

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

Dispute Number: DCA-856-CIRA
Domain Name: fordcanada.ca
Complainant: Ford Motor Company of Canada, Limited
Registrant: Canadian Model Trains Inc.
Registrar: Internic.ca Corp.
Panelists: W.A. Derry Millar
Service Provider: British Columbia International Commercial Arbitration Centre

DECISION

THE PARTIES

1. The Complainant is Ford Motor Company of Canada, Limited., The Canadian Road, Oakville, Ontario L6J 5E4.
2. The Registrant is Canadian Model Trains Inc. 521 North Service Road East, Unit 2c, Oakville, Ontario L6N 1A5.

THE DOMAIN NAME AND REGISTRAR

3. The Domain Name in issue in this proceeding is: "fordcanada.ca".
4. The Registrar is: Internic.ca Corp. of Ottawa, Ontario.
5. The Domain Name was registered by the Registrant on November 9, 2000.

PROCEDURAL HISTORY

6. The British Columbia International Commercial Arbitration Centre ("**BCICAC**") is a recognized service provider pursuant to the CIRA Domain Name Dispute Resolution Policy ("**Policy**") of the Canadian Internet Registration Authority ("**CIRA**").
7. The Complainant filed a Complaint with respect to the Domain Name in issue in accordance with the Policy on June 2, 2005. The Complainant was reviewed and found to be compliant. By letter and email dated June 2, 2005, the BCICAC as Service Provider so confirmed compliance of the Complaint and commencement of the dispute resolution process.

8. According to the information provided by BCICAC attempts to deliver the Complaint to the Registrant by courier and e-mail have been unsuccessful.

9. The Registrant has not provided a Response. As permitted given the absence of a Response, the Complainant has elected under Rule 6.5 of the Domain Name Dispute Resolution Rules ("**Rules**") to convert from a panel of three to a single arbitrator.

10. On June 30, 2005, W.A. Derry Millar was appointed as a single panel. On July 21, 2005, the panel extended the time for delivery of its decision from July 22, 2005 to July 29, 2005 under Rule 12.2.

FACTS

11. The facts and submission set out under this heading and the heading Position of the Complainant are taken from the Complainant's Complaint.

12. The Complainant is a corporation incorporated under the laws of Ontario. It is a wholly owned subsidiary of Ford Motor Company of Dearborn, Michigan.

13. The Complainant has been operation in Canada for many decades and has been selling FORD branded cars in Canada for over a century.

14. The Complainant is the owner in Canada of various trade-mark registrations consisting of and including "FORD". The trade-mark registrations under the *Trade-marks Act* include "FORD", registration number UCA035244 registered in 1949 for use in Canada in association with, among other things, motor vehicles for which first use in Canada was 1904; and "FORD", registration number TMA101227 registered in 1954 for use in Canada in association with, among other things, automotive vehicles for which use is claimed since as early as 1904; These registrations are part of a family of trade-marks registered in Canada in association with, among other things, motor vehicles. The "Ford" script mark was registered by the Complainant in Canada on October 17, 1924. The Complainant registered the "FORD" trade-mark in Newfoundland in 1912. The registrations have been renewed.

15. The Complainant operates under the registered trade name "FORD CANADA" in Quebec, and "FORD OF CANADA" in all other provinces of Canada where trade name registration is available.

16. The Complainant states that it has been known in Canada as FORD CANADA for decades. The Complainant is commonly referred to in the press and by consumers as FORD CANADA in both English and French speaking Canada.

17. The Complainant's business name registrations are registered in the provinces indicated, since at least as early as the corresponding date:

- FORD OF CANADA, in Alberta since February 27, 1997;
- FORD OF CANADA, in British Columbia since March 21, 1997;
- FORD OF CANADA, in Manitoba since February 27, 1997;

- FORD OF CANADA, in New Brunswick since September 26, 1994;
- FORD OF CANADA, in the Northwest Territories since March 18, 1997;
- FORD OF CANADA, in Nova Scotia since September 8, 1994;
- FORD OF CANADA, in Ontario since February 26, 1997;
- FORD OF CANADA, in Prince Edward Island since September 9, 1994;
- FORD OF CANADA, in Quebec since March 13, 1997; on October 27, 2003 Ford Canada added an additional registration for the bilingual name FORD CANADA;
- FORD OF CANADA, in Saskatchewan since September 8, 1994; and
- FORD OF CANADA, in the Yukon since March 4, 1997 (see Tab 2).

