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Crash Goes ICANN's Multistakeholder Model

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A PERSONAL INTRODUCTION

In 1995, the Internet was becoming a global phenomenon and users needed “domain names”—the street signs of Internet addresses—for an array of commercial and noncommercial speech.² ³ A small community of “multistakeholders”—business, civil society, governments, technologists, intellectual property and non-government organization representations—began to write rules for Internet addresses largely on behalf of a global population that had yet to be connected to the Internet. I had the privilege of being part of that group. Since then, Internet use has skyrocketed from 70 million users (1.7% of the world population) in 1995 to over 4.5 billion users (58.8% of the world population) today.⁴ Stunningly, today’s Internet features over 250 million domain names⁵ and 1.5 billion websites.⁶

The Internet had a modest birth. An advanced research division within the US Army created a small “network of networks”⁷ and later transferred oversight to the National Science Foundation (“NSF”), which connected colleges and universities in the early 1980s.⁸ The National Science Foundation Network (“NSFNET”) “carried, at no cost to the institutions,” any U.S. research and education traffic that could reach it,⁹ but NSF rules barred public access and commercial traffic.¹⁰ In 1991, the High Performance Computing Act required that NSFNET, formerly limited to academia, government, and military, be opened to the private sector and commercial access and traffic.¹¹ With the passage of this legislation, the modern Internet was born.

NSF quickly found itself caught between trademark owners and domain name registrants on the early Internet, especially when large businesses gradually came online and sometimes found domain names of what they considered to be

² Following the tradition of Professor Michael Froomkin of the University of Miami School of Law, in *Wrong Turn in Cyberspace: Using ICANN to Route around the APA and the Constitution*, 50 *DUKE L.J.* 186 (2000), I will share that “[r]eaders have a right to know that I participated in activities that touch on the subject of this Article.” I am part of the group that founded the Internet Corporation for Assigned Names and Numbers (ICANN) and a co-founder of one its founding multistakeholder groups, the Noncommercial Users Constituency. As a veteran of many ICANN committees and task forces, I also served on the Final Drafting Team of the Uniform Dispute Resolution Policy (UDRP) of ICANN and currently serve as Co-Chair of The Review of All Rights Protection Mechanisms Policy Development Process Working Group.

³ Hearing on Electronic Commerce: The Future of the Domain Name System Before H. Subcomm. on Telecomm., Trade, and Consumer Prot., 102nd Cong. (1992) (statement of Kathryn A. Kleiman, General Counsel, A-TCPIP/Domain Name Rights Coalition), Summary.

⁴ INTERNET WORLD STATS, *Internet Growth Statistics 1995 to 2019—the Global Village Online* (2019), <https://www.internetworldstats.com/emarketing.htm>.

⁵ VERISIGN, THE DOMAIN NAME INDUSTRY BRIEF 2 (2019), <https://www.verisign.com/assets/domain-name-report-Q32019.pdf>.

⁶ INTERNET LIVE STATS., *Total Number of Websites* (2018), <https://www.internetlivestats.com/total-number-of-websites/>.

⁷ Barry M. Leiner, Vinton G. Cerf, David D. Clark, Robert E. Kahn, Leonard Kleinrock, Daniel C. Lynch, Jon Postel, Larry G. Roberts, Stephen Wolff., Brief History of the Internet 3-4 (1997).

⁸ *Id.* at 10.

⁹ Fact Sheet: A Brief History of NSF and the Internet, August 13, 2003, https://www.nsf.gov/news/news_summ.jsp?cntn_id=103050

¹⁰ A Brief History of the Internet, at 11.

¹¹ High Performance Computing Act of 1991, Pub. L. No. 102-194, 105 Stat. 1594 (1991) (codified at 15 U.S.C. § 5501).

“their brands” already registered to others.¹² These domain names ranged from well-known trademarks, e.g., americanairlines.com, to more common words and nicknames, e.g., pony.com and pokey.com.¹³

NSF’s government contractor, a then-small company named Network Solutions, Inc. (“NSI”), faced a problem. Hired to register domain names for NSF,¹⁴ NSI was caught between domain name registrants and trademark owners. NSI found no guidance and no protection from NSF and then NSI General Council Philip Sbarbaro characterized NSI’s situation as: “knee-deep” in “a wide-fast-running cold water creek between two mountainsides, one populated by the Hatfields and the other by the McCoys.”¹⁵ Behind closed doors with its private attorneys, NSI drafted and adopted the first “domain name dispute policy” which NSF published and implemented absent any public notice or comment as required by the Administrative Procedure Act.¹⁶

NSI’s domain name dispute rules protected trademark owners, but not domain name registrants by allowing trademark owners to challenge domain names with few defenses for registrants. If a challenger provided a federally registered trademark (from any country) in its complaint, the domain name registrant needed to produce another federally registered trademark to protect its domain name.¹⁷ NSI’s rules did not differentiate between coined and fanciful marks used in domain names (e.g., Xerox.com) and ordinary dictionary words and names and nicknames, e.g. pony.com and pokey.com.¹⁸ Further, NSI’s Domain Name Dispute Policy did not protect those using domain names for legitimate non-infringing commercial and noncommercial purposes:

It [NSI’s Domain Name Dispute Policy] allowed none of the traditional limits of exceptions of trademark law: no defense that the goods or services were in entirely different lines of commerce, no defense of parody, no defense of protected person and political use.¹⁹

In the mid-1990s, as a young attorney I represented a group of dynamic, young Internet Service Providers (ISPs) in the Internet Service Providers’ Consortium (ISP/C). The ISPs brought high-speed data connections to their suburbs and rural areas. They “wired” the schools, libraries, and senior centers of their communities and taught teachers, seniors, and librarians to navigate the Internet, many for the first time. While older companies moved online slowly, many of my

¹² Joshua Quittner, *Billions Registered*, WIRED (October 1, 1994), <https://www.wired.com/1994/10/mcdonalds/>.

