

The Uniform Rapid Suspension Procedure (URS) Rules

**GNSO Policy Development Process Working Group –
Review of All Rights Protection Mechanisms (RPMs) in All
gTLDs**

**Staff Presentation & Working Group Discussion with
Doug Isenberg & John Berryhill**

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Doug Isenberg is an attorney in Atlanta who has been practicing in the area of domain name disputes since 1996, before the UDRP or even ICANN existed, and certainly long before the URS was created. He frequently represents parties in proceedings under the UDRP, the URS and other domain name dispute policies. In 2009, he filed what remains today as the largest UDRP complaint, resulting in a decision ordering the transfer of 1,519 domain names to a single client. Doug also serves as a domain name panelist for WIPO; the Forum; the Czech Arbitration Court; and the British Columbia International Commercial Arbitration Centre. During the new gTLD process, Doug both filed and defended objections to applications. He is a member of the IPC, INTA and the Intellectual Property Owners Association and previously served as a member of the ADL Anti-Cyberhate Working Group.



John Berryhill accidentally became an intellectual property attorney while pursuing a career after obtaining a doctorate in electrical engineering, and found out he liked writing about engineering a lot more than actually doing it. He has been involved in domain disputes since 1997, under the old Network Solutions policy, and has since represented both complainants and respondents in over 300 UDRP disputes at WIPO, NAF, ADNDRC and the Czech Arbitration Court. John was the primary author of the ICM Rapid Evaluation Service which is administered by the NAF for the .xxx TLD and operates in a similar manner to the URS, with the exception of non-publication of decisions. John has also represented parties under a variety of domain dispute policies including the .US Nexus dispute policy, the Nominet Dispute Resolution service in .uk, the .eu DRP, and several other TLD specific dispute policies, as well as new gTLD application disputes. John has served as an officer of the ICANN Registrar Stakeholder Group, several ICANN working groups and served on the the ICANN Nominating Committee.

Preliminary Notes on the URS Rules

- ⦿ URS Rules became effective as of **28 June 2013**
- ⦿ Applicable to all proceedings under the Uniform Rapid Suspension Procedure (URS) in relation to domains registered in a gTLD launched under the 2012 **New gTLD Program** (i.e. delegated into root zone after 1 January 2013)**
 - URS complaints cannot be filed against an open or active URS or Uniform Dispute Resolution Policy (UDRP) case
- ⦿ The Rules, along with each URS Provider's Supplemental Rules, explain and enhance the URS Procedure
 - Provider's Supplemental Rules contain provisions for contacting Respondents concerning domains registered under privacy/proxy services
 - If there is a conflict, the URS Rules supersede the Supplemental Rules

*** Some "legacy" gTLD registry operators have voluntarily adopted the URS, and a similar procedure has also been adopted by some ccTLD operators*

Filing a Complaint (1/2)

- ⦿ Complaint must be filed via electronic form, in English
- ⦿ Complaint must be accompanied by requisite filing fee
 - If filing fee (set out in Provider Supplemental Rules) is not paid within 1 business day, complaint is automatically dismissed
- ⦿ Complaint must state:
 - Name, email, address, phone and fax number of **Complainant** and any authorized representative
 - Name of **Respondent** and all “relevant contact information from the Whois record as well as all information known to Complainant regarding how to contact Respondent or any representative of Respondent ... in sufficient detail to allow the Provider to notify the Respondent”
 - **Domain name(s)** at issue, copy of currently available Whois information and, if available, the offending portion of the website content associated with each domain name
 - **Trademark(s)** or service mark(s) on which the complaint is based
 - The **goods or services** for which the mark is used including evidence of use (can be a declaration and one specimen of current use in commerce – submitted directly or with a SMD from the Trademark Clearinghouse (TMCH))
 - Which **elements of the URS Procedure** are being allegedly violated
 - Identify **any other legal proceedings** commenced or terminated in connection with any of the domain name(s) at issue

Filing a Complaint (2/2)

