

**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:** ADESA, Inc.  
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Carmel, Indiana 46032  
United States of America  
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(the "Complainant")

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**Registrant:** Antonia Ojo/ 0902066 B.C. Ltd.  
1201 – 11871 Horseshoe Way  
Richmond, B.C., V7A 5H5  
Attention: Antonia Ojo  
Email: [postmaster@adesapublicauktion.ca](mailto:postmaster@adesapublicauktion.ca)  
[admin@bizmail.com](mailto:admin@bizmail.com)  
(the "Registrant")

**Disputed Domain Name:** adesapublicauktion.ca  
(the "Domain Name")

**Registrar:** BareMetal.com inc @ <http://baremetal.com/>

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

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

**BCICAC File:** DCA-2092-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.

On May 10, 2019, the Complainant filed a complaint (the “Complaint”) with the BCICAC. In the Complaint, the Complainant seeks an order in accordance with the Policy and the Rules directing that the registration of the Domain Name 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 way of an emailed letter dated May 13, 2019 (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 13, 2019. 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 3, 2019. Delivery of this email to the Registrant was confirmed by the BCICAC on May 13, 2019.

By an email dated June 6, 2019, the BCICAC advised the Complainant that as the BCICAC had not received a Response to the Transmittal Letter by June 3, 2019 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 elected to proceed with a single member panel and the undersigned was appointed by the BCICAC as the Single Member Panel by letter dated June 17, 2019, copies of which letter were sent by email to both the Complainant and the Registrant. The undersigned has confirmed to the BCICAC that he can act impartially and independently as the Single Member Panel in this matter.

The undersigned determines that he has been properly appointed and constituted as the Single Member Panel to determine the Complaint in accordance with the Rules.

## **CANADIAN PRESENCE REQUIREMENTS**

Section 1.4 of the Policy requires that in order to initiate the Complaint, the Complainant at the time of the initiation of the Complaint must satisfy the Canadian Presence Requirements for Registrants v 1.3 (“Presence Requirements”) unless the Complaint relates to a trademark registered in the Canadian Intellectual Property Office and the Complainant is the owner of that trademark.

As the Complainant holds Canadian Trademark Registration No. TMA434,316 for ADESA and TMA785,733 for ADESA (and Design) (the “Marks”), and as the Complaint relates to the Marks, the Complainant satisfies the provisions of Section 1.4 of the Policy.

### **ALL TECHNICAL REQUIREMENTS MET**

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

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

The facts in the Complaint might be summarized as follows:

1. The Complainant founded in 1989 offers a full range of auction, reconditioning, logistical and other vehicle-related services to meet the remarketing needs of both its institutional and dealer customers employing over 18,000 people. It hosts weekly sales at 75 whole car auction locations across the United States, Canada and Mexico as well as building and managing online sales platforms for many vehicle manufacturers.
2. The Marks identify the Complainant’s vehicle remarketing and auctioning services as well as other attendant services offered by the Complainant as the Complainant’s house brand generating over two billion dollars in gross revenues during 2018.
3. The Complainant submits that it is reasonable to infer that the Marks are well known, particularly within the automotive industry.
4. The Complainant’s predecessor in interest filed for registration the ADESA trademark in the Canadian Trademark Office on July 20, 1993 and the Complainant applied to register its rights in the Marks in Canada on January 29, 2009. Registration was effected on December 22, 2010. Similar registrations of the Marks have been made in the United States and Mexico.
5. The Complainant has maintained an internet presence through the domain name <adesapublicauctions.ca> which it registered on May 24, 2002 (the “Complainant’s URL”) and uses this domain name to advertise and provide information regarding its actions and listed vehicles, even allowing online mobile bidding for those with an account that cannot be at an auction in person..
6. Well after the registration of the Marks by the Complainant and its registration of the Complainant’s URL, the Registrant registered the Domain Name on November 14, 2011.
7. The Complainant alleges that the Registrant has not associated any content with the Domain Name, but instead has set the page to which the Domain Name resolves to auto-redirect

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visitors to seemingly random webpages which change each time the Domain Name affiliated webpage is visited. The Complainant notes that none of the redirected webpages suggest that the Registrant is known by or otherwise trades under the Marks. Rather, the Complainant alleges, the Registrant used the Domain Name to generate revenue by directing internet traffic to third party websites after such parties have been attracted to the website affiliated with the Domain Name by the Complainant's Marks and the goodwill associated with the Complainant's business.

