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Via Electronic Mail

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**Comments of the Whois Subcommittee of the International Trademark Association
on the
Preliminary Task Force Report on the Purpose of Whois and Whois Contacts**

I Introduction

The Whois Subcommittee of the International Trademark Association (INTA) is pleased to respond to the request for comments on the January 18, 2006 “Preliminary Task Force Report on the Purpose of Whois and of the Whois Contacts” (hereafter referred to as the “preliminary report,” available at <http://www.icann.org/announcements/announcement-18jan06.htm>).

INTA is a 128-year-old global organization with members established in 180 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 also served as the leading voice of trademark owners in the development of cyberspace, including as a founding member of ICANN’s Intellectual Property Constituency. INTA’s Whois Subcommittee is a group of over twenty trademark attorneys and professionals charged with monitoring adoption or modification of Whois policies in new and existing TLDs and advocating for adequate access to domain ownership information.

INTA has particular interest in policy relating to the Whois database, because the information contained therein assists trademark owners and authorities in policing abuses of intellectual property and preventing consumer confusion and consumer fraud. Moreover, the information in Whois also allows Internet users from all walks of life to identify the owners of web sites selling goods or disseminating information over the World Wide Web.

II Summary

The task force produced for comment two formulations of a definition of the purpose of Whois. The formulations provide that the purpose of the gTLD Whois service is to supply sufficient information to contact a responsible person for the purpose of resolving either:

- (1) issues related to the configuration of records associated with a domain within the DNS nameserver (Formulation 1 - Technical Purpose Only Definition); or

- (2) technical, legal, or other issues relation to the registration or use of a domain name (Formulation 2 – Identification Purpose Definition).

Formulation 1, the technical purpose only definition, is supported by the Non Commercial User Constituency, the Registrar Constituency, and the Registry Constituency. This support is based on the constituencies' interpretations of the historical purpose of Whois and data protection concerns.

Formulation 2, the identification purpose definition, is supported by the Commercial and Business Users Constituency, the Intellectual Property Constituency, and the Internet Service Providers and Connectivity Providers Constituencies. These constituencies believe that an identification and contact-ability are essential in the online environment and the Whois database has performed this important function since the inception of the Internet.

The Whois Subcommittee believes that the adoption of Formulation 2 is consistent with the historical and current evidence of the purpose of Whois, which has *always allowed* and since the dawn of individual and corporate domain registrations, has *explicitly recognized* the use of Whois data in the resolution of legal disputes and other non-technical issues. Our analysis also suggests that Formulation 2 is compliant with national and international data protection regimes. With respect to Formulation 1, we believe ICANN should recognize that limiting the purpose of Whois to technical issues would greatly hinder, and in many cases would present a complete obstacle to, the application of national law to illegal activities conducted on the Internet. We find this of particular concern because of ICANN's charge to recognize the responsibility of governments and public authorities for public policy.¹

III The Historical Purpose of Whois Includes Resolution of Legal Disputes

To the extent the task force is considering basing access to Whois on the original purpose of the database, we believe it is vitally important to examine closely the record of that purpose. The notion that Whois was intended only to ensure the efficient technical operation of the Internet is not supported by the historical record. The original purpose of the Whois database was in fact not limited in this way, but rather was and is to allow any person to contact any other person who had obtained an online address, to resolve any issues related to the domain's registration or use.

The lack of historical restrictions on the use of Whois information dates back to the development of the Internet.² Before the Internet was opened to individual and corporate domain name

¹ See ICANN Core Values ¶ 11.

² See, e.g., RFC 812, published in 1982, which "strongly encourages" access to NICNAME/Whois system for "users," not merely technical personnel, available at <http://www.faqs.org/rfcs/rfc812.html>; RFC 954, published in 1985, which specified the inclusion of the "full name, U.S. mailing address, telephone number, and network mailbox for DDN [Defence Data Network] users who are registered in the NIC database," and made no restriction on the uses of the data, available at <http://www.faqs.org/rfcs/rfc954.html>; RFC 1714, published in 1994, which discussed the development of the original NICNAME/Whois system, but did not restrict the use of the information, and in fact sought "to ensure that many uses can be accommodated," available at <http://www.faqs.org/rfcs/rfc1714.html>; and RFC 2167, published in 1997, which notes that, "The original Whois function was to be a central directory of resources and people on ARPANET," available at <http://www.faqs.org/rfcs/rfc2167.html>. More detail on the

registrations through the introduction of the .com gTLD, the ownership of domains by academic and government institutions was naturally not expected to give rise to many legal disputes. However, even in this context, the use of the Whois database was never restricted to technical purposes.

