

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

Dispute Number: DCA-2176-CIRA

Domain Name: sapenergy.ca

Complainant: SAP SE

Registrant: 034562 BC Ltd.,

Registrar: Domain Robot Enterprises Inc.

Panel: The Honourable Neil Anthony Brown QC

Service Provider: The British Columbia International Commercial Arbitration Centre

**DECISION**

**OVERVIEW**

1. This matter concerns a dispute between the Complainant and the Registrant regarding the registration and use of the domain name <sapenergy.ca> (“the disputed domain name”).
2. The British Columbia International Commercial Arbitration Centre (“BCICAC”) is a recognized service provider to the CIRA Domain Name Dispute Resolution Policy (“the Policy”) of the Canadian Internet Registration Authority (“CIRA”).
3. This is a proceeding under the CIRA Domain Name Dispute Resolution Policy (the “Policy”), in accordance with the CIRA Dispute Resolution Rules (the “Rules”).
4. The Complainant claims that the Registrant registered the disputed domain name in breach of the Policy. The Registrant has not filed a Response in this proceeding.

**THE PARTIES**

1. The Complainant in this proceeding is SAP SE, Dietmar-Hopp-Allee 16 Walldorf, Germany 69190 (“the Complainant”) and its Authorised Representative in this proceeding is K & G Law LLC, 602 S. Bethlehem Pike, Bldg. B, Ambler, PA 19002, USA.
2. The Registrant in this proceeding is 034562 BC Ltd., Gibbins Rd. 3045, Duncan, BC V9L1E5, Canada (“the Registrant”).

## **REGISTRATION OF THE DISPUTED DOMAIN NAME**

1. The disputed domain name <sapenergy.ca> was registered by the Registrant on October 1, 2019.
2. The Registrar of the disputed domain name is Domain Robot Enterprises Inc, 1100-1200 West 73rd Avenue, Vancouver BC V6P 6G5 , Canada;  
Email: info@domainrobot.ca.

## **PROCEDURAL HISTORY**

According to the information provided by the BCICAC:

1. The Complainant filed a Complaint with respect to the disputed domain name in accordance with the Policy on December 31, 2019.
2. The Complaint was reviewed and found to be administratively compliant. By letter dated January 6, 2020, the BCICAC as service provider, confirmed administrative compliance of the Complaint and, as Notice in accordance with Rules 2.1 and 4.3, and forwarded a copy of the Complaint to the Registrant together with its Schedules, as the Complaint with attachments had been filed exclusively by email. By the same communication the BCICAC informed the parties that in accordance with Rule 4.4 the date of commencement of the Proceeding was January 7, 2020, and that any Response had to be filed by January 28, 2020.
3. The Complaint and its attachments have been successfully delivered to the Registrant via the email address provided by CIRA and confirmation thereof has been received by the BCICAC.
4. The Registrant did not file a Response in this proceeding with the BCICAC by January 28, 2020 or at all. As permitted, given the absence of a Response, the Complainant elected under Rule 6.5 to convert from a three-person panel to a single arbitrator.
5. On February 11, 2020 BCICAC appointed The Honourable Neil Anthony Brown QC as sole arbitrator in this proceeding. The sole arbitrator has signed and forwarded to the BCICAC an Acceptance of Appointment as Arbitrator and Statement of Independence and Impartiality.
6. The Panel has reviewed all of the material submitted by the Complainant and is satisfied on that material that the Complainant is an eligible Complainant under the Policy and the Rules by virtue of its ownership of the trademark registrations referred to hereafter.

## FACTS

The facts set out below are taken from the Complaint and are supported by related exhibits.

The Complainant is a German company with its headquarters in that country, although it also conducts business worldwide including in Canada and the United States. It was founded in 1972, but since then it has greatly expanded its activities internationally. It is a market leader in enterprise software applications, analytics, mobile solutions and related goods and services. Its name and brand have achieved an international prominence in its field. Some indication of its size may be gleaned from the fact that it employs over 99,000 people.

The Complainant has a well-established trademark and brand, namely SAP (“the SAP trademark”). The SAP trademark is registered internationally, including *inter alia*, in Canada, with respect to a broad range of goods and services related to its above mentioned activities, such as data media, material for computer software, the design of software and many other products, as well as consulting, research and internet services.