- ⦿ Complainant must agree, for the purpose of any challenge to a URS Determination, to the jurisdiction of the courts in at least one **Mutual Jurisdiction**
 - Definition of Mutual Jurisdiction: “a court jurisdiction at the location of either (a) the principal office of the Registrar or (b) the domain-name holder's address as shown for the registration of the domain name in Registrar's Whois database at the time the complaint is submitted to the Provider.”
- ⦿ Complainant must agree to **waive** claims against Registry, Registrar, ICANN and (except in cases of deliberate wrongdoing) the Provider and Examiner
 - i.e. claim is solely against the domain name holder
- ⦿ Complainant must **certify** that complaint is, to the best of Complainant's knowledge complete and accurate, not being presented for any improper purpose (e.g. to harass), and that the assertions are warranted under applicable law
- ⦿ Complaint form permits an additional **500-word optional** explanatory statement

Notification of Respondent regarding a Complaint (1/1)

⦿ Under URS Procedure:

- Provider must conduct Administrative Review within **2 business days** of receiving complaint
- Provider must **notify Registry Operator** on completion of Administrative Review (URS Rules: notice must include copy of Complaint)
- Registry Operator must **“lock” domain name within 24 hours** of receiving notice
- Provider must notify Registrant **within 24 hours of receiving Notice of Lock** from Registry Operator
- Notice to Registrant must be **“clear and understandable”**
- Notice to Registrant must be sent by **postal mail, and by email and fax** (where available) (but Complaint can be sent electronically)
- Provider must also **notify Registrar** of record

⦿ Under URS Rules:

- Notice to Registrant **must be in English and must be translated** into “predominant language used in the registrant’s country or territory, as determined by the country(ies) listed in the Whois record when the Complaint is filed”
- Provider must “employ **reasonably available means calculated to achieve actual notice**”.

Filing a Response to a Complaint (1/2)

⦿ Under URS Procedure:

- Respondent initially has **14 calendar days** from date of Notice of Complaint to respond
- **Limited extension** (duration of not more than 7 calendar days) may be granted on request, if there is good faith basis and if request for extension is filed:
 - during the Response period, or
 - after Default, or
 - not more that 30 calendar days after Determination.
- No **Response Fee** if Complaint is for fewer than 15 disputed domains
- Response Fee required if Complaint is for 15 or more domains (refundable to prevailing party)
- Response Fee also required if Response is filed more than 30 calendar days after a Default Determination (non-refundable)

⦿ Under URS Rules:

- Request to extend Response period to be filed in accordance with Provider's Supplemental Rules
- Response period can also be extended by stipulation of the parties and approved by Provider

Filing a Response to a Complaint (2/2)

- Under URS Procedure:
 - Response (excluding attachments) not to exceed **2500 words**
- Under URS Rules, Response must include:
 - Name, email, postal address, phone and fax number of Respondent and any authorized representative
 - Specific responses to each of the grounds stated by Complainant
 - Any defenses that contradict Complainant's claims
 - Any request for a finding of abuse of URS Procedure (no other affirmative claims for relief permitted)
 - Identification of any legal proceedings commenced or terminated in relation to domain(s) at issue
 - The same waiver of claims against Registry Operator, Registrar, ICANN and the Examiner, and the same certification of accuracy and no improper purpose as required of the Complainant
- Response must be accompanied by any required Response Fee
 - Response will not be considered, and may be treated as a Default, if fee not paid within 1 business day
- **If no response is submitted, Complaint proceeds to Default Determination** (in absence of exceptional circumstances)
 - Responses not normally accepted after domain name has expired (unless Supplemental Rules provide for justified exception)

Rules regarding Communications and Languages (1/1)

- Communications to Complainant or Respondent:
 - Made electronically unless specified otherwise in the Rules
- Communications to Provider:
 - Via means and manner specified by Provider's Supplemental Rules
- Time/Date:
 - Electronic: on date of sending
 - Fax/Telecopy: date shown on confirmation of transmission
 - Post/Courier: date marked on receipt
 - Provider to be notified if sending party receives notice of non-receipt – further proceedings to be conducted as directed by Provider
- Languages:
 - Complaint in English
 - Response in English or one of the languages used for providing Respondent with Notice of Complaint
 - Examiner must be fluent in English and in Respondent's language
 - Examiner has sole discretion to decide which language in which to issue Determination (but if there is no Response, language will be English)

