

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

**Dispute Number:** DCA-1790-CIRA  
**Complainant:** Ford Motor Company of Canada, Ltd.  
**Registrant:** Anatonía Ojo  
**Disputed Domain Names:** Fordparts.ca  
**Registrar:** Namespro Solutions Inc.  
**Arbitrator:** Mr. Claude Freeman  
**Service Provider:** British Columbia International Commercial Arbitration Centre (the “BCICAC”)

**BCICAC FILE NUMBER:** DCA-1790-CIRA

On June 7<sup>th</sup>, 2016, the Complainant filed a complaint via electronic transmission against the Registrant, with the BCICAC, seeking that the Registrant’s registration of <fordparts.ca> be transferred to the Complainant.

The complaint by the Complainant was received by the BCICAC on June 7<sup>th</sup>, 2016, and on June 8<sup>th</sup>, 2016, was found to be in administrative compliance with the Policy and Rules. In accordance with the provisions of Rule 4.3, and by letter via email dated June 8<sup>th</sup>, 2014, the BCICAC, as dispute resolution service provider, so advised the parties and forwarded a copy of the complaint to the Registrant for their response. As the Complaint and related attachments were filed exclusively online, the BCICAC delivered the Complaint to the Registrant only via email. The Registrant has provided no response whatsoever to the BCICAC.

Accordingly, in the absence of a response by the Registrant, the Registrant is not in administrative compliance in the following areas:

- 1) failure to nominate candidates from the providers list – per paragraph 5.2(c) of CDRP rules;
- 2) failure to provide a summary of and references to the relevant Canadian Law – per paragraph 5.2(f) of CDRP rules;
- 3) failure to provide a summary of and references to prior CIRA decisions that would be persuasive, and which apply to domain names registered under any other top-level domain – per paragraph 5.2(g) of CDRP rules; and
- 4) failure to conclude with the certification of the Registrant in form set out in Appendix “B”, followed by the signature of the Registrant or its authorized representative – per paragraph 5.2 (j) of CDRP rules.

As provided for by paragraph 5.6 of CDRP rules, the Registrant is permitted 10 days notice in order to remedy all instances of non-compliance.

As permitted under Rule 6.5, the Complainant elected to convert from a panel of three arbitrators to a single arbitrator, to render a decision in this matter. On August 15<sup>th</sup>, 2016, the BCICAC provided the appointment of the herein sole arbitrator, who accepted same on August 15<sup>th</sup>, 2016.

### **Background/Facts**

The Complainant (FORD) is among the best-known and oldest trademarks in the world. It has continuously used FORD in connection with automobiles and automobile parts since 1895 in the U.S. and through Ford Canada (its subsidiary company) since 1904. The first trademark registration for Ford is in 1909 in the U.S., and in Canada in 1912. Over the years, Ford has added to its growing list of trademark registrations worldwide as a result of the evolving and rapidly growing automobile market it was operating in and serving. Each year, the FORD name and logo is affixed to millions of cars and related goods and services, including especially parts. In 2010, in which “fordparts.ca” was registered, the Ford Motor Company recorded sales of 5,524,000 vehicles in more than 200 markets throughout the world, and had revenue of \$128,954 million USD. Since inception, Ford has sold countless billions of dollars worth of autos and related parts/services. As a result of its’ long history of market prominence and of its business history, Ford has enjoyed occupying a place among the top 50 of the Interbrand/Business Week’s annual survey of “World’s Most Valuable Global Brands”, since 2010. In 2015, Ford was ranked as the 38<sup>th</sup> most valuable global brand by Valuable Global Brands. As mentioned earlier, Ford has an early and long history of trademark registrations, beginning in the U.S. and spreading world-wide. Accordingly, Ford as a large international corporation, has had to register trademarks, patents and any other form(s) of its corporate intellectual property ownership. Its resources to do so are both large internal and external legal resources. Without this form of diligence, Ford would have been negatively impacted many years back, thus perhaps or likely impeding its growth to the world known stature it enjoys today. Further, throughout its history, Ford has been involved in numerous intellectual property challenges, which it has had to defend. In particular, when issues relating to the knowledge and prominence of its corporate name have been raised, Ford has been undeniably recognized as world famous by various and numerous tribunals – and this both before and after Registrant registered “fordparts.ca”. See *Ford Motor Co. v. PrivacyProtect.org/ Domain Admin. UDRP Case No. 1418588 (NAF Feb. 1, 2012)* (“Complainant is a very famous automobile manufacturer and its vehicles can be seen on roads all over the world”). More particularly in *Ford Motor Co. v. Yitao Apex Labs. Ltd., Case No. INDRP/672 (INDRP June 29, 2015)* (“FORD falls within a select class of internationally strong marks that have become so famous that it is impossible for any respondent to claim that he was unaware of Ford’s prior rights or has a legitimate interest in domain names that incorporate the mark”. These are but only two comments levied by tribunals which seem to reflect fairly homogenous thinking by those hearing cases relating to alleged infringement of the Ford trade names and marks. Ford’s rights in FORD and FORD PARTS were well established prior to Registrant’s registration of “fordparts.ca”. Ford operates official websites at “ford.ca” and “ford.com” and “fordparts.com” – all of which were registered by Ford or its authorized agents many years before Registrant’s registration of “fordparts.ca” in 2010. WhoIs records as at May 31, 2016, confirm that Ford has used “fordparts.com” to sell FORD PARTS and MOTORCRAFT PARTS since as early as 2002 – all of which pre-dates the 2010 registration by Registrant. Ford also has in place very stringent contractual agreements and policies with dealers, suppliers et al, with regard to use of trademarks, copyrights, patents and other

