



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

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Working Group of the Generic Names Supporting
Organisation
ICANN

via email: udrp-locking@icann.org

RE \\\ Locking of a Domain Name Subject to UDRP Proceedings

Dear Sirs,

I have pleasure in attaching FICPI's response to the above-mentioned subject.

Yours faithfully

Julian Crump
FICPI Secretary General

Enc.



14 August 2012

Locking of a Domain Name Subject to UDRP Proceedings

Introduction

The GNSO ‘Locking of a Domain Name Subject to UDRP Proceedings’ Working Group has called for public input in order to have a clear understanding of the exact nature and scope of issues encountered with the locking of a domain name subject to UDRP Proceedings.

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession having more than 5000 members from more than 80 countries world-wide, herewith comments on the questions raised by the Working Group of the Generic Names Supporting Organisation (GNSO) on Locking of a Domain Name Subject to UDRP Proceedings.

As stated in FICPI’s comments on ICANN “Preliminary Issue Report on the Current State of the Uniform Dispute Resolution Policy”, filed on 13 July 2011, FICPI is of the opinion that the UDRP has successfully offered parties a far less expensive alternative to litigation for resolving international disputes involving domain name cybersquatting, and that the Internet community has come to rely on the consistency, predictability, efficiency, and fairness generally associated with the present implementation of the UDRP.

Overall, the current UDRP functions well in meeting the needs of both domain name holders and trademark owners. It should be recognised that these two groups are not mutually exclusive but that trademark owners and domain name holders are very often one and the same. FICPI members represent clients from both groups.

As previously concluded by the ICANN Staff, through UDRP webinars, and further addressed in discussions during the 41th and 44th ICANN Public meetings, the only changes or clarifications that may be needed, relates 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.



Locking of a Domain Name Subject to UDRP Proceedings

Detailed comments by FICPI

1. Would the creation of an outline of a proposed procedure, which a complainant must follow in order for a registrar to place a domain name on registrar lock, be desirable?

As noted of the Working Group, only the UDRP Provider can notify a Registrar that a complaint has been officially filed and in the vast majority of cases, Registrars will only implement the locking of a domain name based on the request by the UDRP Provider. FICPI points to the fact that there are existing and well functional UDRP procedures and instructions on how the Complainant shall prepare and file a formally accepted UDRP case application, and there is no need to amend the existing procedure or create a new procedure. What is important is that the UDRP Provider acts promptly in making the initial formal Request for Registrar Verification, and at the same time initiating the lock.

2. Would the creation of an outline of the steps of the process that a registrar can reasonably expect to take place during a UDRP dispute be desirable?

FICPI notes, based on the experience of its members, as well as on the comments and questions from the registrars during the 44th ICANN Public meeting, that there is an obvious need of such outline, which FICPI therefore strongly supports.

3. Should the time frame by which a registrar must lock a domain after a UDRP has been filed be standardised?

As stated above, 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 the same time.

Currently, the time needed for locking a disputed domain name considerably differs between different Registrars, in some cases giving the holder of the disputed domain name the opportunity to transfer the domain name before the UDRP proceeding has come into force.

4. Should what constitutes a “locked” domain name be defined?

FICPI considers that this question, although surprising, clearly reveals the need for a formal definition of a “locked” domain name. It should be made clear that the “locking” of a disputed domain means that any requests for transfer of this domain name are denied.



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5. Once a domain name is ‘locked’ pursuant to a UDRP proceeding, should it be possible or not to change or modify the registrant information for that domain name?

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, particularly 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 particularly usual when third party privacy/proxies details are contained in the Whois.

FICPI notes that in those instances, the current rules are not clear as to who the correct respondent is and what the proper jurisdiction for such cases is. Presently, requisite amendments of UDRP Complaints based on incorrect Whois information causes delays and unnecessary extra costs for the Complainant.

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

In this respect, FICPI notes that in cases where a privacy or proxy registration service appears as the apparent registrant in the public Whois database at the time the complaint is filed, it is important that the so called “underlying registrant” name and contact information be provided by the Registrar at the same time the disputed domain name is “locked”, therewith giving the parties as well as the Panelist/s full particulars of the registered proxy registration service provider as well as the “underlying registrant”.

6. Should additional safeguards be created for the protection of registrants in cases where the domain name is locked subject to a UDRP proceeding?

FICPI wishes to point out that using a privacy or proxy registration service is not as such an indication of bad faith registration and/or use. In fact, there may well be legally, politically or personal reasons for not revealing to the public the full official and searchable Whois information.

The question of additional safeguards therefore needs to be further studied and considered.. One possible way to balance the need for accurate Whois registrant information, essential for



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an effective intellectual property rights enforcement request against privacy rights, would be to make the identity of the “underlying registrant”/true holder details known only to the Registrar, parties of the UDRP proceeding, as well as the Panelist/s, in such cases where a need to keep information private has been demonstrated.

7. Should “unlocking” during the UDRP proceeding be accepted under certain circumstances?

FICPI points out the importance of the possibility to temporarily or for limited purposes “unlock” a disputed domain name during the UDRP proceeding, namely in the case when the parties agree to a transfer.

As noted during the “Locking of a Domain Name subject to UDRP Proceedings” presentation at the 44th ICANN Public meeting, about 25% of the current WIPO UDRP disputes and nearly 20% of the NAF UDRP disputes are settled by the parties before the Panellist has made its decision.

In such cases, there should be a possibility that, upon a request from both parties, the UDRP Provider requests the Registrar to “unlock” the disputed domain name typically in order to transfer the domain name to the Complainant.

8. General

FICPI, as a body of private practitioners from more than 80 countries worldwide representing both trademark owners and domain name holders, will be happy to provide any further input to ICANN concerning any specific or general question relating to UDRP proceedings and possible changes thereto.

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.