

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

Dispute Number: DCA-1524-CIRA
Domain Name : <careymontreal.ca>
Complainant: Carey International, Inc
Registrant: Fabio Simonetti
Registrar: Wild West Domains Canada, Inc
Panel: Elizabeth Cuddihy QC, Harold Margles and The Honourable Neil Anthony Brown QC
(Chair)
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

THE PARTIES

1. The Complainant in this proceeding is Carey International, Inc of 4530 Wisconsin Avenue, N.W., Washington, DC, 20016, USA (“Carey”).
2. The Registrant is Fabio Simonetti of BP Extase, P.O.340. Av Dorval, Dorval, Quebec, H9S 5W4, Canada (“the Registrant”).

THE DOMAIN NAME AND REGISTRAR

3. The Domain Name in issue in this proceeding is <careymontreal.ca> (“the disputed domain name”).
4. The Registrar is: Wild West Domains Canada, Inc.
5. The disputed domain name was registered by the Registrant on October 14, 2012.

PROCEDURAL HISTORY

6. The British Columbia International Commercial Arbitration Centre (“BCICAC”) is a recognized service provider to the CIRA Domain Name Dispute Resolution Policy (“the Policy”) of the Canadian Internet Registration Authority (“CIRA”).
7. According to the information provided by the BCICAC :
 - (a) The Complainant filed a Complaint with respect to the disputed domain name in accordance with the Policy on August 19, 2013.

(b) The Complaint was reviewed and found to be compliant. By letter dated August 22, 2013, the BCICAC as service Provider confirmed compliance of the Complaint and commencement of the dispute resolution process on that date.

(c) The Complaint together with the schedules thereto was sent by BCICAC as service provider to the Registrant electronically by email on August 22, 2013 and delivered on that date; a successful mail delivery report was subsequently furnished, enabling the Panel to conclude that the Complaint and its schedules were duly delivered to the Registrant. By the same communication the Registrant was informed that it could file a Response in the proceeding on or before September 11, 2013.

(d) The Registrant did not reply to that communication and did not provide a Response.

(e) Under Rule 6.5 of CIRA Domain Name Dispute Resolution Rules (“the Rules”) the Complainant was entitled to elect to convert from a panel of three to a single arbitrator but as it did not avail itself of that opportunity this matter proceeds to be determined by a panel of three.

(f) On September 23, 2013, BCICAC named Elizabeth Cuddihy QC, Harold Margles and The Honourable Neil Anthony Brown QC (Chair) as the Panel. The members of the Panel have each signed an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.

(g) The Panel has reviewed all of the material submitted by the Complainant and is satisfied that the Complainant is an eligible Complainant under the Policy and the Rules.

(h) 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

8. The facts set out below are taken from the Complaint.

9. The Complainant is a United States company that operates in the field of limousine and ground transportation services in the United States, Canada and internationally and has done so for many years.

10. It operates under its CAREY trademark which is registered in the United States, Canada and internationally.

11. Without the permission of the Complainant, the Registrant registered the Disputed Domain Name on October 14, 2012. The domain name resolves to a website offering limousine and ground transportation services in the Montreal, Québec area in Canada, in direct competition with the Complainant, which also offers those services in the Montreal, Québec area. The competing limousine and ground transportation services offered by the Registrant are advertised and promoted on the website to which the disputed domain name resolves in association with the trade-mark CAREY LIMOUSINE. The website also makes representations that Montreal’s CAREY LIMOUSINE is a division of Montreal Carey Elite Limousine Service of Quebec and that it is a member of the Carey System all of which statements are false.

12. The Registrant's website at www.careymontreal.ca is a substantial reproduction of the website www.careylimo.com, an authorized website of a valid franchisee of the Complainant in Calgary, Alberta. The images and text on the two websites are identical, with the exception that on the Registrant's competing website at www.careymontreal.ca, his own geographic and contact information have replaced those of the Complainant's franchisee in Calgary.

