

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

Disputed Domain Name: cadillacxts.ca
Complainant: General Motors LLC
Registrant: Tony Wilson
Registrar: DomansAtCost Corp.
Panel: Hugues G. Richard
Service Provider: Resolution Canada Inc.

DECISION

A. THE PARTIES

1. The Complainant is General Motors LLC (“General Motors”), a limited liability company organized and existing under the laws of the State of Delaware with an office at 300 Renaissance Center, City of Detroit, State of Michigan, 48265-3000, United States of America.
2. The Registrant is Tony Wilson. His Administrative Contact is: Phil Walker, 26 Auriga Drive, Nepean, Ontario, K2E 8B7.

B. DISPUTED DOMAIN NAME AND REGISTRAR

The disputed domain name that is subject of this arbitration is cadillacxts.ca (“Domain Name”).

The Registrar with which the Domain Name is registered is DomansAtCost Corp (“Registrar”).

The Domain Name was registered on February 11, 2010.

C. PROCEDURAL HISTORY

A copy of the Complaint and the fee have been sent or transmitted to Resolution Canada Inc. (“Provider”) on February 13, 2012.

On February 14, 2012, Catherine Leung, Administrator of the Provider, sent an email to the Registrant. The email contained these following attachments: the English and French copies of the notice of Complaint filed by the Complainant and the electronic version of the Complaint’s Schedules of Annexes.

The Provider informed the Registrant that the Registrant had twenty (20) days from the Date of Commencement of the Proceeding, on February 14, 2012, to file a Response to the Complaint with the Provider.

The Registrant has not provided his Response.

D. PANELIST IMPARTIALITY AND INDEPENDENCE

As required by section 7 of the Rules, the Panel, Hugues G. Richard, has submitted to the Provider a declaration of impartiality and independence in relation to this dispute.

E. EFFECT OF FAILURE OF REGISTRANT TO FILE A RESPONSE

As mentioned, the Registrant failed to file a compliant Response. In doing so, no information or submission have been filed to have the Complaint dismissed.

Section 5.8 of the Rules states that “[i]f a Registrant does not submit a Response within the period for submission of a Response or any period extended [...] the Panel shall decide the Proceeding on the basis of the Complaint [...]”.

The Panel will then make its decision solely on the basis of the facts and arguments submitted by the Complainant.

F. REMEDY SOUGHT

In accordance with paragraph 4.3 of the Policy, and Rules 3.2 (j), the Complainant requests that the Panel issue a decision that the Domain Name be transferred to the Complainant.

G. APPLICABLE LAW

According to Section 12.1 of the Rules, the Panel shall apply the laws of Ontario and the laws of Canada applicable therein.

Also, as stated in paragraph 4.2 of the *CIRA Domain Name Dispute Resolution Policy* (“Policy”) and in paragraph 3.2 (m) of the CIRA Dispute Resolution Rules (“Rules”), the Panel will give its decision in accordance with the Policy and the Rules.

H. JURISDICTION OVER THE PARTIES: ELIGIBILITY OF THE COMPLAINANT

To form a Complaint, the Complainant shall specify the basis on which it satisfies CIRA’S *Canadian Presence Requirements for Registrants* (the “CPR”) (sub-paragraph 3.2 (f) of the Rules).

The Complainant submitted that it is the owner of numerous trade-marks which are the subject of a registration under the *Trade-marks Act* (Canada) R.S.C. 1985, c. T-13 (the “Trade-marks Act”).

In doing so, the Complainant satisfies section 2(q) of the CPR and has therefore established its Canadian presence.

I. FACTUAL BACKGROUND BASED ON THE COMPLAINANT’S CONTENTIONS

The Complainant makes, among others, the following assertions:

- The Complainant, General Motors, is world-renowned as an automotive manufacturing company and is among the world’s largest automakers. General

Motors is the successor in interest to all trade-marks and related goodwill formerly owned by General Motors Corporation which was founded in 1908.

