

URS Final Recommendation #9

Uniform Rapid Suspension (URS) System Checklist: Meeting the 'Clear and Convincing' Evidence in a Proceeding

NOTE: The following definitions might be helpful when reading this checklist:

- **Complainant:** the party initiating a complaint concerning a domain-name registration;
- **Registrant:** an individual or entity who registers a domain name;
- **Respondent:** the registrant or holder of a domain-name registration against which a complaint is initiated.¹

The [Uniform Rapid Suspension \(URS\) system](#) is a domain name dispute resolution mechanism used for generic top-level domains (gTLDs). It is designed to provide trademark owners with a quick and low-cost process [to suspend trademark-infringing domain names and combat cybersquatting](#).

In a URS proceeding, the burden of proof for the complainant is to demonstrate the respondent's bad faith registration and use of the domain name by "clear and convincing evidence." When a party has the burden of proving any claim or defense by clear and convincing evidence, it means that the party must present evidence that is highly and substantially more likely to be true than untrue. This standard is more rigorous to meet than the "preponderance of the evidence" standard, but it does not require proof beyond a reasonable doubt.

It's essential to make a compelling and well-organized case to meet the "clear and convincing" burden of proof in a URS proceeding. To meet the "clear and convincing" burden of proof in a URS proceeding, the complainant must present strong and compelling evidence that establishes the following three elements:

- **Bad Faith Registration:** The complainant must prove that the respondent registered the domain name in bad faith. This means showing that the respondent had the intent to profit from the complainant's trademark or engage in other malicious activities. To establish bad faith registration, the complainant can provide evidence such as:
 - Evidence of the respondent's knowledge of the complainant's trademark [and evidence of the distinctiveness, strength and notoriety of complainant's trademark](#)
 - Proof of a pattern of abusive domain name registrations by the respondent
 - Any communication or conduct by the respondent indicating bad faith
- **Bad Faith Use:** The complainant must also demonstrate that the respondent is using the domain name in bad faith. This typically involves showing that the respondent is using the domain to divert Internet traffic for commercial gain, confuse consumers, or tarnish the complainant's trademark. Evidence of bad faith use can include:
 - Use of the domain name for phishing, counterfeiting, or other fraudulent activities
 - Attempts to sell the domain name to the complainant or a competitor for an inflated price [, however a party must show that the registrant registered or](#)

¹ Note that the Registrant and Respondent are often the same.

Commented [1]: URS Final Recommendation #9: The Working Group recommends that a uniform set of educational materials be developed to provide guidance for URS parties, practitioners, and Examiners on what is needed to meet the "clear and convincing" burden of proof in a URS proceeding. Implementation Guidance: the Working Group recommends that the educational materials should be developed in the form of an administrative checklist, basic template, and/or FAQ. Specifically, the Working Group recommends that the educational materials should be developed with help from URS Providers, Practitioners, Panelists, as well as researchers/academics who study URS decisions closely. The Working Group suggests that the IRT consider the following: 1) reaching out to the broader multistakeholder community, including Providers/experts, to assist ICANN org and the IRT to develop those educational materials; 2) ICANN org should bear the cost; and 3) translations of the resulting materials should be provided.

As part of the context, The Working Group noted that two of the three URS Providers did not strongly support the issuance of an Examiners Guide, at least, to the extent that the guidance is to provide direction or examples as to the distinction between clear-cut and more difficult cases. Therefore, the Working Group recommends that the uniform set of guidance, or "educational material", should not extend to providing Examiners with specific directions as to what is, and is not, a clear-cut case. It may be preferable to develop the educational material that is more in the nature of an administrative checklist, basic template, and/or FAQ, rather than a substantive document such as WIPO's UDRP Overview.

