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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.

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What's New in this Update:

This release features updates to Chapter 47 (CIRA Domain Name Dispute Resolution Policy: Bad Faith). Appendix I (Case Decisions and Digests) has also been updated in this release.

Highlights:

Part III (Domain Names)—Chapter 47 (CIRA Domain Name Dispute Resolution Policy: Bad Faith)—IV (Bad Faith: Blocking Complainant)—§ 47:18. Purpose—The following is an excerpt from the updates made to this chapter:

- Another decision [*Boston Pizza Limited Royalties Partnership v. Hunter Parsons*, 22766-CDRP, July 12, 2024 (CIIDRC)] highlights the potentially high bar for a determination of bad faith. This decision addressed the use of the domain name `bostonpizzamenu.ca`, which resolved to a website that purported to provide up-to-date menu details of BOSTON PIZZA restaurants. The Complainant made three arguments under the bad faith prong, including that (i) the confusing similarity between the domain name and its trademark was, on its own, evidence of bad faith, (ii) the registrant was well aware that the domain name would misrepresent to the typical internet user that any associated website was owned and operated by the complainant, and (iii) the registrant used a proxy service to register the domain name indicated bad faith. The complainant also indicated that the website contained false and misleading pricing and product information but provided no evidence to support this claim.
- The panel disagreed with the first argument, stating that if it were true, the first and third prong of the test would be redundant. With respect to the second argument, the panel noted that the website has a disclaimer on each page. While the panel noted that if the disclaimer was unclear in its content, hard to read, or placed in an inconspicuous part of the website, it may not be enough to defeat an allegation of bad faith, none of these were the case in this matter. With respect to the third argument, the panel noted that this is a common argument advanced, but it would need to be coupled with other conduct that would make for a bad faith allegation, which was not the case here. In other words, there is nothing inherently wrong with using a proxy or a privacy shield to register a domain name. Finally, the panel acknowledged that the potentially false or misleading pricing and product information could be a factor in the bad faith analysis. However, no evidence was introduced to back this up. The panel ultimately concluded that this was a close call, and ultimately, because no evidence was led regarding the false or misleading content of the website, the panel was not satisfied on a balance of probabilities that the domain name was registered in bad faith.