



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE
DOMAIN NAME DISPUTE
ADMINISTRATIVE PANEL
DECISION

CIIDRC case number:	20094-CDRP	Decision date: February 26, 2023
Domain Name:	<rocketsoft.ca>	
Panel:	María Alejandra López García	
Complainant:	Rocket Software, Inc.	
Complainant's representative:	Miguel Danielson of Danielson Legal LLC	
Registrant:	Privacy Guardian	

1. PROCEDURAL HISTORY

The procedural history of this case was set out in a letter from the CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE (the "CIIDRC") to the Panel, as follows:

On January 24, 2023, the Complainant filed a Complaint with the CIIDRC pursuant to the Canadian Internet Registration Authority ("CIRA") Domain Name Dispute Resolution Policy (the "CDRP") and the CIRA Domain Name Dispute Resolution Rules (the "Resolution Rules").

On January 24, 2023, CIRA was notified of this proceeding. On the same date, CIRA transmitted by email to CIIDRC its verification response informing that the Registrant of the disputed domain name was "Privacy Guardian". CIRA also confirmed that the <rocketsoft.ca> domain name (the "Disputed Domain Name") was placed on a Registrar LOCK.

On January 26, 2023, CIIDRC, as Service Provider, confirmed compliance of the Complaint with CIRA's requirements under Resolution Rules 3.2 and commencement of the dispute resolution process.

Pursuant to Resolution Rules 4.4, CIIDRC notified the Registrant of this administrative proceeding and forwarded a Notice of commencement of the administrative proceeding with the Complaint and its Annexes to the Registrant via email on January 26, 2023.

As the Complaint with the attachments was filed exclusively online, the CIIDRC delivered the Complaint to the Registrant only by email to the address provided by CIRA as well as to 'postmaster@rocketsoft.ca'. Furthermore, pursuant to Resolution Rules 2.1, where "the Provider, shall use whatever reasonably available means are likely to give actual notice to the Registrant", the CIIDRC attempted to mail the documents to the Registrant's Organization website, identified by CIRA as "PrivacyGuardian.org".

Pursuant to the second Paragraph 11.1 of the Resolution Rules: "where the Registrant's identity is not published in the public WHOIS database, the Complainant shall have a right to make a further submission to the Panel, including adducing further evidence, with respect only to the issue of the Registrant's legitimate interest (or lack thereof) in a domain name."

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 Resolution Rules.

The Registrant failed to file its response by the due date of February 15, 2023.

The Complainant in this administrative proceeding has elected for a Panel consisting of a single-member. CIIDRC appointed María Alejandra López García as a single-member Panel in this matter on February 21, 2023.

The Disputed Domain Name was registered on **September 30, 2022**, and by the time of this Decision resolves to an inactive website.

This matter is conducted pursuant to the CDRP and the Resolution Rules.

2. FACTS ALLEGED BY THE PARTIES

The Complainant is a North American technology, company. In 1990 the Complainant created a new type of software for company, identified under the Trademark ROCKET Software, for use in association with computer programs, network operating system programs, computer programs instruction manuals, computer education training services and technical support services. The Complainant has been using its Trademark ROCKET extensively and continuously in connection with identifying its goods and services, in the advertising and promotion of its goods and services, and in other ways customary in the trade, to promote its goods and services throughout Canada, the United States, and internationally.

The Complainant has more than 2,600 global employees; more than 10 thousand customers. Apart from its ROCKET Trademarks, the Complainant owns the following domain names <rocketsoftware.com> since November 15, 1995; <rocketsoft.com> since October 7, 1999; <rocketsoft.us> since April 24, 2002.

The disputed domain name <rocketsoft.ca> was registered on **September 30, 2022** and apparently until October 14, 2022 resolved to an active website, which content is almost identical to a third-party website being 'https://capitalstars.ca', identified as Capital Stars Technologies.

Additionally, the Complainant described the use of the Disputed Domain Name email address associated to fraudulent email correspondence as well as job listings and communications associated with job listings.

