

CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY

DECISION

Domain Name: kijijiautos.ca
Complainant: Kijiji International Limited
Registrant: [privacy protected]
Registrar: Tucows.com Co.
Service Provider: Resolution Canada Inc.
Panel: Peter C. Cooke

THE PARTIES

The Complainant is Kijiji International Limited (the “Complainant”) with an address at Blanchardstown Corporate Park, Unit 6, Dublin, Ireland.

The Registrant is [privacy protected].

THE DOMAIN NAME AND REGISTRAR

The Domain Name is kijijiautos.ca registered on April 1, 2011.

The Registrar of the Domain Name is TuCows.com Co.

PROCEDURAL HISTORY

This is an administrative dispute resolution proceeding pursuant to the Canadian Internet Registration Authority (“CIRA”) *Domain Name Dispute Resolution Policy* (version 1.3) (the “Policy”) and the CIRA *Domain Name Dispute Resolution Rules* (version 1.5) (the “Rules”). By registration of the Domain Name with the Registrar, the Registrant agreed to the resolution of this dispute pursuant to the Policy and the Rules.

According to the information provided by Resolution Canada Inc., the dispute resolution service provider, the history of the proceeding is as follows:

The Complainant filed a complaint (the "Complaint") dated March 14, 2018 with Resolution Canada Inc., requesting that the Domain Name registration be transferred from the Registrant to the Complainant. After having determined that the Complaint was in administrative compliance with the requirements of the Policy and the Rules, Resolution Canada Inc. commenced the dispute resolution process and served notice of the Complaint on the Registrant (as required by paragraph 4.3 of the Rules). No response was received from the Registrant. The Panel confirms that it can act impartially and independently in this matter, as there are no circumstances known that would prevent it from so acting.

In response to a request from the Complainant, the Panel requested submissions relating to the identity of the Registrant, which had recently been revealed to the Complainant.

The Complainant in its submissions indicated that the Registrant was Jim LaPalme, who is identified as being in the automotive business. Further, it was revealed that Mr. LaPalme contacted the Complainant with an offer to sell the Domain Name.

ELIGIBILITY OF COMPLAINANT

The Complainant is an eligible complainant under Paragraph 1.4 of the Policy, as the Complaint relates to the Complainant's registered Canadian trademark KIJJI TMA707133.

OVERVIEW OF THE POLICY

Paragraph 4.1 of the Policy sets forth the Complainant's burden of proof in order to succeed in the proceeding. The 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;
- c) And the Complainant must provide some evidence that:

The Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

COMPLAINANT'S POSITION

The Complainant contends that "KIJJI" is the Complainant's trademark, registered and used in Canada and elsewhere by the Complainant, and that these rights precede the date of registration of the Domain Name.

The Complainant contends that the Registrant registered the Domain Name for the purpose of disrupting the business of the Complainant, a competitor of the Registrant. In addition, it is contended that the Registrant registered the Domain Name in an attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant as to source or sponsorship.

In its additional submissions the Complainant provided further support for the view that the Domain Name was registered in bad faith for the reasons set out above, and further contends that Registrant acquired the Domain Name to sell it for a profit.

DISCUSSIONS AND FINDINGS

Confusing Similarity Between the Domain Name and the Complainant's Mark

The Complainant has demonstrated that it is the owner in Canada and elsewhere of trademark rights in the registered trademark KIJJI, with common law dating back to at least as early as 2005 and registered rights since 2008 in Canada. The Complainant's rights in the trademark therefore precede the 2011 registration date of the Domain Name.

The Complainant submits that the Domain Name is "confusingly similar" with the trademark. A domain name is confusingly similar to a mark if the domain name so nearly resembles the mark in appearance sound or ideas suggested by the mark as to be likely to be mistaken for the mark, as per paragraph 3.3 of the Policy. In applying this definition, it is important to note paragraph 1.2 of the Policy which stipulates that:

For the purposes of this Policy, "domain name" means the domain name excluding the dot-ca suffix..."

As submitted by the Complainant, the Registrant cannot avoid confusion while appropriating the Complainant's entire trademark within the Domain Name. And, the addition of a descriptive

term (in this case “autos”) to a domain name does not diminish the confusion, when the subject matter of the Registrant’s use of the Domain Name would appear to be for the purposes of online automobile sales. The Domain Name kijijiautos.ca therefore so nearly resembles the Complainant’s trademark KIJJI so as to be likely to be mistaken for it. The Panel concludes that the Complainant has succeeded in establishing confusing similarity under paragraph 4.1(a) of the Policy.

