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Submitted to: comments-ppsai-initial-05may15@icann.org

July 7, 2015

Ms. Mary Wong  
Senior Director of Policy  
ICANN  
12025 Waterfront Drive, Suite 300  
Los Angeles, CA 90094-2536

Re: Privacy Proxy Services Accreditation Issues – Initial Report

Dear Ms. Wong:

The International Trademark Association (INTA) is pleased to submit the attached comments regarding the initial report of the policy development process working group on privacy and proxy accreditation issues published for public comment on May 5, 2015. We thank the working group for their diligence and attention to this critical issue.

INTA's comments are predicated on our mission to protect consumers and to promote fair and effective commerce. We have focused on the options for relay and reveal procedures as we favor mechanisms that strike a balance between privacy concerns and the mitigation of risk to consumers who may be harmed by instances of confusion including cybersquatting, counterfeiting and other acts of abuse. Should you have any questions about our comments, I invite you to contact Lori Schulman, INTA's Senior Director of Internet Policy at 202-261-6588 or at [lschulman@inta.org](mailto:lschulman@inta.org).

Sincerely,

A handwritten signature in blue ink, appearing to read "Etienne Sanz de Acedo". The signature is stylized and fluid, with a long horizontal stroke at the end.

Etienne Sanz de Acedo

## INTA Comment on PPSAI WG Initial Report July 7, 2015

The International Trademark Association (“INTA”) appreciates this opportunity to comment on the Initial Report (the “Initial Report”) published by the Policy Development Process Working Group (“WG”) on issues relating to the accreditation of privacy and proxy service providers.

### **Introduction**

INTA’s views on the merits of the recommendations outlined in the Initial Report – and on privacy/proxy services (“P/P Services”) generally – are informed by its mission as an association “dedicated to supporting trademarks in order to protect consumers and to promote fair and effective commerce.”<sup>1</sup> This belief that trademarks protect consumers is itself based on a more fundamental conviction that attribution fosters accountability.<sup>2</sup> Dating back to cattle brands (hence the word “brand”) and stonecutter signs, trademarks have always been, at their core, source identifiers: they are designations used to identify and distinguish the goods (or services, if it is a service mark) of one person or entity from those of another. This attribution function of trademarks fosters accountability, creating an incentive for sellers to maintain a predictable, consistent quality for their goods. And that consistency in turn protects consumers, who can rely on trademarks to make quick, confident, and safe purchasing decisions. That accountability also protects consumers by assigning responsibility: without trademarks, a seller’s low-quality products would be untraceable, leaving consumers without any recourse for faulty, deficient, or unsafe goods.

P/P Services are, by design, intended to thwart attribution. In that sense they are, at their core, the opposite of trademarks: they are not source identifiers but source concealers, used not to tell consumers who is behind a domain name (or the website to which it directs, or the goods and services offered on that website), but to hide that fact from consumers. This in turn inhibits consumers’ ability to make quick, confident, and safe purchasing decisions in at least two related ways: 1) by decreasing consumers’ ability to attribute to a single source faulty, deficient, or unsafe goods or services sold through domains that use P/P Services; and 2) by increasing the enforcement costs that trademark owners must incur to police infringements. That is not to say that P/P Services are *per se* illicit, or that there is never a place for them. Rather, it is to suggest that the standards by which ICANN accredits providers of P/P Services (“P/P Providers”) should be crafted to mitigate as much as possible the risks that those services pose to consumers. To do so, ICANN’s accreditation standards for P/P Providers should: 1) limit the availability of P/P Services to those circumstances when a compelling interest in preserving a registrant’s anonymity justifies the increased risk to consumers that P/P Services create; and 2) in those cases, implement mechanisms to mitigate that increased risk by ensuring that trademark owners can still effectively and

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<sup>1</sup> <http://www.inta.org/About/Pages/Overview.aspx>.

<sup>2</sup> The link between transparency and accountability is a fundamental tenet not just for INTA but also for ICANN, as reiterated in Article III of the ICANN Bylaws and the 2009 Affirmation of Commitments with the United States Department of Commerce. See <https://www.icann.org/resources/pages/governance/bylaws-en/#III> and <https://www.icann.org/resources/pages/affirmation-of-commitments-2009-09-30-en>.

efficiently police consumer confusion. With those two objectives in mind, INTA offers its comments on three specific portions of the Initial Report.

