INTA AND THE
INTERNET
CORPORATION FOR
ASSIGNED NAMES AND
NUMBERS

By Caroline G. Chicoine *

The Internet Corporation for Assigned Names and Numbers (ICANN) was created in October 1998, under a mandate from the U.S. Government to transition control of the Domain Name System (DNS) from the government to the private sector. ICANN’s mission is to coordinate the technical and policy functions of the DNS in order to promote a safe, stable and commercially viable domain name system. The importance of intellectual property and, in particular, trademarks in performing such functions was laid out in the documents that led to the creation of ICANN. Specifically, the “Green Paper” recognized that “for cyberspace to function as an effective commercial market, business must have confidence that their trademarks can be protected.”1 The subsequent “White Paper” recognized that the DNS must offer an affordable and less cumbersome mechanism for resolving conflicts between domain name holders and trademark owners.2 And, ultimately, the Memorandum of Understanding (MoU) between the Department of Commerce (DOC) and ICANN provided that ICANN was to consider recommendations of organizations concerning trademark/domain name disputes.3 As a result, a Domain Name Supporting Organization (DNSO) was created within the ICANN structure and charged with the responsibility of advising the ICANN Board on policy issues relating to the management of the DNS.

INTA, however, has been involved with ICANN well before its inception. In fact, INTA formed an Internet task force in early

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1995 with a handful of interested practitioners who had already appreciated that trademark considerations would be an integral part of ICANN’s policy functions. With the growth of the Internet and the increased number and complexity of DNS issues that have arisen because of such growth, INTA now has a standing Internet Committee consisting of four subcommittees totaling approximately 80 members from over a dozen countries.

INTA’s early efforts with ICANN involved coordinating with other intellectual property organizations to form the Intellectual Property Constituency (IPC) of the DNSO.\(^4\) The DNSO includes a Names Council that advises the ICANN Board on DNSO policy. The IPC has three seats on the Names Council, at least one of which has always been filled by an INTA member.\(^5\) INTA has also been an active participant both directly and in collaboration with the IPC in all areas of ICANN policymaking, including most notably the following:

- dispute resolution mechanisms;
- the addition of new gTLDs;
- WhoIs\(^6\); and
- domain name deletions.\(^7\)

INTA’s participation in these areas has resulted in a number of successful initiatives. With respect to uniform dispute resolution mechanisms, INTA was instrumental in the creation of ICANN’s

\(^4\) The Constituencies of the DNSO are intended to represent the various stakeholders of the DNS. In addition to the IPC, they include ccTLD registries, commercial and business entities, gTLD registries, ISPs and connectivity providers, non-commercial domain name holders and registrars. The original “Organizational Document of the Intellectual Property Constituency of the DNSO” submitted to ICANN can be found at http://www.icann.org/dnso/constituency_groups.html.

\(^5\) INTA Names Council representatives have included to date Caroline Chicoine, Guillermo Carey, J. Scott Evans and Ellen Shankman.

\(^6\) WhoIs is the database service through which Internet users have free public query-based access to up-to-date (i.e., updated at least daily) data concerning all active second level domain (SLD) registrations in the gTLDs. The data currently consists of the following elements: the name of the SLD being registered and the TLD for which registration is being requested; the IP addresses of the primary nameserver and secondary nameserver(s) for the SLD; the corresponding names of those nameservers; the identity of Registrar; the original creation date of the registration; the expiration date of the registration; the name and postal address of the SLD holder; the name, postal address, email address, voice telephone number, and (where available) fax number of the technical contact for the SLD; and the name, postal address, email address, voice telephone number, and (where available) fax number of the administrative contact for the SLD.

\(^7\) INTA’s participation has included being represented at every ICANN “physical” meeting to date. Such meetings have taken place around the world in the following locations: Bucharest, Accra, Marina del Rey, Montevideo, Stockholm, Melbourne, Yokohama, Cairo, Santiago, Berlin and Singapore.
Uniform Dispute Resolution Policy (UDRP). Not only did INTA members actively participate in the working group set up by ICANN to debate the issue, one of INTA’s members, J. Scott Evans, was appointed by ICANN to serve on a committee of only five individuals to draft the policy. Since its inception, over 5,700 UDRP actions have been filed to date, almost 4,500 of which have resulted in favor of the complainant trademark owner. The success of the UDRP was lauded by ICANN’s current President, Stuart Lynn, as one of ICANN’s few triumphs. Its success is further evidenced by the fact that 28 ccTLDs have adopted the UDRP or a variation thereof, although not required to do so.

With respect to the addition of new gTLDs, INTA members again actively participated in the working group set up by ICANN to debate the issue to insure that any introduction of new gTLDs was done in a slow and controlled manner to minimize trademark infringement. As a result of INTA’s efforts, the introduction of only seven new gTLDs was approved by ICANN, despite requests by others for hundreds. ICANN further required that any entity applying to operate one of the new gTLDs describe what measures it proposed for minimizing use of the TLD to carry out infringements or other abuses of intellectual property rights. In fact, the ICANN Board passed a resolution recommending that the President of ICANN consider the importance of appropriate protections of intellectual property rights in connection with the operation of each proposed TLD, especially during the start-up phases, in assessing which applications to accept.

