

# Final Consolidated List of URS Provider Questions (4 May 2018)

## Communications

1. What percentage, if any, of communications to Complainants and Registrants are done in ways other than electronically/via the Internet? What alternative means are utilized?

MFSD: 1. to the **Complainant** all communications (100%) are sent by e-mail.

2. To the **Respondent**:

- all communications (100%) are sent by e-mail to all e-mail addresses available in Whois, to additional e-mail addresses provided by the Complainant in the Complaint and by the Registry Operator in response to the Notice of Lock (if different from the ones shown in Whois) and to e-mail addresses (if any) shown at the website to which the domain name resolves;

- the Notice of Complaint and the Notice of Default are sent by e-mail to all e-mail addresses available in Whois, to additional e-mail addresses provided by the Complainant in the Complaint and by the Registry Operator in response to the Notice of Lock (if different from the ones shown in Whois) and to e-mail addresses (if any) shown at the website to which the domain name resolves, as well as by courier (except for P.O. Box addresses to which couriers do not deliver) or registered letter with return receipt and by fax (if fax no. is available in Whois).

2. Which of the two cited methods in URS Rule 2(a) do you use to deliver the Notice of Complaint, including both the hard and electronic copy? What mechanism(s) do you have in place in either method to track actual delivery to or receipt by the Respondent? Do you utilize any means to confirm receipt?

MFSD: an **electronic copy** of the Notice of Complaint is sent to the Respondent by e-mail to all e-mail addresses shown in Whois, to additional e-mail addresses provided by the Complainant in the Complaint and by the Registry Operator in response to the Notice of Lock (if different from the ones shown in Whois) and to e-mail addresses (if any) shown at the website to which the domain name resolves; a **hard copy** is sent by courier (except for P.O. Box addresses to which couriers do not deliver) or registered letter with return receipt and by fax (if fax no. is available in Whois).

The **methods of tracking** actual delivery to or receipt by the Respondent are:

- return receipt for e-mails
- online tracking available at couriers' website for couriers
- return receipt for registered letters
- transmission verification report for fax.

The Complaint and its annexures are only sent as **electronic copy** by e-mail to all e-mail addresses resulting from Whois, to additional e-mail addresses provided by the Complainant in the Complaint and by the Registry Operator in response to the Notice of Lock (if different from the ones shown in Whois) and to e-mail addresses (if any) shown at the website to which the domain name resolves.

The Notice of Complaint explains that if the Respondent would like to receive the Complaint, including annexes, and other communications in the administrative proceeding to an **alternate** e-mail address, he/she is requested to contact MFSD and provide such e-mail address.

If the Notice of Complaint is sent also in language different from English (pursuant to paragraph 4(b) of the URS Rules) an electronic and a hard copy of the model Response translated in such language is also sent to the Respondent along with the Notice of Complaint.

- *URS Rule 2(a): When forwarding a Complaint, including any annexes, electronically to the Respondent, it shall be the Provider's responsibility to employ reasonably available means calculated to achieve actual notice to Respondent. Achieving actual notice, or employing the following measures to do so, shall discharge this responsibility:*
    - (i) *sending the Notice of Complaint to all email, postal-mail and facsimile addresses shown in the domain name's registration data in the Whois database for the registered domain-name holder, the technical contact, and the administrative contact, as well as to any email addresses for the Respondent provided by the Complainant; and*
    - (ii) *providing the Complaint, including any annexes, in electronic form, either via email to email addresses mentioned in (i) above, or via an email link to an online platform requiring users to create an account.*
3. Do you conform to the communications timeline in accordance with URS Rule 2(g)?

MFSD: yes.

- *URS Rule 2(g): Except as otherwise provided in these Rules, all time periods calculated under these Rules to begin when a communication is made shall begin to run on the earliest date that the communication is deemed to have been made in accordance with Rule 2(f).*
  - *Note also URS Rule 2(f): Except as otherwise provided in these Rules, or decided by an Examiner, all communications provided for under these Rules shall be deemed to have been made: (i) if via the Internet, on the date that the communication was transmitted, provided that the date of transmission is verifiable; or, where applicable; (ii) if delivered by telecopy or facsimile transmission, on the date shown on the confirmation of transmission; or (iii) if by postal or courier service, on the date marked on the receipt.*
4. Do you receive notifications from Registry Operators via email regarding the completion of URS actions on a domain name?

MFSD: yes, we receive notifications from Registry Operators regarding the completion of the URS Lock and the implementation of the URS Determination (URS Suspension or URS Rollback) regularly.

In very few cases we did not receive notifications regarding the completion of the URS actions within 24 hours from our communication. In those cases we sent reminder e-mails to seek confirmation from the Registry Operators of the completion of the requested URS actions.

URS Providers have also the possibility to submit a report to ICANN for the lack of completion of the requested URS action on the domain name by the Registry Operator at <https://forms.icann.org/en/resources/compliance/registries/urs/form>.

MFSD have submitted very few reports to ICANN after having attempted several times to receive notifications from the Registry Operator on the completion of the requested URS actions.

5. Do you receive notification via email from Registry Operators:

A) If a URS Locked or URS Suspended domain name has been either deleted or purged?

MFSD: no, not any notification of deleted or purged URS Suspended domain name.

B) If the registration of a URS Locked or URS Suspended domain name has expired?

MFSD: no, not any notification of expired URS Locked or URS Suspended domain name.

C) If a URS Suspended domain name has been renewed for an additional year?

MFSD: no, not any notification of renewal of URS Suspended domain name.

6. Do you receive information from ICANN with regard to the point of contact of the Back End Registry Operator appointed by a Registry Operator?

MFSD: since its approval as URS Provider MFSD has been provided with credentials to access ICANN's repository and download the Registry Operators' contacts periodically. Registrars' contacts are sent to MFSD monthly by e-mail.

7. Have you experienced difficulties in communicating with Registry Operators in respect of their role in any part of a URS proceeding? If yes, please elaborate.

MFSD: communications with Registry Operators are smooth, cordial and collaborative.

In very few cases we faced the following difficulties:

1. MFSD was appointed as URS Provider in December 2015. In 2016 some Registry Operators were not aware about MFSD's appointment as URS Provider and it was necessary to exchange several e-mails, before obtaining the requested actions (Lock / Suspension). After the start-up phase, this was not an issue any more.

2. Some Registry Operators communicate from e-mail addresses different from the contacts present in ICANN's repository. In that case, it is not possible to send them encrypted notifications signed with the PGP key.

3. In few cases we had to send reminder e-mails to obtain the activation of the URS Lock and in 1 case it was necessary to submit a report to ICANN for the lack of response from the Registry Operator to the Notice of Complaint (<https://forms.icann.org/en/resources/compliance/registries/urs/form>).

4. In few cases we had to send reminder e-mails to obtain the activation of the URS Suspension and in 2 cases it was necessary to submit a report to ICANN for the lack of implementation (suspension) by the Registry Operator (<https://forms.icann.org/en/resources/compliance/registries/urs/form>).

## The Complaint

1. Do you accept Complaints that do not contain all the elements required in URS Rule 3(b)? Please provide your online forms for Complaint filing and identify any deviation from URS Rule 3(b).

