



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE

DOMAIN NAME DISPUTE

ADMINISTRATIVE PANEL

DECISION

CIIDRC case number:	20095-CDRP	Decision date: March 23, 2023
Domain Name:	dellfinancialservice.ca	
Panel:	Claire Kowarsky, LL.M. Sole Panelist	
Complainant:	Dell Inc.	
Complainant's representative:	James Green and Laurent Massam of Gowling WLG	
Registrant:	Derek Sanderson/ Island IT	

1. PROCEDURAL HISTORY

This matter is conducted pursuant to the Canadian Dispute Resolution Policy (“**CDRP**” or “**Policy**”) and the Canadian Dispute Resolution Rules (“**Resolution Rules**” or “**Rules**”) of the Canadian Internet Registry Authority (“**CIRA**”).

The disputed Domain Name was registered on October 29, 2022.

Part of the procedural history of this case was set out in a letter to the Panel from the Canadian International Internet Dispute Resolution Centre (**CIIDRC**) which mentioned:

- a) On January 30, 2023, counsel for the Complainant filed a Complaint pursuant to the CDRP and the Resolution Rules.
- b) The identity of the Registrant is not published in the public WHOIS database; therefore, the Registrant's name was not included in the Complaint.

- c) On January 30, 2023, CIRA was notified of this proceeding. On the same date, CIRA transmitted by email to CIIDRC its verification response informing who is the Registrant of the disputed domain name. CIRA also confirmed that the domain name was placed on a Registrar LOCK.
- d) On January 31, 2023, CIIDRC, as Service Provider, confirmed compliance of the Complaint and commencement of the dispute resolution process.
- e) The Complainant did not file any further submissions with respect to the issue of the Registrant's legitimate interest (or lack thereof) in the disputed domain name, as permitted by section 11.1 of the CIRA Domain Name Dispute Resolution Rules Version 1.5. 6. Per CIRA's Rule 4.3 and as the Complaint with the attachments was filed exclusively online, the Centre delivered the Complaint to the Registrant only by email to the email provided by CIRA as well as to Postmaster@dellfinancialservice.ca .
- f) On February 1, 2023, CIIDRC received correspondence from the Registrant stating: "We have removed the domain lock. Go ahead and transfer to dell. We would prefer to be paid for our registration fees".
- g) On the same date, February 1, 2023, CIIDRC inquired whether the parties were willing to settle the dispute and sent the parties a standard settlement form. On the same date, the Registrant sent a signed settlement form to CIIDRC. The Complainant did not sign the form.
- h) The Registrant failed to file its response by the due date of February 20, 2023.
- i) On February 22, 2023, CIIDRC communicated to the parties a notification of respondent default.
- j) The Complainant in this administrative proceeding has elected to have a Panel consisting of a single member.

On February 24, 2023, CIIDRC appointed me as a single-member Panel in this matter.

Part of the procedural history of this case not included in the aforementioned CIIDRC letter is as follows:

- a) The Registrant submitted several email responses to the Complaint:
 - i. On January 31, 2023 Registrant responded to the CDRP Commencement letter from CIIDRC with a "reply-all" email as follows, "They can purchase the domain and it will be transferred." Later the same day, Registrant wrote, "The domain is listed for sale on GoDaddy. Complete the needful there."
 - ii. On February 1, 2023 Registrant wrote, "We have removed the domain lock. Go ahead and transfer to dell. We would prefer to be paid for our registration fees."
 - iii. On February 22, 2023 Registrant responded to the No Response notification from CIIDRC, "We already offered to give them their domain, but pay for costs is all." Later the same day, Registrant wrote, "I don't know why everyone is ignoring me here, but I did say take the damn domain just pay for the cost of it."
 - iv. On February 24, 2023 Registrant wrote, "I have already instructed to give the domain to them. I just want the cost covered."

