

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

Domain Name: CHEVROLETORLANDO.CA

Complainant: General Motors LLC
Registrant: Ryan Thompson
Registrar: Go Daddy Domains Canada Inc

Panel: David Lametti (sole panelist)

Service Provider: ResolutionCanada

DECISION

A. The Parties

1. The Complainant is General Motors LLC (“GM” or “the Complainant”), a limited liability company registered in Detroit, Michigan. Its corporate address is 300 Renaissance Center, Detroit, Michigan, USA, 48265-3000. The Complainant’s authorized representative is Ms Kristen S. Ruisi, Abelman, Frayne & Schwab, 666 Third Avenue, New York, NY, USA, 10017-5621.

2. The Registrant is Mr Ryan Thompson. His listed address is 650 Queens Quay W., Unit 820, Toronto, Ontario, M5W 3N2.

B. The Domain Name and Registrar

3. The domain name at issue is CHEVROLETORLANDO.CA.

4. The domain name is registered with Go Daddy Domains Canada Inc.

C. Procedural History

5. On 9 March 2012, the Complainant submitted this Complaint to the Domain Name Dispute Resolution Provider, ResolutionCanada. The Complainant elected to have the matter heard by a single-member panel. The Provider served notice of the Complaint to the Registrant as required by paragraph 4.3 of the *CIRA Domain Name Dispute Resolution Rules* (version 1.4) [“Rules”].

6. No response was received from the Registrant.

7. The Provider therefore moved to have the Complaint treated as uncontested, and appointed a panelist, all as governed by the Rules.

D. Panel Member Impartiality and Independence Statement

8. As required by paragraph 7 of the Rules, the panelist has declared to the Provider that he can act impartially and independently in this matter, as there are no circumstances known to him that would prevent him from so acting.

E. Canadian Presence Requirement

9. GM's trademark CHEVROLET is registered in Canada and thus satisfies the Canadian Presence Requirement as stated in paragraph 1.4 of the *CIRA Domain Name Dispute Resolution Policy* (version 1.3) ["Policy"]. The registration of GM's trademark ORLANDO is currently pending in Canada, also complying with the Canadian Presence Requirement.

F. Factual Background

10. Founded in 1908, by its predecessor company the General Motors Corporation, GM is a world-renowned automotive manufacturing company. GM's trademark CHEVROLET was widely known and used in Canada, and registered in Canada in 2005. It would be an understatement to say that this mark is well known, both in Canada and around the world. The Complainant has indeed provided extensive evidence of the fact that mark is quite famous.

11. GM's trademark registration for ORLANDO is currently pending in Canada and elsewhere (Annex 4). The registration process was initiated on 6 February 2008. Like many other GM trademarks, the ORLANDO mark is the name of a specific vehicle model in GM's Chevrolet line of products using the CHEVROLET trademark. The mark is already in use in Canada and elsewhere, and is sufficiently well known on its own terms, especially when linked to GM, CHEVROLET or "Chevy". GM has registered the mark ORLANDO in other numerous countries or has registrations pending.

12. Moreover, the Complainant has shown evidence of the marketing practice of linking the CHEVROLET mark to specific vehicle models – and their trademarked names – over time, many of which have been popular in terms of sales and even iconic in terms of popular culture. Thus CHEVROLET and ORLANDO would be linked in the same way that many models have been in the distant and recent past: CHEVROLET CAPRICE and CHEVROLET VOLT are but two examples.

12. GM owns over 1000 trademark registrations worldwide for CHEVROLET or marks containing CHEVROLET.

13. GM also conducts business on the internet, and its trademarks have a strong internet presence. It has registered various domain names around the world incorporating these marks.

14. The Registrant registered the domain name on 19 May 2010. The domain name resolves to a “parking page” in which various services and products are advertised, and with links to “pay-per-click” sites, including unauthorized links to both the Complainant’s sites and those of its competitors.

15. The Complainant attempted to contact, on 14 September 2011, the Registrant’s Administrative Contact via a CIRA web message using the contact details provided by CIRA. No response was received.

18. The Complainant filed this Complaint on 9 March 2012.

G. CIRA Domain Name Dispute Resolution Policy Requirements

19. The *CIRA Domain Name Dispute Resolution Policy* (version 1.3) [“Policy”] sets out at paragraph 4.1 what the Complainant must establish in order to successfully prove the Complaint:

To succeed in the 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 . . .

20. The Panel will deal with each criterion in turn.

H. Is the Registrant's Domain Name Confusingly Similar to the Complainant's Mark?

21. Paragraph 3.2 of the Policy includes the following in the definition of what constitutes a "mark" for the purposes of the Policy:

A "Mark" is:

- (a) a trade-mark . . . or a trade name that has been used in Canada . . . for the purpose of distinguishing the wares, services or business of that person . . . from the wares, services or business of another person; [and]
- (c) a trade-mark . . . that is registered in CIPO . . .