¹³ Hearing on Electronic Commerce: The Future of the Domain Name System Before H. Subcomm. on Telecomm., Trade, and Consumer Prot., 102nd Cong. 4 (1992) (statement of Kathryn A. Kleiman, General Counsel, A-TCPIP/Domain Name Rights Coalition).

¹⁴ Milton L. Mueller, *Ruling the Root: Internet Governance and the Taming of Cyberspace* 2, 50 (2002).

¹⁵ Philip L. Sbarbaro, Esq., *Network Solutions’ “Domain Name Dispute Policy Present and Future* 1 (1997).

¹⁶ *Network Solutions’ Domain Name Dispute Policy, Rev. 01* (hereinafter “NSI’s Domain Name Dispute Policy”) (1995, <https://www.lectlaw.com/files/inp13.htm>).

¹⁷ NSI Domain Name Dispute Policy, § 6(c)(4).

¹⁸ Kleiman, *supra* note 3, at 5-6.

¹⁹ *Id.*

young ISP clients established their main presences online. Their websites presented their services, including the much-valued, new, private email addresses that they offered to individuals. At the time, it was hard for people outside of academia to obtain email addresses, and customers rushed to the new ISPs to obtain them. Their email addresses generally operated as part of the domain names of the ISP, e.g., *kathy@digex.com* and *kleiman@bigapple.com* (for early customers of ISPs Digex and Big Apple, respectively).²⁰

Some of my clients found their Internet presences threatened by NSI's new rules as they often chose domain names based on their company names, and sometimes found that some of these domain names overlapped with marks of other companies in different categories of goods and services. For example, while the young ISPs were often the first to use a dictionary term, a bird's name or a geographic phrase for an ISP, other companies might use the same word or phrase for accessories, taxis or even cartoon characters.²¹ As I and other lawyers found out, for our ISPs "[l]osing a domain name can mean going out of business."²² NSI's domain name dispute policy did not follow the ordinary, overlapping use of words in commerce: while in ordinary commerce, Delta Faucets, Delta Airlines, Delta Dental co-exist, on the Internet there is only one "delta.com" and it is attractive to the many companies with "delta" as a primary part of their names.

NSI's Domain Name Dispute policy allowed trademark owners to challenge domain name registrants with very limited opportunity for defense; as of November 23, 1995, if a trademark owner showed:

1. a "valid and subsisting registration of the trademark or service mark;" and
2. a date of first use prior to the "activation date of the Domain Name," then the domain name registrant must
 - a. "provide evidence of a trademark or service mark registration to NSI within thirty (30) days of NSI's request;" or
 - b. in most cases, lose the domain name.²³

NSI's policy created a clear problem for the infant Internet industry: challengers had trademarks, but many entrepreneurs did not, including the young ISPs. To make matters worse, the US Trademark Office had a large backlog of trademark applications, and processing a trademark application took, on average,

²⁰ See, e.g., Andrew Zaleski, *Doug Humphrey: Digex cofounder says 'the point of entrepreneurship is to build success'*, TECHNICALY.LY (Feb. 7, 2013) <https://technical.ly/baltimore/2013/02/07/doug-humphrey-digex/>.

²¹ CARL OPPERDAHL, ANALYSIS AND SUGGESTIONS REGARDING NSI DOMAIN NAME TRADEMARK DISPUTE POLICY (1966) (brief discussion of Roadrunner Computer Systems, a young ISP in New Mexico and using the name of its state bird, and challenged by Warner Brothers over trademark claims for the Looney Tunes character), <https://www.oppedahl.com/pubs/iip.htm>.

²² *Id.*

²³ NSI's Domain Name Dispute Policy, § 6(c)(1)-(3).

seventeen (17) months.²⁴ Yet, NSI's policy did not allow a pending federal trademark or established common law use to provide a possible defense.²⁵

Unlike the Lanham Act, which establishes an array of classifications for goods and services at the Patent and Trademark Office²⁶ and bars "use in commerce" of "any reproduction, counterfeit, copy or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising or any goods or services" if "*such use is likely to cause confusion or to cause mistake, or to deceive*,"²⁷ NSI's dispute rules checked only for a "character match" – a match of the letters and/or numbers in the domain name with the trademark. If upon review of a complaint, NSI determined that the trademark was "the same as the Domain Name" (and the trademark was older than the domain name),²⁸ then NSI would revoke the domain name from the registrant unless the registrant could "provide evidence of a trademark or service registration to NSI within thirty (30) days of NSI's request."²⁹ (Delta Faucets and Delta Airlines, both trademark owners, could find another forum to debate the domain name, as NSI would not act on a complaint over delta.com by one against the other.)

For young businesses without trademarks, NSI's policy required no proof of confusion or intent to deceive.³⁰ NSI's policy further provided no defenses for personal, political and other noncommercial uses of domain names, notwithstanding their high protection under laws of the US and around the world.³¹ Accordingly, NSI's rules lacked the traditional balances and protections of the Lanham Act that protect non-infringing, overlapping uses, including those of entrepreneurs and small businesses — and many entrepreneurs and small businesses stood to lose their domain names and growing Internet presences.

It made no sense to me that the new dispute rules allowed—intentionally or inadvertently—the destruction of entrepreneurs and small businesses online; new industries are the lifeblood of growing economies. Further, it seemed clear Internet policies must reflect the balances of the existing laws that protect emerging entities. Together with a few Internet entrepreneurs, we formed a small group called the Domain Name Rights Coalition and dedicated our time to seeking a replacement for NSI's domain name dispute policy with more fair and balanced rules.

The timing was auspicious as dramatic changes to governance of the Internet were underway. In the mid-1990s, the US Department of Commerce ("DOC") undertook oversight of the Internet's domain name system, and then transferred it to a private, nonprofit US company with an international board of directors. The company to manage and oversee domain names and IP addresses. At the time, we hoped the new organization rapidly would create fairer and balanced rules for domain name disputes. The new organization, the Internet Corporation for Assigned Names and Numbers (ICANN), has operated for the last 20 years as an

²⁴ USPTO, A PATENT AND TRADEMARK OFFICE REVIEW, FISCAL YEAR 1997 13 (table describing the time period to register), <https://www.uspto.gov/sites/default/files/about/stratplan/ar/1997annualreport.pdf>.

