

**Comments of the Internet Committee of the International Trademark Association (INTA) on
the Locking of a Domain Name Subject to UDRP Proceedings
August 31, 2012**

The Internet Committee of the International Trademark Association (Internet Committee) appreciates this opportunity to provide comments to the Internet Corporation for Assigned Names and Numbers' (ICANN) PDP Working Group on the Locking of a Domain Name Subject to UDRP Proceedings (UDRP Lock WG).

The Internet Committee fully supports the efforts of the UDRP Lock WG to ascertain current practices and standardize appropriate procedures connected with the locking of domain names subject to a Uniform Domain Name Dispute Resolution Policy (UDRP) proceeding. These comments are intended to assist the working group in its request for input from the community in understanding the exact nature and scope of issues encountered by users of the UDRP with respect to the locking requirement of the UDRP.

As such, the Internet Committee sets forth the following recommendations:

- That a lock should be implemented upon the registrar's receipt of a complaint, rather than upon notification of commencement of the proceeding from the UDRP dispute resolution service provider;
- While immediate implementation of a lock upon receipt of a UDRP complaint should be regarded as a best practice among registrars, the maximum amount of time that a registrar has to lock a domain after receipt of a complaint should be standardized and must not exceed 24 hours after receipt of notice with assurances; That the lock imposed after filing of the UDRP complaint through conclusion of the ten-day "waiting period" following the issuance of a decision should be standardized as well.

I. Background – The UDRP and Domain Name Locking

The UDRP was adopted by ICANN on August 26, 1999 as a comparatively speedy and inexpensive arbitration procedure for resolving certain trademark-related disputes concerning domain names registered in the generic top-level domain (gTLD) space (such as .com and .net). Necessary implementation documents were approved by ICANN on October 24, 1999, and the UDRP has

been, generally speaking, functioning in a fairly consistent and predictable manner for more than a decade. However, the Internet Committee recognizes that there can be glitches in the process, and some of those relate to the topic at hand: domain name “locking” in the context of a UDRP proceeding.

Certain provisions of the UDRP clearly limit domain name registrants’ ability to transfer a contested domain name to a new registrant (Section 8(a))¹ or to a new registrar (Section 8(b))² during a pending UDRP proceeding. Section 8(a) prohibits transfer to another registrant unless “the party to whom the domain name registration is being transferred agrees, in writing, to be bound by the decision of the court or arbitrator.” The Section 8(b) limitation prohibits a change of registrar during a pending proceeding unless the domain name “shall continue to be subject to the [ongoing UDRP] proceedings...” The 8(b) limitation is important to complainants, as it prevents “forum shopping” by the registrant, because it prevents the registrant from moving the domain to a new registrar in a new jurisdiction. Thus, the 8(b) provision preserves the jurisdiction that was available at the time of filing.

Together, the transfer limitations of Paragraphs 8(a) and 8(b) have led to the widely implemented but unwritten practice³ utilized by registrars to “lock” domain name registrations during UDRP

¹ UDRP, Section 8(a), at <http://www.icann.org/en/help/dndr/udrp/policy> (Aug. 26, 1999, appr’v’d Oct. 24, 1999). “a. Transfers of a Domain Name to a New Holder. You may not transfer your domain name registration to another holder (i) during a pending administrative proceeding brought pursuant to [Paragraph 4](#) or for a period of fifteen (15) business days (as observed in the location of our principal place of business) after such proceeding is concluded; or (ii) during a pending court proceeding or arbitration commenced regarding your domain name unless the party to whom the domain name registration is being transferred agrees, in writing, to be bound by the decision of the court or arbitrator. We reserve the right to cancel any transfer of a domain name registration to another holder that is made in violation of this subparagraph.”

² *Id.*, Section 8(b). “b. Changing Registrars. You may not transfer your domain name registration to another registrar during a pending administrative proceeding brought pursuant to [Paragraph 4](#) or for a period of fifteen (15) business days (as observed in the location of our principal place of business) after such proceeding is concluded. You may transfer administration of your domain name registration to another registrar during a pending court action or arbitration, provided that the domain name you have registered with us shall continue to be subject to the proceedings commenced against you in accordance with the terms of this Policy. In the event that you transfer a domain name registration to us during the pendency of a court action or arbitration, such dispute shall remain subject to the domain name dispute policy of the registrar from which the domain name registration was transferred.”

