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THE LAW OF SOCIAL MEDIA AND DOMAIN NAMES

Burshtein and Turco

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This publication considers the commercial and legal realities of how trademarks and domain names are used and perceived on the Internet in the context of established trademark and related legal principles. It sets out the history of, the technology underlying, and the legal issues relating to, the international domain name system. The publication analyzes whether a domain name is property or some other type of right, and it considers the WHOIS database directory of domain names. The text comprehensively deals with the acquisition and violation of trademark and related rights on the Internet. It also analyzes the many practices and techniques that have emerged on the Internet that, when effected in association with a trademark, trade name or individual name, pose fundamental challenges to the essence of trademark and related laws. These practices and techniques include references to trademarks which are typically the subject of national rights on websites which are available on a global basis.

What's New in this Update:

This release features significant updates to Chapter 36. Violation of Web 1.0 Trademark Rights.

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Highlights:

Part III. Domain Names—Chapter 36. Violation of Web 1.0 Trademark Rights—IV. Depreciation of Value of Goodwill—§ 36:18. Use—The following is an excerpt from this section—The statutory right to restrain depreciation only applies to registered trademarks. Further, the right may only be asserted where a trademark is “used” in Canada within the meaning of the TMA. For example, if a trademark which is registered only for use in association with goods is merely referenced in comparative advertising, it may not be “used” within the statutory definition and the registrant may not be able to restrain such activity. It is easier to restrain such activity where a mark is used in association with services because advertising of a trademark in association with services may constitute use. The defendant’s mark need not be identical to the registered mark to establish a cause of action, although some cases have said that there is no liability under section 22 where one does not appropriate the mark as registered. For example, in *Red Label Vacations Inc v. 411 Travel Buys Ltd.*, the court did not consider “red tag” to be use of the registered trademark “redtag.ca,” noting that ‘Use’ under section 22 requires use of the plaintiff’s trademark, as registered.

Conversely, in *Venngo Inc. v. Concierge Connection Inc.*, section 22 of the TMA was considered as applying to “use of a mark that, while not identical to the plaintiff’s registered trade-mark, is so closely akin to the registered mark that it would be understood in a relevant universe of consumers to be the registered mark.” In *Toys “R” Us (Canada) Ltd v Herbs “R” Us Wellness Society*, the court found that use of a HERB R US Design mark was sufficient to establish that the defendant has used the plaintiff’s TOYS R US mark, for the purposes of engaging section 22. In *Energizer Brands, LLC v. Gillette Company*, the court concluded that the defendant’s use of the phrase “the bunny brand” was capable of evoking an image of Energizer’s the ENERGIZER bunny. The court appears to have decided that Duracell’s use of the phrase to refer to Energizer’s trademark satisfied the first and second parts of the test, because, although the reference was not comprised of the registered trademark itself, the only issue was whether reference to ‘the bunny brand’ was something closely akin to the registered trademark.