



**International Trademark Association**  
*Representing Trademark Owners Since 1878*

**COMMENTS OF THE INTERNET COMMITTEE OF THE INTERNATIONAL TRADEMARK  
ASSOCIATION (INTA) ON PROPOSALS FOR IMPROVEMENTS TO THE REGISTRAR  
ACCREDITATION AGREEMENT (RAA)**

**JULY 30, 2010**

The Internet Committee (the Committee) of the International Trademark Association (INTA) applauds the efforts of the Joint Generic Names Supporting Organization/At-Large Advisory Committee Drafting Team in compiling its Initial Report on Proposals for Improvements to the Registrar Accreditation Agreement (RAA).

Because the RAA is a foundational agreement that significantly impacts the rights of Internet users, Registrants and intellectual property owners, the Committee welcomes the opportunity to provide its comments on the Drafting Team's Initial Report.

**Chapter 1: Executive Summary**

While report “acknowledges that additional work may be conducted by members from the At-Large Community relating to an “aspirational charter,” which would reflect rights or principles that should be afforded to registrants in connection with the registration of domain names, the Committee notes that such additional work should include participants from the entire community.

**Chapter 3: Development of the Registrant Rights and Responsibilities Charter**

The Committee strongly agrees that registrant rights and responsibilities should be more clearly defined. However, given the global nature of the Domain Name System, the Committee believes such rights and responsibilities should be enumerated in the RAA rather than being contained in a separate Charter. Moreover, contrary to the content in Annex D, Registrants and the public must have processes to ensure their rights are adequately protected and enforced under the RAA. The public faces problems with some registrars involved with cybersquatting and other forms of malicious online activity. Accordingly, Registrants and third parties must have rights which are able to be asserted against not only their own registrar, but against all registrars.

The current split in the RAA drafting team makes analyzing the purpose and efficacy of the Registrant Rights and Responsibilities Charter relatively difficult. While the Committee agrees with the goals of some of the provisions of the Aspirational Charter, the Committee believes more detailed suggestions will be necessary to make the ‘aspirations’ meaningful. In fact, there might be a need for something stronger than a list of aspirations. The content of the Aspirational Charter appears suitable for a commentary which would have interpretive, if not substantive, force. The RAA could be amended to make this commentary a binding guide for

arbitration panels and courts determining whether a registrar is in compliance with the RAA or whether ICANN is justified in approving or denying a registrar's application.

Conversely, while the Registrant Rights and Responsibilities Charter is very detailed, it only details rules already in existence and therefore the Charter may not prove terribly useful. Indeed, the Charter merely summarizes ICANN consensus policies and sets forth rules for domain registration, maintenance, dispute and renewal. Under the terms, registrars are required to maintain a database of all WHOIS data associated with each domain name, even with proxy or private registrations, and maintain contact information for the registrant in such cases either in a database or in escrow format. The Committee strongly advocates for all policies which ensure access to domain name contact information, especially in the case of private or proxy registrations, as such policies ensure that intellectual property owners and others harmed by malicious conduct can enforce their rights online. However, at this point the Charter essentially represents no more than a useful means for finding rules that already have been harmonized by the industry through active cooperation, 'best practices' efforts, experience, or coincidence, but little more. Ultimately, the purpose of the Registrant Rights and Responsibilities Charter will need to be more clearly defined before it provides detailed, meaningful guidance that will produce benefits to registrants and the public.

The principles enumerated in the Aspirational Charter should be subject to analysis and future recommendations. As a general comment, the Committee notes that some of these rights ought to be enjoyed, not only by registrants, but by members of the public, whether or not they are domain name registrants.

- ARR1 ("accurate, current and complete contact and locative information regarding their registrar"). While registrants may need contact information for their own registrar, members of the public need access to information that is necessary and sufficient for legal service on any registrar, including an email address to which UDRP complaints can be sent.
- ARR2, the Committee agrees in principle that "registrants should be the sole entity capable of asserting and changing ownership information for their domain," but this principle should be subject to exceptions such as for transfer of ownership ordered as the result of a UDRP or other legal proceedings.
- ARR3 ("ample opportunity to renew their existing domain(s) at the same rates as new domains") seems well intentioned but, if applied literally, likely to be ineffective at preventing registrars from applying relatively expensive "standard" rates for renewal after offering initial registration as a discount. A simple change to clarify that a registrant must be given opportunity to renew at the same rate at which that registrant registered would be helpful. Also, it may be useful to provide a guarantee of rapid portability so that names can be transferred to a new registrar. This should have the same effect, because most registrars would welcome new customers.
- ARR4 ("Registrants should protect their trade name against unauthorized use"). Broadly, this appears to be a restatement of trademark law principles. However, in an expression of aspirational rights, it might be better conceived as "Registrant should have

the right to implement mechanisms to protect their trade names ..." For example, registrars are individually and collectively able to publish what is being registered and to whom. Mandating publication of that information, perhaps in a format that can be aggregated by third parties, will allow service providers to set up watches and similar services. It may even, over time, enable 'waiting periods' whereby those with a right to a domain may contest any registration or put the registrant on notice that bad-faith use of the domain will not be allowed.