Bad Faith Registration

The Complainant contends that the Registrant registered the Domain Name for the purpose of disrupting the business of the Complainant, who is a competitor of the Registrant. The Domain Name resolves to a pay-per-click website with links to sales services offered by competitors of the Complainant e.g. “Cheap Used BMW Cars”. By using the Domain Name in this manner it suggests that the Registrant’s website is approved by or affiliated with the Complainant. Further, the Registrant is a “competitor” in the sense that it is using the Domain Name for the purposes of promoting the online sales of automobiles, diverting Internet traffic away from the real Kijiji. As the purpose of the Registrant’s activities would appear to be to confuse the public into visiting the Registrant’s website rather than the Complainant’s website, this Panel concludes that the Registrant registered the Domain Name in bad faith pursuant to paragraph 3.5 (c) of the Policy.

In addition, or in the alternative, it is alleged by the Complainant that the Registrant registered the Domain Name in an attempt to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant as to source or sponsorship, contrary to 3.5 (d) of the Policy. It was concluded above that the Domain Name is confusingly similar to the Complainant’s trademark. It would appear clear from the use of the Domain Name as part of the pay-per-click activities of the Registrant that financial gain by the Registrant was the motivation for its use of the Complainant’s trademark, so the Complainant has established bad faith under paragraph 3.5 (d) of the Policy as well.

A new allegation was made in the additional submissions regarding the Registrant’s attempt to sell the Domain Name for a profit contrary to 3.5(a) of the Policy. However, it is not clear from the submissions that the amount sought by the Registrant was in excess of the Registrant’s actual costs.

In any event, the Panel has already concluded that the Registrant registered the Domain Name in bad faith pursuant to paragraphs 3.5 (c) and (d) of the Policy.

No Legitimate Interest in the Domain Name

The Complainant has submitted that the Registrant has no legitimate interest in the Domain Name. Paragraph 4.1 (c) of the Policy requires that the Complainant provide *some evidence* that the Registrant has no legitimate interest in the Domain Name.

The Complainant has provided evidence that before the date of registration of the Domain Name it had a trademark that was well-known and had attracted considerable reputation and goodwill. That trademark is found within the Domain Name and it was established above that the Domain Name is confusingly similar to the trademark. The Complainant has therefore satisfied its initial burden by demonstrating that it, and not the Registrant, has a legitimate interest in the Domain Name. In addition, the Complainant has in its submissions reviewed each of the paragraphs in 3.4 of the Policy and not identified any possible legitimate interest of the Registrant.

It therefore becomes incumbent on the Registrant to provide evidence that it has a legitimate interest in the Domain Name. Since the Registrant has failed to provide a response to the Complaint, the Panel is limited to reviewing the Complainant's Complaint.

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 had 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 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.

The Panel has reviewed the Complainant's submissions and come to the following conclusions:

The Registrant cannot rely on 3.4(a) of the Policy. The Domain Name may include a mark, but it is the Complainant's mark. The Complainant confirms that it has not licensed or otherwise authorized the Registrant to use the mark or register it in a domain name.

The Registrant cannot rely on 3.4(b) or 3.4 (c) of the Policy. The Domain Name is neither clearly descriptive nor generic, but is inherently distinctive within the context of the Complainant's services.

The Registrant cannot rely on 3.4(d) of the Policy as the Domain Name is not being used in association with non-commercial activities such as criticism, review or news reporting.

The Registrant cannot rely on 3.4(e) of the Policy as the Domain Name is not the legal name or other identifier of the Registrant.

The Registrant cannot rely on 3.4 (f) of the Policy as the Domain Name has no relation to the geographical name of the Registrant's place of business.

In view of the above, the Panel concludes that the Registrant has no legitimate interest in the Domain Name.

CONCLUSION AND DECISION

The Complainant has proven, on a balance of probabilities, that the 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 in which the Complainant continues to have such Rights.

The Complainant has proven, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith.

The Complainant has adduced some evidence that the Registrant has no legitimate interest in the Domain Name.

The Registrant did not file a response disputing the Complainant's submissions, or justifying its registration of the Domain Name.

For these reasons the Complaint regarding the Domain Name is successful and the Panel orders, pursuant to paragraph 4.3 of the Policy, that the registration of the Domain Name be transferred to the Complainant.



Peter C. Cooke

Dated May 15, 2018