THE IMPACT OF GDPR ON ONLINE BRAND ENFORCEMENT

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The European Union (EU) transformed the global landscape of data protection and privacy when it passed the General Data Protection Regulation (GDPR) in 2016.

GDPR basics. The GDPR is a broad framework designed to protect EU citizens' privacy and to level the playing field for businesses by harmonizing data protection and privacy rules across the EU. Because most providers of goods or services collect data of some type, the GDPR contains strict requirements for those who control personal data (data controllers) and those who actually process or publish the data (data processors). Importantly, the GDPR applies not only to those established within the EU who control or process data, but also to any party located anywhere who offers goods and services to data subjects located within the EU or who monitors the behavior of data subjects located within the EU.

Under the GDPR, personal data may only be processed for certain legitimate and specified purposes, and the processing must be limited to what is necessary for those purposes. Data processing must also be based on one of the specific legal grounds set forth in the GDPR.

The WHOIS system of domain name registration data. The Internet Corporation for Assigned Names and Numbers (ICANN) accredits domain name registry operators and registrars and sets forth the rules and requirements for the provision of domain name registrations to members of the public. ICANN requires domain name registrars and registry operators to collect and publish certain specified domain name registration information in a publicly accessible online database known as the WHOIS database.

THE NEW RULES MAKE ACCESS TO NONPUBLIC DATA UNPREDICTABLE AND FRAGMENTED.

Historically, WHOIS provided transparency and facilitated a number of key activities to protect Internet users from harm and ensure the security, stability, and resiliency of the Internet. WHOIS has been an essential tool to help identify parties responsible for domain name registrations and associated online resources such as website content or e-mail addresses engaging in abusive or malicious conduct online. The WHOIS system ensured that all sites have at least one "designated agent" to ensure proper "chain of title" or to name and contact the appropriate party in a dispute or legal proceeding regarding a domain name.

In response to the GDPR, ICANN imposed drastic changes to the WHOIS system on an emergency temporary basis to ensure adequate legal compliance with respect to data processing, but at the expense of continued transparency and accountability. Under these new rules (in the form of a "Temporary Specification" to ICANN's contracts with registry operators and registrars), critical registration data including registrant names, street addresses, and e-mail addresses have gone dark in an attempt to enable ICANN, registry operators, and registrars to comply with the GDPR. The only remaining public information about domain name registrants is their organizational affiliation, state/province, and country. The new rules make access to nonpublic data unpredictable and fragmented.

The Temporary Specification requires that registrars provide

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third parties with "reasonable access" to nonpublic data on the basis of a legitimate interest, except where such interests are overridden by the interests or fundamental rights and freedoms of the registrant. However, no further guidance or criteria set out what constitutes "reasonable access" or a "legitimate interest."

These substantial changes to the WHOIS system have inevitably led to significant obstacles to online trademark enforcement. The only way now to identify the registrant is through the voluntary registrant organization field, which is merely optional and therefore often unavailable.

Many registrars are not even complying with the continuing mandatory minimum information requirements of ICANN. Instead, many have redacted every single WHOIS data field relating to registrant contact information as the default.

Impact on online intellectual property enforcement. These changes have created many impediments across all anti-abuse efforts. Miscreants engaging in counterfeiting, piracy, phishing, fraud, and distribution of malware, among other abuses, are able to carry on longer and are generally harder to take down at all. Large networks and other patterns of abusive domain names and websites are harder to detect or combat in a comprehensive fashion. Even if there are grounds for enforcement, a brand owner has no ability to identify a proper point of contact to notify the registrant of the brand owner's concerns and potentially resolve the issue amicably.

Best practices for online enforcement. Despite the current landscape, intellectual property owners retain a number of key tools and strategies to investigate and address online infringement and other abuses, beyond mere registration data disclosure requests.

Archived WHOIS data. Robust archived WHOIS data remains available from the not-so-distant past when it was still predominantly published online. However, access to archived WHOIS data usually comes commensurate with subscription fees from the service providers who archived it.

Website contacts. Very few fraudsters include legitimate point of contact information within their website content, and many acts of online abuse do not involve a website at all. Nevertheless, innocent infringers sometimes do include functional contact information within their websites or on their domain name parking pages, so it remains useful to check.

"John Doe" cease-and-desist letters. Even where a domain name registrant's identity cannot be confirmed through available WHOIS data or on the website itself, it may still be possible to send an anonymous cease-and-desist letter using an available anonymized registrant e-mail address or online web form, as required under the Temporary Specification. If an anonymized registrant e-mail address or web form is not being provided by the registrar, this is a violation of the Temporary Specification and should be reported to the ICANN contractual compliance department.

Notice and takedown letters to web hosts. The optimal and appropriate way to address problematic online content remains through the intermediaries who host that content. Web hosts can still be easily identified through the Internet Protocol (IP) addresses associated with each domain name and website. Once the web host has been identified, reports of infringement or abuse can be filed with its abuse point of contact or other appropriate complaint contact.

Registration authority abuse points of contact. All domain name registration authorities have a contractual obligation to publish an abuse point of contact, and registrars are required to "take reasonable and prompt steps to investigate and respond appropriately to any reports of abuse." This language should be cited in any takedown demand or demand for registration authorities to reveal nonpublic WHOIS data. ■

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