MFSD: no. Our online Complaint form is accessible at <https://urs.mfsd.it/urs-forms-complaint/new-dispute> upon creation of an account (please see sample enclosed hereto).

The form consists of 11 sections (I-X plus signature) subdivided in further sub-sections:

I. Introduction (only informative, no data to be filled in)

II. The Parties divided into:

A. The Complainant(s) and The Complainant's Authorized Representative

- B. The Respondent(s)
- III. The Domain name(s), Registry Operator(s) and Registrar(s)
- IV. Factual and Legal Grounds divided into:
  - A. The trademark(s) or service mark(s) on which the Complainat is based
  - B. Three requirements of the URS Procedure 1.2.6
    - 1. The domain name(s) is(are) identical or confusingly similar to a word mark with 3 tick boxes
    - 2. The Respondent has no legitimate right or interest to the domain name(s) with 1 tick box
    - 3. The domain name(s) was/were registered and is/are being used in bad faith with 5 tick boxes
  - C. Explanatory Statement with box with 500-word limit
- V. Remedies Requested
- VI. Other Legal Proceedings
- VII. Mutual Jurisdiction with 2 tick boxes
- VIII. Payment with 1 tick box
- IX. Certification pursuant to URS Rules 3(b)(x)
- X. List of Annexes
- Signature

Starting from 25 May 2018, effective date of the GDPR and the Temporary Specification for gTLD Registration Data approved by ICANN's Board on 17 May 2018 (<https://www.icann.org/resources/pages/gtld-registration-data-specs-en>), MFSD accepts URS Complaints even if Complainant does not provide the contact details of the Respondent ("Doe Complaint"), because they are not available in the publicly accessible Whois or not otherwise known to the Complainant. Before 25 May 2018 in the online Complaint form the fields of Section II.B concerning the Respondent's data were mandatory and the online dispute management system did not allow to proceed with the payment of the fees and the submission of the Complaint without such data (error message). Starting from 25 May 2018 those fields (Section II.B) were rendered not mandatory and the online dispute management system allows proceeding with the payment of the fees and the submission of the Complaint even if such data is not filled in.

We also hereto enclose the Checklist used for the Administrative Review of the URS Complaint.

2. Do you ask for any additional information in the Complaint beyond what is required in the URS Rules? If so, please provide the relevant provision(s) of your Supplemental Rules.

MFSD: no. Please see our online Complaint form at <https://urs.mfsd.it/urs-forms-complaint/new-dispute> (a sample is also enclosed hereto).

3. A) (To Forum) How does Forum handle the submission (through its online Complaint filing site) of a relevant SMD proof of use from the TMCH, which is expressly provided for in URS Rule 3(b)(v)? Specifically, the RPM WG understands that the applicable categories of goods and services relating to the trademark is encoded in

the SMD file. Are you able to access and read this encoded information? What part(s) of the information in the SMD file are made available to Examiners, Complainants and Respondents for the URS proceeding?

B) (To ADNDRC) Does ADNDRC's electronic Complaint form (Form C\_URS) also allow the uploading of SMD files in the same manner as MFSD?

In answering this question please note the following:

- *An SMD file is typically a file with the extension .smd and such format is not expressly provided for under Forum's Annex A. By comparison, MFSD's Supplementary Rule 3 expressly specifies the acceptance of .smd files as an annex.*
  - *URS Rule 3(b)(v): Specify the trademark(s) or service mark(s) on which the Complaint is based and the goods or services with which the mark is used including evidence of use – which can be a declaration and a specimen of current use in commerce – submitted directly or by including a relevant SMD (Signed Mark Data) from the Trademark Clearinghouse.*
4. What other circumstances – not included in the non-exclusive list in the URS Procedure 1.2.6.3 – have led your Examiners to determine that the domain name was registered and was being used in bad faith? Have there been cases where your Examiners have not expressly cited a circumstance as the basis of their finding of demonstrable bad faith registration and use? Here is the relevant provision in the URS Procedure:

MFSD: Examiners take into consideration the totality of the circumstances in each case. Some Examiners have found that, in addition to the circumstances expressly mentioned in paragraph 1.2.6.3 of the URS Procedure, the followings were also to be considered as *indicia* of bad faith registration and use:

- the Respondent's use of false contact details (Dispute no. 30AF44A1 sergiorossiooutlet.store; Dispute no. 800AA499 sergiorossie.store; Dispute no. 837FDF94 royalmail.space; Dispute no. 31D42E70 royalmail.xyz);
- the Respondent's failure to provide any evidence of *bona fide* registration and use in its Response (Dispute no. 6DDAB859 le-clerc.shop and leclerc.shop);
- the Respondent's failure to submit any Response and provide any evidence of *bona fide* registration and use (Dispute no. D70B9442 eleclerc.club);
- the fact that Respondent has changed the website content associated with the disputed domain name after having received the letter of Complainant's lawyer and redirected the domain name to another website (Dispute no. F52833A5 orangemoney.cash);
- the Respondent's passive holding of the domain name in combination with the fact that the Respondent has registered a vast number of domain names incorporating well-known trademarks under the same new gTLD (Dispute no. 429EC571 reinhausen.international);
- the Respondent's constructive knowledge of the Complainant's trademarks (Dispute no. 7B10562D flossy.shoes; Dispute no. 8422F178 e-leclerc.paris);
- adult content present at the website associated with the disputed domain name

(Dispute no. 31D42E70 royalmail.xyz);

- the Respondent's failure to reply to cease and desist letters of the Complainant (Dispute no. A75D6EBE royalmail.london).

There are **no** cases where Examiners have not expressly cited a circumstance as the basis of their finding of demonstrable bad faith registration and use.

- *URS Procedure 1.2.6.3: that the domain was registered and is being used in bad faith.*

*A non-exclusive list of circumstances that demonstrate bad faith registration and use by the Registrant include:*

- a. Registrant has registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of documented out-of pocket costs directly related to the domain name; or*
- b. Registrant has registered the domain name in order to prevent the trademark holder or service mark from reflecting the mark in a corresponding domain name, provided that Registrant has engaged in a pattern of such conduct; or*
- c. Registrant registered the domain name primarily for the purpose of disrupting the business of a competitor; or*
- d. By using the domain name Registrant has intentionally attempted to attract for commercial gain, Internet users to Registrant's web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of Registrant's web site or location or of a product or service on that web site or location.*

5. (To ADNDRC) Has any Complainant expressed any difficulty with regard to the 500-word limit set for the Complaint?
  
6. (To ADNDRC and Forum) Do you check to determine whether a domain that is cited in a new URS Complaint is already subject to an open and active URS or UDRP proceeding? If so, how do you find this information?

MFSD: during the Administrative Review of the Complaint (please see Checklist used for the Administrative Review enclosed hereto) we verify the Complainant's declaration in Section VI of the online Complaint form and we carry out manually an online research at the URS and UDRP Providers' website for URS and UDRP cases. For URS cases at:

<http://www.adrforum.com/SearchDecisions>

[http://www.adndrc.org/mten/URS\\_Decisions.php?st=4](http://www.adndrc.org/mten/URS_Decisions.php?st=4)

For UDRP cases at:

<http://www.adrforum.com/SearchDecisions>

[http://www.adndrc.org/mten/UDRP\\_Decisions.php](http://www.adndrc.org/mten/UDRP_Decisions.php)

<http://www.wipo.int/amc/en/domains/search/>

<http://udrp.adr.eu/adr/decisions/index.php>

7. Do you check to determine whether a domain name subject to a URS Complaint is also involved in an active court case in the event that a Respondent does not provide a Response? If so, how do you find this information?

