yoon
Registrar: Internic.ca Corp.
Panel: W.A. Derry Millar
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

THE PARTIES

1. The Complainants are Yamaha Corporation., 10-1 Nakazawa-cho, Hamamatsu-shim, Shizuoka-ken, Japan and Yamaha Motor Canada Ltd., 480 Gordon Baker Rd., Toronto, Ontario, Canada M2H 3B4.
2. The Registrant is Jim Yoon, 156-15, 46 Avenue, 2nd Floor, New York, NY 11355, USA.

THE DOMAIN NAME AND REGISTRAR

3. The Domain Name in issue in this proceeding is: yamahamotors.ca.
4. The Registrar is: Internic.ca Corp. of Oshawa, Ontario.
5. The Domain Name was registered by the Registrant on April 12, 2005.

PROCEDURAL HISTORY

6. The British Columbia International Commercial Arbitration Centre (“BCICAC”) is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy (“Policy”) of the Canadian Internet Registration Authority (“CIRA”).
7. According to the information provided by the BCICAC:

- (a) The Complainants filed a Complaint with respect to the domain name in issue in accordance with the Policy on September 10, 2007;
- (b) The Complaint was reviewed and found to be compliant. By letter dated September 10, 2007, the BCICAC as Service Provider confirmed compliance of the Complaint and commencement of the dispute resolution process;
- (c) The Registrant has not provided a Response;
- (d) As permitted under CIRA Domain Name Dispute Resolution Rules (“Rules”) the Complainant elected under Rule 6.5 to convert from a panel of three to a single arbitrator.

8. On October 17, 2007, the BCICAC named W. A. Derry Millar as the Panel.

9. The Panel has reviewed all of the material submitted by the Complainants and is satisfied that the Complainants are eligible Complainants under the Policy and Rules.

10. The information provided to the Panel by the BCICAC did not disclose when or in what manner the Registrant was served with the Complaint.

11. By e-mail dated October 22, 2007, sent to the BCICAC, and to the solicitor for the Complainants and the Registrant at the e-mail address provided for him in the domain name Registration Information, the Panel requested that the BCICAC advise him when and in what manner the Registrant was served with the Complaint.

12. As a result of an exchange of e-mails between the BCICAC and the Panel, the Panel was advised that:

- (a) On September 10, 2007, the Complaint and Schedules was sent to the Registrant by FedEx courier to the postal mail address shown on the Registration Information for the Registration of the domain name provided by the Complainants in their Complaint. FedEx was unable to deliver the parcel as the Registrant had moved. The parcel was returned to the Provider.
- (b) The BCICAC also attempted to deliver by FedEx courier a parcel containing the Complaint and Schedules to the Registrant at an address found by the BCICAC through a search of the internet phone book and through telephone calls to New York City information. The address the BCICAC obtained was in Flushing, New York. FedEx was unable to deliver the parcel at this address and it was returned.
- (c) The BCICAC also e-mailed the Complaint and Schedule to the Registrant in accordance with Rule 2.1(b). The BCICAC received no indication that delivery of the e-mail was not successful.

13. The Panel sent a number of e-mails to the BCICAC, the solicitor for the Complainants and the Registrant on October 17, 2007, October 22, 2007, October 23, 2007, October 26, 2007, October 29, 2007 and October 30, 2007, with respect to the Complaint and

service. The Panel received no indication that the delivery of the e-mails to the Registrant was not successful.