<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-proposed-24nov20-en.pdf>

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acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant

- Use of the domain name to host a website that infringes on the complainant's rights
- **Confusing Similarity:** The complainant must establish that the domain name in question is confusingly similar to a trademark or service mark in which the complainant has rights. The registration of that trademark must predate the respondent's ownership of the domain name. This element typically requires demonstrating that the domain name is identical or highly similar to the complainant's trademark. The complainant's use of the registered trademark can be shown by:
 - Demonstrating that evidence of use – which can be a declaration and one specimen of current use – was submitted to, and validated by, the Trademark Clearinghouse (TMCH)²
 - Submitting proof of use directly with the URS Complaint

In sum, the trademark owner must prevail on all three of the elements listed above to succeed in a URS proceeding. In other words, if a complainant fails on even one element, the arbitration examiner is required to issue a decision in favor of the respondent, allowing the registrant to keep the disputed domain name. As such, the complainant must present adequate evidence to substantiate its trademark rights in the domain name and the necessary bad faith by the respondent.

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The following checklist is intended to assist URS parties, practitioners, and Examiners. It summarizes the materials that will be considered by the Examiner when determining whether the complainant has met the "clear and convincing" burden of proof:

- Copies of complainant's trademark registrations or other evidence of trademark rights
- Screenshots and other documentation showing the respondent's use of the domain name
- Evidence of the respondent's previous abusive domain name registrations or bad faith activities
- Any correspondence or communications between the parties related to the domain name

² The Trademark Clearinghouse (TMCH) is a database of verified trademark information from around the world. For additional details about the TMCH, please see: <https://www.trademark-clearinghouse.com/>

URS Final Recommendation #10

FAQs for Complainants and Respondents Regarding Uniform Rapid Suspension (URS) System Proceedings

What is the Uniform Rapid Suspension (URS) system?

The URS is a quick and low-cost administrative proceeding that a trademark holder may initiate against a registrant (an individual or entity who registers a domain name) when seeking to have an allegedly cyber-squatted domain name suspended. The URS provides a successful complainant (the party filing a complaint against the registrant of a domain name) with a single remedy of suspension for the remainder of the registration period (which may be extended by a prevailing complainant for one year at commercial rates). The URS is designed to be used for cases of clear-cut trademark infringement. The URS applies to domain names registered under a gTLD whose Registry Agreement (RA) includes this option. Some country code top-level domains (ccTLDs) allocated to specific countries – such as .cn to China, .in to India, etc. – have also adopted these dispute-resolution proceedings or variations of them. If the domain name being disputed is a ccTLD, contact the ccTLD manager for applicable information.³

COMPLAINANTS

Someone has registered a domain name in violation of my trademark. What should I do?

If you discover that someone is using your trademark in a domain name, you may wish to consider filing a URS Complaint with a dispute-resolution service provider. The Internet Corporation for Assigned Names and Numbers (ICANN) maintains a list of approved URS providers on its website. For more information, see: <https://www.icann.org/urs-en>

How do I file a URS Complaint?

Here are the steps to file a URS Complaint:

- 1. Understand Eligibility:** Ensure that you meet the eligibility requirements for filing a URS Complaint. URS complaints are typically filed by trademark holders who believe their rights are being violated through a domain name registration.
- 2. Gather Evidence:** Collect all necessary evidence to support your claim. This may include proof of your trademark rights, evidence of the infringing domain, and any other relevant documentation.
- 3. Choose a URS Provider:** Select an accredited URS provider. Factors to consider when choosing a URS provider include the provider's geographic coverage, fees, the provider's process for selecting URS panelists, experience and expertise, as well as language capabilities. For more information on the ICANN-approved dispute resolution

³ <https://www.icann.org/resources/pages/5-things-registrants-know-udrp-urs-2019-09-25-en>

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The Working Group recommends that clear, concise, easy-to-understand informational materials should be developed, translated into multiple languages, and published on the URS Providers' websites to assist Complainants and Respondents in URS proceedings. Such informational materials should include, but not be limited to the following: 1) a uniform set of basic FAQs, 2) links to Complaint, Response, and Appeal forms, and 3) reference materials that explain the URS Providers' services and practices. Context: this recommendation seeks to assist future URS Parties in URS proceedings. However, the Working Group did not have a position as to whether the uniform set of basic FAQs should be developed by the ICANN org, the three URS Providers jointly, or some other entity. - Providers could share any existing materials with the IRT as a starting point for developing the FAQs.
<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-proposed-24nov20-en.pdf>

Commented [4]: since this is now almost all gTLDs it would be helpful to specifically identify those that are not covered