**A. INTA agrees that P/P Services should be available to commercial entities – but not for domain names used for online financial transactions.**

INTA agrees with the WG that the mere fact that a domain name is registered by a commercial entity or by anyone conducting commercial activity should not preclude the use of P/P Services.<sup>3</sup> In fact, there will be times when INTA members themselves (many of whom are commercial entities) will want to rely on P/P Services. For example, a company may wish to secure a domain name for a new product for which it has cleared a new trademark internally, but which it has not yet announced publicly. It should be able to use a P/P Service to do so.

But INTA also agrees that registrants of domain names that are used for online financial transactions for commercial purposes should be ineligible to use, or to continue to use, P/P Services for those domains.<sup>4</sup> This distinction follows naturally from the basic principle of trademark law that attribution for goods and services fosters consistency and accountability, which in turn protects consumers.<sup>5</sup> Thus, when goods or services are sold or offered for sale through a website, consumers' interest in being able to attribute those goods and services to a single source is high. At the same time, when goods or services are sold or offered for sale through a website, the registrant's interest in maintaining its anonymity is low.

The ability to speak anonymously helps to promote the robust exchange of ideas, and to allow individuals to express themselves without fear of economic reprisal or official retaliation.<sup>6</sup> But those rationales do not extend equally to speech that does no more than propose a commercial transaction.<sup>7</sup> In Europe, the European Convention on Human Rights provides protection for Freedom of Expression under Article 10, including the right to impart and receive information freely. A case that provides a helpful sense of this relates to the upholding of the

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<sup>3</sup> Initial Report at 15, 48.

<sup>4</sup> Initial Report at 16, 49. INTA will use the formulation “used for online financial transactions for commercial purposes” from the Initial Report. But to be clear: a domain name should meet the definition of “used for a financial transaction” when the website to which the domain name resolves facilitates or promotes any part of a transaction – whether or not the *entire* transaction takes place on that website. Many websites facilitate or promote commercial transactions even though the transaction is actually finalized through a third-party payment processor. A domain name that resolves to a website selling counterfeit goods should still meet the definition, even if the currency transfer is handled by a payment processor.

<sup>5</sup> See, e.g., *Two Pesos Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 n.15 (1992) (Stevens, J. concurring) (“The purpose underlying any trademark statute is two-fold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get.”).

<sup>6</sup> See, e.g., *McIntyre v. Ohio Elections Comm'n*, 514 U.S. 334, 341-42 (1995).

<sup>7</sup> See, e.g., *Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60, 64-65 (1983) (noting that the U.S. Constitution “accords less protection to commercial speech than to other constitutionally safeguarded forms of expression.”). See also *C-324/09 - L’Oreal and Others vs. eBay* Judgment of the Court (Grand Chamber) of 12 July 2011 where the Court specifically stated that, “although it is certainly necessary to respect the protection of personal data, the fact remains that when the infringer is operating in the course of trade and not in a private manner, that person must be clearly identifiable.”

criminal convictions of the operators of the piratebay website<sup>8</sup>, where the European Court of Human Rights found that: “*the safeguards afforded to the distributed material in respect of which the applicants were convicted cannot reach the same level as that afforded to political expression and debate*” and that “*there were weighty reasons for the restriction of the applicants’ freedom of expression*” on the commercially run website.

As in the US, the courts distinguish between political speech, which is given a high level of protection, and commercial forms of speech where there is a much wider “margin of appreciation” in balancing this protection with other rights and limitations.

Hence the registrant’s interest in anonymity – and the justification for P/P Services – is lower in those cases. Given this balance – higher consumer interest in attribution; lower registrant interest in anonymity – domain names used for online financial transactions for commercial purposes should be ineligible for P/P Services.

