

The background of the image is a photograph of a city at dusk. On the left, several tall, modern skyscrapers with glass facades are illuminated. In the center, there is a large, ornate fountain structure. On the right, a large, illuminated archway with a dome on top is visible. The foreground is filled with colorful flower beds in shades of red, pink, and white, with a paved walkway leading through them. The sky is a deep orange and red color.

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60

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Overview of the Uniform Rapid Suspension Procedure (URS)

A Rights Protection Mechanism (RPM) developed for the
2012 New gTLD Program

Presented by ICANN staff

ICANN60 (Abu Dhabi)
28 October 2017



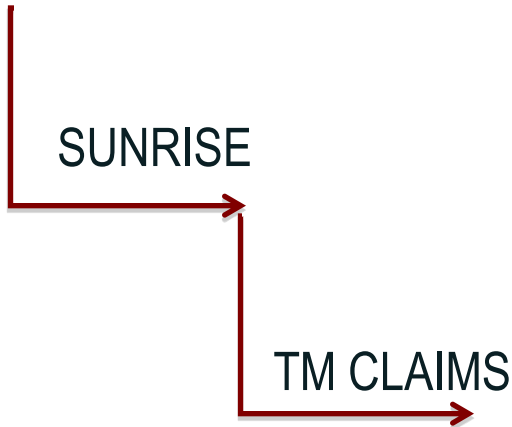
**** The RPMs designed for the New gTLD Program are intended to operate throughout the lifecycle of a gTLD ****

REGISTRY LIFECYCLE


TLD STARTUP  ONGOING OPERATIONS



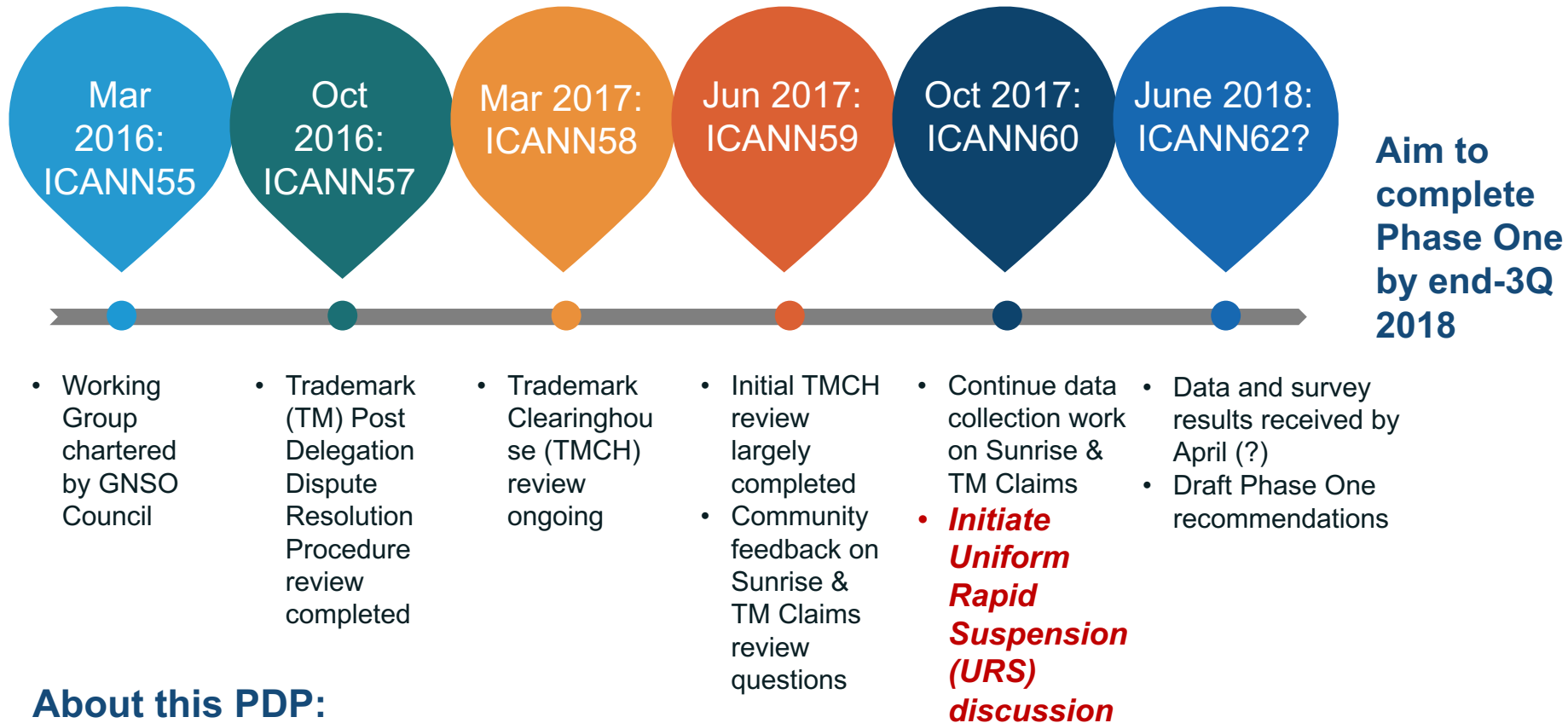
TM CLEARINGHOUSE



 UDRP
URS

 POST-DELEGATION
DISPUTE PROCESSES

RPM Review PDP: Phase One timeline



About this PDP:

PDP to review all the Rights Protection Mechanisms (RPMs) that are currently in operation

- Phase One - RPMs created for the 2012 New gTLD Program
- Phase Two - 1999 Uniform Dispute Resolution Policy (which applies to all gTLDs)

The Uniform Rapid Suspension procedure (URS)

⦿ What is it?

