

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

Domain Name: BMWREGINA.CA
Complainant: Bayerische Motoren Werke AG
Registrant: Payscale Company LLC
Registrar: eNom Canada Corp.

Panelist: Myra J. Tawfik
Service Provider: Resolution Canada

DECISION

1. The Parties:

The Complainant is a company based in Germany. Its postal address is 80788 Munich, Germany. Its authorized representative in Canada is DLA Piper (Canada) LLP, located at 1 First Canadian Place, Suite 6000, P O Box 367, 100 King Street West, Toronto, Ontario M5X 1E2

The Registrant is Payscale Company LLC, 50 Albert Street, Clinton, Ontario N0M 1L0, Canada. A WHOIS search identifies its authorized contact as Bryan Smith, info@PayscaleCompany.com.

2. The Domain Name and Registrar

The disputed domain name is BMWREGINA.CA and the Registrar is eNOM Canada Corp.

3. Procedural History

On July 31, 2018, the Complainant initiated a complaint with Resolution Canada under the Canadian Internet Registration Authority (CIRA) Dispute Resolution Policy (CDRP) and the CIRA Domain Name Dispute Resolution Rules (the Rules). Resolution Canada is an approved Dispute Resolution Service Provider under the CDRP.

Pursuant to Rule 5.1, the Registrant was notified by Resolution Canada that it had 20 days to file a Response to the Complaint.

The Registrant did not file a Response within the stipulated delay.

On September 28, 2018, further to Rule 6.5, Resolution Canada appointed Myra J. Tawfik as sole panelist on the complaint after having received from her a declaration of impartiality and independence. A notice of selection of panelist was sent to all parties at that date.

As the Registrant did not respond to the Complaint, the Panel will decide the proceeding solely on the basis of the Complaint.

4. Eligible Complainant

The Complainant has registered trademarks in Canada and therefore meets the Canadian Presence Requirements for Registrants at s. 2(q).

5. Parties' Contentions

The Complainant alleges the following:

It is the owner of numerous registered trademarks in Canada that include the word mark BMW and/or the word mark plus design in association with automobiles and a wide range of collateral products. Representative trademark registrations TMA 143600, TMA320208 and TMA710865 were filed as Schedule 4 (collectively, "the Mark"). All of these trademarks were registered well before the registration of the domain name by the Registrant, which a WHOIS search established as October 28, 2015.

The Complainant has rights in a Mark in Canada prior to the date of registration of the domain name and that the Registrant has registered a domain name that is confusingly similar to the Complainant's Mark.

Firstly, the Complainant alleges that the use of the letters BMW in the domain name is confusingly similar to the Complainant's Mark, which is a famous mark. The fact that the Registrant has added a non-distinctive suffix does not prevent the domain name from being confusingly similar.

The Complainant has a number of authorized dealerships around the country, who customarily use the BMW Mark alongside the dealer's name or the geographic location of the dealership. For example, the dealership in Toronto uses the domain name BMWTORONTO.CA. The authorized dealership in Regina, Saskatchewan uses the dealer's name alongside the Mark "BMW". The use of BMWREGINA.CA by the Registrant creates an undue association between the Registrant and the Complainant.

The Registrant registered the domain name in bad faith because it is attracting internet users who would be looking for the Complainant's authorized dealers in Regina and would assume that the Registrant was affiliated with the Complainant. The website to which the domain name lands, mimics the BMW Logo Mark and actively suggests an affiliation by including the phrase "BMW Regina as shown below". The website also imbeds feeds from the Complainant's official online profile and refers to the Complainant's international portal website at bmw.com.

The Complainant also alleges that the Registrant is disrupting its business by interfering with its ability to control how its registered trademarks are used.

The Registrant is a competitor of the Complainant since its website provides auto parts services including the sale of BMW auto parts. In this respect, it is operating in competition with Complainant which offers the same services. The Registrant's actions are deliberate given the fame of the Complainant's Mark and are designed to trade off the Complainant's goodwill.

The Registrant has no legitimate interest in the domain name because it was not acting in good faith. Given the content of its website, the Registrant knew of the existence of the Complainant and its Mark and could not have registered the combination BMW with the descriptive term REGINA in good faith. The Registrant uses the domain name for commercial activity. Furthermore, the Registrant is not a licensee or otherwise authorized by the Complainant to use the Mark. The domain name is not clearly descriptive, nor is it generic. The domain name is not the name of the Registrant, nor is it the geographic location of its place of business.

The Complainant requests the transfer of the domain name BMWREGINA.CA

6. Findings

Under paragraph 4.1 of the CDRP, the burden is on the Complainant to prove, on a balance of probabilities, that:

- 1) 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
- 2) The Registrant has registered the domain name in bad faith

And to provide some evidence that:

- 3) The Registrant has no legitimate interest in the domain name.

Under Rule 12.1, the Panel shall render its decision based on the CDRP and Rules, the evidence and arguments submitted and any relevant rules and principles of the laws of Ontario and the laws of Canada. Further, inferences can be drawn about the Registrant's motives in registering the domain name from the Registrant's conduct or other surrounding circumstances including the uses to which the domain name is put. See *Canadian Broadcasting Corp v. Quan* CIRA Dispute #00006 (2003); *Government of Canada v. Bedford* CIRA Dispute #00011 (2003)

6.1. Is the Registrant's domain name confusingly similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and in which Complainant continues to have such Rights?

3.2 Mark. A "Mark" is:

- (a) a trade-mark, including the word elements of a design mark, or a trade name 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 the person's predecessor in title, for the purpose of distinguishing 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).

The Panel finds that the Complainant has discharged its burden of proof under this first element of the CDRP. It clearly had rights in a Mark in Canada prior to the registration of the domain name. The domain name BMWREGINA.CA is confusingly similar to the Complainant's Mark in that it so nearly resembles the Mark in appearance, sound or ideas so as to be likely to be mistaken for the Mark. The word mark BMW is a well-known trademark. The addition of the descriptive geographic location does not change the element of confusion especially since the Complainant's authorized dealerships often use a similar convention of including their geographic location along with the word mark BMW in their domain names.

6.2 The Registrant has registered the domain name in bad faith

The Panel also finds that the Complainant has established, on a balance of probabilities, that the Registrant registered the domain name in bad faith. The website to which the domain name lands includes a confusingly similar representation of the Mark, especially the Complainant's design marks. The Registrant's website offers similar services to the Complainant. The Registrant is intentionally attempting to attract internet users to its website by creating a likelihood of confusion with the Complainant's Mark. The domain name BMWREGINA.CA is intended to suggest that the Registrant is affiliated with the Complainant.

6.3 The Registrant has no legitimate interest in the domain name

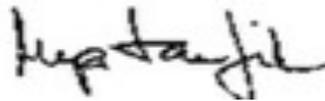
Finally, the Complainant must provide some evidence that the Registrant had no legitimate interest in the domain name under any of the factors identified in ss. 3.4(a) – (f) of the CDRP. The Panel finds that the Complainant has met its burden.

Specifically, BMWREGINA.CA is not descriptive of the character of the wares and is not the generic name in any language of the wares since it includes the complainant's registered trademark which is well-known and distinctive. It is not the legal name of the Registrant, nor is it the geographic location of the Registrant's non-commercial activity or place of business.

7. Decision

The Complainant has established, on a balance of probabilities, the elements set out in s. 4.1 of the CDRP. The Panel orders the transfer of the domain name BMWREGINA.CA to the Complainant.

Dated October 18, 2018



Myra Tawfik
Sole Panelist