# Federal Corporate Name-Granting in the Age of the Internet

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# 1 Purpose, Scope and Conclusions of the Report

How much do Industry Canada's current corporate naming principles need adaptation to the new environment created by the Domain Name System? The purpose of this report is to stimulate discussion among those interested in the subject, and to allow Industry Canada to consult its stakeholders on the basis of a written opinion which addresses a series of questions about the corporate naming policy that we were asked to address in the statement of work in the contract.

We have divided our report into a section explaining the Domain Name System (the DNS) and other computer-based identifiers. We then set forth what Industry Canada states to be its corporate naming principles. Finally we answer in order the questions we have been asked to answer.

The DNS is fundamental to locating where websites and email addresses are situated. It is about 21 years old[1]. Other resource identifiers have appeared, often with great rapidity, but may not be recognized as such. ICQ and Napster also serve to locate resources on the Internet, as do several others. Our perception is that, though the DNS is fundamental to most current ways of finding resources on the Internet, there are many others, there will be more, and their importance will grow with the passage of time. This will be further discussed in Chapter 2, the Domain Name System and Other Computer-Based Identifiers.

The existence and growth of these other resource identifiers suggest that it would be unwise to put too many eggs into the DNS basket. Indeed, Andrew MacLaughlin, chief policy officer for ICANN, the DNS's technical coordination body, says that the DNS has about five to ten years of life ahead of it before something radically undermines it. In the chapter that follows, we will discuss at greater length the problem that the DNS solves and why other systems of resource identification have great futures ahead of them.

[1] A thorough history of the origins of the DNS is "One History of the DNS" by Ross Rader, chief research officer at Tucows, one of the world's largest registrars of domain names, at <http://www.byte.org/one-history-of-dns.pdf>

> "This isn't to say that domain names will somehow "go away"; on the contrary, it's hard to imagine how the Net could continue to function without this essential service. But the fact that it will persist doesn't mean that it will serve as a primary interface for navigating networked resources; after all, other aspects of network addressing have become all but invisible to most users (IP addresses and port numbers to name the most obvious)."[2]

The DNS is a human and political construct designed to put memorable names on top of an Internet Protocol (IP) addressing system that works in pure numbers. It is not surprising that rivals to it, using different architectural ideas, should have come into being, and will continue to be invented.

Another and more fundamental reason guided us in our rejection of the DNS as a basis for reforming the corporate naming system. The temporary duration of the DNS, which we forecast, is not the only reason for limiting the application of principles arising from Internet identifiers to the world of corporate names. It could be asked, "the DNS may be temporary, but perhaps all Internet resource identifiers have common characteristics that should prevail over traditional corporate naming objectives, or influence them more than they now do."

We concluded that the confusion against which Corporations Branch seek to defend, and the rights they seek to protect, lies principally in physical space. Rules devised for physical space are still valid and, in our opinion, are affected very little by the advent of computer resource identifiers like the DNS. At the same time, the cyberspace in which people seek resources has its own rules and characteristics appropriate to it. What might be confusing in physical space would not be so in cyberspace. Computers bring us huge choice, and assist at the same time to distinguish precisely among websites, names, and other resources from each other.

This approach argued for a clean break between rules appropriate for physical space, such as those of Corporations Branch, and those appropriate for the computer and Internet resource identifiers. There was no need for principles suitable for avoiding confusion and protecting rights in physical space to apply to cyberspace, and vice versa.

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[2] Ted BYFIELD, DNS: A Short History and a Short Future, First Monday, September 1998. At < http://www.firstmonday.dk/issues/issue4_3/byfield/>

This study concerned precisely the extent to which rules appropriate for logical space – the Domain Name System – should influence the rules for corporate naming. The answer that became clear in the course of study was either "not at all", or "very little".

| System of Rules | Physical Space | Logical Space |
|---|---|---|
| Corporate Naming Rules | Apply | Not relevant |
| Domain Name System | Does not apply or influence naming conventions of physical space | Relevant, though it faces future rivalry from other resource identifiers |

This table expresses our logic and conclusions succinctly. The issues identified by the client asked essentially how much of the naming convention of the DNS, relevant to logical space, should apply back to physical space. We concluded that there was no advantage to either system to have one influence or prevail over the other. Corporate naming regulations are fashioned for physical space. The qualities associated with logical or cyberspace generate different problems and different solutions.

**First principle**

*Do not assume the DNS will last indefinitely or will maintain its current apparent importance. Technological change will continue with the way people find resources on the Internet.*

This knowledge has led us to the view that it would not be advisable to predicate Canadian corporations naming policy on a system of resource identification that, however popular or fundamental, may be supplanted or whose importance could diminish over the same period of time that it has come to public consciousness.

### Second Principle

*Policy should be consistent across all Internet identifiers.*

This principle is a corollary of the first. Given the inevitability of technical innovation in tools that identify Internet resources, there is no reason to grant privileges to one naming convention over another, or one system of identifying resources over another.

### Third Principle

*Industry Canada has no obligation to make corporate names policy conform to other naming bodies or to other Internet Standards used in Internet identifiers (though adaptation could be helpful in some cases).*

The second motive for our answers was a belief that corporate naming policy in Canada should be kept both independent and relevant. By independence we mean that it should not be predicated upon other naming conventions. We were concerned that, if once an adaptation were made on the basis that the DNS was likely to be the sole relevant corporate identifier, there would be no potential end to the adaptations that would be set in motion. The policy independence of Canada in this matter should be preserved, even if policy must adapt to changed circumstances.

The r*elevance* of our corporate naming principles is affected by the rate of assimilation of knowledge of computers and domain names into the common framework of understanding. People are far more comfortable with domain names in 2002 than they were five years ago. Knowledge of how to locate resources on the Internet is steadily increasing, for which the Domain Name System is a great help.

As always, it is human beings who set the pace of adaptation to anything. The uptake of personal computers has been nothing less than phenomenal. The DNS has gone from obscurity to common knowledge among those who use computers to do business and communicate. People are adapting but they do not wish to absorb superfluous knowledge and change behaviour on the basis of technical systems that may shortly be obsolete.

Canada's corporate naming principles are predicated on avoiding confusion among consumers as to the identity of companies they are dealing with, *within physical space*. Those principles are by nature conservative and slow to adapt. In this report, we are proposing that rules worked out for physical space do not need to adapt to rules which apply to naming conventions in cyberspace. This conclusion might be different in ten years' time. There could be things we have not thought of.

Our concerns about the irrelevance of rules deriving from DNS and cyberspace in general may encourage corporate naming policy to appear to be behind the times. We did not want Industry Canada to be put in the position where it enforces a policy or has to follow a policy that is driven by concerns and commercial disputes deriving from outside bodies or standards, which derive from the radically different environment of cyberspace. Corporations Branch should be in a position to carry out its mandate to prevent confusion in the public mind in physical space.

Our conclusions may seem quite conservative, in that we see no need for a major overhaul, and little point in having one. The Regulations[3] seem to be well adapted to protecting rights and preventing confusion for the world for which they were designed. Our skepticism about the need for major change arises from our familiarity with the DNS and the problems it is designed to solve, as well as with the system of domain name governance which the DNS requires[4].

[3] Canada Business Corporations Regulations, 2001, Industry Canada, November 22nd 2001.
At <http://strategis.ic.gc.ca/SSG/cs01376e.html>; Corporations Directorate, Name Granting Compendium, Industry Canada, Ottawa, November 1999.
At <http://strategis.ic.gc.ca/SSG/cs01290e.html>; Corporations Directorate, Name Granting Guidelines, Industry Canada, Ottawa, April 1999, at < http://strategis.ic.gc.ca/pics/cs/1139.pdf>.
[4] The Internet Corporation for Assigned names and Numbers, a California not-for-profit corporation, governs the DNS. Its website is found at <http://www.icann.org>

# 2 The Domain Name System and other Computer-based Identifiers

## *2.1 Background*

In order to establish communication between two computers connected to the Internet, such as between your computer and a web site, it is necessary to establish a path across the Internet to carry the information. The establishment of this path is controlled by other kinds of computers that are specialized in forwarding bits of information. These computers are called routers. The routers are owned by the service providers and are connected to transmission lines, such as optical fiber, that make the way from your location to that distant computer hosting the web site. Routers make use of a common language to exchange information called the Internet Protocol. The protocol uses physical labels known as Internet Protocol addresses (IP addresses) to relay the information between them (i.e. to 'route' the packets).

Because the numerical IP addresses are not easy to remember, it is often desirable to refer to them with a mnemonic name. The software that lets you refer to a computer IP address as if it were a name is called a resolver (because its function is to resolve the computer name to the corresponding IP address).

If your web browser software did not include a resolver, you would need to enter http://198.103.98.131 in order to reach the web site of the Government of Canada. It is much easier to enter http://www.gc.ca. The resolver incorporates the mechanism which makes it possible to convert a web site name to the corresponding IP address which routers need to use to forward packets across the Internet.