To establish CIRA’s Canadian presence requirements, which the Complainant is required to do, it relies on the fact that it is the owner of that trademark, which is the subject of registration with the Canadian Intellectual Property Office (CIPO) in Canada under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13, being Canadian Trademark Registration No. TMA560389 registered April 18, 2002. The trademark remains in full force and effect. The trademark is Exhibit A to the Complaint.

It is noteworthy that the Complainant’s Canadian trademark, which it uses in its business in Canada, was registered nearly 20 years before the Registrant registered the disputed domain name, which was on October 1, 2019.

The Complainant became aware of the disputed domain name which gives rise to this dispute, when notified by Shell Canada Limited that the Registrant had impersonated an employee of the Complainant and attempted to make a purchase on Shell’s mobile application. The Complainant had of course not authorised or given permission for any such transaction, which was essentially fraudulent.

The Complainant maintains that this shows the Registrant registered the disputed domain name primarily for the purpose of disrupting the business of the Complainant and to gain commercial advantage by creating a likelihood of confusion with the Complainant’s mark, because it was using the trademark in its domain name and clearly for its own commercial benefit. Moreover, the disputed domain name redirects consumers to the Complainant’s legitimate Canadian website at [www.sap.com/canada](http://www.sap.com/canada), which gives the false impression that emails emanating from [@sapenergy.ca](mailto:@sapenergy.ca) are legitimate communications of the Complainant coming from its address, which they are not. The Complainant is particularly concerned that other potential customers and internet users will be misled by this into believing that they are dealing with the Complainant when in fact they are potentially being defrauded. The Complainant is particularly

concerned that the conduct of the Registrant, if allowed to continue, will damage the Complainant's goodwill and reputation.

It therefore seeks to bring this dispute to an end by having the disputed domain name transferred to the Complainant to protect its good name and the integrity of its operations.

## **CONTENTIONS OF THE PARTIES**

### **A. THE COMPLAINANT**

The Complainant submits as follows:

#### **1. CANADIAN PRESENCE REQUIREMENTS**

The Complainant submits that it satisfies the Canadian presence requirement of paragraph 1.4 the Policy in view of the fact that it is the owner of a trademark which is the subject of registration in Canada under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13, namely Canadian Trademark Registration No. TMA 560389, registered April 18, 2002. The trademark remains in full force and effect.

#### **2. THE REGISTRATION OF THE DISPUTED DOMAIN NAME**

1. The disputed domain name <sapenergy.ca> was registered by the Registrant on October 1, 2019.
2. The Registrar of the disputed domain name is Domain Robot Enterprises Inc, 1100-1200 West 73rd Avenue, Vancouver BC V6P 6G5 , Canada, Email: info@domainrobot.ca.

#### **3. THE GROUNDS ON WHICH THE COMPLAINT IS MADE**

##### **Confusingly Similar**

The Complainant is the owner of the trademark for SAP which is the subject of registration in Canada under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13, namely Canadian Trademark Registration No. TMA 560389, registered April 18, 2002. The trademark remains in full force and effect.

The Complainant is the owner of the SAP trademark and has had rights in it prior to the date on which the disputed domain name was registered, namely October 1, 2019. It still has those rights in every respect.

In determining whether the disputed domain name is confusingly similar with Complainant's trademark, the ".ca" suffix should be excluded. The disputed domain name includes, in its entirety, Complainant's SAP trademark together with the additional word "energy". The

inclusion of the entire trademark in the disputed domain name raises the presumption that it will be found to be confusingly similar to the trademark, even taking account of the fact that also includes the generic word “energy”. Accordingly, the Complainant submits that the disputed domain name is confusingly similar to its SAP trademark.

Also, Complainant submits that it had its rights to the SAP trademark prior to the date of registration of the disputed domain name and that it continues to have rights in the trademark. Accordingly, the Complainant satisfies the onus placed on it by clause (a) of Paragraph 4.1 of the Policy.

### **No Legitimate Interest**

The Complainant submits that the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

The Registrant is not using the Domain Name in good faith in accordance with paragraph 3.4 of the CIRA Policy.

The Registrant does not have ownership or rights in the Mark.

The Registrant does not have a website or a legitimate business location. The address listed for the Registrant, according to WHOIS, is located at Cowichan District Hospital in British Columbia, Canada.

