

**IN THE MATTER OF A COMPLAINT MADE PURSUANT TO THE CANADIAN  
INTERNET REGISTRATION AUTHORITY DOMAIN NAME DISPUTE  
REGISTRATION RESOLUTION POLICY (v 1.3) AND RULES (v 1.5)**

**Complainant:** Ford Motor Company of Canada, Limited  
The Canadian Road  
Oakville, Ontario, L6J 5E4  
(the "Complainant")

**Complainant Counsel:** Sumaiya Sharmeen  
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**Registrant:** Gilles Lefebvre  
Yonge Steeles Ford Sales Limited  
7120 Yonge Street  
Thornhill, ON L4J 1V8  
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**Disputed Domain Names:** downtownford.ca and familypricing.ca  
(collectively the "Domain Names")

**Registrar:** Go Daddy Domains Canada, Inc.

**Single Member Panel:** R. John Rogers

**Service Provider:** British Columbia International  
Commercial Arbitration Centre (the "BCICAC")

**BCICAC File:** DCA-1782-CIRA

**PROCEDURAL HISTORY**

The BCICAC is a recognized service provider pursuant to the Domain Name Dispute Resolution Policy (v 1.3) (the "Policy") and Rules (v 1.5) (the "Rules") of the Canadian Internet Registration Authority.

The Complainant filed a complaint dated May 3, 2016 (the "Complaint") with the BCICAC seeking an order in accordance with the Policy and the Rules directing that registration of the Domain Names be transferred from the Registrant to the Complainant.

The BCICAC determined the Complaint to be in administrative compliance with the requirements of Rule 4.2 and, by letter of transmittal dated May 20, 2016 (the "Transmittal Letter"), forwarded a copy of the Complaint to the Registrant to serve as notice of the Complaint in accordance with Rules 2.1 and 4.3. The Transmittal Letter determined the date of the commencement of proceedings in accordance with Rule 4.4 to be May 24, 2016. The Transmittal Letter advised the Registrant that in accordance with the provisions of Rule 5, a Response to the Complaint was to be filed within 20 days of the date of commencement of proceedings, or June 13, 2016.

The Transmittal Letter was addressed to "Michael Lefebvre, 234 Rideau Street, Suite 1008, Ottawa, On CA K1N 0A9", was delivered by courier to this address on Wednesday, May 25, 2016 @ 9:31 AM, and this delivery was confirmed by the signature of the recipient.

On May 26, 2016, an electronic copy of the Complaint together with an electronic copy of the Transmittal Letter was sent by email to the Registrant at his email address above set out. In this email, the Registrant was advised that the final date for the filing of his response was extended by two days from June 13, 2016 to June 15, 2016.

By email dated June 16, 2016, a copy of which was sent to the Registrant, the BCICAC advised the Complainant that as the BCICAC had not received a Response to the Transmittal Letter by June 15, 2016 as required by Rule 5.1, that pursuant to Rule 6.5 the Complainant had the right to elect that the panel in this matter be converted from a three member panel to a single member panel.

The Complainant so elected and the undersigned was appointed by the BCICAC as the Single Member Panel by letter dated June 28, 2016. The undersigned filed his Acceptance of Appointment as the Single Member Panel and Statement of Independence and Impartiality with the BCICAC on July 6, 2016 and determines that he has been properly appointed and constituted as the Single Member Panel to determine the Complaint in accordance with the Rules.

By emails to the BCICAC dated June 28, 2016, the Registrant provided the BCICAC with a postal address and another email address and queried why a hard copy of the Complaint had not been sent to the street address he had provided with this email. By an email of the same date, the BCICAC directed the Registrant's attention to Paragraph 2.2 (e) of the Rules and noted that this provision states that "any written communication

which is required to be sent to a Party pursuant to the Resolution Rules will be sent by electronic transmission via the Internet, provided a record of transmission, which includes the contents of the email and the date of transmission ....". In this email of June 28, 2016 to the Registrant, the BCICAC also directed the Registrant's attention to its emailed letter to him of June 16, 2016.