The Complainant submits that based upon the fact that the Domain Name differs from its registration of the Complainant's URL strictly by the elimination of the letter "s" that the registration of the Domain Name by the Registrant is a clear case of typo-squatting.

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

As was noted above, the Registrant has not responded to the Complaint nor has the Registrant responded to the BCICAC's Transmittal Letter.

### **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 Name to transfer the Domain Name 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. one or more of the Marks or the Complainant's URL qualifies as a "Mark" as defined in paragraph 3.2 of the Policy;
2. the Complainant had "Rights" in the Marks or the Complainant's URL prior to the date of registration of the Domain Name and continues to have "Rights" in the Marks and the Complainant's URL,
3. the Domain Name is "Confusingly Similar" to the Marks and/or the Complainant's URL 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 Name as the concept of "legitimate interest" is defined in paragraph 3.4 of the Policy; and

5. the Registrant has registered the Domain Name 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 portions of paragraph 3.2 of the Policy states that for the purpose of the Policy a “Mark” is:

- (a) a trademark, 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;

and

- (c) a trademark, including the word elements of a design mark, that is registered in CIPO;

The addition of paragraph 3.2(c) as above set out clearly indicates that for a trademark to qualify as a “Mark” under paragraph 3.2, the trademark need not be registered with the CIPO. It is clear, therefore, that a trademark under paragraph 3.2, for the purpose of the Policy a common law trademark, such as the Complainant’s URL, can qualify as a “Mark”.

Since at least 1993 the Complainant or its predecessor in interest has used at least one of the Marks in Canada to distinguish its provision of wares, services or business from another provider of similar wares, services or business.

More importantly, the Complainant has used the Complainant’s URL in Canada since May 24, 2002 for the same purpose. The use of the Complainant’s URL in Canada by the Complainant constitutes the use by the Complainant of a trademark in Canada since May 24, 2002 to distinguish through the internet its provision of wares, services or business from another provider of similar wares, services or business.

These uses by the Complainant of both the Marks and the Complainant’s URL commenced well before the registration of the Domain Name.

The Complainant continues to so use the Marks and the Complainant’s URL.

I find that the Complainant has established that the Marks and the Complainant’s URL collectively qualify as a “Mark” for the purposes of paragraph 3.2(a) of the Policy.

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## RIGHTS

Paragraph 3.1 of the Policy requires that the Complainant have “Rights” in the Marks and the Complainant’s URL. 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 and the Complainant’s URL in Canada, I find that the Complainant has “Rights” in the Marks and the Complainant’s URL for the purpose of paragraph 3.1 of the Policy.

## CONFUSINGLY SIMILAR

The Policy in paragraph 3.3 provides that the Domain Name will be found to be “Confusingly Similar” to the Marks or the Complainant’s URL only if the Domain Name so nearly resembles one or more of the Marks or the Complainant’s URL in appearance, sound or the ideas suggested by the Marks or the Complainant’s URL as likely to be mistaken for one or more of the Marks or the Complainant’s URL.

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 “adesapublicauktion” is the portion relevant for consideration.

The Domain Name consists of the word “adesa” together with the words “public” and “auktion”. The word “adesa” alone is contained in the trademark “ADESA” owned by the Complainant. However, all three words, “adesa”, “public” and “auktionen” are contained in the Complainant’s URL with the only difference between the Complainant’s URL and the Domain Name being that the Domain Name uses the singular of the word “auktion” while the Complainant’s URL uses the plural of this word.

