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Statement of the International Trademark Association

**“Internet Domain Name Fraud – The U.S. Government’s Role in
Ensuring Public Access to Accurate Whois Data”**

**Subcommittee on Courts, the Internet, and Intellectual Property
Committee on the Judiciary
United States House of Representatives**

September 4, 2003

Mr. Chairman, Congressman Berman, and Members of the Subcommittee on Courts, the Internet, and Intellectual Property:

The International Trademark Association (INTA) is pleased to submit this statement in connection with the subcommittee's oversight of intellectual property safeguards on the Internet. We thank the subcommittee for addressing this issue and for its letter of August 8, 2003, to Secretary of Commerce Donald Evans regarding developments that affect the operation of the Internet.

INTA's statement will comment on: (1) the role of the Internet Corporation for Assigned Names and Numbers (ICANN) in the administration of the domain name system (DNS); (2) Whois data and ICANN policies relating to access to the data, enforcement of those policies, and what can be done to improve enforcement; and (3) the need for uniformity in country code top-level domain name policies. We respectfully request that our statement be made part of the record of today's hearing.

About INTA

INTA is a 125-year-old not-for-profit organization comprised of over 4,400 member companies and firms. It is the largest organization in the world dedicated solely to the interests of trademark owners. The membership of INTA, which crosses all industry lines and includes both manufacturers and retailers, values the essential role that trademarks play in promoting effective commerce, protecting the interests of consumers, and encouraging free and fair competition. During the ongoing international debate on the running of the DNS, INTA has served as the voice of trademark owners in the United States and around the globe, working to ensure that their trademarks are protected and, more importantly, that consumers have a safe and reliable choice in cyberspace.

The DNS and ICANN's Role in Its Administration

The DNS is what allows Internet users to "surf" through cyberspace using familiar strings of letters and numbers as their guide. Very often, these identifiers take the form of trademarks (e.g., <http://www.inta.org>). In June 1998, through a policy statement known as the "White Paper," the U.S. government stated its intent to transfer management of the DNS to the private sector.¹ In November 1998, on behalf of the government, the Department of Commerce (DOC) entered into a memorandum of understanding (MOU) with ICANN, recognizing ICANN as the private, not-for-profit entity to which the government would transfer responsibility for DNS management. The MOU is renewed on an annual basis and is now set to expire on September 20, 2003.²

ICANN's role is necessarily one of both policy and technology. The technical and policy coordinating function performed by ICANN has helped to foster consumer confidence in the Internet as a means for conducting business in a simple, quick, reliable,

¹ <http://www.icann.org/general/white-paper-05jun98.htm>.

² Amendment 5 to the MOU can be found at <http://www.icann.org/general/amend5-jpamou-19sep02.htm>.

and easy-to-understand manner. ICANN, through its administration of the DNS, provides a single avenue, whether through meetings, working groups, or even its own website, for stakeholders of all backgrounds and interests to come together and voice concerns, create dialogues, and hopefully build common ground on matters critical to the future of the stability of the DNS for all users. It is commonality and standards, after all, which allow the Internet to serve as a global communications medium.

In promoting the stability of the Internet, ICANN has simultaneously taken steps to ensure proper conditions for protecting trademarks and, in turn, enhancing consumer protection. INTA applauds this decision. Tools such as the Uniform Dispute Resolution Policy (UDRP), which was put in place by ICANN in late 1999, have proven to be valuable means for trademark owners to address piracy and online consumer fraud. ICANN moved forward with these safeguards after consultation with user groups and with the intent of ensuring a stable Internet.

Whois Data

A Definition of Whois and Trademark Owner Use of the Data

The protection of brands and consumers in cyberspace and the stability of the Internet do not end with the UDRP, however. There remain several challenges that lie ahead, the solution to which will promote greater online stability; in particular, ensuring access to accurate contact data on registered domain names. This data is typically referred to as “Whois.” Whois has any number of important uses, including law enforcement, consumer protection, and the protection of intellectual property rights. Trademark owners value Whois data in order to resolve domain name disputes (e.g., cybersquatting),³ learn the contact details for owners of websites offering counterfeit products or other infringement of intellectual property, manage trademark portfolios, provide due diligence on corporate acquisitions, and identify company assets in insolvencies/bankruptcies.

Contractual Provisions and Policies Relating to Whois

The need for “trademark owners and domain name registrants and others”⁴ to have access to Whois was first addressed in the U.S. Government’s White Paper, which laid out the ground rules for private sector management of the DNS. The White Paper stated:

We [the U.S. Government] anticipate that the policies established by the new corporation [ICANN] would provide that [the] following information would be included in all registry databases and available to anyone with access to the Internet.⁵

³ The data from Whois is crucial to learning the identity of a cybersquatter and establishing a case under both the UDRP and the *Anticybersquatting Consumer Protection Act*, a measure that originated with this subcommittee and was signed into law in November 1999. Pub. L. No. 106-113, § 3002, 113 Stat. 1501, 1537 (1999) (amending 15 U.S.C. § 1125).