²⁵ NSI's Domain Name Dispute Policy, § 6(c)(3)-(4).

²⁶ 15 U.S.C. § 1112.

²⁷ 15 U.S.C. § 1114(1)(a) (emphasis added).

²⁸ NSI's Domain Name Dispute Policy, § 6(c)(1).

²⁹ NSI's Domain Name Dispute Policy, § 6(c)(4).

³⁰ See generally David. S. Welkowitz, Article: The Problem of Concurrent Use of Trademarks: An Old/New Proposal, 28 U. RICH. L. REV. 315, 342 (1994).

³¹ Kleiman, *supra* note 3, at 5.

experiment in private technical and community management of the domain name system. While not perfect, ICANN's policies have aimed to include transparency, accountability, diverse representation and policymaking and balance the needs of diverse Internet uses, including trademark owners, entrepreneurs, registrants, noncommercial organizations, individuals, and companies that provide registration services. Commercial and noncommercial speech online has flourished.

Now, as we enter 2020, however, ICANN, like Network Solutions before it, is turning to private attorneys and going behind closed doors to make policy. As discussed below, ICANN's new and privately-negotiated rules and contracts show a clear movement back to the "old days" of NSI's domain name dispute policy and arbitrary rules for domain name suspension and revocation which once again threaten the online presences of business and organizations.

This paper further discusses:

- How the global domain name system came to be run by ICANN with experimental principles of private "bottom-up, multistakeholder governance;"
- How a young ICANN quickly adopted rules for domain name disputes, and other domain name policies, in a fairly open, transparent, and innovative form of private governance for over 20 years; and
- How, after 20 years, ICANN is turning its back on the private multistakeholder model of governance and finding privately negotiated rules and policies to be easier and more efficient. The implications threaten the Internet presences of companies, organizations and individuals around the world and pose a threat to the Internet and the commercial and noncommercial speakers who rely on it.

I. A Brief History of The Internet And Global Domain Name System

The history of the Internet is fairly well known. In the 1960s, an advanced research branch of the US Army, the Defense Advanced Research Projects Agency ("DARPA"), undertook an experiment in decentralized networking: whether independently and separately designed networks could work together without centralized control.³² The experiment worked, and in 1986, the NSF joined DARPA in funding the management and growth of the Internet infrastructure.³³ The growing Internet served the "university research community [and] promoted the academic tradition of open publication of ideas and results."³⁴ Unlike the local phone system of the time, the Internet was not metered with per-minute long-distance charges;³⁵ data packets of NSFNET moved rapidly among universities in the US and around

³² Leiner et al., *supra* note 7, at 5.

³³ Leiner et al., *supra* note 6, at 10-11.

³⁴ Leiner et al., *supra* note 6, at 12.

³⁵ See generally Tracy Waldon & James Lande, The Industry Analysis Division's Reference Book of Rates Price Indices and Household Expenditures for Telephone Service (1997), https://transition.fcc.gov/Bureaus/Common_Carrier/Reports/FCC-State_Link/IAD/ref97.pdf.

on an Internet “Backbone” supported by NSF.³⁶ Use of the Internet was limited to “Research and Education,”³⁷ and when a student or professor left the university, she/he lost email and other access.³⁸ There was no commercial access to the Internet.³⁹

A young Senator, Al Gore, decided to change the face of the early Internet. In 1991, he sponsored the *High Performance Computing and Communications Act* that provided federal funding for additional growth of NSFNET and a small provision opening up NSFNET to those not affiliated with universities. Under the Act, NSF would expand access to NSFNET to a much larger set of users:

Federal agencies and departments shall work with private network service providers, State and local agencies, libraries, educational institutions and organizations, and others, as appropriate, in order to ensure that the researchers, educators, and students have access, as appropriate, to the Network...The Network shall provide access, to the extent practicable, to electronic information resources maintained by libraries, research facilities, publishers, and affiliated organizations.⁴⁰

It was a small change with huge implications. NSFNET, for the first time, would be open to noncommercial and, later, commercial traffic. The modern Internet was born. But commercial traffic began to introduce a range of policy issues and headaches for NSF and soon its staff no longer wanted their position of oversight. The domain name system, still small, was passed to the US Department of Commerce (“DOC”), which noted: “As the Internet becomes commercial, it becomes inappropriate for U.S. research agencies (NSF and DARPA) to participate in and fund these functions.”⁴¹

The DOC inherited an early and domain name system that was one of the few points of control of the global Internet.⁴² As a large and decentralized system, networks do not need centralized approval to join the Internet and send data across it. However, these networks do need uniquely assigned and coordinated numbers—“Internet Protocol addresses” or “IP addresses”—to know where to send their data packets and from which computers the data packets are being received: “There must, in other words, be some way to use the software address to find a specific physical network in a specific location.”⁴³ Because IP addresses are lengthy, numeric and hard for people to remember, the technical community called “domain

³⁶ Leiner et al., *supra* note 7, at 11.

³⁷ Leiner et al., *supra* note 7, at 11.

³⁸ Andrew Zaleski, *Doug Humphrey: Digex cofounder says ‘the point of entrepreneurship is to build success’*, TECHNICALY.LY (Feb. 7, 2013), <https://technical.ly/baltimore/2013/02/07/doug-humphrey-digex/>

³⁹ Leiner et al., *supra* note 7, at 15.

⁴⁰ High Performance Computing Act of 1991, S. 272, 102nd Cong. § 102(b) (1991).

⁴¹ U.S. Department of Commerce, National Telecommunications and Information Administration, A Proposal to Improve Technical Management of Internet Names and Addresses, Discussion Draft (1998), www.ntia.doc.gov/files/ntia/publications/dnsdrft.txt.

