CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number:	DCA - 1817 - CIRA
Domain Names:	homedpeot.ca
Complainant:	Home Depot International, Inc. Home Depot of Canada Inc.
Registrant:	Terry Davies
Panel:	Elizabeth Cuddihy
Service Provider:	British Columbia International Commercial Arbitration Centre

DECISION

The Parties

1. The complainants are Home Depot International, Inc. of 2455 Paces Ferry Road, NW, Atlanta, Georgia 30339, United States of America, (HDI) and Home Depot of Canada Inc. of 900-1 Concorde Gate, Toronto, Ontario M3C 4H9, Canada, (HD Canada), collectively (the Complainant).

2. The Registrant is Terry Davies of Box 276, 130-8191 Westminster Highway, Richmond, British Columbia, Canada V6X 1A7 (the Registrant).

The Disputed Domain Name and Registrar

3. The Domain Name at issue is Homedpeot.ca (the Disputed Domain Names).

4. The Registrar for the Disputed Domain Names is Namespro Solutions Inc.

5. The Disputed Domain Name was registered on J November 11, 2005.

Procedural History

6. The British Columbia International Commercial Arbitration Centre, (BCICAC) is a recognized service provider to the Domain Name Dispute Resolution Policy, (the Policy) and the Rules, (the Rules) of the Canadian Internet Registration Authority, (CIRA).

7. The Complainant filed a complaint dated August 29, 2016, (the Complaint) with the BCICAC seeking an order in accordance with the Policy and the Rules that the Disputed Domain Name be transferred to the Complainant, Home Depot of Canada, Inc.

8. BCICAC confirmed the Complaint to be in administrative compliance with the requirement of the Rules and the commencement of the dispute resolution process and forwarded copy of the Complaint to the Registrant in accordance with the Rules.

9. The Registrant did not provide a response within the timeframe required by the Rules.

10. The Complainant elected to convert to a single arbitrator in accordance with Rule 6.5 and the BCICAC nominated Elizabeth Cuddihy to act as sole arbitrator to determine the matter.

11. As prescribed by the Policy, the Panel has declared that it can act impartially and independently and that there are no circumstances known to the Panel which would prevent it from so doing.

12. As there was no Response to the Complaint, the Panel shall in accordance with Rule 5.8 decide the Proceeding on the basis of the Complaint.

Canadian Presence Requirements

13. In order for a Registrant to be permitted to apply for registration of, and to hold and maintain the registration of a dot ca domain name, the Canadian Presence Requirements for Registrants, (the Presence Requirements) require that the applicant meet at least one of the criteria listed as establishing a Canadian presence.

14. The Complainant, HDI is the owner of Canadian Trade-mark registration for HOME DEPOT registered in the Canadian Intellectual Property Office (CIPO) on April 29, 1999 as registration Number TMA511200, the Complainant's Mark. The Complainant, HD Canada is an active entity incorporated under the laws of Canada and is the exclusive licensee of the Complainant's Mark in Canada.

15. The Complaint relates to a Disputed Domain Name, which includes the whole of the exact word component of the Complainant's Mark registered in CIPO, except for a single letter reversal, namely the "p" in "DEPOT" being positioned before rather than following the "e", spelling "DPEOT". Accordingly, the Presence Requirements are satisfied.

The Position of the Parties

The Position of the Complainant

16. The Complainant HDI was founded in the United States in 1978 and today is the world's largest home improvement specialty retailer with more than 2,000 retail stores in the United

States (including Puerto Rico and the U.S. Virgin Islands), Canada, and Mexico and maintains e-commerce retail website at www.homedepot.com.

