



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

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26 April 2013

Generic Names Supporting Organization Working Group
ICANN

via email: comments-locking-domain-name-15mar13@icann.org

RE \\ Initial Report on the Locking of a Domain Name Subject to UDRP Proceedings Policy Development Process

Dear Sirs,

I have pleasure in submitting FICPI's comments on the above mentioned report.

Yours faithfully

Julian Crump
Secretary General of FICPI

Enc



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Comments by FICPI

Introduction

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, having more than 5000 members in more than 85 countries refers to the Initial Report provided by the Generic Names Supporting Organization Working Group tasked with addressing the issue of locking a domain name subject to Uniform Domain Name Dispute Resolution Policy (UDRP) proceedings Initial Report and the call for community input on the preliminary recommendations contained in the report.

As recognized in FICPI's initial comments filed on August 14, 2012, FICPI believes that the current UDRP functions well in meeting the needs of both domain name holders and trademark owners. The only changes or clarifications that may be needed relate to the implementation of the UDRP rather than the language of the policy itself. One of the procedural issues – actually a need for procedural clarification – relates to the locking of a domain name subject to UDRP proceedings.

FICPI appreciates the work done by the Working Group (WG), considering that there is currently no uniform approach relating to the locking of a domain name subject to UDRP proceedings, thereby resulting in confusion and misunderstandings, and generally accepts and agrees with the conclusions and suggestions now presented by the Working Group.

Our further comments and suggestions are expressed below:

Preliminary Recommendation #1:

In this context, the term “lock” means preventing any changes of registrar and registrant [without impairing the resolution of the domain name]

As FICPI previously stated, it should be clear that the “locking” of a disputed domain name means that any request for the transfer of this domain is denied. The proposed clarification of the term “lock” as “preventing and changes of registrar and registrant” is therefore acceptable and clear. Further, FICPI has no objections to the proposed addition “...without impairing the resolution of the domain name”.

Preliminary Recommendation #2:

Modify the provision from the UDRP rules that specifies that upon submission of the complaint to the UDRP provider the complainant should also ‘state that a copy of the complaint [...] has been sent or



transmitted to the respondent' (section 3, b – xii) and recommend that, as a best practice, complainants need not inform respondents that a complaint has been filed to avoid cyberflight. The UDRP Provider will be responsible for informing the respondent once the proceedings have officially commenced.

This suggested modification is already working in practice in most ccTLD dispute resolution procedures and as noted, has been an efficient way to avoid cyberflight and secure a proper and safe administrative start of the case. Therefore, FICPI welcomes and strongly supports this Recommendation.

Preliminary Recommendation #3a:

Following receipt of the complaint, the UDRP Provider will, after performing a preliminary deficiency check, send a verification request to the Registrar, including the request to prevent any changes of registrar & registrant for the domain name registration. The registrar is not allowed to notify the registrant of the pending proceeding until such moment that any changes of registrar and registrant have been prevented, but may do so once any changes of registrar and registrant have been prevented. In the case of accredited privacy / proxy providers or a privacy / proxy provider affiliated with the registrar, the registrar may contact the accredited / affiliated privacy / proxy provider to allow for the reveal of the proxy customer data. However, such contact may only be established after an initial lock has been applied preventing any changes of registrar and registrant.

It is important that the UDRP provider promptly makes the initial formal request for registrar verification, and that the locking of the disputed domain name is done at least at the same time. FICPI therefore supports Recommendation #3a.

Preliminary Recommendation #3b:

Within 2 business days at the latest following receipt of the verification request from the UDRP Provider, the Registrar will modify the status of the registration to prevent any changes of registrar and registrant. These changes must be prevented within 2 business days from the date of receipt of a request for verification through the remaining pendency of the UDRP Proceeding, except in case of the suspension of a UDRP proceeding (see recommendation #10). Pendency is defined as from the moment a UDRP complaint, or relevant document initiating a court proceeding or arbitration, regarding your domain name, has been submitted by the Complainant to the UDRP Provider, as the case may be. Any updates as a result of a request by the accredited / affiliated privacy / proxy provider to reveal the underlying proxy customer data need to be made before the 2 business day timeframe ends or before the registrar verifies the information requested and confirms the lock to the UDRP Provider, whichever ever occurs first. A registrar may not permit transfer to another registrant or registrar after receipt of a request for verification is received by the Registrar from the UDRP Provider, except in limited situations involving an arbitration not conducted under the Policy or