3. CONTENTIONS OF THE PARTIES

- **Complainant**

- The Complainant states that it has been in the market for more than 30 years; that it is the owner of common law rights as well as multiple trademark registrations worldwide for marks containing or consisting of ROCKET for use in association with computer programs, network operating system programs, computer programs instruction manuals, computer education training services and technical support services; and that it has been using it as a source of its goods and services related to computer software and related goods and services throughout Canada, the United States, and internationally.
- The Complainant states that its trademarks have been registered in Canada at the Canadian Intellectual Property Office ("CIPO"), as early as January 21, 2020, with common law rights extending even earlier. Specifically, the Complainant states that is the owner of the Canadian Trademark Registration No. TMA1070366, for the mark ROCKET. Also, the Complainant states that owns several Trademark Registrations in the United States for the mark ROCKET, one of which was registered June 2, 1992, and had a first use in commerce at least as early as October 31, 1990.
- The Complainant states that the rights over the term ROCKET predate registration of the disputed domain name <rocketsoft.ca>, which was registered September 30, 2022.
- The Complainant contends that the disputed domain name is confusingly similar to the Complainant's domain name for its primary website, <rocketsoftware.com>; that the Disputed Domain Name <rocketsoft.ca> uses Complainant's registered trademark ROCKET without authorization in the Domain Name, and copies Complainant's name and domain name except for the last 4 letters ("rocketsoftware" vs. "rocketsoft"); that the similarity of the domain names and the association with Complainant's registered trademarks is likely to confuse and mislead consumers into thinking Complainant is somehow affiliated with or sponsors the website.
- The Complainant contends that the Registrant has no rights or legitimate interests with respect to the disputed domain name, due to it is not affiliated with Complainant in any way; that no authorization has been given to the Registrant to use its Trademark in any manner, nor to register a domain name encompassing Complainant's trademark; that furthermore, the Registrant knowingly violated

Complainant's rights by incorporating Complainant's trademark in the Disputed Domain Name, on the website hosted by the Disputed Domain Name, and on email communications from the Disputed Domain Name, all for illicit activities that further violate Complainant's rights.

- The Complainant contends that the Disputed Domain Name resolves to a website that has nearly identical content as a third party, Capital Stars Technologies <capitalstars.ca>, and that the only differences between the content on the sites appears to be the addition of Complainant's Trademarks, and another company's contact information.
- The Complainant contends that the Registrant made use of its former logo used with its business since 1996, registered in Canada at the CIPO under Registration No. TMA1070370, filed on February 24, 2017 and granted on January 21, 2020, in the Disputed Domain Name's website.
- The Complainant contends that the Disputed Domain Name has been used for fraudulent email correspondence as well as job listings and communications associated with job listings on the service Indeed.com. That specifically, on October 5, 2022, the disputed domain name <rocketsoft.ca> was used to send an email from 'hr@rocketsoft.ca' to an unsuspecting job seeker offering a job at Registrant's company. That, in the subject line the Respondent used Complainant's name and the email is signed by Ashley Dora who lists Complainant's name in her signature, pretending to work for the Complainant as a Human Resource Specialist. That in addition, a fraudulent LinkedIn profile was created for Ashley Dora as well, falsely identifying her as an employee of Complainant to give legitimacy to the communications; LinkedIn has since removed the fraudulent profile.
- The Complainant contends that On October 7, 2022, the Disputed Domain Name <rocketsoft.ca> was used to send another email from 'hr@rocketsoft.ca', allegedly from Ashley Dora to another job seeker. That, this time the email used one of the Complainant's logos, which is also a registered trademark, in the body of the email and Ashley Dora continued to be held out as Complainant's Human Resources Specialist. That, this second job seeker was offered a job and received a subsequent email which stated "You need to provide your bank account details including", "holder name," "bank name," "email address associated with the account," "phone number," whether the jobseeker had ever used "an electronic (Interac) transfer," and whether they have "active online banking." A third email was sent providing the same job seeker with instructions to download Telegram messenger and indicating that a Bitcoin wallet had been set up for the job seeker. It further described a process for filling said wallet including receiving money through the Interac system into the job seeker's bank account, cashing out the amount and then purchasing Bitcoin for the company-provided wallet and sending a photo to HR.
- The Complainant contends that on October 14, 2022, a fourth job seeker contacted the Complainant and provided copies of similar email communications related to a job offer from Ashley Dora and next steps requesting bank information and purchase of bitcoins. That, this job seeker also provided a copy of the