⁴² Laura DeNardis, *The Global War for Internet Governance* 34 (2014).

⁴³ Mueller, *supra* note 14, at 33.

names”—more recognizable letters and numbers which people can easily remember. “Alphanumeric ‘domain names’ allow individuals to type in or search for an easily understandable virtual location such as twitter.com.”⁴⁴ For example, while computers can easily reference 147.9.4.186 as an Internet destination, people more easily type “American.edu,” to reach American University’s website.⁴⁵

The DOC took charge of the Internet Protocol (“IP”) address system and the global domain name system fairly quickly. Professor Michael Froomkin, in *Wrong Turn in Cyberspace*, summarized the unusual situation of the mid-1990s: “Without meaning to at first, the United States government found itself controlling this unique Internet chokepoint.”⁴⁶

Rather than allowing the Department of Commerce, or the US, to run the emerging Internet themselves, President Clinton and then-Vice President Al Gore advanced a different idea: the future governance of the Internet should be a privatized one. On July 1, 1997, as part of the Clinton Administration's Framework for Global Electronic Commerce, the President directed the Secretary of Commerce to increase competition in, privatize and promote international participation in the domain name system.⁴⁷ The next day, the DOC issued a *Request for Comments on the Registration and Administration of Internet Domain Names*.⁴⁸ This unusual notice asked many questions, including:

- “By what entity, entities, or types of entities should current domain name systems be administered?”⁴⁹ and
- Asking detailed questions about what principles should govern US oversight.⁵⁰

Over 430 comments flooded into the DOC’s early website from around the world; a large response at the time.⁵¹ For almost a year, the DOC and the Clinton Administration’s Senior Advisor for Policy Development, Ira Magaziner, mulled over the comments, met with commercial and noncommercial stakeholders, and talked with other governments.⁵²

⁴⁴ See DeNardis, *supra* note 42, at 41.

⁴⁵ One of the many online tools to convert domain names to their IP address is *Host name to IP Address Lookup*, located at <https://whatismyipaddress.com/hostname-ip>.

⁴⁶ A. Michael Froomkin, *Wrong Turn in Cyberspace: Using ICANN to Route Around the APA and the Constitution*, 50 DUKE L.J. 17, 21 (2000).

⁴⁷ Memorandum on Electronic Commerce, July 1, 1997, <https://www.govinfo.gov/content/pkg/WCPD-1997-07-07/pdf/WCPD-1997-07-07-Pg1006-2.pdf>.

⁴⁸ Request for Comments on the Registration and Administration of Internet Domain Names, 62 Fed. Reg. 127, 35895-35897 (July 2, 1997) [hereinafter *NTIA's Green Paper*], www.ntia.doc.gov/federal-register-notice/1997/request-comments-registration-and-administration-internet-domain-names.

⁴⁹ *Id.* at 35896.

⁵⁰ *Id.*

⁵¹ Department of Commerce, National Telecommunications And Information Administration, Management of Internet Names And Addresses (2000), https://www.icann.org/resources/unthemed-pages/white-paper-2012-02-25-en#N_2_.

⁵² Author participated in these meetings on behalf of the Domain Name Rights Coalition; Magaziner “immers[ed] himself in the culture of cyberspace for more than a year.” John M. Broder, *Ira Magaziner Argues for Minimal Internet Regulation*, N.Y. TIMES, June 30, 1997, at D1, <https://www.nytimes.com/1997/06/30/business/ira-magaziner-argues-for-minimal-internet-regulation.html>.

A year later, on June 10, 1998, the DOC, through its National Telecommunications and Information Administration (“NTIA”) bureau, issued its “Management of Internet Names and Addresses Statement of Policy” and set out the path to a new system of Internet governance.⁵³ The DOC would turn over management of the global domain name system a new, private non-profit corporation organized to reflect the “global and diverse” nature of the Internet.⁵⁴ The company would need a diverse and international Board of Directors:

[B]alanced equitably [to] represent the interests of IP number registries, domain name registries, domain name registrants, the technical community, Internet service providers (ISPs), and Internet users (commercial, not-for-profit, and individuals) from around the world.”⁵⁵

The new company must commit itself to governing “on the basis of a sound and transparent decision-making process which protects against capture by a self-interested faction, and which provides for robust, professional management of the new corporation.”⁵⁶ Most unusually, the new corporation must commit to managing the global domain name system (“DNS”) based on four principles:

- “Stability:” “The introduction of a new management system should not disrupt current operations or create competing root systems.”⁵⁷
- “Competition:” “Where possible, market mechanisms that support competition and consumer choice should drive the management of the Internet because they will lower costs, promote innovation, encourage diversity, and enhance user choice and satisfaction.”⁵⁸
- “Private, Bottom-Up Coordination:” “A private coordinating process is likely to be more flexible than government and to move rapidly enough to meet the changing needs of the Internet and of Internet users. The private process should, as far as possible, reflect the bottom-up governance that has characterized development of the Internet to date.”⁵⁹
- “Representation:” “The new corporation should operate as a private entity for the benefit of the Internet community as a whole. The development of sound, fair, and widely accepted policies for the management of DNS will depend on input from the broad and growing community of Internet users. Management structures should reflect the functional and geographic diversity of the Internet and its users.

⁵³ Management of Internet Names and Addresses Statement of Policy, 62 Fed. Reg. 31741 (June 10, 1998) [hereinafter NTIA’s White Paper], www.ntia.doc.gov/files/ntia/publications/6_5_98dns.pdf.

⁵⁴ *Id.* at 31750.

⁵⁵ *Id.*

⁵⁶ *Id.*

⁵⁷ *Id.* at 31749.

⁵⁸ *Id.*

⁵⁹ *Id.*

Mechanisms should be established to ensure international participation in decision making.”⁶⁰

Such an entity did not exist, but rapidly formed, and on November 11, 1998, the DOC signed a Memorandum of Understanding with the newly-formed Internet Corporation for Assigned Names and Numbers (“ICANN”).⁶¹ ICANN offered a bold experiment in private, multistakeholder governance and a new model for making rules in emerging technological areas.

