

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

Domain Name: montrealcareylimo.ca
Complainant: Carey International, Inc.
Registrant: Haroun Saleh
Registrar: Namespro Solutions Inc.
Panel: Bradley J. Freedman
Provider: The British Columbia International Commercial Arbitration Centre
BCICAC File No.: DCA-1735-CIRA

DECISION

A. The Parties

1. The Complainant is Carey International, Inc., a company with an office in Washington, District of Columbia, United States of America.
2. The Registrant is Haroun Saleh, an individual with a mailing address in Ottawa, Ontario, Canada.

B. The Domain Name and Registrar

3. The disputed domain name is montrealcareylimo.ca (the “**Domain Name**”).
4. The Domain Name was registered on May 7, 2015.
5. The registrar of the Domain Name is Namespro Solutions Inc.

C. Procedural History

6. This is an administrative dispute resolution proceeding pursuant to the *CIRA Domain Name Dispute Resolution Policy* version 1.3 (August 22, 2011) (the “**Policy**”) and the *CIRA Domain Name Dispute Resolution Rules* version 1.5 (July 28, 2014) (the “**Rules**”), both issued by the Canadian Internet Registration Authority (“**CIRA**”).
7. This proceeding is administered by British Columbia International Commercial Arbitration Centre (the “**Provider**”), which is a recognized service provider pursuant to Policy paragraph 1.5.
8. According to the information provided by the Provider, the procedural history of this proceeding is as follows:
 - On December 11, 2015, the Complainant filed a complaint in relation to the Domain Name pursuant to the Policy (the “**Complaint**”).

- By letter dated December 14, 2015, delivered by email to the Complainant and the Registrant, the Provider delivered a copy of the Complaint to the Registrant and advised both the Complainant and the Registrant that: (a) the Complaint had been received by the Provider and was in administrative compliance with the Policy and the Rules; (b) the date of commencement of this proceeding was December 15, 2015; and (c) the Registrant was required to deliver a response by January 4, 2016.
- The Registrant failed to file a response to the Complaint by the applicable due date (January 4, 2016).
- By letter dated January 5, 2016, delivered by email to the Complainant and the Registrant, the Provider gave notice that the Registrant had failed to file a response to the Complaint by the applicable due date.
- The Complainant elected to have this proceeding determined by a single member panel, in accordance with Rules paragraph 6.5.
- On January 8, 2016, the Provider appointed Bradley J. Freedman as the sole member of the Panel.
- As required by Rules paragraph 7.2, Bradley J. Freedman submitted a declaration of impartiality and independence to the Provider.

9. After the Panel was appointed, the Panel determined that the Provider did not send a copy of the Complaint to the Registrant by email to all of the email addresses required by the Rules. Accordingly, on January 11, 2016 the Panel issued a Direction that: (a) the Provider promptly resend the Complaint and related documents to the Registrant by email to all of the email addresses required by the Rules; (b) the Registrant have a further twenty (20) days to file a response; and (c) the due date for the Panel's decision be extended.

10. By letter dated February 2, 2016, delivered by email to the Complainant and the Registrant, the Provider gave notice that the Registrant had failed to file a response to the Complaint by the extended due date.

11. The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Rules.

12. Based on the information provided by the Provider and the events described above, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding have been met.

13. The Panel is not aware of any other legal proceeding or other arbitration in relation to the Domain Name that would give rise to a need to alter the progress of this proceeding pursuant to Rules paragraph 13.2.

D. Eligibility of Complainant

14. The Complainant is an eligible complainant under Policy paragraph 1.4, because the Complaint relates to a trademark (CAREY) registered in the Canadian Intellectual Property Office ("CIPO") and owned by the Complainant.

E. Relief Requested

15. The Complainant requests that the Domain Name registration be transferred from the Registrant to the Complainant.

F. Applicable Law

16. In accordance with Rules paragraph 12.1, the Panel will render its decision based on the rules and principles of the laws of Ontario and the laws of Canada applicable in Ontario.