Following the email exchange on June 28, 2016 between the BCICAC and the Registrant, there was nothing before me which indicated that there had been further communication between these parties until on July 14, 2016, I received an email from the Registrant attaching an email string purportedly being between him and the BCICAC and dated June 5, 2016. While the initial material before me suggested that the Registrant did not file a response to the Complaint, due to the apparent confusion of dates evident from this July 14, 2016 communication from the Registrant, I have determined to consider the Registrant's communication to me of July 14, 2016 as his response (the "Response").

#### **CANADIAN PRESENCE REQUIREMENTS**

The Canadian Presence Requirements for Registrants v 1.3 ("Presence Requirements") require that to be permitted to apply for registration of, and to hold and maintain the registration of, a .ca domain name, the applicant must meet at least one of the criteria listed as establishing a Canadian presence. Section 2(d) of the Presence Requirements specifies that a corporation incorporated under the laws of Canada or any province or territory of Canada has the requisite Canadian presence.

The Complainant is a corporation incorporated under the laws of the Province of Ontario. The Complainant, therefore, meets the Canadian presence requirements.

#### **ALL TECHNICAL REQUIREMENTS MET**

Based upon the information provided by the BCICAC, I find that all technical requirements for the prosecution of this proceeding have been met.

#### **FACTS OFFERED BY THE COMPLAINANT**

The facts put forward by the Complainant might be summarized as follows:

1. The Complainant has been selling FORD branded cars in Canada for over 100 years;
2. The Complainant is the owner of the following Canadian trade-marks ("Marks"):

<b>Trade-Mark</b>	<b>Reg. No.</b>	<b>Reg. Date</b>
FORD	UCA035244	December 9, 1949
FORD DESIGN	TMDA036490	October 17, 1924
FORD OVAL DESIGN	TMA478164	June 20, 1997
FORD	TMA101227	August 19, 1955
FORD	NFLD000417	September 19, 1912
FAMILY PRICING	TMA709809	March 18, 2008

3. The Complainant operates a website associated with the "ford.ca" domain name, which domain name is owned by a company affiliated with the Complainant;
4. The Domain Names were registered on the following dates:
  - a. "downtownford.ca" on September 24, 2015; and
  - b. "familypricing.ca" on July 20, 2015;
5. Although the name and contact information of the registrant owning title to the Domain Names is not publically available, subsequent correspondence between the Complainant and the Registrant identified the Registrant as a sales specialist at Yonge Steeles Ford Sales Limited ("Y&S"), an authorized Ford dealership;
6. This subsequent correspondence also established the Registrant's ownership of the Domain Names and that the Registrant was "solely responsible" for the content on the websites to which the Domain Names resolved and exercised sole control over the Domain Names;
7. The Registrant is not a licensed user of the Marks, nor does he have any rights in any of the Marks;
8. Initially the Domain Names resolved to webpages which contained unauthorized use of the Marks, which referenced Y&S, and which were used to promote the business of the Registrant as an employee of Y&S;
9. Currently, the Domain Names resolve to webpages which bear messages suggesting that the websites have been parked;
10. Initially the Registrant agreed to transfer the Domain Names to the Complainant, however in subsequent email correspondence with the Complainant the Registrant stated that transferring the Domain Names to the Complainant would result in negative consequences as a sales specialist at Y&S and demanded:
  - a. the sum of \$150,00 as compensation,
  - b. the right to continue to use the Domain Names, and
  - c. a letter of apology from the Complainant to him and to his employer, Y&S; and
11. When the Complainant brought the Registrant's use of the Domain Names to the attention of Y&S, the response of Y&S was that it did not know that the Registrant was using the Domain Names in the furtherance of his employment, that the sites used by the Registrant had been "removed/shut down", and that Y&S had made it clear to the Registrant that "though we encourage social media to create and promote an online presence this is certainly not allowed."