In the early days of the Internet, the resolver simply looked up a flat file of corresponding names to IP addresses. The flat file was maintained centrally and distributed manually to all other hosts on the Internet that wished to benefit from simpler host name resolution. With the advent of the Domain Name System (DNS), this process of looking for a host file has now been replaced with the dynamic lookup of a remote host file through a computer protocol. The resolver thus evolved from a computer process that used to look into a local host file to one

which sends queries across the Internet to remote servers which are charged with returning the corresponding IP address associated with the host name being queried for.

When the computer starts up, it needs to know the IP address of at least one DNS server to begin resolving host name queries to their corresponding IP addresses. This is why your ISP has often helped you to adjust your DNS server in your connection parameters when you were complaining that you were not getting anywhere on the Internet.

Like most other Internet protocols that are more than five years old, the DNS protocol is still in use today because it continues to work reasonably well and because it is deployed on practically all Internet-connected hosts. However, despite being well entrenched, the DNS protocol could be displaced rapidly with something better and more efficient, which would diminish the pressure for the current corporate naming system to adapt to the DNS.

In addition, there is no particular advantage in modifying national resource identifiers, to borrow a term, to the way that the DNS works. For example, domain names must be globally unique. Corporate names and trademarks are not required to be globally unique. How much the corporate naming system should adapt to the DNS is discussed at greater length in Chapter Four.

## *2.2 The DNS and other identifiers*

It is important to keep in mind that other kinds of identifiers are coming soon and that their owners may see an advantage to use them as a corporate name. For example, applications such as Internet Protocol telephony (telephony over the Internet) are expected to give birth to a plethora of new identifiers.

It is likely that the arrival of new mass-market identifiers will be viewed as a significant opportunity by the marketplace. Additionally, fierce competition between Internet-based services and legacy services will likely result in significant conflicts between who will be allowed to operate the directory services.

It is expected that telephone companies will not let domain name registries manage the directory services for Internet Telephony without a fight. That alone is sure to bring governments into the picture through their telephony regulators (such as the Canadian Radio Television and Telecommunications Commission). Current limitations associated with the DNS are sure to come out in the open during these upcoming discussions. The fact that all queries for a domain name have to refer to root servers, most of which are currently under the direct control of the United States government, will not be tolerated with critical global applications such as telephony.

One possibility is that the limitations of the DNS will require a system that can be better controlled by national governments. Such a system will need to accommodate conflicting names and is likely to be based on some form of globally unique digital certificate granted by the national government. The speed at which residential telephony will migrate to broadband Internet access lines will likely dictate how quickly this transition will occur.

The arrival of such a system would render nearly obsolete the need to use the DNS. Without the necessity to use the DNS to refer to Internet web sites, as they exist today, the commercial value associated with the presence of .ca, .com or other .ccTLD[5] suffixes would be nonexistent. The adaptation of existing corporate name policies to the Domain Name System must thus be viewed in the bigger context of Internet identifiers in general.

## 2.3 Internet identifiers and confusion

The likely future predominant position of the Domain Name System is on the order of five to ten years before it can be replaced with a better Internet-based identifier system. Such a new identifier system would make it possible to have multiple root directories and would not be dependant on the first-come first-served principle to prevent conflicting entries from being registered in the global directory. Such conflicting entries could be distinguished by underlying Internet identifiers guaranteed to be globally unique. This is more or less the function performed by search engines today.

[5] Country code Top Level Domain Name, .ca, .uk, .fr, etc.

# 3 Existing Corporate Naming Principles

This section repeats explanations of the corporate naming principles that are provided by the Department of Industry. We felt that Industry Canada explains its policy in terms that cannot be improved upon.

When you apply to incorporate a company under the *Canada Business Corporations Act*, you may choose to use a corporate name or have a number name assigned to you. Although incorporating under a name involves additional effort and expense, there are advantages to doing so. A corporate name is an important aspect of corporate communication and advertising today and may be a very valuable asset. It tells people who you are and will often embody the goodwill that you have built up with your customers and suppliers.

An approved federal corporate name offers an extra degree of protection of your rights to that name. Specifically, federal incorporation allows your business to operate using its corporate name right across Canada, which is important if you decide to expand your business to other provinces or territories.

### *Choosing a name*

Your name must meet certain requirements before the Corporations Directorate approves it:

The name must be distinctive.

The name must not cause confusion with any existing name or trademark.

The name must include a legal element.

The name must not include unacceptable terms.

#### Distinctiveness

It must be easy to distinguish your proposed name from the names of other businesses that carry on the same activities. Your name will not be distinctive if it merely describes those

activities. The name "Car Manufacturer Inc." lacks distinctiveness since it describes the activities of all car manufacturers.

You can achieve distinctiveness in a number ways. One of the most common is to include an element that makes it distinctive. "Carwash Incorporated," for example, is too general, but "East Side Carwash Incorporated" is distinctive.

Made-up words also give a name distinctiveness. They can be a combination of two dictionary words such as "Infotech" or something completely new such as "Xerxos." Unusual names are highly distinctive and are given greater protection because they are unique.

### Confusion with other names or trademarks

It is to your advantage to learn about possible name conflicts as soon as possible. If your name is too close to an existing business name or trademark, the owner of that name or trademark could launch a court action to compel you to stop using your name and perhaps even to pay damages.

For many people, the prospect of discovering that their business name may be confused with another is intimidating. This is particularly true if you have invested considerable time and effort in coming up with a name or have been operating under the proposed name for some time before incorporating. The federal name approval process helps you to avoid this problem by identifying potentially confusing names or trademarks in a federal database of names and ensuring that you satisfy yourself that confusion is not likely.

In assessing whether confusion is likely, the Corporations Directorate looks at all circumstances, including a comparison of the goods, services and operating area of your proposed business with those of existing businesses. While name approval from the Corporations Directorate does not guarantee that you are not violating the rights of another firm or individual, it significantly reduces your risks.

You must submit a NUANS (Newly Upgraded Automated Name Search) report as part of your application to use your corporate name. A NUANS search compares your proposed name

with a federal database of names that includes trademarks, provincial and federal corporate names and most provincially registered business names (except those in Quebec).

### Legal element

The accepted way to include a legal element in a corporate name is to add a term to the end of the name such as Limited, Incorporated or Corporation, or contractions of these such as Ltd., Inc. or Corp.

### Unacceptable terms

Unacceptable terms fall into three categories. First, there are terms that imply connections that do not exist. Your corporate name cannot suggest, for example, that you are a branch of the government or that you offer services or products governed by financial legislation, such as trusts, loans, insurance and banking.

The second type of unacceptable term is one that falsely describes your business. You cannot, for example, include terms that suggest that your company is selling cars when it is really selling only tires.

Finally, obscene terms or terms that suggest that your business provides obscene, scandalous or immoral services are not allowed.

## *Applying for a corporate name*

The most important part of your name application is a NUANS report. There are several types of NUANS reports and the one you need for federal incorporation is a Canada-biased report. A Canada-biased report means that the proposed name was searched against all the names found in the database, not just names registered in a particular province. Private businesses known as search houses will do the appropriate search and give you the NUANS report for a fee. You can find a search house by looking in the Yellow Pages under "Searchers of Records," "Incorporating Companies," "Incorporation" or "Trademark Agents."

The NUANS report is valid for 90 days. If you do not submit your application for incorporation within that period, you must get a new report.

You may submit your proposed name along with your application for incorporation or you may ask for pre-approval of your proposed name. If you choose to submit your name along with your complete application, please be aware that if the Corporations Directorate rejects your proposed name, the entire application will be refused. A pre-approved name can prevent this situation from happening. There is no fee for this service.

Your application for pre-approval or for incorporation should be as complete as possible. If your first application is rejected, you may reapply with additional information later, but it is easier, and less expensive, to include all the relevant information the first time. Information considered relevant includes descriptions of your product or service, your customers and where your business will operate.

The Corporations Directorate publication *Name Granting Guidelines* features more information about NUANS and the requirements for corporate names. To ensure that you have included all the relevant information, you may want to use the *Corporate Name Information Form* found in Annex D of *Name Granting Guidelines* and submit it with your name application.

### *Keeping your good name*

The name approval process does not guarantee protection against names or trademarks existing at the time the name is approved. While the NUANS search report is usually very reliable, the NUANS system is not foolproof. The responsibility for ensuring that your business name does not infringe on the rights of others is yours alone. It is also up to you to make sure that no new business names or registered trademarks infringe on your rights.

### *Not-for-profit corporations*

Generally, names for federal not-for-profit corporations must meet the same requirements as for federal business corporations except the legal element requirement. However, not-for-

profit names may receive a slightly more liberal interpretation with regard to distinctiveness since they are typically more general and descriptive than business names.[6]

# 4 Answers to the Questions

In this question we respond serially to the questions that the Department of Industry asked in its statement of work.

