

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

CASE NO.: DCA-1360-CIRA
DISPUTED DOMAIN NAME: www.googleqc.ca
COMPLAINANT: Google Inc.
REGISTRANT: David Perron
SERVICE PROVIDER: British Columbia International Commercial Arbitration Centre
PANEL: James E. Redmond

DECISION

The Parties

1. The Complainant is Google Inc., represented in this proceeding by Clark Wilson LLP of Vancouver, British Columbia. The Registrant is David Perron.

Procedural History

2. This is an administrative proceeding pursuant to the CIRA Domain Name Dispute Resolution Policy (the "Policy") and the CIRA Domain Name Dispute Resolution Rules (the "Rules"). By registration of the domain name with the Registrar, the Registrant agreed to the resolution of certain disputes pursuant to the Policy and Rules.
3. The Complaint was filed on December 7, 2011. The Policy and the Rules were revised effective August 22, 2011, so that the revised Policy (Version 1.3) and the Rules (Version 1.4) apply to this proceeding.
4. The Service Provider advises as follows:

- (a) The Service Provider confirmed on December 8, 2011, compliance of the Complaint and commencement of the dispute resolution process, and forwarded the Complaint to the Registrant'
 - (b) No Response has been received from the Registrant;
 - (c) In the absence of a Response, the Claimant has elected to convert from a Panel of three to a single arbitrator;
 - (d) On January 10, 2012, the Service Provider appointed James E. Redmond as sole arbitrator;
 - (e) The arbitrator delivered to the Service Provider the required Statement of Impartiality and Independence pursuant to the Rules.
5. Based upon the information provided by the Service Provider, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding were met. The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Rules.
6. Absent exceptional circumstances, the Panel was required to deliver its decision no later than January 31, 2012.

Factual Background

7. Since 1997, the Complainant ("Google") has provided Internet search services, search engine technology, and associated products and services. Google has registered in the Canadian Intellectual Property Office ("CIPO") the following trademarks: GOOGLE (Registration No. TMA539,576, January 21, 2001; the Google stylized mark Go gle (Registration Nos. TMA777,096 and TMA748,766), September 28, 2009.
8. The website www.google.com, owned by Google, has been operated by Google since 1998 and the trade name and trade-mark GOOGLE has been used in association with these services. In addition to its primary website, www.google.com, Google owns/operates hundreds of additional GOOGLE-formative domain names, including

www.google.ca. Google registered the domain name www.google.ca on October 3, 2000, and the Google.ca website has operated since May 21, 2001.

9. The evidence provided by the Complainant shows that the Google Mark ranks as one of the most valuable brands and that Google's website has been one of the most-visited websites since as early as 2004. The Google search-engine maintains one of the largest collections of searchable documents and provides a user-friendly interface, advanced search technology and a comprehensive array of search tools. Google has expended significant resources developing, marketing and promoting its products and services in association with the Google Mark and GOOGLE is one of the most recognized and valuable trade-marks in the world.
10. The Disputed Domain Name, www.googleqc.ca, was registered by the Registrant on April 14, 2010.
11. On or about December 1, 2010, the Registrant entered into a Terms of Service Agreement (the "Agreement") with Google for the use of Google's "Custom Search Engine" ("CSE"). The CSE tool provides assistance to a Google client in providing customized web search services by utilizing the Google search engine, customizing the appearance of search results, and tuning search results and advertisements to the client's website and audience. Under the Agreement, and the "Guidelines for Implementing Google Custom Search" (the "Guidelines") the client is permitted certain limited use of the Google name and certain Google logos.

The Complaint

12. In its Complaint the Complainant contends that:
 - (a) The Disputed Domain Name is Confusingly Similar to the Complainant's trademarks, in which the Complainant had Rights prior to the registration of the Disputed Domain Name and in which the Complainant continues to have such Rights;
 - (b) That the Registrant registered the Disputed Domain Name in bad faith;

(c) That the Registrant has no legitimate interest in the Disputed Domain Name.

13. The Registrant has not provided a Response to the Complaint.

Discussion and Findings

(a) Jurisdiction

14. The Complainant, Google Inc. is the owner in Canada of the trademarks identified in paragraph 7 above and is therefore an eligible Complainant under paragraph 1.4 of the Policy.

(b) Applicable Law

15. Paragraph 12.1 of the Rules requires the Panel to render its decision on the basis of the evidence and arguments submitted and in accordance with the Policy, the Rules, and “any rules and principles of the laws of Ontario, or, if the Registrant is domiciled in Quebec, the laws of Quebec, or, if a preference for the laws of another province or territory has been indicated by both parties, the laws of the other province or territory and, in any event the laws of Canada applicable therein.” In this case, the Complainant has requested that the laws of British Columbia, except its conflict of laws rules, be applied, but the Registrant has not responded to this request. In the result, since the information provided appears to indicate that the Registrant is domiciled in Quebec, the laws of Quebec and the laws of Canada applicable therein will be applicable in this case.