MFSD: no, we rely on the Complainant's declaration in Section VI of the online Complaint form. On the other hand, in several jurisdictions it would be impossible to search and find online information about active court cases.

Please note that paragraph 15 of MFSD's Supplemental Rules provides that: "If a party is aware of any proceedings that have been commenced or terminated in connection with or relating to the domain name subject of URS administrative proceeding, **the party shall promptly notify MFSD**, showing official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) of such proceedings.

The Examiner might decide, at its sole discretion, whether to suspend or terminate the URS proceeding or to proceed to the Determination.

If a party initiates any legal proceedings during the pendency of an URS administrative proceeding or after the issuance of the determination in connection with or relating to the domain name subject of URS administrative proceeding, **the party shall promptly notify MFSD**, showing official documentation (such as a copy of a complaint, file stamped by the clerk of the court) of the legal proceedings" (emphasis added by us).

No such notification has ever been received by MFSD.

8. Have you accepted any Complaints that multiple related companies brought against a single domain name Registrant?

MFSD: no cases of multiple related companies bringing a Complaint against a single domain name Registrant.

9. Have you accepted any Complaints that were filed against multiple related Registrants in the same filing?

MFSD: no cases of Complaint filed against multiple related Registrants.

10. How many Complaints have you accepted that listed fifteen or more disputed domain names registered by the same Registrant?

MFSD: no cases listing fifteen or more disputed domain names registered by the same Registrant.

11. (To Forum and MFSD) How many Complaints have been dismissed as a direct result of the incorrect domain name Registrant being named in the Complaint, regardless of whether the domain name(s) registered were subject to a privacy or proxy service? Are you able to determine whether the mistake was due to Complainant error, or a WHOIS inaccuracy? If so, please share with us your analysis.

MFSD: no cases of dismissal as a direct result of the incorrect domain name Registrant being named in the Complaint. Registrants were correctly named in all Complaints.

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## Fees

1. Do you have any opinion regarding the design and feasibility of a "loser pays" model that could levy additional costs against a losing party to a URS?

MFSD: URS fees are relatively low and are wholly advanced by the Complainant (except for the case of Response to Complaint involving 15 or more domain names - Response Fee or Late Response - Re-examination Fee). Recovering URS fees in multiple jurisdictions through enforcement proceedings if the losing party (Respondent) does not pay voluntarily would be burdensome for the Parties (Complainant) and/or the URS Provider either in terms of time, costs and complexity. Moreover, some of the domain names are registered with privacy or proxy service without the possibility for the Complainant and the URS Provider to obtain underlying registration data of the registrant.

Respondents usually do not file the Response to the Complaint and even if they file the Response they are not required to provide any banking (credit card) information (except for the case of filing Response to Complaint involving 15 or more domain names, but in that case the Rules already provide for a kind of "loser pays" model, i.e. the Response Fee is refunded to the prevailing party and the Re-examination Fee - non refundable). This is an additional difficulty for the Complainant and/or the URS Provider in recovering the URS fees if Respondent loses. On the other hand, making mandatory (as policy requirement) to provide credit card details when submitting a Response (cases involving less than 15 or more domain names) might be a deterrent to filing a Response.

Even if it would be a very complex process the only solution for collecting the URS fees from the losing Respondents would be through the Registrars.

2. Among the Complaints you received that each listed 15 or more disputed domain names registered by the same Registrant, how many Respondents filed a Responses and paid the required Response Fee?

MFSD: no cases of Complaints listing 15 or more disputed domain names registered by the same Registrant.

3. Have you received feedback on whether your fees structure has been a major deterrent to the filing of Complaints or Responses?

MFSD: no, the major deterrent to the filing of Complaints or Response is not the URS fee structure. The URS fees are relatively low.

Complainants informally expressed that, starting from the effective date of the GDPR of 25 May 2018, the major deterrent for Complainants to the filing of URS Complaint

could be the difficulties to access to Whois data. Although the provisions of Appendix D paragraph 2 of the Temporary Specification for gTLD Registration Data adopted by ICANN on 17 May 2018 ("Complainant's complaint will not be deemed defective for failure to provide the name of the Respondent (Registered Name Holder) and all other relevant contact information required by Section 3 of the URS Rules if such contact information of the Respondent is not available in registration data publicly available in RDDS or not otherwise known to Complainant. In such an event, Complainant may file a "Doe" complaint and the Examiner shall provide the relevant contact details of the Registered Name Holder after being presented with a "Doe" complaint"), the Complainants will hardly file Doe Complaints, since the strict burden of proof of clear and convincing evidence on all the three URS elements is on them. Without access to the registration data before the submission of the Complaint and without the possibility (there is no policy provision) to amend the Complaint after the submission, they find it gruelling to meet such burden of proof (especially with reference to the second and third URS element). Their question is: how can we prove that the registrant lacks legitimate interest and right in the domain name and its bad faith if we are not aware of the registrant's identity? The solution, in our opinion, could be the review the URS Procedure paragraph 3.3 and enabling the Complainant to modify the Complaint within few days from the disclosure of the full registration data by the URS Provider. UDRP provides for a 5-day term to amend Complaint. Given the rapid nature of the URS, 2 or 3 days would be adequate to make the amendment. Otherwise, without such policy provision, they prefer filing a UDRP, which allows amendment.

Moreover, the following factors are also deterrent to filing URS Complainants and contribute to the fact that the UDRP is a much more used RPM even if it has higher fees:

1. limited applicability of the URS not being the same a consensus policy (applicable only to all new gTLDs and certain legacy gTLDs such as .cat, .jobs, .mobi, .pro, .travel, .xxx and some ccTLDs such as .pw, while UDRP is applicable to all gTLDs);
2. the remedy available in the URS (temporary suspension for the registration period after which there is no 'right of first refusal' of the successful Complainant to register the domain name at its own name);
3. due to the fact that there are more than 1.200 new gTLDs, most of the cybersquatting cases involve domains registered in which the second-level domain is identical to the Complainants' trademarks or confusingly similar to it because it incorporate the entire TM adding a generic term related to Complainant's business/geographic area. In such cases many Complainants prefer having the domain name corresponding to their mark in their domain name portfolio and file a UDRP instead of having them suspended through a URS without possibility to own, control, use or transfer such domain;
4. strict burden of proof.

## Administrative Review

1. (To Forum) Has there been any issue with regard to meeting the two (2) business days requirement of conducting the Administrative Review?

## Notice of Complaint and Locking of Domain

1. Please provide feedback regarding your experiences in getting the disputed domain name(s) locked. In particular, have you experienced any difficulties having the URS Lock activated within 24 hours after sending the request to Registry Operators?