Examination of Complaint (1/1)

- Provider must maintain **public list** of all Examiners and their qualifications
- Examiners must be **impartial and independent**:
 - Must disclose any circumstances leading to justifiable doubt before accepting appointment
 - If new circumstances arise, must disclose promptly – Provider has discretion to appoint new Examiner
- Parties **may not communicate unilaterally** with Examiner:
 - Any communications must be in accordance with Provider’s Supplemental Rules
- Powers of Examiner:
 - Treat parties equally in all cases, to the extent feasible; conduct proceedings “in a manner it considers appropriate” in accordance with the Procedure and Rules; and determine “admissibility, relevance, materiality and weight” of the evidence
 - If 1 or more domains registered with privacy/proxy service, or if nominal registrant changes after Complaint is filed, Examiner has sole discretion to determine if Respondents are sufficiently related and to dismiss the Complaint with respect to any unrelated domain names
 - Where Response was submitted but deemed non-compliant by Provider (other than for non-payment), Examiner may “make any reasonable inferences from the inadequacy of the Response”

Issuing the Determination (1/2)

- Proceeding deemed in Default but nevertheless proceeds to Determination if no Response is submitted:
 - From the Rules: Provider must notify Registry Operator that Registrant is prohibited from changing content and Whois information
 - From the Procedure:
 - Provider must provide Notice of Default to Complainant (email) and Registrant (email, mail and fax)
- URS Procedure specifies number of Examiners, burden of proof and timeline for decision:
 - Single, trained Examiner (with rotation); case decided on “clear and convincing” basis;
 - Determination period commences immediately upon expiration of Response period or submission of the Response, whichever is earlier
 - Determination on an **expedited basis**: within 3 business days from when Examination began but no later than 5 days after the Response is filed (absent extraordinary circumstances)

Issuing the Determination (2/2)

- Proceeding deemed in Default but nevertheless proceeds to Determination if no Response is submitted:
 - From the Rules: Provider must notify Registry Operator that Registrant is prohibited from changing content and Whois information
 - From the Procedure: Provider must provide Notice of Default to Complainant (email) and Registrant (email, mail and fax)
- Examiner must provide a **written Determination in all cases** (e.g. whether Default, Final, Appeal):
 - Examiner to decide based on the Procedure, Rules and “any rules and principles of law that it deems applicable”
 - Determination to state reasons for the decision; length to be based on Provider’s guidelines
 - If Examiner finds that Complaint was filed to harass the registrant or in bad faith, Examiner to declare that Complaint was filed in bad faith and constitutes abuse of process
 - For Default cases, Examiner may include additional written reasoning
- Provider must publish Determinations and the dates of implementation on a publicly accessible web site

Handling Final Determinations following a Response in a Default Case (1/1)

- Responses and Appeals for Default Cases:
 - Under the Procedure: Respondent may file Response up to 6 months after date of Notice of Default (with further 6 months' extension possible):
 - Under the Rules: Provider must notify Registry Operator; Registry Operator must modify nameservers so that domain name(s) resolve as soon as practical, but remain locked as if the Response had been filed in a timely manner before Default
 - Note: Respondent may also file Appeal against the Default Determination (pursuant to applicable deadlines for Appeals)
- Where a Final Determination changes a Default Determination:
 - Final Determination replaces the Default Determination on the Provider's website, unless Examiner determines both shall be made available and so states in its Final Determination
- Where a Final Determination upholds a Default Determination:
 - Examiner has discretion as to whether to publish them together or have the Final Determination replace the Default Determination

Remedies (1/1)

