

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

Complainant: JOBRAPIDO S.r.l., 28 Via Edmondo De Amicis, 20123, Milano, ITALY

Complainant Counsel: Me Claudette Dagenais of DJB Lawyers, 10 122 St-Laurent Blvd., Suite 200, Montreal, Quebec, H3L 2N7

Registrant: Jonathan Langué, 1440 Stanley Street, Montreal, ON KOA 1A0

Disputed Domain Name: jobrapido.ca

Panelist: Paul W. Donovan

Service Provider: Resolution Canada Inc.

DECISION

The Parties

1. The Complainant is JOBRAPIDO S.r.l., 28 Via Edmondo De Amicis, 20123, Milano, Italy.
2. The Complainant is represented by Me Claudette Dagenais, DJB Lawyers, 10 122 St-Laurent Blvd., Suite 200, Montreal, Quebec, H3L 2N7.
3. The Registrant is Jonathan Langué, 1440 Stanley Street, Montreal, ON KOA 1A0

The Domain Name and Registrar

4. The disputed domain name is jobrapido.ca.
5. The Registrar with which the disputed domain name is registered is Tucows.com Co., 96 Mowat Avenue, Toronto, Ontario, M6K 3M1.

Procedural History and Rules

6. The Complainant commenced this proceeding under the Canadian Internet Registration Authority (“CIRA”) Domain Name Dispute Resolution Policy (Version 1.3) (“the Policy”) and the CIRA Domain Name Dispute Resolution Rules (Version 1.4) (“the Rules”) by a complaint dated February 13, 2012.

7. The service provider determined that the complaint was in administrative compliance with the Policy and the Rules and forwarded a copy of the complaint to the Registrant.
8. The Registrant did not file any reply to the complaint.
9. The Panel finds that it was properly constituted pursuant to the Policy and the Rules, and that all of the requirements under the Policy and the Rules for the commencement and maintenance of this proceeding have been met.

Canadian Presence Requirements

10. The Panel finds that the Complainant is an Eligible Complainant (see paragraph 1.4 of the Policy) and has met the Canadian Presence Requirements by virtue of the fact that the Complainant is the owner of the trade-mark JOBRAPIDO Design (TMA804,597, registered August 17, 2011 under the *Trade-marks Act*, R.S.C. 1985, c. T-13, as amended).

The Complaint

11. Pursuant to paragraph 4.1 of the Policy, to succeed in this proceeding the Complainant must prove, on a balance of probabilities, that:
 - (i) 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
 - (ii) the Registrant has registered the domain name in bad faith as described in paragraph 3.5 of the Policy.
12. The Complainant must also provide some evidence that the Registrant has no legitimate interest in the domain name as described in paragraph 3.4 of the Policy. Even if the Complainant proves the first two elements of the test as set out in paragraph 11, above, and provides some evidence that the Registrant has no legitimate interest in the domain name, 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.

Is the Registrant's dot-ca domain name 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?

13. The terms "Confusingly Similar" and "Mark" are both specifically defined in the Policy.

14. The Complainant has asserted rights in the JOBRAPIDO Design mark (TMA804,597).
15. The Panel finds that the Complainant has rights in a Mark as that term is defined in paragraph 3.2(c) of the Policy, which defines a Mark as including “a trade-mark, including the word elements of a design mark that is registered in CIPO”. JOBRAPIDO Design is a design mark that is registered in CIPO, and the word elements of that design mark are JOBRAPIDO.
16. The Panel finds that the Complainant has rights in the word elements of its registered trade-mark, namely, JOBRAPIDO, and that the Complainant continues to have such rights since the evidence suggests that the Complainant’s registered trade-mark is still validly registered with the Canadian Intellectual Property Office.
17. The Complainant, however, is required to show that it has rights in a Mark “prior to the date of registration of the domain name”. The Complainant’s submissions do not explicitly state when the disputed domain name was registered, but Schedule “1-C” to the complaint shows the whois.net results for the domain name jobrapido.ca. The WHOIS information for jobrapido.ca shows a “creation date” of March 13, 2011 and an “expiry date” of March 3, 2012. For the purposes of this decision, the Panel accepts that the disputed domain name was registered by the Registrant on March 13, 2011.
18. The Panel takes note of the fact that the Complainant’s trade-mark was not registered until August 17, 2011, just over five months after the disputed domain name was registered by the Registrant.
19. The Complainant’s JOBRAPIDO trade-mark was registered **after** the date on which the disputed domain name was registered and as such the Complainant cannot rely upon its registration of the JOBRAPIDO trade-mark to meet its onus. The Panel is of the view that the Complainant has the burden of proving that it has rights prior to date of registration of the domain name, and if the Complainant is relying on a **registered** trade-mark pursuant to paragraph 3.2(c) of the Policy, then in our view the Complainant’s trade-mark must have been registered prior to the registration of the domain name. We do not think that the Complainant should be able to rely on a trade-mark registration to establish its rights, yet reference some other date other than the registration date of that trade-mark for the purpose of assessing priority as against the date of registration of the domain name.
20. In light of the above findings, in our view the Complainant cannot rely solely on its Canadian trade-mark registration for JOBRAPIDO Design, since the Complainant did not have rights under paragraph 3.2(c) until August 17, 2011, which is over five months after the disputed domain name was registered by the Registrant.