intellectual-property. Ford rigidly governs and enforces their company marks, commercial slogans and advertising materials as necessary.

The Complainant submits that the Registrant has no license or other form of authorization from FORD to use the "fordparts.ca" name/domain and as such is in violation of Fords' rights. It also submits that the Registrant uses the Domain Name to host a commercial website displaying so-called "pay-per-click" or "PPC" advertisements targeted toward the trademark meaning of the Domain Name. Registrant receives a payment each time a visitor clicks on one of the links, the vast majority of which resolve to websites selling parts in direct competition with Ford parts. Many of the links displayed on "fordparts.ca" are deceptively labelled to refer to Ford when they resolve to websites on which parts that compete with Ford Parts are for sale. For example, a link on the "fordparts.ca" homepage labelled "Ford Parts Catalogue" resolves to links for various websites that sell parts that compete directly with Ford Parts, as were the various homepage screenshots saved in April and May 2016, and submitted. The Complainant submits the prior, and long and dated history of trademark registrations not only in the U.S. but in Canada and elsewhere. Ford submits that its trademark registrations pre-date any registration by the Registrant of anything resembling "Ford". Also submitted are the prior comments made by other tribunals in support of Ford's notoriety, trademark history and legitimacy.

Accordingly, and based on their submissions, the Complainant submits that the registration and use of the domain name falls squarely within the scope of the Policy, and that paragraph 3.1 of the Policy, provides the Jurisdiction requiring the Registrant to submit to a proceeding, covering the tests that the domain name is: a) confusingly similar, b) that the Complainant has a legitimate interest, and c) that the domain name was registered in bad faith.

The submission by the Complainant that the Registrant is a direct competitor is supported by the fact that the Registrant's website resolves to websites competing directly with Ford. Furthermore, there is nothing submitted to support any marketing, sales or other form of agency agreement between the Registrant and the Complainant, and accordingly, no other form of commercial agreement of any kind seems to exist between the parties. The submissions provided by the Complainant therefore submit that the Registrant is not only in violation of its trademark but is also using this violation to compete illegitimately with the Complainant with its products/services. Clearly, both the Complainant and Registrant are now partially involved in the some form of similar product line offerings and are direct competitors with each other – one legitimately so, and the other not quite so. Simple completion in itself is not a violation, but high-jacking another competitor's legitimate trademark as a means to the end/detract/confuse clients is another debate. The Complainant has submitted a copy of their prior trade-mark registrations dating from October, 1924 till February 2016, all in support of their position on prior registration authority. One can also draw a conclusion (or very rational assumption), that a certain amount or percentage of the Complainant's sales income has been devoted to advertising, promotional and other business development enhancements of their corporate image, and that these financial resources have been carefully measured so as to maximize their return on investment for their advertising and public relations activities (including, but not limited to their website image). Sites/domain names blatantly infringing on or closely navigating near or to, previously and properly registered, highly visible and well-known domain names, trade-marks (which are clearly owned by those with a demonstrated, and prior, legitimate interest) do nothing to enhance

