

A Cause for Concern to Geo-domain Name Owners? CIRA Orders Transfer of "niagararegion.ca" to Municipality

~ David Schnurr ~

The term "geo-domain name" refers to a domain name that includes the name of a geographic entity, such as a city or country. Pursuant to its Reserved Names Policy, the Canadian Internet Registration Authority (CIRA) maintains a list of geo-domain names that are reserved for the exclusive use of provinces, municipalities and other government entities. This list includes the names, and all abbreviations of names of all Canadian provinces and territories, as well as the names of cities, towns, villages, and other municipal areas, which names are maintained in the Canadian Geographic Names Database (CGNDB).

Owing to the fact that geographical names are limited in number and have instant name recognition, geo-domain names represent a highly valued Internet commodity. Accordingly, and in an apparent attempt to flout the CIRA's Reserved Names Policy, resourceful domainers have successfully registered geo-domain names consisting of combinations of words containing the name of a city or town (e.g., <torontocity.ca>) or the names of geographical areas that are not expressly covered in the CGNDB (e.g., <waterlooregion.ca>). Following the recent CIRA decision in *Niagara (Regional Municipality) v. Vail*,²⁷ domain name owners may need to be concerned about the legitimacy of their rights in their geo-domain names.

John Vail (the Registrant), a real estate agent, registered the domain name <niagararegion.ca> in 2000, and used the domain name to redirect Internet traffic to another of his Web sites, <johnvail.com>. That site advertised a real estate and brokerage business based in Oakville, Ontario. In 2007, the Regional Municipality of Niagara (the Complainant), filed a proceeding against the Registrant asking that the rights in <niagararegion.ca> be transferred to the Region. The Registrant failed to file a response.

Pursuant to paragraph 4.1 of the CIRA Domain Name Dispute Resolution Policy (the Policy), in order to succeed in its proceeding, the Complainant was required to: (a) prove that the Registrant's domain name was confusingly similar to a mark in which the Complainant had rights prior to the date of registration of the domain name, and continued to have such rights; (b) prove that the Registrant had registered the domain name in bad faith; and (c) provide some evidence that the Registrant had no legitimate interest in the domain name.

Upon consideration of the Complainant's submissions, the panel found for the Complainant and ordered that ownership in the domain name be transferred to the Region. In accordance with paragraph 4.1 of the Policy, the panel found that:

- (a) the Registrant's domain name was confusingly similar to trademarks registered by the Complainant in 1983 and 1997 for the Niagara Regional Police Service and the Regional Municipality of Niagara Police Services Board. While the Complainant assert-

ed that it had been using trade-names such as "The Regional Municipality of Niagara" and "Niagara Region" since 1970, the Complainant did not provide complete evidence of uninterrupted use of these marks;

- (b) the Registrant had registered the domain name in bad faith since the Registrant had a pattern of registering domain names in order to prevent the owners of rights in marks from registering these marks as domain names; and
- (c) there was evidence to suggest that the Registrant had no legitimate interest in the domain name since the Registrant's business was not related to the mark "Niagara Region" and the Registrant did not conduct business in Niagara Region, but rather in the neighbouring Regional Municipality of Halton.

This decision should not be viewed as an outright bar to the use of geo-domain names by non-government entities as each case will depend upon its own particular facts. In this case, for example, it is conceivable that the Registrant would have had a legitimate interest in the domain name, pursuant to subparagraph 3.6(f) of the Policy, if his real estate business had actually been located in Niagara Region as opposed to Halton. It is also conceivable that the result in this case would have been different if the domain name had been associated with a non-commercial use, within subparagraph 3.6(d), as opposed to the Registrant's real estate and brokerage business. Of course, the Complainant's case was also aided by the Registrant's failure to respond.

It is further noteworthy that the Registrant was found to have been engaged in a pattern of registering domain names consisting of third party marks, including <cne.ca> and <jjb.ca>, in order to prevent legitimate owners from registering same. Paragraph 3.7 of the Policy states that a registrant will be considered to have registered a domain name in bad faith if, and only if (a) the registrant registered the domain name primarily for the purpose of selling the registration to the complainant for consideration in excess of the registrant's costs; (b) the registrant has engaged in a pattern of registering domain names in order to prevent legitimate owners from registering same; or (c) the registrant acquired the domain name primarily for the purpose of disrupting the business of the complainant as a competitor of the registrant. In the present case, had the Registrant not registered multiple domain names containing third party marks sufficient to establish a pattern within 3.7(b), it may have been difficult for the Complainant to demonstrate bad faith conduct. After all, there was no indication that the Registrant sought to transfer the domain name to the Complainant and the Registrant was not a competitor of the Complainant. The panel was also careful to point out that the mere act of registering a domain name that is similar or identical to a generic geographically descriptive term does not constitute bad faith conduct.

These considerations notwithstanding, current geo-domain name owners and those seeking geo-domain name registrations should be aware of the potential pitfalls of geo-domain name ownership and the risk that their ownership rights could be expunged. In order to protect these rights, domainers would be wise to ensure that their geo-domain names accord with the location of their businesses, or at the very least that they conduct business within the subject geographical area. In other cases, it may be prudent to ascribe the geo-domain name to a non-commercial purpose. ○

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