- b) On March 8, 2023 pursuant to the Resolution Rules Paragraph 11.1 and 9.1(b) a Panel Request for Further Submissions (“**Panel Request**”) was issued to the Parties, permitting the Complainant, within seven (7) days of such Panel Request, to file further submissions with respect to the Registrant’s legitimate interest (or lack thereof) in the disputed domain name as described in paragraph 3.4 of the Policy. As provided in the Panel Request, the Registrant had seven (7) days following any such submission from the Complainant to respond thereto.
- c) The Panel extended the deadline for its Decision by up to 14 days, to allow the parties sufficient time to file Further Submissions.
- d) On March 10, 2023, Counsel for the Complainant filed such Further Submissions.
- e) Registrant did not submit any response regarding the Complainant’s Further Submissions by the March 17, 2023 response deadline.

2. FACTS ALLEGED BY THE PARTIES

Summarized background facts as submitted by the Complainant collectively in the Complaint and Further Submissions, and not contested by the Registrant are:

- a) Dell is a world-famous technology company and owner of more than 1,000 DELL formative trademarks around the world, including in Canada. Founded in 1984, the Complainant is one of the largest technology companies in the world. The Complainant develops, sells, repairs, and supports computer hardware and software and related products and services, and has developed a family of businesses known as Dell Technologies offering products and services related to technology, software, security, and more. Worldwide, the Complainant sells its products and services in over 180 countries and employs more than 130,000 people. Among Complainant’s significant portfolio of IP assets, Complainant owns and uses the domain name www.dellfinancialservices.ca since 2004. Further, since at least 1997, Complainant has facilitated customer financing of its products and services through its Dell Financial Services business, including through its legitimate www.dellfinancialservices.ca domain name.
- b) The Domain Name redirects to Complainant’s main website for its Dell Financial Services Business, namely www.dfs.dell.com, and has never been used for an active or legitimate website.
- c) Complainant attempted to contact Registrant through CIRA’s messenger service on January 19, 2023. On the same date, Complainant’s counsel received an email from an individual “Yalchin Mammadov”, stating “We got email that you are interested in purchasing our domain. We can list it on Godaddy Auction for you. We are seeking \$3000 USD. Yalchin”
- d) The individual going by the name Yalchin Mammadov was known to Complainant, as in April and May of 2022 Complainant and Yalchin Mammadov had engaged in correspondence concerning Yalchin Mammadov’s DELL related domain name dellfinance.ca. In that correspondence Yalchin Mammadov had

offered to sell, and Complainant had agreed to buy, Yalchin Mammadov's domain name dellfinance.ca for USD \$2,500. According to the Complainant, this transaction was concluded and Yalchin Mammadov's domain name dellfinance.ca was acquired by Complainant.

- e) In the Complaint submitted January 30, 2023, Complainant asserted that Yalchin Mammadov was the registrant of the Domain Name, despite the registrant details being privacy protected in the related whois. The filing date of the Complaint was subsequent to the January 19, 2023 email from Yalchin Mammadov offering the Domain Name for sale for \$3,000.
- f) On March 10, 2023, Complainant's Further Submissions noted that the exact relationship between Yalchin Mammadov and Registrant is not known to Complainant but is known to Registrant.
- g) Neither the Registrant nor Yalchin Mammadov is licensed or otherwise authorized to use any of Complainant's DELL trademarks, and the Domain Name was registered without Complainant's permission.
- h) In the period January 31, 2023 to February 24, 2023, via several emails (as set out above) Registrant offered to transfer the Domain Name, in exchange for compensation. Complainant rejected these offers as Complainant was not prepared to provide any form of compensation for recovery of the Domain Name in the circumstances of this case.