MFSD: in most cases the URS Lock is activated in a few hours from the notification of our Notice of Complaint to the Registry Operator. In few cases we had to send reminder e-mails to obtain the activation of the URS Lock within 24 hours from our communication and in 1 case it was necessary to submit a report to ICANN for the lack of response from the Registry Operator to the Notice of Complaint (<https://forms.icann.org/en/resources/compliance/registries/urs/form>). However, all issues were resolved shortly after the receipt of our reminder e-mails by the Registry Operators and after submitting the report to ICANN.

2. Have you received any notification of delayed communications to the Registrant?

MFSD: no, we have not received any notification of delayed communications to the Registrant.

3. (To Forum and MFSD) Have you received any notification of non-delivery of communications? If Respondents did not receive notifications on the first attempt, how could they know of the Complaint? What steps do you take if you receive notifications of non-delivery?

MFSD: yes, we have received notifications of non-delivery of communications sent by courier, postal mail or fax due to incorrect/false contact details provided by the Respondent, publicly accessible in Whois and confirmed by the Registry Operator. In cases of P.O. box as physical address of the Respondent couriers do not deliver to such addresses and return receipt of the registered letter does not return. In such cases we have to rely on the e-mail transmissions. No e-mails were returned undelivered to MFSD.

## The Response

1. (To Forum and MFSD) Have your Examiners received any Responses alleging an abusive Complaint? If so, how did the Examiners act in determining the validity of the allegations in those cases? What decisions were rendered on that claim? Have your Examiners received any affirmative claims for relief from Respondents, for reasons beyond an allegation of an abusive Complaint? If so, what was the basis of the claim(s)?

MFSD: neither any Responses alleging an abusive Complaint, nor affirmative claims for relief for reasons beyond an allegation of an abusive Complaint were received by us.

2. Is this statement contained in URS Rule 5(a)(v) included in your Respondent forms?

MFSD: yes, this statement is included in our Response forms. Our online Response form is accessible at <https://urs.mfsd.it/urs-forms-complaint-response> upon creating

an account at our online dispute management platform and a sample of such form is enclosed hereto.

- *URS Rule 5(v): Conclude with the following statement followed by the signature (in any electronic format) of the Respondent or its authorized representative:*

*"Respondent agrees that its claims and remedies concerning the dispute, or the dispute resolution, shall be solely against the Complainant and waives all such claims and remedies against (a) the Provider and Examiner, except in the case of deliberate wrongdoing, (b) the Registrar, (c) the Registry Operator, and (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents. Respondent certifies that the information contained in this Response is, to the best of Respondent's knowledge, complete and accurate, that this Response is not being presented for any improper purpose, such as to harass, and that the assertions in this Response are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.";*

3. Have you received any requests for an extension of time to respond?

MFSD: no, we have not received any requests of extension from Respondents.

- A) If yes, how many/what percentage of the Respondents asked for an extension of time? *n/a*
- B) How many of these requests were received after Default (14 Calendar Days), or after Determination (no more than 30 Calendar Days)? *n/a*

4. Have you ever extended the period of time for the filing of a Response by a Respondent under exceptional cases per URS Rule 5(e)? If yes, what have you considered as "exceptional cases" in those instances?

MFSD: no, we have not received any requests of extension from Respondent, hence, we have never extended the period of time for the filing of a Response under exceptional cases per URS Rule 5(e).

- *URS Rule 5(e): At the request of the Respondent, the Provider may, in exceptional cases, extend the period of time for the filing of the Response. The period may also be extended by written stipulation between the Parties, provided the stipulation is approved by the Provider. Requests for an extension of time shall comply with the Provider's Supplemental Rules.*

5. Have you conducted a compliance check for a Respondent for factors beyond the two items stated in URS Rule 5(g)?

MFSD: yes, we also check if Response was submitted timely pursuant to paragraphs 5.1-5.3 and 6.4 of URS Procedure. We hereto enclose the Checklist used for the Administrative Review of the Response.

- *URS Rule 5(g): The Provider's compliance check for a Response shall at least consist of: (1) ascertaining the Response has been filed in a language acceptable under the Rules for that case; and (2) checking for payment of required fees.*

6. (To Forum and MFSD) Who determines whether a Response is non-compliant – you or the appointed Examiner?

MFSD: if MFSD in carrying out the Administrative Review of the Response finds that the Response is non-compliant for reasons:

1. of non-payment of the required fees - the Response will not be considered, meaning that the Response will not be sent by the Provider to the Examiner and the dispute will proceed as Default pursuant to paragraph 5(h) of the URS Rules;
2. other than non-payment, i.e. Response was not submitted within the deadline under paragraphs 5.1-5.3 and 6.4 of the URS Procedure, the Response was submitted in a language different from the language acceptable under the paragraph 9(b) of the URS Rules - the Provider will send the whole case file (including the Response) to the Examiner and the Examiner might make any reasonable inferences from the deficiency of the Response pursuant to paragraph 5(i) of the URS Rules.

7. How many/what percentage of Responses were determined to be non-compliant?

MFSD: none. Only 1 Response filed in 16 cases and it was found administratively compliant.

8. How many Responses were filed but were not accompanied by payment of any required fees?

MFSD: none. Only 1 Response filed in 16 cases and it involved 2 domain names, hence, no payment of fees was required from the Respondent.

9. Can you identify any case in which the Response was determined non-compliant for reasons other than the non-payment of the fees? If any, what was the reason(s)?

MFSD: none. Only 1 Response filed in 16 cases and it was found administratively compliant.

10. Do you believe the deadline for filing Responses is long enough? (Please provide your rationale and any feedback from Respondents that the time period is insufficient.) If not, what time period would you support (keeping in mind that the URS is supposed to operate with rapidity)?

MFSD: given the rapid nature of the URS, we believe that the 14-day Response period is sufficient for filing the Response. In any case, the Respondent is informed in the Notice of Complaint of the possibility to request an extension of time to respond to the Complaint (not more than 7 days) if there is a good faith basis to doing so and the request is received by the Provider during the Response period, after Default, or not more than 30 days after Determination pursuant to the

paragraphs 5(e) of the URS Procedure, 5.3 of the URS Rules, and 7 MFSD's Supplemental Rules.

11. Have you received any late Responses?

MFSD: no. The only Response received in 16 cases was submitted within the 14-day Response period.

12. (To ADNDRC and MFSD)

A) Has any Respondent expressed any difficulty with regard to the 2,500-word limit set for the Response?

MFSD: no.

B) Do you believe that the balance of the word limits for the Complaint (500 words) and the Response (2,500 words) is reasonable? If not, what adjusted balance would you suggest?

MFSD: considering that the Complaint is partially a tick box form and the 500-word limit concerns only the explanatory statement box and not also the other boxes, such as TM rights, we retain that the balance is reasonable.

13. Where, to your knowledge, Responses were filed containing facts that sought to refute the claims of bad faith registration by setting out circumstances other than those in URS Procedure 5.7, were such facts persuasive? If so, should additional grounds be added to Procedure 5.7?

MFSD: no Responses containing facts that sought to refute the claims of bad faith registration by setting out circumstances other than those in URS Procedure 5.7 (1 Response only in 16 cases handled). Please note that our online Response form (enclosed hereto) contains reference to URS Procedure 5.8 (examples of defenses to demonstrate good faith use) and 5.9 (other factors considered by the Examiner) as well.