13. The www.careymontreal.ca website is one of a number of websites operated by the Registrant now or in the past designed to generate revenue by engaging in the misappropriation of the Complainant's intellectual property. The Registrant has registered numerous additional domain names confusingly similar with the Complainant's CAREY trade-mark including careymontreal.com, carrymontreal.com and montrealcareylimo.com.

CONTENTIONS OF THE PARTIES

A.COMPLAINANT

12. The Complainant submits as follows:

1.Canadian Presence Requirements

Pursuant to paragraph 1.4 of the Policy, and paragraph 2(q) of the *CIRA Policies, Procedures and Guidelines: Canadian Presence Requirements For Registrants*, the domain name careymontreal.ca is confusing with the Complainant's registered Canadian trade-mark CAREY, Registration No. TMA423, 694. Accordingly, the Complainant is eligible to file this Complaint.

2. The Complainant & Trade-marks Upon Which the Complaint Is Based

The Complainant operates an international limousine service providing chauffeured ground transportation services in association with the CAREY Trade-mark. The Complainant has been offering its chauffeured ground transportation services in association with the CAREY Trade-mark since 1982 in Canada.

3. The Complainant has enjoyed success internationally, its business spanning more than 60 countries and 550 cities, including Montreal, Québec in Canada.

4. The Complainant has also established an Internet presence which is significant to its business. It has registered the domain name carey.com and uses the website www.carey.com, a global website that has been in use in its business since 2004. The Complainant's website offers information about its limousine and ground transportation services and business and allows consumers to make reservations. Sample printouts from the Complainant's website are attached as **Exhibit 1**.

5. The Complainant is the owner of a Canadian trade-mark registration for CAREY registered on February 25, 1994 (TMA423,694), particulars of which are attached as **Exhibit 2** hereto.

6. The CAREY trade-mark is one of the Complainant's most valuable assets. By virtue of extensive and continuous use in the U.S., Canada, and around the world by the Complainant and its predecessor(s)-in-title, the CAREY trade-mark has become well known and has attracted considerable reputation and goodwill.

Factual Grounds Upon Which the Complaint Is Based The Canadian Litigation and Resulting Federal Court Order

7. In trade-mark infringement proceedings in the Federal Court of Canada, the Respondent, Fabrizio (Fabio) Simonetti, consented to an order granting judgment against himself on December 22, 2009. The consent judgment against Fabrizio Simonetti was issued by the Federal Court of Canada restraining Fabrizio Simonetti from using the trade-mark and trade name CAREY or any trade-mark or trade name confusingly similar to the CAREY trade-mark in association with his wares, services and business. A copy of the Order is attached as **Exhibit 3**.

The Registration and Use of careymontreal.ca

8. On October 14, 2012, without the permission of the Complainant, the Registrant registered the domain name careymontreal.ca. **Exhibit 4** is a copy of the Registrant information for the Domain Name together with CIRA's notice advising of the identity of the domain name owner.

9. The Domain Name has been made to resolve to a website offering limousine and ground transportation services in the Montreal, Québec area, in direct competition with the Complainant, which also offers those services in the Montreal, Québec area. The competing limousine and ground transportation services are advertised and promoted on the website in association with the trade-mark CAREY LIMOUSINE. The website also makes representations that Montreal's CAREY LIMOUSINE is a division of Montreal Carey Elite Limousine Service of Quebec and that it is a member of the Complainant's Carey System. **Exhibit 5** is a copy of the website careymontreal.ca

10. The careymontreal.ca website is a substantial reproduction of the website careylimo.com, an authorized website of a franchisee of the Complainant in Calgary, Alberta. The images and text are identical with the exception that the geographic and contact information of the franchisee has been replaced with that of the competing business. **Exhibit 6** is a copy of the authorized website careylimo.com.

11. The Registrant's careymontreal.ca website is one of a number of websites operated by the Registrant now or in the past designed to generate revenue by engaging in the misappropriation of the Complainant's intellectual property as detailed further below.

12. Given the extensive misappropriation of the Complainant's intellectual property, the overall commercial impression created by the Registrant's website is that it is affiliated with, or endorsed by, the Complainant.