14. Paragraph 2.1 of the Rules provides:

"2.1 **Notice.** When sending a Complaint to the Registrant, the Provider shall communicate in both English and French and shall use whatever reasonably available means are likely to give actual notice to the Registrant. Notice will be deemed to be given by the Provider if the Complaint, including Schedules, is:

(a) transmitted by facsimile or delivered by prepaid postal or courier service, return receipt requested, to all facsimile and postal mail addresses:

(i) of the Registrant and the administrative contact of record in the Registration Information for each Registration in issue

(b) transmitted electronically via the Internet, in the case of Schedules to the extent possible, provided that a record, which includes the contents of the email and the date of transmission, is verifiable, to:

(i) the e-mail addresses for the administrative contact of record in the Registrant Information for each Registration and email address for the Registrar in respect of each Registration; *(amended 2003-12-04)*

(ii) "postmaster@<the contested domain name>"; and

(iii) if the domain name (or "www." followed by the domain name) resolves to an active web page (other than a generic page which the Provider reasonably concludes is maintained by a Registrar or an Internet service provider for parking domain names registered by multiple domain name registrants), any e-mail address, shown or e-mail link, on that web page; and

sent in any form to any address which the Registrant has given notice to the Provider as one it prefers and, to the extent practical, to all other addresses of the Registrant provided to the Provider by the Complainant pursuant to paragraph 3.2 (d). The Provider shall notify the Registrar in respect of each Registration of the commencement of the complaint."

15. It is the responsibility of the Registrant to provide postal mail addresses and e-mail addresses that are current and operative. The BCICAC as Service Provider sent the Complaint and its Schedules to the postal mail address shown on the Registration Information of the Registrant. The Registrant is shown as both the administrative contact and technical contact in the Registration Information with the same postal mail address and e-mail address.

16. The dispute resolution system was designed to permit quick, efficient resolution of domain name disputes. The system should not be frustrated by a Registrant who does not maintain an up-to-date postal mail address and operating e-mail.

17. Rule 2.1 provides as noted, that "notice will be deemed to be given by the Provider if the Complaint including Schedules, is: (a)delivered by prepaid....courier service...to all postal mail addresses (i) of the Registrant and the administrative contact of record in the Registration Information for each Registration." In the Panel's view, service of the Complaint may be deemed to have been given under Rule 2.1. In any event, the Panel believes that the e-mails sent to the Registrant have been received by him given that there is no indication that his e-mail address is not operable and there was no indication that delivery of the e-mails was not successful.

18. In accordance with Rule 5.8, where, as here, no Response is submitted, the Panel shall decide the Proceeding on the basis of the Complaint.

FACTS

19. The Complainant, Yamaha Corporation ("Yamaha") is a corporation incorporated under the laws of Japan. The Complainant, Yamaha Motor Canada Ltd. ("Yamaha Canada") is a corporation incorporated under the laws of Canada.

20. The Complainant Yamaha, and its group of companies, manufacture and sell a wide range of goods and services, including, without limitation, motorcycles, scooters, electro-hybrid bicycles, boats, sailboats, water vehicles, pools, utility boats, fishing boats, outboard motors, diesel engines, ATVs, side-by-side vehicles, racing karts, golf cars, snowmobiles and generators.

21. The Complainant Yamaha operates a network of websites, including websites located at yamaha-motor.ca and yamaha-motor.com.

22. The Complainant Yamaha is the owner of the Canadian trade-mark registrations (collectively, the "YAMAHA Trade-marks") set out below:

Trade-mark	Reg. No.	Reg. Date
YAMAHA	TMA273373	October 19, 1982
YAMAHA & Design	TMA225707	January 17, 1978
YAMAHA	TMA350843	February 3, 1989
YAMAHA	TMA138598	December 24, 1964
YAMAHA	TMA412394	May 14, 1993
YAMAHA & Design	TMA225169	December 20, 1977
YAMAHA Design	TMA645889	August 17, 2004
YAMAHA & Design	TMA229524	August 4, 1978

YAMAHA & Design	TMA232762	April 20, 1979
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23. The Yamaha Motor Canada Ltd. trade name (the "Yamaha Canada Trade Name") was adopted in September 1980. The Complainant Yamaha Canada is licensed to use the YAMAHA trade-mark as part of its trade name by the Complainant Yamaha.