3. CONTENTIONS OF THE PARTIES

3.1 Complainant

Complainant's contentions may be summarized as follows:

- a) Complainant submits that the Domain Name is confusingly similar to Complainant's DELL FINANCIAL SERVICES registered Canadian trademark, because it is reproduced merely with the omission of the final "s" in "Services". Further, Complainant asserts that Complainant is a famous brand in Canada and throughout the world, as a well-established business with great size and global reach, and thus the use of DELL in the Domain Name evokes the DELL trademarks and suggests an official association with Complainant.
- b) Complainant submits that Registrant has no legitimate interest in the Domain Name as described in the mentioned paragraphs of the Policy because: (i) there is no indication the Domain Name has been legitimately used as a mark with respect to paragraph 3.4(a), (ii) Registrant has not carried on any business in Canada in association with the Domain Name, (iii) no active website has been hosted at the Domain Name, but rather it redirects to Complainant's legitimate Dell Financial Services website, (iv) the prior history of the parties indicates that the Domain Name was acquired with a view to selling it to Complainant for profit which would undermine any claim by Registrant of good faith or legitimate use, (v) Registrant has not used the Domain Name in association with any goods, services or business and the Domain Name is not clearly descriptive under paragraph 3.4(b), (vi) the Domain Name is not generic of any goods, services or businesses nor was it acquired in good faith or for a bona fide purpose under paragraph 3.4 (c), (vii)

“DELLFINANCIALSERVICE” is not a legal name, surname or other reference by which the Registrant is commonly identify under paragraph 3.4(e) of the Policy, (viii) the Domain Name is not a geographical name of the location of Registrant’s non-commercial activities or place of business under paragraph 3.4(f).

- c) Complainant submits that the Domain Name was registered in bad faith as described 3.5(a) the Policy because: (i) from the evidence it is apparent or can be inferred that Registrant was aware of Complainant and its registered trademarks including the DELL FINANCIAL SERVICES trademark, (ii) the prior history of the parties, including Registrant’s representative or alter ego indicates that the Domain Name was acquired for the purpose of selling to the Complainant in excess of actual costs of registration, (iii) the Domain Name was offered for sale to the Complainant for USD \$3,000, whereas .ca domain names can be registered for as little as \$0.99 and thus the price offered far exceeded any of the Registrant’s actual costs.
- d) Complainant submits that the Domain Name was registered in bad faith as described 3.5(d) the Policy because: (i) the strength of Complainant’s DELL trademarks indicates that Registrant was attempting to attract, for commercial gain internet users to Registrant’s website by creating a likelihood of confusion as to source, sponsorship or affiliation, (ii) Complainant’s DELL trademarks are distinctive and have a strong reputation, based on the length and extent of use of the more than 1000 trademark registrations worldwide (including in Canada), and the number of countries where they are registered and used, (iii) Registrant’s actual knowledge of Complainant and its business may be inferred due to the fact that Complainant is the owner of the nearly identical www.dellfinancialservices.com domain name, as well as the fact that the Domain Name redirects to Complainant’s own Dell Financial Services website.

3.2 Registrant

The Registrant did not submit an administratively compliant Response to this proceeding. However, following the Commencement of Proceedings notification, Registrant responded to such notification in a series of “reply-all” emails as reproduced above. In these emails Registrant offered to transfer the Domain Name to Complainant in exchange for compensation. Other than the emails regarding potential transfer for compensation, no substantive response was received regarding either the Complaint or the Further Submissions.

3.3 Remedy Sought

The Complainant requests the Domain Name be transferred to it.

4. DISCUSSION AND FINDINGS

4.1 Eligibility

The Complainant is an eligible complainant under paragraph 1.4 of the Policy. Relevantly, the Policy provides “The person initiating a Proceeding (the ‘Complainant’) must, at the time of submitting a complaint (the ‘Complaint’), satisfy the Canadian Presence Requirements for Registrants (the ‘CPR’) in respect of the domain name that is the subject of the Proceeding unless the Complaint relates to a trade-mark registered in the

Canadian Intellectual Property Office ('CIPO') and the Complainant is the owner of the trade-mark". The Panel finds this eligibility requirement is met because the Complainant is the owner of related trademarks registered with CIPO, including:

Trademark	Registration No.	Registration Date	Expiry Date	Class(es)
DELL FINANCIAL SERVICES	TMA1092958	2021-02-02	2031-02-02	42
DELL	TMA357503	1989-06-23	2029-06-23	9,16, 37, 42

See, e.g. CIIDRC Case No. 18331-CDRP Xerox Corporation v Mark Cataford concerning the domain name <xerocopier.ca> where that complainant was found to be an eligible complainant, ("Complainant is the owner of CIPO Reg. No. TMA699490 for the XEROX Trademark.")

