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

CASE NO.:	DCA-1677-CIRA
DISPUTED DOMAIN NAMES:	*www.dellbusiness.ca; www.delldeals.ca*
COMPLAINANT:	Dell Inc.
REGISTRANT:	NameShield Inc./Daniel Mullen
SERVICE PROVIDER:	British Columbia International Commercial Arbitration Centre (BCICAC)
PANEL:	James E. Redmond , (Chair); Harold Margles; David G. Allsebrook

DECISION

The Parties

1. The Complainant is Dell Inc., of 1 Dell Way, RR1-33, Round Rock Texas, 78682, USA. The Complainant's authorized representative is Safenames Ltd., contact person Rebecca Holland. The Registrant is NameShield Inc., P.O. Box 1900, Charlottetown PEI, whose authorized representative and contact person is Daniel Mullen.

Procedural History

2. The Disputed Domain Name, *dellbusiness.ca* was registered on November 21, 2012, updated, January 5, 2015. The Disputed Domain Name *delldeals.ca* was registered on November 14, 2012, updated December 7, 2014.

3. The Complainant filed the Complaint on May 28, 2015 pursuant to the CDRP and the Rules.

4. The Service Provider advises that the Complaint, with its attachments, was filed by electronic transmission, and that in addition to providing a copy of the Complaint to the Centre, the Complainant sent a copy of the Complaint to the Registrant's three email

addresses on May 28, 2015. The Complaint was reviewed and found to be compliant. The Centre, by letter to both parties, dated May 29, 2015 advised the parties of the commencement date. The letter noted that the Registrant had already received the Complaint and advised that the Registrant had until June 18, 2015 to file a Response.

5. On June 18, 2015, the Registrant filed a Response, stating that it had not been properly served.

6. By letter to the Registrant dated June 19, 2015, the Centre forwarded the Complaint to the Registrant including the Annexes, and advised that June 19, 2015 would be the commencement date pursuant to Rule 4.4 and that in accordance with Rule 5.1 the Registrant would have 20 days to file a Response in accordance with the Policy and the Rules.

7. On July 9, 2015 the Registrant submitted its Response. Upon review, the Centre found that three of out five pages of the Response were empty. The Centre contacted the Registrant by email and phone to attempt to recover the missing pages, but its attempts were unsuccessful. On July 14, 2015 the Registrant was notified that its Response was not in administrative compliance and was given ten days to remedy the problem.

8. The Registrant delivered a Response on July 24, 2015. The Centre found that the Response was not in administrative compliance with the Policy and the Rules, but after contacting the CIRA office, the Centre accepted the Response.

9. The Centre then appointed a three-person Panel, naming James E. Redmond as Chair along with Harold Margles and David G. Allsebrook as Panelists. Each of the Panelists submitted an Acceptance of Appointment and Statement of Impartiality and Independence as required under paragraph 7 of the Rules.

Factual Background

10. The evidence before the Panel shows that the Complainant is the owner of a number of registered Canadian Trademarks including:

Registration No.	Date of Registration	Trade-Mark	Goods and Services Covered
TMA357503	June 23, 1989	**DELL**	Computers, computer peripheral devices, accessories and parts; computer software; computer documentation; repair and maintenance services for computer equipment; user support services for computer software.
TMA532358	August 9, 2000	**DELL**	Financial services, namely, financing and leasing of computers.
TMA603337	February 26, 2004	**DELL**	Technical support services, namely, troubleshooting of computer hardware and software problems; consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others.
TMA603306	February 26, 2004	**DELL**	Maintenance and Repair of computer hardware; installation of computer networks; installation of computer systems
TMA624741	November 4, 2004	**DELL**	Printers; personal and handheld computers; computer hardware and computer peripherals, namely modems, computer cables, computer styli, hand-held computers, including hand-held computers with wireless e-mail and wireless access to electronic communications networks; projectors; and

Registration No.	Date of Registration	Trade-Mark	Goods and Services Covered
			instruction manuals sold therewith as a unit for all the aforesaid goods.