In addition, the phone number provided does not function. Therefore, the Registrant cannot claim to be operating in good faith.

For the reasons set out above, the Complainant submits that the Registrant has no rights or legitimate interest in the disputed domain name.

### **Bad Faith**

The Complainant submits that the Registrant registered the domain name in bad faith as described in paragraph 3.5 and generally.

In accordance in with paragraph 3.7 (c) and (d) of the Policy, the Registrant registered the disputed domain name primarily for the purpose of disrupting the business of the Complainant and to gain commercial advantage by creating a likelihood of confusion with the Complainant’s Mark.

The Complainant became aware of the domain name <sapenergy.ca> when notified by Shell Canada Limited (“Shell”) that the Registrant had impersonated a SAP SE employee and

attempted to make a purchase on Shell's mobile application. The Complainant did not authorize or give permission to the Registrant to conduct this type of transaction on its behalf.

Moreover, the disputed domain name redirects consumers to the Complainant's legitimate Canadian website, <https://www.sap.com/canada/index.html?infl=6aba8f73-3d0a-41b4-8a97-449894b27c77>. See Screenshot of SAP Canada's website as **Exhibit E**. The redirection of the Registrant's Domain Name to Complainant's website creates the false impression that email addresses originating from @sapenergy.ca are legitimate SAP SE addresses. See *Intesa Sanpaolo S.p.A v. Interex Corporate Registration Services Inc.*, CIRA Case No. 01130 (2013). Shell is a sophisticated purchaser and was not misled, but other vendors might be confused and send products or provide services to the impersonator.

For the reasons set out above, the Complainant submits that the Registrant registered the disputed domain name in bad faith.

All of the foregoing propositions are supported by previous domain name panel decisions that are cited by the Complainant and on which it relies.

## **B. THE REGISTRANT**

The Registrant did not file a Response to this proceeding.

## **DISCUSSION OF THE ISSUES AND FINDINGS**

### **1. CANADIAN PRESENCE REQUIREMENTS**

Paragraph 1.4 of the Policy provides that a complainant initiating a complaint must satisfy the Canadian Presence Requirements for Registrants in respect of the domain name that is the subject of the proceeding.

Paragraph 2 (q) of the Canadian Presence Requirements for Registrants establishes that requirement in the following circumstance:

“Trade-mark registered in Canada. A Person which does not meet any of the foregoing conditions, but which is the owner of a trade-mark which is the subject of a registration under the *Trade-marks Act* (Canada) R.S.C. 1985, c.T-13 as amended from time to time, but in this case such permission is limited to an application to register a .ca domain name consisting of or including the exact word component of that registered trade-mark;...”

The evidence, which the Panel accepts, is that the Complainant is the owner of a trademark for SAP which is the subject of registration under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13, namely Canadian Trademark Registration No. TMA 560389, registered April 18, 2002. The trademark remains in full force and effect.

The Complainant has therefore satisfied CIRA's Canadian Presence Requirement for Registrants in respect of the disputed domain name and is entitled to initiate the Complaint. With that in mind, the Panel notes that "the exact word component of that registered trademark;...", namely SAP, is included in the disputed domain name.

## **2. REGISTRATION OF THE DISPUTED DOMAIN NAME**

- (a) The domain name <sapenergy.ca> was registered on October 1, 2019.
- (b) The Complainant submits that the Registrant of the domain name is 034562 BC Ltd.
- (c) The foregoing matters were established by evidence that the Panel accepts.
- (d) The Panel will therefore proceed with this matter on the basis that the Complainant has made out its standing to file the Complaint and that the Registrant is the proper party against whom the proceeding should be brought.

## **3. GENERAL**

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

In accordance with paragraph 4.1 of the Policy, to succeed in the Proceeding, the Complainant must prove, on the 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 or generally;

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.

The Panel will now deal with each of the three elements.

### **CONFUSINGLY SIMILAR**

As the Complainant correctly submits, it is required to prove that the disputed domain name is confusingly similar to a Mark in which the Complainant had rights prior to the date of registration of the disputed domain name and continues to have such Rights. The Complainant must therefore show that it has rights to a mark, that it had those rights before the domain name was registered, that it still has them and that the disputed domain name is confusingly similar

to the mark on which it relies to establish that proposition. The Complainant submits that it can meet those requirements. The Panel agrees.