- ⦿ A dispute resolution procedure applicable to second level domain names registered in new gTLDs launched in the 2012 round
- ⦿ Created by the community during iterative process of developing the Applicant Guidebook for the 2012 round
 - ⦿ May 2009: Implementation Recommendations Team final report
 - ⦿ Oct 2009: Board requests GNSO Council review of proposed staff model
 - ⦿ Dec 2009: GNSO Special Trademark Issues (STI) report proposes alternative model, approved by GNSO Council
 - ⦿ Mar 2010: Board directs staff to analyze public comments on URS proposal and develop final version
- ⦿ Complements – but does not replace or supersede - the longstanding Uniform Dispute Resolution Policy (UDRP)
- ⦿ Intended to offer a lower-cost, faster path to relief for rights holders in clear-cut cases of infringement

Uniform Rapid Suspension (URS) – the Complaint (1)

⦿ What are the grounds for a complaint?

Complainant must show all three conjunctive elements:

1. **The relevant registered domain name is identical or confusingly similar to a word mark:**
 - i. for which the Complainant holds a *valid national or regional registration* and that is *in current use*; or
 - ii. that has been validated through *court proceedings*; or
 - iii. that is *specifically protected by a statute or treaty in effect at the time* the complaint is filed.
2. **AND: The Registrant has no legitimate right or interest to the domain name;**
3. **AND: The domain was registered and is being used in bad faith**

Uniform Rapid Suspension (URS) – the Complaint (2)

What does “in current use” mean in relation to nationally/regionally registered marks?

- Use can be shown by demonstrating that *evidence of use* – which can be a declaration and one specimen of current use in commerce – was submitted to, and *validated by, the Trademark Clearinghouse*
- Proof of use may also be *submitted directly* with the URS Complaint.

What does registration and use in bad faith mean?

- Non-exhaustive list of circumstances, including:
 - Registering or acquiring domain name primarily for purpose of selling to mark owner or mark owner’s competitor for consideration beyond out-of-pocket costs
 - Registrant has engaged in pattern of conduct of registering domain name to prevent mark owner from reflecting the mark in a corresponding domain name
 - Registering domain name primarily to disrupt competitor’s business
 - Using domain name in intentional attempt to attract, for commercial gain, Internet users to registrant’s web site by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the web site or of a product or service on that web site

Uniform Rapid Suspension (URS) – the Complaint (3)

- Complaint must be filed via electronic form, in English
 - Additional 500-word free-form text permitted

What happens after the Complaint is filed?

- Within 2 business days, URS provider conducts initial Administrative Review to determine that the Complaint contains all of the necessary information
 - Administrative Review is not a determination of the substantive Complaint
- Registrar must “lock” domain name within 24 hours of receiving Notice of Complaint following Administrative Review
- Provider must notify registrant within 24 hours of receiving Notice of Lock from registrar

Uniform Rapid Suspension (URS) - Notice & Response

- Notice to registrant must be “clear and understandable”
 - in English and translated into predominant language of registrant’s country/territory
- Notice must be sent via email, fax (where available) and postal mail
 - Complaint and exhibits sent electronically

What are the requirements for responding to a URS Complaint?

- Registrant (respondent) has 14 calendar days, from date of sending of Notice of Complaint, to file a Response
 - Response must not exceed 2500 words and cannot include affirmative claim for relief except for allegation of abusive Complaint
- Respondent may request limited extension
 - Up to 7 calendar days if there is good faith basis for doing so and if request is received during the Response period, after Default, or not more than thirty (30) Calendar Days after Determination
- Provider must determine, on same day Response is filed, that Response is compliant with requirements

Uniform Rapid Suspension (URS) – the Response (1)

- Note - Response can refute the claim of bad faith registration by setting out any of the following facts:
 - i. Before notice to Registrant of the dispute, Registrant's use of, or demonstrable preparations to use, the domain name in connection with a bona fide offering of goods or services; or
 - ii. Registrant (as an individual, business or other organization) has been commonly known by the domain name, even if Registrant has acquired no trademark or service mark rights; or
 - iii. Registrant is making a legitimate or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.
- Following compliance check of the Response, provider must immediately send Complaint, Response and supporting materials to qualified Examiner selected by provider

Uniform Rapid Suspension (URS) – the Response (2)