³ UDRP Lock WG, Locking of a Domain Name Subject to UDRP Proceedings Survey --- Registrars (Registrar Survey), Responses to Question 6, at <https://community.icann.org/download/attachments/31174551/Zoomerang+Survey+Results+-+FINAL+-+Registrars.pdf?version=1&modificationDate=1342717490000> (Jul. 11, 2012); UDRP Lock WG, Locking of a

proceedings. The registrars responding to the working group's Registrar Survey revealed that there is variation among registrars as to the exact meaning of the term "lock" and the Internet Committee urges clarification and consistency on this point. As detailed below, the UDRP Lock WG found that registrars responding to the Registrar Survey typically implement⁴ a lock by either changing the domain name's status to REGISTRAR-LOCK (which prohibits transfer of a domain name, its deletion, or modification of registrant or contact details)⁵ or to EPP-LOCK (which has the same effect in registries that use the extensible provisioning protocol)⁶ or a similar locked status.

II. Current Registrar Lock Practices

While the Internet Committee notes that the majority of registrars responding to the Registrar Survey⁷ appear to be the same registrars complying with the UDRP obligations to prevent transfer during an administrative proceeding, the process for implementation of the lock varies widely among those registrars. From the Registrar Survey results, it seems that nearly half of registrars apply a lock upon receipt of a complaint and nearly half wait to apply the lock until receiving notification of commencement of the proceeding from the UDRP dispute resolution service provider. (From a preliminary calculation, it appears that about 46% apply the lock upon receiving a complaint and about 49% apply the lock after notification of a complaint from the service provider).⁸ ***The Internet Committee supports the view that a lock should be implemented upon the registrar's receipt of a complaint, in order to preserve the status quo of the parties, and to allow for a fair judgment upon the facts set forth in the complaint.*** The lapse of time between receipt of a complaint, and the official notification by a UDRP dispute resolution service provider may result in a change of the registrant or registrar. Such a material change may impact the facts and arguments set forth in the complaint which relied upon the prior registrant information and

Domain Name subject to UDRP Proceedings --- UDRP Providers (Provider Survey), Question 4, at <https://community.icann.org/download/attachments/31174551/Zoomerang+Survey+Results+-+UDRP+Providers.pdf?version=1&modificationDate=1342717506000> (Jul. 11, 2012).

⁴ Almost all registrants that responded to the UDRP Lock Group Registrar Survey use one of these two locking options, or unique combinations of these standard locking mechanisms plus additional restrictions. Registrar Survey, Questions 6-7.

⁵ See Network Solutions, Inc., NSI Registry Registrar Protocol (RRP) Version 1.1.0, at <http://tools.ietf.org/html/rfc2832> (May 2000).

⁶ See, e.g., Midano.com, Domain Status Codes, at <http://www.midano.com/FAQ/statusCodes.asp> (last visited Aug. 8, 2012).

⁷ The authors note that 40 responses were received to the Registrar Survey. In the absence of conflicting data, the authors will presume that the survey responses provide an accurate reflection of the registrar community.

⁸ Registrar Survey, Responses to Question 5.

geographic location of the registrar. Changes permitted after filing of a complaint but before a lock is initiated may also allow the registrant to choose a potentially new jurisdiction for appeal if the registrant moves the domain to a new registrar.