**INTA agrees that P/P Providers should relay allegations of trademark infringement to their customers – including in those cases when the P/P Provider learns that its initial electronic relay has failed.**

In order to protect consumers, ICANN’s accreditation standards for P/P Providers must ensure that trademark owners<sup>9</sup> can effectively and efficiently police against consumer confusion – even if the identity of the entity or individual causing that confusion is otherwise hidden by a P/P Service. The first step in doing so is to require P/P Providers to relay allegations of trademark infringement to their customers (“P/P Customers”). The recommendations in the Initial Report largely do so. INTA has no objection to the Initial Report’s recommendation that at least the initial communication to a P/P Provider alleging trademark infringement be made in electronic format (e.g., emails and web forms).<sup>10</sup> INTA also agrees that P/P Providers should be required to either promptly forward to the P/P Customer all electronic communications that they receive (except for spam filtered out by commercially reasonable safeguards), or to promptly forward to the P/P Customer at least those electronic communications they receive that contain allegations of illegal activity such as trademark infringement.<sup>11</sup> Once that initial relay is made, a P/P Provider should be required to promptly notify the trademark owner if it becomes aware of a “persistent delivery

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<sup>8</sup> Neij and Sunde Kolmisoppi v. Sweden 40379/12

<sup>9</sup> For convenience, and given the focus of its mission, INTA will use the shorthand term “trademark owner” throughout this comment. Yet INTA recognizes that the term is under-inclusive. For example, many of the points that INTA raises in this comment apply equally to copyright as well as trademark owners. INTA also recognizes that trademark owners may rely on agents to police against infringement of their marks, and that those agents will interact with P/P Providers in doing so. Nothing in this comment should be read to suggest anything to the contrary.

<sup>10</sup> Initial Report at 11.

<sup>11</sup> Initial Report at 11.

failure”<sup>12</sup> and should perform a verification or re-verification (as applicable) of the P/P Customer’s email address at that time.<sup>13</sup>

INTA thus supports the Initial Report’s recommendations on “relay” as far as they go. But they should go farther. The WG has yet to agree on obligatory next steps for P/P Providers following a persistent delivery failure, and specifically on: 1) whether P/P Providers “must” or “should” forward a further form of notice of trademark infringement to the P/P Customer upon learning of a persistent delivery failure; 2) whether P/P Providers may charge trademark owners a reasonable fee on a cost-recovery basis for doing so; and 3) whether P/P Providers should have the right to impose reasonable limits on the number of such requests made by the same trademark owner.<sup>14</sup>

INTA’s answer to the first of these three questions is “must”. If one objective of the WG’s accreditation standards is to protect consumers by ensuring that trademark owners can effectively and efficiently police against consumer confusion, an optional “should” in this context does not suffice. A touchstone of an effective WHOIS system is contactability. By putting themselves in the shoes of their P/P Customers, P/P Providers accept (in exchange for payment) responsibility for being able to reach those P/P Customers. In the case of a persistent delivery failure, they must try to establish contact with the P/P Customer until they succeed – or at least must try some form of relay other than the initial electronic relay that failed. Moreover, at this juncture in the process, the P/P Provider will, by definition, have more information about the P/P Customer than will the trademark owner. Forcing the trademark owner to escalate its infringement complaint – for example, by filing a lawsuit – before the P/P Provider has exhausted its options for relaying the allegation of trademark infringement to the P/P Customer does not account for this information asymmetry. It also creates a perverse incentive for P/P Customers to provide inaccurate electronic contact information to their P/P Providers. This benefits no one.

INTA’s answer to the second question is that any cost incurred by the P/P Provider for forwarding a further form of notice to the P/P Customer should be borne by either the P/P Provider or the P/P Customer. There are three possibilities as to who should bear that cost: 1) the P/P Provider; 2) the P/P Customer; or 3) the trademark owner/consuming public.<sup>15</sup> But the cost was incurred by the P/P Provider precisely because it chose to offer – and the P/P Customer chose to purchase – the P/P Service (absent the P/P Service, the trademark owner could have known how to contact the P/P Customer directly from the various contact options available in the public

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<sup>12</sup> Initial Report at 12. INTA has no objection to the Initial Report’s definition of “persistent delivery failure” as having occurred “when an electronic communications system abandons or otherwise stops attempting to deliver an electronic communication to a customer after a certain number of repeated or duplicate delivery attempts within a reasonable period of time.” However, to make sure that P/P Providers do not use email addresses that do not accept replies so as to intentionally avoid becoming aware of a persistent delivery failure, the WG should require that P/P Providers only send their relays using email addresses that can receive or otherwise log undeliverable bounce backs.

<sup>13</sup> Initial Report at 12.

<sup>14</sup> Initial Report at 14.

