

Presenting a live 90-minute webinar with interactive Q&A

WHOIS and Enforcement: Data Accuracy Concerns, Natural/Legal Person, NIS₂, SSAD, and Current Views on GDPR

Opportunities and Risks of UDRP, ACPA, PDDRP, Sunrise and Trademark Claims Services

TUESDAY, JUNE 1, 2021

1pm Eastern | 12pm Central | 11am Mountain | 10am Pacific

Today's faculty features:

Paul D. McGrady, Jr., Partner, **Taft Stettinius & Hollister**, Chicago
Brian J. King, Head of Policy and Advocacy, **Clarivate**, Washington, D.C.
Susan Payne, Head of Legal Policy, **Com Laude**, London, United Kingdom

The audio portion of the conference may be accessed via the telephone or by using your computer's speakers. Please refer to the instructions emailed to registrants for additional information. If you have any questions, please contact **Customer Service at 1-800-926-7926 ext. 1.**

Tips for Optimal Quality

FOR LIVE EVENT ONLY

Sound Quality

If you are listening via your computer speakers, please note that the quality of your sound will vary depending on the speed and quality of your internet connection.

If the sound quality is not satisfactory, you may listen via the phone: dial **1-877-447-0294** and enter your **Conference ID and PIN** when prompted. Otherwise, please **send us a chat** or e-mail sound@straffordpub.com immediately so we can address the problem.

If you dialed in and have any difficulties during the call, press *0 for assistance.

Viewing Quality

To maximize your screen, press the 'Full Screen' symbol located on the bottom right of the slides. To exit full screen, press the Esc button.

Continuing Education Credits

FOR LIVE EVENT ONLY

In order for us to process your continuing education credit, you must confirm your participation in this webinar by completing and submitting the Attendance Affirmation/Evaluation after the webinar.

A link to the Attendance Affirmation/Evaluation will be in the thank you email that you will receive immediately following the program.

For additional information about continuing education, call us at 1-800-926-7926 ext. 2.

If you have not printed the conference materials for this program, please complete the following steps:

- Click on the link to the PDF of the slides for today's program, which is located to the right of the slides, just above the Q&A box.
- The PDF will open a separate tab/window. Print the slides by clicking on the printer icon.

ICANN Developments

Current status of EPDP on GDPR and Intervening Issues:

- Data accuracy concerns
- Differentiation between natural legal entity registrants
- NIS2
- SSAD

Rights Protection Mechanisms and Impact of GDPR

Effects of GDPR on:

- UDRP: Uniform Domain Name Dispute Resolution Procedure
- URS: Uniform Rapid Suspension
- ACPA: Anticybersquatting Consumer Protection Act
- TMCH: Trademark Clearinghouse
- PDDRP: Trademark Post Delegation Dispute Resolution Procedure

Some recent decisions

Avoiding Pitfalls

Which RPM to use

UDRP: overview of key elements

UDRP applies to legacy gTLDs, new gTLDs, many ccTLDs

Grounds for UDRP:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights
2. The registrant has no rights or legitimate interest in the domain name, and
3. The domain name has been registered and is being used in bad faith

Complainant to prove each element

UDRP: substantive challenges due to reduced WHOIS

Impacts

- Claimant's ability to establish elements 2 and 3
- Knowledge of potential defences which would influence decision to bring claim
- WHOIS history: date of registration by current registrant
- Complaints against multiple domains of same owner

UDRP: no Rights or Legitimate Interest; Bad Faith

Rights/legitimate interest include:

- Registrant commonly known by the domain name

Evidence of no rights/legitimate interest include:

- Domain name registered primarily to disrupt business of a competitor
- Registrant's pattern of bad faith/abusive registrations

UDRP: other procedural difficulties from a reduced WHOIS

- Service of Complaint by Provider (Rule 2) - potential delay whilst obtaining information from Rr and for Complaint to be updated
- Complainant's provision of registrant name and contact information to Provider (Rule 3(v))
- Certification from the Complainant of completeness and accuracy, and that assertions are warranted

Rights Protection Mechanisms

Effects of GDPR on the URS

- Increased challenge due to word count restrictions
- “Clear cut cases” may now be less-so
- Inability to know registrant identity makes the UDRP/URS decision more difficult

Rights Protection Mechanisms

ACPA

- How has ACPA practice been impacted by GDPR-responsive WHOIS redaction and unavailability?
- Is data needed for litigation still available?
- Is ACPA litigation more time-consuming and/or more expensive now?

Rights Protection Mechanisms

Trademark Clearinghouse (TMCH)

- Is there a right to privacy in the data brand owners submit to TMCH?
- Is there a right to privacy in the identity of the person/entity who attempts to register, triggering a claims notice?
 - Important for next round
 - Still on the horizon: .music, .web

Rights Protection Mechanisms

Post-Delegation Dispute Resolution Proceeding (PDDRP)

- How will the GDPR affect making out claims under the PDDRP?
- Does accurate and accessible WHOIS affect making out a claim?
- Is there a discovery method in these proceedings to get that information from the contracted party on the other side?

Rights Protection Mechanisms

Recent decisions

- Steven Madden, Ltd. v. Domain Administrator, Privacyguardian.org, Jonas Weber, Gottschalk Ursula, Christina Kappel, Whoisprotection.cc, Domain Admin, Engel Ralph. 6 domain names involved across 4 registrars and 7 “registrants.”
- Dareos LTD., and Dareos INC. v. Pavel Balabanov, Vladimir Luchaninov, Isys, Oleksandr Zakharov, Irina Zayats, Evgeniy Lavryonov, Sergey Adamenko, Domain Admin, Whois Privacy Corp., Super Privacy Service LTD c/o Dynadot. 39 domain names involved across 4 registrants and 9 “registrants.”
- Gucci
 - How many different data points are needed to tie domains together?

Avoiding Pitfalls

What are the pitfalls?

- Too narrow UDRPs/URS

- Wasting time threatening registrars

- Leaving options on the table

- Treating foreign registrants the same way you treat U.S. based registrants

How to avoid them

Which RPM to use?

- Which ICANN or legislative method is best?
- Are there models from outside the US (e.g. Nominet) that might work better?
- Should we be looking at those in Phase 2 of the RPM Working Group/PDP?

Contact Information

Paul D. McGrady

pmcgrady@taftlaw.com

Brian J. King

brian.king@markmonitor.com

Susan Payne

susan.payne@valideus.com