G. Facts

17. The undisputed facts relevant to the Panel's decision are set out in the Complaint (including its exhibits), and are as follows:

- The Complainant operates an international chauffeured limousine service business in association with the CAREY trademark. The Complainant has operated its chauffeured limousine service business in association with the CAREY trademark in Canada since 1982.
- The Complainant offers its chauffeured limousine service in Montreal, Québec.
- The total value of the Complainant's services in Canada was in excess of \$1.75 million per year since 2006.
- Since 2004, the Complainant has operated a global website using the carey.com domain name. The Complainant's website offers information about the Complainant's limousine and ground transportation services and allows customers to make reservations. The website is important to the Complainant's business.
- The Complainant is the registered owner of the carey.com domain name, which was registered in 1994.
- The Complainant is the owner of a Canadian trademark registration for the trademark CAREY, registered on February 25, 1994 for use in association with transportation services, namely transporting passengers in chauffeur driven automobiles (Reg. No. TMA423,694).
- By virtue of the extensive and continuous use of the CAREY trademark in Canada and elsewhere around the world by the Complainant and its predecessors-in-title, the CAREY trademark has become well known and has attracted considerable reputation and goodwill.
- The Complainant is also the owner of a Canadian copyright registration, issued on October 30, 2015, for the Complainant's website (2004 Edition) as it was first published on October 1, 2004 (Copyright Reg. No. 1066920).
- Without the Complainant's permission, the Registrant registered the Domain Name on May 7, 2015.
- The Domain Name was registered using the privacy protection offered by CIRA in accordance with the CIRA Privacy Policy. CIRA disclosed the Registrant's name and contact details to the Complainant in response to the Complainant's Request for Disclosure of Registrant Information.

- The Domain Name resolves to a website that appears to be an official website for the Complainant’s business worldwide. The website: (a) purports to advertise the Complainant’s limousine and ground transportation services worldwide; (b) extensively copies images and text from a 2009 version of the Complainant’s website; (c) uses repeatedly the CAREY trademark and other derivations of that mark (e.g. CAREY WORLD WIDE LIMO); and (d) provides the Registrant’s contact information (including a toll-free number) to be used to purchase services.
- The Complainant’s legal counsel issued a cease and desist demand letter dated October 13, 2015 to the Registrant. The Complainant did not receive a response to that letter.
- There is not, and has never been, any relationship between the Complainant and the Registrant. The Registrant has never been licensed or otherwise authorized to register or use the CAREY trademark in any manner whatsoever, including as part of a domain name.

H. Parties’ Contentions

The Complainant contends as follows:

- The Complainant is the owner of the CAREY trademark, which was registered before the registration of the Domain Name, and the Domain Name is confusingly similar to the CAREY trademark.
- The Registrant registered the Domain Name in bad faith because: (1) the Registrant registered the Domain Name primarily for the purpose of disrupting the business of the Complainant, who is a competitor of the Registrant; and (2) the Registrant registered the Domain Name primarily for the purpose of intentionally attempting to attract, for commercial gain, Internet users to the Registrant’s website by creating a likelihood of confusion with the CAREY trademark.
- The Registrant has no legitimate interest in the Domain Name.

The Registrant did not file a response to the Complaint or dispute the Complainant’s contentions in any other way.

I. Discussion and Findings

Policy paragraph 3.1 provides that the Policy applies where a complainant asserts the following:

- (a) the registrant’s dot-ca domain name is “Confusingly Similar” (as defined in Policy paragraph 3.3) to a “Mark” (as defined in Policy paragraph 3.2) in which the complainant had rights before the date of registration of the domain name and continues to have those rights;
- (b) the registrant has no “legitimate interest” in the domain name, as described in Policy paragraph 3.4; and
- (c) the registrant has registered the domain name in “bad faith”, as described in Policy paragraph 3.5.

If a dispute does not fall within that narrow framework, then the dispute is beyond the scope of the Policy.

Policy paragraph 4.1 sets out the onus on the Complainant, and reads as follows:

“4.1 **Onus.** To succeed in the Proceeding, 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;

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.

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding 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.”

18. The Registrant’s failure to respond to the Complaint does not automatically result in a decision in favour of the Complainant. There is no concept of a default award under the Policy. Rules paragraph 5.8 provides that if a registrant does not submit a response within the applicable period, then the panel will decide the Proceeding on the basis of the Complaint. While a panel may draw appropriate inferences from a registrant’s failure to respond to a complaint, the complainant must still satisfy the requirements of the Policy. Accordingly, it is incumbent on the Panel to assess the Complaint and determine whether the Complainant has satisfied the requirements of the Policy.

(a) The Complainant’s Marks

The Complainant must prove, on a balance of probabilities, that the Domain Name is “Confusingly Similar” to a “Mark” in which the Complainant had rights before the date of registration of the Domain Name and continues to have those rights.

Policy paragraph 3.1 provides that the date of registration of a domain name is “the date on which the domain name was registered in the Registry or the predecessor registry operated by the University of British Columbia by the Registrant or a predecessor in title of the Registrant”. Based on the evidence provided by the Complainant, the Panel finds that the Domain Name was registered by the Registrant on May 7, 2015. Accordingly, May 7, 2015 is the date for determining whether the Complainant had rights in a “Mark”.