### **The Mark**

The first question that arises is whether the Complainant has a trademark on which it can rely for the purpose of this proceeding.

The Complainant relies on a Canadian trademark of which it submits it is the owner and which is the subject of registration in Canada under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13, namely Canadian Trademark Registration No. TMA 560389, registered April 18, 2002 (already defined as “the SAP trademark”). The trademark remains in full force and effect.

The Complainant has established that registration by evidence that the Panel accepts. In particular, a copy of the relevant Canadian trademark registration adduced by the Complainant in evidence is annexed to the Complaint as Annex A. The Panel also finds that the Complainant adopted the SAP trademark as its trademark in the trade and industry in question in which it is engaged from at least April 18, 2002, which was of course well prior to the disputed domain names being registered.

The question that therefore arises is whether the SAP trademark is a “mark... in which the Complainant had rights prior to the date of registration of the disputed domain name and continues to have such rights”. Bearing in mind that the Registrant registered the disputed domain name on October 1, 2019, (“the due date”) the Panel finds that the Complainant had rights in the SAP trademark from at least April 18, 2002 which was, of course, prior to the due date. The Panel also finds that the Complainant continues to have such rights.

The Panel finds that the SAP trademark is a mark as defined by Paragraph 3.2 of the Policy and that it comes within the meaning of “mark” in Paragraph 3.2 (a), as the unchallenged evidence shows that it is “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;...”.

The Panel therefore finds that the SAP trademarks is a mark in which the Complainant had rights before the disputed domain names was registered and in which it still has rights.

### **Confusingly similar**

Pursuant to paragraph 3.3 of the Policy, a domain name will be found to be confusingly similar with a mark if it so nearly resembles the same in appearance, sound or in the ideas suggested so as to be likely to be mistaken for the mark. The test to be applied when considering “confusingly similar” is one of first impression and imperfect recollection and the “dot-ca”

suffix should be excluded from consideration (see *Coca-Cola Ltd. v. Amos B. Hennan*, BCICAC Case No. 00014).

Having regard to those principles, the Panel finds that the disputed domain name is confusingly similar to the SAP trademark because it contains the entirety of the SAP trademark in the domain name, as well as the generic word "energy." The internet user would naturally conclude, because of the presence of the SAP trademark, that the domain name was related to the trademark and its owner or was being invoked by it and would see it as confusingly similar to the trademark for that reason.

Moreover, an internet user would also conclude that the idea suggested by the domain name is that it is an official domain name of the Complainant that will lead to a website dealing with the Complainant's business conducted under the SAP trademark.

Another important point must be made, because the domain name also includes the word "energy". That is a generic word. But it does not negate a finding of confusing similarity. It is a well-established principle in this field that a generic word added to a trademark in a domain name cannot avoid a finding of confusing similarity that is otherwise present, as it is in the present case. That is the approach taken regularly by panellists in this field including the present panellist. The reason is that the generic word merely colours the domain name so that the internet user is more likely to conclude that it refers to, as in the present case, the issue of energy used by or in association with the goods and services provided by the Complainant, being the owner of the SAP trademark.

Accordingly, the Panel finds that disputed domain name is, for the purposes of the Policy, confusingly similar to the SAP trademark as it so nearly resembles the mark in appearance, sound and in the ideas suggested as to be likely to be mistaken for the SAP trademark within the meaning of Paragraph 3.3 of the Policy.

Putting all of these matters together, the Panel therefore concludes that the disputed domain name is confusingly similar to the SAP trademark in which the Complainant had rights prior to the registration date of the disputed domain name and in which it continues to have such rights.

The Complainant has thus made out the first of the three elements that it must prove.

#### **NO LEGITIMATE INTEREST IN THE DOMAIN NAME**

The Complainant submits that the Registrant does not have a right or legitimate interest in the disputed domain name within Section 3.4 of the Policy. The Complainant's case in that regard is as follows.

The Registrant has registered a domain name, but that does not give the Registrant any rights or legitimate interest in respect of the domain name.

The Registrant has not been using the SAP trademark in any way that would provide legitimate rights in the domain name. It has no registered trademark corresponding to the disputed domain name and was not authorised by the Complainant to register it.

The Registrant is not using the name SAP or “sapenergy.ca” as a company name and it has no other legal rights in the name. Rather, it is the fame of the Complainants' trademark and business and the prospect of using it for an improper commercial purpose that has motivated the Registrant to register the disputed domain name.