- *URS Procedure 5.7: The Response can contain any facts refuting the claim of bad faith registration by setting out any of the following circumstances:*
  - 5.7.1 Before any notice to Registrant of the dispute, Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or*
  - 5.7.2 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*
  - 5.7.3 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. Such claims, if found by the Examiner to be proved based on its evaluation of all evidence, shall result in a finding in favor of the Registrant.*

14. (To Forum) What is the purpose of Forum Supplemental Rule 5(d)(ii)? In any cases in which this Rule has been employed:

A) Has any other named Respondent sought to be separated out from the case?

B) Have any Registrants asked to be dismissed from the case on the basis of not having registered or being in control of the domain? If so, have your Examiners granted or denied such requests?

- *Forum Supplemental Rule 5(d): Multiple Respondents.*  
*(ii) If you are named in a case that contains domain names not registered or controlled by you, you may request that the Examiner dismiss the case as to any domain names not owned by you. It is up to the Examiner's discretion to make a factual finding as to whether or not the evidence supports your claim.*

## Stay of the Administrative Proceeding

1. Have you received any joint requests for a Stay of the Administrative Proceeding? If yes, how many cases were reinstated or otherwise dismissed upon expiration of the Stay?

MFSD: no.

2. Have you received any requests for a Stay after the appointment of the Examiner? If so, how was this handled?

MFSD: no.

## Examiner

1. What factors should we consider in regard to evaluating your processes and practices pertaining to Examiners' selection and training?

MFSD: 1. **Selection:** MFSD seeks, selects and accredits in its Examiners list highly-qualified professionals of multiple jurisdictions with language skills experienced in cross-border IP disputes and ADR proceedings, in particular in domain name disputes. Experience is given by the fact that many of them are UDRP Panelists or Panelists in other TLDs (ccTLD or .eu) disputes which are UDRP-variants. Some of the Examiners were previously ccTLD dispute case managers, others have an extensive expertise in domain name disputes (including court litigation) as representative of Parties.

Paragraph 7.3 of URS Procedure expressly provides that: "Examiners used by any given URS Provider shall be rotated to the extent feasible to avoid forum or examiner shopping. URS Providers are strongly encouraged to work equally with all certified Examiners, with reasonable exceptions (such as language needs, non-performance, or malfeasance) to be determined on a case by case analysis". Some of our Examiners are also listed as Examiners at the other two URS Provider. This contributes to have a major consistency in Examiners' view and avoids forum

shopping risks.

2. **Appointment:** the assignment of an Examiner to a dispute is determined on a case by case analysis, considering the necessary language skills (language of the Notice of Complaint/Response), the principle of rotation and the availability of the Examiner.

3. **Education and training:** MFSD continuously monitors the development of the URS and UDRP case law of other Dispute Resolution Providers and organizes training sessions and meetings regularly (<https://urs.mfsd.it/news-events>). Informational e-mails are also sent to the Examiners with update on policy changes (e.g. impact of the Temporary Specification for gTLD Registration Data, in particular the Appendix D, on the URS proceeding).

2. (To ADNDRC and Forum) Why have the qualifications of some of your Examiners not been published?

MFSD: all CVs complete of the Examiners' qualifications are published at our website: <https://urs.mfsd.it/urs-examiners>

3. (To MFSD) What is your conflict of interest policy for Examiners? How do you make the Examiners aware of their obligation to be impartial and independent?

MFSD: the Examiners' obligation to be impartial and independent are contained in the URS Procedure, URS Rules and MFSD's Supplemental Rules and Examiners are bound by those policy and rules. URS Rules 6(b) sets forth that the "Examiner shall be impartial and independent and shall have, before accepting appointment, disclosed to the Provider any circumstances giving rise to justifiable doubt as to the Examiner's impartiality or independence". Paragraph 9 of MFSD's Supplemental Rules sets forth that the "Examiner shall be impartial and independent and shall ensure that the Parties are treated with equality". In order to verify absence of conflict of interest of an Examiner, before the his/her appointment MFSD sends an e-mail communication to the Examiner disclosing to him/her the Parties' name and the disputed domain name and requesting the Examiner to communicate to MFSD if there is any conflict of interest. Upon confirmation of the absence of conflict of interest of the Examiner, he/she is appointed to the dispute. The online Determination form (a sample is hereto enclosed) also contains an acknowledgement and declaration that the Examiner has acted independently and impartially (tick box of Section IV: "the Examiner certifies that he/she has acted independently and impartially and to the best of his/her knowledge has no known conflict in serving as the Examiner in this administrative proceeding").

4. (To MFSD) How do your Examiners confirm their impartiality and independence?

MFSD: Examiners confirm their availability to serve as Examiner in a certain dispute and the absence of conflict of interest by e-mail before their appointment. Once appointed, the Examiners shall declare in the online Determination form (see enclosure) by ticking the relevant box that "the Examiner certifies that he/she has acted independently and impartially and to the best of his/her knowledge has no known conflict in serving as the Examiner in this administrative proceeding".

5. Can you provide a copy of any oath taken by your Examiners to affirm that they will be neutral and independent? Is the oath signed by the Examiners?

MFSD: before appointment the Examiners confirm through e-mail the absence of conflict of interest. Once appointed, upon filing the online Determination form (see enclosure) the Examiners shall declare by ticking the box that "the Examiner certifies that he/she has acted independently and impartially and to the best of his/her knowledge has no known conflict in serving as the Examiner in this administrative proceeding".

6. Do you undertake any independent inquiries to adequately satisfy yourself of your Examiners' impartiality and independence? Or do you rely solely upon the oath or declaration made by each Examiner?

MFSD: we rely on the declaration made by each Examiner. In most cases it would not be feasible to undertake independent inquiries on the absence of conflict of interest. Ultimately, the Parties have the possibility to submit a request of challenge of the Examiner pursuant to the paragraph 9 of MFSD's Supplemental Rules.

7. (To Forum and MFSD) Has any of your Examiners voluntarily disclosed any conflict of interest? If not, then what action was taken upon discovery of any conflict? If a conflict was disclosed, did the Examiner do this before and/or during the case proceeding?

MFSD: yes, before the Examiner's appointment upon our e-mail request an Examiner disclosed possible conflict of interest with one of the Parties. Hence, no appointment of such Examiner has taken place in that dispute. Another Examiner declaring no conflict of interest was appointed to decide the dispute.

8. Has there been any incident in which an allegation of partiality, non-independence, or bias of an Examiner was raised by any party to a URS proceeding either during the initial Determination process, or as ground for a review or Appeal? If so, how was the conflict of interest subsequently evaluated?

MFSD: no such incident has ever occurred and no request of challenge under paragraph 9 of MFSD's Supplemental Rules have ever been received.

9. (To Forum and MFSD) When a conflict of interest has been confirmed, what remedial actions have been taken? Is any Examiner who failed to disclose a proven conflict permitted to preside in subsequent cases?

MFSD: please see our response above under question 7. The Examiner who upon our e-mail request declared possible conflict of interest before its appointment was not appointed in that dispute. Another Examiner declaring no conflict of interest was appointed to decide the dispute.

