During your time at INTA, how have you seen the internet develop as both a challenge and an opportunity for the association’s members?

Over the last quarter century, the internet has evolved from a government-funded research project, to a private network of academics, to a public platform of global commerce and communication. This new technology has helped spur a Digital Revolution, similar to the Industrial Revolution of prior centuries. The Internet has revolutionised commerce and communication by fostering innovation and changing the way trademark owners communicate with their consumers and fans. The internet enables the public to more efficiently research, communicate, and purchase products and services from all regions of the world.

While the internet has created significant opportunities for businesses to connect with their consumers, they utilise this new market in one way that remains unchanged from the days when all sales were made through brick-and-mortar stores—to develop goodwill and reputation in their brands. These ‘online conversations’ create new opportunities for organisations to establish their online identities and reputations, increase sales, productivity and donations, while lowering transactional and overhead costs. For example, the internet marketplace has undergone tremendous growth through social media platforms and online applications, which some have espoused as facilitating more direct, and effective interaction between brands and consumers. To better leverage this new environment, companies are adopting a more unified approach, integrating departments that have been traditionally independent, such as marketing, information technology, public relations, and legal, to better manage their digital brand assets.

A study from the Boston Consulting Group in March 2012 had some interesting statistics that are relevant to this discussion. The study examined how the internet has grown in many countries over the past several years and this growth is expected to continue, especially among the G-20 countries. In addition, SMEs that rely on...
the web have experienced revenue growth that was more than 20 percent higher than SMEs with little to no use of the web over the last three years. The study further noted “if it were a national economy, the ‘internet economy’ would rank in the world’s top five”, of all nations worldwide.

As an international IP organisation, INTA’s focus remains on ensuring that trademarks receive the same protection on the Internet as they receive in the offline world. Nefarious actors use the Internet to perpetrate crimes and defraud consumers at an increasingly alarming rate. Despite the coordinated efforts of law enforcement, trademark owners and their representatives, cyber-criminals are successfully harnessing the anonymity and global reach of the Internet to defraud and mishandle consumers by misappropriating the goodwill associated with well-known and famous brands.

These criminal practices include phishing, diverting internet users to fraudulent websites, compromising their computers to steal individual’s personal identifying information, and spreading viruses or ‘SPAM’ emails that are used to sell counterfeit goods. In addition, the ease, speed and low-cost of registering domain names and monetising web traffic have led to a proliferation of domain name cybersquatting and online counterfeiting. These fraudulent schemes not only threaten public health and safety, but reduce consumer trust and confidence in the Internet. As a result, brand owners are facing numerous challenges to ensure the integrity of their brands and the safety of their consumer’s online experience. INTA is working on many fronts to ensure that trademarks are protected on the Internet so users can have confidence in the products and services they acquire or use online.

How has INTA worked to ensure that its members’ rights are adequately protected in the domain name system?

During the last decade, INTA has served as a leading voice for trademark owners in the development of cyberspace, including as a founding member of the Internet Corporation for Assigned Names and Numbers’s (ICANN’s) Intellectual Property Constituency (IPC). INTA works actively within the ICANN ‘multi-stakeholder model’ to ensure that IP can be adequately protected in the domain name system, by promoting policies that acknowledge that the assignment of domain names (and use of domain names) without sufficient regard to the rights of trademark owners can result in the infringement of trademarks and consumer confusion.

In light of ICANN’s plan to drastically expand the domain name system, INTA has advocated for the development of robust rights protection mechanisms, including new administrative enforcement procedures, and other tools, such as the Trademark Clearinghouse (TMCH) database, which are intended to reduce costs and burdens on rights holders.

At the national level, INTA urges the development of appropriate national legislative, regulatory, administrative, or international mechanisms, including treaties and trade agreements, to combat Internet cybersquatting. INTA recommends that these regulations have, at a minimum, provisions that prohibit and provide sanctions against cybersquatting, and provide clear remedies for trademark holders, such as the availability of injunctive and other appropriate relief.

Moreover, INTA continues to advocate for open access to accurate ownership information via a publicly accessible Whois database for addressing legal and other issues relating to the registration and use of domain names. INTA believes the available information should include the identity of and contact details for the true owner of the domain name, so the identity of the infringer can be discovered in a timely manner.

Do brands think more can be done to relieve the burden of policing?

From a public policy perspective, the context in which monitoring for trademark infringement occurs is relevant with regard to what can be done to relieve the cost burdens. For example, in the domain name system context, trademark owners have expressed the need for measures that can relieve some of the burdens associated with monitoring from trademark infringement across potentially hundreds of new gTLDs.

INTA successfully advocated for the establishment of a TMCH database. This should help relieve some of the costs carried by trademark owners to monitor for infringements, at least in the new gTLDs. Thanks to recent INTA advocacy efforts, the claims service will now cover up to 50 variations of the brand owner’s trademark (i.e., domains the brand owner recovered through the Uniform Domain-Name Dispute-Resolution Policy) and will now extend to the first 90 days after the launch of each new gTLD registry.

What is INTA’s position on new gTLDs—will they add to this burden?

The introduction of the new gTLDs represents one of the biggest changes to the Internet’s domain name system since its formation. INTA supports the expansion of the Internet as a marketplace for electronic commerce, and the use of Internet websites for the advertising and sale of goods and services, consistent with principles that protect IP and consumers. In representing the views of trademark owners, INTA’s interest centres on ensuring the adequate protection of trademarks and, concurrently, building consumer trust in this growing internet environment.

New business models are appearing on the internet all the time—what help does INTA give them with handling trademarks?

The policy development and advocacy group of INTA is divided into committees that are composed of trademark owners and those that provide legal and other services regarding trademarks. The internet committee has specific jurisdiction to monitor and address trademark issues on the internet. INTA understands the importance of industry collaboration and cooperation in addressing intellectual property infringement problems presented by the internet.

Whether companies provide services through search engines, auction platforms or marketplace websites, INTA has partnered with industry from all sectors to develop recommended policies and guidelines for addressing trademark abuse. For example, several years ago INTA worked closely with several prominent Internet companies in developing a trademark complaint form as an industry best practice—similar to the forms that operate for copyright infringement—to report websites selling counterfeit goods that appear in search results.

With regard to social media and other ‘Web 2.0’ companies, the Internet committee has reviewed the policies of various companies and has published them on the INTA website so they are visible and easily accessible to enable trademark owners to enforce their rights. We also provide guidance and recommended trademark protection guidelines to companies that are in process of developing their own policies as they enter the competitive internet marketplace.

In addition to affecting the policy aspects of trademarks on the internet, INTA over the years has provided significant educational programmes, training and webinars to help its members better understand and deal with the issues on a daily basis. This year’s annual meeting programme offers several panel sessions which should be of great interest to any brand owner whose trademarks are or will be out there in the brave new world of cyberspace.