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Providers authorized to conduct administrative proceedings, see:

<https://www.icann.org/urs-en>

4. **Review URS Rules:** Familiarize yourself with the URS [rules](#) and [procedures](#), as well as the supplemental [rules](#) provided by your chosen provider. Each provider may have slightly different supplemental rules, so make sure you understand the specific requirements.
5. **Prepare Complaint:** Draft your URS Complaint according to the rules and guidelines of your chosen provider. Be concise and clear in outlining your case and the reasons for your Complaint. Include all relevant evidence and documents.
6. **Pay Fees:** Pay the required fees associated with filing a URS Complaint. The fees can vary depending on the provider and the circumstances of your case.
7. **Submit Complaint:** Submit your URS Complaint to your chosen provider. They may have an online submission system or require you to send it via email or another specified method.
8. **Respond to Provider Inquiries:** Be prepared to respond to any inquiries or requests for additional information from the URS provider promptly. Failure to do so may result in your Complaint being dismissed.
9. **Await Decision:** The URS provider will review your Complaint, and the domain registrant (the alleged infringing party) will have an opportunity to respond.
10. **Receive Decision:** The URS provider will issue a decision based on the evidence and arguments presented by both parties. If the decision is in your favor, the domain in question will be suspended for the duration of the domain name registration, with the option to extend the registration period for one additional year. Once the suspension period expires, the disputed domain becomes available for registration again on a first-come, first-served basis.

RESPONDENTS

Someone has said that I have registered a domain name in violation of their trademark. What is next?

If you receive a communication from someone else claiming your domain name is infringing on their trademark, you should read the notice/communication carefully and consider consulting an attorney who deals with intellectual property law to discuss your available options. As a registrant of a domain name you have certain rights, including the right to defend yourself if your domain name registration is being disputed or challenged under the URS. This procedure was adopted to combat cybersquatting. However, if you believe you have registered a domain name for a legitimate use and in good faith, you should respond to a URS claim in a timely fashion (within two weeks) to ensure that your perspective is considered.⁴

How do I file a URS response?

Here are the steps to file a URS response:

1. **Understand Your Rights:** As the domain registrant, it's crucial to understand your [rights](#) and the URS process. Familiarize yourself with the URS [rules](#) and [procedure](#), as well as the supplemental [rules](#) provided by the URS provider handling your case.

⁴ <https://www.icann.org/resources/pages/faqs-2014-01-21-en>

2. **Gather Evidence:** Collect all necessary evidence to support your defense. This may include proof that you have a legitimate interest in the domain name, evidence that you are not using it in bad faith, and any other relevant documentation.
3. **Review URS Complaint:** Carefully review the URS Complaint filed against you by the trademark holder. Understand the specific allegations and arguments being made against your domain registration.
4. **Prepare Your Response:** Draft your URS response according to the rules and guidelines of the URS provider. Be concise and clear in addressing each allegation made in the Complaint. Include all relevant evidence and documents to support your defense.
5. **Pay Fees (if applicable):** Check if there are any fees associated with filing a URS response. Depending on the URS provider, there may be fees for responding to the Complaint.
6. **Submit Response:** Submit your URS response to the URS provider within the specified timeframe of 14 days. Follow the submission instructions provided by the URS provider, which may involve sending it via email or using an online submission system. *Note: If there is no reply in 14 days, the Complaint proceeds to default. All default cases proceed to examination for review on the merits of the claim. If the determination is in favor of the complainant, the domain name will be suspended for the remaining time in the registration period, unless the decision is reversed.*
7. **Await Decision:** After submitting your response, the URS provider will review both the complaint and your response. The process is designed to be swift and typically takes a matter of weeks.
8. **Receive Decision:** The URS provider will issue a decision based on the evidence and arguments presented by both parties. They will determine whether the domain should be suspended or remain with you.
9. **Comply with Decision:** Depending on the outcome, you must comply with the URS provider's decision. If the decision is in your favor, you will retain ownership of the domain. If the decision is against you, the domain will be suspended for the duration of the domain name registration.
10. **Seek Legal Counsel (if necessary):** If you believe the URS decision is unjust or if your case involves complex legal issues, you may want to consult with legal counsel to explore further options, such as appealing the decision.