21. The Panel is then left to consider whether the Complainant has established evidence of any other “Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights”.
22. Based on the information contained in the complaint, it appears that the Complainant’s trade-mark application for JOBRAPIDO Design was filed on March 9, 2009 on the basis of proposed use in Canada. The mark was advertised in the *Canadian Trade-marks Journal* on April 28, 2010 and ultimately progressed to allowance, and subsequently to registration when the Declaration of Use was filed on August 17, 2011. There is nothing in the application details by which the Panel can conclude that the Complainant had rights in the Mark prior to the registration of the domain name (March 13, 2011). In the Panel’s view, a pending trade-mark application based on proposed use in Canada is insufficient for the purposes of establishing rights in a Mark. The word “Mark” is a defined term (see paragraph 3.2 of the Policy) and the various subsections require one or more of the following (a) use in Canada of a trade-mark, (b) use in Canada of a certification mark, (c) a trade-mark that is registered in CIPO, or (d) a badge, crest, emblem or mark pursuant to paragraph 9(1)(n) of the *Trade-marks Act*.
23. The complaint does make the following assertion: “The Complainant operates a job search website in 50 countries. Currently the Canadian site of JOBRAPIDO is accessible under <http://ca.jobrapido.com>”. The Complainant does not indicate when the Canadian site was active in Canada and does not provide any evidence relating to the website and / or to the use of the Mark in Canada. The Panel concludes that the Complainant has not met its burden in showing any use in Canada of the Mark, as per paragraph 3.2(a) of the Policy, and no evidence was introduced by the Complainant with respect to paragraphs 3.2(b) and (d) of the Policy.
24. Had the Complainant been able to establish its Rights prior to the date of registration of the domain name, and if the Complainant had established that it continues to have such rights, the Panel would have found that the disputed domain name is Confusingly Similar to the Complainant’s JOBRAPIDO Mark. The definition of “Confusingly Similar” is expressed at paragraph 3.3 of the Policy: “In 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 as to be likely to be mistaken for the Mark”.
25. The Panel finds that not only does the domain name “so nearly resemble” the Complainant’s Mark, in fact it is identical. There is no question that the domain name and the Mark are Confusingly Similar as said term is defined in the Policy.

26. However, based on a review of the evidence submitted, in the Panel's view the Complainant has **not** met its burden of establishing that it had Rights in the Mark JOBRAPIDO **prior to the date of registration of the domain name.**
27. Since the Complainant has not met its burden in terms of paragraph 3.1(a) of the Policy, the Panel finds it unnecessary to consider whether the Registrant has no legitimate interest in the domain name (as that term is described in paragraph 3.4 of the Policy) or whether the Registrant has registered the domain name in bad faith (as that term is described in paragraph 3.5 of the Policy). The Panel would note that the Complainant has also asked for the following relief: "Moreover given the Registrant's evident bad faith the Complainant is seeking costs associated to these proceedings". The Panel notes that it has no authority under the Policy and the Rules to award costs to the Complainant, and therefore refuses this request.

Summary of Findings

28. The Panel has found that the Complainant has **not** proven, on a balance of probabilities, 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 domain name and continues to have such rights. As such, the Panel **rejects** the request to transfer the disputed domain name to the Complainant pursuant to section 4.3 of the Policy, and dismisses the Complaint.
29. Further, the Complainant's claim for costs is refused.

DATE: April 20, 2012

Paul W. Donovan, B.A., M.A., LL.B.
Lawyer / Trade-mark Agent