

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

Domain Names: *rsrs.ca*

Complainant: RSRS- Record Storage & Retrieval Services Inc.

Registrant: Sid Soil

Registrar: Go Daddy Domains Canada, Inc.

Service Provider: Resolution Canada Inc.

Panel: Timothy C. Bourne

A. The Parties

1. The Complainant is RSRS - Record Storage & Retrieval Services Inc. ("RSRS"), a Canadian corporation established in 1997. RSRS is based in Toronto, Ontario, Canada.
2. The Registrant is Sid Soil.

B. Disputed Domain Name and Registrar

3. The disputed domain name is *rsrs.ca* (the "Domain Name"). The Registrar with which the Domain Name is registered is Go Daddy Domains Canada, Inc. (the "Registrar"). The Domain Name was registered by the Registrant on February 17, 2010.

C. Procedural History

4. This is an administrative dispute resolution proceeding pursuant to the *CIRA Domain Name Dispute Resolution Policy*, version 1.3 (dated August 22, 2011) (the "*Policy*") and the *CIRA Domain Name Dispute Resolution Rules*, version 1.5 (the "*Rules*").
5. RSRS originally filed the Complaint with Resolution Canada Inc. (the "Provider") on May 17, 2017. The submission did not comply with the *Rules* since payment was not received. Thus the Complaint only became compliant with the *Rules* on June 12, 2017. On June 13, 2017, the Provider sent by e-mail to the Registrant English and French versions of the Notice of Complaint filed by RSRS, along with electronic versions of the Complaint and annexes thereto. The Notice of Complaint explained that the Registrant had twenty (20) days from June 13, 2017 to file a Response to the Complaint with the Provider. On June 20, 2017, the Registrant requested an extension of the deadline to file the Response. The request was declined on June 21, 2017. The Registrant then requested a document to assist with filing a Response and the Provider responded on June 22, 2017. No Response was filed by the deadline for doing so or otherwise.
6. On July 27, 2017, the Provider appointed the Panel.
7. Based on the information forwarded by the Provider, the Panel holds that all technical requirements for the commencement and maintenance of this proceeding have been established.
8. The Panel is not aware of any other legal proceeding or other arbitration in relation to the Domain Name that would create a need to alter the progress of the proceeding pursuant to paragraph 13.2 of the *Rules*.

D. Panellist Impartiality and Independence

9. As required by paragraph 7 of the *Rules*, the Panel, Timothy C. Bourne, has submitted to the Provider a declaration of impartiality and independence for this dispute.

E. Effect of Failure of Registrant to File a Response

10. Paragraph 5.8 of the *Rules* provides that “[i]f a Registrant does not submit a Response within the period for submission of a Response or any extended period... the Panel shall decide the Proceeding on the basis of the Complaint...”. Accordingly, the Panel will decide this matter based on the arguments submitted by RSRS.

F. Remedy Sought

11. In accordance with paragraph 4.3 of the *Policy* and paragraph 3.2(j) of the *Rules* RSRS has requested that the registration for the Domain Name be transferred to RSRS.

G. Applicable Law

12. In accordance with paragraph 12.1 of the *Rules*, the Panel shall apply the laws of Ontario and the laws of Canada applicable within Ontario. Also, as stated in paragraph 4.2 of the *Policy* and paragraph 3.2(m) of the *Rules*, the Panel will base this decision in accordance with the *Policy* and the *Rules*.

H. Eligibility of the Complainant

13. As the Complainant, RSRS must satisfy CIRA's *Canadian Presence Requirements for Registrants* (the "CPR"). According to the Complaint, RSRS is a Canadian corporation established in 1997. Thus RSRS qualifies as a "corporation under the laws of Canada or any province or territory of Canada" and satisfies paragraph 2(d) of the CPR. RSRS is an eligible complainant.

I. Facts

14. RSRS makes a number of unchallenged assertions, including the following:

- RSRS specializes in the field of document management and medical records services and services the healthcare and general business sectors across Canada;
- the domain name *rsrs.com* resolves to RSRS' website;
- RSRS owns trademark registration No. TMA852,485 for the trademark RSRS. According to that registration, the trademark has been used for at least some of the associated services since 1997;
- RSRS has used the trademark RSRS for its medical record management services in Canada for more than twenty years;
- RSRS has spent and continues to spend significant money and resources to develop and market the trademark RSRS across Canada;
- RSRS previously owned the registration for the Domain Name and the term of registration was inadvertently allowed to expire on February 10, 2010;