⁴ *Supra* note 1.

⁵ *Id.*

ICANN, upon its formation and as part of its initiative to expand the number of domain name registrars,⁶ crafted the Registrar Accreditation Agreement (RAA),⁷ a contract between itself and domain name registrars that addresses the obligations ICANN accredited registrars have with respect to domain names registered in the global top-level domain (gTLD) space. This includes the familiar suffixes of .com, .net, and .org, as well as the recently introduced .info, .biz, .name, .pro, .museum, .coop, and .aero. Among the RAA obligations are compliance with the UDRP⁸ and the provision of Whois data.⁹ Both are in accordance with the precepts of the White Paper.

Today there are basically two types of Whois: (1) free, interactive, publicly accessible web-based Whois data that can be found by going to any registrar's website, finding the icon labeled "Whois," "clicking," and typing in a particular domain name;¹⁰ and (2) bulk Whois data that is the whole of a particular registrar's database, which can be purchased from a registrar by a third party for an annual fee not to exceed \$10,000.¹¹ Trademark owners use both types of Whois. Trademark search firms in particular purchase bulk Whois data in order to provide services to trademark owners, such as investigation of alleged cybersquatters, particularly to show whether the cybersquatter has a pattern of registering multiple domain names incorporating the trademarks of others. ICANN accredited registrars are required to have all of their registrants enter into an agreement wherein each registrant "shall provide to Registrar accurate and reliable contact details and promptly correct and update" those details during the term of the registration.¹²

Problems with Whois: Accuracy and Accessibility

Unfortunately, despite the RAA requirement that registrants provide "accurate and reliable contact details," trademark owners have for many years been encountering instances of inaccurate or missing data often from fictitious entities listing false addresses, as well as information that is simply out of date. These are just a few examples of bad data that trademark owners have recently come across:

- (1) In a recent UDRP case involving the cybersquatting of www.nhlpenguins.com, the individuals listed as administrative and technical contacts for the contested domain name, Allen Ginsberg and Charles Bukowski, respectively, are the names

⁶ Today there are approximately 167 ICANN accredited registrars from 25 countries.

<http://www.icann.org/registrars/accredited-list.html>.

⁷ RAA, at <http://www.icann.org/registrars/ra-agreement-17may01.htm>.

⁸ *Id.*, at para. 3.8.

⁹ *Id.*, at paras. 3.3-3.7. Note, however, that registrars are responsible for public access to Whois data only in the so-called "thin registry" TLDs, currently .com, .net, and .org. In the other so-called "thick registries," Whois service is the responsibility of the single registry operator for each registry.

¹⁰ *Id.*, at para. 3.3. The information to be listed on the publicly accessible site is provided in para. 3.3.1.1 through 3.3.1.8. Whois data is also publicly available for free via a number of third-party portals, see, e.g., www.swhois.net.

¹¹ *Id.*, at para. 3.3.6.

¹² *Id.*, at para. 3.7.7.1.

- of deceased poets from the American “Beat Generation.”¹³ The contact address listed in the Whois records was the Russian Institute of Physics and Power Engineering in a town 100 kilometers south of Moscow.
- (2) The domain name www.kodakphotospot.com, which is listed by its owner as being for sale, does not provide an owner, administrative, or technical contact address.
 - (3) For the domain name www.harleydavidsonmotorcompany.net, counsel investigating the ownership of the name found the telephone and fax numbers were listed as “+1.1111111111” in the Whois database.
 - (4) Investigating the domain name www.amazonshopper.com, Amazon.com found that the domain name registrar had accepted the registration even with the registrant listing most of the contact information as “unknown.” The telephone number for the administrative contact was listed as “+1.1234567891.”

Presumably there is a means for addressing these flagrant violations of the RAA. Paragraph 3.7.8 of the RAA stipulates:

Registrar shall, upon notification by any person of an inaccuracy in the contact information associated with a Registered Name sponsored by Registrar, take reasonable steps to investigate that claimed inaccuracy. In the event Registrar learns of inaccurate contact information associated with a Registered Name it sponsors, it shall take reasonable steps to correct that inaccuracy.