<sup>15</sup> *See, e.g.*, J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 2:33 (“When a business sues for trademark infringement the plaintiff is acting not only in its own interest, but in the public interest. . . . The plaintiff in trademark litigation could be characterized as a ‘vicarious avenger’ of consumer interests.”) (citations omitted).

WHOIS). Presumably both the P/P Provider and the P/P Customer entered into that contract willingly, and derived some benefit from doing so. Conversely, the trademark owner/consuming public had no choice as to whether the P/P Provider and P/P Customer would enter into that contract, and derived no benefit from them doing so. Rather than passing on that cost as an externality of their contract, the P/P Provider and the P/P Customer should bear it themselves. They can negotiate between themselves as to how to divide it.

INTA's answer to the third question is that P/P Providers should have the ability to impose reasonable limits on the number of relay escalation requests made by the same trademark owner *against the same domain name*. But P/P Providers should not be able to limit the number of relay escalation requests made by the same trademark owner *against different domain names*. Trademark owners obviously cannot control the volume of infringements undertaken by different P/P Customers using the same P/P Service. Nor for that matter can trademark owners even tell if multiple different domain names using the same P/P Service are in fact operated by the same P/P Customer. One way to reduce the volume of such relay escalation requests might be for P/P Providers to include unique identifiers (e.g., a random number) for each of their P/P Customers in the publicly accessible WHOIS. That way trademark owners could run the equivalent of a Reverse WHOIS lookup – identifying the P/P Customer behind multiple infringing domain names – without having to burden the P/P Provider with relay escalation requests for each domain name. But absent such a feature, P/P Providers should not be able to limit the number of relay escalation requests against a single P/P Customer. And even with such a feature, P/P Providers should not be able to limit the number of relay escalation requests against different P/P Customers. The Initial Report should be amended to make this point explicit.

**C. INTA's views on the Initial Report's Disclosure Framework are mixed.**

**1) *INTA agrees with most of the Disclosure Framework – especially Section III(D).***

Requiring P/P Providers to relay allegations of trademark infringement to P/P Customers is a good first step. But it is not sufficient by itself to ensure that trademark owners can effectively and efficiently police consumer confusion. Presumably there will be times when relay will not resolve a trademark owner's concerns. In those cases, there must be some process whereby the trademark owner can request that the P/P Provider disclose the contact information for the P/P Customer that would ordinarily appear in the publicly accessible WHOIS. The Initial Report's "Annex E – Illustrative Draft Disclosure Framework for Intellectual Property Rights-holders" (the "Disclosure Framework") outlines just that.<sup>16</sup> With the exception of the specific points discussed below, INTA generally supports the Disclosure Framework. In INTA's view, the Disclosure Framework largely achieves the three objectives that the WG identified for it: 1) facilitating direct communication between trademark owners and P/P Providers; 2) providing trademark owners with a high degree of certainty and predictability as to if, when, and how they can obtain disclosure; and 3) balancing the interests of trademark owners, P/P Providers, and P/P Customers alike.<sup>17</sup>

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<sup>16</sup> Initial Report at 84-93.

<sup>17</sup> Initial Report at 84.

INTA especially agrees with Section III(D) of the Disclosure Framework, which provides: 1) that disclosure cannot be refused solely for lack of a court order, subpoena, pending civil action, or UDRP/URS proceeding; and 2) that disclosure cannot be refused solely because a trademark owner's request was founded on alleged intellectual property infringement in content on a website associated with the domain name (rather than in the domain name itself).<sup>18</sup> Both of these points reflect a broader sentiment that animates much of the Disclosure Framework (from the first sentence):<sup>19</sup> that the public interest is better served by a policy that facilitates direct and open communication between trademark owners and P/P Customers, rather than one that simply funnels them into adversarial litigation or other adjudication. In fact, it is easy to think of cases where disclosure may obviate the need for adversarial litigation altogether. Perhaps the trademark owner can contact the P/P Customer to negotiate a resolution. Perhaps the name or address of the P/P Customer may change the trademark owner's jurisdictional analysis. Perhaps that information could be relevant to the bad-faith element of the trademark owner's potential UDRP action. And so on. Nobody benefits from a policy that prematurely forces trademark owners and P/P Customers (and P/P Providers for that matter, who are often named in proceedings on behalf of P/P Customers) into adversarial proceedings that could have otherwise been avoided.<sup>20</sup> The WG was right to work with that sentiment in mind. Section III(D) is critical to achieving it.