II. ICANN's Initial Policies Were Adopted Using Fairly Open And Transparent And Innovative New Form Of Private Governance Starting With Fair Rules For Domain Name Disputes.

As its first experiment in “bottom-up, multistakeholder governance,” ICANN took on the problem of domain names disputes. In the NTIA White Paper, the DOC stated that the new company must:

1. provide businesses with “confidence that their trademarks can be protected” online;⁶² and
2. manage the Internet in ways which “respond to the needs of the Internet community as whole, and not trademark owners exclusively.”⁶³

In the task of protecting trademarks, jurisdiction provided to be a complicated problem given the global nature of the Internet. A domain name registrant might be in Brazil, the trademark owner in France, and the registry and registrar in the US. Where could a dispute among these parties be brought?

On request of the DOC in the NTIA White Paper, the World Intellectual Property Organization (“WIPO”) began to explore an arbitration-like process; WIPO “initiate[d] a balanced and transparent process, which include[d] the participation of trademark holders and members of the Internet community who are not trademark holders” to develop “a uniform approach to resolving trademark/domain name disputes.”⁶⁴ On April 30, 1999, WIPO presented its *Final Report of the First WIPO Internet Domain Name Process* to ICANN and recommended a “mandatory administrative procedure be adopted uniformly across open gTLDs (“generic top-level domains”).”⁶⁵ It urged the creation of a new process in which a “neutral decision-maker” could “impose a binding decision” on

⁶⁰ *Id.*

⁶¹ MEMORANDUM OF UNDERSTANDING BETWEEN THE U.S. DEPARTMENT OF COMMERCE AND INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS (November 25, 1998), <https://www.icann.org/resources/unthemed-pages/icann-mou-1998-11-25-en>.

⁶² NTIA's White Paper, *supra* note 53, at 31746.

⁶³ *Id.*

⁶⁴ NTIA's White Paper, *supra* note 53, at 31747.

⁶⁵ World Intellectual Property Organization, The Management of Internet Names and Addresses: Intellectual Property Issues, ¶ 152 (1999) [hereinafter WIPO Final Report], <https://www.wipo.int/amc/en/processes/process1/report/>.

a trademark owner and domain name registrant.⁶⁶ In its report, WIPO proposed a set of rules for determining whether the domain name was an “abusive registration”⁶⁷ and, if so, a process by which the trademark owner could ask for cancellation of the domain name or transfer to itself.⁶⁸

WIPO’s Final Report, however, tested ICANN’s young bottom-up, multistakeholder process. Initially, supporters tried to push the WIPO-proposed rules forward quickly, asking to adopt these rules even as ICANN’s bottom-up, multistakeholder process was still being created. At an early ICANN meeting in March 1999 in Berlin, Germany, “[a] major revolt by Internet users was required to prevent ICANN’s board from endorsing the WIPO report in its entirety,” even as major structures of ICANN were still being formed.⁶⁹ The new ICANN Community argued that to follow ICANN’s new-adopted principles of private, bottom-up coordination and representation, the ICANN community would need to review the WIPO proposals, and a working group of the new ICANN “Domain Name Supporting Organization” (which included registries, intellectual property owners, noncommercial organizations and businesses) formed for that purpose.⁷⁰

Close examination of the WIPO recommendations continued at the subsequent meeting of ICANN in Santiago, Chile, in August 1999. WIPO’s proposed rules for domain name disputes met with strong opposition from the newly formed Noncommercial Domain Name Holders Constituency (NCDNHC) which felt that the WIPO proposals still did not protect the legitimate rights of registrants.⁷¹ NCDNHC members, including the American Library Association and Association for Computing Machinery’s Internet Governance Project used ICANN’s new “Public Forum”—an open discussion before the ICANN Board and meeting attendees—to speak strongly for more balanced rules and fairer protection of domain name holders.⁷²

The openness and transparency of ICANN’s new procedural rules enable various stakeholders to be heard. Upon completion of the Public Forum at the Santiago meeting, and after deliberation, the ICANN Board devised a compromise: it would adopt the WIPO domain dispute rules and suspend them pending creation of a “small drafting team” of diverse stakeholders which would draft additional protections for the “legitimate noncommercial or fair use of the mark.”⁷³ The small drafting team met, negotiated and quickly recommended the addition of § 4(c) of ICANN’s Uniform Dispute Resolution Policy (“UDRP”), which would allow

⁶⁶ *Id.* ¶¶ 183, 229.

⁶⁷ *Id.* ¶ 171.

⁶⁸ *Id.* ¶ 188.

⁶⁹ Mueller, *supra* note 14, at 193.

⁷⁰ *Id.*

⁷¹ This part of ICANN history is poorly documented, but the author was a) present, b) primary drafter of the NCDNHC charter, and c) drafter of the resolution of the NCDNHC that called on ICANN to consider adoption of the WIPO proposed domain name dispute rules only upon protection of the legitimate rights of registrants.

⁷² Jeri Clausing, Internet Oversight Board Adopts New Rules on Domain Names, N.Y. TIMES, August 27, 1999, at C2.