18. The Complainant owns the "ford.ca" domain name. It registered the "ford.ca" domain name on November 3, 2000. The Complainant is the user of the "fordcanada.com" domain name, registered for its benefit by its parent company located in Dearborn, Michigan, Ford Motor Company.

19. Canadian Model Trains Inc. ("Registrant") is a corporation under the laws of the Province of Ontario and is in the business of selling model trains. The Registrant actively promotes its business at a website associated with the "modeltrains.com" domain name. The Registrant has no business relationship with the Complainant. It has no license to use the Ford Mark.

20. The Domain Name "fordcanada.ca" was first registered by the Registrant on November 9, 2000. According to the information provided by the Complainant, the Registrant, initially, parked the Domain Name with Intenic.ca Corp. where it remained unused (until recently).

21. The Complainant became aware of the Domain Name through routine searches. By letter dated July 23, 2004 from the solicitors for the Complainant to the Registrant, the Complainant sought to inform the Registrant of the Complainant's objections to its registration and asked the Registrant to transfer the Domain Name to the Complainant. The letter dated July 23, 2004 was undeliverable by registered mail as the Registrant had not provided correct information for the WHOIS database.

22. After numerous attempts, counsel for the Complainant was ultimately able to contact the Registrant by phone to reiterate the issues raised in the first letter. At this point, the Domain Name had never been used, and the only costs that the Registrant could have incurred in relation to the Domain Name were the annual registration fees with Intenic.ca.

23. In a phone call on September 15, 2004 with counsel for the Complainant, the president of the Registrant, Tom Tomblin, acknowledged that "Ford Canada" referred to the Complainant and stated that the Registrant had no interest in using the Domain Name. Mr. Tomblin offered to sell the Domain Name to the Complainant. When he was informed that the Complainant would not buy it, Mr. Tomblin also offered to transfer the Domain Name in exchange for \$1000 to be paid to an Oakville sports association with which Mr. Tomblin is

associated. Mr. Tomblin advised he was running for president of the association. The Complainant rejected this offer as a matter of principle.

24. The Registrant's offer and the Complainant's counter offer to pay for the transfer costs were summarized in letter dated September 30, 2004 to the Registrant. The Registrant never replied to this letter.

25. On December 30, 2004, the Registrant renewed its registration of the Domain Name for another year. At about this time, the Registrant also began linking the website associated with the Domain Name to automotive sites operated by competitors of Ford Canada and its authorized dealers. In particular, the Domain Name supports a website promoting Internic.ca, and advertising the services of "carbuyingtips.com", "auto123.com", "eBay.com", "secretsofcarbuying.com" and "automobiles.allthebrands.com". None of these listed sites are affiliated with the Complainant.

POSITION OF THE COMPLAINANT

RIGHTS OF COMPLAINANT IN THE "FORD" MARK

26. The Complainant submits that it had the rights to the trade-mark "FORD" (the "Mark") prior to the registration date of November 9, 2000 of the Domain Name "fordcanada.ca". The Ford Mark has widespread use within the Complainant's business, used either alone, in a design, in conjunction with other words, or as the primary feature of the Complainant's corporate name and business name. Canadian trade-mark registration UCA035244 for FORD, which is owned by the Complainant is based on over 100 years of use. The Complainant submits that:

- (i) The Ford Mark is a "Mark" within the meaning of paragraph 3.2(c) of the Policy.
- (ii) The Complainant has rights to the Ford Mark within the meaning of paragraph 3.3(b) of the Policy.
- (iii) FORD OF CANADA, FORD DU CANADA and FORD CANADA are all current or former registered trade names in at least one province, which are "Marks" within the meaning of paragraph 3.2(a) of the Policy.