## *4.1 Lacking Distinctiveness*

### Background

Clients who register a domain name using a sub-domain like "cars", which merely describes a business or the product of a business, are unable to obtain a corporate name which is only the domain name plus a legal element. Clients who attempt to register corporate names like "Joe Smith.ca Inc.", "Ottawa.ca Inc." and "FasterDeliveries.ca Inc." are also rejected. All of these names are rejected because they lack distinctiveness within the meaning of the amended regulation 24 under the CBCA. We do not consider that the addition of ".ca" gives the corporate name distinctiveness. Some clients, denied their corporate name for this reason, find this decision to be unreasonable.

### Issue

Is a corporate name, which is a domain name, inherently distinctive within the meaning of the CBCA regulations, even though but for the ccTLD or gTLD, it would contravene amended regulation 24? We have received arguments that such names should be considered to be distinctive because they lead to a unique Internet address.

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The general rule for « distinctiveness » in corporate naming is found in section 24, paragraph 1 of the Regulations under the *Canada Business Corporations Act*. The exception provided for in

[6] Corporations Directorate, Choosing a name… for your federally incorporated company, Industry Canada, Ottawa, 28 September 1999. At < http://strategis.ic.gc.ca/SSG/cs01191e.html#text>

the second paragraph of section 24 allows names which have acquired, by their use, a derivative sense and thus a distinct character.

> "**24.** (1) For the purpose of paragraph 12(1)(*a*) of the Act and subject to subsection (2), a corporate name is prohibited if the corporate name is not distinctive because it
>
> > (*a*) is only descriptive, in any language, of the business of the corporation, of the goods and services in which the corporation deals or intends to deal, or of the quality, function or other characteristic of those goods and services;
> >
> > (*b*) is primarily or only the name or surname, used alone, of an individual who is living or has died within 30 years before the date of the request to the Director for that name; or
> >
> > (*c*) is primarily or only a geographic name, used alone.
>
> (2) Subsection (1) does not apply if a person requesting a corporate name establishes that it has, through use, acquired the name and the name continues at the time of the request to have secondary meaning."[7]

Does the addition of a top level domain to a non-distinct name render it sufficiently distinct? Let us look at various TLDs in use in Canada.

The generic top level domains (.com, .org, .net) have no territorial, sectoral or other attachments which might link them to a particular industry or sector of activity. This type of TLD cannot, in our view, make distinctive a name that does not already satisfy the criteria of section 24(1) of the Regulations under the CBCA, 2001.

The dot ca domain is held by those who qualify for the Canadian Presence Requirements : *Canadian Presence Requirements For Registrants* (RPPG 05-20001108-00006 Version 1.2 Effective Date: November 8, 2000)[8]. Given that CIRA had registered its 200,000th dot ca domain by March 21st 2001[9], it is impossible to defend the position that the addition of a

[7] Corporations Directorate, Canada Business Corporations regulations, 2001, Industry Canada, November 22nd 2001, at <http://strategis.ic.gc.ca/SSG/cs01376e.html>
[8] http://www.cira.ca/official-doc/47.RPPG_00006EN.pdf
[9] 200,000th dot-ca domain name registered, News releases, CIRA, Ottawa, March 22, 2001. At http://www.cira.ca/news-releases/38.html

dot ca confers an element of distinctiveness to a name that would otherwise fail the test of section 24(1) of the Regulations.

New TLDs have been authorized by ICANN. They are divided into « sponsored » and unsponsored TLDs.

> "Generally speaking, an "unsponsored" TLD operates under policies established by the global Internet community directly through the ICANN process, while a "sponsored" TLD is a specialized TLD that has a sponsor representing the narrower community that is most affected by the TLD. The sponsor thus carries out delegated policy-formulation responsibilities over many matters concerning the TLD."[10]

Unsponsored TLDs consist of .biz, .info, .pro, .name, to which others may be added in the coming years. The generality of these suffixes and the fact that they will be available worldwide makes it difficult to conclude that they too allow Industry Canada to approve a name which would otherwise contravene Regulation 24(1) for want of distinctiveness.

Sponsored TLDs (.aero., .museum, and .travel ) are characterized by another body besides ICANN controlling parties which have standing to apply for one. Again we are hard pressed to imagine the circumstances in which, say, « grouptravel.inc », if it contravenes regulation 24(1), somehow does not contravene it if « grouptravelinc.travel » is the name. Those companies which propose the use of a sponsored TLD may have an easier burden to demonstrate their distinctiveness, assuming the basic name fails the test, but in our view, the criteria of regulation 24(1) are sufficiently clear that we see little way this can be successfully argued.

### The question

Is a corporate name, which is a domain name, inherently distinctive within the meaning of the CBCA regulations, even though but for the ccTLD or gTLD, it would contravene amended regulation 24?

[10] Status page on new TLD agreements, ICANN, Upgrade 06-mar-2002, at http://www.icann.org/tlds

### The answer

So far, the answer would be « no ». The addition of .ca or .com or the like does not make a name distinctive within the meaning of regulation 24 (1). Does regulation 24 (2) offer any relief?

Contrary to the federal name-granting regime, no prior control is exercised over the distinct character of a domain name. If a name is available, it may be registered, and once registered, may become the basis of a successful web-based business. In our opinion this condition could create a situation where certain domain names which could not satisfy the criteria of 24(1) may nevertheless benefit from the exception of 24(2) if they were able to produce an "affidavit stating some facts showing how large and widespread [their] business is and, if necessary, affidavits from others in the trade supporting [their] claim of secondary meaning."[11] The use of a domain name may well satisfy the requirements of secondary meaning within the sense of regulation 24(2) of the *Regulations*.

### Conclusion

A name is not made distinctive by the addition of a top level domain suffix. If *abc inc.* lacks distinctiveness, adding *abc.com inc* will not make it so.

Two exceptions might be arguable. One is that sponsored TLDs (.aero, .travel) may be sufficiently specific to create distinctiveness that would otherwise not be there without the TLD.

The second is that certain domain names may become sufficiently well known as a corporate identifier that "it has, through use, acquired the name and the name continues at the time of the request to have secondary meaning." - regulation 24(2)

### Recommendation

Corporations Branch should adjust its policy in the sense just described.

[11] Corporations Directorate, Name Granting Guidelines, Ottawa, Industry Canada, April 22, 1999, p.2-1. At <http://strategis.ic.gc.ca/pics/cs/1139.pdf>

## 4.2 Confusion

### 4.2.1 Uniqueness

#### Background

Clients proposing corporate names which consist largely of a domain name (not suffering from lack of distinctiveness), eg., "ABC.ca Inc." are refused their proposed name, on the basis of being likely to cause confusion, where there is an existing business name or trademark, using the same sub-domain with or without a different TLD, like "ABC" or "ABC.com". Some clients, denied their corporate names for this reason, find this decision to be unreasonable.

#### Issue

Is confusion unlikely to be caused by such corporate names in these circumstances due to the fact that each domain name is a unique Internet address? Are gTLDs and ccTLDs distinctive enough outside of Internet circles that a corporate name like ABC.ca Inc. is distinguishable from ABC.com Inc. even if they are in a similar business, for example, manufacturing textiles in Canada?

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One of the readily available sources of information on how uniqueness is being judged is the set of cases available from the Uniform Dispute Resolution Process (UDRP) established under the auspices of ICANN. We have examined those cases where a distinction, based solely in the domain name suffix, was the subject of the arbitration. Is the distinction between abc.com and abc.ca sufficient to avoid confusion?

**Decisions made in relation to the Uniform Dispute Resolution Process of ICANN**[12]

Here follow several extracts from decisions rendered in the domain name conflict resolution process, called the Uniform Dispute Resolution Process (UDRP). ICANN felt the requirement to establish the UDRP as a means of resolving intellectual property claims with

greater speed and less cost than would have been possible in domestic courts. Most of these decisions are rendered by American panelists in particular circumstances related to domain name disputes. They have been selected because they might enlighten us, when a generic TLD or a country code (ccTLD) is used. The question which was examined in these cases was whether the use of ccTLD or GTLD with the same prefix was « confusingly similar ». While these cases do not deal with corporate names as such, they may illustrate notions relevant to corporate naming.

Telstra Corporation Limited v. Nuclear Marshmallows[13], at paragraph 7.1 :

> "The domain name in issue is <telstra.org>. The relevant part of this domain name is <telstra>. The Administrative Panel finds that this part of the domain name is identical to the numerous trademark registrations of the word <TELSTRA> held by the Complainant. In addition, the Administrative Panel finds that the whole of the domain name is confusingly similar to those trademark registrations."

Guerlain S.A. v. Peikang[14], under section 6 :

> "The Domain Name is guerlain.net. The Panel finds that the second level domain (i.e.: guerlain) is identical to the numerous trademark registrations of the word "Guerlain" held by Complainant. In addition, the whole of the Domain Name is confusingly similar to those trademark registrations."