⁷³ ICANN, INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS MINUTES OF MEETING, [hereinafter Resolution] (1999) (resolving to adopt a dispute resolution policy), www.icann.org/resources/board-material/minutes-1999-08-26-en#99.81.

domain name registrants to demonstrate their “*Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint.*”⁷⁴ This new section stated:

Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark right⁷⁵

Over the last twenty years, tens of thousands of domain name disputes have been decided under the UDRP, and WIPO recently celebrated the 20th anniversary of its passage.⁷⁶

In addition to the UDRP, the first “consensus policy, in the last 20 years, the ICANN Community has negotiated, debated, and written “consensus policies”⁷⁷ a range of domain name issues using its open and transparent “bottom-up, multistakeholder governance” processes, including:

- WHOIS Data Reminder Policy: reminding registrants to update their domain name registration data on an annual basis (2003);⁷⁸
- Inter-Registrar Transfer Policy: enabling registrants to transfer domain names from one ICANN-accredited registrar to another without undue delay (2016);⁷⁹ and
- Expired Registration Recovery Policy: providing at least two notices to registrants prior to expiration of their domain names and creating a 30 day “Redemption Grace Period” to allow registrant to renew their domain names following deletion of the registration (when the loss of website pages and email notices may provide actual knowledge of the loss of domain name even if email notices did not reach the registrant) (2013).⁸⁰

⁷⁴ ICANN, UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (1999) (adopting and implementing the dispute resolution policy), www.icann.org/resources/pages/policy-2012-02-25-en.

⁷⁵ *Id.*

⁷⁶ *WIPO Conference – As the UDRP Turns 20: Looking Back, Looking Ahead*, WORLD INTELLECTUAL PROP. ORG. (2019), www.wipo.int/portal/en/news/2019/article_0050.html.

⁷⁷ ICANN Consensus Policies, www.icann.org/resources/pages/registrars/consensus-policies-en.

⁷⁸ ICANN, WHOIS DATA REMINDER POLICY (2003), <https://www.icann.org/resources/pages/registrars/consensus-policies/wdrp-en>.

⁷⁹ ICANN, DOMAIN NAME TRANSFERS (2016), <https://www.icann.org/resources/pages/registrars/transfers-en>.

⁸⁰ ICANN, EXPIRED REGISTRATION RECOVERY POLICY (2013),

In addition, the Generic Names Supporting Organization (GNSO) (successor to the DNSO discussed above), the group charged with making policies for “generic top level domains” including .com, .org and .net, negotiated and wrote a comprehensive set of rules to allow companies to apply to ICANN to manage and run new generic top level domains.⁸¹ Following these rules, in 2012, prospective registry operators submitted more than 1900 applications to ICANN for new generic top level domain ranging from .ninja to .horse, .bank, .paris and .nyc.⁸² From these applications, and after extensive operational, financial and technical reviews, ICANN “delegated” more than 1300 new top level domains to registries, including .sport, .grocery, .volvo, .basketball, .citi, and .smart.⁸³ These top level domains include the first generic top level domain in foreign scripts, including:

| |
|---|
| شبكة (xn—ngbc5azd) – Arabic for “web/network” |
| онлайн (xn—80asehdb) – Russian for “online” |
| сайт (xn—80aswg) – Russian for “site” |
| 游戏(xn—unup4y) – Chinese for “game(s)” ⁸⁴ |

These ICANN policies developed through the “bottom-up, multistakeholder process” of the GNSO, to the GNSO Council and ultimately and reached the ICANN Board for approval. Advisory Committees provided oversight, including ICANN’s Government Advisory Committee in which the DOC continues to play an active role.

III. Crash Goes The Multistakeholder Model: How ICANN Is Reverting To Closed-Door Policy-Making Processes And Leaving Behind Its Open, Accountable And Bottom-Up, Multistakeholder Processes.

Unfortunately, “bottom-up, multistakeholder processes,” like democracy, are “messy” and “hard.”⁸⁵ ICANN’s processes are particularly time-consuming as they involve diverse representation: peoples from different countries and cultures, speaking different languages, bringing different legal structures and a wide array of concerns. Yet private multistakeholder policy-making processes have stood the test of time and helped created an Internet environment that now serves approximately 200 million domain name registrants and more than four billion users.

<https://www.icann.org/resources/pages/errp-2013-02-28-en>.

⁸¹ ICANN, APPLICANT GUIDEBOOK (2012), newgtlds.icann.org/en/applicants/agb.

⁸² See ICANN, New Top-New Top-Level Domain Name Applications Revealed, Historic Milestone for the Internet’s Domain Name System (June 13, 2012), <https://newgtlds.icann.org/en/announcements-and-media/announcement-13jun12-en>

⁸³ ABOUT THE PROGRAM, <https://newgtlds.icann.org/en/about/program> (last visited Jan. 3, 2020).

⁸⁴ DELEGATED STRINGS, <https://newgtlds.icann.org/en/program-status/delegated-strings> (last visited Jan. 3, 2020)

⁸⁵ ROBERT F. KENNEDY, JR. QUOTES, https://www.brainyquote.com/quotes/robert_kennedy_jr_777604 (last visited Jan. 3, 2020).

The current question is whether ICANN is willing to stick with its multistakeholder processes and the traditional limits of its scope of authority. For example, for the last 20 years, ICANN avoided using its control of the DNS—the routing of Internet domain names—for content control. In almost Biblical fashion, ICANN's 2016 Bylaws declare that it “*shall not regulate* (i.e., impose rules or restrictions on) services that use the Internet's unique identifiers or the content that such services carry or provide” ICANN Bylaws, Article 1.1(c).⁸⁶ However, close watchers of ICANN, including American University Internet Governance Lab Co-Founder Professor Laura DeNardis, have warned of the easy ability ICANN to use the “Internet Governance Infrastructure as a Proxy for Content Control.”⁸⁷

Further, individual registries are now moving towards more active roles as Internet content controllers using their control of domain names. In 2013, Donuts—an owner of over 200 new generic top-level domains—adopted an anti-abuse policy focused on content.⁸⁸ “Specification 11” of its registry contracts allows Donuts to remove domain names “at its sole discretion:”

[Donuts] reserves the right, at its sole discretion and at any time and without limitation, to deny, suspend, cancel, or transfer any registration or transaction, or place any domain name(s) on registry lock, hold, or similar status as it determines necessary . . .⁸⁹

Accordingly, for the domain name registrants of more than 200 generic top-level domains, Donuts may remove the domain names without notice, due process, or a court finding of illegality or infringement. It is important to note that these content policies of Donuts was never written, researched, debated, or adopted by ICANN's bottom-up, multistakeholder community, and did not go through any ICANN policy-development process. They are private policies placed by Donuts in its private contracts with ICANN for its 200 top level domains without public input or oversight. The implications of Donuts' private content policies are potentially far-reaching: domain names are the street signs of the Internet and they can be associated with enormous amounts of Internet material. A single domain name, of a large commercial or organizational site, may host hundreds of webpages, thousands of email addresses, and numerous “listservs,” which facilitate group messages among employees and customers.