The Registrant's Additional Infringing Websites

13. The Registrant operates or has operated in the past a number of commercial websites in the field of limousine and ground transportation services that have misappropriated the Complainant's intellectual property with a view to extracting a financial benefit. The websites all adopt the same model: extensive use of the CAREY trade-mark (or the misspelled and confusingly similar phonetic equivalent CARRY), in association with a competing business offering limousine and ground transportation services in the Montreal, Quebec area, creating the mistaken belief that the sites are operated by the Complainant, or otherwise connected to same.

14. Apart from the careymontreal.ca website, the Registrant has operated websites located at careymontreal.com and carrymontreal.com (the subject of concurrent UDRP proceedings). These websites promoted a business offering limousine and ground transportation services in the Montreal, Quebec area in association with the CAREY trade-mark (or the phonetic equivalent CARRY) – once again all for commercial gain. The websites associated with these domain names were active at various points in 2011, though they are currently inactive. **Exhibit 7** contains pages printed from these websites as they appeared in 2011 and the associated Registrant

information for the domain names. Fabio Simonetti (aka Fabrizio Simonetti) is listed as the Registrant/owner, administrative and technical contacts of these domain names.

15. The Registrant in the current proceedings, Fabio Simonetti, was also the respondent in a 2007 UDRP proceeding initiated by the Complainant with respect to the domain name montrealcareylimo.com which was registered to Fabio Simon (a pseudonym of Fabio Simonetti) c/o Montreal Limo. The Panel in that case ordered that the domain name be transferred to the Complainant, confirming that: a) montrealcareylimo.com was confusingly similar to Complainant's CAREY mark; b) the Respondent did not have rights or legitimate interests in the domain name; and c) the Respondent registered and used the domain name in bad faith. A copy of the Decision is attached as **Exhibit 8**. A copy of the homepage as it appeared before the prior UDRP decision is attached hereto as **Exhibit 9**.

The Complainant Contacts the Registrant

16. The Complainant issued a cease and desist letter to the Registrant dated June 21, 2013. This letter is attached as **Exhibit 10**. No response was received to this letter.

(A) CONFUSINGLY SIMILAR

17. The disputed domain name is confusingly similar with a mark in which the Complainant had rights prior to the date of registration of the domain name and continues to have such rights, namely the CAREY trade-mark. As the Registrant registered the disputed domain name careymontreal.ca on October 14, 2012 and as the CAREY trade-mark matured to registration in 1994, the Complainant's rights in the CAREY trade-mark precede the domain name registration date. The Complainant's registered CAREY trade-mark by itself satisfies the requirement of prior rights.

18. Pursuant to paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if it so nearly resembles same in appearance, sound or in the ideas suggested so as to be likely to be mistaken for the mark. The test to be applied when considering "confusingly similar" is one of first impression and imperfect recollection and the "dot-ca" suffix should be excluded from consideration. When those principles are applied, the disputed domain name is confusingly similar to the Complainant's CAREY mark.

19. In particular, the disputed domain name includes the entirety of the CAREY mark and the Registrant cannot avoid confusion by incorporating the mark in the domain name.

20. The addition of descriptive or non-distinctive terms such as the geographic indicator "montreal" to a domain name does not mitigate against a finding of confusion and actually enhances the likelihood of confusion, as internet users would naturally assume that the domain name was referring to the activities of the trademark owner with the ambit described by the addition, namely Montreal. As Montreal is a city in which the Complainant offers its services, consumers are likely to conclude that the domain name resolves to a website providing information about the Complainant's services in Montreal.

21. Accordingly, the domain name careymontreal.ca is confusingly similar with the CAREY trade-mark as it so nearly resembles the CAREY trade-mark in appearance, sound and in the ideas suggested so as to be likely to be mistaken for same.

22. It is therefore respectfully submitted that the domain name careymontreal.ca is confusingly similar with the CAREY trade-mark in which the Complainant had rights prior to the registration date of careymontreal.ca, and continues to have such rights.