Registrars also have the authority to cancel domain name registrations that are based on false contact data or whose registered owners do not make a timely response to an inquiry about allegedly false data. Paragraph 3.7.7.2 of the RAA stipulates:

A Registered Name Holder's willful provision of inaccurate or unreliable information, its willful failure promptly to update information provided to Registrar, or its failure to respond for over fifteen calendar days to inquiries by Registrar concerning the accuracy of contact details associated with the Registered Name Holder's registration shall constitute a material breach of the Registered Name Holder-registrar contract and be a basis for cancellation of the Registered Name registration.

Despite these provisions, many accredited registrars have been lax in investigating and cleaning up registrations with false Whois data. The dual problems of inaccurate Whois data and the failure on the part of domain name registrars to ensure reliable data has reached the point that some trademark owners no longer seek assistance from the domain name registrar. It is simply too time consuming and there is no guarantee of positive results. Instead, trademark owners are forced to hire private investigators to obtain the accurate contact data.

¹³ WIPO Mediation and Arbitration Center, Administrative Panel Decision, *National Hockey League And Lemieux Group Lp v. Domain For Sale*, Case No. D2001-1185.

Trademark and copyright owners have repeatedly drawn ICANN's attention to the problems with respect to inaccurate Whois data. There is, however, only one reported instance in which ICANN has advised a domain name registrar that it was in violation of the RAA's Whois provisions, specifically paragraph 3.7.8, and threatened to terminate the registrar's accreditation.¹⁴ Beyond this one case, we are not aware of any other time whereby ICANN has sought to enforce the Whois accuracy provisions of the RAA.

In addition to the problem of accuracy, trademark owners are also beginning to experience problems with respect to registrars granting accessibility to bulk Whois data. These problems were outlined in a May 1, 2003 letter from Jane Mutimear, president of the ICANN Intellectual Property Constituency (IPC), to ICANN's then-general counsel Louis Touton.

- A failure by domain name registrars to respond to requests for bulk Whois information.
- Deleting most of the information from the database before making it available under bulk Whois agreements; and
- Drafting of extremely restrictive, non-negotiable bulk Whois access contracts, which are so one-sided that they have served as a significant deterrent for third parties to enter into an agreement with registrars.¹⁵

The IPC letter added, "Denial of such access is a violation of the RAA, something that falls squarely within the purview of ICANN's enforcement responsibilities." To date, no one from ICANN has responded to this letter. In fact, we know of no action taken by ICANN to ensure that domain name registrars are complying with the bulk Whois requirements of the RAA.

Efforts to Improve Whois

There are efforts currently underway within ICANN that are designed to improve the collection and accuracy of Whois data and to address the ways that access to the data affects privacy and the proliferation of "spam." We assume these efforts would produce results more substantial than the limited number of minor changes that were recently implemented by ICANN, including the Whois data reminder policy (WDRP), which "calls for ICANN-accredited registrars to provide domain-name registrants with an annual listing of their Whois data and to remind registrants of the need to correct inaccurate or out-of-date information."¹⁶

Perhaps the most visible efforts to move forward on the Whois issue took place at the recent ICANN meeting in Montreal. A two-day workshop was held on the uses of Whois

¹⁴ Letter from Louis Touton to Bruce Beckwith, *Notice of Breach of ICANN Registrar Accreditation Agreement*, September 3, 2002, at <http://www.icann.org/correspondence/touton-letter-to-beckwith-03sep02.htm>.

¹⁵ Letter from Jane Mutimear (Intellectual Property Interests Constituency) to Louis Touton, May 1, 2003, at <http://www.icann.org/correspondence/mutimear-to-touton-01may03.htm>.

¹⁶ <http://www.icann.org/announcements/advisory-16jun03.htm>.

and possible new approaches to the structuring, accessibility, and use of the data. INTA expresses its gratitude to ICANN for holding the seminar and to the U.S. DOC for its role in organizing the event on behalf of the ICANN Governmental Advisory Committee (GAC). The presentations were informative and provided members of different constituencies with the opportunity to exchange ideas. We look forward to following up on those productive meetings.

The follow up to the Montreal workshop, however, as well as the work of ICANN committees and task forces that are focusing on Whois, will take months, if not years to complete and then implement. In the meantime, the problems that we identified above, as well as others, continue to proliferate. Therefore, in the interim, ICANN itself must begin to take concrete steps to enforce the Whois and related provisions of the existing contracts, and must demonstrate a willingness to revoke the accreditation of domain name registrars that do not carry out their obligations. ICANN must dedicate more staff time and financial resources to this task and respond in a timely manner to complaints by the public concerning potential RAA violations. If it does not, ICANN not only risks the credibility that it has fought so hard to establish, but the stability of the DNS that is entrusted with, as well as becoming nothing more than a paper tiger in the eyes of domain name registrars.