27. The Complainant submits that the Domain Name "fordcanada.ca" is confusingly similar to the previously existing Ford Mark.

28. The Complainant submits that in establishing whether the Domain Name is confusingly similar with the Ford Mark, the test to be applied is as set out in paragraph 66 of the decision in *Re: governmentofcanada.ca gouvernementducanada.ca canadiancustoms.ca ecgc.ca publicworkscanada.ca statecanada.ca statscanada.ca theweatheroffice.ca transportcanada.ca weatheroffice.ca*, CDRP 00011 (BCICAC 27 May 2003) where the panel stated as follows:

“the test for “Confusingly Similar” under Policy paragraph 3.4 is one of resemblance based on first impression and imperfect recollection. Accordingly, for each Domain Name the Complainant must prove on a balance of the probabilities that a person, on a first impression, knowing the Complainant’s corresponding mark only and having an imperfect recollection of it, would likely mistake the Domain Name (without the .ca suffix) for the Complainant’s corresponding mark based upon the appearance, sound or ideas suggested by the Mark.”

29. The Complainant submits that using the above test, it must be found that the Domain Name is confusingly similar with the Ford Mark. The Domain Name consists of the whole of the Ford Mark, plus the word “Canada”. The Complainant is known throughout Canada as: in English, FORD, FORD MOTOR COMPANY OF CANADA, LIMITED, FORD OF CANADA, and FORD CANADA; and in French, FORD, FORD DU CANADA LIMITÉE, FORD DU CANADA and FORD CANADA. The Complainant submits that it is very likely that a person, aware of the Ford Mark, would mistake the Domain Name, “fordcanada.ca”, with the Ford Mark and believe the Domain Name was associated with the Complainant. The Complainant submits that the Domain Name so nearly resembles the Ford Mark in appearance, sound and ideas suggested by the Ford Mark, as to be likely mistaken for the Ford Mark.

30. As further evidence of the likelihood of confusion, the Complainant directed the panel to the use of the Ford Mark and the Complainant’s names on the Internet. The Domain Name consists of the Complainant’s registered trade name FORD OF CANADA without the preposition “of”. It is common for speakers, writers or Internet users to omit words such as “of”, and the Complainant is also commonly referred to as FORD CANADA. On January 25, 2005, comparative GOOGLE™ searches of the exact phrases “FORD CANADA” and “FORD OF CANADA” on the Internet showed over 18,000 hits for “FORD CANADA” and over 11,000 hits for the registered trade name “FORD OF CANADA”. A joint search of both terms produced 970 results where both “FORD OF CANADA” and “FORD CANADA” appear in the same web page.

31. On January 28, 2005, comparative GOOGLE™ searches of the exact phrases “FORD CANADA” and “FORD DU CANADA” on the Internet showed over 18,000 hits for “FORD CANADA” and over 5,000 hits for the French name “FORD DU CANADA”. A joint search of both terms produced 652 results where both “FORD DU CANADA” and “FORD CANADA” appear in the same web page.

32. The Complainant submitted that while it was not possible to check each of these hits, those that were examined all refer to the Complainant, its products, licensed dealers or affiliates.

33. The Complainant submits that it is very likely that a person aware of the FORD OF CANADA registered business name would mistake the Domain Name, “fordcanada.ca”, with the sound and idea suggested by the Ford Mark. The Complainant submits that the Domain Name is confusingly similar with the Complainant’s FORD OF CANADA previously registered trade names. The Complainant submits that the Domain Name is identical to FORD CANADA

by which the Complainant is known. Reasonable people aware of the Ford Mark assume that "fordcanada" refers directly to The Complainant.

NO LEGITIMATE INTEREST IN REGISTRANT IN DOMAIN NAME

34. The Complainant submits that, under any paragraph 3.6 of the Policy, the Registrant has no legitimate interest in the Domain Name for the reasons set out below.