(B) REGISTRATION IN BAD FAITH

23. Pattern of Unauthorized Domain Name Registrations - Paragraph 3.5(b)

As per paragraph 3.5(b) of the Policy, the Registrant has engaged in a pattern of registering domain names that contain trade-marks to which he is not entitled, and has prevented the Complainant from registering the domain names.

24. The Registrant has registered at least 4 domain names to which he does not appear entitled, namely, careymontreal.ca, montrealcareylimo.com, careymontreal.com and carrymontreal.com. The Complainant was successful in its 2007 UDRP complaint against the Registrant in respect of the domain name montrealcareylimo.com, where the Panel held that a) montrealcareylimo.com was confusingly similar to Complainant's CAREY mark; b) the Respondent did not have rights or legitimate interests in the domain name; and c) the Respondent registered and used the domain name in bad faith. The remaining three domain names were registered subsequent to the Federal Court of Canada order which restrained Fabrizio Simonetti from using the CAREY trade-mark.

Disrupt A Competitor - Paragraph 3.5(c)

25. The Complainant relies upon paragraph 3.5(c), and respectfully submits that the Registrant registered the Domain Name primarily for the purpose of disrupting the business of the Complainant.

26. The Domain Name resolves to a website that is making unauthorized use of the CAREY trade-mark. The Registrant's misappropriation of the Complainant's intellectual property creates the overall commercial impression that he is affiliated with, or otherwise endorsed by the Complainant. This use of the Domain Name qualifies the Registrant as a competitor of the Complainant as his unauthorized website offers services that compete directly with those of the Complainant.

Intentionally Attract Traffic For Commercial Gain - Paragraph 3.5(d)

27. The Complainant also relies on paragraph 3.5(d) and respectfully submits that the Registrant intentionally attempted to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the CAREY trade-mark as to the source, sponsorship, affiliation or endorsement.

28. The domain name careymontreal.ca incorporates the whole of the CAREY trade-mark. As a result, the use of the disputed domain name is likely to result in potential consumers being confused or misled into believing that the Registrant is somehow affiliated with, or endorsed by, the Complainant. This is particularly the case given the extensive goodwill associated with the CAREY trade-mark. As well, the substantial reproduction of the authorized website of the Complainant's Calgary franchisee only further confuses or misleads end users as to source or sponsorship, as end users are likely to believe that the Domain Name also resolves to an authorized website of a franchisee of the Complainant in the Montreal area.

Surrounding Circumstances

Actual or Constructive Knowledge of the CAREY trade-mark

29. A registrant's actual or constructive knowledge of a complainant's rights in a domain name at the time of registration has been found to reinforce a finding of bad faith registration.

30. Given the wholesale incorporation of the CAREY trade-mark in the disputed domain name, together with the nature of the Registrant's website and the fact that it has been substantially reproduced from the authorized website of the Complainant's Calgary-based franchisee, the only plausible conclusion is that the Registrant had actual knowledge of the CAREY trade-mark, thereby supporting a finding of bad faith. In any event, and at the very least, the Registrant had constructive knowledge of the CAREY trade-mark, given that it is the subject of a Canadian trade-mark registration. This also supports a finding of bad faith.

(C) NO LEGITIMATE INTEREST IN THE DOMAIN NAME

The Registrant has no legitimate interest in the domain name as described in paragraph 3.4

31. 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.

No Relationship Between the Parties

32. Apart from the litigation commenced by the Complainant against the Respondent Fabrizio Simonetti and the prior domain name complaint, there has never been any relationship between the Complainant and the Registrant, and the Registrant has never been licensed, or otherwise authorized to register or use, the CAREY trade-mark in any manner whatsoever, including in, or as part of, a domain name.

(a) Paragraph 3.4(a)

33. The domain name careymontreal.ca was not acquired in good faith or for a *bona fide* purpose. The website www.careymontreal.ca is one of a number of infringing websites operated by the Registrant designed to generate revenue by misappropriating the Complainant's CAREY trade-mark. This completely undermines any claim of good faith or legitimate interest.

