What has ICANN done to make the internet a safe place for trademark owners and users?

By: Jonathan Cohen
TMDN, Inc.
Aventum LLP (Consultant)
Before ICANN

- 1998 ....The IHAC Kidnap attempt by WIPO
- The positive result
- The Green Paper
- The White Paper
- ICANN is born
ICANN ..The Early Years

March 4, 1999 ICANN Singapore meeting: The GNSO (DNSO) is Born
- 1999 JCC founds the IPC (intellectual property Constituency) with the support of John Orange and FICPI
- May 25, 1999 ICANN Meeting in Berlin. The IPC is presented by JCC to, and approved by, the Board of ICANN
- The First Working Group (WG) of ICANN is created. UDRP under the Chairmanship of JCC
- August 1999 ICANN meeting in Santiago, Chile. Following weeks of review of, and negotiations concerning, and amendments to, the WIPO Draft UDRP the Chair of the UDRP WG presents a final Draft to the ICANN Board for approval.
- The UDRP is approved.
- Public Comments are received and reviewed in the Fall of 1999.
- All Registrars are bound by agreement with ICANN to follow UDRP
- UDRP becomes operational early December 1999.
- First UDRP decision is rendered in mid January 2000.
WHOIS

- WHOIS allows a search for the details of the owner of a Domain name.
- Its roots go back to the IETF in 1982
- ICANN requires Registrars to maintain WHOIS records for all its Domain names and make those records available to the public.
- IP lawyers are able to quickly discover the name and address of cyber “criminals” for purposes of UDRP or Court Action
NEW gTLDs

- In 1999 WG C was established to decide if new gTLDs should be introduced into the ROOT.
- In June 2008 The Board adopted the GNSOs recommendation to introduce new gTLDs.
- ICANN Staff is instructed to develop a plan to expand the number of gTLDs.
- March 6, 2009 The IRT is approved by the Board at the request of the IPC.
- In 90 days the IRT, comprised of international IP experts, develops a comprehensive number of RPMs (Rights Protection Mechanisms) to be adopted and followed by new gTLDs.
- After much discussion, debate and commentary the RPMs are approved and made part of the Agreement between ICANN and new gTLD owners INCLUDING IDNs.
- Among the RPMs are a Trademark Clearing House; Thick WHOIS; Uniform Rapid Suspension System (URS).
GDPR

- 2016: The EU introduces strict privacy laws which affect Internet operations under its jurisdiction.
- Under GDPR rules the WHOIS comes under threat
- ICANN loses court challenges in Germany to the GDPR
- ICANN establishes a WG to come up with a position on WHOIS to present to the EU whereby IP practitioners may have access to WHOIS information under GDPR regulations.
- The First stage of the work of the WG is completed including a comprehensive survey about the experience of users of WHOIS including questions about PHISHING and Malware.
- Stage 2 begins
New gTLDs 2

- ICANN announces it is preparing to open up a second round of new gTLDs
- The IPC will now consider what if any new requirements from a Trademark perspective should be considered for the second round of new gTLDs