35. The Complainant submits that the Registrant cannot establish any legitimate interest as set out in paragraph 3.6 of the Policy. The Registrant has never claimed a legitimate interest in the name "fordcanada". In conversations between the Registrant's president and counsel for the Complainant, the president stated the Registrant had no claim, particular interest or intent to use the Domain Name. He went on to say that he just wanted some money for the Domain Name. Furthermore, no listed principal of the Registrant is named Ford. Each of the potentially legitimate uses itemized in paragraph 3.6 includes some 'good faith' use by a registrant. In this instance, the Complainant submits that the registrant cannot establish 'good faith' or a legitimate interest because:

- (i) the Registrant had no interest in the Ford Mark, and no permission from Ford Canada to use it;
- (ii) the Registrant, initially and upon renewal, knew that the Domain Name was confusingly similar to the Ford Mark;
- (iii) the Registrant offered the Domain Name for sale to the Complainant;
- (iv) the Domain Name was used to market services in competition with the Complainant.

36. With reference to each element of paragraph 3.6 of the Policy, the Complainant submits that:

- a. the Registrant cannot have used the Domain Name in good faith under paragraph 3.6(a). The Domain Name, and any reasonable derivative thereof is not a "Mark" (as defined in the Policy) in which the Registrant has any right. The Registrant's actual business website does not relate in any way to a legitimate interest in "fordcanada". The Registrant is not a licensee of the Complainant.
- b. the Registrant cannot have used the Domain Name in good faith under paragraph 3.6(b). The Domain Name, and any reasonable derivative thereof, is distinctive, in both English and French, of the wares and services of the Complainant. The Registrant is not a licensee of the Complainant. The Registrant does not use the Domain Name in Canada in good faith in association with any wares, services or business. The Domain Name is not clearly descriptive in Canada in either English or French of (i) the character or quality of the Registrant's wares, services or business, (ii) the conditions of, or the persons employed in, performance of the services or operation of the Registrant's business; or (iii) the place of origin of the Registrant's wares, services or business. The Registrant's business website

demonstrates that neither the wares, services nor business of the Registrant can legitimately be identified as "fordcanada".

- c. The Registrant cannot have used the Domain Name in good faith under paragraph 3.6(c). The Domain Name and any reasonable derivative thereof, is not the generic name in any language of the goods and services offered by the Registrant using the Domain Name. The Domain Name consists principally of the Ford Mark, which is highly distinctive of the Complainant's products. The Domain Name is confusingly similar to the Complainant's FORD OF CANADA registered trade name.
- d. The Registrant cannot have used the Domain Name in good faith under paragraph 3.6(d). The Domain Name, and any reasonable derivative thereof, is not being used in good faith for non-commercial activity. Until December 2004, the website associated with the Domain Name was inactive. From at least as early as January 14, 2005 until June 1, 2005, the website has been used to advertise the services of other automobile manufacturers and retailers, and has been offered by the Registrant for sale to the Complainant.
- e. The Registrant cannot have used the Domain Name in good faith under paragraph 3.6(e). The name of the Registrant is listed on the CIRA WHOIS record as CANADIAN MODEL TRAINS INC. The Domain Name, and any reasonable derivative thereof, is not the name of the Registrant, but is in fact a registered name of the Complainant in the province of Quebec, and is confusingly similar to the Complainant's registered business names in the other provinces of Canada that permit such registrations.
- f. The Registrant cannot have used the Domain Name in good faith under paragraph 3.6(f). The Domain Name is not the geographical name of the location of the Registrant's non-commercial activity or place of business.

BAD FAITH

37. The Complainant submits that, under paragraph 3.7 of the Policy, the Registrant has registered the Domain Name in bad faith for the reasons set out below.

38. The Registrant's conduct amounts to bad faith under paragraphs 3.7(a) and 3.7(c) of the Policy.

39. The Complainant made numerous attempts, through its solicitors, to contact the Registrant and arrange for the orderly transfer of the Domain Name in which the Registrant had no legitimate interest. On July 23, 2004, the Complainant, through its solicitors, sent a letter to the Registrant, which detailed the Complainant's objections to the Registrant. The president of the Registrant spoke with counsel for the Complainant on September 15, 2004, at which time the Registrant attempted to sell the Domain Name to the Complainant for a price significantly higher than the cost of registering or transferring the Domain Name. In a letter dated September 30, 2004 to the Registrant, the discussion was summarized and the Complainant offered to pay the cost to transfer the Domain Name registration. The Registrant did not respond to the Complainant and did not return subsequent telephone calls.