The approach taken in these two extracts separates the domain name according to levels : the name *abc* is a second level domain in DNS jargon and the TLD suffix, such as *.com* is a first level domain. In both these cases the arbitration panel concluded that second level domain (telstra, guerlain) was identical to the trademark and that the two levels taken together (telstra.org) were confusingly similar to the complainants' trademarks.

We have also seen arbiters in UDRP arbitration separate the gTLD or ccTLD from the other part of the domain name in the evaluation of "confusingly similar" and conclude that a domain name is identical or virtually identical to a trademark.

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[12] www.icann.org
[13] Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Arbitration and Mediation Center, Case No. D2000-0003, February 18, 2000.
At <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0003.html>

Encyclopaedia Britannica, Inc. v. John Zuccarini and The Cupcake Patrol a/ka Country Walk a/k/a Cupcake Party[15]

The panel determined that the complainant had sold, since 1870, encyclopaedias, dictionaries, atlases and other goods and services under the mark ENCYCLOPAEDIA BRITANNICA. The mark has been registered since 1950 and the complainants also have the US trademark registrations for BRITANNICA and has registered or applied to register these marks in a number of other countries. It also applied to register the term BRITANNICA.COM.

On October 19th, 1999, the complainant announced the opening of www.britannica.com. On or about October 22nd, 1999, the respondent registered the domain names in dispute, like brtannica.com, bitannica.com, enyclopediabrittanica.com and britannca.com.

> “Respondents’ "encyclopediabrittanica.com" domain name is virtually identical and confusingly similar to Complainant’s ENCYCLOPAEDIA BRITANNICA mark. Respondents’ domain names brtannica.com, britannca.com, and bitannica.com are virtually identical and confusingly similar to Complainant’s BRITANNICA and BRITANNICA.COM marks.”

Ingersoll-Rand Co. v. Frank Gully, d/b/a Advcomren[16]

> “The domain names registered by Respondent are identical or confusingly similar to Complainant's trademark, Ingersoll-Rand. Respondent has demonstrated no legitimate interests in respect of the domain names, nor is it reasonably possible that Respondent could do so, since the trademark, a hyphenated name combination, is venerable and distinctive.”

Despite different approaches to the reasoning by which they arrived at their results, it seems that no arbitration decision in the UDRP has held that a different suffix (.com versus .org or .uk) prevents confusion. Indeed, some decisions seem rather to have affirmed that the top level domain (the suffix) should not influence the decision whether a name is confusingly similar.

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[14] Guerlain S.A. v. Peikang, WIPO Arbitration and Mediation Center, Case No. D2000-0055, March 21, 2000. At <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0055.html>

[15] WIPO Arbitration and Mediation Center, Case No. D2000-0330, June 7, 2000. At http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0330.html

[16] Ingersoll-Rand Co. v. Frank Gully, d/b/a Advcomren, WIPO Arbitration and Mediation Center, Case No. D2000-0021, March 9, 2000. At <http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0021.html>

This was particularly emphasized in a WIPO arbitration case of last March, 2001 (*Groupo Ferrovial).* (Note : The panelist's native language is Spanish, which explains the prose style).

> "It cannot be relevant the generic TLD particle. The particles "com", "org" or "net" are not relevant to establish the comparison, since they do not give any particularity or difference to the domain name chosen by the registrant. Those particles are usually used to make a difference of the sectors and activities advertised through the domain name. In the practice, however, this purpose has failed, since registrants do dedicate the Web Sites to activities other than those initially intended under the TLD particles."[17]

## Judicial case

A decision of the Supreme Court of Canada engaged in an analysis of "confusion" in a suit dealing with the issue of "passing off". The conclusions of M$^r$ Justice Charles Gonthier in *Ciba-Geigy Canada Ltd. c. Apotex Inc.*[18] are relevant to the question of confusion as it relates to section 25 of the Regulations of the *Canada Business Corporations Act* (RSARF, 2001). This decision concerned the pharmaceutical industry, in relation to which two interpretations existed of who constituted the public. The first held that confusion pertained to those familiar with the industry, such as doctors, dentists and pharmacists. The second held that the public whose potential confusion was a concern, was wider :

> "There are those who argue that only physicians, dentists and pharmacists are included. I will begin by reviewing the cases which have given a limited definition of the clientele and then consider several aspects of the question, an analysis of which will inevitably lead in my opinion to a preference for a broad clientele. Finally, I will cite decisions of the courts and authors who consider that the patient is included in the clientele of pharmaceutical laboratories for the purposes of a passing-off action."[19]

[17] Grupo Ferrovial, S.A. v. Carlos Zamora, WIPO Arbitration and Mediation Center, Case No. D2001-0017, March 4, 2001. At http://arbiter.wipo.int/domains/decisions/html/2001/d2001-0017.html
[18] [1992] 3 R.C.S., 120.
[19] Ciba-Geigy Canada Ltd. c. Apotex Inc., [1992] 3 R.C.S., 120, 143. At http://www.lexum.umontreal.ca/csc-scc/en/pub/1992/vol3/html/1992scr3_0120.html

The Court found :

> "There is no reason in law to depart from the well-established rule that the final consumer of a product must be taken into account in determining whether the tort of passing-off has been committed. In the field of prescription drugs, therefore, the customers of pharmaceutical laboratories include physicians, pharmacists, dentists and patients."[20]

As regards the criterion by which to evaluate "confusion" the Court confirmed that :

> "There is no shortage of fraudulent or simply misleading practices: one may think, for example, of products having a similar get-up, the use of similar labelling, use of the same trade name, counterfeiting, imitation of packaging. These are all possible ways of attempting, deliberately or otherwise, to mislead the public. The courts and authors have unanimously concluded that the facts must be weighed in relation to an "ordinary" public, "average" customers"[21]

No Canadian case law or UDRP arbitrations have been found which consider the issue of confusion between a dot com and a dot ca, for instance, or a gTLD and a ccTLD.

No Canadian case law or UDRP arbitrations have been found which consider the issue of confusion of a domain name, generic or country code, with a business name.

No Canadian case law or UDRP arbitrations have been found which consider the idea of confusion of an unincorporated trade name with a generic or a country code TLD.

## Opinion Survey

This leads us to consider who is the average customer when it comes to domain names and what is their state of knowledge. To help us answer, we refer to an opinion survey sponsored by CIRA (Canadian Internet Registration Agency), the manager of the dot ca domain. Published

[20] Id., 157.
[21] Id., 137.

on December 6th, 2001, it bore on the attitudes of Canadians towards the dot ca[22]. The sample was of 1,078 users with a confidence level of around ± 3 %. The most interesting aspects of the study are as follows :

**Main Difference Between Dot-ca and Dot-com Websites - top 5 Mentions**

| | |
|---|---|
| **Dot-ca is Canadian:** | **24 %** |
| **Dot-com is business/commercial:** | **23 %** |
| Dot-com is worldwide | 22 % |
| Dot-com is American | 11 % |
| Nothing/no difference | 6 % |

**Amount Of Attention Paid To Address Suffixes**

TOTAL pay attention : 53 %

TOTAL do **not** pay attention: 47 %

**Knowledge of Requirements For Registering A Dot-ca Domain Name**

| | |
|---|---|
| Yes, there are requirements : | 38 % |
| No, there are no requirement s: | 9 % |
| Don't know if there are any requirements : | 53 % |

**Registration Of A Dot-ca Or Other Domain In The Past 12 Months**

92 % do not have registered a domain

8 % have registered a domain

[22] CIRA, Canadian Attitudes Toward The Dot-ca Domain : A Presentation by Allan Gregg to the Annual General Meeting of the Canadian Internet Registration Authority, Officials documents, 2001 AGM Agenda & documents, December 6th, 2001. http://www.cira.ca/official-doc/104.cira_tsc_en.pdf

## Conclusion on the questions

1. Is confusion unlikely to be caused by such corporate names in these circumstances due to the fact that each domain name is a unique Internet address?

2. Are gTLDs and ccTLDs distinctive enough outside of Internet circles that a corporate name like ABC.ca Inc. is distinguishable from ABC.com Inc. even if they are in a similar business, for example, manufacturing textiles in Canada?

In both cases we consider the answer to be “no”. Confusion is likely to be caused in both cases.

The general conclusion drawn from the CIRA survey is that the average Canadian user of the Internet is not well versed in domain names. Almost half (47 %) said they pay no attention to the difference between a dot ca or a dot com or a dot org. For the time being, there seems to be a strong possibility of confusion in the public’s mind if a company is distinguished only by the top level domain suffix, when the spelling of the name itself is identical.

The issue is not whether the technology of the DNS causes a domain name to resolve uniquely to a certain IP address; the issue is whether a name in plain language, such as a domain name, causes the human mind to be confused within the meaning and sense that the corporate naming policy tries to avoid. Resolution of the DNS to a unique domain name and IP address is irrelevant to the confusion of human minds.