Perhaps most importantly from the perspective of the public's reasonable expectations of the purpose of the Whois, information has been explicitly meant for non-technical use as long as private individuals and companies could register domain names. After ownership of domains was opened to individuals and commercial entities, Network Solutions' dispute resolution policy explicitly referred to the use of information from the Whois database in the resolution of legal disputes.³ Like NSI's policy before it, ICANN's Registrar Accreditation Agreement⁴ and Uniform Dispute Resolution Policy⁵ encourage reliance on Whois data for resolving trademark disputes. For example, Rule 2(a)(i) of the rules governing UDRP proceedings provides that a dispute resolution provider can satisfy its obligations to use "reasonably available means" to contact the domain name owner by addressing communications to the contact information in the Whois database.⁶

In other words, from the very beginning of private ownership of Internet domains, information on those registrants has been used for legal purposes, registrants have been on notice of that fact, and can reasonably only have expected that the information could be used in the formal or informal resolution of legal disputes. All registrants were aware of the use of their personal data in the manner in which it is currently made available by the Whois service.

IV Laws, Regulation, and Policies are Consistent with and Depend on Access to Whois Data for Non-Technical Purposes

A Formulation 2 is Consistent with Data Protection Laws

The preliminary report cites comments from supporters of Formulation 1 that data protection laws require limited collection of personal data and refers to data protection laws in the European Union, Australia, and Canada as restricting the collection and use of data by Whois for purposes other than technical ones.

Of course, the data protection laws in these and other countries do not specifically reference Whois. Nevertheless, all three jurisdictions provide that if the requisite consent has been

historical evidence of the purpose of Whois may be found in the Intellectual Property Constituency Background Paper (see <http://forum.icann.org/lists/gnso-dow123/msg00465.html>).

³ NSI Domain Name Dispute Policy Statement, Paragraph 1(c), Revision 01, Effective November 23, 1995, at <http://www.lectlaw.com/files/inp13.htm>.

⁴ <http://www.icann.org/registrars/ra-agreement-17may01.htm>.

⁵ <http://www.icann.org/dndr/udrp/uniform-rules.htm>. Cases and administrative rules under the UDRP recognize the Whois' role in determining an authoritative legal holder-of-record of a domain, requiring that the "registrant" listed in the Whois be named as the UDRP Respondent, even when evidence may suggest that person had no role in registering or using the domain. See *National Arbitration Forum's UDRP Supplemental Rules* ¶ 1d, (effective Jan. 1, 2006), available at <http://www.arb-forum.com/domains/UDRP/rules.asp>; *Wells Fargo & Co. v. Doe*, No. 362108 (Nat. Arb. Forum Dec. 30, 2004).

⁶ *Id.*

obtained from the data subject for use of the data, then that use will be compliant with data protection laws.⁷

In addition, Europe, Australia, and Canada all provide that data collected may be disclosed for legitimate purposes or public interest, including, we argue, the protection of trademarks, which provide the public with valuable information about goods and services.⁸ Whois, for example, allows holders of intellectual property rights to identify and contact alleged cybersquatters. The World Intellectual Property Organization has reported a 20% increase from 2004 in the number of cybersquatting cases filed in 2005.⁹ And, the Internet has proven to be fertile ground for illegal activity, such as trademark counterfeiting, and potentially dangerous crimes, requiring ready access to Whois data by law enforcement. Therefore, the availability of full contact details for registered domain holders is vital to transparency, accountability, and safety in Internet dealings. Making it more difficult to identify domain names holders is harmful to the public interest.

Finally, there are provisions for disclosure of data for secondary purposes where the data subject “would reasonably expect” the use and disclosure of the information.¹⁰ Since there has been a public Whois service for over 20 years, the data subject would reasonably expect that the information about their identity would be disclosed in some form, given the public nature of their potential use of the domain name.