24. The YAMAHA Trade-marks and the Yamaha Canada Trade Name (collectively, the "YAMAHA Marks") have become famous in Canada, and have achieved an extensive and exceptional reputation.

25. The Registrant registered the domain name yamahamotors.ca on April 12, 2005.

26. The yamahamotors.ca domain name resolves to a pay-per-click website, which prominently displays "**yamahamotors.ca**" at the top of the website, followed by the headline, "**A specialist in Porn Advertising, Online Part yamaha, Generators!**"

27. The Registrant's website features sponsored or advertised links to competitors of the Complainant Yamaha, such as Kawasaki and Suzuki. Many of these sponsored links contain the famous YAMAHA trade-mark, including, without limitation, the links "Online Part yamaha", "Motorcycle OEM Part yamaha", "Motorcycle Part yamaha", "Motorcycle covers yamaha", "Yamaha ATV", "Yamaha Motorbike", "Yamaha scooter" and "Yamaha Four Wheelers". The website also provides end users with a means of conducting searches to access links to competitors of the Complainants. In addition, the website displays links to adult content, and includes a link entitled, "Porn Advertising".

28. The yamahamotors.ca pay-per-click website is operated by Klickerz, as confirmed by the server designations, "nsl.klickerz.com" and "ns2.klickerz.com," assigned to the domain name.

29. As indicated on its website at klickerz.com, Klickerz offers monetization services in connection with parked domain names. As noted under the FAQ portion of its website, websites are customized to fit the domain name and domain name owners receive payment for parking their domain names at sites operated by Klickerz.

30. In return for parking yamahamotors.ca at the current website, the Registrant becomes eligible for a referral fee.

31. The Complainant Yamaha Canada, through its legal counsel, sent a cease and desist letter to the Registrant, dated July 20, 2006, requiring the transfer of the domain name yamahamotors.ca to Yamaha Canada. The Registrant did not respond to the Complainant's letter.

32. The evidence disclosed that the Registrant is the owner of the domain names empiretheatres.ca and encandirect.ca which contain third party registered Canadian trade-marks to which the Registrant has no entitlement to the knowledge of the Complainants. EMPIRE THEATRES is a registered mark, registration no. TMA 409,468, owned by Empire Theatres

Limited. ENCAN is a registered mark, registration no. TMA 596065, owned by Société Des Loteries du Quebec.

POSITION OF THE COMPLAINANTS

33. The Complainants submit that:

- (a) The Registrant's domain name, yamahamotors.ca, is confusingly similar to a mark in which the Complainants had rights prior to the date of registration of the domain name and continues to have such rights.
- (b) In accordance with paragraph 3.4 of the Policy, a domain name will be found to be confusingly similar with a mark if it so nearly resembles the mark in appearance, sound, or in the ideas suggested so as to be likely to be mistaken for the mark.
- (c) The Registrant has registered the domain name in bad faith and that the Registrant registered yamahamotors.ca primarily for the purpose of disrupting the business of the Complainants and that his activities fall squarely within subparagraph 3.7(c) of the Policy.
- (d) The Registrant has engaged in a pattern of registering domain names that incorporate the marks of third parties to which he has no entitlement to the knowledge of the Complainants, and that the Registrant has prevented the Complainants from registering yamahamotors.ca as set out in subparagraph 3.7(b) of the Policy.

34. The Complainants submit that the Registrant has no legitimate interest in the domain name as described in paragraph 3.6 and to establish rights, the overall circumstances should demonstrate that the registration was obtained in good faith for the purpose of making *bona fide* use of the domain name.

35. The Complainants submit that:

- (a) With respect to paragraph 3.6(a), there has never been any relationship between the Complainants and the Registrant, and the Registrant has never been licensed, or otherwise authorized to register or use, the YAMAHA Marks in any manner whatsoever, including in, or as part of, a domain name and that:
 - (i) The pointing of a domain name to a pay-per-click site does not constitute *bona fide* or good faith use of a domain name.
 - (ii) The purpose behind the registration of yamahamotors.ca was to exploit Internet traffic properly destined for the Complainants with a view to reaping a commercial advantage by capitalizing on consumer confusion. This is not *bona fide* or good faith use of a domain.