- The Complainant owns over 500 trade-marks registrations for the trade-mark CADILLAC, or trade-marks containing CADILLAC worldwide. Moreover, the Complainant owns registrations for the trade-mark CADILLAC XTS in numerous countries.
- The Complainant owns the following registered trade-marks for CADILLAC in Canada (Rules, para. 3.2(h)):
 - Reg. No. TMDA40178 CADILLAC (Registered July 3, 1926) covering the wares: “Automobiles, their structural parts and accessories”.
 - Reg. No. TMA107713 CADILLAC (Registered August 16, 1957) covering the services: “The inspection, adjustment, maintenance and repair of motor vehicles, their parts and accessories”.
 - Reg. No. TMA408650 CADILLAC (Registered February 26, 1993) covering the wares: “Automobiles and parts and accessories therefor.”
 - Reg. No. TMA568698 CADILLAC (Registered October 8, 2002) covering the wares: “Key rings; pens and pencils; mugs; drinking glasses; notepad holder; lapel pins; cigarette lighters; playing cards; flags; balloons.”
 - Reg. No. TMA604054 CADILLAC SRX (Registered March 03, 2004) covering the wares: “Motor vehicles, namely trucks; parts and fittings therefor.”
 - Reg. No. TMA664465 CADILLAC (Registered May 17, 2006) covering the wares: “Optical frames, eyewear lenses, eyewear cases, and eyewear chains.”
 - Reg. No. TMA740195 CADILLAC (Registered May 14, 2009) covering the wares: “Lighters for cigars and cigarettes”.

- Reg. No. TMA674261 CADILLAC (Registered October 5, 2006) covering the services: “The inspection, adjustment, maintenance and repair of motor vehicles, their parts and accessories.”
- The Complainant also owns in Canada pending application No. 1455597 CADILLAC XTS (filed October 16, 2009) covering “Motor land vehicles, namely automobiles, sport utility vehicles, trucks and vans.”

J. COMPLAINANT’S CONTENTIONS:

A. The domain name is identical or confusingly similar to a trade-mark or service mark in which the Complainants have rights (sic):

- On February 11, 2010 the Registrant registered the Domain Name with the Registrar. The first and dominant element of the Domain Name incorporates the trade-mark CADILLAC in its entirety. The Complainant’s predecessor General Motors Corporation adopted and has used the trade-mark CADILLAC for over 100 years. Such adoption and use of this trade-mark precedes the registration date of the Domain Name.
- The Domain Name and the trade-mark CADILLAC are confusingly similar. Thus, the Domain Name so nearly resembles the trade-mark as to be likely to be mistaken for the trade-mark.
- As the trade-mark CADILLAC has no meaning in English other than in relation to its ware and services, the Domain Name is calculated to confuse or deceive, as it falsely suggested its services are those of the Complainant.

B. The Registrant has no rights or legitimate interests in respect of the Domain Name (sic):

- The Registrant has not received any licence or consent, express or implied, to use the trade-mark CADILLAC in a domain name or in any other manner from the Complainant, nor has the Complainant acquiesced in any way to such use or application of the trade-mark CADILLAC by the Registrant. Indeed, at no time

did the Registrant have authorization from the Complainant to register the Domain Name. To the best knowledge of the Complainant, the Registrant has no legitimate right or interest in the Domain Name.

- Prior to the registration of the Domain Name, the Registrant did not use CADILLAC or any other marks containing CADILLAC as a trade-mark, company name, business or trade name. The Registrant is not otherwise commonly known in reference to CADILLAC and/or CADILLACXTS. In view of the above, it may be inferred that the Registrant has no legal right to use the CADILLAC mark.
- Prior to commencing this CDRP proceeding, on October 12, 2011, the Complainant's attorney sent a letter to the Administrative contact concerning the Domain Name via CIRA's message delivery system. The Complainant's attorney did not receive a response.
- The Registrant does not use the Domain Name in connection with a bona fide offering of goods and services. The Domain Name does not currently resolve to an active website. When you type www.cadillacxts.ca in the Internet browser, the following message appears: "Internet Explorer could not find www.cadillacxts.ca".
- At the time the Registrant registered the Domain Name, the trade-mark CADILLAC was well-known among the automobile industry and consumers throughout the world. In view of the above, it may be inferred that at the time the Registrant registered the Domain Name, the Registrant was aware of the Complainant's trade-mark right in respect of the mark CADILLAC.

C. The Domain Name was registered and is being used in bad faith (sic):

- Because of the famous and distinctive nature of the CADILLAC trade-mark, the Registrant is likely to have had constructive notice as to the existence of the Complainant's trade-mark at the time the Registrant registered the Domain Name.

- On the information and belief that in using the Domain Name, the Registrant has intentionally attempted to create a false association, sponsorship or endorsement with or of the Complainant (Policy 3.5(d)). The registration of a domain name containing well-known trade-marks by a person and/or company with no connection to that trade-mark amounts to “opportunistic bad faith”.
- In view of the above it may be inferred that the Registrant registered the Domain Name primarily for the purpose of disrupting the business of the Complainant and in an attempt to profit (Policy 3.5 (c)).
- As previously stated, the Domain Name is currently inactive. The failure to make active use of the Domain Name qualifies as bad faith when the domain name registration occurred after the complainant acquired rights in the trade-mark.

