

# CANADIAN INTERNET REGISTRATION AUTHORITY

## DOMAIN NAME DISPUTE RESOLUTION POLICY

### COMPLAINT

Dispute Number:  
Domain Names: enterpriseautorental.ca; enterprisecarrentals.ca; enterpriserentalcars.ca;  
enterpriserentatruck.ca; enterpriserental.ca; enterpriserentals.ca;  
enterprisecar.ca; enterprisecars.ca; enterprisetricks.ca;  
enterprizerentacar.ca; enterprisetoronto.ca; enterprisecanada.ca  
Complainant: Enterprise Rent-A-Car Company  
Registrant: David Bedford  
Registrar: Canadian Domain Name Services Inc.  
Arbitrator: David Wotherspoon  
Service Provider: British Columbia International Commercial Arbitration Centre

### DECISION

#### A. THE PARTIES

1. The **Complainant** is Enterprise Rent-A-Car Company (“Enterprise”), a corporation under the laws of the State of Missouri, in the United States of America, having a principal place of business at 600 Corporate Park Drive, St. Louis, Missouri, U.S.A., 63105.
2. The **Registrant** is David Bedford, an individual with a listed mailing address of 4363 Halifax Street, Burnaby, British Columbia, V5C 5Z3.

#### B. THE DOMAIN NAME AND REGISTRAR

3. The 12 Domain Names at issue (the “Domain Names”) are:
  - (a) enterpriseautorental.ca
  - (b) enterprisecarrentals.ca
  - (c) enterpriserentalcars.ca
  - (d) enterpriserentatruck.ca

- (e) enterpriserental.ca
- (f) enterpriserentals.ca
- (g) enterprisecar.ca
- (h) enterprisecars.ca
- (i) enterprisetrucks.ca
- (j) enterprizerentacar.ca
- (k) enterprisetoronto.ca
- (l) enterprisecanada.ca

4. The Registrar of the Domain Names is BareMetal.com Inc.
5. Ten of the Domain Names were registered in June 2006, one (“enterpriserentalcars.ca”) was registered in August 2006, and one (“enterprisetoronto.ca”) was registered in September 2005.

### **C. 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 (the “Policy”) of the Canadian Internet Registration Authority (“CIRA”).
7. The **Complainant** filed a complaint with respect to the Domain Names pursuant to the Policy on January 28, 2008 (the “Complaint”).
8. In a letter dated January 29, 2008, BCICAC as Service Provider, confirmed compliance of the Complaint and commencement of the dispute resolution process.
9. The Complaint was delivered to the **Registrant** on January 30, 2008.
10. The **Registrant** has not provided a response. As a result, the **Complainant** elected under Rule 6.5 to convert from a panel of three to a single arbitrator. I was subsequently appointed as sole arbitrator in the Complaint.
11. I have reviewed all of the material submitted by the **Complainant** and am satisfied that the **Complainant** is an eligible complainant under the Policy and the Rules.
12. I have received no further submissions from either party since being appointed.
13. I am obliged to issue a decision on or prior to March 27, 2008 in the English language and am unaware of any other proceedings which may have been undertaken by the parties or others in the present matter.

**D. FACTS**

14. The **Complainant**, which opened its first rental location in Canada in 1993, describes itself as the largest car rental company in North America and one of the leading vehicle rental businesses in Canada. It provides vehicle rental, rental reservation and related services, all in association with its family of ENTERPRISE trade-marks and its ENTERPRISE trade-name.
15. The **Complainant** is the registered owner of five ENTERPRISE trade-marks (TMA535866; TMA508117; TMA537905; TMA535865; and TMA535487), all of which were registered between February 1999 and November 2000.
16. By 1996 the **Complainant** had over 90 rental locations in Canada. That year the Federal Court of Canada held that the **Complainant** had established a reputation in Canada in association with its ENTERPRISE name and mark, and the Court granted the **Complainant** a permanent injunction preventing the defendants from using the ENTERPRISE name and mark in Canada: *Enterprise Rent-A-Car v. Singer* (1996), 66 C.P.R. (3d) 453 (FCTD); aff'd (1998) 79 C.P.R. (3d) 45 (FCA).
17. The **Complainant** has operated continuously in Canada since 1993, and now provides its services here through physical locations and through the Internet via its domain name registration for [enterprise.com](http://enterprise.com) (registered on June 1, 1998). The **Complainant** now has over 400 rental locations across Canada, and its domain name has an active website which displays the **Complainant's** ENTERPRISE marks, and promotes, provides information about, and offers the **Complainant's** vehicle rental and reservation services. According to Alexa.com, 7.9% of all visitors to [enterprise.com](http://enterprise.com) are from Canada. Moreover, the estimated number of total transactions performed by the **Complainant** in Canada from 1993 to December 2007 is approximately 13.9 million.
18. As shown by the evidence, the **Registrant** registered ten of the Domain Names in June 2006, one ("enterpriserentalcars.ca") was registered in August 2006, and one ("enterprisetoronto.ca") was registered in September 2005. He subsequently began to operate related websites in connection with the Domain Names. These websites display the word ENTERPRISE in association with advertisements or links to travel booking services, which include vehicle rental services. For instance, the homepage of several of the websites show tool bars across the top of the page and display links under headings such as "Popular Categories", which include:

"Enterprise Car"

"Enterprise Car Rental Canada"

"Enterprise Rent A Car"

"enterprisecarrentalsalberta"

"enterprise car rental"

19. Clicking on one of these links produces a different set of links, including links to the **Complainant's** competitors such as Thrifty Car Rental, Avis Rent A Car and Hertz Rent A Car.
20. There has never been any relationship between the **Complainant** and the **Registrant**, and the **Complainant** does not sponsor the **Registrant's** websites, nor has it authorized the use of its mark on the **Registrant's** websites.

**E. COMPLAINANT'S CONTENTIONS**

21. The **Complainant** asserts that the **Registrant's** use of the word ENTERPRISE on his websites, and the use of icon headings which relate to vehicle rental services, demonstrates that he was well aware that his websites implied a connection with the **Complainant**. The **Complainant** asserts that it can therefore be inferred that the **Registrant** must have predicted the confusion likely generated by the Domain Names and the related websites.
22. The **Complainant** asserts that the **Registrant** has repeatedly engaged in "cyber squatting" activities beginning at least as early as May 27, 2003. In support of this assertion, the **Complainant** cites two decisions:
  - (a) In *Government of Canada v. David Bedford*, CIRA Decision 11, the Panel concluded that the **Registrant** had engaged in cyber squatting activities.
  - (b) In *Government of Canada v. David Bedford a.k.a. the Domain Baron*, WIPO Decision D2001-0470, the Panel concluded that the **Registrant's** registration of the domain names in issue was in bad faith and for the purpose of sale.
23. The **Complainant** further asserts that the **Registrant's** cyber squatting activities have continued since the aforementioned decisions. In support of this assertion, the **Complainant** has provided a list of domain names (as provided by CIRA in August 2007) registered by the **Registrant**. The list includes:

"alamocarrentals.ca"

"aviscarrentals.ca"

"budgetcarrentals.ca"

"discountrentalcar.ca"

"nationalcarrentals.ca"

"thrifycars.ca"

These names relate to the **Complainant's** competitors.

24. The **Complainant** states that the **Registrant's** registration of the abovementioned domain names demonstrates that the **Registrant** has not only engaged in cyber squatting, but that he has specifically targeted the trade-marks of vehicle rental companies. The **Complainant** believes that this evinces the **Registrant's** bad faith use and registration of the Domain Names.

*The Domain Names are Confusingly Similar to a Trade-mark in which the Complainant Has Rights*

25. At ¶38 of the Complaint, the **Complainant** asserts that eleven of the disputed domain names contain the word "Enterprise", which is identical in appearance, sound and ideas associated with the **Complainant's** ENTERPRISE Canadian trade-mark. This trade-mark was registered as early as February 1999, and used in Canada 12 years before the **Registrant** registered the first of the Domain Names.
26. The **Complainant** notes that a previous CIRA panel concluded that the domain name "enterprise.ca" was confusingly similar to the **Complainant's** ENTERPRISE trade-mark (*Enterprise Rent-A-Car Company v. Ebenezer Thevasagayam*, CIRA Decision 43).
27. The **Complainant** argues that consumers are likely to mistake the Domain Names for the **Complainant's** trade-mark because they contain the word "enterprise" (or, in one case, "enterprize"). Specifically, Internet users who attempt to access a website operated by the **Complainant**, either by entering "enterprise" into an Internet search engine, or by entering a domain name which includes "enterprise" into the address bar of an Internet browser, would likely be confused or misled as a matter of first impression.
28. Additionally, the **Complainant** asserts at ¶44 and ¶46 of the Complaint that the Domain Names further increase the likelihood of confusion because they combine the identical word "enterprise" (or "enterprize") with a word or words which are descriptive of either the nature of the services which the **Complainant** offers or of locations where the **Complainant's** services are offered.
29. Lastly, at ¶50 of the Complaint, the **Complainant** argues that the Domain Names are confusingly similar to its ENTERPRISE mark, and that the **Registrant** is using the Domain Names to promote and provide access to third-party sites offering vehicle rental services that include the **Complainant's** rental services and those offered by its competitors.