(b) Paragraph 3.4(b)

34. The Registrant has not used careymontreal.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) Paragraph 3.4(c)

35. The Registrant cannot claim a legitimate interest in the disputed domain name, as careymontreal.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) Paragraph 3.4(d)

36. The Registrant has never used the Domain Name in association with a non-commercial activity, and therefore cannot invoke paragraph 3.4(d) of the Policy. In any event and as previously noted, the Domain Name has not been used in good faith.

The Registrant's website is not a non-commercial fan or information website. Rather, it is a commercial website designed to generate revenue by misappropriating third party trade-marks.

(e) Paragraph 3.4(e)

37. CAREY MONTREAL is not a legal name, surname, or other reference, by which the Registrant is commonly identified, and accordingly, the Registrant cannot rely on paragraph 3.4(e) of the Policy.

(f) Paragraph 3.4(f)

38. The Domain Name is not the geographical name of the location of the Registrant's non-commercial activity or place of business. Although the element "Montreal" does pertain to the location where the services are offered, the trade-mark CAREY (the dominant element in the Domain Name) does not pertain to a geographic location.

39. In light of the foregoing, the Complainant respectfully submits that the Registrant does not have a legitimate interest in careymontreal.ca, and is therefore removed from the application of paragraph 3.4 of the Policy.

CONCLUSION

40. The Complainant submits that the constituent elements of the Policy have therefore been made out and the Panel should order that the disputed domain name be transferred to the Complainant.

B.REGISTRANT

The Registrant did not submit a Response in this proceeding.

DISCUSSION OF THE ISSUES

(A) CONFUSINGLY SIMILAR

41. Under paragraph 4.1 of the Policy the Complainant must prove on the 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 3.5;

and the Complainant must provide some evidence that:

(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

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 3.4.”

42. The Registrant has filed no response to the Complaint and, accordingly, the Registrant has provided no evidence of legitimate use. The Complainant has verified all of the above matters that it relies on by means of the evidence exhibited to the Complaint and the Panel accepts that evidence as establishing each of those matters.

43. The panel finds that the disputed domain name is confusingly similar to the Complainant's CAREY trademark, being, within the meaning of paragraph 4.1 of the Policy, "a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights". That is so for the following reasons.

44. The Complainant has adduced evidence, which the panel accepts, that the Complainant is the owner of the Canadian trademark for CAREY registered on February 25, 1994 (TMA423,694) ("the CAREY trademark") and, accordingly, the Panel finds that the Complainant has rights in the CAREY trademark and continues to have such rights. As the disputed domain name was registered on October 14, 2012 and the CAREY trademark matured to registration in 1994, the Complainant's rights in the mark precede the domain name registration date.

45. The test of whether a domain name is confusingly similar with a mark or trade name, pursuant to paragraph 3.3 of the Policy is if it so nearly resembles same in appearance, sound or in the ideas suggested so as to be likely to be mistaken for the mark.

46. In undertaking that exercise, Paragraph 1.2 of the Policy provides that a domain name is defined so as to exclude the "dot-ca" suffix; see: *Coca-Cola Ltd. v. Amos B. Hennis*, BCICAC Case No. 00014.

47. The Panel has undertaken the comparison between the disputed domain name and the CAREY trade mark and finds that the domain name so nearly resembles the trademark in appearance, sound and the ideas suggested as to be likely to be mistaken for the mark. The CAREY name is clearly well established in Canada, the United States and internationally and so prestigious that the objective bystander would naturally assume that the "carey" of the domain name was invoking the CAREY of the trademark and that it was an official Carey domain name leading to an official Carey website.