17. The Complainant entered Canada in 1994 beginning with stores in the Greater Toronto Area. By 2000, the Complainant operated approximately 60 stores in Canada and by 2003 the Complainant opened its 100th Canadian store in Thunder Bay, Ontario. Today the Complainant is Canada's leading home improvement specialty retailer with 182 stores in all ten Canadian provinces and employs in excess of 27,000 Canadian associates, with an e-commerce site specifically targeting Canadians at www.homedepot.ca. The Complainant's Mark is the Complainant's corporate identity, a well-known trade name and house mark which has been used in Canada, the United States and Mexico for decades. In addition to owning trademark registrations for the Complainant's Mark, HD, under license from HDI, owns valid and active dot-ca domain names with the Complainant's Mark, including homedepot.ca, registered on October 26, 2000. The corresponding website has been active since then and receives hundreds of thousands of unique visitors every month, including Canadian visitors. HDI's predecessor in title, Homer TLC, Inc. is also listed as owner of valid and active domain names with the Complainant's Marks, including homedepot.com, registered on August 4, 1992.

18. The Complainant submits that the Disputed Domain Name, a misspelling of the Complainant's Mark is confusingly similar to the Complainant's Mark in which the Complainant had rights prior to the registration of the Disputed Domain Name and continues to have such rights, and further that the Registrant has no legitimate interest in the Disputed Domain Name and that the Disputed Domain Name was registered in bad faith in accordance with paragraph 3.5 of the Policy.

19. Accordingly, the Complainant requests that the Disputed Domain Name be transferred to the Complainant, HD Canada.

The Position of the Registrant

20. The Registrant did not file a Response.

Analysis and Findings

21. The purpose of the Policy as stated in paragraph 3.3 is to provide a forum by which cases of bad faith registration of dot-ca domain names can be dealt with relatively inexpensively and quickly. The Policy does not apply to other types of differences between owners of trade-marks and Registrants of Domain names.

Relevant provisions of the Policy are provided below

22. Paragraph 4.1 of the Policy provides:

> **4.1 Onus.** To succeed in a Proceeding, the Complainant must prove, on a balance of probabilities, that:

(a) the Registrant's dot-ca domain name is Confusingly Similar to a Mark in which the Complainant had rights prior to the date of registration of the domain name and continues to have such rights; and
(b) The Registrant has registered the domain name in bad faith as described in paragraph 3.5;
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.

23. Paragraph 3.2 of the Policy provides in part:

3.2 Mark. A "Mark" is
(a) A trade-mark, including the word elements of a design mark, or a tradename that has 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;
(b) A certification mark, including the word elements of a design mark that has been used in Canada by a person or that person's predecessor in title, for the purpose of distinguishing the wares or services that are of a defined standard;
(c) A trade-mark, including the word elements of a design mark, that is registered in CIPO; or
(d) The alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of
Which the Registrar of Trade-marks has given public notice of adoption and use pursuant to paragraph 9(1)(n) of the *Trade-marks Act* (Canada).

24. Paragraph 3.3 provides:

3.3 Confusingly Similar: In determining whether a domain name is "Confusingly Similar" to a Mark, the Panel shall only consider whether the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark.

25. Paragraph 3.4 provides:

3.4 Legitimate Interest: For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all the evidence presented, shall demonstrate that the Registrant has a legitimate interest in the domain name:
(a) The domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;
(b) The Registrant registered the domain name in Canada in good faith in association with 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 registered the domain name in Canada in god 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 god faith in association with a non-commercial activity including, without limitation, criticism, review or 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 paragraph 3.4(d) "use" by the Registrant includes, but is not limited to, use to identify a website.

26. Paragraph 3.5 provides:

3.5 Registration in Bad Faith. For the purposes of paragraph 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limited, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:
(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 licensor or licensee 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 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; or
(d) The Registrant has intentionally attempted to attract, for commercial gain, internet users to the Registrant's website or other location, by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

27. In summary, to succeed in a proceeding, the Complainant must prove on a balance of probabilities that:

1. The dot-ca domain name is confusingly similar to a Mark in which the Complainant had Rights prior to the registration of the Disputed Domain Names and continues to have such Rights;
2. The Registrant has registered the Disputed Domain Names in bad faith; and
3. The Complainant must provide some evidence that the Registrant has no legitimate interest in the Disputed domain Names.

Notwithstanding the evidence presented that the Registrant has no legitimate in the Disputed Domain Names, the Registrant will succeed if the Registrant proves on a balance of probabilities that he has a legitimate interest in the Disputed Domain Names.

