

IN THE MATTER OF THE ARBITRATION OF A COMPLAINT PURSUANT TO THE
CANADIAN INTERNET REGISTRATION AUTHORITY (CIRA) DOMAIN NAME
DISPUTE RESOLUTION POLICY (CDRP)

Domain in Dispute: enmotion.ca
Complainant: Georgia-Pacific Consumer Products LP
Registrant: JoAnn Gaudry
Registrar: Go Daddy Domains Canada, Inc.
BCICAC File: DCA-1374-CIRA

DECISION

1. The Parties

Complainant is Georgia-Pacific Consumer Products LP of Atlanta, Georgia, USA, represented by Antonio Turco of Blake, Cassels & Graydon LLP of Toronto, Ontario, Canada.

Registrant is JoAnn Gaudry of Vancouver, British Columbia, Canada. The Registrant did not file a Response.

2. The Domain Name and Registrar

The disputed domain name is <enmotion.ca> (the “Disputed Domain Name”), which was created on October 29, 2010.

3. Governing Policy and Rules

This is a proceeding under the CIRA Domain Name Dispute Resolution Policy, Version 1.3 (August 22, 2011) (“Policy”) and the CIRA Domain Name Dispute Resolution Rules, Version 1.4 (August 22, 2011) (“Resolution Rules”). Paragraph 1.8 of the Policy states: “The version of the Policy in effect at the time a Proceeding is initiated will apply to the Proceeding.” And, paragraph 1.2 of the Rules states: “The version of the Resolution Rules in effect at the time a Proceeding is initiated will apply to that Proceeding.” Accordingly, because the British Columbia International Commercial Arbitration Centre (“BCICAC”) states that the Complaint was filed on February 22, 2012, this Decision is based upon Version 1.3 of the Policy and Version 1.4 of the Resolution Rules.

4. Procedural History

The history of this proceeding, according to the information provided by BCICAC, is as follows:

- a. On February 22, 2012, Complainant filed a Complaint pursuant to the Policy and the Rules.
- b. In a letter dated February 27, 2012, BCICAC confirmed compliance of the Complaint and commencement of the dispute resolution process. Attempts to deliver the Complaint

to the Registrant via courier were unsuccessful. BCICAC contacted the Registrant via e-mail with a request to clarify the address, but the Registrant has not replied to BCICAC.

- c. The Registrant has not provided a Response. The Complainant has elected to proceed with a three-person tribunal.
- d. BCICAC appointed Douglas M. Isenberg as Chair of the Panel, and David Wotherspoon as co-panelist, on March 27, 2012. BCICAC appointed Eric Macramalla as co-panelist on the same date, but Mr. Macramalla recused himself on April 5, 2012. BCICAC appointed Anton M.S. Melnyk as co-panelist on April 9, 2012. Messrs. Isenberg, Wotherspoon and Melnyk have each executed a document titled “Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.”
- e. Absent exceptional circumstances, and pursuant to Rule 12.2, the Panel’s decision is to be delivered to BCICAC by April 30, 2012.

The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Rules. Based upon the information provided by the BCICAC, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding, unless otherwise noted, have been met.

5. Canadian Presence Requirement

Paragraph 1.4 of the Policy states: “The person initiating a Proceeding (the ‘Complainant’) must, at the time of submitting a complaint (the ‘Complaint’), satisfy the Canadian Presence Requirements for Registrants (the ‘CPR’) in respect of the domain name that is the subject of the Proceeding unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office (‘CIPO’) and the Complainant is the owner of the trade-mark.” Here, as discussed below, it is evident that the Complainant is the owner of Reg. Nos. TMA648, 928; TMA728,781; and TMA625,313 at the Canadian Intellectual Property Office for the trade-mark ENMOTION. As a result, the Panel is satisfied that the Complainant meets the Canadian Presence Requirements and is eligible to initiate this proceeding.

6. Factual Background and Parties’ Contentions

Complainant states that it is “one of the world’s leading manufacturers of tissue, towels, napkins, dispensers and related consumer products.”

Complainant further states, and has provided evidence in support thereof, that it is the owner of the following trade-mark registrations at the Canadian Intellectual Property Office:

MARK	REG. NO.	REG. DATE	WARES
ENMOTION	TMA648,928	September 26, 2005	Paper towels
ENMOTION	TMA728,781	November 19, 2008	Feminine hygiene containers; dispensers for air fresheners; dispensers for toilet paper
ENMOTION	TMA625,313	November 12, 2004	Paper towel dispenser

These trade-marks are referred to hereafter collectively as the “ENMOTION Trade-mark.”

Complainant further states that, from 2007 to 2011, total sales to customers in Canada of products sold in association with the ENMOTION Trade-mark exceeded US\$30 million.

Complainant further states that it is the registrant of the domain name <enmotion.com>, which is used in connection with web pages associated with products that use the ENMOTION Trade-mark.

Complainant further states, and has provided evidence in support thereof, that the Disputed Domain Name “has always resolved to a ‘parked’ website that displays a number of advertisements and hyper links [sic] under the heading ‘Ads’.... The hyperlinks on the Registrant’s Website link to various websites, including to third party providers of wares which include the products in association with which the [ENMOTION Trade-mark] is used and registered in Canada, including paper towels and dispensers therefore. Specifically, the ‘Ads’ include links to direct competitors of the Complainant, such as BOUNTY paper towels, manufactured by Procter & Gamble, a competitor of the Complainant. These third party providers are not affiliated with the Complainant and provide wares which compete with those of the Complainant.”

