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## **NEWSLETTER - NOVEMBER 2005**

### **CANADIAN DOMAIN NAME ALTERNATIVE DISPUTE RESOLUTION**

Microsoft owns a number of trademarks comprising or prefixed by the letters MSN, and the domain name <msn.ca>. Microscience Corp. registered the domain name <msnsearch.ca>. Apparently mistakenly thinking that the Canadian alternative dispute resolution (ADR) Policy administered by the Canadian Internet Registration Authority (CIRA) is similar to the Uniform Domain Name Dispute Resolution Policy (UDRP) applied in the US, Microsoft elected to file a complaint with CIRA. Microsoft lost, although it probably would have won if a parallel situation had been adjudicated in the US pursuant to the UDRP. And Microsoft would probably would have won in Canada had it elected to file a lawsuit based on trademark infringement or passing-off instead of relying upon CIRA's ADR proceedings.

The Microsoft decision reflects serious deficiencies in the CIRA Policy. Although confusion between Microsoft's prior trademarks and the domain name <msnsearch.ca> was established, Microsoft could not establish under the Canadian test that the registrant Microscience Corp. had registered <msnsearch.ca> in bad faith - a prerequisite to success against the registrant in the proceedings. Under the US test, "bad faith" is given its ordinary everyday meaning, and since Microscience presumably was well aware of Microsoft's family of MSN trademarks, its bad faith in selecting the domain name <msnsearch.ca> could readily be inferred. But under the Canadian test, bad faith is established only if it is proved that

- the registrant intended to attempt to sell the impugned domain name to the complainant or a competitor of the complainant; or
- the registrant registered the impugned domain name to prevent the complainant from registering it, and this conduct was part of a pattern of behaviour on the part of the registrant; or
- the complainant is a competitor of the registrant, and the registrant intended to disrupt the complainant's business.

Microsoft could not prove any of the foregoing, so its complaint failed. But note that deliberate confusion of the public, misappropriation, and dilution of the complainant's trademarks could all occur without there being "bad faith" under the Canadian test.

This and other recent CIRA decisions reflect the inadequacy of the Canadian ADR procedure. Trademark owners who wish to complain about confusing domain names registered by others would be well advised to do so in a Canadian court of law. A Canadian court would be expected to provide suitable remedies for trademark infringement and passing-off; including punitive damages in appropriate cases, as well as an order for transfer to the plaintiff or expungement of the impugned domain name.

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