Employment Contract sent from Ashley Dora, posing as HR Specialist for Complainant, via the Disputed Domain Name. That the Employment Contract includes a seal with Complainant's name and a Canadian Business Number 859899783. That upon verification in the Canadian Federal Corporation Information database, this Canadian Business number belongs to an unrelated third party named Rocket Fireworks, Inc. That the fourth job seeker also provided evidence that the same Ashley Dora was listed as the contact for two other companies Shine Talent Group and Midland Inn & Suites which reached out to the job seeker via Indeed with nearly identical messages and job details. That there is no evidence of the Respondent's use of, or preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, and the Respondent is not making a legitimate non-commercial or fair use of the domain name, suggesting that there cannot be any respondent rights or legitimate interests.

- The Complainant contends that the Disputed Domain Name was registered in bad faith according to paragraph 3.5(d) of the CDRP. That, the fact that the Disputed Domain Name was created on September 30, 2022, only six days before the first jobseeker contacted the Complainant, suggests pre-planned activities. That those, taken together with the website hosted by the Domain Name, communications via email addresses associated with the Disputed Domain Name, use of Complainant's trademarks to give the appearance of being or associating with Complainant, and the communications falsely claiming to be sent by an employee of Complainant, further demonstrates a premeditated, intentional effort by Registrant to confuse the public as to the source of the goods, services, and communications. Additionally, job seekers who contacted Complainant to inquire whether the job offer was legitimate or a scam indicated that they had provided personal identification information including social security number, bank information, and their bank pin number. That these are not just job seekers but victims of fraud being perpetrated by the use of the Disputed Domain Name.

- **Registrant**

The Registrant did not reply to any of the Complainant's contentions.

- **Remedy Sought**

The Complainant requests the Disputed Domain Name <rocketsoft.ca> be transferred to it.

4. DISCUSSION AND FINDINGS

4.1 Eligibility

Paragraph 2 of CIRA Canadian Presence Requirements for Registrants, Version 1.3, establishes that:

“On and after November 8, 2000 only the following individuals and entities will be permitted to apply to CIRA (through a CIRA certified registrar) for the registration of, and to hold and maintain the registration of, a .ca domain name:

(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).

Paragraph 1.4 of the CDRP, establishes that:

“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 Complainant has provided sufficient evidence that is the Trademark Owner of the term ROCKET, Reg. No. TMA1070366, filed on February 24, 2017, registered on January 1, 2020 (and in force until January 1, 2030) in the CIPO, which is reproduced in the Disputed Domain Name.

Therefore, the Complainant satisfies the Canadian Presence Requirements under section 1.4 of the CDRP.

4.2 Requirements

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

(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 3.5;

and the Complainant must provide some evidence that:

(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4. Once that is done, the onus shifts to the Registrant to prove, on a balance of probabilities, that the Registrant has a legitimate interest in the Domain Name as described in paragraph 3.4 of the CDRP.

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

According to the evidence submitted, the Complainant has sufficiently proved its prior Trademark Rights over the Canadian Trademark ROCKET, Reg. No. TMA1070366, filed on February 24, 2017, registered on January 1, 2020 (and in force until January 1, 2030) at the CIPO.

Paragraph 3.3 of the CDRP, 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.

If this first element is analyzed under the analogous to the CDRP, the Uniform Domain Name Dispute Resolution Policy (“the UDRP”) criteria (see *Nanaimo Airport Commission, Nanaimo, Canada vs. Chris Stewart*, CIIDRC Case No. 17100-CDRP), the Disputed Domain Name <rocketsoft.ca>, will be the result of the composition of the Complainant’s Trademark ROCKET, plus a generic word as “soft”, which on this Case infers the word “software”, being intrinsically related to Complainant’s business activity, protected goods and services, and where Complainant’s Trademark ROCKET it “is recognizable within the disputed domain name the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.” (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”)).