Not surprisingly, academics and digital rights groups are raising alarms that ICANN and its registries are straying beyond their narrow mandate, and leaving behind their multistakeholder processes.⁹⁰ Last Spring, American University Washington College of Law hosted an event where faculty, students, registry

⁸⁶ ICANN, BYLAWS FOR INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS Art. 1.1(c) (2016) (emphasis added), www.icann.org/resources/pages/governance/bylaws-en/#article1.

⁸⁷ DeNardis, *supra* note 42, at 9.

⁸⁸ .LAND REGISTRY AGREEMENT, www.icann.org/resources/agreement/land-2013-09-10-en (last visited Jan. 3, 2020).

⁸⁹ *Id.*

⁹⁰ See, e.g., Bridy, Annemarie, Notice and Takedown in the Domain Name System: ICANN's Ambivalent Drift into Online Content Regulation, 74 WASH. & LEE L. REV., 1345, 1346 (2017); Jeremy Malcolm & Mitch Stoltz, How Threats Against Domain Names are Used to Censor Content, ELECTRONIC FRONTIER FOUND (July 27, 2017, <https://www EFF.ORG/deep links/2017/07/how-threats-against-domain-names-used-censor-content>) (announcing new white paper on registry private policies).

representatives, ICANN Board members, DOC representatives and Internet users explored the potential concerns and dangers of “domain name takedown policies.” Such policies allow a registry to remove a domain name, thereby deleting its full range of content, without due process. An attorney with a digital rights group, the Electronic Frontier Foundation, raised the specter of growing private censorship on the Internet by top level domain name registries through their control of domain names.⁹¹

More recently, in 2019, ICANN moved privately, and outside the multistakeholder process, to dramatically revise the contract terms of the .org top level domain. Now in its 34th year and run by an entity named the Public Interest Registry, .org is home to over 10 million domain name registration. ICANN staff privately negotiated a new contract with the Public Interest Registry, posted it for public comment, and despite the objection of more than 3200 commenters, adopted the contract without change.⁹² In July 2019, ICANN allowed .org registry to drop its long-standing price caps and write private rules for content monitoring and takedown.⁹³ Further, on November 13, 2019, the Internet Society announced that it would sell the Public Interest Registry to the newly-formed private equity firm Ethos Capital.⁹⁴ An uproar emerged from the nongovernmental organizations (“NGOs”), political groups, religious entities, civil society entities and civil liberties groups who had a .org domain name:

At stake are internet addresses ending in “.org” used by some 10 million organizations It is traditionally reserved for nonprofit organizations devoted to the public interest, such as the Red Cross, the Girl Scouts, and the United Way... for the most part, organizations genuinely aimed at doing good tend to choose .org addresses. And, for that matter, so do Democratic and Republican party websites.⁹⁵

Registrants across the Internet are urging ICANN to reject the sale.⁹⁶ In a campaign titled SaveDotOrg, over 23,000 individuals and 780 organizations signed a petition asking ICANN, the Internet Society and the Public Interest Registry to stop the sale of the Public Interest Registry (and .org) to a private equity and argued that “.org must be managed by a leader that puts the needs of NGOs over profits.”⁹⁷ The debate continues to play out before the ICANN Board, ICANN community,.org community of registrants and in the press as of the publication of this paper.

⁹¹ American University Washington College of Law, *ICANN and the New Top-Level Domains Event* (February 25, 2019), www.wcl.american.edu/impact/initiatives-programs/pijip/events/icann-and-the-new-top-level-domains/.

⁹² Proposed Renewal of .org Registry Agreement, *Public Comments and Report of Public Comments* (2019), www.icann.org/public-comments/org-renewal-2019-03-18-en.

⁹³ .ORG REGISTRY AGREEMENT (June 30, 2019), <https://www.icann.org/resources/agreement/org-2019-06-30-en>.

⁹⁴ Internet Society, *Ethos Capital to Acquire Public Interest Registry from the Internet Society* (Nov. 13, 2019), <https://www.internetsociety.org/news/press-releases/2019/ethos-capital-to-acquire-public-interest-registry-from-the-internet-society/>.

⁹⁵ Hiltzik, Michael, *Column: What Happens When Private Equity Buys the .org Internet?*, L.A. TIMES, Dec. 12 2019, www.latimes.com/business/story/2019-12-12/dot-org-sale-outrage-internet-society-ethos-capital.

⁹⁶ See e.g., Marc Rotenberg, *Save the .ORG domain and all it symbolizes*, HILL (Dec. 12 2019), <https://thehill.com/opinion/technology/473537-save-the-org-domain-and-all-it-symbolizes> (former chair of the Public Interest Registry, which runs .org, explaining the dangers of the .org sale).

⁹⁷ SAVE .ORG, <https://savedotorg.org/> (last visited Feb. 5, 2020).

Why should the commercial and intellectual property communities care about changes to ICANN's bottom-up multistakeholder policy-making processes or changes to the .org contract? It may be easy to dismiss the slow tide of changes in the ICANN processes or wonder why changes to .org matter to the commercial and intellectual property communities, however, three reasons capture the dangers of the current .org process for the larger Internet community.

First, nearly everyone turns to .org domain names for sought-after noncommercial content: checking the time schools open (as many school systems use .org domain names), donating to a favorite charity, finding a local religious service, and seeking a favorite nonprofit news source. Removal of this content for arbitrary reasons will harm the public's access to news, educational, religious, personal and political information—all highly protected speech.