10. (To Forum) Why do you have a requirement that any request to challenge the selection of an Examiner must be filed within one (1) Business Day under Forum Supplemental Rule 10(d)? Has any party filed a challenge after the end of the

required time period? Have Respondents alleged any difficulties in meeting this deadline for filing a challenge?

- *Forum Supplemental Rule 10(d): A request to challenge must be filed in writing with the Forum within one (1) Business Day of the date of receipt of the notice of the selection.*

11. (To ADNDRC) Has ADNDRC experienced any instance where an Examiner refused or failed to act per your Supplemental Rule 8.4? What motivated ADNDRC to adopt Rule 8.4?

- *ADNDRC Supplemental Rule 8.4: Where an Examiner has been appointed but before rendering a Determination the appointed Examiner fails to act or refuses to act, the Relevant Office of the Centre may appoint a substitute Examiner upon request by the Parties or in its discretion.*

12. Has any Examiner ever been removed from the pool of Examiners for any reason? If so, why? What behaviors would disqualify/bar an Examiner from future cases?

MFSD: no Examiner has ever been removed from our list.

A non-exclusive list of behaviors that would disqualify/bar an Examiner from future cases includes: non-compliance with the deadlines of the URS proceeding, repeated non-availability to being appointed as Examiner, non-declaration of conflict of interest, repeated non-participation at trainings, rendering Determinations contrary to the policies and rules or with insufficient and illogical reasoning.

13. Do you permit one to continue being an Examiner if one represented a Complainant in a URS or UDRP proceeding where there was finding of Reverse Domain Name Hijacking?

MFSD: as per our knowledge no cases of abusive Complaint have ever occurred in the URS proceedings so far. Should there be any case of abuse of the URS proceeding involving an Examiner, the case would be carefully evaluated. There is no policy requirement for the URS Providers to monitor and keep track of UDRP proceedings with finding of RDNH. The only way to learn about an Examiner who represented a Complainant in a UDRP proceeding with finding of RDNH is if a Party submits a request of challenge. Should that happen, the case will be carefully evaluated.

14. A) What steps, if any, do you take to ensure that your Examiners have demonstrable relevant legal background?

MFSD: we seek, select and accredit in our Examiners list highly-qualified professionals of multiple jurisdictions with language skills experienced in cross-border IP disputes and ADR proceedings, in particular in domain name disputes. Experience is given by the fact that many of them are UDRP Panelists or Panelists in other TLDs (ccTLD or .eu) disputes which are UDRP-variants. Some of the Examiners were previously ccTLD dispute case managers, others have an extensive expertise in domain name disputes (including court litigation) as representative of

Parties. We review CVs received together with the requests of accreditation and we carefully evaluate the (legal) qualifications of each Examiner. If we retain necessary, we require letter of recommendation or have an interview with the Examiner.

B) What steps, if any, do you take to ensure that your Examiners have a diversity of relevant experience (e.g., have experience representing Respondents as well as Complainants)? If so, please explain.

MFSD: our selection and accreditation process is open, transparent and non-discriminatory. Many of our Examiners are UDRP Panelists or URS Examiners listed at the other two URS Providers or they are Panelists in other TLD (ccTLD or .eu) disputes which are UDRP-variants. Some of the Examiners were previously ccTLD dispute case managers, others have an extensive expertise in domain name disputes (including court litigation) as representative of Parties. Considering that there is no specific URS policy requirement to list neutrals representing both Complainants and Respondents, it is not a reason for refusal to include in our list an Examiner who has experience in representing only Complainants or Respondents. On the other hand, Examiners who represent Parties usually do not disclose their clients name nor declare themselves as Complainant representative or Respondent representative only. We engage with various stakeholders of the Internet community, including domain owners' associations, and encourage professionals having language skills and thorough experience in domain name disputes to send us their CVs and requests of accreditation.

## Language

1. Do you think it would be feasible to mandate sending Registry and Registrar notices in the same language(s)?

MFSD: we are not aware of such current practice in URS proceedings. Notices are sent to the Registry Operator in Cc to Registrar only in English. All URS actions requested by us (URS Lock and Implementation of the Determination) are directed to and taken by the Registry Operators in according with the provisions of policies and rules drafted and approved in English. Complying with such policies and rules is an obligation of the Registry Operators set forth in Registry Agreements with ICANN which, as far as we know, are in English. The reason of the language requirement regarding the notices and communications sent to the Respondents is to guarantee adequately the right of defense.

- *Background: The URS Documents Sub Team has noted that the current practice seems to be that Registry notices are sent in English while Registrar notices are sent in English as well as (where applicable) the language of the affected registrant.*

2. Are all of your Examiners fluent in English?

MFSD: yes. We select highly-qualified professionals of multiple jurisdictions with language skills experienced in cross-border IP disputes and ADR proceedings.

3. Are all of your assigned Examiners fluent in the non-English language of the Respondents?

MFSD: to each case we assign an Examiner fluent both in English and in the language of the Notice of Complaint.

4. Can you provide any information as to whether, and in how many instances, it has been demonstrated that a Respondent had the capability of understanding English in addition to their primary language?

MFSD:

- Dispute no. F52833A5 orangemoney.cash. Website content associated with the disputed domain name changed after having received the letter of the Complainant's lawyer. Both the original content and the modified content of the website were in English. Default Determination rendered in English pursuant to paragraph 9(d) of the URS Rules.

- Dispute no. D5C230DE planetwin365.paris. Website content associated with the disputed domain name was in English. Default Determination rendered in English pursuant to paragraph 9(d) of the URS Rules.

- Dispute no. D70B9442 eleclerc.club. Respondent replied to the cease and desist letter in English. Default Determination rendered in English pursuant to paragraph 9(d) of the URS Rules.

- Dispute no. 6DDAB859 le-clerc.shop, leclerc.shop. Language of the communications between the Complainant and the Respondent and the Respondent and the Provider were in English. Website content associated with the disputed domain name was also in English. Final Determination rendered in English.

- Dispute no. 800AA499 sergiorossie.store. Website content associated with the disputed domain name was in English. Default Determination rendered in English pursuant to paragraph 9(d) of the URS Rules.

- Dispute no. 30AF44A1 sergiorossioutlet.store. Website content associated with the disputed domain name was in English. Default Determination rendered in English pursuant to paragraph 9(d) of the URS Rules.

- Dispute no. 369B0FE1 dpd.solutions. Website content associated with the disputed domain name was in English. Default Determination rendered in English pursuant to paragraph 9(d) of the URS Rules.

- Dispute no. 804D64F0 yonka.xyz. Communications between the Parties were in English. Default Determination rendered in English pursuant to paragraph 9(d) of the URS Rules.

- Dispute no. 12835AFC pvpro.trade. Website content associated with the disputed domain name was in English. Default Determination rendered in English pursuant to paragraph 9(d) of the URS Rules.

## Further Statement

1. Have you acted in conformance with URS Rule 10 by not allowing an Examiner to request further statements or documents from either of the Parties?

MFSD: yes. No cases of Examiner's request for further statements or documents from the Parties.