- (iii) In any event, the domain name has not been used as a Mark as defined by the Policy, namely "for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person". It follows that the Registrant cannot claim Rights in the disputed domain name.
- (b) With respect to paragraph 3.6(b), the Complainants submit that the Registrant has not used yamahamotors.ca in good faith in association with any wares, services or business, and the domain name is not clearly descriptive in any of the senses stipulated by this paragraph.
- (c) With respect to paragraph 3.6(c), the Complainants submit that the Registrant cannot claim a legitimate interest in the domain name as yamahamotors.ca is not generic of any wares, services or business, nor has the domain name been used in good faith or for a *bona fide* purpose.
- (d) With respect to paragraph 3.6(d), the Complainants submit that the Registrant has never used the domain name in association with a non-commercial activity, and therefore cannot invoke subparagraph 3.6(d) of the Policy. In any event, the domain name has not been used in good faith.
- (e) With respect to paragraph 3.6(e), the Complainants submit that Yamaha or Yamaha Motors is not a legal name, surname, or other reference, by which the Registrant is commonly identified, and accordingly, the Registrant cannot rely on subparagraph 3.6(e) of the Policy.
- (f) With respect to paragraph 3.6(f), the Complainants submit that the domain name is not the geographical name of the location of the Registrant's non-commercial activity or place of business.

36. The Complainants submit that the factual matrix demonstrates that yamahamotors.ca was registered in bad faith and that the Registrant has no entitlement to yamahamotors.ca. In particular, the Complainants note as follows:

- (a) The domain name yamahamotors.ca is confusingly similar to the YAMAHA Marks, in which the Complainants had rights prior to the registration date of yamahamotors.ca, and continue to have such rights.
- (b) The Registrant registered the domain name primarily for the purpose of disrupting the business of the Complainants and the Registrant is a competitor of the Complainants.
- (c) The Registrant has engaged in a pattern of registering domain names that incorporate third party marks to which he has no entitlement, and has prevented the Complainants from registering the disputed domain name.

- (d) The Registrant does not have a legitimate interest in yamahamotors.ca as he has not brought himself within any of the circumstances specified by paragraph 3.6.

37. The Complainants request that yamahamotors.ca be transferred from the Registrant to the Complainant Yamaha Canada.

ANALYSIS AND FINDINGS

38. Under paragraph 4.1 of the Policy, the onus is on the Complainants to 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.

39. Paragraph 4.1 of the Policy also provides that:

“Even if the Complainant proves (a) and (b) and provides some evidence of (c), 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.”

40. In this case, the Registrant has filed no response to the Complaint and accordingly has provided no evidence of legitimate use.

CONFUSINGLY SIMILAR - PARAGRAPH 4.1 (a) OF THE POLICY

41. YAMAHA is a trade-mark registered by the Complainant Yamaha in the Canadian Intellectual Property Office ("CIPO") and is a "Mark" as defined in paragraph 3.2(c) of the Policy. The YAMAHA Mark has been used since at least 1960 in relation to motorcycles and their parts and accessories. The trade name Yamaha Motor Canada Ltd. is also a "Mark" as defined in paragraph 3.2(a) of the Policy. The Complainant Yamaha Canada is licensed to use the YAMAHA trade-mark as part of its trade name. The trade name was adopted in September 1980

42. The Complainants have the rights to the "YAMAHA" and "Yamaha Motor Canada Ltd." Marks as required under paragraph 3.3 (a) and (b) of the Policy.

43. The Complainants have met the onus to establish that the Registrant's domain name "yamahamotors.ca" is confusingly similar to the Complainants' Marks.