Therefore, to satisfy the onus placed upon it by the Policy, the Complainant must demonstrate that the “adesapublicauktion” portion of the Domain Name so nearly resembles either the trademark “ADESA” or the Complainant’s URL in appearance, sound or the ideas suggested by the trademark or the Complainant’s URL as likely to be mistaken for the trademark or the Complainant’s URL.

It is clear from decisions of other panels that where, apart from the omission of a space or an additional letter, a trademark contains the same words as the domain name under consideration, that the domain name and the mark are considered “identical”. See for example, *Ford Motor Co. of Canada Ltd. v. Lefebvre* (CIRA Dispute Resolution Decision #00314, 2016).

I find that the addition of the letter “s” in the trademark contained in the Complainant’s URL is not sufficient to render the Domain Name different from the Complainant’s URL for the purpose of the Policy and that, therefore, the Domain Name is for the purpose of paragraph 3.3 likely to be mistaken for the Complainant’s URL owned by the Complainant.

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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 Name so nearly resembles the Complainant's URL in appearance, sound or the ideas suggested by the Complainant's URL as to be likely mistaken for the Complainant's URL.

### **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 Name 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 Registrant 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 Name "in good faith". The evidence before me, as referenced below, is not that the Registrant used the Domain Name in good faith, but rather to the contrary, that the Registrant used the Domain Names to disrupt and 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 Name nor is there a geographical reference so the provisions of paragraphs 3.6(e) and 3.6(f) do not apply.

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

## **BAD FAITH**

Under paragraph 3.5 of the Policy, the Registrant will be considered to have registered the Domain Name in bad faith if, and only if, the Complainant can demonstrate that the Registrant in effecting the registration of the Domain Name 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.

Based upon the evidence before me, I find that the Complainant has satisfied the provisions of paragraph 3.5 (d) of the Policy by establishing that that the Registrant has intentionally attempted to attract for commercial gain traffic to the website to which the Domain Name resolves by creating a likelihood of confusion with the Complainant's URL as to the source, sponsorship, affiliation, or endorsement of the website to which the Domain Name resolves.

## **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 Name.

I find that the Complainant has satisfied this onus with respect to all three of these items by demonstrating that the Marks and the Complainant's URL qualify as a Mark in accordance with paragraph 3.2 of the Policy; that the Domain Name is Confusingly Similar to the Complainant's URL; and that the Registrant has registered the Domain Name 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 Name in accordance with the provisions of paragraph 3.4 of the Policy.

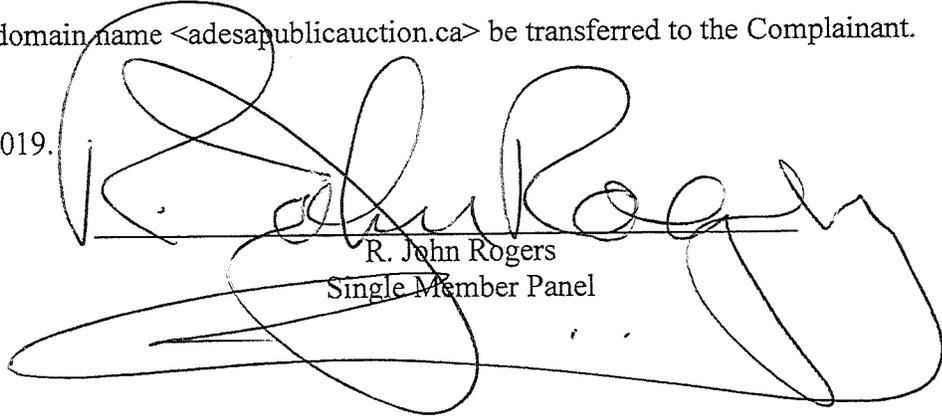
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I therefore find that the Complainant has satisfied the onus placed upon it by paragraph 4.1 of the Policy and is entitled to the remedy sought by it.

**ORDER**

I order that the domain name <adesapublicauction.ca> be transferred to the Complainant.

Dated: July 3, 2019.



R. John Rogers  
Single Member Panel