By initiated these proceedings, under s1.9(b) of the Policy Complainant "represents and warrants to CIRA and the Registrant that: (i) the Complainant satisfies the CPR at the time of submitting the Complaint **or the Complaint relates to a trade-mark registered in CIPO and the Complainant is the owner of the trademark;** and (ii) if CIRA transfers the Registration that is the subject of the Proceeding to the Complainant **at the time of transfer, the Complainant, will satisfy the CPR in respect of the domain name that is subject of the Proceeding.**" [emphasis added]

According to CIRA's CPR for Registrants paragraph 2.q. "**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.**" [emphasis added].

Here, the Panel finds the Domain Name includes the exact word component of Complainant's DELL mark, and thus the CPR is satisfied for the purpose of these proceedings.

4.2 Requirements

In accordance with Paragraph 4.1 of the CDRP, the onus is on the Complainant to prove:

- (a) That the Domain Name is Confusingly Similar to a trademark or service mark in which the Complainant has rights:
- (b) That the Domain Name has been registered in bad faith.

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and the Complainant must provide some evidence that:

- (c) That the Registrant has no legitimate interests in the Domain Name.

The Panel will consider each of these requirements in turn.

4.3 Analysis

4.3.1 That the Domain Name is Confusingly Similar to a Mark in which the Complainant has Rights

The Panel finds the Domain Name to be confusingly similar to Complainant's mark.

The Panel concludes that Complainant had rights in the DELL FINANCIAL SERVICES trademark prior to the date of registration of the Domain Name, as a result of the registration described above. Further, the Domain Name is confusingly similar thereto.

Paragraph 4.1(a) of the CDRP requires a complainant to prove "on a balance of probabilities" that "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." In this case, Complainant's Canadian DELL FINANCIAL SERVICES trademark registration number 1,092,958 (the "Trademark") was registered February 02, 2021, which is prior to the date of registration of the Domain Name on October 30, 2022. The Domain Name differs from the Trademark solely by the omission of the final "s" in the word "services". The dominant aspects of the Trademark are included in the Domain Name, such that Domain Name so nearly resembles the Trademark in appearance, sound or the ideas suggested by the Trademark as to be likely to be mistaken for the Trademark.

Accordingly, the burden of proof under 4.1(a) is met and Complainant prevails in this first element.

4.3.2 That the Registrant has No Legitimate Interest in the Domain Name

The Panel finds that the Registrant lacks legitimate interests in the Domain name.

Paragraph 4.1 (c) of the CDRP requires the complainant to "provide some evidence" that "the Registrant has no legitimate interest in the domain name as described in paragraph 3.4." Paragraph 3.4 has a non-exhaustive list of circumstances that could be used to establish the Registrant's legitimate interest as follows:

"(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 registered 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

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- business; or (iii) the place of origin of the wares, services or business;
- (c) the Registrant registered 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 the instant case, regarding legitimate interests, Registrant has not refuted or rebutted Complainant's detailed and numerous contentions regarding Registrant's lack legitimate interest in the Domain Name and supporting evidence thereof. The Panel finds that none of the six circumstances mentioned in paragraph 3.4 applies, there is no evidence that demonstrates (i) that the Registrant has a right in the domain name, (ii) Registrant has a legitimate interest in the Domain Name. See, e.g., *Six Continents Limited v. MichaelArnold (sic)*, CIIDRC Case No. 20096-CDRP ("While the Complainant has provided sufficient evidence to establish that the Registrant lacks legitimate interests in the Domain Name, the Registrant chose to not appear in this matter and, thus, failed to invoke any of the circumstances that could demonstrate legitimate interests in the Domain Name.").

As demonstrated by ample evidence provided by the Complainant that has not been rebutted by the Registrant, the Domain Name appears to solely correspond to a distinctive trademark used by the Complainant to provide financial services for Complainant's DELL products and services, and the Registrant has no apparent legitimate interest in the Domain Name.