(c) Confusing Similarity between the Disputed Domain Name and the Complainant’s Marks

16. Paragraph 3.3 of the Policy provides as follows:

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.

17. The Google trademarks registered in the CIPO as set out above constitute Marks as defined in paragraph 3.2 of the Policy. The Disputed Domain Name includes in its

entirety the Complainant's Mark "GOOGLE" but adds the letters "qc" and ".ca". Under paragraph 1.2 of the Policy, "Domain Name" means the domain excluding the ".CA" suffix. A number of CIRA and WIPO cases establish that the addition of further words or letters along with the word or words constituting the trademark will not prevent the Disputed Domain Name from being found to be confusingly similar. (For example, see *LEGO Juris A/S v. James Carswell*, CIRA Dispute No. 00150, May 7, 2010, at para 20, domain name *Legomaniac.ca*; *Enterprise-Rent-A-Car Company v. David Bedford*, CIRA Decision No. 00097, March 27, 2008, para. 46, domain names "*enterpriseautorental.ca*" and "*enterprisetoronto.ca*"; *Google Inc. v. 4 Fenix Group, Ltd*, WIPO Case No. D2011-0790, June 23, 2011). In the *Fenix* case where the disputed domain names included, among others, "*googlemontenegro.com*", and "*google-montenegro.com*", the Panel said "... the addition of geographical terms ... fails to distinguish domain names from established trademarks or service marks when those marks are wholly contained in such names". See also: *Seiko Epson Corporation v. Zokool Technologies, Inc.*, CIRA Case No. 1137 (*epsonink.ca*; *epsoncartridge.ca*; *epsoninkjet.ca*); *Honda Motor Company Limited v. LOKITA Enterprises*, WIPO Case No. D2003-0507 (*Hondaindia.com*), where the Panel noted that "complainant's trade name is famous around the globe." The same can clearly be said about the Complainant's trademark in this case.

18. Here, the Disputed Domain Name includes the Complainant's trademark GOOGLE, adding "qc.ca". The letters "qc" appear to be a geographical reference to Quebec, an inference that is supported by the appearance in the webpage to which the Disputed Domain Name resolves of the Complainant's stylized Mark "Google", the word "Quebec" and a *fleur de lys* beneath the stylized Mark "Google", and several lines of text in French.
19. I find that the Disputed Domain Name is Confusingly Similar with the Google Marks, within the words of paragraph 3.3 of the Policy. The Disputed Domain Name so nearly resembles the Marks in appearance, sound or the ideas suggested by the Marks, as to be likely to be mistaken for the Mark. As required by paragraph 3.1 of the Policy, the Complainant had Rights to its Marks prior to the registration of the Disputed Domain Name and continues to have such Rights.

(d) **Legitimate Interests**

20. In accordance with the requirements of paragraph 3.1(b) of the Policy, the Complainant has alleged that the Registrant has no legitimate interest in the Disputed Domain Name. Paragraph 3.4 of the Policy contains a list of six sets of circumstances which, 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 the domain name. Paragraph 4.1 of the Policy, which sets out the onus of proof upon the Complainant, provides that the Complainant must provide some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.4. Accordingly, it is necessary for the Panel to review the evidence put forward by the Complainant, the Registrant having failed to file any Response, to determine whether the Complainant has provided some evidence that the Registrant has no legitimate interest in the Disputed Domain Name.
21. The Complainant submits that both the Disputed Domain Name and the contents of the webpage to which the Disputed Domain Name resolves, target internet users seeking Google's website www.google.ca and that by using the Disputed Domain Name in this manner, the Registrant intends to confuse and mislead internet users viewing the Registrant's website. This confusion, the Complainant submits, works to the benefit of the Registrant and disrupts the business of Google. The Complainant refers to the decision in *Sittercity Incorporated v. Mile Mocilac*, CIRA Decision No. DCA 00169 (September 20, 2011), where the Panel said p. 8:
- Furthermore, "disruption" for the purpose of Policy sub-paragraph 3.7(c) occurs when internet users encountering a domain name are misled into believing that a registrant's business associated with the domain name is a business of the complainant, or at least endorsed, sponsored or approved by the complainant.
22. The Complainant further points to the use of the letters "qc" in the Disputed Domain Name, an apparent abbreviation for "Quebec" as further evidence of the Registrant's intention to disrupt Google's business by misleading internet users into believing that the Registrant's website was created by Google for internet users in Quebec. The Panel agrees that the fact that a Disputed Domain Name resolves to a website prominently

displaying Google's stylized Mark, followed by the word "Quebec", a *fleur de lys* and some text in French, supports an inference that the use of the Disputed Domain Name was intended to mislead internet users encountering it as the Complainant submits.

