



European Communities Trade Mark Association

## **Comments of ECTA, the European Communities Trade Mark Association on the results of ICANN Study on the Prevalence of Domain Names Registered Using a Privacy or Proxy Registration Service**

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### **About ECTA**

ECTA is the European Communities Trade Mark Association. ECTA numbers approximately 1500 members, coming from the Member States of the European Union, with associate members from all over the world. It brings together all those persons practising professionally in the Member States of the European Community in the field of trade marks, designs and related IP matters.

### **Comments**

The contents of ICANN Study (the "Study"), shows a phenomenon that is constantly increasing and that creates concern among trade mark owners, who are continuously confronted with the defence of their intellectual property rights on the Internet.

As the Study indicates, a privacy service provider offers alternate contact information that the registered name holder may choose to have listed in a Whois record, while a proxy service provider acts as registered name holder of record and licenses the use of domain name to the customer or beneficial user of the domain name.

Accordingly, if a domain name is registered through a privacy service provider, the domain name proprietor can request the privacy service provider to conceal their identity and contact details. Likewise, if a domain name is registered through a proxy service provider, the proprietor of the domain name is the service provider, but the entity/individual who is effectively interested in the use and maintenance of the domain name is the service provider's customer or beneficial user of the domain name, whose identity is undisclosed. The purpose of these comments is not to question about the existence and activity of privacy/proxy service providers.

ECTA is well aware of the fact that privacy/proxy service providers do exist, are well established and it is most likely that the number of domain names registered through them will increase in the future. ECTA also recognises that for individuals owning domain names, particularly in the European Union, the use of privacy services or hidden contact information reflects the general data protection concerns within the EU.

However, ECTA, on behalf of its members and as an association representing trade mark owners, believes that the Whois proxy/privacy service rules should be regulated more strictly to ensure that mechanisms to reveal undisclosed information be implemented, if particular circumstances so require. Currently, no specific rules exist on this issue.



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The ICANN Registrar Accreditation Agreement (“RAA”) provides for specific obligations to Registrars to ensure public access to data on registered names, including:

- the name and postal address of the registered name holder;
- the original creation and expiration dates;
- the administrative contact name, postal address, email address, telephone number, and fax, where available, etc.

However, the RAA does not contain any provision regulating Whois information provided by privacy/proxy service providers. It is not clear why this particular issue was not addressed in the revised version of the RAA of 21 May 2009.

ECTA believes that ICANN is well aware of the concern that proxy/privacy service providers raise in the Internet constituency in general, and among owners of IP rights in particular: the GNSO is undertaking work to look at whether a significant percentage of the domain names used to conduct illegal or harmful Internet activities are registered via privacy or proxy services to obscure the perpetrator’s identity. One part of this study is to try to determine how many abusive domain name registrations (cyber squatting) were registered through privacy/proxy service providers.

This issue is of particular concern to trade mark owners because privacy/proxy service providers generally decline revealing who is effectively behind a domain name that was registered through them, or will only after the domain name is challenged through a UDRP complaint.

As a result, often cease and desist letter sent before the filing of a UDRP complaint remain unanswered and the trade mark owner is deprived of the possibility to settle the matter amicably or elaborate useful arguments and find adequate evidence to support a UDRP procedure. Very frequently, trade mark owners who decide to challenge a domain name registration based on their earlier rights are forced to file their complaint against the privacy/proxy service provider who, only at this stage and in order not to be involved with the dispute resolution procedure, reveals the domain name holder’s name.

At this point, if the respondent’s name indicated in the UDRP complaint does not coincide with the effective domain name holder, which is always the case when the domain name holder registered its domain through a privacy service provider; the complainant is forced to amend its complaint to reflect the name of the effective domain name holder.

The lack of prior information regarding the respondent’s name in UDRP proceedings creates an undue burden on the complainant, who not only needs to modify its complaint by inserting the name of the respondent as communicated by the Registrar after the filing of the complaint, but often needs to substantially modify the contents of the complainant itself, to demonstrate the respondent (or beneficial user) lack of rights or legitimate interests and bad faith in the registration and maintenance of bad faith.

Moreover, without knowing certain information, such as the exact date of creation of a challenged domain name, the complainant may find it quite difficult to prove the respondent’s lack of rights or legitimate interests and bad faith.



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The domain name creation date is one of the key pieces of information that anyone using a privacy service provider may ask to conceal.

Trade mark owners should be able to protect their trade mark rights rapidly and effectively and to do so they need to know, in advance, who is the person or entity that registered the domain name they want to challenge.

Many Registrars ensure the possibility to request the disclosure of the registered domain holder data, whenever these data have been concealed for privacy protection of individuals. This is achieved by filing an expressed and motivated request to that effect. The concerned Registrars reveal the registered domain holder information, once they have verified that the petitioner has a prima facie legitimate reason for obtaining the requested information. ECTA considers that such a practice is a good approach to balancing the contrasting needs of trade mark owners and privacy/proxy service providers and requests ICANN to take in consideration this view and to work towards the achievement of this goal.

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