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involving litigation as provided by the UDRP Policy Paragraphs 8(a) or 8(b). For the purposes of the UDRP, the Registrant listed in the Whois record at the time of the Lock will be recorded as the Respondent(s). Any changes to Whois information during the pendency of the administrative proceeding under the Policy may be permitted or prohibited based on the Registrar's applicable policies and contracts, however, it is the responsibility of the Registrant (UDRP Rule 2(e) and UDRP Rule 5(b)(ii)) to inform the Provider of any relevant updates that may affect Provider notices and obligations to Respondent under the UDRP. A registrar may opt to reveal underlying data as a result of privacy/proxy services to the Provider or in Whois, or both, if it is aware of such. This will not count as a "transfer" in violation of the above, if it occurs in accordance with draft recommendation #2. If a privacy/proxy service is revealed or proxy customer information released after the Lock is applied and the Provider is notified, the Provider is under no obligation to require the Complainant to amend its complaint accordingly, but may do so in its discretion. It is the responsibility of the Registrant (UDRP Rule 2(e) and UDRP Rule 5(b)(ii)) to inform the Provider of any relevant updates that may affect Provider notices and obligations to Respondent under the UDRP and the Provider shall, in accordance with the UDRP, provide Respondent with case information at the details it prefers once the Provider is aware of the update (UDRP 5(b)(iii) requires Provider to send communications to the preferred email address of Respondent, for instance).

As regards "business days", although FICPI appreciates that the current reference to "calendar days" may well mean that a specific time limit ends on a holiday, the term "business days" is also not perfectly clear – depending on what is considered as a "business day" in the jurisdiction of each case. FICPI notes that the WG suggests that "business days" are defined as business days in the jurisdiction of the entity required to undertake the action. Although this may be acceptable, it also requires such entity to inform clearly of the yearly business days agenda in its rules related to the dispute resolution procedure.

The availability of accurate identity and contact information of domain name holders is essential for effective intellectual property rights enforcement. FICPI has urged, and continues to urge, ICANN, Registrars and others tasked with the registration of domain names to provide up-to-date and accurate identity ("Whois") information to those having a legitimate need to obtain such information, especially those pursuing infringement of intellectual property rights.

Further, Whois record modifications after filing but before commencement of action lead to unnecessary deficiencies and amendments in the context of the UDRP process. This is most often seen when third party privacy/proxies details are contained in the Whois.

FICPI notes that in those instances, the current rules are unclear as to who is the correct respondent and what is the proper jurisdiction for such cases. Presently, requisite amendments of UDRP complaints based on incorrect Whois information cause delays and unnecessary extra costs for a



complainant. It is therefore important that the registrant information not be changed or modified once the domain name is “locked”.

FICPI welcomes the suggested clarification that the provider is under no obligation to require the complainant to amend its complaint, should a further privacy/proxy customer information be released after the lock is applied.

Preliminary Recommendation #4:

The registrar must confirm to the UDRP Provider within 2 business day following receipt of the verification request from the UDRP Provider that any changes of registrar and registrant have been prevented and will be prevented during the pendency of the proceeding and verifies the information requested by the UDRP Provider.

FICPI supports this Recommendation, which is considered another way to speed up the initial part of the process.

Preliminary Recommendation #5:

If deemed compliant, the UDRP Provider shall forward the complaint to the Registrar and Respondent and notify them of the commencement of the administrative proceeding no later than 3 business days following receipt of the fees paid by the complainant.

See FICPI’s comments on Preliminary Recommendation #3b above. It is important to clarify what are regarded as “business days” in each case, especially since UDRP is a global dispute resolution system.

Preliminary Recommendation #6:

If the complaint should remain non-compliant, or fees unpaid, after the period for the administrative deficiency check per UDRP Para 4 has passed, or if the complainant should voluntarily withdraw during that period, the UDRP Provider informs the Registrar that the proceeding is withdrawn. The Registrar shall, within one business day of the transmission of the notice of withdrawal, release the “lock”.

FICPI supports this Recommendation.

