

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

Domain Names: *buickcertifiedservice.ca, chevroletcertifiedservice.ca and
cadillaccertifiedservice.ca*

Complainant: General Motors LLC

Registrant: DS1 Design

Registrar: Tucows.com Co.

Service Provider: Resolution Canada Inc.

Panel: Timothy C. Bourne

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 DS1 Design. The administrative contact listed within the domain name registration is Alex Charlton. Mr. Charlton's address is 33 Murdock Ave., Aurora, Ontario, L4G 5E7, Canada.

B. Disputed Domain Names and Registrar

3. The disputed domain names are *buickcertifiedservice.ca*, *cadillaccertifiedservice.ca* and *chevroletcertifiedservice.ca* (collectively the "Domain Names"). The Registrar with which the Domain Names is registered is TuCows.com Co. (the "Registrar"). Each of the Domain Names was registered on November 8, 2010.

C. Procedural History

4. This is an administrative dispute resolution proceeding pursuant to the *CIRA Domain Name Dispute Resolution Policy*, version 1.3 (dated August 22, 2011) (the "Policy") and the *CIRA Domain Name Dispute Resolution Rules*, version 1.4 (the "Rules").
5. The Complainant filed a Complaint dated April 4, 2013 with Resolution Canada Inc. (the "Provider"). On April 8, 2013, Ms. Catherine Leung, Administrator of the Provider, sent an e-mail to the Registrant. The e-mail contained the English and French versions of the Notice of Complaint filed by the Complainant and electronic versions of the Complaint and the Annexes thereto. The Notice of Complaint explained that the Registrant had twenty (20) days from April 8, 2013 to file a Response to the Complaint with the Provider. No Response has been filed.
6. On May 9, 2013, the Provider appointed the Panel.
7. Based upon the information forwarded by the Provider, the Panel holds that all technical requirements for the commencement and maintenance of this proceeding have been established.

8. The Panel is not aware of any other legal proceeding or other arbitration in relation to the Domain Names that would create a need to alter the progress of the proceeding pursuant to paragraph 13.2 of the Rules.

D. Panellist Impartiality and Independence

9. As required by paragraph 7 of the Rules, the Panel, Timothy C. Bourne, has submitted to the Provider a declaration of impartiality and independence for this dispute.

E. Effect of Failure of Registrant to File a Response

10. Paragraph 5.8 of the Rules provides that “[i]f a Registrant does not submit a Response within the period for submission of a Response or any extended period... the Panel shall decide the Proceeding on the basis of the Complaint...”. Accordingly, the Panel will decide this matter solely on the basis of the arguments submitted by the Complainant.

F. Remedy Sought

11. In accordance with paragraph 4.3 of the Policy and paragraph 3.2(j) of the Rules the Complainant has requested that the registrations for the Domain Names be transferred to the Complainant.

G. Applicable Law

12. In accordance with paragraph 12.1 of the Rules, the Panel shall apply the laws of Ontario and the laws of Canada applicable within Ontario. Also, as stated in paragraph 4.2 of the Policy and paragraph 3.2(m) of the Rules, the Panel will base this decision in accordance with the Policy and the Rules.

H. Eligibility of the Complainant

13. The Complainant must satisfy CIRA's *Canadian Presence Requirements for Registrants* (the "CPR"). The Complainant has established that it owns numerous trade-marks corresponding with each of the Domain Names, which trade-marks are registered pursuant to Canada's *Trade-marks Act*, R.S.C. 1985, c. T-13 (the "Act"). Accordingly, the Complainant satisfies paragraph 2(q) of the CPR and is an eligible complainant.