K. OVERVIEW OF APPLICABLE CRITERIA

The Policy sets out, at paragraph 4.1, three criteria to be established by the Complainant in order to successfully prove the Complaint. To onus is on the Complainant to 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;

The Complainant must also provide some evidence that:

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

Accordingly to the Policy, the Complainant has to win with respect to all three elements to be successful.

L. DISCUSSION AND FINDINGS

The Panel will now deal with each of the criteria mentioned above.

(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

Under paragraph 3.3 of the Policy, "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".

In its Complaint, the Complainant did not submit evidence in order to establish that the trade-mark CADILLAC XTS has been used in Canada. However, it has presented evidence that, at the time of the registration of the Domain Name, February 11, 2010, the Complainant had a pending application for CADILLAC XTS, filed on October 16, 2009 (No. 1455597). The panel conducted, *proprio motu*, a search on CIPO Trade-marks Database and has found that the application has been allowed. Finally, the Complainant also indicated that it owns registrations for the trade-mark CADILLAC XTS in numerous countries.

Evidence of registration of the trade-mark CADILLAC prior to the date of registration of the Domain Name has also been submitted by the Complainant. In doing so, the Complainant stated that it owns over 500 trade-mark registrations for the trade-mark CADILLAC, or trade-marks containing CADILLAC worldwide. In addition, evidence regarding the registration of the trade-mark CADILLAC in Canada has been submitted and shows that the trade-mark CADILLAC has been registered for the first time in Canada in July 3, 1926.

As stated by the Complainant, a domain name excludes the "dot-ca" suffix for the purpose of the Proceeding. See paragraph 1.2 of the Policy and *Citrix Online LLC vs Mediavision Network Inc.*, (October 28, 2011), *Resolution Canada, CIRA Dispute No.*

00175. Therefore, the Panel has to decide whether CADILLAC and CADILLACXTS are confusingly similar.

The Panel in *General Motors Acceptance Corporation v. Bob Woods*, (January, 2006), B.C.I.C.A.C., CIRA Dispute No. 00051, page 5 held that “[t]he addition of descriptive or non-descriptive terms in a domain name will not prevent it from being found confusingly similar with a Complainant’s Mark”. Further: “The fact that the whole of the distinctive element of the GMAC Marks, namely GMAC, is incorporated in the domain name is sufficient to support a finding of confusing similarity”.

Likewise, in the present case, the Panel finds that the addition of the letters “xts” to a famous trade-mark such as CADILLAC does not avoid a finding of confusing similarity.

Accordingly, the Panel finds that the Domain Name is confusingly similar to the Complainant’s Mark, in which the Complainant had rights prior to the date of 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;

It is to be noted that the Complainant to be successful under this second element of the basis for Complaint need not prove "use" in bad faith but only "registration" in bad faith.

The Complainant contends that “it may be inferred that the Registrant registered the Domain Name primarily for the purpose of disrupting the business of the Complainant and in an attempt to profit (Policy 3.5 (c))”.

Sub-paragraph 3.5 (c) provides that:

3.5 Registration in Bad Faith. For the purposes of paragraphs 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:

(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;

To satisfy this factor, the Complainant must prove the two elements required by this subparagraph: (i) the Domain name was registered primarily for the purpose of disrupting the business of the Complainant; and (ii) the Complainant is a competitor of the Registrant.

The Panel will address each of those issues.

(i) The Domain name was registered primarily for the purpose of disrupting the business of the Complainant.

The Panel finds no direct evidence that the Registrant registered the Domain Name primarily "for the purpose of disrupting the business of the Complainant". However, from the evidence presented in the Complaint and which the Registrant has failed to answer, the Complainant's Mark CADILLAC is world-renowned. Therefore, as stated in the Complaint, "the Registrant is likely to have had constructive notice as to the existence of the Complainant's trade-mark at the time the Registrant registered the Domain Name" and yet he registered the Domain Name.

The Panel, in *Great Pacific Industries Inc. v. Ghalib Dhalla (April 2, 2003), B.C.I.C.A.C., CIRA Dispute No 00009, p. 20-21*, finds that such registration and use of the Domain Name would disrupt the business of the Complainant. In this case, the Registrant had its website "under construction" for three to five years. The Panel concluded that the Registrant should not be permitted to use the Complainant's trade-mark in its Domain Name and then simply sit on the name for years. As a result, the Panel concluded:

"There is no legitimate purpose in registering and holding this name. As with the provisions of paragraph 3.7 (b) [now 3.5 (c)], had the Registrant made greater use of the website, we would have placed a greater onus on the Complainant to demonstrate the requirements of paragraph 3.7 (c), however, under the circumstances, we believe that the Complainant has satisfied its onus".