*The Registrant Has No Legitimate Interest in the Domain Names*

30. The **Complainant** asserts that the Domain Names do not fall within any of the six indicia of legitimate interest set out in ¶3.6 of the Policy.
31. The **Complainant** further asserts that there is no evidence that the **Registrant** has used, is using, or is preparing to use, the Domain Names in "good faith" in connection with any *bona fide* wares or services, or for legitimate non-commercial use (¶3.6(b), (c) and (d) of

the Policy). On the contrary, the **Complainant** argues that the **Registrant** registered the Domain Names in bad faith to confuse and attract users to his websites in order to obtain advertising revenue through pay-per-click links. As such, the **Registrant** is illegally and unfairly exploiting the goodwill attached to the **Complainant's** ENTERPRISE mark and name.

32. The **Complainant** then claims that the available evidence suggests that it can be reasonably inferred that the **Registrant** is attempting to sell the Domain Names through his DomainBaron.com website for consideration in excess of the costs of their registration.
33. At ¶55 of the Complaint, the **Complainant** contends that, on a balance of probabilities, the **Registrant** was well aware of the **Complainant's** prior trade-mark rights in the ENTERPRISE mark when he registered the Domain Names.
34. The **Complainant** further argues that the **Registrant's** display of the ENTERPRISE marks on his website, combined as it was with links for vehicle rental services, is further proof that the **Registrant** was aware of the **Complainant's** mark, name and services.
35. At ¶57 of the Complaint, the **Complainant** states that to its knowledge, the **Registrant** is not making any other use of its Enterprise mark aside from its inclusion in the Domain Names and displaying it on the related websites. These websites do not provide any services, other than posting a set of pay-per-click links. As such, the **Registrant's** use of the ENTERPRISE mark is neither clearly descriptive of nor a generic name for the services provided by the **Registrant's** websites.

Lastly, the **Complainant** asserts at ¶66 that none of the other types of legitimate interest outlined in the Policy apply to the **Registrant's** use of the Domain Names: the **Registrant** is not commonly identified by Enterprise/Enterprize, nor is Enterprise the **Registrant's** legal name; given the **Complainant's** entitlement to them, the **Registrant** could not have acquired rights in the ENTERPRISE mark for the use which he has put them to; the **Registrant** had no rights in the ENTERPRISE mark when he registered the Domain Names, not has he ever been licensed or authorized to the use the ENTERPRISE mark in any manner; the Domain Names are not the geographical name of the **Registrant's** location, and the two Domain Names that contain geographical names also contain the **Complainant's** ENTERPRISE marks and name; and the **Registrant** has not used the Domain Names in Canada in good faith with a non-commercial activity.

*The Domain Names Were Registered in Bad Faith*

36. The **Complainant** asserts that the **Registrant** registered the Domain Names in bad faith, as defined by ¶3.7 of the Policy, for the following purposes:
  - (a) preventing the **Complainant** from displaying the ENTERPRISE mark on the dot-ca domain;

- (b) exploiting the goodwill of the **Complainant's** name and mark, thereby disrupting the **Complainant's** business;
- (c) intending to transfer the Domain Names to the **Complainant**, or to another cyber squatter who is a competitor, for an amount in excess of the costs incurred to acquire the Domain Names; and
- (d) attracting users to his website via consumer confusion in order to obtain advertising revenue from third parties.

*Passing Off, Trade-mark Infringement and Depreciation of Goodwill*

37. At ¶83 of the Complaint, the **Complainant** contends that pursuant to Canadian trade-mark law (particularly ss. 7(b), 19, 20 and 22 of the *Trade-marks Act*, R.S. 1985, c. T-13) the **Registrant's** use of Domain Names and the display of the **Complainant's** Enterprise trade-mark on his websites constitutes passing-off, trade-mark infringement, and depreciation of goodwill.

