



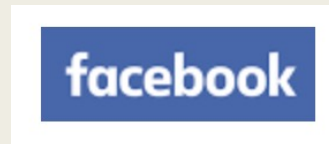
GDPR AS A TECHNOLOGY: POLICY IMPLICATIONS

*Intellectual Property Implications for Further
GDPR Policy Work within ICANN*

Intellectual Property and Domain Names: *Trademarks*

What is a trademark?

- Recognizable sign, design, or expression which identifies products or services of a particular source
- May say something about the quality of the product
- Serves a commercial function



Acquiring and Enforcing a Trademark

- **Acquired by use:** used (such as a brand name or in advertising) in relation to certain goods or services to such an extent that it is recognised as distinguishing the goods and services of the business using that mark from those of other businesses.
- Enforceable under common law, including consumer law – misleading and deceptive conduct
- **Registration:** Generally can be registered under national law. Elements generally include **use** of mark, **distinguish** goods and services, in **course of trade**, - a connection between the relevant goods or services and the mark
- Enforceable in Court under trade mark law and generally recognized under international conventions

Is a Domain Name a Trademark?

- Not necessarily – but it can be used as such. That is, if it is used in the course of trade to distinguish from other products.
- Cybersquatting

(NB – a trademark becomes your property, whether or not it is registered; a domain name is only licensed to your use)

The Issue: Enforceability post GDPR

- *IF you can establish that your domain name has been used as a Trademark, then how can you obtain contact details for the alleged offender under either trademark law, common law (passing off) or consumer law (misleading and deceptive conduct) in a post GDPR world.*

Access to Contact Information?

To take any action against the individual(s)/company that has misappropriated abused 'your' domain name, you need contact details – the WHOIS information

1. Where is the information and what are the rules for access
2. Are you eligible for access
3. Can access be refused
4. Can you appeal

*Final Report of the Temporary Specification for gTLD Registration Data
Phase 2 Expedited Policy Development Process*

Where is the information and what are the rules for access

Now:

Registrars and registries with thick WHOIS

In the future:

Held by Registries – with thick WHOIS

Are you eligible for access

(assuming the data is held by the Registry – with access through the Central Gateway Manager)

Is the complainant an accredited organization or individual – both legal and natural persons are eligible

Make a legal request with the legal basis for the request. (among specific requestors – an example is for trademark ownership/registration) (Para 1.4.2)

Under Implementation – additional information can include ‘information asserting trademark ownership’ (para 1.8.2)

The request for purpose can include ‘intellectual property infringement’ and ‘consumer protection’. (para 7.1)

Can access be refused/Can you appeal

- The Central Gateway Manager MAY recommend disclosure (or not)
- The Contracted Party MAY follow the Central Gateway Manager's recommendation, but if they do not, they must give reasons for refusal
- ICANN Org is to handle complaints about access refusal (paras 5.1 and 5.2)
- Absent any legal requirements, disclosure cannot be refused solely for lack of any of the following: (i) a court order; (ii) a subpoena; (iii) a pending civil action; or (iv) a UDRP or URS proceeding; nor can refusal to disclose be solely based on the fact that the request is founded on alleged intellectual property infringement. (Para 8.5)

QUESTIONS?

THANK YOU