December 6, 2019

Via Electronic Mail: PrivacyRegulations@doj.ca.gov

Privacy Regulations Coordinator
California Office of the Attorney General
300 South Spring Street, First Floor
Los Angeles, CA 90013

Re: WHOIS Database Intellectual Property Right Comments on the California Attorney General’s Proposed Regulatory Action Concerning the California Consumer Privacy Act (CCPA)

Dear Attorney General Becerra:

As Chair of the American Bar Association Section of Intellectual Property Law (“ABA-IPL Section” or “Section”), I write on behalf of the Section to provide comments on the proposed regulations for the California Consumer Privacy Act (“CCPA”), published October 11, 2019 by the California Department of Justice (“Office”). The views expressed herein are presented on behalf of the Section of Intellectual Property Law. They have not been approved by the House of Delegates or the Board of Governors of the American Bar Association and, accordingly, should not be construed as representing the position of the Association.

Recent changes in data privacy law have significantly impaired the ability to enforce intellectual property rights. In particular, since the May 25, 2018 effective date of the General Data Protection Regulation (“GDPR”), it has been much more difficult to enforce intellectual property rights online against persons or entities that register domain names confusingly similar to a registered trademark, or whose website offers counterfeit, pirated or otherwise infringing content, products or services.
The Section is greatly concerned that the rights of intellectual property owners are similarly being overlooked in the proposed regulations for the CCPA. We appreciate the difficult task of regulating and enforcing a complex statute such as the CCPA in addressing consumer privacy concerns. But unless amended the Office’s proposed regulations will exacerbate these enforcement difficulties.

The California legislature expressly acknowledges the potential impact of data privacy laws and regulations on intellectual property rights, as the text of the CCPA states that your Office “shall solicit broad public participation and adopt regulations to further the purposes of this title, including … establishing any exceptions necessary to comply with state or federal law, including, but not limited to, those relating to trade secrets and intellectual property rights, within one year of passage of this title and as needed thereafter” (Cal. Civil Code § 1798.185(a)(3)).

Yet, the proposed regulations for the CCPA are silent on intellectual property rights. To address this concern regarding the intersection of intellectual property rights and consumer privacy, the Section supports the right of the public, furthered by the rights of intellectual property owners and the needs of law enforcement officials, to access contact information for registrants of domain names in the WHOIS database administered by the Internet Corporation for Assigned Names and Numbers (ICANN), for at least the limited purpose of investigating and enforcing against violations of applicable law relating to intellectual property protections.

Therefore, the Section respectfully requests the Office’s proposed regulations be amended to clarify that under the CCPA, a right is reserved for intellectual property owners that would legally compel the disclosure of domain registrant contact information by any U.S. entity that administers and maintains such contact information, upon receipt of a notice alleging a legitimate interest based on the registrant’s violations of applicable laws relating to intellectual property protections.

I. History and Background on the WHOIS Database and How It is Used to Enforce Intellectual Property Rights

A straightforward process has long been available to the general public, including intellectual property owners, to obtain domain registrant contact information. From at least as early as 1999 through 2018, accredited registrars were contractually obligated by ICANN to provide an interactive web page where the public could request information on registered domain names, including the name and contact information for the registrant or owner of the domain name as such information is maintained in the WHOIS database.

The WHOIS database is a protocol administered by ICANN and used to make a variety of information about a given domain name available to the public. For example, most WHOIS queries disclose the date a domain name was registered, the date it was last updated with the registrar, and the date the domain’s registration will expire if not renewed.

Before the GDPR went into effect, contact information for most domain registrants, such as an email address, was also generally available to the public unless the registrant paid for a privacy or proxy service. Privacy services allow persons or entities to be listed as the registered domain
name holder, but alternative and reliable contact information such as an anonymized mail-forwarding email address is substituted for the true registrant’s personal contact information. Proxy services similarly provide alternate contact information for the registrant, but proxy service providers also are listed as the registered domain name holder.

When a privacy or proxy service is used, the registrant at least could be notified of the trademark or copyright owner’s concerns about any alleged violations of applicable law relating to intellectual property protections. Communications with such registrants would often lead to a cost-effective settlement of the matter.