Policy paragraph 3.2(c) defines the term “Mark” as including “a trade-mark, including the word elements of a design mark, that is registered in CIPO”. The Complainant’s CAREY trademark was registered in CIPO on February 25, 1994, and therefore is a “Mark” within the meaning of the Policy.

The Complainant is the current registered owner of the CAREY trademark.

Policy paragraph 3.3 specifies that the test for determining whether a disputed domain name and a mark are “Confusingly Similar” is a resemblance test rather than the confusion test that is usually applied in trademark disputes. Policy paragraph 3.3 reads 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.”

The resemblance test is based on first impression and imperfect recollection. The underlying rationale for the test is discussed in *Canadian Thermos Products Inc. v. Michael Fagundes*, CIRA Dispute 00049.

Accordingly, the Complainant must prove on a balance of probabilities that a person, having an imperfect recollection of the CAREY trademark, would on a first impression of the Domain Name (without the dot-ca suffix) likely mistake the Domain Name (without the dot-ca suffix) for the CAREY trademark based on the appearance, sound or the ideas suggested by the CAREY trademark.

The Domain Name combines the Complainant’s entire CAREY trademark with a geographic location name (Montreal) and a descriptive term (limo). The “dot-ca” suffix is not considered when assessing confusing similarity (see Policy paragraph 1.2).

The addition of the geographic location name “Montreal” does not distinguish the Domain Name from the Complainant’s trademark. To the contrary, the geographic location name enhances the confusing similarity because it suggests that the domain name relates to a website operated by, or associated with, the Complainant that relates to the Complainant’s limousine services in Montreal.

The addition of the descriptive term “limo” does not distinguish the Domain Name from the Complainant’s trademark. To the contrary, the descriptive term enhances the confusing similarity because the descriptive term relates to the services with which the Complainant uses the Complainant’s trademark and it suggests that the domain name relates to a website operated by, or associated with, the Complainant that relates to the Complainant’s limousine services in Montreal.

The Panel finds that a person familiar with the Complainant’s CAREY trademark would likely believe that the Domain Name relates to a website for the Complainant’s limousine services offered in the Montreal area.

For those reasons, applying the test of resemblance based on first impression and imperfect recollection, the Panel finds that the Domain Name is “Confusingly Similar” to the Complainant’s CAREY trademark within the meaning of Policy paragraph 3.3.

(b) Bad Faith

Policy paragraph 4.1 requires the Complainant to prove, on a balance of probabilities, that the Registrant registered the Domain Name in “bad faith” as described in Policy paragraph 3.5.

Policy paragraph 3.5 sets out a non-exhaustive list of circumstances that are evidence that a registrant has registered a domain name in “bad faith”, including the following:

“(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.

(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.”

Only in rare cases will there be direct evidence of a registrant's bad faith. In most cases, a panel's findings regarding a registrant's purposes in registering a domain name will be based on common sense inferences from the registrant's conduct and other surrounding circumstances.

The Complainant relies on two circumstances – disrupting the Complainant's competing business and intentional confusion of Internet users – as evidence of the Registrant's bad faith registration and use of the Domain Name. The Panel will consider each separately.

(i) Disrupting Business of Competitor – Policy Paragraph 3.5(c)

The Complainant contends that the Registrant registered the Domain Name primarily for the purpose of disrupting the business of the Complainant because the Domain Name, which is confusing with the Complainant's CAREY trademark and directs the Complainant's actual and potential customers to the Registrant's website that appears to be the Complainant's official website advertising the Complainant's services, but in fact provides the Registrant's contact information (including a toll-free number) to be used to purchase services.

The Complainant relies on the following facts (established by the Complaint) to prove the Registrant's purpose in registering the Domain Name:

- The Domain Name was registered long after the registration of the Complainant's well-known CAREY trademark, and it is inconceivable that the Registrant was not aware of the Complainant's services and the CAREY trademark when the Registrant registered the Domain Name.
- The Domain Name is confusingly similar to the CAREY trademark, and implies that the website to which the Domain Name resolves relates to the Complainant's limousine services offered in Montreal, Québec.
- The Domain Name resolves to a website that copies substantial parts of the Complainant's official website (as it appeared in 2009), extensively uses the Complainant's CAREY trademark and appears to be the Complainant's official website that advertises the Complainant's services, but in fact provides the Registrant's contact information (including a toll-free number) to be used to purchase services.

The Registrant has not filed a response to the Complaint to dispute the Complainant's evidence or contentions or to otherwise justify the Registrant's registration or use of the Domain Name. The Panel draws an adverse inference, from the Registrant's failure to respond, that the Registrant did not have a good faith reason for registering the Domain Name.

