

CIRA DRP CONSULTATION
Canadian Internet Registration Authority (CIRA)
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Ottawa, Ontario
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Dear Sir:

I am writing on behalf of the Chief Information Office Branch of Treasury Board Secretariat of Canada to express our views with respect to the September 7, 2001 draft of the CIRA Domain Name Dispute Resolution Policy and Rules. We (and our legal advisors) have examined the draft policy and rules in light of a number of cases in the dot.ca domain where registrants have appropriated Government of Canada-related domain names. Briefly, we are concerned that the policy and rules may not be as flexible as they need to be to protect the legitimate interests of the Government of Canada in the integrity of its Internet presence.

1. Indicia of Bad Faith Registration

The principal problem with the indicia of bad faith is a logical one, i.e., the problem is that a demonstration of bad faith registration depends almost entirely on a demonstration of the registrant's purpose, e.g, to resell, to prevent rightsholder from registering, to disrupt a competitor, etc. But it is logically impossible to make an inference from the fact of registration(s) alone. Who knows what the registrant's purpose was, based on the registration alone? We can have no real knowledge of what the registrant's intentions might have been. This is perhaps most obvious in the case of a registrant who takes a name and "parks" it - "passive holding" in the Uniform Dispute Resolution Policy jurisprudence. If the registrant merely parks the domain name, there is quite simply no evidence on which to ground a conclusion about the registrant's purpose. And therefore no basis on which to make a finding of bad faith.

If, instead of parking the domain, the registrant used the address to interfere with public access to government Web sites - a form of public mischief - this would not appear to qualify as bad faith either. The bad faith criteria are mostly referable to registration and not use, e.g., offering to resell, preventing rightsholder from registering, disrupting competitors, etc.. It would appear that perhaps the policy and rules lost something in the move to these bad faith criteria that fasten exclusively on registration and (ostensibly, at least) ignore bad faith use.

In the September 2000 iteration of the CIRA DRP, one of the indicia of bad faith registration was to be found in Para. 9.4.1(g): the registrant has registered, or acquired registrations of, multiple domain names which the registrant knows or has good reason to believe are confusing with marks in which other persons have rights at the time of registration of such domain names.

Although this criterion would probably serve us better than the September 2001 iteration of bad faith, it suffers from the problem of requiring the Complainant to establish that the registrant "knows or has good reason to believe". It is a mistake to require a conclusion (and evidence to support that conclusion) about the intentions of the registrant. Criterion (g) above would serve its purpose much better if it simply removed the reference to the registrant and his intentions. It would be enough, then, to demonstrate that the registrant has registered or acquired registrations of multiple domain names which are confusing with marks in which other persons have rights at the time of registration of such domain names.

I would urge CIRA to include such an element in its indicia of bad faith, i.e., bad faith registration could be demonstrated where the registrant has registered or acquired registrations of multiple domain names which are confusing with marks in which other persons have rights at the time of registration of such domain names

2. Registrant has legitimate interests if registrant has used the domain name in Canada in good faith, etc.

Article 3.6(d) describes a legitimate interest as including situations where a "Registrant has used the domain name in good faith in Canada in association with a non-commercial activity including, without limitation, criticism, review or news reporting.

I am concerned that this provision tips the balance too far against the interests of legitimate trademark holders. According to this provision, a registrant with a Web site dedicated to criticising General Motors of Canada would have a legitimate interest in the generalmotorsofcanada.ca domain and would prevail in an arbitration initiated by General Motors. Surely, a registrant should have no right to appropriate someone else's trademark simply because the registrant has a constitutional right to criticise the rightsholder.

I note that most of the other indicia of "legitimate interests" contain an element by virtue of which the registrant has some prior right, e.g., where "the registrant has rights in the mark"; where the registrant has used the name in association with wares, services or a business; where the domain name is made up of the registrant's own name, etc. There is no equivalent element in Article 3.6(d), with the result that someone with no prior right of any kind can appropriate the interests of a legitimate trademark holder simply because the registrant has a "legitimate interest" in criticism, review or news reporting vis-à-vis the trademark rightsholder. I would suggest that there must be more effective ways of protecting constitutional rights to freedom of expression than permitting critics to appropriate the domain names and legitimate interests of trademark rightsholders.

3. Precedents

At Paragraph 3.2(m) it is said that a Complaint should include a "summary of, and references to, prior decisions in CIRA Proceedings which the Complainant considers persuasive."

I would suggest that this is a very parochial limitation. Why would the precedents be restricted to CIRA jurisprudence? If, for example, one of Canada's leading trademark lawyers, in another UDRP forum, decides that the Government of Canada enjoys common law trademark rights in the names of its institutions, why could we not import that finding as a precedent in CIRA proceedings? Why would we have to establish that proposition over again in CIRA jurisprudence?

4. Search by Registrant

It would be of considerable assistance to the Government of Canada, and doubtless other institutions as well, if CIRA offered a search-by-registrant feature. In some cases, domain names are registered, sometimes by the same person, with a great many variations on the names of federal institutions.

For purposes of formulating a CIRA DRP Complaint, it would obviously be preferable if we could identify all the Government of Canada-related domain names held by a particular registrant.

I hope that these comments will prove of assistance to CIRA in formulating the next iteration of its Dispute Resolution Policy. We hope soon to be able to use those rules to protect the legitimate interests of the Government of Canada in the integrity of its Internet presence.

Yours sincerely,

Helen McDonald
Director General
Government On-Line