Such settlement of a trademark dispute might include a transfer or cancellation of the domain registration, without any need for costly litigation or the filing of a complaint under ICANN’s Uniform Domain Name Dispute Resolution Policy (“UDRP”), which requires a fee of at least $1,500 USD. Further, UDRP proceedings are determined based on a record set forth solely by the complaint and any formal response by the registrant. Therefore, a successful UDRP complaint must include evidence establishing that, among other things, the registrant has no rights or legitimate interest in the domain name, and that the domain name was registered and used in bad faith (UDRP, Paragraphs 4(a-c)). The content of communications with domain registrants, among other evidence which is only accessible after learning the registrant’s email address, is often important to proving such factors in a UDRP proceeding. For example, communications can reveal whether the registrant is preparing to use the domain name in connection with a bona fide offering of goods or services in a way that could show the registrant has a legitimate interest in the domain. Similarly, communications that reveal the registrant is located in a jurisdiction where the complainant is not active may indicate the domain was not registered in bad faith because the registrant may not have been aware of the complainant’s mark when the domain was registered.

With respect to online copyright violations, communications with a domain registrant are crucial for copyright owners to protect their exclusive rights and exercise the notice and takedown procedure available under the Digital Millennium Copyright Act (“DMCA”) in a cost-effective manner. When a copyright owner simply wants infringing content removed from a website, oftentimes a letter or email correspondence to the domain registrant is enough to cause the removal. If the registrant posted the infringing content, the registrant may not know such content violated someone’s copyright and be more than willing to remove it to avoid ongoing liability. If a user of the registrant’s website posted the infringing content, then the DMCA provides an immunity from copyright infringement for website operators that remove infringing content upon receipt of a formal notice from the copyright owner (17 U.S.C. § 512(c)). Accordingly, registrants that operate websites with infringing user-generated content are incentivized to comply with copyright-based takedown requests. However, these simple options are not available if the registrant cannot be contacted by a copyright owner concerned about infringement. If a copyright owner is unable to contact a registrant potentially involved with infringing content, litigation becomes the only recourse even if a basic takedown is all the

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1 See generally Uniform Domain Name Dispute Resolution Policy, available at https://www.icann.org/resources/pages/policy-2012-02-25-en.
copyright owner seeks. Such litigation leads to additional legal measures, such as a subpoena or other court order, to compel disclosure of a domain registrant’s contact information, often accompanied by a significant financial burden in comparison to a simple exchange of correspondence between cooperative parties.

II. Data Privacy Regulations Can Significantly Affect the Availability of Information Through the WHOIS Database

Before the GDPR, even if the registrant paid for a privacy or proxy service, such services would list an anonymized email address in the WHOIS record that could be used reliably to direct communications to the registrant. While there is no guarantee the registrant would respond, these anonymous email addresses still provide a means to communicate concerns over an alleged dispute before initiating costly legal action that may not be necessary.

After the GDPR went into effect, it has become difficult, if not impossible, to locate any usable registrant contact information even from registrars and registry services located outside of Europe. Due to potential penalties for the unauthorized disclosure of personal data under the GDPR of “up to 20,000,000 EUR or … 4% of [a business’s] total worldwide annual turnover … whichever is higher,” ICANN has released accredited registrars from any contractual obligations to disclose registrant information, including contact information. ICANN also has struggled to implement a GDPR-compliant replacement access model for the WHOIS database. Because of this uncertainty, many registrars now hide or redact registrant names and contact information by default.3

Without any clear obligation to disclose registrant contact information, obtaining access to such information is now at the discretion of each of the thousands of ICANN-accredited registrars and registry services. Some registrars, such as eNom, an affiliate of the Canadian company Tucows, provide a tiered access system where enforcement entities can provide “name, legitimate interest for access, and domain name(s) for which access is desired” as part of an application process to request access to a “tiered registration directory.”4 Other registrars, such as the French company OVH, use anonymized email addresses to direct communications to registrants without disclosing their identity, similar to how many paid privacy services work.5