40. Instead, on December 30, 2004, the Registrant renewed its registration of the Domain Name for another year and began to trade on the goodwill associated with the Ford Mark by advertising automotive sites operated by competitors of the Complainant or its authorized dealers.

41. Actions after initial registration and at the time of active renewal can be used to determine bad faith registration. In *Canadian Broadcasting Corporation v. Quon Re: radiocanada.ca*, CIRA-CDRP 00006 (8 April 2003), the panel held that the registrant's purpose in registering the domain names may be determined by common sense inferences from the registrant's conduct and other surrounding circumstances.

42. The Registrant engaged in bad faith under section 3.7(a) of the Policy by attempting to sell the Domain Name to the Complainant for a price in excess of the cost to register the Domain Name.

43. The Registrant engaged in bad faith under section 3.7(c) by renewing the Domain Name and changing its purpose to a commercial purpose so that competitors of the Complainant benefit from association with the Domain Name, "fordcanada.ca". From the prior statements of the Registrant's president and the Registrant's conduct, it may be inferred that the Registrant intended to disrupt the business of the Complainant.

44. The Registrant's request for money to transfer the Domain Name and its subsequent renewal of the Domain Name without legitimate interest, shows that the Registrant is acting in bad faith. The Registrant's recent use of the Domain Name to advertise the services of competitors with knowledge of the Complainant's ownership of the Ford Mark shows additional bad faith behaviour.

DECISION

45. Under paragraph 4.1 of the Policy, the onus is on the Complainant to 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 3.7;

and the Complainant must provide some evidence that

(c) the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.6.

46. Paragraph 4.1 of the Policy also provides that:

“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 3.6.”

47. In this case, the Registrant has filed no response to the Complaint and accordingly has provided no evidence of legitimate use.

CONFUSINGLY SIMILAR - PARAGRAPH 4.1 (a) OF THE POLICY

48. With respect to the definition of "Mark" in paragraph 3.2 of the Policy, the Complainant has established that:

(a) FORD OF CANADA and FORD DU CANADA are trade names used by the Complainant before the registration of the Registrant's Domain Name and are "Marks" as contemplated by paragraph 3.2(a) of the Policy. It is unclear from the evidence when the trade name FORD CANADA was adopted by the Complainant. It became a successful business name in Quebec in October, 2003. However, the Complainant states that FORD CANADA was used for many years to identify the Complainant. FORD CANADA was clearly used in the "fordcanada.com" domain name registration prior to the registration by the Registrant of the "fordcanada.ca" domain name. On balance, the panel is of the view that FORD CANADA qualifies as a Mark. Even if it did not, the other Marks identified herein are clearly Marks to which the Complainant has the rights to use; and

(b) FORD and the "Ford" design marks are registered trade-marks and are "Marks" as contemplated by paragraph 3.2(c) of the Policy.

49. The Complainant has the rights to the FORD Mark as required under paragraph 3.3(b) of the Policy.

50. The Complainant has met the onus that the Registrant's Domain Name "fordcanada.ca" is confusingly similar to the Complainant's Mark.

51. Paragraph 3.4 of the Policy defines "confusingly similar" as follows:

“(a) domain name is ‘**Confusingly Similar**’ to a Mark if the domain name so nearly resembles the Mark in appearance, sound or ideas suggested by the Mark as to be likely to be mistaken for the Mark.

52. The panel agrees with the comments of the panel in the decision in *Re: governmentofcanada.ca gouvernementducanada.ca canadiancustoms.ca ecgc.ca publicworkscanada.ca statcanada.ca statscanada.ca theweatheroffice.ca transportcanada.ca*

weatheroffice.ca, CDRP 00011 (BCICAC 27 May 2003) that the test to be applied is as follows as set out in paragraph 66 of their decision:

“the test for “Confusingly Similar” under Policy paragraph 3.4 is one of resemblance based on first impression and imperfect recollection. Accordingly, for each Domain Name the Complainant must prove on a balance of the probabilities that a person, on a first impression, knowing the Complainant’s corresponding mark only and having an imperfect recollection of it, would likely mistake the Domain Name (without the .ca suffix) for the Complainant’s corresponding mark based upon the appearance, sound or ideas suggested by the Mark.”