48. Moreover, if the trademark is included in the disputed domain name, a Registrant cannot avoid a finding of confusion by appropriating another's entire mark in a domain name: *RGIS Inventory Specialists v. AccuTrak Inventory*, BCICAC Case No. 00053; *Glaxo Group Limited v. Defining Presence Marketing Group Inc. (Manitoba)*, BCICAC Case No. 00020. Applying that principle to the present case, the disputed domain name incorporates the whole of the registered CAREY trade-mark. Accordingly, the Panel finds that the Registrant cannot avoid a finding of confusion as it has misappropriated the entirety of the CAREY trademark. As a further issue under this heading, the Panel notes that the disputed domain name includes the name Montreal, a prominent city in Canada. However, this fact cannot avoid a finding of confusing similarity as it is now accepted that the addition of a geographic indicator such as the name of a city when it is added to a trademark enhances the confusing similarity, rather than diminishing it, as the objective bystander would naturally assume that the domain name thus invoked the activities of the trademark owner in the place in question. See the decision cited by the Complainant, *HMV (IP) Limited et al. v. Michael Mateescu*, DCA-1364-CIRA. That is particularly so in the present case, where the unchallenged evidence is that the Complainant operates in Montreal as well as elsewhere.

49. Accordingly, the Panel finds that the disputed domain name is confusingly similar with the CAREY trade-mark in which the Complainant had rights prior to its registration date and continues to have such rights.

(B) REGISTRATION OF CAREYMONTREAL.CA IN BAD FAITH

50. The Panel now turns to consider whether the disputed domain name was registered in bad faith. The Panel finds that, on the ground relied on by the Complainant and generally, the Registrant registered the disputed domain name in bad faith.

1. THE GROUND RELIED ON BY THE COMPLAINANT THAT THE REGISTRANT REGISTERED THE DOMAIN NAME IN ORDER TO PREVENT THE COMPLAINANT FROM REGISTERING THE TRADEMARK AS A DOMAIN NAME AND THAT THERE HAS BEEN A PATTERN OF DOMAIN NAME REGISTRATIONS BY THE REGISTRANT TO PREVENT PERSONS WITH RIGHTS IN MARKS FROM REGISTERING THE MARKS AS DOMAIN NAMES WITHIN THE MEANING OF PARAGRAPH 3.5 (B) OF THE POLICY.

51. The Complainant submitted that, as per paragraph 3.5(b) of the Policy, the Registrant has engaged in a pattern of registering domain names that contain trade-marks to which he is not entitled and has prevented the Complainant from registering the CAREY mark as a domain name.

52. As authority in support of the application of that proposition in the present case the Complainant argued that it has been held that as few as two (2) domain name registrations, including the disputed domain name, was sufficient to establish that a registrant has engaged in a "pattern" of abusive registrations (*Great Pacific Industries Inc. v. Ghalib Dhalla*, BCICAC Case No.00009; *Canadian Broadcasting Corporation/Société Radio-Canada v. William Quon*, BCICAC Case No. 00006; *Allergan Inc. v. Hiebert Net Inc.*, BCICAC Case No. 00058). The Panel accepts that submission.

53. It was also submitted that repeated registrations of trade-marks of third parties by a registrant resulted in a presumption that a disputed domain name was registered in bad faith and the decision in *Valeant Pharmaceuticals International and Valeant Canada Limited v. Johnny Carpela*, WIPO Case No. D2005-0786 was cited.

54. It was further submitted that:

- (a) the Registrant had registered at least 4 domain names to which he did not appear entitled, namely, careymontreal.ca, montrealcareylimo.com, careymontreal.com and carrymontreal.com;
- (b) the Complainant was successful in its 2007 UDRP complaint against the Registrant in respect of the domain name montrealcareylimo.com, where the Panel held that a) montrealcareylimo.com was confusingly similar to Complainant's CAREY mark; b) the Respondent did not have rights or legitimate interests in the domain name; and c) the Respondent registered and used the domain name in bad faith;
- (c) the remaining three domain names were registered subsequent to the Federal Court of Canada order which restrained Fabrizio Simonetti from using the

CAREY trade-mark; and that

- (d) the Registrant had thus engaged in an unauthorized pattern of domain name registrations, having registered at least 4 domain names to which he was not entitled, and had prevented the Complainant from registering same and from registering the disputed domain name.