Moreover, it is inconceivable that the Registrant could use the SAP trademark without being aware of the Complainants' rights to it, as it is prominent as a trademark and has been so for many years.

The Registrant is also wrongly using the domain name for what appears to be a fraudulent purpose and to redirect internet users to the Complainant's own website. The Panel has examined the evidence submitted to that effect and finds that it makes out the Complainant's submission. As such, on the evidence, the Registrant is neither using the disputed domain names to provide a *bona fide* offering of goods or services, nor a legitimate non-commercial or fair use as allowed under the Policy. Numerous past panel decisions have confirmed that the type of use of a domain name as the Registrant has been making of the domain name does not bestow legitimate rights or interests upon a registrant.

Moreover, redirecting an internet user to a complainant's website shows an intention to profit from the apparent goodwill of the Complainant and the confusion created by the identical nature of the disputed domain name with the Complainant's mark and this conduct does not show a legitimate interest, but the opposite.

For the reasons set out above, the Complainant has submitted that the Registrant has no rights or legitimate interest in the disputed domain name. The Panel agrees with those submissions and finds accordingly that the Registrant had no right to register the domain name and has no legitimate interest in it. The Panel also concludes that the decision cited by the Complainant is a cogent example of principles involved.

The Panel is of course also required to see if the Complainant has provided “some evidence” that the Registrant has not brought itself within any of the specific criteria in paragraph 3.4. The Panel finds that the Complainant has provided such evidence and that the evidence establishes the Complainant's case. In particular, the Complainant has shown by the evidence that, as the Complainant submitted and as the Panel agrees, the Registrant cannot have used the domain name in good faith.

The Panel has also examined each of the circumstances set out in the various sub-paragraphs of paragraph 3.4 of the Policy. It is apparent to the Panel that the Registrant could not conceivably bring itself within any of the circumstances in those sub-paragraphs. The evidence

also shows that the Registrant has in fact no such legitimate interest, for such conduct of the Registrant described above could never give rise to a legitimate interest in a domain name. It is illegal and unprincipled in every respect and cannot possibly justify the registration or use of the domain name.

Finally, and underlying all of these considerations is the fact that the Registrant had an unlimited opportunity of presenting its case, but has forfeited that opportunity by not filing a Response and has not tried in any way to show that it has a legitimate interest in the domain name.

The Complainant has thus established the second of the three elements that it must prove.

### **REGISTRATION IN BAD FAITH**

The Panel now turns to consider whether the disputed domain name was registered in bad faith. In that regard, the Panel notes that, consistent with the decision in *Canadian Broadcasting Corporation? Societes Radio-Vanada v. William Quon*, CIRA Dispute Number 00006(April 8, 2003), pp.13-14, surrounding circumstances may be considered in assessing whether the disputed domain name has been registered in bad faith.

The Complainant argues that the matter comes within paragraph 3.7(c) and (d) of the Policy as the Registrant primarily registered the disputed domain name for the purpose of disrupting the business of the Complainant and to gain commercial advantage by creating a likelihood of confusion with the Complainant's mark. The Panel has already discussed the conduct of the Registrant under the heading of rights and legitimate interests in the domain name and it is not necessary to repeat those matters here. It is sufficient to say that those facts also demonstrate that the Registrant registered the domain name in bad faith.

The Registrant tried to engage in a fraudulent transaction and, by redirecting internet traffic to the Complainant's website, tried to give the false impression that email communications emanating from the domain name were legitimate, which they clearly were not. That conduct amounts to bad faith and the Panel so finds. Indeed, the whole of the Registrant's conduct in this matter can fairly be described as being in bad faith.

The Complainant has thus made out the third of the three elements that it must establish.

### **CONCLUSION AND DECISION**

The Panel finds that the constituent elements of the Policy have all been made out and that the Complainant is entitled to the relief it seeks. The Panel will therefore order that the disputed domain name be transferred to the Complainant.

**ORDER**

The Panel directs that the registration of the disputed domain name <sapenergy.ca> be transferred from the Registrant to the Complainant SAP SE.

Date: February 18, 2020

A handwritten signature in black ink, appearing to read 'N.A. Brown', with a long horizontal flourish extending to the right.

The Honourable Neil Anthony Brown QC.