**F. DISCUSSION AND FINDINGS**

38. ¶4.1 of the Policy sets out that, to succeed, the **Complainant** must establish 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. Additionally, ¶4.1 of the Policy provides that even if a **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 ¶3.6. In other words, once the **Complainant** has met its evidentiary burden under ¶4.1(a) and (b), either by positive or negative inference, the onus shifts to the **Registrant** who must then prove, on a balance of probabilities, that he is making legitimate use of the domain name.

40. I have concluded, for the reasons that follow, that the **Complainant** has met its burden under ¶4.1 of the Policy. The **Complainant** has established that it has a "mark" according to the definition in ¶3.2(a), and it has established that the Domain Names, which were registered by the **Registrant**, are confusingly similar to that mark. Lastly,

the **Complainant** has established that the **Registrant** registered the Domain Names in bad faith according to ¶3.7, and has provided some evidence that the **Registrant** has no legitimate interest in the Domain Names.

41. Given that the **Registrant** did not respond to the Complaint, he has failed to establish, on a balance of probabilities, that he was making legitimate use of the Domain Names.

*Paragraph 4.1(a) – Confusingly Similar*

42. To succeed in meeting its onus under ¶4.1(a), the **Complainant** must show that it has rights in a mark, and that the Domain Names are confusingly similar to that mark.

43. ¶3.2(a) of the Policy states that a “Mark” includes:

A trade-mark, including the word elements of a design mark, or a trade name that been used in Canada by a person, or the person’s predecessor in title, 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.

44. Given that the **Complainant** registered its ENTERPRISE trade-mark in Canada at least as early as February 1999 - approximately six years before the **Registrant** registered the Domain Names - I have concluded that the ENTERPRISE name is such a mark.

45. ¶3.4 of the Policy defines the term “confusingly similar”. The Policy requires a finding that the mark at issue is likely to be mistaken for the domain name(s) at issue because of the resemblance in “appearance, sound or the ideas suggested by the Mark”. Thus, unlike in Canadian trade-mark jurisprudence, the test is not one of confusion, but rather of resemblance.

46. I have concluded that a person knowing the **Complainant’s** mark, ENTERPRISE, would likely mistake the Domain Names for the **Complainant’s** mark. The **Complainant** is one of the leading vehicle rental businesses in Canada, and it provides vehicle rental, rental reservation and related services, all in association with its family of Enterprise trade-marks and its Enterprise trade-name. Given the use to which the **Registrant** has put the Domain Names to, it is likely that the Domain Names would confuse and mislead the general public into mistaking the Domain Names as being somehow affiliated with or owned by the **Complainant**. The jurisprudence affirms that this is sufficient to conclude that the Domain Names are confusingly similar to the **Complainant’s** mark, ENTERPRISE: *Glaxo Group Ltd. v. Defining Presence Marketing*, CIRA Decision 20; *Great Pacific Industries v. Ghalib Dhalla*, CIRA Decision 9; *Government of Canada v. David Bedford*, *supra*.

47. I have concluded that the **Complainant** has established, on a balance of probabilities, that the Domain Names are “confusingly similar” to the ENTERPRISE mark in which the **Complainant** had rights prior to the date the Domain Names were registered and that



it continues to have said rights. The **Registrant** has failed to provide any evidence to rebut this conclusion.

*Paragraph 4.1(b) – Bad Faith Registration*

48. ¶3.7 of the Policy provides:

**Registration in Bad Faith.** 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:

- (a) 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;
- (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 has engaged in a pattern of registering domain names in order to prevent persons who have Rights in 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.

49. Although to be successful the **Complainant** need only establish one element of ¶3.7, I have concluded that the **Complainant** has established all three.

50. In regards to ¶3.7(a), the websites which correspond with the Domain Names have links on them that direct Internet users to further links. These links include “avis.com”, “budget.com”, “thrifty.com”, and others that are in direct competition with the **Complainant**. In some cases, Internet users are directed to these links after clicking on misleading links or icons such as “Enterprise Car Rental”. Previous jurisprudence has held that “a competitor is someone who acts in opposition to another, including competing for Internet users and that there is no requirement that the **Registrant** be a commercial business competitor or someone that sells competing products”: *Glaxo Group, supra*. I agree with the **Complainant** that the **Registrant’s** websites compete with the **Complainant** for Internet traffic. Moreover, the **Registrant’s** websites provide to third-party retailers of competing vehicle rental services, and could very well divert customers from the **Complainant** to its competitors. Furthermore, by virtue of the fact

that the **Registrant's** DomainBaron.com offers the Domain Names for sale, I have concluded, on a balance of probabilities, that the **Registrant** sought to sell, rent, license or otherwise transfer the registration of the Domain Names for "valuable consideration" in excess of the costs he incurred to acquire the registrations.