- soon after registering the Domain Name seven days later, the Registrant had the Domain Name resolve to a website operated by and which advertises the services of DOCUdavit Solutions Inc. (“DOCUdavit”), a direct competitor of RSRS in the field of document management and medical record services;
- RSRS has requested that DOCUdavit relinquish the registration for the Domain Name. The requests have been refused. Instead, the Registrant has offered to sell the registration for the Domain Name to the RSRS for sums between CDN\$7,500.00 and CDN\$10,000.00. Correspondence from the Complaint demonstrates that a representative of DOCUdavit admitted that it owns the registration for the Domain Name (in fact the Registrar has confirmed that the Registrant is Sid Soil). The correspondence also demonstrates that the same representative consulted counsel to obtain the costs of CDRP or Court proceedings with the intention of offering the registration for the Domain Name for sale at half of the costs for RSRS “to litigate”; and
- the aforementioned communications with counsel were forwarded by the representative to RSRS with a copy to the Registrant.

J. Complainant’s Contentions

i. The Domain Name Is Identical or Confusingly Similar to a Mark in Which the Complainant Has Rights

15. RSRS submits that the Domain Name wholly incorporates RSRS’ trademark RSRS and thus mirrors RSRS’ trademark.

ii. The Registrant Has No Rights or Legitimate Interests in Respect of the Domain Name

16. RSRS submits that it is not affiliated with the Registrant and did not authorize the Registrant to use its trademark or register the Domain Name. RSRS also submits that the Registrant is not and has never been a representative of RSRS and that to RSRS' knowledge, the Registrant has not ever been known as RSRS or any variation thereof. RSRS also submits that the Registrant has no rights in the trademark RSRS or the Domain Name.

iii. The Domain Name Was Registered and is Being Used in Bad Faith

17. RSRS submits that the Registrant has offered to sell the Domain Name back to RSRS for a sum in excess of the Registrant's costs to register the Domain Name. Specifically, RSRS mentions DOCUdavit's aforementioned discussions with counsel, meant to establish an offer price for selling the registration for the Domain Name.
18. RSRS also submits that as a result of the Domain Name resolving to DOCUdavit's website, the public has been misled as to the source, sponsorship or origin of the information on the website. As a result, RSRS has profited from the resulting consumer confusion. It is also submitted that the Registrant's actions are intentional and occurred with full knowledge of RSRS' ownership of the trademark RSRS.

K. Discussion and Finding

19. Paragraph 4.1 of the *Policy* provides that, to succeed, RSRS must prove, on a balance of probabilities, that:

- (a) the Domain Name is Confusingly Similar to a Mark in which RSRS 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.

20. Paragraph 4.1(c) of the *Policy* also states that RSRS must provide some evidence that:

- (c) the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.4.

L. Confusingly Similar – Paragraph 3.3 of *Policy*

- 21. To satisfy this branch of the test, RSRS must demonstrate that it has rights in a Mark that predate the registration of the Domain Name. Also, RSRS must demonstrate that the Domain Name is confusingly similar with the Mark.
- 22. RSRS references its registration No. TMA852,485 for the trademark RSRS. That registration issued on June 4, 2013. The Domain Name was registered more than three years earlier. Thus, RSRS' registered trademark rights do not predate the Domain Name registration date and RSRS' registered trademark rights are not a proper basis for finding that RSRS had Rights in a Mark prior to the date on which the Domain Name was registered.
- 23. RSRS' submissions also reference its use of the trademark RSRS in Canada. Included as an exhibit to the Complaint are magazine advertisements published in the Ontario Medical Review in 2009 (prior to the Domain Name registration date) prominently depicting a design version of the trademark RSRS. The Panel is prepared to accept, based on these submissions, that

RSRS had common law trademark rights in Canada in that design mark prior to the Domain Name registration date.

24. Paragraph 3.2(a) of the *Policy* includes the following as the definition of the term "Mark":

"a trade-mark ...that has been used by a person...for the purpose of distinguishing the...services...of that person...from the...services...of another person;"

The advertisements included within the Complaint demonstrate that RSRS had used its design version of the trademark RSRS prior to the Domain Name registration date and thus had trademark rights recognized by the *Policy* which precede the Domain Name registration date.

25. Paragraph 3.3 of the *Policy* provides that when determining whether a domain name is confusingly similar to a Mark, the Panel shall only consider whether the Domain Name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark. Thus the Panel must not conduct the confusion analysis in the same manner as would occur under subsection 6(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 by addressing all of the "surrounding circumstances" including those enumerated within that provision.
26. The Domain Name wholly incorporates the wording of the design version of the trademark RSRS used by RSRS. The design aspects of the mark used by RSRS are not significant enough to attenuate the likelihood of confusion between the mark and the Domain Name. Thus the Domain name is confusingly similar to the design version of the RSRS trademark used by RSRS prior to the date of registration of the Domain Name.