COMPLAINANTS & RESPONDENTS

How much does it cost to file a URS Complaint?

The cost to a complainant for a URS proceeding ranges from USD\$300 - \$500.⁵

How long does it take to reach a URS decision?

The URS process typically takes less than three weeks to reach a decision.

What happens if the complainant prevails?

⁵ <https://gns0.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-proposed-24nov20-en.pdf>

If the complainant prevails, the panel will order the domain name to be suspended for the remainder of its registration period. The URS is intended to address clear-cut cases of trademark infringement and, therefore, it is a faster and less costly procedure than other available legal remedies.

What happens if the complainant prevails?

The filing of a URS Complaint will cause the domain name to be locked for the duration of the dispute process so that no unauthorized changes can be made to the domain name registration during the proceeding. The complainant has the option to extend the registration period of the domain name by one year. At the end of the registration period, the domain name is available for registration again.

What happens if the Respondent prevails?

If the prerequisites for bad faith registration and use are not met, the domain owner will retain ownership and regain full control of the domain name.

Can I appeal a URS decision?

The URS procedure also includes its own internal appeal process so that either party can appeal the decision. A losing registrant who fails to file a response can seek *de novo* review for up to 6 months (plus an additional six-month extension), and either party can seek a *de novo* review of a determination within 14 days from the date of issuance of the decision (in other words, another examiner will review the case for the first time again, as opposed to reviewing the findings of the first examiner).

Looking for more information? See below to review the URS Procedure, Rules, and URS Technical Requirements, as well as helpful links to relevant materials published on the providers' websites to assist in filing a Complaint or a response.

- [Review the URS Procedure](#)
- [Review the URS Rules](#)
- [Review the URS Technical Requirements](#)

URS Service Providers:

[National Arbitration Forum](#)

- [Supplemental Rules](#)
- [Before You File](#)
- [Instructions for Filing a URS Complaint](#)
- [File a Claim](#)
- [Instructions for Filing a URS Response](#)
- [URS Fee Schedule](#)

[ADNDRC](#)

- [Supplemental Rules](#)
- [Guidelines for Electronic Submissions](#)
- [Flow Chart of Proceedings](#)

Commented [6]: ICANN org to check with URS Providers regarding additional materials that can be made available on their website concerning items 2) links to Complaint, Response, and Appeal forms, and 3) reference materials that explain the URS Providers' services and practices.

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- [Supplemental Rules](#)
- [URS Forms](#) (Complaint, Response to Complaint, Appeal, Response to Appeal)
- [Fee Schedule](#)

TMCH Final Recommendation #3

Information for Domain Name and Potential Registrants Concerning the Trademark Clearinghouse (TMCH)

The Trademark Clearinghouse (TMCH) is a global repository for verified trademark data. Designed to meet global needs for the domain name system (DNS), the TMCH providers will: (i) verify trademark data from multiple global regions; and (ii) maintain a database with the verified trademark records.⁶ The verified data in the TMCH is used to support both Trademark Claims and Sunrise Services, required in all new gTLDs.

Sunrise Services offered by the TMCH allow trademark holders (the owners of the recorded trademark) an advance opportunity to register domain names corresponding to their marks before names are generally available to the public. Following the Sunrise period, the Trademark Claims service runs for at least the first 90 days of general registration in a new gTLD, during which anyone attempting to register a domain name matching a mark that is recorded in the TMCH will receive a notification displaying the relevant mark information. Note that some new gTLDs choose to extend the Trademark Claims notification service beyond the required 90 days.

As a potential registrant, you may come across a Trademark Claims Notice when attempting to register a domain name if a requested domain name matches a mark recorded in the TMCH. The Trademark Claims Notice explains that a company or individual claims trademark rights to the term you're trying to register, but this doesn't necessarily mean you can't register and use the domain name. The Trademark Claims Notice includes the name of the entity that's making the claim, the jurisdiction, class of goods, and the contact information for the entity.

