

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

BETWEEN:

BEST BUY ENTERPRISES SERVICES INC.

Complainant

- and -

GTA COMPUTER GEEK SQUAD

Registrant

DECISION

A. The Parties

1. The Complainant, Best Buy Enterprises Services Inc., is a company incorporated under the laws of Minnesota, U.S.A.
2. The Registrant, GTA Computer Geek Squad, is a business based in Concord, Ontario. The Registrant's administrative contact person is Gabriel Adewusi.

B. The Domain Name and Registrar

3. The disputed domain name that is the subject of this arbitration is computergeek squad.ca (the **Domain Name**).
4. The Registrar of the Domain Name is Tucows.com Co., with an office in Ottawa, Ontario.

C. Procedural History

5. This matter is arbitrated under the CIRA Domain Name 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 under the Policy and Rules.
6. Based on information from the Dispute Resolution Service Provider - the British Columbia International Commercial Arbitration Centre (**BCICAC**) - the history of this proceeding can be summarized as follows:

- (a) On October 14, 2008, the Complainant filed with BCICAC a Complaint regarding the Domain Name.
- (b) BCICAC reviewed the Complaint and found it to be compliant with administrative requirements. In a letter dated October 15, 2008, BCICAC confirmed compliance to the parties.
- (c) On October 23, 2008, BCICAC successfully delivered the Complaint to the Registrant.
- (d) The Registrant failed to provide a Response in the time allowed under Rule 5.1 and did not seek an extension. Therefore, Rule 5.8 requires the arbitrator to decide the matter based on the Complaint alone.
- (e) The Complainant elected under Rule 6.5 to proceed with a sole arbitrator. The BCICAC named David R. Haigh, Q.C., as sole arbitrator (the **Arbitrator**).
- (f) The Arbitrator delivered to the BCICAC a required Statement of Impartiality and Independence, according to Rule 7.2.

D. Preliminary Determinations

7. The Arbitrator was appointed in accordance with the Policy and the Rules.
8. Under Rule 12.1, the law of Ontario applies.

E. Factual Background

9. Based on the Complaint in this uncontested dispute, a summary of the facts is set out below.
10. The Complainant is the owner of the following Canadian trademarks registered on the dates noted:
 - GEEK SQUAD & DESIGN – December 8, 1998;
 - GEEK SQUAD – September 24, 2004; and
 - GEEK SQUAD & DESIGN – January 25, 2006.(collectively, the **Trademarks**).

11. The Complainant has granted an exclusive licence to Best Buy Canada Ltd. (**Best Buy Canada**) for the use of the Trademarks in Canada. Under the terms of that licence, the Complainant has control over the character and quality of the goods and services that Best Buy Canada associates with the Trademarks, and the Complainant takes the benefit of all use of the Trademarks by Best Buy Canada.

12. Best Buy Canada is one of the largest consumers electronics retail chains in Canada. It has over 180 retail stores across Canada and in fiscal 2008 had gross sales of approximately \$1.7 Billion.

13. Since about August 2004, Best Buy Canada has extensively used the Trademarks throughout Canada in advertising and promotion of computer-related technical support services provided to its customers at Best Buy stores and at customers' homes. The advertising of Best Buy Canada's computer-related technical support services using the Trademarks has included in-store promotional materials, advertising in newspapers and on radio and television, and advertising on the BEST BUY website (www.bestbuy.ca) and the GEEK SQUAD website (www.geeksquad.ca). Since 2004, Best Buy Canada has spent over \$1 Million each year on advertising its services using some or all of the Trademarks.

14. The marketing and promotion of Best Buy Canada's services using the Trademarks include the use of a distinctively decorated car known as a "GeekMobile", and the outfitting of employees in a uniform comprised of a short-sleeve white shirt, a black tie, a black belt, a black skirt or pair of pants, black shoes, white socks, black jacket and a badge.

15. The Registrant registered the Domain Name on April 25, 2007 – after the Complainant registered the Trademarks in Canada.

16. As a result of customer inquiries in July 2007, Best Buy Canada discovered that the Domain Name had been registered and was being use for a website that advertised a business called "Computer Geek Squad" that provided "expert onsite computer solutions".

17. Best Buy Canada's customer records indicate that a few customers have reported that the uniform of the Registrant's employees is a set of black pants and white shirt, with the words "Geek Squad" embroidered on it, and that the Registrant's employees have been incorrectly stating that the Registrant is affiliated with Best Buy Canada.

18. Best Buy Canada's lawyers engaged in correspondence with the Registrant and its administrative contact, Gabriel Adewusi, demanding that they cease using the "Computer Geek Squad" business name and transfer registered ownership of the Domain Name to the Complainant and Best Buy Canada.