B Similar Public Registries around the World Require the Disclosure of Registrant Information

The disclosure of contact details currently provided by the Whois database is also consistent with other similar public registries. For example, a search on the European Community trademark database, the U.S. Patent and Trademark Office trademark database, and many similar databases around the world will return the name and address of the applicant or trademark owner (whether the applicant or trademark owner is a legal entity or individual), the date of application and registration, and details of an authorized representative.

Similarly, in many jurisdictions, businesses and individuals who carry on business under a name other than their own must register that name with government agencies in order to carry on business legally. The contact information is publicly available and in many cases is accessible by anyone over the Internet.¹¹

⁷ See National Privacy Principles (NPPs) in the Australian Privacy Act of 1988, NPP 2.1(b), at <http://www.privacy.gov.au/act/index.html>; Canadian Personal Information Protection and Electronic Documents Act (PIPEDA), Section 4.3.2 of Schedule 1 at S.C. 2000, c. 5 (“organizations shall make a reasonable effort to ensure that the individual is advised of the purposes for which the information will be used.”); and European Union Data Protection Directive 95/46, at Article 7(a) (authorizing processing of personal data where the data subject has unambiguously given his consent).

⁸ See, e.g., *European Data Protection Directive, Articles 7(e) and 7(f)*; see also 2004 European Union Directive on Enforcement of Intellectual Property Rights, which expressly recognizes the importance of the protection and enforcement of intellectual property rights in the internal market. See Section 4.3.3. of Schedule 1 to Canada’s PIPEDA.

⁹ http://www.wipo.int/edocs/prdocs/en/2006/wipo_pr_2006_435.html.

¹⁰ Australia NPP 2.1(a). See also Section 4.3.3. of Schedule 1 to Canada’s PIPEDA.

¹¹ See, e.g., Australian Securities & Investments Commission National Names Index, available at <http://www.search.asic.gov.au/gns001.html>; Colorado Secretary of State Business Entity Filing database, available

C The Identification Purpose is Essential for Meaningful Access to Legal Relief

Restricting the definition of the purpose of Whois and limiting contact and ownership details would force individuals and companies who have suffered legal injury from another's conduct on the Internet to commence court proceedings merely to find out the name of their wrongdoer. This not only impedes a business whose trademark has been infringed or impermissibly incorporated into a domain name, but also, for example, a consumer fleeced by a faceless and unscrupulous merchant. In 2005, 46% of all fraud complaints reported on the U.S. Federal Trade Commission (FTC) Consumer Sentinel database were Internet-related complaints. Whois data is one of the first means used to identify wrongdoers and is essential in the investigation of online fraud and crime. Fraudsters cannot be pursued if law enforcement agencies, companies that have an interest in protecting their customers from such fraud, or injured parties seeking redress cannot identify or locate the culprits. The pace of Internet fraud and crime makes it crucial to obtain basic identifying information about the operator of a web site. Any examination of the purpose of the Whois database must take into account the public interest in seeing online fraud, piracy, and crime investigated and prevented. The public's confidence in online transactions depends on deterring violations of law, which in turn depends on the availability of effective legal relief.

For the application of existing laws to Internet activity, the ability to serve process upon a violator is a key facet of judicial procedure. The world's court systems differ in the manner of notice that must be provided to a defendant. In the Mexican civil court system, service of process must be performed by a court officer using certified documents, whereas rules for service in United States are generally less rigid. Nonetheless, the common element is providing fair notice of claims to putative defendants so that a jurisdiction's measure of due process can be achieved. Limiting access to complete and accurate Whois information that would reveal the alleged wrongdoer's identity and location prevents an injured party from crossing this critical threshold to availing him or herself of the law's protection.

As noted, in many cases, the injured party would have to bring legal action merely to uncover the domain registrant's identity and location. At best, this could mean seeking identifying information through discovery-type applications, well before the substantive merits of a case are addressed. At worst, the petitioner may discover that the defendant must be sued elsewhere, requiring a second legal action. Nor is this a desirable situation for the domain registrant who, instead of responding to concerns raised in a letter, e-mail message, or phone call, must defend against formal legal action. The substantial expense and resulting delay compound harm not only to the injured party, but to others as well. A trademark owner's inability to contact the registrant will prolong the public's confusion and allow additional consumers to fall victim to fraudulent or criminal activity by unscrupulous domain name registrants.