Section III(D) is also critical to maintaining the internal logic of the Disclosure Framework. The whole point of the Disclosure Framework is to outline what information trademark owners must provide when seeking disclosure from P/P Providers, and what P/P Providers must do in response to receiving such information. If the WG believed that P/P Providers were justified in disclosing only in response to a court order, subpoena, pending civil action, or UDRP/URS proceeding, then it could have just said that in the Initial Report – and not created the Disclosure Framework at all. Similarly, with respect to the notion that disclosure might be refused solely because a request relates solely to website “content”: Section II(B) of the Disclosure Framework outlines the process to be used when a “domain name resolves to website where copyright is allegedly infringed”; Section II(C) outlines the process to be used when a “domain name resolves to website where trademark is allegedly infringed.” Both of those sections would be superfluous if a P/P Provider could refuse to disclose simply because a request was founded on alleged infringement in content on a website associated with a domain name, rather than in the domain name itself. In short, Section III(D) simply makes *explicit* certain assumptions that are *implicit* in the structure of other portions of the Disclosure Framework.

## 2) *INTA disagrees with other portions of the Disclosure Framework.*

While INTA thus largely supports the Disclosure Framework, there are still portions of it with which INTA disagrees. Some of INTA's objections are narrow:

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<sup>18</sup> Initial Report at 91.

<sup>19</sup> Initial Report at 84.

<sup>20</sup> This is especially true to the extent that litigation or a UDRP results in termination of the P/P Service altogether. Obviously, disclosure to a single entity is less consequential for the P/P Customer than publication to the world.

- **Cost recovery:** INTA objects to P/P Providers assessing “a standardized nominal cost-recovery fee” for processing disclosure complaints, as contemplated by Section I(B)(iii),<sup>21</sup> for the same reason that it objected to the cost-recovery fee discussed above: it is the P/P Provider and P/P Customer who willingly entered into the contract for the P/P Service, and who derive benefit therefrom. Any costs arising from that contract should be divided between the two contracting parties as they see fit – not passed on to trademark owners and the consuming public.<sup>22</sup>
- **Timeframes:** INTA submits that the timeframes included in Sections III(A) and (B) – currently “15 calendar days” and “x calendar days” respectively<sup>23</sup> – should be “10 calendar days” each. Twenty (20) calendar days is sufficient time for a P/P Provider and P/P Customer to respond to a trademark owner’s notice. And in those exceptional circumstances when 20 days are not enough, the Disclosure Framework provides a release valve for P/P Providers to inform the trademark owner of the cause of the delay, and to provide a new later date by which it will respond.<sup>24</sup> Again, a P/P Customer’s need for additional time to respond has to be balanced with the need of a trademark owner to police its rights, and to prevent the inherent risk of consumer confusion or harm from infringement. Any extension of the time by which P/P Providers address trademark owner complaints only increases the risk that consumers will be confused in the interim.
- **Evidentiary requirement:** INTA notes that both Sections II(A)(5) and II(C)(5) require trademark owners to provide a trademark registration number and links to the national trademark register where the trademark in question is registered (or a representative sample of such registers in the case of an internationally registered mark) as part of any request for disclosure.<sup>25</sup> Such a requirement could be read to suggest that the Disclosure Framework does not apply to complaints based on common-law trademarks for which the trademark owner has no national registration. INTA assumes that the WG did not intend to exclude such trademarks from the process outlined in the Disclosure Framework, and thus would recommend adding the phrase “and, if applicable” between “the trademark” and “the trademark registration number” in Sections II(A)(5) and II(C)(5) to clarify this potential ambiguity.

On a broader note: INTA also objects to the inclusion of the language “and which should be similarly accessible to the Customer for purposes of an appeal” in Section III(F), which outlines the process by which P/P Providers must participate in an ICANN-approved review/appeal process in the event that they refuse a disclosure request. Applying Section III(F) to P/P Customers seems odd on its face: Section III(F) only applies “[i]n the event of a final refusal to disclose” by the P/P Provider. So why would a P/P Customer ever need to appeal a final *refusal* to disclose? The WG doesn’t say. But assuming that the language was intended to allow the P/P Customer an opportunity to appeal a P/P Provider’s decision *to* disclose (not its *refusal* to disclose), there are multiple problems with it.