22. The Complainant must establish trademark rights that precede the domain name registration date. This the Complainant has done by showing that both that registered mark CHEVROLET and the pending registered mark ORLANDO preceded the Registrant's registration of the domain name. In addition, the CHEVROLET mark is well known in Canada, and the ORLANDO mark increasingly so. Moreover, both had already been extensively used together in advertising in Canada and on the internet.

23. Paragraph 3.3 of the Policy defines "confusingly similar" in the following terms:

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.

24. The implications of the words "shall only consider" – a change from the previous versions of the Policy – remains to be determined. That discussion does not arise in this matter, as the question of confusion is, in my view, straightforward.

25. For the purposes of this proceeding, the domain name at issue is confusingly similar with the Complainant's trademarks. The domain name is composed of two words, each of which is a trademark belonging to the Complainant, one registered and one pending. Moreover, they are used together in the domain name in the same manner in which the other equivalents of ORLANDO – namely other Chevrolet car models – have been traditionally used by the Complainant, i.e., coupled with the dominant and distinctive mark CHEVROLET. This is a long-established marketing practice of GM, and it was already being done with CHEVROLET ORLANDO when the domain name was registered. Together the marks are identical to the domain name.

26. In any event, the use of CHEVROLET on its own, a significant part of the domain name and a very well known mark used by GM and its predecessor General Motors Corporation for over 100 years worldwide, would be enough on comparison to evoke the requisite degree of resemblance for the purposes of determining confusing similarity under paragraph 3.3.

27. Thus, the Panel finds that the Registrant's domain name CHEVROLETORLANDO.CA is confusingly similar with the Complainant's registered marks – CHEVROLET separately and ORLANDO in conjunction with CHEVROLET – in which the Complainant had longstanding rights prior to the registration of the essentially identical domain name.

I. Was the Registration of the Domain Name Made in Bad Faith?

28. In order to succeed in the second stage of the test set out in paragraph 4.1, the Complainant must show, on the balance of probabilities, that the Registrant registered the domain name in bad faith. Paragraph 3.5 of the Policy states that the Registrant will be considered to have registered the domain name in bad faith, generally if one of the following four conditions is met:

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:

- (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 licensee or licensor 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 or 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 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.

29. There are two significant changes to be noted in this latest iteration of the Policy. First, the list of general criteria for bad faith behaviour is no longer closed. As with "legitimate interest", these four criteria are exemplars of certain kinds of behaviour, and thus make possible other acts demonstrating bad faith. Second, paragraph 3.5(d) adds *intentionally attempting to attract users* for commercial gain as a listed criterion of bad faith where such is done by "creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement" of what the Registrant has to offer – it seems in the widest sense – on its website.

30. The Complainant's argument is framed under paragraphs 3.5(c) and (d). Given that the CHEVROLET mark is so distinctive and well known, the Registrant had constructive notice of its existence prior to registering the domain name. It then becomes easy to draw the inference that the domain name was registered precisely to capitalize on the accumulated goodwill of the Complainant's marks by intentionally creating the impression of a false association, sponsorship or endorsement with them (paragraph 3.5(d)). One could also raise the argument, under the head of paragraph 3.5(c), that the registration was undertaken "primarily for the purpose of disrupting the business of the Complainant".

31. As a whole, this argument is convincing. Interpretations of the predecessor provision under the previous Policy, the equivalent of current paragraph 3.5(c), focusing on "primarily for the purpose of disrupting", held that such opportunistic traffic diversion could be sufficient in some circumstances to constitute bad faith. In this case, where the Registrant makes no effort to dispel any confusion or presumption of a link created by his use of the trademarks in registering and using this domain name, the conclusion of bad faith may be reasonably inferred.

32. Even more compelling is the application of the new paragraph 3.5(d), an addition that likely was meant precisely to apply to this situation. Using a domain name *intentionally* to attract users for commercial gain in a manner *likely to create confusion* as to source, sponsorship, affiliation or endorsement would in my view constitute bad faith where the linking site does not clearly and sufficiently dispel ambiguities as regards the presumptive link to the trademarks. Put another way, the paragraph appears to imply that while some degree of initial interest confusion might still be tolerated (i.e., when *not* intentional and not done "by creating a likelihood of confusion"), it will only be tolerated where it is clear on reaching the site of the domain name in question that the use of domain name was done effectively in good faith and not done to simply piggyback on the domain name's popularity for the purposes financial gain. That there is a conceptual link between this new criterion of good faith to some sort of legitimate interest or legitimately-believed interest in using the domain name to attract traffic seems to be intuitively and analytically obvious.