I. Facts

14. The Complainant makes a number of assertions including the following:
 - the Complainant is world-renowned as an automotive manufacturing company and is among the world's largest automakers. The Complainant 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 three hundred trade-mark registrations and pending applications for the trade-mark BUICK or trade-marks incorporating the term BUICK worldwide;
 - the Complainant owns over five hundred trade-mark registrations and pending applications for the trade-mark CADILLAC or trade-marks incorporating the term CADILLAC worldwide;

- the Complainant owns over one thousand trade-mark registrations for the trade-mark CHEVROLET or trade-marks incorporating the term CHEVROLET worldwide;
- the Complainant owns the following registrations for the trade-mark BUICK in Canada:
 - registration No. TMDA40176 (registered July 3, 1926), covering "Automobiles, their structural parts and accessories";
 - registration No. TMA107710 (registered August 16, 1957), covering "The inspection, adjustment, maintenance and repair of motor vehicles, their parts and accessories";
 - registration No. TMA535512 (registered October 24, 2000), covering "Sports caps; golf balls; shirts; mugs; sports bags"; and
 - registration No. TMA674262 (registered October 5, 2000), covering "The inspection, adjustment, maintenance and repair of motor vehicles, their parts and accessories.
- the Complainant owns the following registrations for the trade-mark CADILLAC in Canada:
 - registration No. TMDA40178 (registered July 3, 1926), covering "Automobiles, their structural parts and accessories";

- registration No. TMA107713 (registered August 16, 1957), covering "The inspection, adjustment, maintenance and repair of motor vehicles, their parts and accessories";
 - registration No. TMA408650 (registered February 26, 1993), covering "Automobiles and parts and accessories therefor";
 - registration No. TMA568698 (registered October 8, 2002), covering "Key rings; pens and pencils; mugs; drinking glasses; notepad holders; lapel pins; cigarette lighters; playing cards; flags; balloons";
 - registration No. TMA664465 (registered May 17, 2006), covering "Optical frames, eyewear lenses, eyewear cases, and eyewear chains";
 - registration No. TMA740195 (registered May 14, 2009), covering "Lighters for cigars and cigarettes"; and
 - registration No. TMA674261 (registered October 5, 2006), covering "The inspection, adjustment, maintenance and repair of motor vehicles, their parts and accessories".
- the Complainant owns the following registrations for the trade-mark CHEVROLET in Canada:
 - registration No. TMDA20280 (registered November 5, 1914), covering "Automobiles, motor trucks, motor vehicles, internal combustion engines and parts thereof";

- registration No. TMA107709 (registered August 16, 1957), covering "The inspection, adjustment, maintenance and repair of motor vehicles, their parts and accessories";
 - registration No. TMA534846 (registered October 17, 2000), covering "Pens and pencils; watches; key rings; drinking glasses; travel mugs; mugs; long sleeved shirts, short sleeved shirts; sports caps; sweatshirts; jackets, coats; windbreakers; sports bags; cooler bags; plastic model car kits; die cast model cars; balloons; miniature footballs; hockey pucks; lapel pins; golf balls; golf tees and golf tee holders; sweaters; letter openers; portfolios; towels; sports towels; portable emergency tool kits"; and
 - registration No. TMA673861 (registered September 29, 2006), covering "The inspection, adjustment, maintenance and repair of motor vehicles, their parts and accessories".
-
- each of the trade-marks BUICK, CADILLAC and CHEVROLET are famous on the basis of long-standing use of each of the trade-marks and numerous awards;
 - the Complainant operates websites located at the URLs <http://www.buick.com>, <http://www.cadillac.com> and <http://www.chevrolet.com>; and
 - each of the trade-marks BUICK, CADILLAC and CHEVROLET have been used by the Complainant on wares other than automobiles, including clothing, furniture and watches.

J. Complainant's Contentions

i. The Domain Name is Identical or Confusingly Similar to a Mark in Which the Complainant Has Rights

15. The Complainant submits that the first and dominant element of each of the Domain Names incorporates one of the Complainant's trade-marks. The second element of each of the Domain Names incorporates the term "certified" and "service". The presence of the country code top level domain (ccTLD) ".ca" suffix is irrelevant when comparing a domain name to a trade-mark. Additionally, it is submitted that the combination of a well-known and inventive trade-mark with a common noun or adjective constitutes a domain name which is confusingly similar to the trade-mark. Moreover, the addition of the words "certified" and "service" will not distinguish the Domain Names from the Complainant's trade-marks because:

- of how well-known the Complainant's trade-marks are;
- one of the Complainant's trade-marks appears at the beginning of the disputed Domain Names and is the primary element of the Domain Names; and
- the words "certified" and "service" are likely to be associated with motor vehicles.

ii. The Registrant Has No Rights or Legitimate Interests in Respect of the Domain Names

16. The Complainant submits that the Respondent has not received any license or consent, expressed or implied, to use the trade-marks BUICK, CADILLAC and CHEVROLET in a domain name or in any other manner from the

Complainant. Additionally, it is submitted that the Complainant has not acquiesced in any way to such use or application of the trade-marks BUICK, CADILLAC and CHEVROLET by the Respondent. Further, according to the Complainant, the Respondent did not at any time have authorization from the Complainant to register any of the Domain Names.

17. Further, the Complainant also submits that:

- the Registrant has no legal right to use the trade-marks BUICK, CADILLAC and/or CHEVROLET since the Registrant did not use any of the trade-marks prior to the registration of the Domain Names. Additionally, the Registrant is not otherwise commonly known as any of the Domain Names or the trade-marks which they incorporate;
- the Complainant's attorney sent a letter to the administrative contact listed within each of the registrations for the Domain Names and received no response;
- the Registrant does not use any of the Domain Names in connection with a *bona fide* offering of goods and services since none of the Domain Names resolve to active websites. According to the Complainant, the use of a domain name incorporating a well-known trade-mark to direct visitors to a website unconnected with a trade-mark owner cannot constitute use in connection with a *bona fide* offering of goods and services or otherwise be considered a legitimate interest in a domain name. The Complainant thus asks the Panel to infer that the Registrant's purpose for purchasing the disputes Domain Names was to gain business by portraying to be associated with the Complainant;

- as of November 8, 2010, when each of the disputed Domain Names was registered, the trade-marks BUICK, CADILLAC and CHEVROLET were well-known among the automobile industry and consumers. The Complainant thus requests the Panel to infer that as of the Domain Name registration date, the Registrant was aware of the Complainant's trade-mark rights;
- based upon the numerous trade-mark registrations for the trade-marks BUICK, CADILLAC and CHEVROLET and the fame, goodwill and notoriety associated with the trade-marks, it is impossible to conceive of a circumstance in which the Registrant could legitimately use the Domain Names without creating a false impression of association with the Complainant;
- the Complainant and its predecessor have used the trade-marks for over a hundred years prior to the registration of the Domain Names and thus it can be inferred that the Registrant had notice of the trade-marks as of the registration date for the Domain Names; and
- each of the trade-marks BUICK, CADILLAC and CHEVROLET are distinctive and can have no meaning other than as a reference to the Complainant and its goods and services. Accordingly, the Complainant asks the Panel to infer that the Domain Names would not have been registered but for the renown of the trade-marks and thus that the Registrant has no legitimate right or interest in the disputed Domain Names.

iii. The Domain Name Was Registered and is Being Used in Bad Faith

18. The Complainant submits that because of the famous and distinctive nature of the trade-marks BUICK, CADILLAC and CHEVROLET, the Registrant is likely to have had constructive notice as to the existence of the Complainant's trade-marks when the Registrant registered the disputed Domain Names and thus that the Registrant acted with "opportunistic bad faith".
19. The Complainant relies on paragraph 3.5(d) of the Policy and argues that by using the Domain Names, the Registrant has intentionally attempted to create a false association, sponsorship or endorsement with or of the Complainant. Again the Complainant cites the Registrant's alleged opportunistic bad faith.
20. Finally, the Complainant submits that, in view of the above, it can be inferred that the Registrant registered the Domain Names primarily for the purpose of disrupting the business of the Complainant and in an attempt to profit.

K. Discussion and Finding

21. Paragraph 4.1 of the Policy provides that, to succeed, 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.

22. Paragraph 4.1(c) of the Policy also states that the Complainant must provide some evidence that:

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

L. Confusingly Similar – Paragraph 3.3

23. To satisfy this branch of the test, the Complainant must demonstrate that it has rights in Marks that predate the registration of the Domain Names. Also, the Complainant must demonstrate that each of the Domain Names is confusingly similar with one of the Marks.