Regardless of when the lock is instituted, certain features of locks appear to be fairly universal and most of the responding registrars consider a lock to include these elements:

- Prohibiting transfer of a domain name,
- Prohibiting deletion of a domain name,
- Prohibiting cancellation of a domain name, and
- Prohibiting modification of registrant information or contact details.⁹

Other locking limitations that appear to be employed by at least some of the registrars in the Registrar Survey:

- Prohibiting expiration of a domain name, and
- Prohibiting modification of a domain name's WHOIS details with an exception of swapping out privacy / proxy services.¹⁰

The Internet Committee views all of these features as being critical to an effective “lock” process, except that the registrar should not itself be allowed to make changes to the registrant information--including terminating its affiliated proxy/privacy service to remove it, or its affiliated entity, from the position of registrant. Such a prohibition would both encourage trademark owners to contact the proxy service with reasonable evidence of actionable harm, pursuant to the provisions required by RAA 3.7.7.3, prior to filing the complaint, and would encourage proxy services to act upon such complaints by revealing the beneficial owner's information, as contemplated by the RAA.

The registrars that responded to the Registrar Survey suggest that the practice among these registrars is to implement locks promptly. Assuming the “triggering event” (depending on the registrar this may be either the filing of the complaint or the receipt of a request for verification from the provider) occurs on a business day, half of responding registrars lock domain names in

⁹ Each of these matches the vast majority of current registrar locking practice. Of the locks applied by registrars pursuant to UDRP actions: 95% prevent transfer to another registrar, 74% prevent transfer to another account at the same registrar, 88% prevent a change of registrant, and 74% prevent any modification of WHOIS data. *See* Registrar Survey, Question 7.

¹⁰ *Id.*

less than twelve hours and a further 28% of responding registrars lock domain names within twelve to twenty-four hours.¹¹ *The Internet Committee views the immediate implementation of a lock upon notification of the filing of a UDRP complaint as a best practice among registrars and urges standardization of that best practice as a requirement.*

In some UDRP disputes, presumably those not involving any of the registrar-respondents to the Registrar Survey, the registrar takes a significantly longer time (five days or more) to implement a lock.¹² In some cases, the “lock” imposed by registrars does not fully prevent changes to registrant data.¹³

III. Problems With Current Lock Processes

From the Registrar Survey results, it appears that a significant percentage of the registrars surveyed¹⁴ lock domain names upon receipt of a UDRP complaint. The registrars that lock domain names upon receipt of a complaint occupy a substantial share of the registrar market and include the largest registrar, GoDaddy. While complete data is currently unavailable, it appears that a majority (or substantial majority) of gTLD domain names are registered with registrars that lock upon receipt of a complaint rather than waiting for a notice of a commencement from the provider.¹⁵ The Internet Committee supports this practice as a means to preserve the status quo between the parties as early in the UDRP process as possible.

Registrars that lock only upon receipt of a notice of commencement from the UDRP service provider rather than on receipt of the filed complaint from the complainant leave a considerable window of time (*i.e.* between 24 and 72) hours¹⁶ between the time when the registrant is notified of the complaint and the time when the registrar applies a lock. This is more than enough time for a registrant to change registrant information, or transfer the domain name to another registrant in

¹¹ Registrar Survey, Question 9.

¹² See Supplemental Provider Survey Responses from WIPO, Question 5 (approximately 6% of proceedings); Supplemental Provider Survey Responses from Czech Arbitration Court (noting that it takes 5 days or more in 25% - 30% of cases).

¹³ Supplemental Survey Responses from WIPO and National Arbitration Forum, Question 8, 13, 14 (approximately 1-2% of proceedings and less than 5% of proceedings, respectively).

¹⁴ Registrar Survey, Question 5.

¹⁵ Its market share was estimated at around 32% in August 2012. WebHosting.info, Largest ICANN Registrars, at <http://www.webhosting.info/registrars/top-registrars/global/> (last visited Aug. 8, 2012).

¹⁶ Between 12-24 (usually 12-15) hours between filing and a provider’s sending a request for registrar verification and confirmation of lock, Provider Survey, Question 11, and a further period of up to two business days from then to lock by the registrar, Registrar Survey, Question 9.

violation of Section 8(a), or change registrars in violation of Section 8(b). The window of opportunity for a registrant to make changes in violation of Section 8(a) or 8(b) of the UDRP is even greater for the apparent minority of registrars that implement locks much more slowly than the industry average.