11. The trade-mark **DELL** has been used in Canada since at least May 4, 1989.

12. The Complainant's evidence is that the Complainant was established in 1984 by Michael Dell and released its first computer system in 1985. It opened its first international subsidiary in the UK in 1987. By 2013, it was the third largest PC vendor in the world and is currently the number one shipper of PC monitors in the world. From as early as 2000, the Complainant has maintained an active internet presence, with a main website at *www.dell.com*. It also owns the domain names *dell.ca*, and *dellrefurbished.ca*, the latter being run by Dell Financial Services Canada LLC, a wholly-owned subsidiary of Dell Inc. The Complainant further asserts that its registered trade-marks as described above have been used by the Complainant to sell computer and computer related products throughout Canada and the world.

13. In this regard, the Complainant operates a Canadian office in Ontario.

14. The Complainant further asserts that the Disputed Domain Name *dellbusiness.ca* resolves to a website that appears to be a Pay Per Click (PPC) website consisting of construction-related links, but which the Complainant says are in fact inactive and do not resolve to external sites. It further asserts that the Disputed Domain Name *delldeals.ca* resolves to a PPC site containing active links for laptops, including **DELL** branded products.

Discussion and Findings

(i) Jurisdiction

15. As the owner of the Canadian trade-marks identified above the Complainant is an eligible Complainant under paragraph 1.4 of the Policy.

(ii) Onus of Proof

16. Under paragraph 4.1 of the Policy, the Complainant must prove on a balance of probabilities that:

(a) The Registrant's dot-ca Domain is confusingly similar to a Mark in which the Complainant had Rights prior to the date of the registration of the Domain Name, and continues to have such Rights;

(b) The Registrant has registered the Domain Name in bad faith, as described in paragraph 3.5 of the Policy;

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 of the Policy.

Even if the Complainant proves (a) and (b) and provides some evidence of (c) the Registrant will succeed 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.

(iii) Confusingly Similar

17. Paragraph 3.3 of the Policy provides as follows:

> 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.

18. Since the Complainant's **DELL** trade-marks as described above are registered at the CIPO, they constitute Marks as defined in paragraph 3.2 of the Policy.

19. Paragraph 1.2 of the Policy provides that for the purposes of the Policy, "**domain name**" means the domain name excluding the "dot-ca" suffix. Therefore, for the purposes of determining whether the Disputed Domain Names are Confusingly Similar to the Complainant's trade-marks, the dot-ca suffix is to be excluded from consideration.

20. In this case, each of the Disputed Domain Names includes the Complainant's **DELL** trade-mark, and includes an additional word, "business" and "deals", respectively. It has been held in numerous CIRA and WIPO cases that the inclusion of additional descriptive words or letters will not prevent a disputed domain name from being found to be Confusingly Similar. For example, in *Enterprise Rent-A-Car Company v. David Bedford* (CIRA Case No. 00097) the Registrant had registered 12 domain names incorporating the Complainant's ENTERPRISE trade-mark, including, among others: *enterpriseautorental.ca, enterprisecarrentals.ca, enterpriserentalcars.ca, enterpriserental.ca, enterprisetoronto.ca, enterprisecanada.ca,* and others. The Panel held that the additional words were merely descriptive and did not prevent the disputed domain names from being held to be Confusingly Similar to the Complainant's trade-mark. In *Google Inc. v 4 Fenix Group Ltd.* (WIPO Case No. D2011-0790) the Registrant had registered a number of domain names including the Claimant's **GOOGLE** trade-mark, along with additional descriptive words, including, for example, *googlemontenegro.com*. Again, the Panel held that the inclusion of the additional words along with the Complainant's well-known trade-mark did not prevent the disputed domain names from being held to be confusingly similar to the Complainant's Marks.