Confusingly Similar to a Mark

28. Evidence shows that the Complainant is the owner of the Complainant's Mark, and the Complainant's Mark was registered in CIPO as No TMA511200 on April 29, 1999.

29. In accordance with paragraph 3.3 of the Policy, a domain name is confusingly similar to a Mark if the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark as to be likely mistaken for the Mark. In assessing the domain name, the dot-ca suffix is ignored. It is the narrow resemblance that is applied.

30. The Disputed Domain Name incorporates the entire word of the Complainant's Mark, with only a single letter reversal, namely the "p" in DEPOT is positioned before rather than after the letter "e", spelling Dpeot. The Complainant submits that such a letter reversal is a common typing error, and its incorporation in a domain name is considered "typo-squatting or "typo-piracy", the intentional misspelling of a well-known trade mark. The Complainant refers to the case of *AMAZON.com Inc. vs David Abraham*, DCA-784-CIRA, where the Panel found that typo-squatting is intended to cause confusion for Internet users in order to lure them to the registrant's website. In that case the domain names <amzon.ca>, <amamzon.ca>, <amazzopn.ca>, <amazn.ca> and <amazons.ca> were all found to be confusingly similar to the AMAZON Mark.

31. The Panel agrees. Accordingly for the reason stated above, the Disputed Domain Name is confusingly similar to the Complainant's Mark.

Rights in the Mark prior to the Disputed Domain Name registration and continuing Rights

32. Dpeot.ca was registered on November 11, 2005.

33. As noted in paragraph 28 above, the Complainant owns a Canadian registered trademark issued on April 29, 1999. In addition evidence shows that the Complainant's common law rights and statutory rights to the Complainant's Mark based on use and registered rights date back to the 1990s, years prior to the registration of the Disputed Domain Name and continues to have such rights.

34. The Panel is satisfied that the Complainant's Mark was registered well before the registration of the Disputed Domain Name and accordingly had Rights in the Complainant's Mark well before the registration of the Disputed Domain Name and as the evidence shows that the Complainant's rights are active, the Complainant continues to have such Rights.

Was the Disputed Domain Name registered in bad faith?

35. The Complainant alleges that the Registrant would have been well aware, at the time of registration of the Disputed Domain Name that the Complainant owned prior trademark rights in the Complainant's Mark and trade name and was aware of the Complainant's business in view of the Complainant's trademark registrations, domain name registrations and widespread use of the HOME DEPOT name and Complainant's Mark throughout Canada for years prior to the registration of the Disputed Domain Name.

36. The Complainant further alleges that the Registrant intentionally engaged in a pattern of registering domain names consisting of third party trademarks and misspellings of third-party trademarks. Evidence shows that the Registrant owns many domain names containing registered trademarks of third parties, or common misspellings of such marks, including well-known marks. Examples cited by the Complainant of domain names owned by the Registrant which contain third party trademarks, or common misspellings of such marks, include among others: <Aircanadaa.ca> misspelling of Air Canada owned mark <AIR CANADA> , <Costcoo.ca> and <Cotco.ca> both misspellings of Costco Wholesale Corporation owned <COSTCO> mark, <Mcdonlds.ca> misspelling of McDonald's Corporation owned <McDONALD'S> mark and <Toytota.ca>, misspelling of Toyota Jidosha Kabushiki Kaisha/Toyota Motor Corporation owned <TOYOTA> mark.

37. The Complainant submits that the extensive portfolio of unauthorized domain name registrations incorporating the marks of third parties or misspellings thereof clearly indicates that the Registrant satisfies the test of a "pattern" of registrations as contemplated by sub=paragraph 3(b) of the Policy.

38. Further, the Complainant submits that the Registrant has never been licensed to, nor has it ever authorized the use of, the Complainant's Mark in any manner, in Canada or otherwise, including in, or as part of a domain name or the Disputed Domain Name, nor has the Complainant provided consent to the use or display of the Complainant's Mark at the website of the Disputed Domain Name.