Major UDRP dispute providers have also recognized some of the problems that these “pre-commencement” transfers create. For example, panel decisions have noted:

World Intellectual Property Organization (“WIPO”)

To interpret section 8(a) of the Policy in such a way as to permit transfers of registration after notice of the complaint to the respondent but before official commencement of the proceedings by way of notification from the provider would not do justice to complainants who have initiated complaints in accordance with the Policy and the Rules. Moreover such an interpretation would appear to permit, if not encourage the phenomenon [of] cyberflying, where a registrant of a domain name, when named as the respondent in a domain name dispute case, systematically transfers the domain name to a different registrant to disrupt the proceeding.¹⁷

National Arbitration Forum

The National Arbitration Forum regularly finds that cyberflight has occurred where “after Respondent received the Complaint, but before it was verified, it [the registrant] changed the registrant name [...] in order to avoid another adverse finding under the UDRP.”¹⁸

¹⁷ *British Broadcasting Corp. v. Data Art Corp. / Stoneybrook*, D2000-0683 (WIPO Sep. 20, 2000), at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0683.html>. For other representative examples, see also *BolognaFiere S.p.A. v. Currentbank-Promotools, SA. Inc/Isidro Sentis a/k/a Alex Bars*, D2004-0830 (WIPO Dec. 2, 2004), at <http://www.wipo.int/amc/en/domains/decisions/html/2004/d2004-0830.html>, *Fifth Third Bancorp v. Secure Whois Information Service*, D2006-0696 (WIPO Sep. 14, 2006), at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0696.html>, *PREPADOM V. DOMAIN DROP S.A. (PREPADOM-COM-DOM)*, D2006-0917 (Oct. 9, 2006), at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0917.html>, *LPG SYSTEMS .v Jerry / Mr. Jeff Yan*, D2010-0377 (WIPO Jun. 4, 2010), at <http://www.wipo.int/amc/en/domains/decisions/text/2010/d2010-0387.html>.

¹⁸ *American Career College, Inc. v. Gioacchino Zerbo, a/k/a Vincenzo Dinoia*, FA1108001404659 (Nat’l Arb. Forum Sep. 26, 2011), at <http://domains.adrforum.com/domains/decisions/1404659.htm>. For other representative examples, see also *Google Inc. v. Wolfgang Sauer / W.B. Sauer / Wolf Internet Services LDC / Keith Carpenter*, FA1202001430759 (Nat’l Arb. Forum, Apr. 17, 2012), at <http://domains.adrforum.com/domains/decisions/1430759.htm> (“Respondent’s modification of the Whois record after

A number of problems arise if these pre-commencement changes to registrant data occur:

- The portions of the complaint that refer to the registrant and its activities may no longer be accurate, and the complaint may need to be revised at the expense of the complainant.
- A change of registrant information may impact the ability of the complainant to group multiple domain names in a single UDRP proceeding, or cause the complainant to incur additional costs to prepare and submit arguments (and fees, where applicable, under providers' supplemental rules) to argue that the domain names, in fact, share a common owner.
- A change of registrar may impact jurisdiction for appeals.
- The change of registrant may impact complainant's ability to prove bad faith registration and use, *e.g.* through ownership of other domain names or through prior UDRP decisions. The change also is likely to require the complainant to order an additional reverse WHOIS search from a third-party vendor for each "new" registrant (incurring substantial costs to do so).

Each delay to a UDRP proceeding caused by a pre-commencement change is likely to result in additional costs to both the complainant and the provider and may even cause the complainant to start over with a new set of facts. Delaying commencement of the UDRP proceeding also delays resolution of the proceeding. (Such delays may be quite significant if the domain owner succeeds in making multiple changes to registrant information.) In the cyberspace universe where time moves at "warp speed" such delays create lost commercial opportunities, the wasted resources of the complainant, registrant, registrar and provider, and a loss of consumer confidence in the efficacy of the entire system.

