



## ARE YOU MASTER OF YOUR DOMAIN?

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A company may get into trouble if it does not adequately protect its domain names, which have become critical extensions of its names, trade-marks, projects and business places on the Internet.

Domain names are ubiquitous on the Internet, because they are part of what allows users to find their destinations. We see them after the "@" symbol in email addresses and following the "www." in web addresses. They are scarce resources because, on a worldwide scale, there can only be one holder for any given domain name. This scarcity creates a market for their registration, even to the extent that those that have an intrinsic value are prime targets for speculation, auctions and sometimes cybersquatting and misappropriation.

### Where domain names come from?

Unlike "pure" intellectual property rights (patent, copyright, trade mark, industrial design, etc.), there is no Canadian statute specific to domain names.

One acquires a right in a domain name in a manner similar to a phone number: by a service contract with a supplier, which gives to the customer exclusivity on use of the domain name in exchange of an annual fee. If a domain name is not yet registered, anyone can register it through the registrar of his choice.

For each type of domain name (such as .com, .ca or org), there is only one registry and one registry operator, but several registrars accredited by the registry operator. A registrar can be accredited for several types and deals with registrants.

### Why register a domain name?

A domain name can be used in conjunction with website and email addresses. Even if you do not intend to use a domain name actively or immediately, registering it will prevent anyone from using it and may deter third parties from adopting a name or a

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trade-mark corresponding to the domain name due to the mere fact that it is no longer available as a domain name.

### How to protect your domain names?

Your organization should conduct audits and, where necessary, adopt appropriate measures in response to the following questions:

1. Has it a complete, centralized and up-to-date list of all the domain names that were registered by all its constituents (departments of marketing, IT, legal affairs, research and development, etc.)?
2. Would it be vulnerable to potential extortion by the individual acting as administrative contact for domain names used in Internet communications if relations with that individual deteriorate?
3. Does the email address entered in the domain name record to receive the notices from the registrar correspond to the address of an individual who may not be responsible for the domain name when it will be up for renewal (sometimes as long as ten years from now)?
4. Are all the organization's domain names registered under its corporate name, or are some of them registered under other names (e.g. under the name of an employee, a consultant or the agency that created the website to which the domain name must lead)?
5. Are the domain names' records managed through a single registrar with facilities located in Canada?
6. Could a disgruntled employee, who does not have access to passwords for changes to the domain names' records or their transfer to a third parties, obtain them secretly without permission?
7. Does the organization have a policy allowing it to determine which domain names it should register, recover, renew or abandon?

If your organization cannot give a proper answer to any one of these questions, a review of its domain name portfolio would be appropriate.

### Who is the holder of a domain name?

To find the identity of a domain name registrant, you can perform a WHOIS search, in the registry corresponding to the type of domain name. The "administrative contact"

in a domain name record is the primary contact for the domain name. The administrative contact can be the registrant or any other person authorized by him to act on his behalf regarding this domain name.

However, there are situations where information about the registrant or the administrative contact is hidden, incomplete or erroneous. For those cases, advanced search methods do exist.

In the case of .ca domain names, the Canadian Internet Registration Authority requires that the registrant meets the Canadian presence requirements. For example, a company cannot hold a .ca domain name if it is not incorporated under a Canadian law, unless it owns a trade-mark registered in Canada and the domain name consists of or includes the exact word component of that registered trade-mark.

### **How can one recover a domain name?**

To acquire rights in a domain name that is registered by someone else, you could consider negotiation, arbitration or delayed reservation. The current registrant could hold the domain name in good faith or could be a cybersquatter looking for financial gain by transferring "your" domain name to you. Before acting, however, one must carefully assess the situation to avoid that the position taken in a first communication with the owner decreases the chances of recovering the domain name.

When dealing with a registrant to buy his rights in a domain name, if he requires a payment before the transfer, it is usually preferable to use an escrow agent (similar to what is done for sales between individuals through online platforms such as eBayTM), which help to secure the transaction for both parties.

### **What does the future hold?**

We will soon see an increase in these types of new suffixes such as .app, .book, .blog, .expert, .homes, .news, .online, .browser, .shop, .site, .sites, etc. which will coexist with to the usual .com, .ca and .org.

Companies that own registered trade-marks should consider submitting them to the validation process of ICANN's Trademark Clearinghouse, which provides a priority for registration of these new types of domain names and ensures that any third party who requests registration of a domain name corresponding to a trade-mark validated by ICANN be notified that such trade-mark exists, and the trade-mark owner be notified that a third party applied for the registration of a corresponding domain name.

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