- Specified under the Procedure and confirmed by the Rules:
 - Suspension for balance of registration period
 - Complainant has option to extend suspension for additional year by paying the applicable fee (URS Rules clarifies it is for Complainant to contact the Registry Operator)
- Where Determination is in Complainant's favor:
 - Domain will not resolve; redirects to URS informational webpage
 - WHOIS registrant information unchanged (but registry operator must ensure WHOIS shows that domain cannot be transferred, deleted or modified)
- Where Determination is in Respondent's favor:
 - Provider to notify Registry Operator to unlock the domain name(s) and return full control to Registrant

Availability of Other Proceedings; Termination of URS Proceeding (1/1)

- URS Determination does not affect availability of remedies under UDRP or judicial proceedings; and does not prejudice either party in UDRP or judicial proceedings

Note URS Rules:

- If legal proceedings commenced prior to or during URS proceedings, **Examiner has discretion to terminate URS or proceed** with Determination
- Party initiating proceedings must inform Provider and the Examiner
- Before Determination, Examiner may terminate URS proceeding where:
 - Parties agree on settlement before Determination; or
 - It becomes "unnecessary or impossible to continue the URS proceeding for any reason", unless "justifiable grounds for objection" are raised within a period of time to be determined by Examiner

Appeals from Determinations (1/2)

- ◎ URS Procedure specifies **14 days** from Determination to file an Appeal for a de novo review, and **14 days** after filing to respond
 - If Appellant introduces new additional evidence (as may be permitted), Appellee has right to respond without any additional fees, within time period specified by Provider's Supplemental Rules
 - Party initiating proceedings must inform Provider and the Examiner
- ◎ Appeals concerning domain names that are **expired at the time of Appeal are rejected**
 - Exception: Where Appeal is in relation to a finding of abuse or material falsehood and Appellant alleges that Examiner abused its discretion or acted in an arbitrary or capricious manner
- ◎ If appeal is from Determination in Respondent's favor:
 - Provider must notify Registry Operator to **re-lock** domain (but domain will continue to resolve)

Appeals from Determinations (2/2)

- **Remedies on Appeal are limited to:**

- Affirmation of Final Determination and Remedy ordered (e.g. if domain is suspended, it remains suspended); or
- Overruling of Final Determination and Remedy ordered (e.g. if domain is suspended, Registry Operator must unlock name; if domain is with the Registrant, Provider must follow steps to suspend); or
- Overruling an Examiner's finding that a Complaint was abusive or contained a deliberate material falsehood (Appeal Panel may replace original Determination with appropriate changes)

- **Publication of Appeal Determination:**

- Examiner or Appeal Panel has sole discretion to require Appeal Determination to be published either instead of, or together with, the Default or Final Determination it has overruled or upheld

Handling of Abusive Complaints (1/1)

- URS Procedure specifies what constitutes “abuse” and “deliberate material falsehood” as well as accompanying penalties

URS Rules specify that:

- Examiner may find abuse or deliberate material falsehood of its own accord
- Respondent may allege abuse or deliberate material falsehood in its Response to a Complaint
- Where Examiner finds abuse, this must be stated in the Determination together with “**sufficient rationale to justify the finding** to any potential Appeal Panel”

- URS Procedure requires Providers to track barred parties

URS Rules specify that:

- Providers must submit information on an abuse case to an abuse case database within 1 business day
- Database must be publicly accessible to all Providers
- When a Provider receives a Complaint, it must verify it against the abuse case database and dismiss it if it is not admissible as a result

The Providers and Further Information

Three URS providers as of October 2017:

- **FORUM** (February 2013); located in USA: <http://www.adrforum.com/URS>
- **Asian Domain Name Dispute Resolution Center** (ADNDRC) (April 2013); located in Asia: <https://www.adndrc.org/mten/klen/URS.php?st=4>
- **MFSD** (December 2015); located in Europe: <https://urs.mfsd.it/new-gtlds-urs>
- Each provider has its own Supplemental Rules, in addition to the official URS Procedure and URS Rules

General information on the URS:

- <https://www.icann.org/resources/pages/urs-2014-01-09-en>

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>