Other registrars are less forthcoming about an alternate means of accessing registrant information and may bury trademark and copyright complaint procedures in website policies and agreements. Certain registrars expressly prioritize the privacy concerns of customers over the interests of

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3 See Brian Winterfeldt, Griffin M. Barnett and Janet Lee, The Impact of GDPR on Online Brand Enforcement: Lessons Learned and Best Practices for IP Practitioners, 11 LANDSLIDE 4, A.B.A. SEC. INTELL. PROP. L. (March/April 2019), https://www.americanbar.org/groups/intellectual_property_law/publications/landslide/2018-19/march-april/impact-gdpr-online-brand-enforcement-webinar/ (“Many registrars are not even complying with the continuing mandatory minimum information requirements of ICANN … many have redacted every single WHOIS data field relating to registrant contact information as the default”).
4 https://www.enom.com/help/abusepolicy.aspx#fragment-4
5 See, e.g., https://www.ovh.co.uk/domains/owo_service.xml.
intellectual property owners and other enforcement entities. Namecheap, for example, has a published policy stating it will forward “a valid and formal notice of a trademark complaint,” provided the notice meets five specific requirements, to the allegedly infringing customer. However, Namecheap is also clear that after the GDPR, it “will not disclose any personal information about our customers unless required by law or pursuant to a court order or subpoena.”

The many competing ways in which registrars handle this issue have caused the WHOIS database to become far less useful for the enforcement of intellectual property rights than it has been for decades. The table below provides a representative sample illustrating the numerous ways prominent registrars in jurisdictions around the world have handled WHOIS access since the GDPR became effective.

<table>
<thead>
<tr>
<th>Registrar</th>
<th>Location</th>
<th>Access Model</th>
</tr>
</thead>
<tbody>
<tr>
<td>Alibaba Cloud</td>
<td>China</td>
<td>Email registrar abuse contact</td>
</tr>
<tr>
<td>DENIC</td>
<td>Germany</td>
<td>Submit paper application form</td>
</tr>
<tr>
<td>eNom/Tucows</td>
<td>Canada</td>
<td>Tiered access based on legitimate interest</td>
</tr>
<tr>
<td>EURid</td>
<td>Belgium</td>
<td>Submit email request</td>
</tr>
<tr>
<td>GoDaddy</td>
<td>U.S.</td>
<td>Available depending on location of registrant</td>
</tr>
<tr>
<td>Namecheap</td>
<td>U.S.</td>
<td>Subpoena/ court order/UDRP</td>
</tr>
<tr>
<td>Namegear</td>
<td>Japan</td>
<td>Submit request to “Privacy Information Support Contact”</td>
</tr>
<tr>
<td>Network Solutions</td>
<td>U.S.</td>
<td>Submit “Report Abuse” web form</td>
</tr>
<tr>
<td>OVH</td>
<td>France</td>
<td>Anonymized auto-forwarding email address</td>
</tr>
<tr>
<td>Public Domain Registry</td>
<td>India</td>
<td>Subpoena/ court order/UDRP</td>
</tr>
</tbody>
</table>

These different access models tend to just provide a variety of dead-ends for intellectual property owners justifiably seeking to identify any entity that is violating applicable federal and state laws relating to intellectual property protections. Accordingly, intellectual property owners effectively no longer have the right of access they once did to registrant contact information for enforcement purposes, and there is much less opportunity to resolve these disputes amicably between the parties.

7 [https://www.namecheap.com/about/privacy-commitment/](https://www.namecheap.com/about/privacy-commitment/).
III. The CCPA’s Proposed Regulations Should Be Amended To Restore Certain Rights of Access to WHOIS Information

The GDPR set a precedent in data privacy law, which appears to have inspired the CCPA to some degree. However, the GDPR and the complicated patchwork of state laws in the U.S. emerging in the area of data privacy, of which the CCPA is a dominant component, have yet to address the need for intellectual property owners, among others, to identify and contact entities engaging in infringing activities online that violate applicable intellectual property laws.