24. The Complainant has proven that it has numerous registrations in Canada for each of the trade-marks BUICK, CADILLAC and CHEVROLET. Each of the registrations predates the common registration date for the Domain Names.

25. Paragraph 3.3 of the Policy provides that when 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 mistaken for the Mark. Accordingly, the Panel must not conduct the confusion analysis in the same manner as would occur under subsection 6(5) of the Act.

26. Each of the Domain Names is confusingly similar with one of the Complainant's Marks. Each of the Domain Names wholly incorporates one of the Complainant's registered trade-marks. Paragraph 1.2 of the Policy provides that the term "domain name" excludes the .ca suffix and thus that component cannot differentiate any of the Domain Names from the Complainant's trade-marks. Further, I agree with the Complainant's submission that the addition of the words "certified" and "service" to each of

the Domain Names cannot distinguish them from the Complainant's corresponding trade-mark. Each of these terms are merely descriptive terms, especially in the context of motor vehicles and motor vehicle services, and this puts these circumstances squarely on all fours with those considered in the case of *General Motors Acceptance Corporation v. Bob Woods*, CIRA Dispute No. 00051 (2006). In that case the Panel stated 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."

27. Thus, the Panel finds that each of the Domain Names is confusingly similar to the corresponding Complainant's Mark. Further, the Complainant had rights in each of the Marks prior to the date of registration of the corresponding Domain Name and continues to have such rights.

L. Bad Faith – Paragraph 3.5

28. The Complainant's submissions regarding this element of test are limited to paragraphs 3.5(c) and 3.5(d) of the Policy. Those provisions are reproduced below:

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; 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. The Complainant has failed to prove that any of the Domain Names was registered in bad faith under paragraph 3.5(c). Further, it is not necessary for the Panel to make a final ruling regarding the applicability of paragraph 3.5(d) in view of the findings below.
30. Paragraph 3.5(c) requires the Complainant to prove not only that the Registrant registered a domain name to disrupt the Complainant's business, but also that the Complainant is a competitor of the Registrant. The Complainant has not included any submissions regarding the Registrant's business or otherwise proving that the Complainant is a competitor of the Registrant. Indeed, the Complainant's evidence is that each of the Domain Names resolves to an inactive website.
31. The Complainant also made submissions regarding paragraph 3.5(d). As the Panel understands those submissions, the registration of a domain name containing a well-known trade-mark by an unauthorized party amounts to "opportunistic bad faith" and this constitutes circumstances that violate the provisions of paragraph 3.5(d). The Complainant relies upon three decisions issued pursuant to the Uniform Domain Name Dispute Resolution Policy as precedent (*Expedia, Inc. v. European Travel Network*, WIPO Case No. D200-0137, *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. D2000-0163 and *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. D2000-0226).

32. The Panel's reading of *General Motors LLC v. Tony Wilson*, CIRA Dispute No. 00182 (2012) suggests that the Complainant made the same argument in that case. That case regarded the registration for the domain name *cadillacxts.ca* and it was stated that it may have been "doubtful" that the Registrant fell within the provisions of paragraph 3.5(d) of the Policy. However, the Panel in that case ultimately concluded that:

"[t]he 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."

33. One element that the Complainant must prove under paragraph 3.5(d) is that the Registrant has intentionally attempted to attract Internet users to the Registrant's website for commercial gain. The Complainant has neglected to address this aspect of paragraph 3.5(d) or has simply presumed that the presence of opportunistic bad faith precludes the requirement for proving this element.
34. Nonetheless, in view of the findings below, the Panel makes no finding in respect of whether the Registrant's conduct falls within the spirit of paragraph 3.5(d) or even within the inclusive language of paragraph 3.5.
35. Rather, the Panel concludes that the Registrant's conduct is best addressed by paragraph 3.5(b) of the Policy, which states that the following

circumstance, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:

...

- (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".