33. In this case, it appears on the evidence that the only reason to use the confusing domain name was to draw traffic to the web site for commercial gain, profiting from the goodwill in the GM marks, and that this was done intentionally and in a manner which does not sufficiently dispel any notion of confusion as to source, sponsorship, affiliation or endorsement.

34. Therefore this Panel concludes that the Registrant acquired the domain name CHEVROLETORLANDO.CA in bad faith under both paragraphs 3.5(c) and 3.5(d) of the Policy.

J. Does the Registrant Have a “Legitimate Interest” In the Domain Name?

35. The third element of the test set out in paragraph 4.1 of the Policy is to determine whether or not the Registrant has a legitimate interest in the domain name. This inquiry tries to find some more or less objective or ascertainable link between the Registrant and the domain name in question, aside from mere registration, and which is legitimate. Paragraph 3.4 of the Policy, as revised, now states:

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 evidence presented, shall demonstrate that the Registrant has a legitimate interest in a 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 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.

In paragraph 3.4(d) “use” by the Registrants includes, but is not limited to, use to identify a web site.

36. The first four criteria contain an element of good faith in assessing the behaviour of the Registrant, while the last three point to more objective facts linking the domain name to the Registrant. It is to be noted that this definition is also no longer a closed, restrictive list that was the case in the previous version of the Policy, but rather illustrates the primary examples of the kinds of association between the Registrant and the domain name that would be found legitimate. It may now be appropriate for parties or a panel to look beyond these stated criteria in determining the kinds of facts and behaviour that constitute a legitimate interest. It should also be noted that the time frame for assessing legitimacy – “before the receipt by the registrant of notice from or on behalf of the Complainant” – have been removed from the revised Policy.

37. In terms of the procedure required under the Policy, the Complainant must provide some evidence that none of these or similar interests can reasonably apply to the Registrant. The burden would then shift to the Registrant to show that it has, on the balance of probabilities, any one of these legitimate interests as defined under these subparagraphs, as well as, in the amended version, other legitimate interests not so listed.

38. The Complainant has introduced sufficient evidence of the Registrant having no legitimate interest as exemplified under any of the listed heads. The Complainant has not been able to identify any manner in which the registrant might have a legitimate interest in the domain name. In particular:

- the Registrant had neither permission or license, express or implied to use the marks, nor authorization, nor was there acquiescence on the part of the Complainant
- the Registrant was in no way known by the marks in a company name, trade name, business name or trademark
- the Registrant does not use the domain name in a bona fide offering of goods and services

39. Regarding the offering of bona fide goods and services, there is a growing consensus in domain name dispute resolution that incorporating trademarks belonging to others and domain names likely causing confusion or raising presumptive associations are not bona fide offerings. [*Canada Post Corporation v. Marco Ferro*, DCA-871-CIRA “canadapost.ca”; *AADAC v. Ashkay Solutions*, DCA-933-CIRA “aadac.ca”]. The practice of using “parking pages” with “pay-per-click” remuneration to whomever has been singled out as a non-bona fide practice where the intent was simply to capitalize on the goodwill of a popular trademark. [*Canadian Broadcasting Corporation v. Ghalib Dhalla*, DCA-964-CIRA “hockeynightincanada.ca”].

40. The Complainant having thus satisfied its initial burden of showing “some evidence” of “no legitimate interest” puts the onus on the Registrant to show a legitimate interest.

41. The Registrant has not responded, and thus fails to meet its burden of showing a legitimate interest in the domain name.

42. The Panel therefore concludes that the Registrant did not have a legitimate interest in the domain name CHEVROLETORLANDO.CA under paragraph 3.4 of the Policy.

K. Conclusion and Decision

43. The Complainant has established that the Registrant’s domain name CHEVROLETORLANDO.CA is confusingly similar to the Complainant’s registered Canadian trademark and its pending Canadian trademark.

44. The Complainant has established that the Registrant had registered the domain name CHEVROLETORLANDO.CA in bad faith, as defined in the Policy.

45. The Complainant has provided some evidence that the Registrant has no legitimate interest, as defined in the Policy, in the domain name CHEVROLETORLANDO.CA. The Registrant has not established, as set out in the Policy, that it does have a legitimate interest.

46. For these reasons, the Complaint regarding the domain name CHEVROLETORLANDO.CA is successful.

L. Remedy

47. The Complainant has asked that the domain name at issue be transferred to it. The Panel hereby so orders.



David Lametti
Sole Panelist

May 11, 2012