23. The question whether the Registrant has a legitimate interest in the Disputed Domain Name, on the basis that the Registrant registered the domain name in good faith within any of the subparagraphs of paragraph 3.4 of the Policy, and whether he acted in bad faith in registering the domain name under any of the subparagraphs of paragraph 3.5 of the Policy, is complicated by the fact that the Registrant was granted certain limited rights to use Google's trademarks under the Terms of Service Agreement, entered into on December 1, 2010 between Google and the Registrant. Under the Agreement, the Registrant was granted the right to use Google's "Custom Search Engine" ("CSE") tool on his website. The CSE tool, as described by the Complainant, "allows Google's clients to create search engines for use by visitors to their websites; customize the appearance of search results and advertisements displayed; and tune search results and advertisements to the client's website and audience." However, the Agreement requires CSE clients to comply with "Guidelines for Implementing Google Custom Search" which include principles governing the use of the Google name in conjunction with CSE results. These principles include:
- CSE clients are not permitted to display Google's trade-marks, trade names, service marks, logos, domain names, web pages, screen shots or other distinctive features ("Google Brand Features") in a manner that implies sponsorship or endorsement by Google;
 - CSE clients cannot use the Google name, except in association with the CSE results and only if Google is the exclusive provider of the search results;
 - CSE clients are not permitted to use Google logos in conjunction with the Google CSE results other than as authorized in the guidelines.
24. Under the Terms of Service for the Custom Search Engine, the Registrant is authorized to provide customized web search services on a website or sites established by the Registrant. Users of that Site can enter search queries which are sent from the Site to Google and if they are in compliance with Google's technical specifications, search results will be displayed on a Results Page. Paragraph 2.2 of the Terms of Service

Agreement is headed “Brand Feature License”. In paragraph 2.2, “Brand Features” is defined as “the trade names, trademarks, service marks, logos, domain names, and other distinctive brand features of each party, respectively, as secured by such party from time to time.” It continues:

Google hereby grants to You a non-transferable, non-sublicensable, non-exclusive license during the Term to display Google’s Brand Features for the purpose of promoting or advertising that You use the Service and for the purpose of fulfilling Your obligations under section 2.3 below.

The last sentence of paragraph 2.2 of the Brand Feature License includes the following:

At no time during or after the Term ... shall You attempt to register any Brand Features (including domain names) that are confusingly similar in any way (including but not limited to, sound, appearance and spelling) to those of Google.

This provision has the result that in entering into the CES Agreement, the Registrant has agreed that he will not attempt to register a domain name that is confusingly similar to Google’s trademarks. The Panel therefore concludes that, although the Registrant was given a limited to right to use the Complainant’s Marks, the use of the Marks in the Disputed Domain Name and the Registrant’s website to which it resolves was not a use “in good faith”, and the Registrant did not have the right to use the Marks as he did. Therefore, paragraph 3.4(a) of the Policy does not apply so as to give the Registrant a legitimate interest in the Disputed Domain Name.

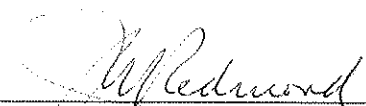
25. None of the other provisions in paragraph 3.4 of the Policy apply to the facts of this case. The Panel concludes that it is entitled to infer from the evidence submitted by the Complainant (the Respondent having submitted no Response) that there is “some evidence” sufficient to enable the Panel to conclude that the Registrant had no legitimate interest in registering the disputed domain name.

(e) Registration in Bad Faith

26. Paragraph 3.5 of the Policy lists circumstances which constitute 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 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.
27. With regard to subparagraph 3.5(c), it is clear from the evidence that the Registrant was aware of Google's trademarks prior to registering the Disputed Domain Name and entering into the Agreement for use of Google's CSE tool under which he was granted a limited license for use of the Google Marks. The license allowed the Registrant to use the trademarks in a limited manner in connection with use of the CSE tool, but did not contemplate that the Registrant would register a domain name and create a website using Google's Marks; in fact it specifically provided that he would not do so. As held in the section of this decision dealing with legitimate interest, the primary purpose of the Registrant for registering the Disputed Domain Name can reasonably be inferred to have been to disrupt the business of the Complainant.

Decision and Order

33. For the reasons given above, the Complaint regarding the Disputed Domain Name is successful, and it is ordered and directed that the registration of the Disputed Domain Name be transferred to the Complainant.



James E. Redmond, Sole Panelist

DATED January 24, 2012