- Registrant may also assert defenses to demonstrate that the Registrant's use of the domain name is not in bad faith, e.g. by showing that:
 - i. The domain name is generic or descriptive and Registrant is making fair use of it.
 - ii. The domain name is operated solely in tribute to or in criticism of a person or business that is found by the Examiner to be fair use.
 - iii. Registrant's holding of the domain name is consistent with an express term of a written agreement entered into by the disputing Parties and that is still in effect.
 - iv. The domain name is not part of a wider pattern or series of abusive registrations because it is of a significantly different type or character to other domain names registered by the Registrant.
- Note – trading in domain names for profit, holding a large domain portfolio, and sale of traffic (e.g. parking) do not in and of themselves amount to bad faith

Uniform Rapid Suspension (URS) – Default

- Case considered in Default if no Response is received in time – however, all Default cases proceed to Examination for review on the merits of the claim
- Provider must provide Notice of Default to Complainant (email) and Registrant (email, mail and fax)
 - Registrant prohibited from changing WHOIS information and website content to argue legitimate use
- If Default Determination is in Complainant's favor, registrant has up to **6 months** from date of Notice of Default to file for de novo review
 - Registrant can request additional 6-month extension if request is filed before expiry of initial 6-month period
- Registrant may file Response after Default period
 - If filed in accordance with requirements and proper notice provided, domain to resolve to original IP address as soon as practical, but remains locked as if the Response had been filed in a timely manner
 - Filing of Response after Default is not considered an appeal

Uniform Rapid Suspension (URS) – Examination & Determination

- Examiner selected by provider must have demonstrable relevant expertise and be trained and certified in URS proceedings
 - Providers to maintain publicly available list of examiners and qualifications
- Examiners to be rotated to the extent feasible to avoid forum or examiner shopping
- Burden of Proof – ***clear and convincing*** evidence
 - Complaint dismissed if Examiner finds there is no genuine issue of material fact
 - URS not intended for use in any proceedings with open questions of fact, but only clear cases of trademark abuse
- No discovery or hearing – submitted materials form the full record
- Determination is by a single Examiner
 - must be issued in writing, and include reasons
 - Provider must publish decision on its website and inform Complainant, Registrant, Registrar & Registry Operator via email

Uniform Rapid Suspension (URS) – Remedy

- If Complainant wins, domain name is ***suspended for balance of its registration period***
 - Domain will not resolve; redirect to URS informational webpage
 - WHOIS registrant information unchanged but registry operator must ensure WHOIS shows that domain cannot be transferred, deleted or modified
- Complainant has option to extend suspension for additional year by paying the applicable fee

Uniform Rapid Suspension (URS) – Abusive Complaints

- Examiner may determine that a complaint was abusive if:
 - It was presented solely for improper purpose such as to harass, cause unnecessary delay, or needlessly increase the cost of doing business; and (i) the claims or other assertions were not warranted by any existing law or the URS standards; or (ii) the factual contentions lacked any evidentiary support
- Examiner may also find that complaint contained “deliberate material falsehood” if:
 - It contained an assertion of fact, which at the time it was made, was made with the knowledge that it was false and which, if true, would have an impact on the outcome on the URS proceeding
- If Complainant files 2 abusive complaints or 1 deliberate material falsehood: **barred for 1 year** from using URS
- If Complainant is found to have filed 2 deliberate material falsehoods: **permanently barred** from using URS
- Findings can be appealed on sole basis that Examiner abused his/her discretion or acted in capricious or arbitrary manner

Uniform Rapid Suspension (URS) – Appeals

- Either party may file an appeal ***within 14 days*** of a Determination
 - Appeal is for a de novo determination based on existing record
 - Limited right to introduce new evidence pre-dating the filing of the Complaint and material to the Determination (for additional fee)
 - Panelists have discretion to request additional statements from the parties
 - Filing an appeal does not change how the domain name resolves based on the Determination
 - Fees borne by appellant
- Response must be filed ***within 14 days*** of the filing of the appeal
- Remedies on appeal limited to affirmation or overruling of earlier Determination

Who are the URS providers?

- Three providers as of October 2017:
 - **FORUM** (February 2013); located in USA
 - **Asian Domain Name Dispute Resolution Center (ADNDRC)** (April 2013); located in Asia
 - **MFSD** (December 2015); located in Europe
- Each provider has its own Supplemental Rules, in addition to the official URS Procedure and URS Rules

Further Information

URS Procedure, Rules & Requirements:

- ⦿ URS Procedure: <https://newgtlds.icann.org/en/applicants/urs/procedure-01mar13-en.pdf>
- ⦿ URS Rules: <https://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>
- ⦿ URS Technical Requirements: <https://newgtlds.icann.org/en/applicants/urs/tech-requirements-17oct13-en.pdf>

The Review of All RPMs PDP:

- ⦿ <https://gnso.icann.org/en/group-activities/active/rpm> (PDP background information)
- ⦿ <https://community.icann.org/x/wCWAaw> (Working Group wiki space)

Engage with ICANN and the GNSO



Thank You and Questions

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