



## Intellectual Property Watch

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### **ICANN IP Advisory Group: Whois, Dot-Brands, Contracts Key Sticking Points In New Domains**

By Liza Porteus Viana for Intellectual Property Watch on 11/05/2012  
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Washington, DC – Wary eyes are on the Internet Corporation for Assigned Names and Numbers (ICANN), which on 12 January opened a first window for applications for new generic top level domains (gTLDs), expected to be made public later this month.

ICANN, the internet domain name system technical oversight body, has come under fire from trademark groups for trying to open up the internet's real estate. ICANN says expanding the number of generic top-level domains (gTLDs, such as .com) will increase competition among private registry service providers, but many trademark owners think the move could result in a loss of ability for them to protect their intellectual property – many critically refer to the new gTLD process as "dot-anything" – and they want to ensure the strings of characters in domain names contain as few trademarked names as possible.

Developing countries have also been critical of the lack of outreach in their part of the world on the new gTLD process and on ICANN processes, in general.

Brands such as Yahoo! Inc. are particularly concerned that the new gTLD system won't do enough to protect against cyber squatters and domain-name registrars grabbing up dot-brand names. Many applications are expected to come from brand owners who want control of their whole domain name – such as Japan-based electronics company Canon did when it applied for the .canon gTLD.

Companies need to better identify people from their firms to participate in the gTLD process and not just send technical people to the meetings, J. Scott Evans, former president of the ICANN Intellectual Property Constituency (IPC) and head of Global Brand Domains & Copyright at Yahoo! said this week. "That's a huge mistake – you've got to send policy people. You've got to have a coordinated message. That's how China, Brazil, South Africa are doing it, because they're concerned with the 'Arab Spring'" and regime changes in the Middle East may affect the process.

"We are at a critical juncture," he added. "This could ruin our businesses, some of the ideas they're coming up with."

### Getting the 'Right People' to the Table

The IPC is one of the six constituencies of the Generic Names Supporting Organization (GNSO) charged with the responsibility of advising the ICANN board on policy issues relating to the management of the domain name system. The IPC met in Washington this week during the International Trademark Association (INTA) annual conference to discuss the gTLD process with stakeholders and trademark experts.

Brian Wilterfeldt, the IPC representative to the GNSO council, said big changes are coming at ICANN, particularly for those applying for dot-brand names, and that the IPC is working with ICANN to stave off any problems that may arise.

Winterfeldt, who is also partner at the Washington office of Steptoe & Johnson LLP, also said there likely will be negotiations over how, exactly, registry agreement contracts will be handled. ICANN wants to follow the process outlined in the Applicant Guidebook for New gTLDs, Winterfeldt said, but "my guess is, there's going to be some issues there."

The IPC has put together a list of "top asks" from large and small companies regarding the agreements, and has circulated it among a small group of stakeholder groups for feedback.

The IPC also wants to ensure continued public access to the Whois database, which provides data on registered domain names, including contact information for registered name holders. A Whois policy review team has been convened and its report of recommendations to ICANN was due on 30 April. Steve Metalitz, IPC president and partner at Washington law firm Mitchell Silberberg & Knupp LLP, said it should be released soon. The ICANN board is required to act within six months of that release.

The Whois report, Metalitz said, likely will include an obligation by ICANN to prioritize reducing Whois inaccuracies by 50 percent each year, along with other suggestions for improving the system, and creation of a more effective Whois policy. The IPC is also working to ensure ICANN updates Whois system. For example, there currently is no standardised way for dealing with registrant content data other than what is in Latin-based characters, he said; the new gTLDs could include non-Latin, and non-English scripts.

“As we get more gTLDs that are using internationalized domain names” and get more domain name registrants from countries that don’t use the English alphabet, Metalitz said, “this is going to be an increasing problem.”

“We need to get some of the right people at that table who understand why public access to Whois is so critical to trademark owners, copyright holders, to the general public, to law enforcement – really to the whole public interest,” Metalitz added.

#### Lack of Complaint-Tracking Called ‘Criminal’

ICANN had previously set the deadline for new gTLD applications at 12 April, but a technical glitch in its TAS application system caused that date to be extended.

ICANN this week said it now anticipates 22 May to be the intended reopening date for TAS, and 30 May will be the cut-off date for registration applications.

TAS had 2,091 applications either submitted or in progress when it was taken offline 12 April. In addition, there are 214 more potential applications that were registered prior, but whose payments had not been fulfilled. ICANN said it has received about \$350 million in fees for applications for new gTLDs.

But other technical systems also plague the gTLD system. Association for Competitive Technology President Jonathan Zuck, who has been working on several issues with ICANN on behalf of the IPC, said ICANN has been making short-term changes to systems and interfaces currently in place to make the process of tracking gTLD complaints more “user-friendly.” As of now, the system doesn’t track anything past the initial complaint; no more data has been collected over the past 10 years on this front.

“It’s criminal that none of that information was available,” Zuck said.

Suzanne Radell, senior policy advisor to the National Telecommunications & Information Administration (NTIA) at the US Department of Commerce and the US representative to the ICANN's Governmental Advisory Committee (GAC), told gTLD stakeholders that "the level of interest on these issues around the GAC table is exceedingly high.... There's shared support for ICANN to do the right thing."

It is expected that the GAC will analyse all applications – and applicants – and issue early warnings on what gTLD strings may cause problems within 60 days. But that timeframe is proving to be very optimistic. Not only are there so many applications, Radell said, but many governments want to give all of their agencies time to weigh in on applications for names like .bank. Plus, some states and cities in the US have expressed interest in obtaining domain names like .nyc or .miami.

"There have been some states and state secretaries expressing concerns about certain possible strings. So we know the interest is there," she said. "Other governments are encountering the same challenges."

Plus, all of the anticipated objections to applications for certain domain names need to be dealt with. On top of that, many of Europe's government workers – those who haven't been laid off amid budget crises – go on vacation in the summer, leaving even fewer people to weigh in on the applications.

"There's a strong concern among GAC members while, we certainly wish to be kept informed and aware of the concerns that rights holders have, it's not entirely clear to us there's going to be the resources available in each capital to deal with those objections."

Whether or not the GAC can sustain a rolling 60-day review for these applications will be a top question to deal with 24-29 June, when ICANN meets in Prague.

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[1] WIPO Offers Dispute Services For Objections To New TLDs At ICANN: **<http://www.ip-watch.org/2012/02/13/wipo-offers-dispute-services-for-objections-to-new-tlds-at-icann/>**

[2] ICANN Board Approval Opens Internet To Many New Domains: **<http://www.ip-watch.org/2011/06/20/icann-board-approves-long-awaited-plan-for-new-internet-domains/>**

[3] UN, IMF, WTO, Other Organizations Raise Concern About New Domains: **<http://www.ip-watch.org/2011/12/14/un-imf-other-organizations-raise-concern-about-new-domains/>**