In the present case, the Registrant registered a domain name containing a well-known trade-mark and yet he doesn't operate his website. As the situation is similar to the *Great Pacific Industries* case, the Panel finds the Registrant has registered the Domain Name primarily for the purpose of disrupting the business of the Complainant.

(ii) The Complainant is a competitor of the Registrant

The Complainant does not expressly contend that the Complainant is a "competitor" of the Registrant.

The decision in *Canadian Thermos Products v. Michael Fagundes (January 18, 2006)*, *B.C.I.C.A.C., CIRA Dispute No 00049* illustrates the divergent views on what constitutes a competitor. The Panel said that:

"This requirement of Policy paragraph 3.7(c) [now 3.5(c)] has been given different interpretations in previous decisions under the Policy. Some panels have adopted a broad interpretation, holding that a complainant is a competitor of a registrant if they have websites that compete for the attention of Internet users (for example, see *Internet Movie Database Inc. v. 384128 Canada Inc. (December 2005)*). Other panels have adopted a narrower interpretation, holding that there must be some form of direct or indirect business competition between the complainant and the registrant, which may include the registrant directing Internet users to websites of the complainant's business competitors or advertising wares or services that compete with the complainant's wares and services (for example, see *Acrobat Construction v. 1550507 Ontario Inc. (June 2003)*, *Trans Union LLC v. 1491070 Ontario Inc. (April 2003)*, *Microsoft Corporation v. Microscience Corporation (July 2005)*, *The Toro Company v. Hannon (August 2005)*), and that competition for the attention of Internet users is not sufficient to make the complainant a "competitor" of the registrant within the meaning of Policy paragraph 3.7(c) [now 3.5(c)]."

There is no definition of the term "competitor", neither in the Policy nor in the Rules. The issue is whether actual competition exists between the Complainant and the Registrant.

The Panel finds it difficult to conclude that the Complainant is a competitor to the Registrant. As previously stated above, the Domain Name is currently inactive. In doing so, even with the broader interpretation of the word "competitor", it is difficult to establish that the Registrant is competing for Internet traffic, or that the Registrant is

gaining any economic benefit from any redirected traffic, even with a broader interpretation.

Therefore, the Complainant failed to prove this second element required by Policy sub-paragraph 3.5 (c).

Based on sub-paragraph 3.5(d) of the Policy, the Complainant also contends that “the Registrant has intentionally attempted to create a false association, sponsorship or endorsement with or of the Complainant”.

Sub-paragraph 3.5 (d) provides that:

(d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant’s website or other on-line 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.

To demonstrate its argument, the Complainant, based on several WIPO decisions, stated that “[t]he registration of a domain name containing well-known trade-marks by a person and/or company with no connection to that trade-mark amounts to “opportunistic bad faith””.

Whether in our case the Registrant falls squarely under the provisions of sub-paragraph 3.5(d) of the Policy may be doubtful, however, the list of situations under paragraph 3.5 of the Policy are illustrations of situations where bad faith can be found and serve only as guidance for panels' decisions.

The fact that in our case the Registrant chose to adopt a Domain Name where the prominent component was the world famous trade-mark "Cadillac" is in itself an indication that the Registrant is intentionally attempting to attract, for commercial gain, the attention of Internet users. When we add to this that the Domain Name actually registered on February 11, 2010 is identical to the trade-mark "Cadillacxts" which the Complainant filed for registration on October 16, 2009 and which is registered in

numerous other countries, the Panel can only conclude that the Registrant falls within the spirit of sub-paragraph 3.5(d) of the Policy and therefore, the Panel concludes that the Registrant registered the Domain Name in bad faith. It is worth noting that the Registrant did not even attempt to justify his actions.

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

According to the Complainant, the Registrant has not received any licence or consent, express or implied, to use the trade-mark CADILLAC as a domain name or in any other manner.

Moreover, the submissions made by the Complainant indicate that the domain name does not resolve to an active website.

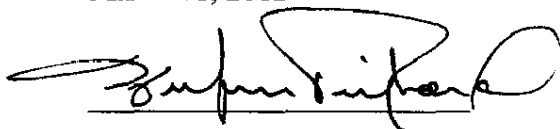
Also, the Registrant does not appear to have used CADILLAC or any other marks containing CADILLAC as a trade-mark, company name, business or trade name. Finally, the Registrant is not commonly known in reference to CADILLAC and/on CADILLACXTS.

Accordingly, the Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name and this evidence has not been rebutted by the Registrant.

M. CONCLUSION AND ORDER

The Complaint having succeeded in proving the three elements of the basis for the Complaint, the Panel orders that the Domain Name cadillacxts.ca be transferred to the Complainant.

March 21, 2012



Hugues G. Richard

Sole Panelist