#### **FACTS OFFERED BY THE REGISTRANT**

The facts put forward by the Registrant might be summarized as follows:

1. In the fall of 2015, the Registrant submits that he shut down the websites to which the Domain Names resolve and turned the sites over to the "registrant";
2. As he is an employee of Y&S, a dealership licensed by the Complainant, he has the right to use the Marks and has had this right since 1978;
3. The suggestion that he has acted in "bad faith" is defamatory in nature; and
4. The Registrant denies ever attempting to negotiate a price for the Domain Names as they are not his to transfer, and that he is currently asking for a letter of apology from the Complainant, legal costs of \$5,000, and website costs of \$9,800.

Domain Names: downtownford.ca and familypricing.ca  
 Ford Motor Company of Canada, Limited  
 and  
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**REMEDIES SOUGHT**

The Complainant seeks an order from the Panel in accordance with paragraph 4.3 of the Policy instructing the Registrar of the Domain Names to transfer the Domain Names to the Complainant.

**THE POLICY**

The purpose of the Policy as stated in paragraph 1.1 of the Policy is to provide a forum in which cases of bad faith registration of .ca domain names can be dealt with relatively inexpensively and quickly.

Paragraph 4.1 of the Policy puts the onus on the Complainant to demonstrate this “bad faith registration” by proving on a balance of probabilities that:

1. the Marks qualify as a “Mark” as defined in paragraph 3.2 of the Policy;
2. the Complainant had “Rights” in the Marks prior to the date of registration of the Domain Names and continues to have “Rights” in the Marks,
3. the Domain Names are “Confusingly Similar” to the Marks as the concept of “Confusingly Similar” is defined in paragraph 3.3 of the Policy;
4. the Registrant has no “legitimate interest” in the Domain Names as the concept of “legitimate interest” is defined in paragraph 3.4 of the Policy; and
5. the Registrant has registered the Domain Names in “bad faith” in accordance with the definition of “bad faith” contained in paragraph 3.5 of the Policy.

If the Complainant is unable to satisfy this onus, bad faith registration is not demonstrated and the Complaint fails.

**MARK**

In the matter at hand, the relevant portion of paragraph 3.2 of the Policy states that for the purpose of the Policy a “Mark” is:

- (a) a trade-mark, including the word elements of a design mark, or a trade name that has been used in Canada by a person, or the person’s predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person;

Since at least March 18, 2008 and well before the registration of the Domain Names, the Complainant has used one or more of the Marks in Canada to distinguish its provision of wares, services or business from another provider of similar wares, services or business.

The Complainant continues to use the Marks.

The Marks clearly qualify as a “Mark” pursuant to paragraph 3.2(a) of the Policy.

## **RIGHTS**

The paragraph 3.1 of the Policy requires that the Complainant have "Rights" in the Marks. Unfortunately, the term "Rights" is not defined in the Policy.

However, given the evidence before me of the Complainant's ownership and use of the Marks in Canada, I find that the Complainant has "Rights" in the Marks for the purpose of paragraph 3.1 of the Policy.

## **CONFUSINGLY SIMILAR**

Policy paragraph 3.3 provides that the Domain Names will be found to be "Confusingly Similar" to the Marks only if the Domain Names so nearly resemble the Marks in appearance, sound or the ideas suggested by the Marks as likely to be mistaken for the Marks.

To firstly address the "familypricing.ca" domain name. This domain name consists of the words contained in the trade-mark "FAMILY PRICING" owned by the Complainant, but without the space between the words FAMILY and PRICING and includes the .ca suffix. As paragraph 1.2 of the Policy defines the domain name for the purpose of this proceeding to exclude the .ca suffix, the portion of the domain name consisting of "FAMILYPRICING" is the portion relevant for consideration.

Therefore, to satisfy the onus placed upon it by the Policy, the Complainant must demonstrate that the "familypricing" portion of the domain name so nearly resembles the trade-mark "FAMILY PRICING" in appearance, sound or the ideas suggested by the trade-mark as likely to be mistaken for the trade-mark.