## Recommendations

We recommend that Corporations Branch should reject :

- ABC.TLD if ABC. another TLD exists either as an incorporated or unincorporated name (e.g. If Infometrica.com. is incorporated or unincorporated, then reject Infometrica.ca , Infometrica.biz etc as suitable corporate names)

- ABC.TLD inc if ABC trademark exists and is held by another party and permission is not given to use it

- ABC.TLD if ABC.another TLD exists and is either as an incorporated or unincorporated name.

### 4.2.2 Dilution

#### Issue

Generally speaking, the more diluted (or used) the distinctive element of a proposed corporate name, the easier it is for us to approve the proposed name with only a small difference from existing names. If we were to search proposed corporate names against existing domain names as well as existing corporate and business names and trademarks, a search for "ABC.ca Inc." would sometimes show many highly similar domain names like "ABC.com", "ABC.org", "ABC.net", etc. To what extent can these be considered to increase the level of dilution of the proposed name, to the point where the small difference in gTLD or ccTLD, is sufficient to distinguish them?

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The first step in the analysis starts with the definition of “dilution”.

> “Dilution doctrine : A trademark doctrine protecting strong mark against use by other parties even where there is no competition or likelihood of confusion. The concept is most applicable where subsequent user used the trademark of prior user and there is no likelihood of confusion of the products or sources, but where the use of the trademark by the subsequent user will lessen uniqueness of the prior user’s mark with the possible future result that a strong mark may come a weak mark. Holiday Inns, Inc. v. Holidays Out in America, C.A.Fla., 481 F.2d 445, 450.”[23]

It appears that the principle of dilution was born in 1927 in the writings of Frank I. Schechter. We refer to a passage in the decision *Intermatic Incorporated,* v. *Dennis Toeppen*[24]*,*which makes reference to it :

> “The concept of trademark dilution dates back to an article written by Frank I. Schechter and published in the Harvard Law Review in 1927. *The Rational Basis of Trademark Protection*, 40 Harv. L. Rev. 813 (1927). Schechter explained that the true function of a trademark is "to identify a product as satisfactory and

[23] Henry CAMPBELL BLACK, Black’s Law Dictionary With Pronunciations, 6th ed., St. Paul, West Publishing co., 1990.
[24] (3 octobre 1996) 65 USLW2274, 40 U.S.P.Q. 2d 1412.
At <http://www.jmls.edu/cyber/cases/intermat.html>

> thereby to stimulate further purchases by the consuming public." *Id.* at 818. Schechter rejected the theory that the exclusive role of a trademark was to serve as a source identifier. He argued that injury occurs to a trademark owner whenever a trademark is used by another, even when used on non-competing goods. He explained that an injury to the trademark owner occurs when there is "a gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon non-competing goods. The more distinctive or unique the mark, the deeper is its impress upon the public consciousness, and the greater is its need for protection against vitiation or dissociation from the particular product in connection with which it has been used." *Id.* at 825. This argument that the trademark laws should protect owners in connection with non-competing goods was novel. Attempts to enact a federal dilution statute in 1932 were unsuccessful. See, *Gilson* , at p. 3."[25]

While the principle of dilution is well established in statute law in the United States (see *Federal Trademark Dilution Act 1995*[26]), in Canada, its application is less certain, as was remarked by Pierre-Emmanuel Moyse :

> « […] la solution ne paraît pas transposable en droit canadien, ni dans de nombreux autres systèmes qui ne connaissent pas le concept de dépréciation - en droit français, une équivalence très lointaine est à chercher du côté du concept à contenu variable de concurrence parasitaire, concept élaboré à partir d'interprétations modernes de l'article 1382 du Code civil français. Le droit canadien des marques de commerce connaît toutefois une disposition singulière quelque peu semblable à la loi américaine. L'article 22 de la *Loi canadienne sur les marques de commerce* précise en effet que "Nul ne peut employer une marque de commerce déposée par une autre d'une manière susceptible d'entraîner la diminution de la valeur de l'achalandage attaché à cette marque de commerce". L'application de ce texte reste problématique depuis un arrêt énigmatique de la Cour Fédérale. Celle-ci a conclu dans l'arrêt *Clairol,* que l'article 22(1) prohibe l'utilisation d'une marque dans une publicité comparative honnête de services lorsque cette publicité est placée sur son emballage ou sur la marchandise elle-même. Sans revirement de jurisprudence, cette interprétation vide de tout sens l'article 22(1) en ramenant la notion d'emploi de la marque à celle prévue à l'article 4 de la loi. Ainsi, comme le déplore Jacques Léger, ce jugement "restreint l'application de l'article 22 au seul cas où la marque enregistrée est "employée" par la partie défenderesse conformément à la définition donnée à ce terme à l'article 4 de la loi. Ce jugement exclut notamment tout emploi fait par des tiers non autorisés d'une marque de commerce enregistrée dans de la publicité par exemple. Et à nous de continuer : dans le cas de publicité sur Internet ou par tout autre nouveau médium qui ne peut pas être sanctionné sur le fondement des

[25] Idem.
[26] Section 43 (c) of the Lanham Act, 15 U.S.C. Section 1125(c). At http://caselaw.lp.findlaw.com/casecode/uscodes/15/chapters/22/subchapters/iii/sections/section_1125.html

> articles 19, 20 ou 7(a) de la loi où il est difficile d'établir l'usage tel que prévu à l4 et où la confusion est difficile à établir. »[27]

The position of Industry Canada concerning the principle of dilution is as follows :

> "Our primary concern in enforcing the name regulations should be in ensuring that we cause no confusion. Nowhere do the regulations enshrine the principle that a highly distinctive name should be protected from dilution and so we will have no hard and fast rule with respect to protection of them. In practice, however, the protection principle should complement the principle of avoiding confusion. Where an existing corporation has a highly distinctive name, i.e. unique and imaginative, being a purely arbitrary creation, e.g. DWIDAG (for a food wholesaler), as opposed to an obviously derived composition, e.g. CORTIVET (for the manufacture of cortisone veterinarian preparation), one is generally more apt to foresee confusion in granting the same distinctive element to a second company because the distinctive element of the existing company is more likely to linger in the mind of the public. Each case, however, depends on its facts and depending on differences of wares, territory and clientele, we may or may not feel that there is in fact a likelihood of confusion.
>
> Some words are so common that they are used as the distinctive element in many business names. Such wide usage dilutes the impact of the business name and gives it a reduced claim to protection. As a general rule, where a distinctive element is highly diluted, the same distinctive feature may be used in new corporate names that are only slightly different from the existing names. For instance, a different descriptive word might be all that is needed to distinguish the proposed corporate name from similar existing names, even if the descriptive word describes essentially the same business that is carried on under the existing names.
>
> For example, names such as "Universal Products Inc." or "Universal Bakery Products Inc." would not be prohibited, even though there were existing names like "Universal Food Enterprises Inc.," because the distinctive element "Universal" is highly diluted, and the existing names do not deserve much protection."[28]

[27] Pierre-Emmanuel MOYSE, Les noms de domaine : un pavé dans la marque, (1997) 9-3 Les cahiers de propriété intellectuelles (CPI) 425. Can also be found in Robic publications at http://www.robic.com/publications/71.htm

[28], Corporations Directorate, Name Granting Compendium, Industry Canada, November 1999, chapter 5(B). At http://strategis.ic.gc.ca/SSG/cs01290e.html

### Conclusion on the Question

As regards the principle of dilution, it would seem that domain names might act as a source of dilution of existing trademarks and corporate names. Nevertheless we conclude that the dilution of these trade marks or corporate names will not reach the stage where the simple difference in the TLD suffix would suffice to distinguish two corporate names or trademarks.

### Recommendation

No change of policy is required. Dilution does not create the basis of accepting otherwise unacceptable corporate names.

## 4.2.3 Territory and Means of Distribution

### Questions

In light of the Internet reality, can territory (one of the factors listed in amended regulation 25, to be considered in determining confusion) be a distinguishing factor any longer? If clients have their domain names in their proposed corporate names, do we assume that they carry on business nationally/internationally for purpose of determining whether their corporate names are likely to cause confusion? Is there any longer any point in asking whether the proposed corporate name and the existing businesses operate in different geographical regions, if both proposed and existing entities also operate over the Internet? (If we cannot distinguish by region, the effect will be that fewer corporate names will be approvable.)