the credibility (for the tests of legitimate interest/confusingly similar and bad faith) of those Registrants who feel they have some free right or licence to infringe.

The Complainant has made several attempts in April and May of 2016 to communicate with the Registrant both through their in-house legal counsel and their out-side counsel. The Complainant sought to advise the Registrant of their objection to the use of the “fordpart.ca” Domain Name and to cease and desist. Letters sent on three occasions electronically to the Registrant via *circa.ca* went unanswered. Attempts by the service provider to notify the registrant the Complaint was leading/proceeding to arbitration, also went unanswered.

The Complainant submits that the use of (“fordparts.ca”) is, and can only be attributed to the Complainant, by virtue of its trade name, trade-mark, and other history attesting to its use, related strictly to its corporate name, wares and services. Further, anything to the contrary defies the rational, reasoning and legal basis for filing for trade-marks and trade names in the first place. Anything else would, and will be confusing and distracting – with the results being that internet users, and existing/potential customers, will be confused, and this will have a damaging effect to the public image of the Complainant.

In short, the Complainant submits that the disputed domain name is:

- 1) Confusingly similar
- 2) Registrant has no right or legitimate interest in the domain name, and
- 3) The domain name was registered and used in bad faith.

### **Reasons**

As noted earlier, the Registrant was not only found administratively non-compliant, but has not put forth any submissions to be reviewed in any detail. Accordingly, as per paragraph 4.1 of the CDRP policy, the onus is on the Complainant to prove on a balance of probabilities that the disputed domain names as registered by the Registrant are confusingly similar to that of the Complainant, and that they have been registered in bad faith. In addition, the Complainant is required under this paragraph to provide “some evidence” that the Registrant has no legitimate interest in the disputed domain name(s).

#### **1. Confusingly Similar**

The first test is whether the Disputed Domain Names are confusingly similar to Complainant’s domain name.

The evidence before us shows that in Canada, the Complainant has been using the Ford name in Canada since as early as 1904.

In order to address the issue of confusion with the standard legal test prevailing in Canada, one can find that in determining whether or not there exists a reasonable likelihood of confusion between the trademarks at issue, the Registrant must have a regard to all the surrounding circumstances, including non-exhaustingly, those specifically enumerated in Subsection 6 (5) of the Canadian Trademarks Act.



- a) inherent distinctiveness of the trademarks, and the extent to which they have become known;
- b) length of time the trademarks have been in use;
- c) nature of wares, services or business;
- d) nature of the trade; and
- e) degree of resemblance between the trademarks in appearance or sound in the ideas suggested by them.

A generally accepted principle when applying the test of confusion is looking at the trademarks from the point of the unwary consumer – comparing similarities as opposed to differences. Can the consumer be easily misled by error or otherwise – and perhaps not even know? Could this also impact not only on the consumer, but also on other potential commercial relationships being sought with the Complainant? If this would impact on the commercial relationship sought with the Complainant by the consumers, then by logical corollary, this would also impact (or possibly sabotage) the commercial relationships the Complainant is seeking with its' potential client base.

The Registrant's dot.ca domain 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. Simply put, this assertion was held in *Veuve Clicquot Ponsardin v. Boutiques Clicquot Ltée*. 2006 SCC 23, [2006] 1 SCR 824 (2 June 2006). Confusion under the *Trade-marks Act* occurs if the use over the trade-marks is likely to lead to the inference that the wares and services associated with the trade-marks are manufactured, sold or performed by the same person. See *LEGO Juris A/S v. James Carswell*, CIRA CASE No. 00150 (2010). The fact that the Registrant is competing for Ford's web traffic makes the Registrant a competitor of Ford.