44. Paragraph 3.4 of the Policy defines "confusingly similar" as follows:

"(a) domain name is '**Confusingly Similar**' to a Mark if the domain name so nearly resembles the Mark in appearance, sound or ideas suggested by the Mark as to be likely to be mistaken for the Mark."

45. The test to be applied in determining the issue of "confusingly similar" is set out in paragraph 66 of the decision in *Government of Canada v. David Bedford, c.o.b. Abundance Computer Consulting*¹:

"The test for "Confusingly Similar" under Policy paragraph 3.4 is one of resemblance based on first impression and imperfect recollection. Accordingly, for each domain name the Complainant must prove on a balance of the probabilities that a person, on a first impression, knowing the Complainant's corresponding mark only and having an imperfect recollection of it, would likely mistake the domain name (without the .ca suffix) for the Complainant's corresponding mark based upon the appearance, sound or ideas suggested by the Mark."

46. In the Panel's view, a person knowing the Complainants' Marks "YAMAHA" and "Yamaha Motor Canada Ltd." only and "having an imperfect recollection of" them "would likely mistake the domain name" "yamahamotors.ca" "for the Complainant's corresponding mark based upon the appearance, sound or ideas suggested by the Mark."

47. The incorporation of the whole of the YAMAHA trade-mark in the Registrant's domain name and the addition of the word "motors" does not obviate the likelihood of confusion.²

48. The Panel agrees with the Complainants that confusion is enhanced by the addition of the word "motors" as the Complainants are involved in the motor vehicle business, and as such, the addition of "motors" is likely to increase the likelihood that potential consumers will believe that "yamahamotors.ca" is somehow connected to the Complainants. The Complainant Yamaha, and its group of companies, operates websites at yamaha-motor.ca and yamaha-motor.com. The likelihood of confusion is increased as the Registrant's domain name yamahamotors.ca is nearly identical in appearance to the domain names yamaha-motor.ca and yamaha-motor.com.

BAD FAITH - PARAGRAPH 4.1(b) OF THE POLICY

¹ BCICAC Case No. 00011 (May 27, 2003)

² See: *RGIS Inventory Specialists v. AccuTrak Inventory*, BCICAC Case No. 00053 (March 6, 2006), *Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)*, BCICAC Case No. 00020 (August 26, 2004) and *General Motors Acceptance Corporation v. Bob Woods*, BCICAC Case No. 00051 (January 2006).

49. In order to establish bad faith, the Complainants must establish on the balance of probabilities, one of paragraphs 3.7(a), (b) or (c) of the Policy. The Complainants rely on paragraphs (b) and (c).

50. Paragraph 3.7 defines "registration in bad faith" for the purposes of the Policy. The relevant portions of paragraph 3.7 read as follows:

"For the purposes of paragraph 3.1(c), a Registrant will be considered to have registered a domain name in bad faith if, and only if:

(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 is engaged in a pattern of registering domain names in order to prevent persons who have rights and 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."

51. The Complainants have satisfied the requirements of paragraphs 3.7(b) and 3.7(c) of the Policy and are entitled to a finding that the Registrant has registered the name "yamahamotors.ca" in bad faith.

Bad Faith – Paragraph 3.7(b) of the Policy

52. Where, as here, the Registrant has neither responded to the Complainants' letters nor to the Complaint, the intent of the Registrant must be inferred from the Registrant's conduct. In the Panel's view, the registration of the domain name "yamahamotors.ca" on April 12, 2005, despite the registration by the Complainant Yamaha of its trade marks substantially before April 12, 2005 and the use by the Complainant Yamaha Canada of the trade name Yamaha Motor Canada Ltd. since September 1980 can only lead to the conclusion that "the Registrant registered the domain name ... to prevent the Complainant or the Complainants' licensor or licensee of the Mark, from registering the Mark as a domain name."