INTA also worked closely with the successful applicants to develop “start-up” mechanisms to protect trademark owners’ rights in the new gTLDs. For example, in the case of .info, a pre-registration period for trademark owners known as the “Sunrise period” was developed. In the case of .biz, trademark owners could file an “intellectual property claim” whereby they could challenge any third party attempts to register their trademarks as domain names. Trademark owners were also provided a mechanism similar to the UDRP in which they could challenge a third party’s wrongful use of the .info Sunrise period or .biz

11. See http://arbiter.wipo.int/domains/cctld/index.html for a list of such countries.
13. Id.
15. See http://www.icann.org/tlds/agreements/biz/registry-agmt-appj-11may01.htm. For general information on .biz, see http://www.neulevel.biz/.
Intellectual Property Claim procedure. In the case of the other five “chartered” gTLDs, dispute resolution procedures similar to the UDRP were developed whereby trademark owners can challenge a third party’s violation of the respective charter.

The addition of new gTLDs was accepted by ICANN as part of a “proof of concept.” As a result, ICANN formed a task force of only ten members to monitor and evaluate their implementation with a view toward developing the best procedures possible for possible future introductions. INTA is again represented on this small task force through its Government Relations Manager, Michael Heltzer, to ensure that proper protections are put in place for trademark owners.

The accuracy and availability of WhoIs data is of course critical to trademark owners in their enforcement efforts against cyber pirates. Early on, INTA urged the World Intellectual Property Organization (WIPO) to lend its expertise to ICANN to study and comment on technical means for improvement of the WhoIs database, and to develop a set of best practices for those operating WhoIs databases. Since then, INTA has worked closely with the IPC in trying to establish a fully searchable, open and freely available WhoIs database that works across a variety of platforms despite the growing the number of registration authorities inputting data into such databases.

Likewise, an incorrect deletion of a domain name, one of a trademark owner’s key assets, can be devastating. In recent months, ICANN began experiencing a rising tide of problems and complaints relating to the mistaken, inadvertent or fraudulent deletion of domain-name registrations. As a result, ICANN proposed a “Redemption Grace Period” during which a domain name registrant, registrar, and/or registry could detect and correct any such deletions. INTA supported this proposal as a member of the IPC. The IPC’s comments were the only “Constituency”

16. For .info’s dispute resolution mechanism, see http://www.icann.org/tlds/agreements/biz/. For .biz, see http://www.neulevel.biz/stop_overview/index.html.
18. For information on the New TLD Evaluation Process Planning Task Force, see http://www.icann.org/committees/ntepptf/.
19. A copy of its Interim Report can be found at http://www.icann.org/committees/ntepptf/interim-report-03dec01.htm.
21. A copy of an early paper submitted by the IPC to ICANN outlining the problems with the existing Whols and its importance to intellectual property owners can be found at http://ipc.songbird.com/whois_paper.html.
comments cited by ICANN in the report it posted for public consideration in preparation for last spring’s meeting in Accra.\(^{23}\) As a result of the comments, ICANN agreed to move forward with the Redemption Grace Period and has convened a technical steering group that is currently in the process of developing a concrete proposal for its implementation.\(^{24}\)

Most recently, INTA is actively participating in ICANN’s reform initiative.\(^{25}\) INTA’s initial participation focused on trying to prevent the narrowing of ICANN’s mission to eliminate its policy-making authority and thus, a trademark owner’s ability to voice its concerns regarding the functioning of the DNS. INTA has since been providing ICANN with its comments both in writing and at ICANN’s June, 2002, meeting in Bucharest on the various papers posted by ICANN relating to ICANN’s structure and the policy development process. With respect to the latter, ICANN requested the assistance of a small group of eight individuals to formulate a new process for names policy development. I had the privilege of representing INTA as one of the members of this group to insure that the voice of trademark owners continues to be heard.\(^{26}\)

Without the UDRP or the new gTLD start-up measures, trademark infringement on the Internet would be rampant. Without a robust WhoIs, a trademark owner’s enforcement efforts would be thwarted. Without a proper safety net to prevent the mistaken, inadvertent or fraudulent deletion of domain names, one of a trademark owner’s key assets could be forever lost. It is thus clear that INTA’s involvement with ICANN to date has been critical to trademark owners. Given the ever-changing nature of the Internet, however, INTA’s work is far from over. WIPO recently identified four potential areas of expansion of the UDRP, which were not considered or even contemplated at the time the UDRP was developed.\(^{27}\) At some point in the future, it is hoped that the ccTLDs will be brought under the rubric of a reformed ICANN. While internationalized domain names (IDNs) are being contemplated, they have yet to be broadly introduced. All of these areas have implications for trademark owners and as in the past, INTA will continue to represent trademark owners every step of the way to insure their interests are properly protected.

\(^{23}\) See http://www.icann.org/accra/redemption-topic.htm.

\(^{24}\) See http://www.icann.org/minutes/prelim-report-28jun02.htm.

\(^{25}\) This initiative calling for constructive changes in ICANN’s structure and processes to improve its effectiveness is laid out in “President’s Report: ICANN—The Case for Reform,” February 24, 2002, which can be found at http://www.icann.org/general/lynn-reform-proposal-24feb02.htm.

\(^{26}\) A copy of the group’s recommendations can be found at http://www.icann.org/committees/evol-reform/npdpag-report-21aug02.htm.

\(^{27}\) See http://wipo2.wipo.int/process2/.