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## 4.2.3 First Question

*In light of the Internet reality, can territory (one of the factors listed in amended regulation 25, to be considered in determining confusion) be a distinguishing factor any longer?*

One of the difficulties we faced in answering this question was that the Internet's novelty and ubiquity can make one focus excessively on its characteristics rather than on how people use it, and what computers can do to reduce confusion and increase knowledge and choice. Certain pertinent attributes of the Internet were described in the *Report of the Second WIPO Internet*

*Domain Name Process*[29] of September 3, 2001, and they will serve as a useful reminder of the Internet's salient characteristics. These "Special features of the environment" are :

- *A global Medium,*
- *A global Space,*
- *Speed of Penetration and of Change and*
- *Multifunctionality.*

The most pertinent aspect is *Global Space :*

> "60. The Internet makes possible a global space for activity. It is true that activity on the Internet will have a series of territorial connections: the location of the computer from which the activity emanates, the location of the server, the location of the computer on which the activity is perceived, the locality of the target audience, the locality of the accidental audience that may perceive or be able to perceive the activity, the territory over which messages travel, and so forth. Sorting out the territorial connections to activity on the Internet is, however, a difficult exercise and the reality is that activity on the Internet is not susceptible to territorial localization in the way in which activity in the non-virtual world is. The absence of territorial localization in this way stands in contrast to the historical basis of political and legal systems in which policy is formulated by governments and parliaments for the territory over which they exercise authority and the ensuing legal rights are limited to, and enforced within, the same territories."[30]

### Conclusion on the Question

We shall try to be careful about the question we are answering. The question really asks whether, in considering the principle of confusion, territorial separation reduces the possibility of confusion of one corporate name for another.

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[29] <http://wipo2.wipo.int/process2/report/pdf/report.pdf>

[30] The Recognition of Rights and the use of Names in the Internet Domain Name System : Report of the Second WIPO Internet Domain Name Process, World Intellectual Property Organization (WIPO), Geneva, September, 2001, p. 19.

The absence of territoriality on the Internet can mislead one into ignoring the importance of territoriality in consumer behaviour, and many other dimensions of life as well.

Our conclusion is that territory can still serve as an adequate distinguishing factor despite the existence of a global Internet-mediated market. We have considered this issue from the point of view of the average person in two circumstances. The first is in ordinary geographical or physical space ("meatspace" in cyber-jargon, and the second is on the Internet "cyberspace" or logical space).

Before we get into the analysis, we should state that we are not concerned with whether a company proposes to do business over the Internet or not. It is reasonable to suppose that all or most corporate name applicants will be doing business over the Internet. It could be argued that those companies not doing business over the Internet should be treated differently from those that are proposing to do so. We do not find that this possibility persuades us that territorial separation should apply in some cases and not others. The Internet will mediate business in the same way that the telephone has before it, and current intentions of an incorporating entity not to use the Internet to transact business are irrelevant.

Our analysis of how geographic separation might still be relevant is based on how ordinary people approach companies over the Internet. Let us suppose that John Smith Plumbing exists in seven places, Halifax, Vancouver, Glasgow, Alabama, Vermont, Ontario, and Kansas. How would we know this? Because we used a search engine to find out. We would not have known about these companies without one. A search engine brings up these companies and many more plumbing contractors. To have been found by a search engine, they would have to have some web presence, usually a website. The websites give addresses, telephone numbers and email addresses, as well as other information about their services. Would anyone be confused as to which one they were dealing with? No. Anyone able to use a search engine and read would recognize the seven companies as different.

The same Internet that would increase knowledge of the plumbing contractors' market, would not also increase confusion in the ordinary person's mind. The tool that increases

knowledge of all the John Smith Plumbing companies and contractors is also the tool that sorts them out.

As to consumers in ordinary space, the same considerations that lead to geography being a factor that diminishes potential confusion would continue to operate.

Accordingly, we have concluded that *the geographical separation principle can still be useful in allowing similar or identical corporate names in separate geographical areas*. It may have less effect than before because of the range of modern business. Yet the confusion which is guarded against does not really arise because of the existence of the Internet. The ordinary person using the Internet to look for plumbing contractors, or any other type of company, will not be confused by many similar or identical corporate names. The technology which identifies them also distinguishes them.

### 4.2.3 Second Question

*If clients have their domain names in their proposed corporate names, do we assume that they carry on business nationally/internationally for the purpose of determining whether their corporate names are likely to cause confusion?*

In our opinion, no assumption can be made about the range of commercial operation of a company based on its domain name. A dot-com domain name can be local and a dot-ca domain can be international.

### 4.2.3 Third Question

*Is there any longer any point in asking whether the proposed corporate name and the existing businesses operate in different geographical regions, if both proposed and existing entities also operate over the Internet?*

Our answer to this question is substantially the same as that to Question 1.

Yes. Almost all businesses will work over the Internet or have some form of web presence. But confusion is not increased by the presence of multiple companies or suppliers found through the Internet. The same technologies that identify companies of the same name are the technologies that help to distinguish their locations, product offerings, and physical

coordinates. The average person able to use the Internet is able to sort through the data. Indeed, the great advantage of the Internet is to assist the buyer to obtain more perfect information about the market for goods and services in which he is interested.

In physical space, the territorial factor increases the amount of information available by letting the average person know that « John Smith Plumbing » in Kelowna is not to be confused with a similar plumbing firm in the same town, or area code, or same province. Applying the territorial rule to the Internet does not in our view increase the information available to the user of the Internet, and inconveniences businesses to no one's particular benefit.

### 4.2.3 Fourth Question

Does the Internet reality have the same effect on the "means of distribution" factors listed in amended regulation 25 as it does for the territorial factor?

The Regulation states :

> **"25.** For the purpose of paragraph 12(1)(*a*) of the Act, a corporate name is prohibited if it is confusing, having regard to all the circumstances, including :
>
> *(a)* the inherent distinctiveness of the whole or any elements of any trademark, official mark or trade-name and the extent to which it has become known;
>
> *(b)* the length of time the trademark, official mark or trade name has been in use;
>
> *(c)* the nature of the goods or services associated with a trademark or an official mark, or the nature of the business carried on under or associated with a trade-name, including the likelihood of any competition among businesses using such a trademark, official mark or trade-name;<the nature of the trade with which a trademark, an official mark or a trade name is associated, including the nature of the products or services and the means by which they are offered or distributed;
>
> *(d)* the degree of resemblance between the proposed corporate name and a trademark, an official mark or a trade name in appearance or sound or in the ideas suggested by them; and

*(e)* the territorial area in Canada in which the proposed corporate name or an existing trade name is likely to be used."[31]

The question supposes an effect on "*means of distribution*". We see two types of distribution :

- Physical distribution;
- Digital distribution.

The first kind of distribution will depend on either physical transportation or physical presence of the provider. The second type of distribution will be possible only by electronic file transfer. The first type of distribution will not be affected by the Internet but the second type will. The distribution via the Internet of software-based products and services, including the use of the trade name or the trademark of the business would appear to increase the chance of confusion and this might constitute a circumstance to take in consideration when applying s.25(d) of the regulation.

But does it really? Again we needed to reflect on our own use of computers and shopping on the Internet. In our uses of the Internet, have we ever been confused as to the company with which we were dealing, and did this confusion ever mislead us? The answer is never, and if we had been confused, it does not matter, because the content of the information or service is what was being sought, not the corporation that owned the website or sold the product. If a website were engaged in fraudulent practice, other recourses of law are available to deal with it.

We have concluded that the means of distribution via the Internet does not really constitute a material source of confusion such that corporate naming conventions need to be tightened.

### Recommendation

No change of policy is recommended. Naming rules appropriate for preventing confusion in physical space are not made less relevant by the fact that companies also may operate in

[31] See note 7

logical space. The Internet does not affect the interpretation of territory or means of distribution for the purposes of avoiding confusion in physical space.

### 4.2.4 Extent of Protection

#### Question

Our regulation requires us to protect existing trademarks and trade names. In what circumstances does an existing domain name become a trademark or a trade name? Assuming we were to check proposed corporate names against domain names, should we check for these circumstances when approving new corporate names? If so, how?

---

### 4.2.4 First question

*Our regulation requires us to protect existing trademarks and trade names. In what circumstances does an existing domain name become a trade mark or a trade name?*

We have been unable to find clearly stated criteria or circumstances which will determine when the use of a domain name will grant its owner the protection of trademark law. It will be the responsibility of the courts to establish these criteria, based on the criteria that exist in common law. The Courts seem to indicate that they will evaluate the use of a domain name on a case-by-case basis to determine whether it constitutes "use" within the meaning of trademark law, and that they will take into account the amount of traffic on the site.[32]

We base our argument on these comments :

> "If a party intentionally or negligently causes injury and the ingredients for establishing a tort can be proved, then the new technology of the Internet and websites can be readily accommodated. It is much more sensible to apply tort

[32] FileNET Corporation v. The Registrar of Trademarks, her Majesty the Queen in Right of Canada as represented by the Minister of National Revenue, [2001] CFPI 865. At http://decisions.fct-cf.gc.ca/fct/2001/2001fct865.html Though FileNET dealt with an official mark, the reasoning is applicable to ordinary trade marks.

> principles to accommodate new technologies than to distort statutory trademark rights."[33]

*Assuming we were to check proposed corporate names against domain names, should we check for these circumstances when approving new corporate names? If so, how?*

In our opinion, Domain Names do not have a specific status in law. They have not been vested with a set of legal rights or attributes. The extent and manner of their use help to determine whether they constitute some form of common law trademark. We do not think it would be appropriate to check for these circumstances when approving a new corporate name. By analogy, Industry Canada does not check for common law trademarks or trade names which might exist when it approves new corporate names.