53. The Panel is also of the opinion that the second part of paragraph 3.7(b) has been satisfied by the evidence of the registration by the Registrant of at least two other dot-ca domain names composed of, or containing, third party marks, or intentional misspellings of same. The Complainants have provided evidence that the two domain names, empiretheaters.ca and encandirect.ca, are comprised of, or contain, marks that are the subject of Canadian trade-mark registrations, or which are intentional misspellings of those marks. Save for the intentional misspelling of "theatres", empiretheaters.ca is identical to the registered mark EMPIRE THEATRES, registration no. TMA 409,468, which is owned by Empire Theatres Limited and

the domain name encandirect.ca incorporates the whole of the registered mark ENCAN, registration no. TMA 596065, which is owned by Société Des Loteries du Quebec.

54. *Viacom International Inc. v. Harvey Ross Enterprises. Ltd.*³ decided that evidence indicating that a registrant owns multiple domain names which correspond to third party trademarks constitutes *prima facie* evidence of bad faith registration. In *Great Pacific Industries Inc. v. Ghalib Dhalla*⁴ and *Volvo Trademark Holding AB v. Cup International Limited*,⁵ the Panels held that as few as two (2) domain name registrations, which include the domain name in dispute, is sufficient to establish that a registrant has engaged in a pattern of abusive registrations.⁶

55. The Panel finds that the registration of the domain names yamahamotors.ca, empiretheatres.ca and encandirect.ca by the Registrant constitutes a pattern of abusive registrations within 3.7(b) of the Policy.

REGISTRATION IN BAD FAITH - PARAGRAPH 3.7(c) OF THE POLICY

56. Under paragraph 3.7(c), the Complainant must establish that:

"(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."

57. The Complainants have established bad faith under this subparagraph. The Complainants' business is disrupted or potentially disrupted by the fact that the Registrant's website features sponsored or advertised links to competitors of the Complainant Yamaha including Kawasaki and Suzuki and some of the sponsored links contain the YAMAHA trademark, including the links "Online Part yamaha," "Motorcycle OEM yamaha," "Motorcycle Part Yamaha," and others. From the manner that he uses the domain name, the Registrant is a competitor of the Complainants. He receives fees by directing Internet users to the websites of direct competitors. The conduct of the Registrant meets the requirements set out in Section 3.7(c) of the Policy and demonstrates his bad faith.

58. In addition, bad faith exists where, as here, the use of the domain name is likely to cause confusion among Internet users as to affiliation or sponsorship.⁷

59. In the absence of an explanation from the Registrant, the only reasonable inference to be drawn from his registration of the domain name "yamahamotors.ca" is that it was done to disrupt the business of the Complainants by directing Internet users seeking the Complainants' products to their competitors.

³ BCICAC Case No. 00015 (October 15, 2003).

⁴ BCICAC Case No. 00009 (April 21, 2003).

⁵ WIPO Case No. D2000-0338 (June 12, 2000).

⁶ See also: *Alberta Treasury Branches v. Jim Yoon*, CIRA Case No. 00052 (February 13, 2006).

⁷ *Bell Canada v. Archer Enterprises*, BCICAC Case No. 00038 (August 30, 2005).

**LEGITIMATE INTEREST IN DOMAIN NAME 4.1(c) OF THE POLICY –
LEGITIMATE INTEREST, PARAGRAPH 3.6 OF THE POLICY**

60. The Panel finds that the Complainants have met their burden under paragraph 4.1(c) of the Policy that the Registrant does not have a legitimate interest in the domain name. As the Registrant has not replied to the Complaint, it has therefore not proven it has a legitimate interest in the domain name as described in paragraph 3.6 of the Policy.

ORDER

61. The Complainants have met the requirements of paragraph 4.1 of the Policy. The Panel directs that the registration of the domain name “yamahamotors.ca” be transferred from the Registrant to the Complainant Yamaha Canada.

Date: October 31, 2007.


W.A. Derry Millar