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<sup>21</sup> Initial Report at 85.

<sup>22</sup> In addition to this basic principle (that the parties enjoying the benefit of a contract should also bear its costs), INTA would also object to any “standardized nominal cost-recovery fee” because that term is ambiguous, nebulous, and prone to abuse.

<sup>23</sup> Initial Report at 90.

<sup>24</sup> Initial Report at 90.

<sup>25</sup> Initial Report at 86 and 89.

One problem is that the Disclosure Framework does not provide any kind of explanation or guidance as to the procedure to be used for a P/P Customer's appeal of a P/P Provider's decision to disclose. Section III(B) simply provides that after receiving the P/P Customer's response to a trademark owner's request (or after the time for a response has passed), the P/P Provider can either disclose, or not. If the P/P Customer is supposed to be able to appeal that decision to disclose: when would that appeal take place? How would the P/P Customer know the P/P Provider's decision? Would the P/P Provider be required to communicate its decision to disclose to the P/P Customer before actually disclosing? If so, how long before? Must it provide the P/P Customer with its reasons? The Disclosure Framework does not address any of those questions in Section III(F) – or anywhere else. The WG must address these questions.

Moreover, allowing P/P Customers to appeal a P/P Provider's decision to disclose is internally inconsistent with other portions of the Disclosure Framework. Specifically, in Section I(D) of the Disclosure Framework the WG noted that nothing would prevent a P/P Provider from adopting and implementing policies to publish the contact details of its P/P Customers, or to otherwise terminate a P/P Service, for any grounds outlined in its Terms of Service (including breach of those Terms).<sup>26</sup> There was no mention there – or anywhere else in the Initial Report – about P/P Customers having any access to any kind of an appeal of a P/P Provider's decision to terminate a P/P Service for that reason. It is unclear why the WG would decide that P/P Customers should have the ability to appeal a P/P Provider's decision to terminate their P/P Service for *one* specific reason (namely, trademark or copyright infringement), but not for *any other* reason. The WG does not say.

Finally, allowing P/P Customers to appeal a P/P Provider's decision to disclose ignores the basic contractual imbalance between trademark owners, P/P Providers, and P/P Customers. Two of those groups – the P/P Providers and the P/P Customers – have a contractual relationship with each other. Trademark owners, in contrast, are on the outside looking in. So if a P/P Customer wants to obtain some form of notice and a chance to object before its P/P Provider discloses its contact information to anybody (including but not limited to trademark owners), then it can negotiate such a process with its P/P Provider (so long as the process is otherwise consistent with the Disclosure Framework). Likewise, if a P/P Provider wants to offer its P/P Customers a robust appeal process – perhaps as a means of distinguishing itself from its competitors – it is also free to do so (again, so long as that process is otherwise consistent with the Disclosure Framework). Trademark owners do not have that ability to bargain for any more or less appellate procedures. Section III(F) aims to compensate for that imbalance. Applying Section III(F) equally to trademark owners and P/P Customers alike is inconsistent with that objective.

**3) *INTA can only support Section III(C) of the Disclosure Framework if the WG chooses the second of the two possible standards for Sections III(C)(ii) and (iii).***

In addition to those points of disagreement, there are other portions of the Disclosure Framework for which INTA neither agrees nor disagrees, but instead will withhold judgment until certain open questions (for which the WG sought community input) are resolved. Of these, the

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<sup>26</sup> Initial Report at 85.

most significant open question is what standard to use to justify a P/P Provider’s refusal to disclose based on either: 1) the P/P Customer’s objection (as outlined in Section III(C)(ii)); or 2) the P/P Provider’s own determination (as outlined in Section III(C)(iii)).<sup>27</sup> The Disclosure Framework offers two possible options for this standard:

- That the P/P Customer has provided – or the P/P Provider has independently found – an [adequate], [sufficient], or [compelling] reason against disclosure; or
- That the P/P Customer has provided – or the P/P Provider has independently found – a reasonable basis for believing that the P/P Customer is not infringing the trademark in question, or that its use of the trademark is defensible.