Based on the foregoing facts and the referenced adverse inference, the Panel finds that the Complainant has proven, on a balance of probabilities, that the Registrant registered the Domain Name primarily for the purpose of disrupting the Complainant's business within the meaning of Policy paragraph 3.5(c), because the Domain Name is likely to confuse the Complainant's customers or potential customers and direct them to the Registrant's website.

The Panel also finds that the Complainant is a "competitor" of the Registrant, as required by Policy paragraph 3.5(c), because the Registrant offers limousine services that compete directly with the Complainant's limousine services.

(ii) Intentional Confusion of Internet Users – Policy Paragraph 3.5(d)

The Complainant contends that the Registrant registered the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to the Registrant's website by creating a likelihood of confusion with the Complainant's well-known CAREY trademark as to the source, sponsorship, affiliation or endorsement of the Registrant's website or the services advertised on the Registrant's website.

The Complainant argues that the Domain Name is confusingly similar to the Complainant's CAREY trademark and resolves to a deceptive website that is likely to confuse or mislead Internet users to believe that the website is the Complainant's official website that advertises the Complainant's services.

The Panel notes the following facts established by the Complainant:

- The Domain Name was registered long after the registration of the Complainant's well-known CAREY trademark, and it is inconceivable that the Registrant was not aware of the Complainant's services and the CAREY trademark when the Registrant registered the Domain Name.
- The Domain Name is confusingly similar to the CAREY trademark, and implies that the website to which the Domain Name resolves to a website relating to the Complainant's limousine services offered in Montreal, Québec.
- The Domain Name resolves to a website that copies substantial parts of the Complainant's official website (as it appeared in 2009), extensively uses the Complainant's CAREY trademark and is likely to mislead Internet users into believing that the website is the Complainant's official website that advertises the Complainant's services, but in fact provides the Registrant's contact information (including a toll-free number) to be used to purchase services.
- The Registrant has not filed a response to the Complaint to dispute the Complainant's evidence or contentions or to otherwise justify the Registrant's registration or use of the Domain Name. The Panel draws an adverse inference that the Registrant did not have a good faith reason for registering the Domain Name.

Based on the foregoing facts and the referenced adverse inference, the Panel finds that the Complainant has proven, on a balance of probabilities, that the Registrant registered the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to the Registrant's website by creating a likelihood of confusion between the Domain Name and the Complainant's CAREY trademark, within the meaning of Policy paragraph 3.5(d).

(iii) *Summary – Bad Faith*

For those reasons, the Panel finds that the Complainant has proven, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith as described in Policy paragraph 3.5.

(c) No Legitimate Interest

Policy paragraph 4.1(c) requires a complainant to provide “some evidence” that a registrant has no legitimate interest in a disputed domain name as described in Policy paragraph 3.4, which provides a non-exhaustive list of circumstances that demonstrate that a registrant has a legitimate interest in a domain name. Policy paragraph 1.2 provides that a reference to “domain name” in the Policy means a disputed domain name excluding the “dot-ca” suffix.

Policy paragraphs 3.4 and 4.1(c) together require an objective or ascertainable legitimate link between a registrant and a disputed domain name (without the “dot-ca” suffix) aside from mere registration. The criteria specified in Policy paragraphs 3.4(a), (b), (c) and (d) focus on a registrant’s registration or use of a disputed domain name and require that the registration or use be “in good faith”. The criteria specified in Policy paragraphs 3.4(e) and (f) relate to other kinds of legitimate links between the disputed domain name and the registrant or the registrant’s activities. In addition to the listed criteria, the parties or panel may look beyond the listed criteria to determine whether a registrant has a legitimate interest in a disputed domain name.

A plain reading of Policy paragraph 4.1(c) requires a panel to consider whether a registrant has a legitimate interest in a domain name based on any of the criteria listed in Policy paragraph 3.4 or other circumstances. The fact that one or more of the listed criteria are not applicable is not determinative, because a legitimate interest may be established under any of the listed criteria or other circumstances. Further, the fact that a registrant may not have registered or used a disputed domain name in good faith (and therefore Policy paragraphs 3.4(a), (b), (c) and (d) are not applicable) does not mean that the registrant does not have a legitimate interest in the domain name under the criteria specified in Policy paragraphs 3.4(e) and (f) or otherwise. This view is consistent with a reading of Policy paragraph 4.1 as a whole, which treats as distinct elements bad faith registration of a disputed domain name and legitimate interest in a disputed domain name, and expressly provides that a registrant who registers a disputed domain name in bad faith may nevertheless succeed in a proceeding under the Policy by establishing that the registrant has a legitimate interest in the disputed domain name.