The U.S. government, through the DOC, can play a critical role in ensuring that the provisions of the RAA are enforced by ICANN. One way this can be accomplished is by continuing to be a leader among the nations that participate in the GAC. INTA commends the work of former Under Secretary of Commerce Nancy Victory, DOC Associate Administrator Robyn Layton, and U.S Patent and Trademark Office (USPTO) Attorney-Advisor Amy Cotton in protecting brand owner and consumer interests through their direct participation in the GAC.

The other way that the DOC can ensure that the RAA provisions are enforced is through the MOU. It is in the MOU that the DOC and ICANN agree upon those subjects to which ICANN will dedicate resources in the coming year. For example, in the present version of the MOU, ICANN agreed to “Continue its efforts to achieve stable agreements with [country code top-level domain] ccTLD operators.”¹⁷ and “Continue the process of implementing new top level domains (TLDs).”¹⁸ Therefore, INTA requests that the DOC stipulate in the MOU, which is up for renewal later this month, that ICANN dedicate significant resources to enforcing its contracts with registrars and exercise its right under the RAA to take steps to revoke a registrar’s accreditation if the registrar does not comply.

ccTLDs

Access to reliable Whois data and effective policies for resolving domain name disputes are also a concern in the country code top-level domain (ccTLD) space. The ccTLDs are the domains assigned to specific countries (e.g., .us for the United States, .uk

¹⁷ Amendment 5 to the MOU, *supra* note 2, at section II, amending V.C. of the MOU.

¹⁸ *Id.*

for the United Kingdom, and .il for Israel). At present, there are over 240 ccTLDs in the world, and the number of ccTLD domain name registrations is growing rapidly. As of February 1, 2003, there are 19,158,364 registered domain names in ccTLDs, constituting 38.4% of the total number of domain names registered in the combined gTLD and ccTLD namespaces.¹⁹ The ccTLD for Germany, .de, is second only to .com in the total number of registrations with 6,117,000,²⁰ and .uk is the third largest TLD with 4,168,000 domain names.²¹

At the recent ICANN meeting in Montreal, an agreement was reached concerning the formation of a ccTLD supporting organization, which would significantly assist ICANN in achieving agreements with ccTLD operators. INTA, through its participation in the IPC, supported the formation of the Country Code Name Supporting Organization (ccNSO) and compliments ICANN and the ccTLD administrators for coming to an agreement that will facilitate greater communication between them. We also acknowledge that ccTLD managers and ICANN have agreed that ccTLDs should have a mechanism “for making certain [registrant contact] data generally and publicly available (be it, for example, through Whois or nameservers).”²²

However, we are concerned that ccNSO mandate agreed to in Montreal is not sufficient in terms of improving the accuracy or the accessibility of Whois data in ccTLDs. It does not encourage the enforcement of Whois data policy in the ccTLD namespace. And, it fails to address the development of a cybersquatting dispute resolution policy for ccTLDs, something that would be akin to the UDRP that exists on the gTLD level.

The IPC had urged that ICANN play a direct role in the development of these policies. Uniformity of Whois and dispute resolution policies on the ccTLD level are just as important as they are on the gTLD level. It is essential to ensuring a safe, stable, and reliable online environment, particularly with ccTLD usage on the rise. ICANN should establish some broad-based policies for ccTLD administrators to implement regarding Whois and dispute resolution in their ccTLD. We suggest that the World Intellectual Property Organization’s *ccTLD Best Practices for the Prevention and Resolution of Intellectual Property Disputes*²³ be used as a guide for these policies.

Until such time as ICANN creates ccTLD policies regarding Whois and dispute resolution, INTA recommends that the U.S. government continue to insert into its bi-lateral trade agreements with other countries Whois and domain name dispute resolution language similar to that in the recently completed Chilean and Singaporean accords. INTA commends the U.S. government, particularly the DOC, USPTO, and U.S. Trade

¹⁹ ICANN, Proposed Fiscal Year 2003-2004 Budget, Appendix 1, May 17, 2003, at <http://icann.org/financials/proposed-budget-17may03.htm>.

²⁰ *Id.* As of February 1, 2003, there are 23,239,000 domain names in .com.

²¹ *Id.*

²² ICANN Bylaws, Annex C: The Scope of the ccNSO, The Core Functions, Data Entry Function (1)(b), at <http://www.icann.org/general/bylaws.htm>.

²³ <http://ecommerce.wipo.int/domains/cctlds/bestpractices/bestpractices.doc>.

Representative, for inserting provisions that address the online concerns of trademark owners.

Conclusion

Thank you for the opportunity to submit a statement in connection with the subcommittee's oversight of intellectual property safeguards on the Internet. INTA looks forward to working with the administration, this subcommittee, and our colleagues who are part of the Internet community to strengthen the safety and reliability of the DNS.