As well, as per paragraph 1.2 of the Policy, and per BCICAC Case No. 00014 (*Coca-Cola Ltd. v. Amos B. Hennan*), the domain name is defined as follows: "domain name" means the domain name excluding the "dot-ca" suffix and suffixes associated with all third and fourth level domain names accepted by CIRA. Further, a Registrant cannot avoid confusion by appropriating another's entire mark in a domain name per *RGIS Inventory Specialists v. AccuTrak Inventory*, BCICAC Case No. 00053, and *Glaxo Group Limited v. Defining Presence Marketing Group Inc.* (Manitoba), BCICAC Case No. 00020.

To this arbitrator, the domain name "Fordparts.ca" is a part of, (and similar in appearance, sound and in the ideas) with the "Ford" Trade-mark. There appears therefore, not only confusion with, but also misappropriation of the domain name if hijacked elsewhere – especially in the hands of a competitor, whether we know or not of their motives or modus operandi.

This Arbitrator concludes on this issue that the Complainant has met the onus of demonstrating that the disputed domain name is "confusingly similar" – as also supported in part by the "tests" applied by Subsection 6 (5) of the Canadian Trademarks Act ("a" to "e" above).

## **2. Legitimate Interest**

A sufficient and initial proof brought on by the Complainant and pertaining to the Registrant's lack of legitimate interest forces the Registrant to rebut, explain or otherwise plead this issue, for which the Registrant has not done so. Failing to do so permits the Arbitrator to make a negative inference.

As described above, the Complainant must provide “some evidence” that the Registrant has no legitimate interest in the domain name(s), as described in Policy paragraph 4.1(c). If the Complainant satisfies this evidentiary burden, the onus shifts to the Registrant to prove on a balance of probabilities that the Registrant has a legitimate interest in the challenged domain name, for which again the Registrant has not done so.

Policy paragraph 3.4 sets forth an exhaustive list of criteria for determining whether a registrant has a legitimate interest in a domain name. It provides as follows:

*The Registrant has a legitimate interest in a domain name if, and only if, before the receipt by the Registrant of notice from or on behalf of the Complainant that a complaint was submitted.*

- (a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant has Rights in the Mark;*
- (b) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of: (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;*
- (c) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;*
- (d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review of news reporting;*
- (e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or*
- (f) the domain name was the geographical name of the location of the Registrant’s non-commercial activity or place of business.*

*In paragraphs 3.4 (b), (c), and (d) “use” by the Registrant includes, but is not limited to, use to identify a web site.*

The legitimate interest criteria set forth in Policy paragraphs 3.4 (a), (b), (c), and (d) are satisfied only if the Registrant’s use was in “good faith”, a term which is not defined by the Policy. This Arbitrator notes that “good faith” as used in Policy paragraph 3.4 is not necessarily the opposite of “Bad Faith” as defined in Policy paragraph 3.5.

This Arbitrator has reviewed submissions by the Complainant and absent any submissions to not only debate the Complainant’s positions, but to provide any historical proof of commercial activities, and fully eliminate confusion between the Registrant and the Complainant, leaves for invalidated support for the Registrant. Furthermore, the history covered by the Complainant’s submissions themselves (registration, sales volumes et al), speaks volumes about the Complainant’s right to a legitimate interest.

The domain name in dispute was registered by the Registrant on March 3, 2010, and such, without any prior or existing written contract, or other form of trade-mark use or licence with the Complainant.

There has never been any commercial or relationship of any sort between the parties, permitting the use etc. of any of the Complainant's trade-marks or domain name by the Registrant, which could give rise to any confusion. Absent any rebuttal, this unto itself demonstrates a clear, historical lack of interest in the disputed domain name by the Registrant.

The Registrant has not provided any justification whatsoever to justify its claim to a legitimate interest in the disputed domain name.