A complainant’s burden regarding a registrant’s lack of a legitimate interest in a disputed domain name is relatively light. Policy paragraph 4.1 requires a complainant to provide “some evidence” that a registrant has no legitimate interest in a disputed domain name, and then the burden shifts to the registrant to prove that the registrant has a legitimate interest in the domain name. That approach reflects the fact that in most cases the nature of a registrant’s legitimate interests, if any, in a domain name lies most directly within the registrant’s knowledge. In most cases, a complainant can satisfy its evidentiary onus to provide “some evidence” that a registrant does not have a legitimate interest in a disputed domain name by conducting reasonable, limited inquiries or rudimentary Internet-based searches using the registrant’s name and other contact details.

The Complaint is signed by the Complainant’s legal counsel as the Complainant’s authorized representative and contains the following statement: “The Complainant certifies that the information contained in this Complaint is to the best of the Complainant’s knowledge complete and accurate...”. The Complainant’s assertions regarding the inapplicability of the criteria for legitimate interest specified in Policy paragraph 3.4 are as follows:

- There is not, and has never been, any relationship between the Complainant and the Registrant. The Registrant has never been licensed or otherwise authorized to register or use the CAREY trademark in any manner whatsoever, including as part of a domain name.
- The Registrant is not using the Domain Name in good faith because the Registrant is using the Domain Name for a misleading and copyright-infringing website to generate revenue by misappropriating the Complainant's CAREY trademark.
- The Domain Name is not clearly descriptive of the character or quality of the Registrant's wares, services or business, the conditions of, or the persons employed in, production, performance or operation of the Registrant's wares, services or business.
- The Domain Name is not the generic name of the Registrant's wares, services or business.
- The Domain Name is not being used in association with a non-commercial activity.
- The Domain Name is not a legal name or commonly used identifier of the Registrant.
- The Domain Name as a whole is not the geographical name of the location of the Registrant's place of business. The word "Montreal" is a geographic location, but the rest of the Domain Name ("careylimo") is not geographic.

Except for the assertions in the signed and certified Complaint, the Complainant has not provided any evidence of trademark searches or other investigations to indicate that the Registrant does not have a legitimate interest in the term "CAREY". In some circumstances, the omission of that evidence might be fatal to a complaint under the Policy. Nevertheless, in the circumstances of this case – including the distinct nature of the CAREY trademark, the Registrant's name, and the Registrant's use of the Domain Name for a deceptive website that is likely to mislead Internet users – the signed and certified Complaint together with an adverse inference from the Registrant's failure to file a response to the Complaint are sufficient to satisfy the Complainants' relatively light evidentiary burden to provide "some evidence" that the Registrant does not meet any of the criteria listed in Policy paragraph 3.4 and therefore does not have a legitimate interest in the Domain Name as described in Policy paragraph 3.4.

Accordingly, the onus shifts to the Registrant to prove, on a balance of probabilities, that the Registrant has a legitimate interest in the Domain Name. The Registrant has not filed a response to dispute the Complainant's contentions or to justify the Registrant's registration and use of the Domain Name.

For those reasons, the Panel finds that the Complainant has satisfied the evidentiary burden to provide "some evidence" that the Registrant does not have a legitimate interest in the Domain Name as described in Policy paragraph 3.4, and the Registrant has not proven, on a balance of probabilities, that the Registrant has a legitimate interest in the Domain Name as described in Policy paragraph 3.4.

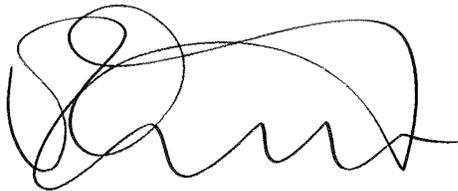
J. Conclusion and Decision

For the reasons set out above, the Panel finds as follows:

- The Complainant is eligible to file the Complaint.
- The Complainant has proven, on a balance of probabilities, that the Domain Name is Confusingly Similar to the Complainant's CAREY trademark, which is a Mark in which the Complainant had rights before the registration of the Domain Name and continues to have rights.
- The Complainant has proven, on a balance of probabilities, that the Registrant registered the Domain Name in bad faith as described in Policy paragraph 3.5.
- The Registrant does not have any legitimate interest in the Domain Name as described in Policy paragraph 3.4.

Based on those findings, the Panel decides this proceeding in favour of the Complainant and orders that the registration of the Domain Name be transferred to the Complainant.

Dated: February 23, 2016.

A handwritten signature in black ink, appearing to read 'Bradley J. Freedman', written in a cursive style.

Bradley J. Freedman, Sole Panellist