55. The Complainant has verified the above matters by evidence and the Panel accepts that evidence. The Complainant's authorised representative has also certified that the information contained in the Complaint is to the best of the Complainant's knowledge complete and accurate. The Registrant has filed no response to the Complaint and, accordingly, the Registrant has provided no evidence on the issue of bad faith.

56. The only conclusion that can be reached in the light of the foregoing is that the Registrant has engaged in a pattern of registering domain names in order to prevent persons with rights in the trademarks from registering the trademarks as domain names.

2. THE GROUND RELIED ON BY THE COMPLAINANT THAT THE REGISTRANT REGISTERED THE DOMAIN NAME PRIMARILY FOR THE PURPOSE OF DISRUPTING THE BUSINESS OF THE COMPLAINANT WITHIN THE MEANING OF PARAGRAPH 3.5 (C) OF THE POLICY.

57. The Complainant's submission was that the Registrant registered the Domain Name primarily for the purpose of disrupting the business of the Complainant. The Panel finds that the evidence supports that conclusion and so finds.

As the Complainant submitted and as the unchallenged evidence shows, the disputed domain name incorporating the Complainant's trademark resolves to a website that itself makes unauthorized use of the CAREY trade-mark and promotes a business that is identical to that of the Complainant. The whole of the evidence shows that the commercial impression of the website is that the Registrant's business is affiliated with, or otherwise endorsed by the Complainant. The Registrant must be found to have been attempting to give the false impression that his business was part of the prestigious and well known Carey enterprise or endorsed by it and that he was attempting to attract business from the Complainant's customers or potential customers for himself. This use of the Domain Name qualifies the Registrant as a competitor of the Complainant as his unauthorized website offers services that compete directly with those of the Complainant. That being so he must be held to have registered the domain name primarily for the purpose of disrupting the business of the Complainant, as any business he got by this means must have been intended for the Complainant. This clearly amounts to bad faith.

3. THE GROUND RELIED ON BY THE COMPLAINANT THAT THE REGISTRANT INTENDED TO ATTRACT TRAFFIC FOR COMMERCIAL GAIN BY CREATING A LIKLIHOOD OF CONFUSION WITHIN THE MEANING OF PARAGRAPH 3.5(d) OF THE POLICY.

58. The Complainant submitted that the Registrant intentionally attempted to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the CAREY trade-mark as to the source, sponsorship, affiliation or endorsement.

The totality of the unchallenged evidence is that the Registrant was falsely trying to fly under the Complainant's colours, which must have resulted in potential consumers being confused or misled into believing that the Registrant was somehow affiliated with, or endorsed by, the Complainant. This is particularly the case, as the Complainant argued, given the extensive goodwill associated with the CAREY trade-mark and the fact that the Registrant was implying

that if customers came to his business, they would be going to the Complainant's business, which was false. The probability is that some potential customers were confused as to whether the Registrant's business was the real Carey business. As well, copying the website of the Complainant's Calgary franchisee made the situation worse, as at least some customers must have believed or have been at risk of believing that the Domain Name resolved to an authorized website of a franchisee of the Complainant in the Montreal area.

The Panel therefore finds this ground has been established.

4. THE GROUND RELIED ON BY THE COMPLAINANT THAT THE REGISTRANT HAD ACTUAL OR CONSTRUCTIVE KNOWLEDGE OF THE CAREY TRADEMARK WHEN HE REGISTERED THE DISPUTED DOMAIN NAME.

59. The Complainant submitted that it is also open to consider surrounding circumstances when examining the issue of bad faith and that one such circumstance is whether the Registrant had actual or constructive notice of the Complainant's trademark at the time it registered the disputed domain name. The Complainant cited in support of such an approach the decisions in

Canadian Broadcasting Corporation/Société Radio-Canada v. William Quon, supra;
Coca-Cola Ltd. v. Amos B. Hennan, supra; *Government of Alberta, on behalf of Her Majesty the Queen in Right of Canada v. Advantico Internet Solutions Inc.,*
BCICAC Case No. 00012. The Panel agrees with that submission.