The Section is concerned the broad applicability of the CCPA and its proposed regulations could have a similar impact on the availability of contact information through the WHOIS database in the U.S., to the extent it was not already affected by the GDPR. While consent requirements under the CCPA generally rest on opt-outs rather than the affirmative opt-in consent required under the GDPR, registrants who violate intellectual property rights would theoretically receive a cost-free means of avoiding detection for acts violating federal or state law should they choose to exercise the opt-out.

The CCPA specifically gives your Office the authority to issue regulations addressing potential conflicts between the privacy obligations of the CCPA and trade secrets and intellectual property rights granted under state or federal law (Cal. Civil Code § 1798.185(a)(3)). Despite this invitation from the state’s legislature, the proposed regulations make no mention of trademark, copyright, patent, trade secret or any other kind of intellectual property protections.

There is a reasonable compromise between the interests of intellectual property owners and privacy rights with respect to domain registration and the information available through the WHOIS protocol. The Section respectfully requests that your office consider the adoption of regulations which ensure the right of intellectual property owners to have access to domain registrant contact information upon the showing of a legitimate interest in enforcing intellectual property rights against a registrant engaged in violations of applicable law relating to intellectual property protections, including, but not limited to, cybersquatting, trademark or copyright infringement, dilution, piracy, counterfeiting, or unfair competition. For example, under trademark law, such a legitimate interest could be established by showing ownership of a name or mark that is confusingly similar to the domain name at issue with the relevant registrar or registry service. Under copyright law, a similar legitimate interest could be established by showing ownership of a copyright protected work that is copied in website content available through the domain at issue, along with any other claims or evidence necessary to make the disclosure of registrant information permissible under applicable law. More specifically, the Section submits that the proposed regulations should be amended to grant an express right to intellectual property owners that would compel access to domain registrant information in the

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8 See Justin P. Webb and Sarah A. Sargent, An American Perspective on the GDPR One Year In, 11 LANDSLIDE 5, A.B.A. Sec. Intell. Prop. L. (May/June 2019), https://www.americanbar.org/groups/intellectual_property_law/publications/landslide/2018-19/may-june/an-american-perspective-the-gdpr-one-year-in/ (“Similar to the GDPR, U.S. companies will be forced to choose between providing the more robust privacy protections in the CCPA only to California residents or spending more money and time to provide those rights to all individuals”).
WHOIS database for the limited purposes of enforcement against persons or entities engaged in violations of applicable law relating to intellectual property protections.

The Section does not suggest any specific information access model given that any form of access likely will need to be compliant in other jurisdictions. Regardless of the form of access model, access to registrant information in the WHOIS database should be restored for the effective enforcement of intellectual property rights online. The current need to litigate, obtain a court order, or initiate a UDRP proceeding just to identify an infringing entity is overly expensive and burdensome to parties—justifiably seeking to enforce rights granted to them under law—while making it easier for infringers to hide from the parties they damage.

An access model allowing enforcers of intellectual property rights to view contact information for an allegedly infringing registrant for the limited purposes of intellectual property enforcement would respect individual privacy rights while also ensuring that intellectual property owners can reach entities that are violating applicable laws, such as the Lanham Act and the Copyright Act. Under the CCPA, such an access model would identify the enforcement of intellectual property rights as among the specific reasons an opt-out request can be refused. The Section does not intend to comment on European law, but in theory, such an access model would also help establish that a violation of applicable intellectual property rights is a legitimate interest which is not overridden by the interests or fundamental rights or freedoms of the registrant under the GDPR.9

California law should support a public access system that would legally compel relevant entities to disclose contact information for persons or entities plausibly alleged to have engaged in violations of applicable law relating to intellectual property protections. Under such an access system, entities including, but not limited to, registrars and registry services should be legally required to disclose such contact information once the requesting party has established a legitimate interest in a legal right potentially violated by the domain registrant at issue.

Thank you for the opportunity to submit these comments for the public record relevant to the proposed regulatory action. The ABA-IPL Section commends the Office for its consideration of these issues and appreciates the opportunity to offer these comments. Should you have any questions or would like to discuss these issues further, please do not hesitate to contact me.

Sincerely,

George W. Jordan III
Chair, ABA Section of Intellectual Property Law