Second, the sale of .org is taking place without formal input or involvement of the ICANN Community. ICANN's Noncommercial Users Constituency (NCSG) protested in a formal letter that the ICANN Board Chair and ICANN President "should make decisions about the future of the ORG TLD only after consulting with impacted registrants and the global non-commercial Internet community."⁹⁸ ICANN's Government Advisory Committee similarly asked the ICANN Chair and President "what process or mechanism exists or could be established to allow any concerned members of the ICANN community to appropriately express their views regarding the transition."⁹⁹ The lack of substantive responses from the ICANN Board and officers indicates a problem in the multistakeholder process and the lack of openness and transparency run counter to ICANN's principles of bottom-up multistakeholder coordination and representation. The loss or diminishment of these multistakeholder processes would harm not only .org domain name registrants, but all ICANN and Internet stakeholders.

Third, the renewals of .com and .net lie ahead. These are large top-level domains run by the Fortune 500 company VeriSign Inc. based in Northern Virginia. Similar to .org (before July 2019), .com, and .net operate under older contracts and their current contracts place price caps on .com and .net domain names which strictly limit the amount by which Verisign may raise prices and bind Verisign to commitments of "content neutrality" (barring removal of .com domain names for allegations of content illegality by unilateral action of Versign).¹⁰⁰ If the recent changes to the Public Interest Registry's .org contract are a harbinger, future changes to Versign's .com and .net contracts may propose dramatic price increases domain names without recourse by registrants and may allow Versign to "takedown" domain names based on private decisions absent a legal finding of infringement or illegality.

⁹⁸ Milton Mueller, *ICANN Told to Make Ethos Capital Conform to Original ORG RFP Criteria*, INTERNET GOVERNANCE PROJECT (Dec. 11 2019), <https://www.internetgovernance.org/2019/12/11/icann-told-to-make-ethos-capital-conform-to-original-org-rfp-criteria/> (showing the letter from ICANN's Noncommercial Stakeholders Group to ICANN Board Chair, Maarten Botterman, and President, Goran Marby).

⁹⁹ Letter from Manal Ismail to Maarten Botterman & Goran Marby (Jan. 7, 2020), <https://www.icann.org/en/system/files/correspondence/ismail-to-botterman-marby-07jan20-en.pdf>.

¹⁰⁰ NTIA, Statement on Amendment 35 to the Cooperative Agreement with Verisign (November 01, 2018).

The implications for the 144 million .com domain name registrants¹⁰¹ would be far-reaching and, potentially, devastating.¹⁰² Tens of millions of commercial domain name registrants may find that their domain names and online presences are no longer safe, secure, and protected.

CONCLUSION

Twenty years ago, Internet rules such as NSI's domain name dispute policy were negotiated behind closed doors. These policies – intentionally or inadvertently – often did not protect the legal rights and legitimate needs of domain name registrants. A small group of young and dynamic Internet Service Providers almost lost their livelihoods, and the economy almost lost a new industry.

Under the principles written by the DOC, and undertaken by ICANN, the ICANN Community created fairer and more balanced processes for writing and adopted Internet policies – with the name of “bottom-up, multistakeholder” policy development and the commitment to balancing the legitimate needs and concerns of all major stakeholders; the goal was not want to leave anyone out.

Now the doors are closing again as private contracts between ICANN's Board and old and new top-level domain registries shift an increasing set of domain name policies to private oversight and control. As ICANN moves away from bottom-up, multistakeholder processes for .org and other top-level domains, Verisign, with its .com treasure-trove is taking careful notes.

Ultimately, commercial and IP communities should care about changes to .org's contract because Verisign may seek the same contractual terms, including the right of unlimited price increases and private creation of content rules, in future contract renewals. Even complaints of tens of millions of .com domain name registrants may be insufficient as ICANN's Board and officers point to the precedent of ignoring thousands of comments in the .org renewal. In the closed-door ICANN Board and CEO sessions, who will speak for the emerging existing and new industries? How will the ICANN Community protect the next generation of entrepreneurs and new businesses – the disruptors who will shape our future new economies?

For the current state of the Internet and the decline of its multistakeholder processes, John Donne's pre-Internet resonates:

Therefore, send not to know
For whom the bell tolls,
It tolls for thee.¹⁰³

¹⁰¹ VERISIGN, THE VERISIGN DOMAIN NAME INDUSTRY BRIEF (2019), https://www.verisign.com/en_US/domain-names/dnib/index.xhtml?section=tlds.

¹⁰² In fact, during the course of the editing of this paper, on January 3, 2020, ICANN issued a public notice regarding Verisign's request of price increases for .com domain names and other contractual amendments. ICANN, PROPOSED AMENDMENT 3 TO THE .COM REGISTRY AGREEMENT (2020), <https://www.icann.org/public-comments/com-amendment-3-2020-01-03-en>

¹⁰³ John Donne, *For Whom the Bell Tolls*, http://www.yourdaily poem.com/listpoem.jsp?poem_id=2118.

PATENTING AN ENANTIOMER IN INDIA, A FOREGONE CONCLUSION?

Jeffrey Rhodes

ABSTRACT

This article compares enantiomers as patentable subject matter under Indian and US patent regimes, showing that the US generally allows enantiomer patents while India generally bars enantiomer patents. It considers cases illustrating India's approach, which contextualize the bar's parameters. From this analysis, important strategic considerations are highlighted, such as: defining efficacy; using the proper terms of art as a guide and a means of reference; and presenting empirical evidence to prove the improvement in efficacy.

Enantiomers are important in the pharmaceutical arts because natural systems are sensitive to a molecule's structural "handedness." This "handedness" causes unexpected interactions between the drug and the organism. Interactions, broadly speaking, can present as changes in: efficacy, duration of action, and toxicity. The complexity of a living system makes predicting these interactions difficult. This article will briefly explain their scientific significance to those arts and elucidate the interplay between the art and patent law relative to the overall topic.