- ARR5 ("Registrants should refuse the transfer of their personal information to unauthorized bodies"). The Committee believes ARR 5 should be modified to read as follows: "Registrants should have the right to refuse [or prohibit, or prevent]..." The revised wording permits an opt-in (or even an opt-out) privacy policy. In any event, this principle should apply only to personal information other than what is contained in WHOIS, which should remain publicly available as it has been throughout the history of the domain name system. The Committee believes this provision should convey that registrars cannot distribute non-WHOIS personal information without registrant permission, unless the registrar is obligated to disclose the information pursuant to the RAA, a binding court order or a decision by a panel as set out in ICANN policies.
- ARR6 ("... should expect ICANN to enforce its agreements with registrars"). This goes with the general point above: registrants (and perhaps the public) should have something resembling a cause of action against ICANN and any registrar for the breach of agreements, because those agreements are meant, in many ways, to protect registrants and the public at large. The Committee strongly believes the only way to ensure these protections are in place is to allow the public to assert them. Something akin to a UDRP mechanism might be appropriate.

Regarding Section 3.2, while consultation on the Registrant Rights and Responsibilities Charter should be done in conjunction with registrars, as the name of the charter makes clear, Registrants must be part of that consultation, and representatives from the entire community should be included.

Although it is disheartening that the Drafting Team could not agree upon the scope of the Registrant Rights and Responsibilities Charter, their summary in Annex D of the existing rights and obligations as currently specified in the 2009 RAA provides solid groundwork for moving forward. However, there are issues with the current draft. For example, the "RAA Terms of Interest" provision states: "As the RAA is between ICANN and a Registrar, no one else - including a Registered Name Holder - may sue ICANN or the Registrar to claim a breach of the RAA."

This provision highlights a deficiency in the current contractual framework system. Under the current framework, Registrants and the public have no remedy should the parties under the RAA fail to fulfill their obligations. Because the RAA directly impacts the public, these parties need adequate mechanisms to ensure the terms of the agreement are enforced by both parties. Thus, the Committee recommends that the Terms of Interest provision be revisited in

order to ensure that Registrants and the public have sufficient recourse should registrars or ICANN fail to comply with or enforce the RAA.

When a Registered Name is registered through a privacy or proxy server, search costs for brand owners who require access to registrants' personal information are exacerbated. Accordingly, if registration through a proxy server is allowed, registrars should be required to keep a database which contains the name, postal address, email address, and telephone number of the customer, and to surrender that information when requested by a brand owner as per RAA provision 3.7.7.3. While the registrars claim this is their procedure, it is often not done in a timely manner.

The Committee endorses the RAA provisions requiring registrants to submit to mandatory administrative proceedings to resolve disputes under the UDRP. This mechanism is the strongest ICANN-related recourse available to a brand owner whose intellectual property rights are being threatened.

#### **Chapter 4: Potential Topics for Additional Amendments to the RAA**

Hundreds of suggested amendments to the RAA were considered, prioritized and categorized based on suggestions from stakeholders who submitted proposals. The proposed amendments of “high priority” concerned, *inter alia*, placing a duty on the registrar to investigate ‘malicious conduct,’ inaccurate registrant information and private/proxy domain registration information. These proposals are encouraging as they may relieve the burden on intellectual property owners from investigating and verifying registrant identity and contact information. Moreover, the proposed amendments may prompt registrars to avoid association with registrants who are known to be problematic.

Another proposed “high priority” amendment is the clarification of registrar responsibilities in connection with UDRP proceedings. Although the UDRP and related rules currently provide general guidelines for the procedures in domain disputes, the role of the registrar is ambiguous in certain regards. Accordingly, registrars have adopted inconsistent policies on how to behave in UDRP disputes. Creating more defined responsibilities and timelines will reduce uncertainty for registrants, registrars and trademark owners.

The Committee vigorously supports the following “high priority” topics:

- Prohibition on registrar cybersquatting: A prohibition of this nature, particularly to the extent the prohibition requires a registrar to police its registrations, is extremely important. However, any such policing should in no way indemnify, or create an affirmative defense for, a registrant or registrar. The prohibition must also include a contractual definition of “cybersquatting.” The Committee recommends looking to the definition of cybersquatting in 15 U.S.C. § U.S.C. 1125 (d) (1) (A). A starting point may be: “the registration, trafficking in, or use of a domain name, while having a bad faith intent to profit from such activity, if the domain name is identical or confusingly similar to a mark at the time the domain name is registered”.