51. In regards to ¶3.7(b), it is clear from previous decisions of the CIRA and the WIPO noted above, and from the fact that many of the 1,200 dot-ca domain names registered by the **Registrant** correspond to trade-marks owned by third-parties (including the well-known trade-marks of other vehicle rental companies) that the **Registrant** has engaged in a pattern of cyber squatting by registering domain names in order to prevent persons who have rights in marks from registering the marks as domain names. Most telling is the fact that the **Registrant's** DomainBaron.com website (the website address to which the Domain Names are registered) offers the Domain Names for sale.
52. Lastly, in regards to ¶3.7(c), I agree with the **Complainant** that the **Registrant** registered the Domain Names for the purpose of disrupting the **Complainant's** business. Given that the Domain Names combine the use of the ENTERPRISE mark with a word or words which are descriptive of either a geographic location in which the **Complainant** offers its services or the nature of the services which the **Complainant** offers, Internet users who encounter the Domain Names could be misled into believing that the **Registrant** business is a business of the **Complainant**, or is at least commercially associated with the **Complainant**. As a result of the **Registrant's** conduct in this regard, the **Complainant's** business reputation is put at risk.
53. Given the foregoing, I find that the **Complainant** has established, on a balance of probabilities, that the **Registrant** registered the Domain Names in bad faith. Again, the **Registrant** has failed to provide any evidence to rebut this conclusion.

*Paragraph 4.1(c) - Legitimate Interest*

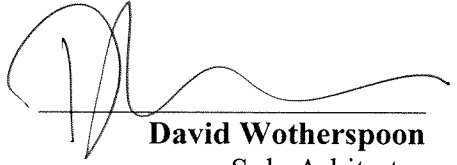
54. ¶3.6 of the Policy states that a **Registrant** has a legitimate interest in a domain name if it can demonstrate that, prior to notice of the Complaint, it had any of the indicia of legitimate interest listed in ¶3.6(a)-(f). I have concluded that the **Registrant** has failed to do so. Moreover, I have concluded that the **Complainant** has provided at least some evidence to show that the **Registrant** has no legitimate interest in the Domain Names.
55. First, there has never been any business relationship between the **Complainant** and the **Registrant** (¶3.6(a)).
56. Second, the **Complainant** does not sponsor the **Registrant's** websites, nor has it authorized the use of its mark on the **Registrant's** websites (¶3.6(b)).
57. Third, the **Registrant's** use of the ENTERPRISE mark has not been for the purpose of distinguishing the **Registrant's** business or products. Nor is the ENTERPRISE name generic (¶3.6(c)).

58. Fourth, the **Registrant** has not used the ENTERPRISE name for non-commercial activity.
59. Fifth, the ENTERPRISE name is not a reference by which the **Registrant** is commonly identified ((¶3.6(e)).
60. Sixth, the ENTERPRISE name is not the geographical name of the location of the **Registrant's** non-commercial activity or its place of business ((¶3.6(f)).
61. Clearly, the **Registrant** has not provided any evidence to counter the **Complainant's** assertions regarding his lack of a legitimate interest. As such, I have concluded that the **Registrant** does not have a legitimate interest in the Domain Names.
62. Given the foregoing, it is unnecessary for me to address the **Complainant's** arguments concerning the **Registrant's** violations of the *Trade-marks Act*.

**G. ORDER**

63. I have concluded that the **Complainant** has met the requirements of ¶4.1 of the Policy.
64. Accordingly, and pursuant to ¶4.3 of the Policy, I order that the registrations of the following domain names:
  - (a) enterpriseautorental.ca
  - (b) enterprisecarrentals.ca
  - (c) enterpriserentalcars.ca
  - (d) enterpriserentatruck.ca
  - (e) enterpriserental.ca
  - (f) enterpriserentals.ca
  - (g) enterprisecar.ca
  - (h) enterprisecars.ca
  - (i) enterprisetricks.ca
  - (j) enterprizerentacar.ca
  - (k) enterprisetoronto.ca
  - (l) enterprisecanada.ca

be transferred forthwith to the **Complainant** by the Registrar, Canadian Domain Services Inc.

A handwritten signature in black ink, consisting of a large, stylized 'D' followed by a series of loops and a long horizontal stroke.

**David Wotherspoon**

Sole Arbitrator

March 27, 2008