Complainant contends that the Disputed Domain Name is confusingly similar to the ENMOTION Trade-mark; and that Complainant has rights in the ENMOTION Trade-mark that pre-date the registration date of the Disputed Domain Name and that Complainant continues to have such rights.

Complainant further contends that Registrant has no legitimate interest in the Disputed Domain Name because, *inter alia*, (1) the Registrant has no rights in the ENMOTION Trade-mark; (2) the Registrant is “unfairly and illegally exploiting the goodwill attached to the” ENMOTION Trade-mark; (3) the Disputed Domain Name is not a generic word in Canada; (4) the Disputed Domain Name is not being used in connection with non-commercial activity; (5) the Disputed Domain Name is “not comprised of the legal name of the Registrant, nor is there any evidence that enMotion was a name, surname, or other reference by which the Registrant was commonly identified”; and (6) the Disputed Domain Name is “not the geographical name of the location of the Registrant’s non-commercial activity or place of business.”

Complainant further contends that the Registrant should be considered as having registered the Disputed Domain Name in bad faith because, *inter alia*, (1) “the Registrant acquired the registration of the Domain Name for the purposes of disrupting the business of the Complainant,

which is a competitor of the Registrant” (establishing bad faith under paragraph 3.5(c) of the Policy); and (2) the Registrant “has registered the Domain Name in order to profit from the confusion that the Domain Name, in combination with the Registrant’s Website, might create in the minds of consumers” (establishing bad faith under paragraph 3.5(d) of the Policy).

Complainant requests that the Disputed Domain Name be transferred from the Registrant to the Complainant.

The Respondent did not file a Response.

7. Discussion and Findings

To obtain a transfer of the Disputed Domain Name, Complainant must, as set forth in paragraph 4.1 of the Policy, 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.

Confusingly Similar

With respect to paragraph 3.1(a) of the Policy, regarding confusing similarity, the Panel finds that, based upon Complainant’s representations, including a copy of the trade-mark registration certificate (showing a registration date of December 17, 2003) that it provided as an exhibit, Complainant has rights in the ENMOTION Trade-mark, which was first registered in Canada on November 12, 2004, and that these rights pre-date creation of the Disputed Domain Name, which occurred on October 29, 2010.

As to whether the Disputed Domain Name is confusingly similar to the ENMOTION Trade-mark, paragraph 3.3 of the Policy states: “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.” Here, given that the relevant portion of the Disputed Domain Name, “enmotion”, is identical to the ENMOTION Trade-mark, it is obvious without the need for elaboration or citation that the Disputed Domain Name is “Confusingly Similar” to the ENMOTION Trade-mark for purposes of the Policy. Further, given the trade-mark registrations cited by Complainant, each of which pre-dates creation of the Disputed Domain Name, it is also apparent without the need for elaboration or citation that Complainant had

“rights” in the ENMOTION Trade-mark prior to the date of registration of the Disputed Domain Name and there is no reason to question whether Complainant continues to have such rights.

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(a) of the Policy.

No Legitimate Interest

With respect to paragraph 3.1(b) of the Policy, regarding a lack of legitimate interests, the Panel is satisfied that the Complainant has established, on a balance of probabilities, that the Registrant does not have a legitimate interest in the Disputed Domain Name. The Registrant, by failing to submit a Response, has not made any attempt to rebut Complainant’s allegations or argue that it has a legitimate interest in the Disputed Domain Name under any of the six elements described in paragraph 3.4 of the Policy. Under these circumstances, the lack of a response is fatal to the Registrant. See, e.g., *Cointreau v. Netnic Corporation*, CIRA Case No. 00180 (“[t]here is no evidence from the ‘customer’ about its ‘interest’ in the Domain Name”); and *General Motors LLC v. Tony Wilson*, CIRA Case No. 00182 (“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”).

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(b) of the Policy.

Bad Faith

With respect to paragraph 3.1(c) of the Policy, regarding bad faith, the Panel notes that a Registrant will be considered to have registered a domain name in bad faith if, *inter alia*:

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.

Policy, paragraph 3.5(c); or

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.

Policy, paragraph 3.5(d).

Here, Complainant alleges that bad faith exists pursuant to both of these paragraphs. In connection therewith, the Panel agrees with the decisions cited by Complainant, including *LEGO Juris A/S v. James Carswell*, CIRA Case No. 00150 (“[t]he diversion of web traffic from the legitimate [trade-mark] sites to its own site creates revenue for the Registrant through the

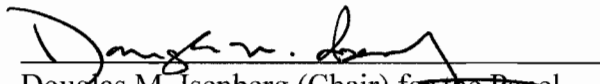
sponsored links, at the expense of the Complainant”); and *Mr. Appliance Corp v. Computerfest*, CIRA Case No. 1322 (“[t]he Panel agrees with the Complainant that its business is disrupted or potentially disrupted as the registration of the Domain Name will attract users to the Registrant’s website through consumer confusion with the Complainant’s [trade-mark] and website, thereby creating traffic to the Registrant’s website from which the Registrant will obtain advertising revenue from third parties, some of whom are competitors of the Complainant”).

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 3.1(c) of the Policy.

8. Decision

For all the foregoing reasons, in accordance with paragraph 4.3 of the Policy, the Panel orders that the Disputed Domain Name <enmotion.ca> be transferred to Complainant.

Douglas M. Isenberg (Chair), David Wotherspoon (Co-Panelist) and
Anton M.S. Melnyk (Co-Panelist)



Douglas M. Isenberg (Chair) for the Panel
Dated: April 25, 2012