

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

CASE NO.: DCA-1687-CIRA
DISPUTED DOMAIN NAME: *www.nationalcarhire.ca*
COMPLAINANT: Vanguard Trademark Holdings USA, LLC
REGISTRANT: Essi Nikulainen
SERVICE PROVIDER: British Columbia International Commercial Arbitration
Centre (BCICAC)
PANEL: James E. Redmond

DECISION

The Parties

1. The Complainant is Vanguard Trademark Holdings USA, LLC, of 600 Corporate Park Drive, St. Louis, Missouri 63105 USA. The Registrant is Essi Nikulainen, of 99 University Avenue, Kingston, Ontario K7L 3N6.

Procedural History

2. The Disputed Domain Name, *nationalcarhire.ca*, was registered on May 8, 2014.
3. On June 12, 2015, the Complainant filed the Complaint pursuant to the CDRP and the Rules.
4. By letter to the Complainant and the Registrant, dated June 17, 2015, the Service Provider advised that the Complaint had been received and was in administrative compliance under Rule 4.2.
5. The Registrant has not provided a Response. The Complainant has therefore elected under Rule 6.5 to convert from a panel of three to a single arbitrator. On July 10, 2015,

James E. Redmond was appointed as the Arbitrator, and has filed the required Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality in relation to this dispute.

Factual Background

6. The evidence before the Panel shows that the Complainant is the owner of Canadian Trademark Registration No. TMA534880 “**NATIONAL**”, and Canadian Trademark Registration No. TMA343651 “**NATIONAL CAR RENTAL**”, each covering automobile and truck rental and leasing services. The Complainant licenses these trademarks to National Car Rental operating entities, which provide rental and leasing services throughout the United States, Canada, Mexico, the Caribbean, Latin America, Asia and the Pacific Rim. The **NATIONAL** and **NATIONAL CAR RENTAL** Marks have been used in Canada in connection with car rental and leasing services since at least as early as 1950 and July 1971, respectively. The Complainant’s licensee operates car rental sites at *nationalcar.ca* (to which *nationalcarrental.ca* also resolves) and *nationalcar.com*.
7. The evidence further shows that the Disputed Domain Name resolves to a website with the domain name as the heading and following that heading are “Sponsored Listings” on the right and “Related Links” on the left. These lists of “Sponsored Listings” and “Related Links” provide Registrant with “click-through” fees when someone “clicks” on one of those links. The “Sponsored Listings” and “Related Links” on the *nationalcarhire.ca* website are links to the National Car Rental website and the websites of Complainant’s licensees’ competitors.
8. It is further asserted by the Complainant that the Registrant’s *nationalcarhire.ca* web page also contains the words “BUY THIS DOMAIN The domain *nationalcarhire.ca* may be for sale by its owner!”. The statement is accompanied by a link to a webpage indicating that the Disputed Domain Name is for sale and allowing a user to enter a bid to purchase the domain name.
9. The Complainant’s evidence further is that before it requested disclosure of Registrant’s contact information from CIRA, Complainant’s representative notified the Registrant by

email that his use of the Disputed Domain Name constituted an infringement of Complainant's rights in its **NATIONAL CAR RENTAL** mark, and that the Registrant responded: "the price is 5,000 us \$, thanks!"

The Complaint

10. In its Complaint the Complainant contends that:
- (a) The Disputed Domain Name is Confusingly Similar to Marks in which Complainant had Rights prior to registration of the Disputed Domain Name and continues to have such Rights;
 - (b) The Registrant registered the Disputed Domain Name in bad faith;
 - (c) The Registrant has no legitimate interest in the Disputed Domain Name.

Discussion and Findings

(i) Jurisdiction

11. The Complainant is the owner of the Canadian trade-marks identified above and is therefore an eligible Complainant under paragraph 1.4 of the Policy.

(ii) Onus of Proof

12. Under paragraph 4.1 of the Policy, the Complainant must prove on a balance of probabilities that:
- (a) The Registrant's dot-ca Domain is confusingly similar to a Mark in which the Complainant had Rights prior to the date of the registration of the Domain Name, and continues to have such Rights;
 - (b) The Registrant has registered the Domain Name in bad faith, as described in paragraph 3.5 of the Policy;

And the Complainant must provide some evidence that:

- (c) The Registrant has no legitimate interest in the Domain as described in paragraph 3.4 of the Policy.

Even if the Complainant proves: (a) and (b) and provides some evidence of (c) the Registrant will succeed if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the Domain Name as described in paragraph 3.4.

(iii) Confusingly Similar

13. 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.

14. Since the Complainant’s trade-marks **NATIONAL** and **NATIONAL CAR RENTAL** are registered at the CIPO, they constitute Marks as defined in paragraph 3.2 of the Policy.
15. Paragraph 1.2 of the Policy provides that for the purposes of the Policy, “**domain name**” means the domain name excluding the “dot-ca” suffix. Therefore, for the purposes of determining whether the Disputed Domain Name is Confusingly Similar to the Complainant’s above-described trade-marks, the dot-ca suffix is to be excluded from consideration. Numerous CIRA and WIPO cases have held that the inclusion of additional words or letters will not prevent the Disputed Domain Name from being found to be confusingly similar (For example, see *Enterprise-Rent-A-Car Company v. David Bedford*, CIRA Decision No. 00097, domain names “*enterpriseautorental.ca*” and “*enterprisetoronto.ca*”; *Google Inc. v. 4 Fenix Group, Ltd.*, WIPO Case No. D2011-0790, disputed domain names included “*googlemontenegro.com*”. Here, the Disputed Domain Name includes in its entirety the Complainant’s trade-mark “**NATIONAL**”. The fact that it includes some additional words does not prevent it from being held to be confusingly similar to the Complainant’s Mark, given particularly that the words “car hire” merely constitute a description of the Complainant’s business. The Disputed Domain Name also includes a significant portion of the Complainant’s trade-mark

“NATIONAL CAR RENTAL” (ie. “National”) along with the words “car hire”, which are merely descriptive and are virtually synonymous with the words “car rental”.