If you want to register a domain name that matches someone else's trademark that has been recorded in the TMCH, there are several potential outcomes, depending on the domain name registrar's policies and the specific domain extension you are interested in. Here's what typically happens:

1. **Trademark Claims Notice:** If a requested domain name matches a mark recorded in the TMCH, the party trying to register the name will receive a Claims Notice of the match. The notification informs the potential registrant of the scope of the Trademark Holder's rights, that the domain they are trying to register corresponds to a trademark, and that they should be aware of potential trademark infringement. The registrar provides the Trademark Claims Notice to the potential registrant in English, as well as the language of the registrant's registration agreement. An example of a completed

Commented [7]: TMCH Final Recommendation #3: The Working Group recommends that the TMCH Validation Provider be primarily responsible for educating rights-holders, domain name registrants, and potential registrants about the services it provides. The Working Group also recommends that the IRT work with the TMCH Validation Provider and consider enhancing existing educational materials already made available by the TMCH Validation Provider, with additional attention to providing information that can benefit domain name and potential registrants. Context: The Working Group further agreed that the TMCH Validation Provider is best positioned to explain its own services and correctly identify the stakeholders it interacts with. It therefore should be primarily responsible for the educational efforts. <https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-proposed-24nov20-en.pdf>

⁶ <https://newgtlds.icann.org/en/about/trademark-clearinghouse/faqs>

Claims Notice is provided in Exhibit B of the Rights Protection Mechanism (RPM) Requirements:⁷ [link to updated RPM Requirements](#)

2. **Notification to Trademark Holder:** If the potential registrant acknowledges the Trademark Claims Notice and continues with the registration, the TMCH will send a notice to those trademark holders (the owners of the recorded trademark) with matching records in the TMCH, informing them that someone has registered the domain name.⁸
3. **Trademark Holder's Options:** If the trademark holder receives a notification and believes that the registration of the domain name infringes on their trademark rights, they may choose to take legal action, such as filing a complaint under the [Uniform Rapid Suspension \(URS\) system](#), the [Uniform Domain Name Dispute Resolution Policy \(UDRP\)](#) or pursuing other legal remedies.
4. **Registrant's Options:** If you believe that your registration of the domain name does not infringe on the trademark holder's rights, you may choose to proceed with the registration. However, be aware that this could lead to potential legal challenges and disputes in the future. For more information about ICANN's UDRP and URS, please see: <https://www.icann.org/resources/pages/5-things-registrants-know-udrp-urs-2019-09-25-en>

If you are considering registering a domain name that matches a recorded trademark, you may want to consult with legal counsel who specializes in intellectual property and domain name issues. They can provide guidance on the potential risks and legal implications associated with your registration. Additionally, you should be aware of the terms and conditions of the domain registrar you choose, as they may have specific policies related to trademark disputes and domain registrations.

Looking for more information? See below helpful links to relevant information published on the TMCH provider's website.

- [What is the Trademark Clearinghouse?](#)
- [Sunrise services](#)
- [Trademark Claims services](#)

⁷ The RPM Requirements outline operational requirements for implementation of the Sunrise and Trademark Claims processes in new gTLDs.

⁸ <https://newgtlds.icann.org/en/about/trademark-clearinghouse/faqs>

URS Final Recommendation #13: The Working Group recommends that all URS Providers require their Examiners to document their rationale in sufficient detail to explain how the decision was reached in all issued Determinations.

Implementation Guidance: As implementation guidance, the Working Group recommends that URS Providers provide their Examiners a set of basic guidance for documenting their rationale for a Determination. The purpose is to ensure consistency and precision in terminology and format as well as ensure that all steps in a proceeding are recorded. Such guidance may take the form of an administrative checklist or template of minimum elements that need to be included for a Determination; specifically and at a minimum, that the relevant facts are spelled out and each of the three URS elements listed in the original language of the Determination are addressed in the Determination.

As part of the context, some Working Group members cautioned against micromanaging and imposing burdensome guidance on panelists, who have limited time and compensation in handling URS cases. The Working Group agreed that Providers should have the discretion to provide their Examiners the basic guidance in a suitable form, so long as such guidance requires the Examiners to document their rationale for a Determination and at a minimum, to spell out relevant facts and address each of the three URS elements listed in the original language of the Determination.

<https://qns0.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-proposed-24nov20-en.pdf>

Commented [8]: This recommendation will be passed on to Providers.