Of these two standards, INTA only supports the second. Offering a fair balance, the second standard mirrors the language in Sections II(A)(6)(a) and II(C)(6)(a) as to what information a trademark owner seeking a disclosure must provide to a P/P Provider.<sup>28</sup> It also mirrors the language in Section III(F) as to what the ICANN-approved dispute resolution provider will review to determine whether the P/P Provider’s refusal to disclose was appropriate.<sup>29</sup> Specifically, Section III(F) provides that “the dispute resolution provider *shall* order that disclosure be made if there is a reasonable basis for believing that the Customer has, as alleged, infringed upon the Requester’s claimed rights in a manner that is not defensible.” (Emphasis added). In other words, Sections II (A), II(C), and III (F) all contemplate that the *only* acceptable reason for a P/P Provider to deny a trademark owner’s request for disclosure is if there is a reasonable basis for believing that the P/P Customer is not infringing the trademark in question, or that its use of the trademark is defensible. The second standard is entirely consistent with that assumption.

Conversely, the first standard assumes that there may be reasons for a P/P Provider to deny a trademark owner’s request for disclosure that may be “adequate,” “sufficient,” or “compelling” *but that have nothing to do with* whether there is a reasonable basis for believing that the P/P Customer is infringing the trademark in question, or that its use of the trademark is defensible. The WG nowhere says what those other reasons might be. Nor can INTA think of any. They cannot have anything to do with whether the trademark owner has pursued a court order, subpoena, pending civil action, or UDRP/URS proceeding – those reasons are *per se* invalid under Section III(D). Nor could they be that the P/P Provider has already terminated the P/P Service, that the P/P Customer has surrendered its domain name in lieu of disclosure, or that the P/P Provider has found specific information showing that the trademark owner’s request was pretextual – those reasons are already covered by Sections III(C)(i), (iv), and (v), respectively. Again, INTA cannot think of what might be left as a legitimate reason to refuse disclosure. Yet the first standard contemplates that such reasons do exist. But it does not say what they are. It does not contemplate any mechanism for trademark owners to address them before-the-fact (because there is no way to proactively address them under Sections II(A) and II(C) as written). And it does not contemplate any mechanism for the ICANN-approved dispute resolution provider to review them after-the-fact

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<sup>27</sup> Initial Report at 91.

<sup>28</sup> Initial Report at 86 and 89.

<sup>29</sup> Initial Report at 92 n.61.

(because the scope of its review is limited to whether the P/P Customer was infringing under Section III(F) as written).

In sum, the first standard injects uncertainty and ambiguity into the Disclosure Framework – and not only because words like “adequate,” “sufficient,” and “compelling” are by their nature ambiguous (though they are). Doing so benefits no one: not P/P Customers who need clarity on when their P/P Service may or may not be terminated; not P/P Providers whose accreditation may turn on whether they have complied with the Disclosure Framework; not trademark owners seeking a high degree of certainty and predictability as to if, when, and how they can obtain disclosure; not consumers who rely on trademarks in their purchasing decisions. Such uncertainty and ambiguity invites abuse, and should be avoided if possible. They are easily avoidable here. All the WG needs to do is to adopt the second standard for Sections III(C)(ii) and (iii).<sup>30</sup>

## **Conclusion**

INTA appreciates the many competing interests that the WG has had to weigh and consider in formulating the recommendations in the Initial Report. The WG has done a commendable job doing so. And INTA appreciates the weight and consideration that the WG gave to ensuring that P/P Services do not hinder trademark owners’ efforts to effectively and efficiently enforce their trademarks and prevent consumer confusion. The Initial Report almost achieves that goal. But not quite. And for that reason, INTA also appreciates this opportunity to comment on those portions of the Initial Report with which it disagrees – or where it sees room for potential improvements. INTA thanks the WG in advance for its consideration of these comments.

## **About INTA and the Internet Committee**

INTA is a 136 year-old global not-for-profit association with more than 5,700 member organizations from over 190 countries. One of INTA’s 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 been the leading voice of trademark owners within the Internet community, serving as a founding member of the Intellectual Property Constituency of the Internet Corporation for Assigned Names and Numbers (ICANN). INTA’s Internet Committee is a group of over 200 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.

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<sup>30</sup> For the same reasons, INTA objects to the inclusion of “[without limitation]” in the prefatory language of Section III(C). Initial Report at 91.