In relation to the country code top level domain (ccTLD) ‘.ca’, as defined by paragraph 1.2 of the CDRP, for the purpose of this proceeding, is excluded.

By applying these tests, the Panel finds that the Disputed Domain Name <rocketsoft.ca> is confusingly similar to the Complainant’s ROCKET Trademark.

Therefore, the Complainant has satisfied this requirement.

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

According to paragraph 3.4 of the CDRP, 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

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- 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.

According to the facts and evidence submitted by the Complainant to this Panel, it is clear that the Registrant is not affiliated to the Complainant, nor has been licensed, or even authorized in any manner by the Complainant to register the Disputed Domain Name <rocketsoft.ca>, nor has Rights over the ROCKET Trademark, and even less is commonly known by the term <rocketsoft.ca>.

Furthermore, the content of the website apparently until October 14, 2022 (despite the current inactive use), plus the entire use of the Disputed Domain Name's email address, described by the Complainant (which involves selection and registration of a Domain Name based on Complainant's Registered Trademarks, including in Canada; non legitimate job offers; fraudulent scam email correspondence; and phishing activity), "where such use was held to be fraudulent, and inapt to form a basis for a claim to a right or legitimate interest" (see *Samsung Electronics Co., Ltd. v. Albert Daniel Carter*, WIPO Case No. D2010-1367) confirms without hesitation to this Panel that the Disputed Domain Name was not registered by the Registrant in good faith in association with a non-commercial activity. Facts that were not rebutted by the Registrant at any moment of the present Dispute.

In accordance to paragraph 4.1(c) of the CDRP, the Complainant has provided sufficient evidence, succeeding on this requirement.

Therefore, this Panel finds that the Registrant has no legitimate interest in the Disputed Domain Name, and in consequence the Complainant has satisfied this requirement.

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

According to paragraph 3.4 of the CDRP, for the purposes of paragraphs 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, 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 e.g.:
- 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.

In accordance to the evidence submitted to this Panel, the Registrant has failed into paragraph 3.5(d) of the CDRP.

The Complainant has been operating its business under the Trademark ROCKET, since **October 31, 1990** (e.g.: US Trademark Registration ROCKET, Reg. No.1,690.753, First Use in Commerce: October 31, 1990; granted on June 2, 1992, and in force until June 2, 2032; US Trademark Registration ROCKET AND DESIGN, Reg. No. 3271565; First Use in Commerce: October 31, 1990; granted on July 31, 2007, and in force until July 31, 2026). The Complainant has acquired its Registered Trademark Rights in Canada on **January 1, 2020** (and in force until January 1, 2023). Complainant's Trademark ROCKET, has been used it as a source of its goods and services related to computer software and related goods and services at a worldwide level, including in Canada, and in the United States.

As indicated along this Decision and in accordance to the Whols, the Disputed Domain Name <rocketsoft.ca> was registered on **September 30, 2022** by the Registrant, meaning to this Panel, and well supported by the Domain Name Jurisprudence (see section 3.2.1 of the WIPO Jurisprudential Overview 3.0; and Paragraph 3.2(I) of the Resolution Rules) that the Registrant "knew or should have known" about Complainant's business and Trademark value at the moment of the Disputed Domain Name's registration.

Furthermore, the entire Registrant’s illegitimate activity towards the use of the Disputed Domain Name’s email address (as selection and registration of a Domain Name based on Complainant’s Registered Trademarks, including in Canada; non legitimate job offers; fraudulent scam email correspondence; and phishing activity), leaves no trace of doubt in this Panel, to conclude that the Registrant registered the Disputed Domain Name with Complainant’s Trademark on mind.

Based on all the above, this Panel concludes that the Disputed Domain Name has been registered in bad faith. Therefore, the Complainant has satisfied this requirement.

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 Disputed Domain Name <rocketsoft.ca> be transferred to Complainant.

Made as of **February 26, 2023**

SIGNATURE OF PANEL



María Alejandra López G.