- *URS Rule 10: In order to ensure expedience of the proceeding, the Examiner may not request further statements or documents from either of the Parties.*

## Withdrawal

1. (To Forum) Do you have any explanation of the seeming inconsistency between the use of the phrase "without prejudice" in 12(a), versus "with or without prejudice" used in 12(b) of the Forum Supplemental Rules?
  - *Forum Supplemental Rule 12(a): Prior to the first issued Determination, the Complainant may withdraw the Complaint without prejudice. A withdrawal request must be Submitted to the Forum via the online portal. Upon the Forum's receipt of the withdrawal request, the Complaint will be withdrawn without prejudice and the administrative proceeding will be terminated.*
  - *Forum Supplemental Rule 12(b): Prior to the first issued Determination, the Complaint may be withdrawn pursuant to a joint request made by both parties. A withdrawal request must be Submitted to the Forum via the online portal, must be consented to by both parties, and may request dismissal either with or without prejudice.*

## Default

1. With reference to URS Procedure 6.2, to your knowledge, has any Registrant changed content on their sites during the Default period, possibly to support an argument that there has been a legitimate use? If so, do you know how the matter was handled?

MFSD: no cases of website content modification by the Respondent during the Default period.

- *URS Procedure 6.2: In either case, the Provider shall provide Notice of Default via email to the Complainant and Registrant, and via mail and fax to Registrant. During the Default period, the Registrant will be prohibited from changing content found on the site to argue that it is now a legitimate use and will also be prohibited from changing the Whois information.*
2. Has any of your Examiners drawn inferences per URS Rule 12(f) when a party is not in compliance with URS Rules, Procedures, and Supplemental Rules, in the absence of exceptional circumstances? If so, what inferences were made?

MFSD: yes. In Default Determinations Examiners concluded that: "Respondent's default does not automatically result in a decision in favor of the Complainant. Although, the Examiner may draw appropriate inferences from a Respondent's default, Paragraph 12 of the URS Rules requires the Examiner to review the Complaint for a prima facie case, including complete and appropriate evidence [...]"

The Examiner finds that in this case there are no such exceptional circumstances. Consequently, failure on the part of the Respondent to file a response to the Complaint permits an inference that the Complainant's reasonable allegations are true. It may also permit the Examiner to infer that the Respondent does not deny the facts that the Complainant asserted" (e.g. Dispute no. 8422F178 e-leclerc.paris; Dispute no. 429EC571 reinhausen.international).

- *URS Rule 12(f): If a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, these Rules, the URS Procedure or the Provider's Supplemental Rules, the Examiner shall draw such inferences therefrom as it considers appropriate.*

## Examiner Determination

1. To your knowledge, has any Examiner rendered his/her Determination based upon wordmark factors beyond the three elements enumerated in URS Procedure 8.1.2?

MFSD: no. All Determinations were based upon wordmark(s) under paragraph 8.1.2(i) of the URS Procedure ("*for which the Complainant holds a valid national or regional registration and that is in current use*").

- *URS Procedure 8.1: The standards that the qualified Examiner shall apply when rendering its Determination are whether: 8.1.2 The 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 currently in effect and that was in effect at the time the URS Complaint is filed;*

2. Noting that URS Rule 13(a) provides that an Examiner may "make a Determination ...in accordance with ...any rules and principles of law that it deems applicable", are you aware of instances where an Examiner has invoked substantive criteria beyond those articulated in the URS Rules, Procedure, and Supplemental Rules?

MFSD: not aware of any.

3. How do you compel your Examiners to comply with your templates in writing their Determinations or guidelines? Do you intervene in an administrative capacity to ensure your Examiners provide the most comprehensive written Determinations they possibly can? How do you strive to standardize the completeness or quality of your Examiners' written Determinations beyond the use of your online Determination template or form?

MFSD: 1. **Selection:** MFSD seeks, selects and accredits in its Examiners list highly-qualified professionals of multiple jurisdictions with language skills experienced in cross-border IP disputes and ADR proceedings, in particular in domain name disputes. Many of them are UDRP Panelists, listed as URS Examiner at the other two URS Provider or experienced (as Panelist or representatives) in other TLD

dispute (ccTLD or .eu) which are UDRP-variants and, hence, have an extensive expertise in domain name disputes.

2. **Instructions and guidelines:** our online Determination form (hereto annexed) provides the Examiners with instructions and guidelines concerning the URS, please see in particular Section VII E. Reasoning. In the latest cases the Examiners were encouraged by MFSD to refer to WIPO Overview of WIPO Panels Views on Selected UDRP Questions, Third Edition (WIPO Jurisprudential Overview 3.0).

3. **Ex-post quality check:** MFSD adopts the best practice of well-known international Dispute Resolution Providers (e.g. WIPO and CAC), known also as ex-post quality check, i.e. upon receipt of the Determination's final draft MFSD does not enter into the merits of the case, but limits its verification to the abstract and formal conformity, consistency, homogeneity, balance and consonance in an absolute (and not relative) sense of the Determination with the applicable policies and rules and, if necessary, discusses it with the Examiner in order to improve the quality of the Determination, recalling his/her attention to any logical leap, shortcoming in the reasoning which undermines the decision-making path or the consensus view of the case law developed on a certain question. If an Examiner confirms his/her decision without any amendment, MFSD will not influence the Examiner or restrict in any way his/her decisional autonomy, remaining the latter free to adopt the solution or interpretation he/she considers to most substantiated by logical-juridical reasoning for the dispute in question. The only sanction applicable by MFSD, if the case may be, is the de-accreditation and de-listing of an Examiner.

4. **Monitoring and education:** MFSD continuously monitors the development of the URS and UDRP case law of other Dispute Resolution Providers and organizes training sessions and meetings regularly (<https://urs.mfsd.it/news-events>). Informational e-mails are also sent to the Examiners with update on policy changes (e.g. impact of the Temporary Specification for gTLD Registration Data, in particular the Appendix D, on the URS proceeding).

4. The URS Documents Sub Team has suggested that a Guide for URS Examiners be developed, to assist them with understanding the distinction between clear-cut and more difficult cases. Do you agree? If so, who should develop this guide – ICANN, each Provider separately, or should all Providers collaborate to develop a uniform guide?

MFSD: please see our response provided above under question 3. We retain that Examiners selected on the basis of their qualification, language skills and thorough expertise in domain name disputes have sufficient experience to make the distinction between clear-cut and more difficult cases. However, we would be happy to collaborate with the other Providers to develop a uniform guide if that might be of assistance for the Examiners and the Parties and contribute to a more consistent case law.

5. How do your Examiners apply the “clear and convincing evidence” standard of proof required in URS cases?

MFSD: please see our response provided above under question 3. Section VII of our online Determination form (hereto annexed) requires the Examiners to reassume the

position and defenses of the Parties (A and B), the procedural findings (C), the findings of facts (D), the reasoning with reference to the three URS requirements (paragraph 1.2.6 of the URS Procedure), providing them with instructions and guidelines on the URS elements and defenses.