16. The Panel finds that the Disputed Domain Name so nearly resembles the Complainant’s Marks in appearance, sound or the ideas suggested by the Mark as to be likely to be mistaken for the Mark, and is confusingly similar to the Complainant’s Marks.

(iv) Registration in Bad Faith

17. The Complainant submits that the Registrant registered the Disputed Domain Name in bad faith under paragraph 3.5(d) of the Policy, which provides that it is evidence of bad faith if:

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.

18. The Complainant’s evidence, as set out above, shows that the Disputed Domain Name resolves to a website containing a number of links which, when someone “clicks” on them, will take that person to the National Car Rental website and the websites of competitors to the Complainant’s licensees. The web page for *nationalcarhire.ca* includes a link to National Car Rental. The evidence is that the Registrant earns “click-through” fees when someone clicks on any of the links, including National Car Rental’s own website.
19. The Complainant cites *Empire Theatres Limited v. Michael Morgan*, CIRA Dispute No. 00236 (BCICAC Aug. 9, 2013):

It is widely held that directing internet users to websites featuring revenue generating advertisements or links does not constitute bona fides offering of goods or services and is not a legitimate or non-commercial fair use. Moreover, it is not a legitimate use of the Mark to use it on a domain name to attract customers and re-direct them to competing products. On the evidence, the Panel accepts that submission and so finds.

20. The Complainant also points to the offer contained on the domain *nationalcarhire.cca* to accept bids to buy the domain, and to Registrant's response to Complainant's email advising that use of the Disputed Domain Name constituted an infringement of Complainant's rights in its Mark, in which Registrant quoted a price for purchase of the Disputed Domain Name of \$5,000. The Complainant asserts that this amount is far in excess Registrant's out-of-pocket costs.
21. It is a reasonable inference from this evidence that by registering the Disputed Domain Name, the Registrant attempted to attract internet users to his website 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 of a product or service on the Registrant's website.
22. The Panel finds that the Registrant registered the Disputed Domain Name in bad faith.

(v) Legitimate Interest

23. The Policy lists, in paragraph 3.4, six circumstances which, in particular but without limitation, shall demonstrate that the Registrant has a legitimate interest in a domain name. The Complainant submits that none of these circumstances exist in this case, for the following reasons:
 - (a) nothing in the evidence indicates that the Domain Name was a Mark, that the Registrant used the Mark in good faith or that the Registrant had rights in the Mark;
 - (b) the Domain Name was not registered in good faith in association with any wares, services or business and was not clearly descriptive in Canada of the character or quality of the wares, services or business, the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business, or the place of origin of the wares, services or business;
 - (c) there is nothing in the evidence to show that 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 a generic name thereof in any language;

- (d) there is no evidence to show that 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 evidence does not show that 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;
- (f) the evidence does not show that the Domain Name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

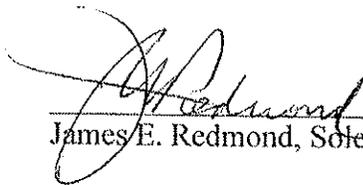
24. The Complainant, in order to meet the onus of providing "some evidence" to support its submissions of a lack of legitimate interest of the Registrant in the Disputed Domain Name, asserts that it has not licensed or authorized Essi Nikulainen to use "nationalcarhire" or "National Car Hire", and that Complainant has no relationship whatsoever with Essi Nikulainen. Complainant cites *General Motors LLC v. DSI Design*, CIRA Dispute No. 00231 (Resolution Canada, May 29, 2013) (at paras 39-40), where the Panel held that the fact that the Registrant had not received any licence or consent to use the Complainant's Marks, that the Complainant had not acquiesced in any way to the use of its trade-marks, and had no authorization from the Complainant to register the disputed domain names, was sufficient to constitute "some evidence" of Registrant's lack of a legitimate interest in the domain name.

25. The Complainant also produced as evidence printouts from the Canadian Intellectual Property Office trade-marks database showing that neither the Registrant nor anyone else has a trade-mark registration or pending application for "nationalcarhire" or "National Car Hire" in Canada. The evidence also includes a printout from the trade-marks database which shows that there are no trade-mark registrations or pending applications in Canada owned by anyone with the surname "Nikulainen".

26. The Panel concludes that the absence of any evidence of the existence of any of the criteria for legitimate interest listed in paragraph 3.4 of the Policy, together with the additional evidence submitted by the Complainant is sufficient to meet the onus on the Complainant to provide "some evidence" that the Registrant lacks any legitimate interest in the Disputed Domain Name. Further, the Panel's finding that the Registrant registered the Disputed Domain Name in bad faith supports a finding that the requirement of "good faith" in the registration or use of the Disputed Domain Name has not been met.
27. The Panel finds that the Registrant has no legitimate interest in the Disputed Domain Name.

Decision and Order

28. The Panel finds, for the reasons given above, that the Complaint 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 July 27, 2015