- Registrars' duty to investigate malicious conduct: The term “illegal malicious conduct” should be clearly defined. The Committee strongly agrees that an “automatic” email response from a registrar in response to an abuse complaint is wholly insufficient. The Committee supports the Drafting Team’s proposed implementation, which requires a registrar to state how it has responded or will respond to the inquiry or, at the very least, indicate why it believes a response is not necessary.
- Designation of technically accurate point of contact on malicious conduct: the Committee believes such designations should be required for all registrars, resellers and proxy-privacy services.
- Define circumstances under which registrar is required to cancel a registration for false WHOIS data: As previously stated, the failure of registrars to ensure reliable WHOIS data has led to unnecessary hardship and exorbitant costs to members of the public, including but by no means limited to trademark owners. The Committee strongly agrees with the Drafting Team that the RAA must be amended to more clearly define the existing registrar obligation to take "reasonable steps" to verify or correct WHOIS data in response to reported inaccuracies. The Committee believes the "reasonable steps" enumerated on page 116 of the Initial Report are a good starting point. The Committee supports the idea of suspending a domain registration for a limited period of time if the registrant fails to respond to a registrar's inquiry regarding inaccurate contact information. If the registrant does not respond for an extended period of time or there is evidence the registrant has willfully provided false information, the registrar should be required to automatically cancel the registration (the current RAA permits them to do so).

In addition, the Committee strongly supports all of the “high priority” efforts which are directed at ensuring greater accountability on the part of privacy/proxy services. These are worthwhile and challenging efforts given the existence of anonymizing technologies, corporate shell games and dummy email accounts. In terms of the proposals from law enforcement that were not included, the Committee notes that the report specifically states: “Staff informed Subteam B that the law enforcement proposals focused on due diligence issues were being taken into account in updating the registrar accreditation application. An updated application is expected to be made available by the end of June 2010”. The Committee is pleased to see that the law enforcement proposals were taken into account and looks forward to the updated application including such provisions.

Also, the Committee is mindful of the legitimate privacy concerns of some registrants. A general goal of the Committee is that proper and legitimate actions (under the relevant jurisdictional laws) be allowed to proceed against the real party in interest at the time the relevant jurisdiction requires the identification of that real party in interest. The Committee is not now endorsing proposals that eliminate the ability of registrants to otherwise maintain anonymity, but generally favors proposals that allow that anonymity to be pierced when it is legally appropriate and proposals that result in default deregistration or transfer of registered domains if a suitable identity is not disclosed at that point.

## **Chapter 5: Recommended Next Steps for Evaluation of the Proposed RAA Amendment Topics**

The Initial Report states that Subteam B could not agree on a recommendation for next steps in the evaluation of the proposed RAA amendment topics. The Initial Report indicates that the point of dispute between Subteam B members is the amount of participation, if any, parties other than registrars and ICANN would have in negotiations for the next round of amendments. The first proposed process provides that representatives of affected third parties could participate as observers during direct negotiations and be consulted on the final terms decided by the contracting parties to the Agreement (Registrars and ICANN). The negotiating parties and observers also would provide periodic reports on the progress of the negotiations. The second proposed process keeps the direct negotiations between the parties to the contract, but also provides for reporting back to the community during the process.

The second proposed process was strongly supported by registrar representatives of Subteam B, who took the position that only the contracting parties to the RAA should be involved in negotiations. According to the Initial Report, the registrars took the position that any amendments addressing consensus policy are not appropriate for any amendments to the RAA and should be handled by a policy development process.

The Committee strongly supports the position of those Subteam B members who stated that, "...representatives of registrants, commercial and non-commercial users and other affected ICANN Stakeholders should be full participants in the negotiation." The RAA is a foundational agreement that significantly affects all Internet users, including trademark owners who promote and police their intellectual property rights on the Internet. More importantly, the substance of the RAA has obvious and direct consequences on intellectual property owners, as well as all other Internet users on a daily basis.

Registrants and other affected constituencies, whether individuals, brand holders, non-commercial institutions or the like should have a role in the amendment process. Further, these constituents should have a role that goes beyond just being able to observe and possibly voice opinions. Furthermore, because the RAA amendment process as set forth in the RAA itself does not stipulate or require a bi-lateral negotiation of future amendments, the Committee is aware of no basis to exclude any affected constituency from any negotiations that occur. While the Policy Development Process (PDP) might provide an alternative route, initiating a PDP is not required to develop RAA amendments, and could interject additional risk that amendments vital to enhancing the accountability and transparency of the domain name marketplace will not be incorporated into the agreement.

For the foregoing reasons, the Committee strongly believes that Registrants, and other affected constituencies, should have an active role in the RAA amendment process. The inclusion of all affected constituencies fosters a more genuine and productive dialogue and, more importantly, ensures a greater level of transparency and accountability within ICANN.

Thank you for considering our views on these important issues. Should you have any questions regarding our submission, please contact INTA External Relations Manager, Claudio Digangi at: [cdigangi@inta.org](mailto:cdigangi@inta.org)