

# Foreign Companies and .ca Domain Names - Obstacles to Registering a .ca Domain Name (Part One)

Jonathan G. Colombo and Catherine Lovrics

© 2010 Bereskin & Parr LLP

---

Canadians will often type in a .ca domain name when looking for the Canadian version of a website. As this practice becomes more common, .ca domain names become more attractive to foreign companies. However, foreign companies are often surprised by the obstacles they will face when trying to register .ca domain names in Canada.

The Canadian Internet Registration Authority (CIRA) is the registry for the .ca domain. It sets and enforces the requirements for .ca domain names, including the Canadian Presence Requirements (CPRs) and Registrant Agreement (CRA).

Under the CPRs, a foreign company is entitled to register .ca domain names that consist of, or include, the exact word components of its registered Canadian trade marks. Put differently, without a registered trade mark, a foreign company may not be able to register .ca domain names that correspond to its unregistered trade marks. A trade mark application will not meet the CPRs either.

Unfortunately, foreign companies without a Canadian trade mark registration will face three additional obstacles when trying to protect their mark in the .ca space. First, there are typically no "local contact" service providers that register .ca domain names on behalf of foreign companies. Second, the CRA prohibits a registrant from allowing any third party to use or operate a .ca domain name. Third, the CRA also prohibits the registration of a .ca domain name by an agent for, or on behalf of, any third party. It appears that CIRA is auditing for compliance with the CPRs, so non-compliance is increasingly risky. If a registrant is found to have failed to meet the CPRs, CIRA does not give the registrant the opportunity to correct the registration or transfer it so that the requirements can be met. In fact, CIRA may simply cancel the registration.

However, a foreign company can reach an agreement with a Canadian subsidiary or incorporate a Canadian company to register and operate a .ca domain name. A written agreement is advisable to specify the terms of the trade mark or domain name licence and address what will happen if and when (i) the licence is terminated, or (ii) the licensor meets the CPRs. The agreement should also be carefully worded to avoid violating the above CRA prohibition against granting rights in a .ca domain name. Technically the registrant cannot register or use the domain name "on behalf of" the licensor. Rather, the registrant should be a licensee of the trade mark, but actually own and use the domain name. Agreements should be worded, for example, to make clear that the licensor controls the use of the trade mark, but not the domain name *per se*.

In Part Two of this series, the limitations of the Canadian Domain Name Dispute Resolution Policy will be discussed.

**Jonathan G. Colombo**, B.A., M.A., LL.B., is the Managing Partner of Bereskin & Parr LLP, and a member of the Trade Mark Practice group. Jonathan can be reached in Toronto at 416.957.1613 or [jcolombo@bereskinparr.com](mailto:jcolombo@bereskinparr.com).

**Catherine Lovrics**, B.A., LL.B., is an associate lawyer with Bereskin & Parr LLP's Trade Mark Practice group. Catherine can be reached in Toronto at 416.957.1163 or [clovrics@bereskinparr.com](mailto:clovrics@bereskinparr.com).