19. By e-mails dated October 30 and November 26, 2007, Gabriel Adewusi advised that the Registrant's business name would be changed, "the website will no longer exist", and "all other use of the name GEEK SQUAD together" will stop December 1st, 2007". However, Gabriel Adewusi refused to transfer registered ownership of the Domain Name.

20. Since July 2008, the Domain Name has resolved to webpages that state either "Forbidden You don't have permission to access / on this server" or "Address Not Found".

F. Discussion and Conclusions

Eligibility of the Complainant

21. This Complaint relates to Trademarks registered in Canada that the Complainant owns. As such, the Complainant is eligible to make this Complaint under Rule 1.4.

Confusingly Similar to the Marks

22. The Complainant's burden of proof under paragraph 4.1(a) of the Policy is to establish that "the Registrant's .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".

First Sub-Element

23. Paragraph 4.1(a) of the Policy contains a number of sub-elements. The first relevant sub-element is whether the Complainant had Rights in Marks (as defined in paragraph 3.2 of the Policy) before the registration date of the Domain Name.

24. The Complainant registered the Trademarks before the registration of the Domain Name, so the Complainant did have such Rights.

Second Sub-Element

25. The second sub-element of paragraph 4.1(a) of the Policy is whether the Domain Name is confusingly similar to the Marks. Under paragraph 3.4 of the Policy, this would be so if the Domain Name were to resemble the applicable Marks so nearly in appearance, sound or in the ideas suggested by the Marks as to be likely to be mistaken for the Marks.

26. The Domain Name does resemble the Trademarks so as to likely be mistaken for them. The Domain Name includes the entire word trademark GEEK SQUAD and the entire word elements of the design trademarks GEEK SQUAD & DESIGN. The addition of the word "computer" does not reduce the

resemblance in any real way, since the use of the Trademarks relate to that very subject matter. The top-level domain portion (the .ca portion) is an irrelevant distinction.

27. Based on the reasoning above, the Complainant has satisfied its onus under paragraph 4.1(a) of the Policy.

Registration in Bad Faith

28. Under paragraph 4.1(b) of the Policy, the Complainant must prove that the Registrant has registered the Domain Name in bad faith as described in paragraph 3.7.

29. Because the Trademarks are well-known and because of the nature of browsing and searching on the Internet, it is inconceivable that the Registrant would not have been aware of the business of the Complainant or its licensee (Best Buy Canada), and of its use of the Trademarks. Moreover, Best Buy Canada customer records indicate that employees of the Registrant have been passing themselves off as being affiliated with Best Buy Canada, and the Registrant has refused to transfer the Domain Name to the Registrant. Evidently, the Registrant has in the past attempted to divert customers or potential customers of the Complainant's licensee to the Registrant. Further, it has failed to foreclose future diversion, in that the Registrant has refused to transfer registration of the Domain Name. It follows that the Registrant acquired the Domain Name for the bad faith purpose under paragraph 3.7(c) of the Policy, namely, for disrupting the business of the licensee of the Trademarks, which is a direct competitor of the Registrant.

30. For the above reasons, the Registrant registered the Domain Name in bad faith.

No Legitimate Interest

31. Under paragraph 4.1(c) of the Policy, the onus is on the Complainant to show at least some evidence that the Registrant has no legitimate interest in the Domain Name. Upon discharging that onus, it then shifts to the Registrant to prove that it has a legitimate interest in the Domain Name.

32. In this uncontested arbitration, the Registrant has provided no evidence, so it remains only for the Complainant to show at least some evidence that the Registrant has no legitimate interest in the Domain Name.

33. For the Registrant's use of the Domain Name to be legitimate, that use must fall under one of the sub-paragraphs 3.6(a) – (f) of the Policy. The uncontested evidence is that the Registrant does not have a legitimate interest in the Domain Name under any of those sub-paragraphs.

34. The Complainant has satisfied its onus in providing some evidence that the Registrant has no legitimate interest in the Domain Name.

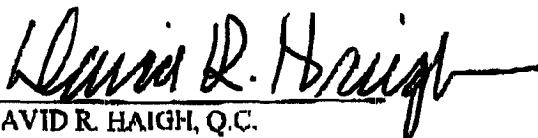
Decision

35. The Arbitrator has decided as follows:

- (a) The Complainant is an eligible complainant.
- (b) The Registrant's Domain Name is Confusingly Similar to Marks, in which the Complainant had Rights before the Registration of the Domain Name, and continues to have such Rights.
- (c) The Registrant has registered the Domain Name in bad faith.
- (d) The Registrant has no legitimate interest in the Domain Name.
- (e) The Complainant has satisfied its onus obligations under paragraph 4.1 of the Policy.

36. Based on these conclusions, the Arbitrator decides these proceedings in favour of the Complainant and orders that the Registration of the following Domain Name, `computergeeksqad.ca` be transferred to the Complainant:

MADE this 27th November, 2008.


DAVID R. HAIGH, Q.C.
Sole Arbitrator