It is clear from decisions of other panels that where, apart from the omission of a space, a trade-mark uses the same words as the domain name under consideration, that the domain name and the mark are considered "identical". See for example, *Discovery Toys, Inc. v. Ebenezer Therasagayam* (CIRA Dispute Resolution Decision # 00118), and *Extreme Fitness Inc. v. Gutam Relan* (CIRA Dispute Resolution Decision # 0019).

I find that the spacing difference between the wording of the trade-mark "FAMILY PRICING" and the domain name "familypricing.ca" is not sufficient to render the domain name different from the trade-mark for the purpose of the Policy and that, therefore, the domain name "familypricing.ca" is for the purpose of paragraph 3.3 likely to be mistaken for the trade-mark "FAMILY PRICING" owned by the Complainant.

The domain name "downtownford.ca", however, involves additional considerations. Even with the exclusion of the .ca suffix, a direct comparison with the Complainant's trade-mark "FORD" is a greater challenge.

However, as other panels have determined, the test for "Confusingly Similar" in paragraph 3.3 of the Policy is not one of the trade-mark being exactly the same as the domain name. Rather, the test is one of resemblance based upon first impression and

imperfect recollection. Similarly, other decisions have determined that the inclusion of additional words will not prevent a domain name to be confusingly similar to a trade-mark. See for example, *Re: governmentofcanada.ca et al.* CDRP 00011 (BCICAC 27 May 2003) and *Re: nationalcarhire.ca* CIRA-CDRP 00288 (BCICAC 27 July 2015).

The Complainant notes that the domain name “downtownford.ca” consists of the entire trade-mark “FORD” owned by the Complainant and the word “downtown”. It submits that the addition of the word “downtown” is merely descriptive of the location of the business of the Registrant and does not add to the distinctiveness of the domain name. It takes the position that it would be very likely that a person aware of the Complainant’s trade-mark “FORD” would believe that the domain name was associated with the Complainant.

I agree with the Complainant that notwithstanding the additional word “downtown” that a person coming across the domain name “downtownford.ca” would very likely associate it with the Complainant. Indeed, from the evidence before me, it was the Registrant’s purpose of creating that association with the Complainant that led him to utilize this particular domain name. To that end, when he was asked to transfer this domain name to the Complainant, the Registrant complained that such a transfer would markedly adversely affect his business of selling through Y&S cars manufactured by the Complainant.

I therefore find that the Complainant has satisfied the onus placed upon it by paragraph 3.3 of the Policy and has demonstrated that the Domain Names so nearly resemble one or more of the Marks in appearance, sound or the ideas suggested by the Marks as to be likely mistaken for the Marks.

#### **NO LEGITIMATE INTEREST**

Paragraph 4.1 of the Policy requires that to succeed in the Complaint, the Complainant must provide some evidence that the Registrant has no legitimate interest in the Domain Names as the concept of “legitimate interest” is provided for in paragraph 3.4 of the Policy.

Paragraph 3.4 of the Policy provides that the Registrant has a legitimate interest in a domain name if:

- 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 used 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 used 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.

It is to be noted that in paragraphs 3.6(a), (b), (c), and (d), there is a requirement that the Registrant use the Domain Names "in good faith". The evidence before me, as referenced below, is not that the Registrant used the Domain Names in good faith, but rather to the contrary, that the Registrant used the Domain Names to trade upon the goodwill of the Complainant without a license to do so. Therefore, the provisions of these paragraphs do not apply.

The Registrant's name is not included in the Domain Names, so the provisions of paragraph 3.6(e) do not apply.

Although the Complainant has submitted that the inclusion of the word "downtown" in the "downtownford.ca" domain name is a reference to the location of a business, nonetheless I find that the provisions of paragraph 3.6(f) do not apply. The reference in this paragraph to a business location requires the utilization of a geographical name to reference the location of the business. I find that the inclusion of the word "downtown" is a generic descriptor and does not provide the required "geographical" reference.