Formulation 1, in limiting the purpose of Whois to only technical matters, will impede the application of national law and public policy to illegal activities conducted on the Internet.¹²

at <http://www.sos.state.co.us/biz/InquiryMenu.do>; Ireland Company Registration Office Search, available at <http://www.cro.ie/search/>.

¹² See ICANN Core Values ¶ 11.

D Specific Laws Depend on Information in the Whois

Responding to the Internet's newly realized status as the world's pre-eminent public communications and commerce medium, lawmakers and judiciaries around the world addressing Internet-specific legal issues are finding that the Whois is an essential legal tool. For example, the United States adopted the Fraudulent Online Identity Sanctions Act (FOISA) in an effort to curtail phishing, spoofing, and other Internet-based frauds.¹³ FOISA increases the maximum prison time for a felony offense committed where the perpetrator registered a domain name using false contact information and knowingly used that domain name in the course of criminal activity. FOISA also presumes that a violation of United States trademark law is willful if the violator knowingly provided false contact information when registering, maintaining, or renewing a domain name. In short, FOISA's purpose is to combat false Whois data, and hence is consistent only with the view that Whois is meant as a public resource of accurate information so that domain owners can readily be contacted concerning a legal problems involving use of the domain.

The United States also enacted the Anticybersquatting Consumer Protection Act, which provides that a registrant's "registration or acquisition of multiple domain names which the [registrant] knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names" are evidence of bad faith domain name registration and use.¹⁴ Thus, this important statutory scheme incorporates the need to determine what other domain names are owned by a particular domain name registrant, which the current formulation of Whois facilitates. To allow the omission of registrant or administrative contact information from the Whois record would thwart the consumer protection policy advanced by this law and other laws in effect or subsequently enacted by jurisdictions around the globe.

V Formulation 2 Recognizes the Use of Whois to Resolve Disputes without Resort to Legal Proceedings

Ready access to Whois contact information makes it possible for parties to resolve issues between themselves without being forced to involve the courts. For instance, Company A spots Owner B's newly filed domain name address that incorporates one of Company A's trademarks. With Whois information, Company A would often simply contact Owner B and express its concern about potential harm and confusion among consumers. Thus, it is possible for the two parties to come to an understanding without the necessity of formal legal action. The information can also allow Company A to research Owner B and discover any legitimate interests in the domain and determine not to pursue the matter.

If Whois information is not available and Company A is forced to subpoena the registrar or file an injunction against Owner B, the potential harm to consumers will remain unsolved, legal costs for both parties will escalate, and a legal resolution could take months or even years. This is not to mention that resorting to legal action without an attempt at amicable resolution often hardens both parties' positions out of hostility and the legal costs both have sunk into the matter. The use of Whois frequently helps parties settle disputes through informal communication without

¹³ United States Pub. L. 108-482.

¹⁴ United States Pub. L. 106-113.

significant business interference for either party.

VI Conclusion

We thank the task force for the opportunity to provide comments on its preliminary report. The original purpose of the Whois database—from its inception, through the commercialization of the Internet, and continuing today—has always been to provide the public with ready access to the identity and contact information for domain name registrants. This helps resolve legal and other disputes and, where amicable resolution is not possible, facilitates bringing the registrant to court under legitimate national laws. Individual and commercial domain name registrants have always been on notice of the purpose of Whois. To argue that use of Whois data by users of the Internet to identify domain name owners is contrary to the “original purpose” of the Whois database, or that the database has technical purposes only, is inconsistent with the historical record and the experience and expectation of Internet users and domain name registrants. Limiting Whois to purely technical information, by frustrating the service of process on domain owners, would significantly set back the practical operation of the rule of law on the Internet. Adopting Formulation 1 would cause significant harm to consumers who are increasingly using the Internet to communicate and make important decisions.

If there are any questions concerning this submission, please contact Michael Heltzer at mheltzer@inta.org.