53. In the panel's view a person knowing the Complainant's Marks FORD, FORD DU CANADA, FORD OF CANADA and FORD CANADA only and "having an imperfect recollection of" them "would likely mistake the Domain Name" "fordcanada" "for the Complainant's corresponding mark based upon the appearance, sound or ideas suggested by the Mark."

BAD FAITH - PARAGRAPH 4.1(b) OF THE POLICY

54. In order to establish bad faith, the Complainant must establish on the balance of probabilities, one of paragraphs 3.7(a), (b) or (c) of the Policy. The Complainant has not sought to establish paragraph (b).

The introductory words of paragraph 3.7 are as follows"

For the purposes of paragraph 3.1(c), a Registrant will be considered to have registered a domain name in bad faith if, and only if:

The paragraph then goes on to set out the three types of bad faith. The applicable paragraphs are dealt with below.

REGISTRATION IN BAD FAITH - PARAGRAPH 3.7(b) OF THE POLICY

55. With respect paragraph 3.7(a), the Complainant must establish that:

(a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration.”

56. According to the information provided by the Complainant, the Registrant had simply "parked" the Domain Name with its registrar and made no use of it until after the Complainant attempted to contact the Registrant objecting to the use of the Domain Name "fordcanada.ca" by letter dated July 23, 2004 and representatives of the Complainant spoke to the president of the Registrant on September 15, 2004.

57. In the September 15, 2004, telephone call, the president of the Registrant:

- (a) acknowledged that Ford Canada referred to the Complainant;
- (b) stated that the Registrant had no interest in the Domain Name;
- (c) offered to sell the Domain Name to the Complainant for a price significantly higher than the cost of registering or transferring the Domain Name. The material provided by the Complainant does not include the amount sought by the Registrant; and
- (d) when informed that the Complainant would not purchase the Domain Name offered to transfer it for a \$1,000.00 donation to a charity with which the president of the Registrant was associated.

58. On December 30, 2004, the Registrant renewed its registration of "fordcanada.ca" and started linking the "fordcanada.ca" website to automotive sites operated by the Complainant's competitors including: carbuyingtips.com, auto123.com, eBay.com, secretsof buying.com and Automobiles.AlltheBrands.com.

59. In the panel's view, the conduct of the Registrant described in paragraphs 21, 22, 23 and 24 satisfies the requirements of paragraph 3.7 (a) of the Policy. The panel finds that the Registrant registered the Domain Name in bad faith.

REGISTRATION IN BAD FAITH - PARAGRAPH 3.7(c) OF THE POLICY

60. With respect to paragraph 3.7(c), the Complainant must establish that:

“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.”

61. As noted below, the Registrant has no legitimate interest in the Domain Name in accordance with paragraph 3.6 of the Policy. Having decided that the Registrant registered the Domain Name in bad faith under paragraph 3.7(a), it is unnecessary to determine whether the Registrant acted in bad faith under this paragraph.

**LEGITIMATE INTEREST IN DOMAIN NAME - 4.1 (c) OF THE POLICY -
LEGITIMATE INTERESTS PARAGRAPH 3.6 OF THE POLICY**

62. In the panel's view, the Registrant does not have a legitimate interest in the Domain Name as the Registrant's use of the Domain Name meets none of the criteria set out in paragraph 3.6 and the panel so finds.

63. The statements made by the president of the Registrant noted above and the use made by the Registrant of the Domain Name make it clear that the Registrant has no legitimate interest in the Domain Name.

ORDER

64. In accordance with the panel's decision, the panel directs that the registration of the Domain Name "fordcanada.ca" be transferred to the Complainant.

Date: July 27, 2005


W.A. Derry Millar