Preliminary Recommendation #7:

As part of its notification to the Registrant, the UDRP Provider informs the Registrant that any corrections to the Registrant’s contact information during the remaining pendency of the proceedings are also required to be communicated to the UDRP Provider as per UDRP rule 5(ii) and (iii).

FICPI supports this Recommendation.



Preliminary Recommendation #8:

This notification would also include information that any changes as a result of lifting of proxy / privacy services, following the ‘locking’, would need to be discussed / addressed by the UDRP Panel directly. The WG recommends that this issue is further reviewed as part of the privacy / proxy accreditation program.

It should be recalled here FICPI’s previous statement that proxy/privacy registrations are not, as such, an indication of bad faith registration and/or use. It is recognized fact there may well be legally, politically or personal reasons for not revealing to the public the full official and searchable Whois information.

FICPI therefore supports further review of this issue, including the possible solution in cases where a need to keep information confidential has been demonstrated that the identity of the “underlying registrant”/true holder details are only made known to the Registrar, to parties to the UDRP proceedings, as well as to the Panelist/s.

Preliminary Recommendation #9:

Upon receipt and communication of a decision from the Provider, the Registrar must within 3 business days communicate to each Party, the Provider, and ICANN the date for the implementation of the decision in accordance with the Policy (UDRP Rule 16 and UDRP Paragraphs 4(k) and Paragraph 8(a)). If the Complainant has prevailed, the Registrar shall implement the Panel order immediately after 10 business days have elapsed (UDRP Paragraph 4(k)). The Complainant or its Authorized representative is required to provide the Registrar with the required information regarding implementation; this may include the information that should be in the Whois. If the Respondent has prevailed, the Registrar shall prohibit transfer of the domain name to another registrar or registrant for 15 business days from the date the decision is transmitted from the Provider (UDRP Paragraph 8).

FICPI supports this Recommendation.

Preliminary Recommendation #10:

In the case of suspension of a proceeding (when the parties have agreed to a settlement), the UDRP Provider informs the Registrar of the Suspension, including the expected duration of the suspension. Should both parties come to a settlement, which would involve a transfer, cancellation or agreement that the registration will remain with the Respondent, the registrar must remove any lock preventing a transfer or cancellation within 2 Business days of confirmation of the settlement by both Parties.

FICPI welcomes this needed clarification. It is important to retain the ability to “unlock” a disputed domain name during the UDRP proceedings in cases wherein parties agree to a transfer.



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Preliminary Recommendation #11:

ICANN, in collaboration with UDRP Providers, Registrars and other interested parties, will develop educational and informational materials that will assist in informing affected parties of these new requirements and recommended best practices following the adoption by the ICANN Board of these recommendations.

FICPI looks forward to seeing this educational and informational material, which should be useful to our members in their daily work of providing efficient assistance to clients in UDRP cases.

IMPORTANT NOTE:

The views set forth in this paper have been provisionally approved by the Bureau of FICPI and are subject to final approval by the Executive Committee (ExCo). The content of the paper may therefore change following review by the ExCo.

The International Federation of Intellectual Property Attorneys (FICPI) is the global representative body for intellectual property attorneys in private practice. FICPI's opinions are based on its members' experiences with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

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The Australian Federation of Intellectual Property Attorneys, FICPI Canada, Association of Danish Intellectual Property Attorneys (ADIPA), Suomen Patenttiasiamiesyhdistys ry, Association de Conseils en Propriété Industrielle (ACPI), Patentanwaltskammer, Collegio Italiano dei Consulenti in Proprietà Industriale, Japanese Association of FICPI, Norske Patentingeniørers Forening (NPF), Associação Portuguesa dos Consultores em Propriedade Industria I (ACPI), F.I.C.P.I South Africa, the International Federation of Intellectual Property Attorneys – Swedish Association, Verband Schweizerischer Patent und Markenanwälte (VSP) and the British Association of the International Federation of Intellectual Property Attorneys are members of FICPI.

FICPI has national sections in Argentina, Austria, Belgium, Brazil, Chile, China, Colombia, Czech Republic, Greece, Hungary, India, Ireland, Israel, Mexico, Netherlands, New Zealand, Peru, Singapore, South Korea, Spain and the United States of America, and individual members in a further 49 countries.

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