the Complaint was filed is a deliberate effort at cyberflight to avoid transferring this infringing Domain Name"); *Microsoft Corporation v. Eliran Mishal*, FA1101001370342 (Nat'l Arb. Forum Mar. 16, 2011), at <http://domains.adrforum.com/domains/decisions/1370342.htm> ("This case is unique because the Whois originally recorded the domains as all belonging to an individual, but the Whois now indicates the Whois records are privacy-protected. Accordingly this Panel finds that this is classic cyberflight, the simple transfer of a domain name to another party after a UDRP proceeding has been instituted, so that the registrant can avoid the UDRP (whether or not the "unshielding" of previously private Whois details is common practice per the registration agreements the privacy services have with their customers.)"); and *Foster and Smith, Inc. v. Jasper Development Pty., Ltd.*, FA1009001345191 (Nat'l Arb. Forum, Oct. 27, 2010), at <http://domains.adrforum.com/domains/decisions/1345191.htm>.

IV. Standardization of the Timing of Implementation of a Lock Related to a UDRP Proceeding

Implementing a domain name lock upon a registrar's receipt of a complaint, according to a standard practice, would dramatically simplify UDRP disputes for complainants, providers, registrants, and registries. Independently, implementation of an early lock would help minimize disruption of cyber-traffic and protect consumers from accidentally buying a domain name that is subject to an ongoing UDRP proceeding of which the buyer was unaware. Accordingly, as previously mentioned, the Internet Committee strongly supports standardizing the implementation of a UDRP lock at the time of filing a complaint.

In the UDRP WG, a concern has been raised that registrars acting on notice of the filing of a complaint could subject themselves to legal liability by implementing the lock in response to a "fake" UDRP complaint. Although this seems likely to be an uncommon occurrence, standardization of the timing of and method for implementation of a domain name lock would create a standard of responsible behavior that should help shield registrars from any such liability. Nonetheless, the Internet Committee recognizes the possibility of this occurrence and acknowledges the legitimacy of this concern. To alleviate the possibility of such an occurrence, the Internet Committee suggests that implementation of a domain lock upon receipt of a complaint be required, but only if the complainant meets certain conditions that minimize the risk of a fake complaint. This will provide registrars with assurances of the legitimacy of the proffered complaint without requiring registrars to exercise any judgment as to the merits of the complaint. In particular, the Internet Committee suggests that registrars be obliged to lock domain names upon receipt of the complaint where the complainant, pursuant to the requirements of a UDRP action:

- Sends a single e-mail addressed to: (a) the registrant's e-mail address as listed in WHOIS data at the time of the filing of the complaint; (b) the provider's UDRP-related e-mail address; and (c) the registrar's e-mail address (as provided at InterNIC's registrar list at <http://www.internic.net/alpha.html>, or as clearly and prominently identified on the registrar's website);
- Attaches a copy of the complaint and any annexes as an attachment or attachments (each in either Word or PDF formats) to the single e-mail;
- Attaches some proof of payment of the provider's UDRP fees to the single email. Provided, however, that financial data (like credit card numbers) may be obscured. This requirement

shall be deemed met if the complainant attaches a filing receipt from the provider's online filing system.

The requirement of simultaneous service on the registrant, provider, and registrar, as noted above, is completely consistent with rules for service of UDRP complaints under the supplemental rules adopted by WIPO,¹⁹ the National Arbitration Forum,²⁰ and the Asian Domain Name Dispute Resolution Centre,²¹ and is not inconsistent with the Supplemental Rules of the Czech Arbitration Court.²² A single communication to the registrant, provider, and registrar, and the inclusion of the complaint, any annexes, and proof of payment (“notice with assurances”), provides the registrar with reasonable assurances that a legitimate complaint has, indeed, been filed without burdening the registrar with further authentication determinations.

The Internet Committee further suggests standardizing the amount of time that a registrar has to lock a domain name after receipt of notice with assurances. The Internet Committee suggests that registrars should have no more than one (1) business day to implement the lock after receipt of notice with assurances. Over three-quarters of responding registrars already impose a lock within the time frame contemplated by this suggestion, as counted from the registrar's current lock-triggering event.²³ While we recognize that registrars need a commercially reasonable time in which to implement the lock--such as the maximum of 24 hours suggested here--this still leaves an opportunity for cyberflight by the registrant upon receiving notice. Therefore, we recommend that, when the registrar implements the lock, the registrar should rescind all changes of registrant data that occurred after the time of the transmission of the complaint.