### **3. Registration in Bad Faith**

The following facts lead this Arbitrator to conclude that the disputed domain names were registered in bad faith:

- 1) The Registrant has, (after considerable historical and past name and product branding by the Complainant) registered (or acquired) a confusingly similar name, and this, in quick succession after some failed, good-faith negotiations attempted by the Complainant.
- 2) The registration of the disputed domain name competes directly with the Complainant's trade-mark, and wares/services, and appears to redirect traffic away from the Complainant to the Registrant. The disputed domain name is also embedded as a component of the Complainant's trade-mark.
- 3) The disputed name could have a confusingly and negative public image impact/confusion about affiliation or sponsorship with the complainant, not to mention the diversion of commercial activity away from the Complainant. Refer to *Bell Canada v. Archer Enterprises*, BCICAC Case No. 00038, and *Yamaha Corporation and Yamaha Motor Canada Inc. v. Jim Yoon*, BCICAC Case No. 00089.
- 4) No attempt whatsoever has been made by the Registrant to provide any answers, rebuttals, support or evidence for the registration/acquisition of the disputed domain name.
- 5) Where the Registrant would seemingly have some justification for the registrations, the Registrant has to put forward some form of evidence to support his conduct, but has not done so. See *Musician's Friend Inc. v. Lowcost Domains Inc.*, CIRA Dispute No. 00074, citing in turn *Canadian Broadcasting Corporation/Société Radio-Canada*.

All of the foregoing is irreconcilable, and sustains the conclusion that there appears to be no compelling need (or right) for the Registrant to register and keep the disputed domain name. Had there been a sound business and legal reason to do so, it would be logical for the Registrant to counter-argue all of this. This does not suggest that any counter-argument would be successful. Websites (not to mention trade-names) are to be seemingly purchased/registered and designed for some legitimate purpose, and certainly no sound reasons have been advanced by the Registrant to support their recent acquisition of the domain name. At the very least, any use made valid by any arguments that might be raised by the Registrant would have been less confusing at the outset, if they were to register a name which would not be confusing and infringing on the Complainant's Trade-mark. Very importantly, the redirection/resolving of

traffic from one web site (“fordparts.ca”) to other sites competitive with “Ford” can only create a clear impression of causing confusion, disruption and hijacking of the Complainant’s business. See *Intesa Sanpaolo S.p.A. v. Interex Corporate Registration Services Inc.*, CIRA Case No. 01130 (2013).

**Balance of Probabilities**

Even if a complainant has met the burdens of proof contained in Paragraph 4.1, a complaint will be dismissed if the registrant is able to prove on a balance of probabilities that the registrant has a legitimate interest in the disputed domain name. Again, such “legitimate interest” must meet one or more of the six tests set out in Paragraph 3.4 and referred to above.

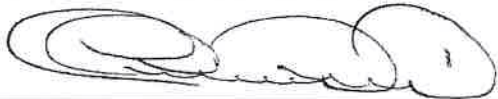
This balance of probabilities test in Paragraph 4.1 of the Policy deals with the situation where even though a complainant has satisfied all of the burdens of proof contained in Paragraph 4.1, an Arbitrator believes that justice requires the Registrant to succeed. In finding against a Registrant, the Arbitrator is depriving that Registrant of a property interest. Such a decision should not be taken lightly. Therefore, even if an Arbitrator finds that a complainant has satisfied the rather heavy burdens of proof placed on it by Paragraph 4.1, if the Arbitrator is satisfied that on a balance of probabilities the registrant has a legitimate interest in the disputed domain name, the Arbitrator must find for the registrant and dismiss the complaint. The Registrant has manifestly provided no argument, solid, or otherwise, to either refute the allegations made by the Complainant or at the very least, support the registration (and any rights) in the disputed domain name.

In the case at hand, this Arbitrator is satisfied that on a balance of probabilities, based upon the evidence before him, that the Registrant has no legitimate interest in the Disputed Domain name (“fordparts.ca”)

**Decision and Order**

I find that the Complainant has succeeded in this proceeding, initiated under the Policy. I therefore direct that the registration of (“fordparts.ca”) be transferred to the Complainant: Ford Motor Company of Canada, Ltd.

Dated this 29<sup>th</sup> day of August, 2016



Claude Freeman, LL.M. (ADR), C. Med., C. Arb.