I therefore find that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Names.

### **BAD FAITH**

Under paragraph 3.5 of the Policy, the Registrant will be considered to have registered the Domain Names in bad faith if, and only if, the Complainant can demonstrate that the Registrant in effecting the registration of the Domain Names was motivated by any one of the four general intentions set out in paragraph 3.5.

Of these intentions, the form of intention contained in paragraph 3.5(d) is the one most applicable to the matter at hand.



Paragraph 3.5(d) provides as follows:

(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.

It is clear from the evidence before me that the Registrant with the use of the Domain Names was without right or license intent in trading off the goodwill and reputation of the Complainant. Indeed, in his communication with the Complainant, the Registrant was quite direct in stating that in transferring the Domain Names to the Complainant, he would suffer loss to his business of selling cars manufactured by the Complainant.

The Registrant in the Response submits that he was entitled to use the Domain Names in the course of his employment as an employee of Y&S. However, the evidence before me is to the contrary with Y&S claiming to be unaware of the Registrant's use of the Domain Names and upon being appraised of their use by the Complainant, instructing the Registrant to cease their use in the course of his employment with Y&S.

I therefore find that the Complainant has satisfied the provisions of paragraph 3.5 (d) of the Policy by establishing that the Registrant without colour of right has by his actions intentionally attempted to attract for commercial gain Internet users to his websites by creating a likelihood of confusion with the Complainant's Marks as to the source, sponsorship, affiliation or endorsement of the product or service referenced on the Registrant's website.

#### **DECISION**

As was above set out, paragraph 4.1 of the Policy provides that to be successful in the Complaint the Complainant has the onus of proving on a balance of probabilities three specific items and of providing some evidence that the Registrant has no legitimate interest in the Domain Names.

I find that the Complainant has satisfied this onus with respect to all three of these items by demonstrating that each of the Marks qualify as a Mark in accordance with paragraph 3.2 of the Policy; that the Domain Names are Confusingly Similar to one or more of the Marks; and that the Registrant has registered the Domain Names in bad faith in accordance with the provisions of paragraph 3.5 of the Policy.

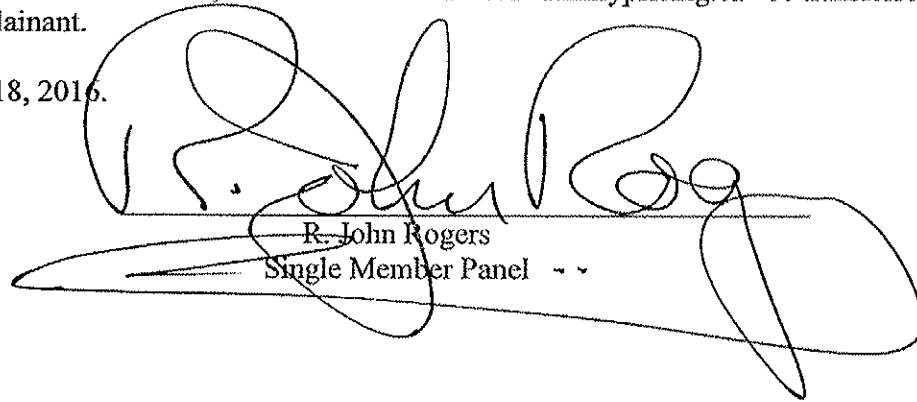
I have also found that the Complainant has shown some evidence that the Registrant does not have a legitimate interest in the Domain Names in accordance with the provisions of paragraph 3.4.

I therefore find that the Complainant has satisfied the onus placed upon it by paragraph 4.1 of the Policy and is entitled to the remedy sought by it.

**ORDER**

I order that the domain names, "downtownford.ca" and "familypricing.ca" be transferred to the Complainant.

Dated: July 18, 2016.



R. John Rogers  
Single Member Panel - -