39. Evidence further shows that the Disputed Domain Name resolves to a pay-per-click parking page with links categorized under headings that falsely suggest a connection with the Complainant's business and lead also to websites of competitors, such as Lowes.ca, HomeGardenPro.com, LumbertLiquidiators.com and EasyHomeDecorations.com, to name a few. In so doing, the Complainant alleges that the Registrant, without authority to do so, has intentionally attempted to attract, for commercial gain, internet users to the Registrant's website by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement. To further demonstrate the Registrant's bad faith registration, the Complainant alleges that the Disputed Domain Name has been used to redirect consumers, intending to visit the

Complainant's legitimate website to an illegitimate "Home Depot" customer survey, offering "exclusive rewards" in exchange for the completion of a survey and resulting in incidences of consumer confusion, customer complaints, and a disruption of the Complainant's business.

40. It is well established that pointing a domain name containing a third-party trademark to a pay-per-click website may give rise to a finding of bad faith. These types of websites put registrants in a position to gain financially from referral fees and, as is the case here, do so by trading upon the goodwill and reputation of the Complainant's Mark. Reference is made to *Meguiar's, Inc. v. Interex Corporate Registration Services Inc.* (2015), CIRA Dispute No. 00278 where the Panel stated at paragraph 38:

> The Domain Name is comprised exclusively of the MEGUIAR'S trademark. Under the circumstances, the Panel is of the view that the Domain Name is likely to confuse potential consumers into believing that the Registrant is somehow affiliated with, or endorsed by, the Complainant. Further, resolving the disputed domain name to a pay-for-click website in these circumstances featuring sponsored links to competitors of the Complainant is evidence of bad faith. These websites put the Registrant in a position to reap financial benefit by way of referral fees. Accordingly, the Panel concludes that bad faith does exist as per Paragraph 3.5(d). (*Sleep Country Canada Inc. V. Pitfold Ventures Inc.*, Resolution Canada Case No. 00027; *Lee Valleys Tools Limited v. Pitfold Ventures Inc.*, Resolution Canada Case No. 00040)

41. Based on all the circumstances demonstrated in the material and all the evidence provided by the Complainant, the Panel is satisfied that the Complainant has proven bad faith registration of the Disputed Domain Name as required by the Policy.

Legitimate Interest of the Registrant

42. Paragraph 3.4 of the Policy sets out a non-exhaustive list of criteria upon which the Panel may find, based on all the evidence, that the Registrant has a legitimate interest in the Disputed Domain Name. Paragraph 4.1 of the Policy places the onus on the Complainant to provide "some evidence" that the Registrant did not have a legitimate interest in the Disputed Domain Name. Although "some evidence" is not defined, it imposes, in the Panel's view, a lower threshold than on a balance of probabilities. The onus on the Complainant is to provide "some evidence" of a negative.

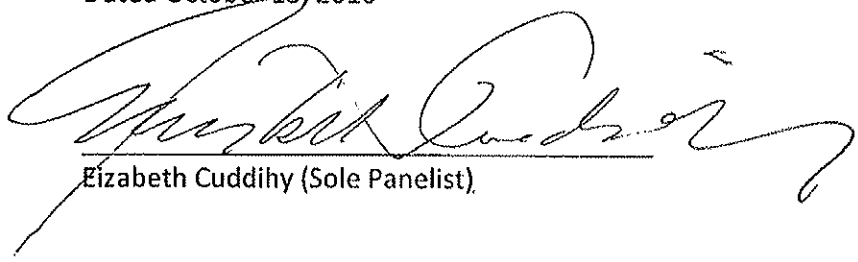
43. The Complainant has provided evidence in respect of the non-exhaustive list contained in paragraph 3.4 of the Policy that the Registrant has no legitimate interest in the Disputed Domain Name. The Registrant did not provide a Response and accordingly the Complainant's evidence is not refuted.

44. Based on the evidence provided which is not refuted by the Registrant, the Panel is satisfied that the Registrant has no legitimate interest in the Disputed Domain Name.

Decision

45. For the reasons set out herein, the Panel decides in favour of the Complainant and orders the transfer forthwith of the Disputed Domain Name to the Complainant, Home Depot of Canada Inc.

Dated October 13, 2016



Elizabeth Cuddihy (Sole Panelist)