Registrars working under the rules of ICANN and CIRA make no inquiries about existing rights when they sell a Domain Name. Registrations are on a first-come, first-serve basis.

When new TLDs were launched recently, there were special pre-registration privileges for those who held trademarks or other forms of intellectual property, called "sunrise periods". In these periods those who could demonstrate intellectual property in certain names had privileges of registering them as domain names. After those special periods were over, those who claim intellectual property in a name have no other recourse than the Uniform Dispute Resolution Policy to get back a domain name that they claim is properly theirs.

This absence of requirement to inquire on the part of registrars was recognized in the *Bell Sygma* case :

> « Bell Sygma s'est révélée plus rapide que la demanderesse pour enregistrer le nom de son site, ce qui ne lui confère pas par le fait même une exclusivité, mais Internet n'est pas une agence légalement autorisée à reconnaître des droits en vertu de la *Loi concernant le droit d'auteur* (S.R. ch. C-30 et amendements). Internet suit la règle du premier arrivé et ne se soucie pas de trancher les conflits de ce genre et elle fait bien. »[34]

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[33] Pro-C Ltd v. Computer City Inc. (2001-09-11) ONCA C34719, par.16.
At <http://www.ontariocourts.on.ca/decisions/2001/September/pro-cC34719.htm>
[34] Visual Conception Visuelle Inc. c. Bell Sygma Inc., REJB 1997-00630 (C.S.)

### 4.2.4 Second Question

*If a domain name is not a trade name or trademark, should regulations be amended to protect the public against confusion with domain names per se? With only ".ca" domain names? How would we justify protecting ".ca" and not protect against confusion with ".com", ".org", etc.?*

We see very little point in protecting the public from confusion of domain names with trademarks Actually, we see a problem with modifying regulations or statutes to protect the public against such confusion. These laws have the effect of granting legal protection to trade names and marks. They extend no such protection to domain names. Consistent with our position that Industry Canada's policies should not be determined by policies made elsewhere concerning Internet identifiers, we see no advantage in protecting some or all domain names from confusion with trade names and marks. The actual procedures of ICANN and CIRA offer remedies if domain names are registered contrary to someone else's intellectual property rights.

If it were thought desirable to try to protect the public against confusion of trade names with domain names, and we do not share this view, one option might be modifying CIRA policies to require a preliminary NUANS search. This would dramatically raise the cost of registering a dot ca domain and cripple it relatively to the dot com and other generic TLDs.

### 4.2.4 Third Question

*If in granting corporate names we concern ourselves with protection against confusion with domain names, should we be requiring a separate search of domain names? What kind of search?*

We urge the government not to undertake any such course of action. Domain names are registered on a first come, first served basis, and if the rights of any intellectual property owner are affected, the UDRP and its equivalent process in the dot ca domain allows for proper redress. Domain names may be as wild as the imagination can devise; there are no statutory or other criteria in place to limit them.

We understand that the protection of the public against confusion is an important aspect of Industry Canada's tasks and that the Domain Name System (DNS) may actually be a source of confusion.

However a preliminary search of domain names before a corporate name is approved could be interpreted as according domain names a status approaching or equalling a trade name. More than one enterprise in Canada can have a legitimate interest in a particular domain name, but the dispute resolution principles were devised to deal with such cases.

The CIRA dispute resolution policies are based on these principles :

"3.1 **Applicable Disputes**. A Registrant must submit to a Proceeding if a Complainant asserts in a Complaint submitted in compliance with the Policy and the Resolution Rules that :

(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;

(b) the Registrant has no legitimate interest in the domain name as described in paragraph 3.6; and

(c) the Registrant has registered the domain name in bad faith as described in paragraph 3.7."[35]

**"4. Mandatory Administrative Proceeding**

This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one of the administrative-dispute-resolution service providers listed at www.icann.org/udrp/approved-providers.htm (each, a "Provider").

**a. Applicable Disputes.** You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that :

(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) you have no rights or legitimate interests in respect of the domain name; and

(iii) your domain name has been registered and is being used in bad faith.

[35] CIRA Domain Name Dispute Resolution Policy, CIRA Official documents, November 2001. At http://cira.ca/official-doc/95.policy__final___November_29__2001___en.pdf

> In the administrative proceeding, the complainant must prove that each of these three elements are present."[36]

In addition to the dispute resolution processes, applicants complaining of trademark infringement have recourses to the courts for this purpose. They may also have recourses under the Competition Act in certain cases.

> "À supposer qu'il existe, la nature juridique du nom de domaine réside autant dans sa valeur économique intrinsèque directement issue de sa rareté relative - ce qui le rapproche d'une marque - que dans l'habile discours du milieu juridique. Il faut d'abord le dire clairement : le nom de domaine n'est pas, selon nous, une simple adresse, mais constitue un signe qui, s'il sert à promouvoir une activité commerciale, pourra être éligible sous certaines conditions à la protection de la *Loi canadienne sur le droit des marques*. Ces conditions, notons-le dés maintenant, sont assez restrictives et le sont d'autant plus que la technologie d'Internet n'était pas prévue. S'il n'est pas de notre tâche de faire l'exposé du droit des marques, une attention suffisante à la loi fédérale permettra de s'en convaincre. Nous analyserons successivement l'action en contrefaçon (i), l'action en concurrence déloyale (ii), puis le cas particulier de l'article 22 de la *Loi canadienne sur les marques de commerce* sur la dépréciation de l'achalandage (iii)."[37]

At the moment, most applicants for corporate names are routinely searching domain name registrations in all gTLDs, through the Whois system, to see if other domain name registrations conflict.

A search showing a lack of conflicts should not be interpreted as a specific right in a corporate name by the owner of a domain name. An owner of a domain name would have to prove the kind of use and recognition which can give him some common law trademark rights. Two or more enterprises can have an interest in a specific domain name, subject to it being sorted out by dispute resolution processes. Contrary to the corporate name system, which permits the registration of the same name more than once on a basis of geography and on the categorization of wares and services, the DNS will not permit multiple registrations of the same name. The use of a domain name should not automatically give an exclusive right on the use of

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[36] ICANN Uniform Domain Name Dispute Resolution Policy, ICANN Resources, August 1999. At http://www.icann.org/dndr/udrp/policy.htm
[37] See note 27.

the name. "Bell Sygma was shown to be faster than the plaintiff to register the name of its website, which act does not confer upon it a right to exclusivity?"[38]

Supposing that Industry Canada asks the future registrant to research the availability of domain names and to give them the result, what would be the implications? If a potential registrant for a corporate name does the research asked for by Industry Canada, and finds that a confusing domain name exists (on the who is of dot com, or dot org, or dot ca] the search asked for by Industry Canada gives the potential registrant the opportunity to see if the domain name, corresponding to his proposed corporate name, is available. He probably does this anyway in today's environment. In fact, he has probably secured several domain names in anticipation of the risk that Industry Canada might not accept a proposed corporate name, on the basis of its stricter standards. If the domain name exists but it is registered by a Japanese company, or, if it is for a company in another services or products category, Industry Canada has no basis of concern, according to its rules.

Ultimately, if a domain name is in the same geographical area, in the same category of services or wares, and Corporations Branch foresees potential confusion, but only on the basis of the use of a domain name, it cannot automatically conclude that the first registrant has common law trademark rights in the name. It would depend on the global use of the name or the mark.

So, then, what purpose is served by requiring a search of domain names? If one is required, it will be only for the benefit of a potential registrant who needs a domain name which will correspond to his corporate name. He will be able to see that the domain name is not available and give indication that maybe an unregistered trade name or a mark exists and could benefit from the protection of the law. It seems appropriate to conclude that Industry Canada does not need to ask potential registrants to reveal the results of their (presumed) separate search of available domain names because the registration of a domain name grants no status in law.

### Recommendation

There is no need to change the Regulations to give status or protection to domain names.

[38] Visual Conception Visuelle Inc. c. Bell Sygma Inc, See, note 2.

### 4.2.5 Use

#### Question

An existing business that is using its name or trademark can make an allegation to the Director that a corporate name causes confusion with its name or trademark, and request the Director to order a change of that corporate name (s. 12(2)). If the regulations are not amended to specifically protect domain names, (thereby giving a domain name holder standing to make an allegation under s. 12) does Internet use of a domain name, which forms the greater part of the business name of the entity alleging confusion, constitute use of that business name sufficient to give the entity standing to make the allegation on the basis of its business name alone?

If this is a policy question, it is consistent with our approach that Industry Canada should protect *corporate names and trade names,* and if the major portion of a corporate name is (incidentally) a domain name, Industry Canada should protect it.