M. Bad Faith – Paragraph 3.5 of *Policy*

27. RSRS need only demonstrate bad faith under one of the grounds provided in paragraph 3.5 of the *Policy*. Thus, the Panel will address only whether bad faith exists under paragraph 3.5(d) of the *Policy*. That provision provides that the following circumstance constitutes registration of a domain name in bad faith:

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.

28. The Registrant has resolved the Domain Name to the website for DOCUdavit, a direct competitor of RSRS. As referenced above, the Domain Name is confusingly similar with RSRS' trademark RSRS, which was used in Canada prior to the date on which the Registrant registered the Domain Name. Consumers who incorporate the trademark RSRS into the associated .ca domain name within a browser will find themselves at the website of DOCUdavit, a direct competitor of RSRS. The Panel concludes that the Registrant registered the Domain Name intending to attract Internet users to DOCUdavit's website for profit and that that has occurred. The Registrant pounced upon RSRS' apparent failure to renew its registration for the Domain Name in a bald attempt to benefit financially. There is a likelihood of confusion because Internet users may presume that RSRS is the source of, sponsor, is affiliated with or endorses the DOCUdavit website and/or the services promoted thereon.

29. The Panel thus concludes that the Registrant registered the Domain Name in bad faith pursuant to paragraph 3.5(d) of the *Policy*. The Panel also is persuaded by the fact that, despite receiving notice of the Complaint, the

Registrant has not made any submissions to the Panel, including any submissions suggesting that the Domain Name is not registered in bad faith.

N. Legitimate Interest – Paragraph 3.4 of *Policy*

30. Paragraph 3.4 of the *Policy* provides that:

For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in a domain name:

- (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 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 paragraph 3.4(d) "use" by the Registrants includes, but is not limited to, use to identify a web site.

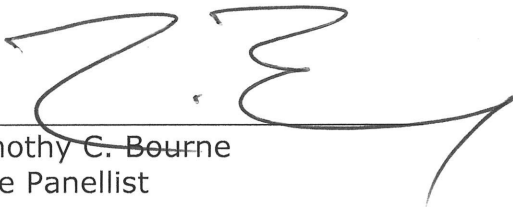
31. RSRS' unchallenged submission is that it did not authorize the Registrant to use or register the Domain Name or to use its trademark. Thus, RSRS has provided some evidence that the Registrant has no legitimate interest in the Domain Name under paragraph 3.4 of the *Policy*.
32. The Registrant clearly did not register the Domain Name in Canada in good faith. There is no evidence before the Panel that the Registrant had rights in the trademark RSRS. Additionally, the Domain Name does not clearly describe any aspect of the associated services or business, nor is there any evidence before the Panel that the Domain Name is understood to be the generic name of such services or business in any language. Accordingly, the Registrant has no legitimate interest pursuant to paragraphs 3.4(a), 3.4(b) or 3.4(c) of the *Policy*.
33. There is no evidence before the Panel that the Registrant has used the Domain Name for a non-commercial activity. Indeed, the evidence demonstrates that the Registrant used the Domain Name for profit and thus the Registrant has no legitimate interest under paragraph 3.4(d) of the *Policy*.
34. The Domain Name is not the legal name of the Registrant Sid Soil. Nor is there any evidence or suggestion that the Domain Name is a name, surname or other reference by which the Registrant is commonly identified. Thus the Registrant has no legitimate interest under paragraph 3.4(e) of the *Policy*.
35. Finally, the Domain Name is not a geographical name and thus cannot constitute the geographical name of the Registrant's place of business. Thus the Registrant has no legitimate interest under paragraph 3.4(f) of the *Policy*.

36. The Panel thus concludes that RSRS has provided some evidence that the Registrant has no legitimate interest in the Domain Name. The onus thus shifts to the Registrant to prove, on a balance of probabilities, that it has a legitimate interest in the Domain Name. The Registrant has not filed any submissions disputing the RSRS' submissions or justifying its registration or use of the Domain Name and thus has failed to meet its onus.

O. Conclusion and Decision

37. For the reasons set forth above, the Panel concludes that RSRS has established the three elements of the basis for the Complaint in accordance with their respective onuses. Thus, the Panel orders the transfer of the registration for the Domain Name to the Complainant RSRS.

August 11, 2017

A handwritten signature in black ink, appearing to be 'T.C. Bourne', written over a horizontal line.

Timothy C. Bourne
Sole Panellist