

DOMAIN NAME DISPUTES IN CANADA: CONSIDERATIONS FOR NON-CANADIAN ENTITIES

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For non-Canadian companies looking to do business in Canada, securing a “.ca” domain name should be a natural part of their intellectual property strategy. The recent domain name dispute in Trucksuite LLC v Paul Donofrio et al, [CDRP Decision 00440](#) (“**Trucksuite**”) is another illustrative example of this point.

Trucksuite LLC (“**Trucksuite**”) had been operating in its home jurisdiction (U.S.A.) for a period of time, and had been using the trademark TRUCKSUITE in its home jurisdiction. Trucksuite had not done business in Canada, but nevertheless had plans to expand into Canada. Trucksuite had not registered the TRUCKSUITE trademark in Canada either. In anticipation of its expansion into Canada, Trucksuite engaged a Canadian company, Paul Donofrio et al. (“**Donofrio**”), with the intention that Donofrio would eventually become Trucksuite’s Canadian business arm or form a substantial part of Trucksuite’s Canadian business operations.

During the negotiations between Trucksuite and Donofrio, Donofrio registered the “.ca” domain name [www.trucksuite.ca](#) (the “**Domain Name**”) to ensure that such domain name was no longer available for registration by third parties in Canada. Unfortunately, negotiations between Trucksuite and Donofrio ultimately broke down. Donofrio continued to be listed as the registrant of the Domain Name, and Trucksuite advanced a complaint pursuant to the [Canadian Internet Registration Authority’s](#) (“**CIRA**”) [Dispute Resolution Policy](#) (the “**Policy**”) to contest Donofrio’s continued ownership of the Domain Name.

Background on the Policy and the Rules

Complaints involving “.ca” domain names in Canada are commonly initiated under the Policy and subject to the CIRA [Dispute Resolution Rules](#) (the “**Rules**”). Such proceedings are generally appropriate when the matters at hand are straightforward (e.g. no contractual disputes between the parties, no complicated relationship between the parties). Matters involving convoluted fact patterns are better reserved for the court system through which remedies/orders involving domain name transfers may be obtained.

Only “**Eligible Complainants**” may initiate “.ca” domain name complaints pursuant to the Policies and Rules. Per the Policy, an “Eligible Complainant” is one who:

- satisfies a [Canadian presence requirement](#) (e.g. Canadian citizen, Canadian permanent resident, a corporation existing under the laws of Canada or a province within Canada, a trust established under the laws of Canada or a province within Canada); OR
- owns a [Canadian trademark registration](#) for the trademark that has been incorporated into the “.ca” domain name in dispute.

In order for an Eligible Complainant to succeed in such proceedings, the panel hearing the complaint would need to find on a balance of probabilities that: (i) the “.ca” domain name in dispute is confusingly similar to the complainant’s trademark, and the complainant had rights in and to the trademark prior to the date of registration of the “.ca” domain name in dispute and continues to have such rights; (ii) the “.ca” domain name in dispute was registered in bad faith; and (iii) the registrant of the “.ca” domain name in dispute had no legitimate interests in the “.ca” domain name in dispute.

Trucksuite

Satisfying the “Eligible Complainant” requirement is often a hurdle for non-Canadian entities who have plans to expand into Canada but have not done any business in Canada or have not taken preliminary steps to protect their trademarks in Canada. This was also an issue for Trucksuite in the Trucksuite decision. Because Trucksuite was unable to establish that it had a Canadian presence or that it had a Canadian trademark registration for the trademark TRUCKSUITE, which was incorporated into the “.ca” domain name in dispute, the panel hearing the complaint ruled that Trucksuite did not satisfy the criteria of an “Eligible Complainant” (as defined under the Policy) and therefore did not have standing to initiate a “.ca” domain name complaint under the Policy and Rules.

Take-Aways

Expansion is a natural and organic part of any business. Below are some points that non-Canadian businesses planning to expand their operations into Canada may wish to consider in order to better protect their intellectual property interests in Canada and better position themselves in the Canadian market:

- plan ahead and apply to register your trademark in Canada early. As of the writing of this bulletin, the trademark application process in Canada is long (i.e. generally over two years from filing to registration). Note that there is no requirement to provide a statement of use of the trademark in Canada in order to secure a registration for the trademark.
- when eligible to do so, register “.ca” domain names that may be valuable to your business. The “.ca” domain is the top-level domain in Canada, and commonly used by businesses operating within Canada.
- prior to advancing a domain name dispute, consider the forum. If the facts of the matter are relatively

straightforward, then advancing a complaint pursuant to the Policy and Rules may be appropriate. However, if the facts are, or the relationship between the relevant parties is, convoluted or if the domain name is one of many issues requiring resolution between the relevant parties, then consider seeking remedies/orders related to the domain name as a part of a greater court action or application.

by Pablo Tseng

A Cautionary Note

The foregoing provides only an overview and does not constitute legal advice. Readers are cautioned against making any decisions based on this material alone. Rather, specific legal advice should be obtained.

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