60. In considering the application to the present case the Panel is influenced by the facts that the Complainant's CAREY trademark is itself well known, having been in use for many years and being prominent in its field of endeavour in Canada and internationally. The evidence is also that the CAREY trademark has attracted considerable reputation and goodwill. Moreover, the Registrant itself must have been of the same opinion as it sought to use the trademark, trade off it and even engage in some brazenly misleading and deceptive conduct when using it to achieve its financial objectives. Clearly, the Registrant could not and would not have gone to the lengths he did of misappropriating the Complainant's trademark, getting up a trade dress on his website that was clearly false and deceptive, pretending that his business was in the same group as the Complainant's franchisee in Calgary, defying an order of the Federal Court of Canada and doing everything it apparently could to pretend that he was part of the Carey network unless the trademark was very widely known and respected and that it would be an effective bait to entice innocent internet users before the Registrant switched them to his own business. This was tantamount to actual knowledge not only of the Complainant's trademark but of its value. The only rational conclusion that the Panel can draw from the evidence is that the Registrant had actual knowledge of the CAREY trademark at the time he registered the disputed domain name; this amounts to bad faith.

It is therefore not necessary to consider if the Registrant had merely constructive notice of the CAREY trademark.

5. GENERAL

61. The Panel has also had regard to all of the circumstances revealed by the case presented by the Complainant and finds that quite apart from and in addition to the liability of the Registrant pursuant to the specific paragraphs of the Policy relied on by the Complainant and

the issue of actual notice, the Registrant registered the disputed domain name in bad faith within the generally accepted meaning of that expression.

(C) NO LEGITIMATE INTEREST IN THE DOMAIN NAME

62. Paragraph 4.1 (c) of the Policy requires the Complainant to provide some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

63. The Panel finds that the Complainant has provided such evidence. The Complainant's case in this regard is that the Registrant has no legitimate interest in the disputed domain name as described in paragraph 3.4 of the Policy because:

- (a) There is no evidence that the Registrant has used the domain name as a mark in good faith with the Registrant having rights in the mark within the meaning of subparagraph 3.4 (a).
- (b) The Registrant cannot claim a legitimate interest in the disputed domain name, as careymontreal.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 pursuant to paragraph 3.4 (c).
- (c) There is no evidence that the domain name is being used for a non-commercial activity, or at all, within the meaning of subparagraph 3.4(d). The evidence is that the domain name has not been used in good faith. Clearly the Registrant's website is not a non-commercial fan or information site.
- (d) There is no evidence that the domain name is a legal name of the Registrant or the name or surname or other reference by which the Registrant was or is commonly identified within the meaning of subparagraph 3.4 (e).
- (e) Sub-paragraph 3.4 (f) of the Policy does not apply because the domain name is not the geographical name of the location of the Registrant's non-commercial activity or place of business. The use of the word Montreal in the domain name is a false suggestion that the domain name itself is part of the business of the Complainant in Montreal which it clearly is not.

64. The Panel accepts the submission of the Complainant and the evidence adduced in its support and concludes that these matters constitute evidence that the Registrant has no legitimate interest in the disputed domain name.

65. Moreover, the Registrant has not filed a response to the Complaint or sought to rebut the above evidence and has thus provided no evidence of legitimate use. If he had any evidence that he had any legitimate interest in the domain name, he could have brought that evidence forward but has not done so. In addition, in view of the facts set out above, it is inherently unlikely that the Registrant could establish a legitimate interest in the domain name when his whole *modus operandi* in this matter has been deceptive and misleading.

DECISION

The Panel finds that the Complainant has satisfied the requirements of Paragraph 4.1 of the Policy and that it is entitled to the remedy it seeks.

ORDER

The Panel directs that the registration of the Domain Name <careymontreal.ca> be transferred from the Registrant to the Complainant.

Date: October 3, 2013

Elizabeth Cuddihy QC,
Panelist

Harold Margles
Panelist

A handwritten signature in black ink, appearing to read "N. A. Brown", written over a horizontal line.

The Honourable Neil Anthony Brown QC
Chair