CIIDRC case number: UDRP-6911          Decision date: 13 January 2020

Panelist:         Tina M. Cicchetti
Domain in Dispute: carpages.com
Complainant:      Autopath Technologies Inc.
Registrant:       Melanie Chapple
Registrar:        PublicDomainRegistry.com

PROCEDURAL HISTORY

1. On December 10, 2019 the above-named Complainant filed a Complaint with the Canadian International Internet Dispute Resolution Centre (“CIIDRC”), a dispute resolution service provider approved by ICANN, pursuant to the Uniform Domain Name Dispute Resolution Policy (the “UDRP Policy”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “UDRP Rules”) and the CIIDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

2. CIIDRC notified the Registrar of the disputed domain name of this proceeding on the date of the receipt of the Complaint. A Registrar lock was applied to “carpages.com” on December 11, 2019.

3. Upon review of the Complaint, CIIDRC determined that the Complaint was not in administrative compliance. On December 12, 2019, CIIDRC sent a letter to the Complainant advising of instances of non-compliance. The Complainant refiled its Complaint via online platform on December 13, 2019.

4. On December 13, 2019, CIIDRC, as Service Provider, confirmed compliance of the Complaint and commencement of the dispute resolution process.

5. Pursuant to UDRP Rule 4 and Supplemental Rule 5, CIIDRC notified the Respondent of this administrative proceeding and forwarded a Notice with login information and the link to the Complaint to the Respondent on December 13, 2019.

7. The Complainant and the Respondent in this administrative proceeding elected a single-member Panel. CIIRDC appointed Tina M. Cicchetti to act as sole arbitrator in the above-referenced matter and she provided a statement of acceptance and declaration of impartiality and independence.

REMEDY SOUGHT

8. The Complainant seeks transfer of the domain name from the Respondent to it.

FACTUAL AND LEGAL GROUNDS

9. The Complainant submits that carpages.com infringes on its registered trademarks in Canada and the United States. The Claimant states that it has been using the CARPAGES trademark in Canada and the United States since 2004 and that confusion has been experienced by customers sending communications to carpages.com instead of carpages.ca, which is the domain the Complainant currently has registered.

10. The Complainant states that it wishes to further expand its services in the United States and that it “would require ownership of the carpages.com domain” to do so.

11. The Complainant says that the Respondent is not currently using the domain name and that it is set up to redirect to carpages.co.uk, which it says is not actively in use. The Complainant has attempted to negotiate the purchase/transfer of the domain but has not received a response. The Complainant alleges that the current non-use of the domain is cybersquatting and represents bad faith use of the domain name.

POSITION OF THE PARTIES

• Complainant

• The Complainant provided evidence that it was incorporated on September 8, 2004 and that it has operated an online vehicle marketplace at carpages.ca since that time. It holds the Canadian trademark for CARPAGES, which was registered December 16, 2005 with registration number TMA655293 and the US service mark for CARPAGES, which was registered on March 26, 2013 with registration number 4308171.
The Complainant says that it plans to expand into the US market and that it requires ownership of the carpages.com domain. It contacted the Respondent in 2017 and 2018 to offer to purchase carpages.com, but did not receive a response to its inquiries.

The Complainant says that the Respondent is not actively using carpages.com, that the page redirects to carpages.co.uk, which it says is also not actively in use. The Complainant believes that the Respondent is cybersquatting.

Respondent

The Respondent submitted evidence that it has been using the CARPAGES mark in the UK since June 25, 1999, including through the use of carpages.uk.co, and claims common law protection to that trademark from that time. The Respondent owns the registered trademark for CARPAGES in the UK (registration number UK00003022572) registered December 13, 2013. The Respondent says that it acquired the rights to carpages.com in 2006 as a prudent business practice in order to protect its reputation and intellectual property in the UK. In accordance with online best practices, the carpages.com domain redirects to its carpages.uk.co page.

The Respondent denies cybersquatting and confirms the Complainant’s evidence that it received the Complainant’s requests to purchase the domain name carpages.com, but states that it is not for sale.

The Respondent claims that it has a legitimate right to use the carpages.com domain based on its own trademark in the UK and notes that its use of the mark CARPAGES in its territory predates the Complainant’s territorial 2004 Canadian trademark registration by some five years and their 2013 territorial US service mark by fourteen years. It submits that it acquired the carpages.com domain name in good faith and on a first come first served basis in 2006. The Respondent also notes that the Complainant’s marks do not offer protection in the UK. Further, the Respondent submits that it has also used the mark on social media since 2011 and that its legitimate rights extend beyond the website.

The Respondent refutes any claim of confusion on the basis that its CARPAGES website is published and hosted on servers in the UK and its principal purpose is to act as a new car buyer’s guide for buyers in the UK market. The Respondent notes that it would be clear to anyone visiting its site that its business is in the UK and that there is neither
territorial nor service overlap with the Complainant’s business. The Respondent also notes that the Complainant’s evidence demonstrates that website users from the US are successfully finding its website in Canada and that it has provided no evidence of confusion.

- The Respondent relies on the ICANN resources pages, which state that “[t]he .com domain...is a generic top-level domain originally intended for commercial businesses around the world”, to refute the Complainant’s position that there is a territorial connection to the US with a .com domain name or that its registered service mark in the US would give it the right to use the .com domain name.

- The Respondent also specifically refuted the Complainant’s allegation that carpages.co.uk was not actively in use noting that its December 2019 update marked its 20th anniversary or that it is simply cybersquatting, as alleged without evidence by the Complainant.

**REASONS**

12. UDRP Rule 4(a) requires the Complainant to prove each of the following three elements in order to be successful in this proceeding: the Respondent’s domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; the Respondent has no rights or legitimate interests in respect of the domain name; and the domain name has been registered and is being used in bad faith.

- Is the disputed domain name identical and/or confusingly similar to a trademark or service mark in which the Complainant has rights?
  - The Complainant has established that it has rights (a Canadian trademark and US service mark) to the mark CARPAGES. It has therefore established that the disputed domain name carpages.com is identical to marks in which it has rights, which is the first requirement under the UDRP Rules.

- Has the Respondent’s lack of rights or legitimate interests in respect of the domain name been proven?
  - The Complainant has alleged that the Respondent has no rights or legitimate interests in respect of the domain name carpages.com, but has failed to prove this allegation.
• In its response, the Respondent has established that it has rights to the CARPAGES mark in the UK and that it has a legitimate interest in the use of the carpages.com domain name in connection with the active and continued operation of its online car catalogue business at carpages.uk.co.

• Is registration and use of the disputed domain name in bad faith?
  • The Complainant has alleged that the Respondent has registered and used the disputed domain name in bad faith, but has failed to prove this allegation.
  • In its response, the Respondent established that it registered carpages.com on a first come first served basis in 2006 and that it has used the domain name to direct traffic to its main site carpages.uk.co in furtherance of its own legitimate business interests in the UK. There was no evidence of either registration or use in bad faith.

DECISION

13. As the Complainant has failed to establish all three elements required under the UDRP Rules, the Panel concludes that the requested relief shall be denied.

14. It is ordered that the carpages.com domain name remain with the Respondent.

Tina M. Cicchetti, Panelist
Dated: January 13, 2020