21. In this case, the additional words in the Disputed Domain Names can be characterized as merely descriptive.

22. The Panel finds that the Disputed Domain Names, each of which incorporates in its entirety the Complainant's **DELL** trade-marks, so nearly resemble the Complainant's Marks in appearance, sound or the ideas suggested by the Marks as to be likely to be mistaken for the Mark, and are Confusingly Similar to the Complainant's Marks.

(iv) Registration in Bad Faith

23. The Complainant alleges that the Registrant registered the Disputed Domain Names in bad faith as described in paragraph 3.5 of the Policy.

24. In support of its submission, the Complainant asserts that the Registrant is associated with the registration of numerous third party trademarks, such as "Blackberry", "Dolce and Gabbana", "Facebook", "Pfizer", "Ralph Lauren". It further asserts that the

Registrant has been involved in and lost at least seven domain name disputes as registrant and has registered at least 15 infringing domains under one of his companies. The Complainant asserts that this shows that the Registrant is engaged in a pattern of registering third party trade-marks within domain names. The Complainant cites in this regard *Westinghouse Electric Corporation v. Daniel Mullen,* (Case No. 00083, at p. 6). The Complainant asserts that the evidence makes it clear that the Registrant has undertaken a pattern of conduct of registering domain names containing third party trade-marks over a period of at least 14 years.

25. The Complainant further asserts that the Disputed Domain Names resolve to pay per click ("PPC") websites, a form of web advertising that allows companies to place advertisements from which revenue is gained. It says that the links on *dellbusiness.ca* refer to various sites related to construction, but the links are inactive and do not resolve to third party websites. However *delldeals.ca* contains links to sites of both Complainant and its competitors.

26. The Complainant further asserts that both of the Disputed Domain Names have been listed for sale on "*domainnamesales.com*", which the Complainant describes as "an online premium domain market place".

27. It is a reasonable inference that by registering domain names using an internationally famous trade name in which the Complainant has Rights through its trade-mark registrations in Canada, the Registrant intended to benefit from the good will attaching to the Complainant's brand. The fact that the Disputed Domain names were set up as PPC sites, although it appears one of them may currently be inactive, supports the view that the Registrant intended to trade on the Complainant's good will. It appears to the Panel that the registration of the Disputed Domain Names in this case falls within each of subparagraphs 3.5(c) and (d) of the Policy.

28. The evidence supports the Complainant's allegation that the Disputed Domain Names were registered primarily for the purpose of disrupting the business of the Complainant under 3.5(c) and that, as set out in subparagraph 3.5(d), the Registrant has attempted to attract internet users to its website or other on-line locations by creating a likelihood of

confusion with the Complainant's mark by using that mark as the primary component of the Disputed Domain Names.

29. On the evidence before it, the Panel concludes that the Disputed Domain Names were registered in bad faith.

(v) Legitimate Interest

30. Paragraph 3.4 of the Policy lists six sets of circumstances which "in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in a domain name". These circumstances are listed in subparagraphs 3.4(a) to (f) as follows:

(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 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 registered 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 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.

31. With regard to paragraph 3.4(a) a search of the CIPO trade-mark database reveals no trade-mark registrations for "*dellbusiness.ca*" or "*delldeals.ca*" or any variations thereof in the name of Daniel Mullen, NameShield, or any of the Registrant's other companies. Accordingly the evidence does not show that either of the Disputed Domain Names constituted a Mark in which Registrant had Rights.

32. With regard to paragraph 3.4(b), the Disputed Domain Names were not registered in association with any wares, services or business, nor were the Domain Names 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.

33. On the evidence, the Disputed Domain Names were not registered in association with any wares, services or business nor were the Domain Names understood to be the generic name thereof in any language, as set out in subparagraph 3.4(c).

34. With regard to the criteria set out in subparagraphs 3.4(d), (e) and (f), the evidence negates any submission that the Disputed Domain Names were used in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting, that they or either of them comprised the legal name of the Registrant or constituted a name, surname on other reference by which the Registrant was commonly identified, or that they or either of them was the geographical name of the location of the Registrant's non-commercial activity or place of business.