36. The Complainant's evidence is that the Registrant registered three domain names, each corresponding with one of the Complainant's trade-marks, on the same date. In *Viacom International Inc. v. Harvey Ross Enterprises, Ltd.*, CIRA Dispute No. 00015 (2003), the Panel held that evidence that a Registrant owns multiple domain names corresponding with third party trade-marks constitutes *prima face* evidence of bad faith registration. Further, in *Yamaha Corporation and Yamaha Motor Canada Ltd. v. Jim Yoon*, CIRA Dispute No. 00089 (2007), the Panel held that a registrant owning as few as two domain name registrations, including the domain name in dispute, is sufficient to establish that the registrant has engaged in a pattern of abusive registrations.
37. Accordingly, the Panel concludes that the Registrant registered each of the Domain Names in bad faith pursuant to paragraph 3.5(b) of the Policy. The Panel also is persuaded by the fact that, despite receiving notice of the Complaint, the Registrant has not bothered to make any submissions to the Panel, including those suggesting that the Domain Names were not registered in bad faith.

M. Legitimate Interest – Paragraph 3.4

38. Paragraph 3.4 of the Policy provides that:

3.4 Legitimate Interests. 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.

39. The Complainant's unchallenged submissions are that:

- the Registrant has not received any license or consent to use the trade-marks BUICK, CADILLAC and CHEVROLET in a domain name or in any other manner from the Complainant;
- the Complainant has not acquiesced in any way to such use of the trade-marks BUICK, CADILLAC and CHEVROLET; and
- at no time did the Registrant have authorization from the Complainant to register any of the Domain Names.

40. Accordingly, the Complainant has provided some evidence that the Registrant has no legitimate interest under paragraph 3.4(a) of the Policy.

41. The Complainant has made submissions regarding the long-standing use by the Complainant and its predecessor of each of the trade-marks BUICK, CADILLAC and CHEVROLET. Accordingly, the Complainant has provided some evidence that the Domain Names cannot be "clearly descriptive" pursuant to paragraph 3.4(b) of the Policy.

42. As for paragraph 3.4(c) of the Policy, the Panel has concluded that the Registrant registered the Domain Names in bad faith and thus the Registrant cannot have a legitimate interest pursuant to this provision.

43. The Complainant's submissions regarding the Registrant's use of the Domain Names do not suggest that the Registrant is using the Domain Names for a "non-commercial activity" such as those specified within paragraph 3.4(d). Accordingly, the Complainant has met its onus under paragraph 3.4(d) of the Policy.
44. The Complainant also has provided some evidence that the Registrant has no legitimate interest under paragraph 3.4(e) of the Policy. According to the registrations for the Domain Names, the Registrant is known as DS1 Design and thus none of the Domain Names comprise a legal name of the Registrant. Further, none of the Domain Names are remotely similar to the business name DS1 Design and thus, in the absence of any evidence to the contrary, do not constitute a "reference by which the Registrant [is] commonly identified". Accordingly, the Complainant has met its onus under paragraph 3.4(e) of the Policy.
45. Finally, in respect of paragraph 3.4(f), the Complainant has included within its materials information regarding the origins of each of the trade-marks BUICK, CADILLAC and CHEVROLET. Each of those trade-marks is ultimately premised upon an individual's surname and thus the Complainant has included some evidence that the Domain Names are not geographical names. Accordingly, in the absence of any evidence to the contrary, the Registrant's conduct does not fall within paragraph 3.4(f) of the Policy.
46. Thus, the Panel concludes that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Names. The onus thus shifts for the Registrant to prove, on a balance of probabilities, that it has a legitimate interest in the Domain Names. The Registrant has not filed any submissions disputing the Complainant's submissions or justifying its registration or use of any of the Domain Names.

N. Conclusion and Decision

47. For the reasons set forth above, the Panel concludes that the Complainant has established the three elements of the basis for the Complaint in accordance with their respective onuses. Thus, the Panel orders the transfer of each of the Domain Names to the Complainant.

May 29, 2013

A handwritten signature in black ink, appearing to read 'T.C. Bourne', written over a horizontal line.

Timothy C. Bourne
Sole Panelist