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This is how we see the situation arising. Your trade name is the same as your domain name. You come to Industry Canada with your trade name. The only use you have made of it is on the Internet. Does that Internet-based use of the trade name give you standing to ask the Director to take a corporate name away from a third party?

"Use" means actual use by a person that carries on business in Canada or elsewhere. According to section 17 of the Regulations[39], does use on the Internet constitute “use” within the meaning of section 17 such that you can complain to the Director that a corporate name should be overturned?

#### Conclusion

We see a reasonable basis for finding that use on the Internet of a domain name which forms the greater part of the business name of the entity alleging confusion, constitutes *use* of that business name sufficient to give standing to make the allegation on the basis of its business name alone.

[39] See note 7.

That the entity should gain standing does not automatically guarantee that it wins its case. The second point is that the Director might wish to investigate the conditions under which the entity is using the business name, but this is a different issue than the standing to bring the complaint. In the circumstances described above, we feel comfortable that the person carrying on business has the necessary standing to make the complaint.

### Recommendation

Corporations Branch should accept Internet use as a basis of standing in this instance, whether or not there is a registered business name or trademark.

### *4.3 Deceptively Misdescriptive*

#### Question

Should we verify whether proposed corporate names containing @, .ca, .com, etc. are registered for Internet purposes and if so, reject the name for being deceptively misdescriptive?

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#### Deceptively Misdescriptive Names

> **“32.** For the purpose of paragraph 12(1)(*a*) of the Act, a corporate name is deceptively misdescriptive if it is likely to mislead the public, in any language, with respect to :
>
> *(a)* the business, goods or services in association with which it is proposed to be used;
>
> *(b)* the conditions under which the goods or services will be produced or supplied or the persons to be employed in the production or supply of the goods or services; or
>
> *(c)* the place of origin of the goods or services.”[40]

We think the use of Internet-derived typographical symbols in the trade name of a corporation will probably cause the reader to infer an Internet presence of the corporation at the apparent domain name address. The question is: to what degree is this misdescriptive? Or if misdescriptive, does it matter? To be deceptively misdescriptive, the name must mislead the public, with respect to :

> *(a)* "the business, goods or services in association with which it is proposed to be used;
>
> *(b)* the conditions under which the goods or services will be produced or supplied or the persons to be employed in the production or supply of the goods or services; or
>
> *(c)* the place of origin of the goods or services.”[41]

[40] See note 7

The misdescriptions with which we are concerned here are that :

1. the company appears to have a domain name in a certain category, but does not have one in that category (such as dot ca);

2. or has failed to procure a web address at the purported address;

3. or has an address related symbol (@), but has no email address.

The company is seeking the cachet of a web presence through a corporate name, which may promise more than it delivers. In our view, this is somewhat akin to including a telephone number into one's corporate name, and then failing to have a telephone number, or failing to have call forwarding when the corporation's telephone number changes. It may be deceptively misdesriptive – at a stretch – but it is the company, and not the computer user searching for the company, which is harmed. In any case, the non-computer user may be deceived into thinking that the company in question is more computer-centred than it is, but since he does not use a computer to find companies on the Internet, his "deception" is, in our view, immaterial. If the computer-user goes to the wrong website, or cannot find a web site, he may conclude that the company is stupid, in which case he is not deceived but is made aware of their technical incompetence. And if he locates them through a search engine, despite the apparent false name, it is doubtful he was deceived.

Supposing that the Department of Industry decides to view this matter more seriously, it can be easily addressed. Proof of the domain registration corresponding to the proposed trade name could be a good way to restrain the risk of deceptively misdescriptive names. We also think that the presence of these typographical symbols does not have to lead to an automatic conclusion of a deceptively misdescriptive name if the corporation does not hold a registered domain name at this address. The absence of the proof of registered domain name can be interpreted as a presumption of a deceptively misdescriptive name which can be reversed by arguments and facts brought up by the corporation.

[41] See note 7

One possibility worth considering (though it is outside the boundary of the question asked) is whether a proposed name contains identifiers (pertinent to the DNS, or SIP, or others which may be invented) which would lead one to believe that it, or a major product it offers, complies with some Internet standard, but does not. Standards for how things work on the Internet are mostly set by the Internet Engineering Task Force, or IETF. Suppose that the symbol # designated a service which is supposed to comply with an IETF standard. We considered this possibility but rejected the idea that Corporations Branch should enforce the rules of logical space. In order to concern itself with this type of misdescription, Industry Canada would be violating the rule we established, that it would not enforce naming conventions of logical space.

Turning back to the question asked, we are skeptical that the Corporations Branch is protecting the real interests of the consumer, and maybe only the corporation from its own stupidity, if it concerns itself with this form of misdescription. Once again, we are motivated in our position that the corporate naming system should not be driven automatically by criteria and decisions made by different naming systems. On the other hand, accuracy in naming conventions may create a public interest that corporate names translate accurately into domain names if they purport to do so.

### Recommendation

Corporations Branch should not verify whether a domain name is actually registered for the purposes of verifying whether a name is deceptively misdescriptive.

## *5. The NUANS Corporate Name Search System*

NUANS is an electronic search system comparing a proposed name against a national data bank of existing and reserved trade names, and registered and applied-for trademarks. If we change our regulations and/or policy to protect domain names and if we require applicants to search existing domain names, is NUANS a useful tool on which they should search? Since it is based on phonetic equivalence, is NUANS appropriate for searching existing similar domain names, which are visual and precise in nature?

NUANS (Newly Upgraded Automated Name Search) is a computerized search system that compares a proposed corporate name or trademark with databases of existing corporate and unincorporated bodies and trademarks. This comparison determines the similarity that exists between the proposed name/mark and existing names in the database, and produces a listing of names that are found to be most similar.

It is easier to understand exactly what NUANS does by looking at how it operates internally. NUANS uses a sophisticated algorithm to match bit-patterns. The signature of a proposed application (its bit-pattern) is compared against the signatures of several million other records (the NUANS database).

When the signature comparison algorithm returns a positive match, the record set of the corresponding match is then queried, the result of which search then appears on the corporate name search report. This entire process is done in batch mode, non-interactively. Currently, a search will not compare signatures of records that have been added within the last hour. Improvements are being made so that this delay will be reduced to one minute.

The bit pattern signature on which NUANS makes comparisons is of 192 individual values of one or zero (or bits) in size. Out of the following 192 bits, the allocations mentioned hereunder are made :

8 bits : Geographical correlation

26 bits : Description of the line of business, industry code, etc.

10 bits : Numerical digits in the corporate name

60 bits : Phonetic contents, phonetic sequences, syllable counts

26 bits : Anagrams

26 bits : Acronyms

24 bits : Spelling and common letter pairs

12 bits :	Reserved for future use

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192 bits

NUANS will typically return queries that match the highest 25 of 36 overall attributes reflected in the signature bit pattern for each entry in the database.

In addition, NUANS will discard legal elements or legal designators appended to a corporate name such as Limited, Corp, Corporation, etc., as a potential differentiator between name applications. Similarly, NUANS will also discard leading words such as (The, Le, La, Les) prepended to a corporate name. NUANS will, in addition, confer lower weights on certain common words such as “Enterprises” often featured in several corporate names.

The desire to register corporate names featuring existing Internet identifiers suffixes such as domain names (i.e. company.ca Inc.) or prefixes such as protocol identifiers (SIP:service.company Inc.) or both a prefix and a suffix (SIP:service.company.ca Inc.) would require NUANS to filter for such prefixes and suffixes as part of the algorithm which discards legal elements or designators and leading words. This would make it possible for NUANS to continue operation considering the same criteria that it has used so far.

In the event that it is deemed necessary that NUANS consider the presence of Internet identifiers, it would be desirable for NUANS to validate that the same Internet identifiers are not sources of confusion. The purpose of registering a corporate name featuring an Internet identifier, such as a domain name, (i.e. Company.ca Inc.) is to facilitate the public reaching the Internet-based service designated by the corporate name (i.e. the website of Company.ca Inc.).

The likely duration of the domain name system is on the order of five to ten years before it can be replaced with, or loses its current predominance to, a better Internet-based identifier system. Such a new identifier system would make it possible to have multiple root directories and would not be dependent on the first-come first-served principle to prevent conflicting entries from being registered in the global directory. Such conflicting entries could be told apart by

underlying Internet identifiers guaranteed to be globally unique. This is more or less the function performed by search engines today.

### Answers to the Questions

*1. If we change our regulations and/or policy to protect domain names and if we require applicants to search existing domain names, is NUANS a useful tool on which they should search?*

No, not currently. NUANS can be modified to import domain name databases though the Whois system can be used to determine who owns domain names.*Since it is based on phonetic equivalence, is NUANS appropriate for searching existing similar domain names, which are visual and precise in nature?*

The premise of the question is inaccurate. NUANS' search algorithms check for several criteria and can be modified to suit new criteria.

### Conclusion

If Corporations Branch wishes to modify the NUANS to search for domain name information, it can be modified to this purpose.

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