35. Further, the evidence advanced by the Complainant that the Disputed Domain Names resolve to PPC websites, and that the Registrant was offering the websites for sale, lead to the reasonable inference that the Registrant's real intent in registering the Disputed

Domain Names was for the purpose of financial benefit through the Complainant's well known trade-mark **DELL**. That the Registrant had any legitimate interest in the Disputed Domain Names is further negated by the Complainant's evidence that there was no connection or relationship between the Complainant and the Registrant under which the Registrant was given any clear right to use the Complainant's Marks. Also, the factors upon which the Panel has found that the Disputed Domain Names were registered in bath faith also may be taken as some evidence that, as required under the respective subparagraphs of paragraph 3.4 of the Policy, the Registrant did not use the Marks in good faith,

36. The Panel finds that the Complainant has produced sufficient evidence to satisfy the onus on it under Policy paragraph 4.1 to show that the Registrant has no legitimate interest in the Disputed Domain Names.

37. The Panel concludes that the Complainant has met the onus upon it under paragraph 4.1 of the Policy to provide some evidence that the Registrant has no legitimate interest in the Disputed Domain Names. The Registrant has failed to produce evidence showing on a balance of probabilities that it has a legitimate interest in the Disputed Domain Names.

(vi) The Response

38. In its Response, the Registrant has raised several objections of a procedural nature, as a result of which it alleges that the Complaint should fail.

39. One ground of objection arises from the fact that the Service Provider did not include a copy of the Complaint in its original letter to the Registrant notifying it of the Complaint, apparently because a copy of the Complaint had already been provided directly to the Registrant by the Complainant. The Registrant argues that this rendered the Complaint invalid from the beginning. However, the Service Provider advises that when it received a Response from the Registrant respecting this point, the Service Provider sent a further letter to the Registrant providing the Registrant with a copy of the Complaint and attachments and setting a new time for Response. Following that, the Registrant filed a further Response, which the Service Provider found to be non-compliant with the Policy and Rules. The Registrant then filed a further Response, which the Service Provider

accepted as compliant and notified the parties that the Panel had been appointed to deal with the Complaint.

40. The Panel sees no merit in the suggestion that these facts should lead to a dismissal of the Complaint. The Registrant was given proper notice of the Complaint and a proper opportunity to file its Response.

41. The Registrant also complained about the fact that the Complaint Transmittal Cover Sheet showed that the Complainant was Dell Inc. and that the Complainant's Authorized Representative was Safenames Ltd. whose address was in the United Kingdom. It also showed that the contact person for each of Dell Inc. and Safenames Ltd. was one RebeccaHolland. The Registrant took issue with the fact that Safenames Ltd. was a UK companwhich "has no standing and has no trade-mark registration in Canada for any term involving the surname 'Dell'" and that it was "abusive of the CDRP to allow a third party which is not a legal representative of a CIPO trade-mark holder, and which is not a law firm and which is not a Canadian entity, to bring forth a CDRP merely based on representations that it acts for a CIPO trade mark holder". The Panel has not found anything in the Policy providing that the Representative of the Complainant must be in Canada or must be a lawyer or a law firm, and the Registrant identifies no such provision. The Panel therefore finds no merit in this objection.

42. The Response also submits that the Complainant "holds no trade-mark registration at CIRA for operation of a website", and that the only party that holds a CIPO trade-mark registration for the operation of s website in connection with the Dell name is Dell Chemists (1975) Limited. The simple answer to that complaint is that it is not necessary that a complainant's trade-mark be registered for the service of operating a website. It can be registered for any good or service.

43. To the extent that the arguments of the Registrant go to the question of the validity of the Complainant's trade-mark registration, that is a question that is not within the powers given to a Panel under the Dispute Resolution Policy to resolve.

Decision and Order

44. The Panel finds, for the reasons given above, that the Complaint is successful, and it is ordered and directed that the registration of the Disputed Domain Names be transferred to the Complainant.

James E. Redmond, Chair

for Harold Margles

for David G. Allsebrook

DATED August 24, 2015