Finally, the Internet Committee suggests that the lock imposed after filing of the UDRP complaint through conclusion of the ten-day “waiting period” following the issuance of a decision should also be standardized. At a minimum, the Internet Committee suggests formalizing

¹⁹ WIPO, WIPO Supplemental Rules for UDRP, Rule 4(b), at <http://www.wipo.int/amc/en/domains/rules/supplemental/> (effective Dec. 1, 1999).

²⁰ National Arbitration Forum, The NAF's Supplemental Rules to ICANN's UDRP, Rule 4(d), at [http://domains.adrforum.com/users/icann/resources/UDRP%20Supplemental%20Rules%20eff%20July%201%202010%20\(final\).pdf](http://domains.adrforum.com/users/icann/resources/UDRP%20Supplemental%20Rules%20eff%20July%201%202010%20(final).pdf) (effective Jul. 1, 2010).

²¹ Asian Domain Name Dispute Resolution Centre Supplemental Rules for ICANN UDRP and the Rules for the UDRP, Article 5(3), at https://www.adndrc.org/doc/Supplemental_Rules_26-07-2012_en.pdf (effective Jul. 26, 2012).

²² UDRP Supplemental Rules of the Czech Arbitration Court, at http://www.adr.eu/arbitration_platform/udrp_supplemental_rules.php (effective Mar. 1, 2010).

²³ Registrar Survey, Question 9 (50% lock in under 12 hours on a business day and a further 28% lock between 12 hours and 24 hours on a business day).

the requirement that the registrar impose the limitations associated with the REGISTRAR-LOCK status or the EPP-LOCK status (depending on the domain name registry in question). The Internet Committee notes that approximately three-quarters of responding registrars are already utilizing the essential elements of these restrictions utilized by, namely:

- Prohibiting transfer of a domain name,
- Prohibiting deletion of a domain name, and
- Prohibiting modification of registrant information or contact details.²⁴

Standardization of the timing and nature of a domain name lock would codify existing best practices; minimize post-filing complications resulting from cyberflight or from other pre-commencement changes to or transfers of ownership; reduce the likelihood that third parties might inadvertently purchase a domain name for which a UDRP complaint had already been filed; provide registrars with a clear, simple, “bright line” checklist for implementing locks pursuant to a UDRP action; define minimum “lock” requirements in a way that reflects industry practice and maximizes the efficiency of the domain name lock in promoting the goals of Sections 8(a) and 8(b) of the UDRP; and improve consumer confidence in the predictability and efficacy of the domain name governance.

V. Conclusion

We value the efforts of the UDRP Lock WG and ICANN in the furtherance of improvements to domain name locking procedures for domain names that are subject to a dispute under the UDRP. The Internet Committee is available to assist or provide additional comments if requested to do so. Thank you for considering our views on these important issues.

Should you have any questions regarding our submission, please contact INTA's External Relations Manager, Claudio DiGangi, at: cdigangi@inta.org.

²⁴ Each of these matches the vast majority of current registrar locking practice; of the locks applied by registrars pursuant to a UDRP action: 95% prevent transfer to another registrar, 74% prevent transfer to another account at the same registrar, 88% prevent a change of registrant, and 74% prevent any modification of WHOIS data. *See Registrar Survey, Question 7.*

About INTA & The Internet Committee

The International Trademark Association (INTA) is a more than 134-year-old global organization with members in over 190 countries. One of INTA's key goals is the promotion and protection of trademarks as a primary means for consumers to make informed choices regarding the products and services they purchase. During the last decade, INTA has served as a leading voice for trademark owners in the development of cyberspace, including as a founding member of ICANN's Intellectual Property Constituency (IPC).

INTA's Internet Committee is a group of over two hundred trademark owners and professionals from around the world charged with evaluating treaties, laws, regulations and procedures relating to domain name assignment, use of trademarks on the Internet, and unfair competition on the Internet, whose mission is to advance the balanced protection of trademarks on the Internet.