Accordingly, the Panel finds that Complainant has met its burden of proof with respect to paragraph 4.1(c) of the Policy and therefore prevails on this element.

4.3.3 That the Registrant has Registered the Domain Name in Bad Faith

The Panel finds the Domain Name was registered in bad faith.

Paragraph 4.1(b) of the CDRP requires a complainant to prove "on a balance of probabilities" that "the Registrant has registered the domain name in bad faith as described in paragraph 3.5." Under paragraph 3.5 of the CDRP, the following "shall be evidence that a Registrant has registered a domain name in bad faith":

- "(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;

“(b) the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant’s licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names;

“(c) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant’s licensor or licensee of the Mark, who is a competitor of the Registrant; or

“(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.”

The Panel is persuaded that bad faith exists pursuant to paragraph 3.5 (a) of the CDRP. The correspondence between the parties evidences a clear intent to sell the Domain Name in excess of actual costs. Initially, in an email to Complainant’s counsel, Registrant’s representative or alter ego offered to sell the Domain Name to the Complainant for \$3,000. On January 31, 2023 Registrant themselves wrote, “They can purchase the domain and it will be transferred.”, and then later the same day, “The domain is listed for sale on GoDaddy. Complete the needful there.” It was only the next day, on February 1, 2023, that the Registrant wrote that they would be prepared to transfer the domain in exchange for the registration costs. The evidence points to at least an initial intention to sell the domain to Complainant in excess of actual costs, even if such intent waned over time.

The Panel finds less compelling Complainant’s assertion of bad faith under paragraph 3.5(d). While Registrant was clearly targeting Complainant and attempting to take advantage of the likelihood that a visitor desiring to visit Complainant’s legitimate website might type in “dellfinancialservice” instead of “dellfinancialservices”, it is unclear on the evidence what, if any, commercial gain Registrant may have had through using the Domain Name to redirect to Complainant’s legitimate website. This instant use of the Domain Name, namely to redirect to a complainant’s own legitimate site, may be distinguished from the bad faith found in *Simon Tian v. M Mohammed/ LOOL IPTV Stream Inc CIIDRC Case No 18093-CDRP* (“as contemplated in Paragraph 3.5 (d), taking into consideration the facts that Registrant copied the look and feel of Complainant’s website and retained many of the copied elements even after protest by Complainant and used the Complainant’s marks FONUS and FONUSMOBILE on its website in association with similar goods in the same channel of trade, that Registrant intentionally attempted to attract for commercial gain users to Registrant’s website by creating a likelihood of confusion with Complainant’s marks as to source or the endorsement by Complainant of Registrant’s websites or the products or services on Registrant’s websites”).

As noted above, a finding that any of the circumstances described in paragraph 3.5 applies may be sufficient evidence of bad faith. While the evidence regarding bad faith under paragraph 3.5(d) bad faith is lacking, the Complainant has nevertheless met its burden of proof regarding bad faith under paragraph 3.5(a).

As a final point regarding bad faith, Registrant has not rebutted any of Complainant's assertions. This lack of response bolsters the Complainant's case. See, e.g., *Bolloré SE v. Diesel Pro, Diesel Pro Inc CIIDRC Case No. 18330-CDRP* ("The Registrant has not responded to the allegations despite apparently receiving the notice of proceedings as required pursuant to the Rules. Had the Registrant had an affirmative defense to make to these allegations, it can be assumed that it would have made it.")

Accordingly, the Panel finds that Complainant has made out its case that the Domain Name was registered in bad faith, and thus has satisfied the requirements under paragraph 4.1(b) of the CDRP.

5 DECISION and ORDER

For the above reasons, in accordance with Paragraph 4 of the CDRP, Paragraph 12 of the Resolution Rules, the Panel orders that the Domain Name is **TRANSFERRED** to the Complainant.

Made as of March 23, 2023

SIGNATURE OF PANEL



Claire Kowarsky, LL.M