The Examiner decides the case based on the submissions and the evidence presented by the Parties. The Examiner verifies and evaluates whether the Complainant has met its burden of proof by satisfying all the three URS requirements, i.e. a) the Complainant has rights to the domain name (by verifying if the Complainant has presented adequate evidence to substantiate its trademark rights in the domain name); b) the Registrant has no rights and legitimate interest in the domain name; c) the domain name was registered and is being used in bad faith). If the Examiner finds that: all three standards are satisfied by clear and convincing evidence submitted by the Complainant, the Respondent has not rebutted to the Complaint, providing sufficient proof of its rights or legitimate interest to the domain name and good faith registration and use of the same, and there is no evidence available to Examiner to indicate that the use of the domain name in question is a non-infringing use or fair use of the trademark, then the Examiner accepts the Complaint by issuing a Determination in favor of the Complainant. If the Examiner finds that any of the standards have not been satisfied (Complainant has not met its burden of proof or genuine issues of material fact remain in regards to any of the three URS elements), then the Examiner shall reject the Complaint.

6. How do you ensure that Examiners actually provide some explanation of the facts and reasoning in support of their Determinations? If you do not do so, please explain why.

MFSD: please see our response provided above under question 3. Section VII of our online Determination form (hereto annexed) requires the Examiners to reassume the position and defenses of the Parties (A and B), the procedural findings (C), the findings of facts (D), the reasoning with reference to the three URS requirements (paragraph 1.2.6 of the URS Procedure), providing them with instructions and guidelines on the URS elements and defenses.

7. Among your Examiner's Determinations, how many did not provide the reasons on which the Determination is based but simply stated that the URS elements have been established?

MFSD: none. All Determinations contain sufficient reasoning of the Examiners on the URS elements.

8. How often has URS Rule 13(d) been invoked? What factors have been cited by Examiners in making that Determination?

MFSD: no cases of abuse of URS proceeding.

- *URS Rule 13(d): If after considering the submissions the Examiner finds that the Complaint was brought in bad faith or was brought primarily to harass the domain name holder, the Examiner shall declare in its Determination that the*

*Complaint was brought in bad faith and constitutes an abuse of the URS proceeding.*

9. (A) Do you supply the Examiners with information, analysis, or research concerning a Complaint or Response that is not to be found within the Complaint or Response itself? If so, please explain.

MFSD: in forwarding the case file to the Examiner appointed to the dispute we provide information regarding the case management (procedural matters).

- (B) Do you provide drafts or exemplars to the Examiners? If so, please explain.

MFSD: only the Examiner appointed to a dispute has the access to the Determination form of such dispute. Upon the appointment the Determination form is partially filled with some data (identification of Parties, domain name, Registry Operator and Registrar, procedural history and Examiner's name) captured automatically by the online dispute management system. The Examiners fill in the Determination form starting from ticking the box of the declaration of independence and impartiality and absence of conflict in serving as Examiner in the case. The Examiners is encouraged to refer to WIPO Overview of WIPO Panels Views on Selected UDRP Questions, Third Edition (WIPO Jurisprudential Overview 3.0) and to cite URS and UDRP case law they retain significant for the decision of the dispute.

## Remedies

1. Please provide feedback regarding any difficulties encountered in the implementation of the suspension remedy.

MFSD: usually no difficulties in the implementation of the suspension remedy. In few cases we had to send reminder e-mails to obtain the activation of the URS Suspension within 24 hours from our communication and in 2 cases it was necessary to submit a report to ICANN for the lack of implementation (URS Suspension) by the Registry Operator (<https://forms.icann.org/en/resources/compliance/registries/urs/form>).

2. Are you aware of any instances where a successful Complainant has requested the extension of the registration period of the URS Suspended domain name for one additional year? If so, do you know if any of them encountered difficulties extending the registration period of a URS Suspended domain name for the additional year? If so, do you know how the matter was handled?

MFSD: in one case successful Complainant requested us to extend/renew the suspension period. We informed the Complainant about the relevant policy provisions (URS Procedure 10.3; URS Rules 14(b) and Technical Requirements 3. Domain Name Life-Cycle - Registry Requirement 10) and that it should have contacted the Registry Operator/Registrar directly. We have had no further information if extension was obtained through the Registry Operator/Registrar in that case. No other information in other cases.

3. During the one additional year of URS Suspension available to the successful Complainant, the domain name must remain registered to the original Registrant. Should the registration information be altered in such circumstances?

MFSD: we are not handling the extension of the URS Suspension for an additional year. As far as our knowledge, from the Technical Requirement 3. Domain Name Life-Cycle Registry Requirement 10 it seems that the suspended domain name is renewed by the successful Complainant at the name of the original registrant. Renewal fees are paid by the successful Complainant and the registration information (except for the expiry date) should not be altered.

4. Have you received any notices or queries from any party regarding procedural and/or implementation anomalies or mistakes following the issuance of a Determination (e.g., resolution of a domain name to particular Name Servers following issuance of a Determination)? If yes, what action did you take on receiving the notice or to resolving the query?

MFSD: no notice or queries received from any party. After sending the Notice of Determination to the Registry Operator we monitor if the actions required are taken in 24 hours. Upon receipt of Registry Operator's notification, we check if actions were taken, i.e. if Whois reflects the action that the Registry Operator affirms to have taken. Hence, we check if the original nameservers were substituted with our nameservers (otherwise the domain name does not resolve to the suspension page). We check correct redirection of the domain name to the suspension page. If any of those is not carried out at all or not carried out correctly, we send reminder e-mails and, if necessary, we submit a report to ICANN for the lack/error of implementation of the URS Determination by the Registry Operator (<https://forms.icann.org/en/resources/compliance/registries/urs/form>).

## Determinations and Publication

1. What is your Examiners' practice with regard to the publication of an Appeal Determination?

MFSD: no Appeal handled so far. Pursuant to paragraph 15(e) of the URS Rules our online Appeal Determination form provides the Examiners with the following options: "Publish the Appeal Determination by replacing the previous Determination(s)" or "Publish the Appeal Determination together with the previous Determination(s)". The Examiners' choice would depend on the evaluation of all circumstances of each case.

2. Do you agree with the policy embodied in URS Rule 15(f)?

MFSD: yes. As URS Provider we do not see any reason to link Determinations related to the same domain names and/or parties, but not part of the same case at our website. Nor any provision requiring the linking of decisions exists under UDRP.

- *URS Rule 15(f): Determinations related to the same domain names and/or parties, but not part of the same case, need not be linked in any way on the Provider's website.*
3. Has any Determination that your Examiners have issued concerned the same domain name(s) at issue in a prior case? If so, have you linked the cases? Has any Final Determination been made by the same Examiner who made the initial Default Determination in the same case? If so, how many times has this occurred?

MFSD: no, none.

4. (To Forum) What is the purpose of Forum Supplemental Rule 15(b)? Has any party requested to include or exclude certain information from a publicly available Determination? If so, how did Forum act on such request?
- *Forum Supplemental Rule 15(b): All requests pursuant regarding what information a party wants included or excluded from a publicly available Determination must be made in a timely, compliant Complaint or Response.*

## Settlement or Other Grounds for Termination

1. How many "unnecessary or impossible" incidents, per URS Rule 16(b), have been recorded by you?

MFSD: no cases of "unnecessary or impossible" incidents.

- *URS Rule 16(b): If, before the Examiner's Determination is made, it becomes unnecessary or impossible to continue the URS proceeding for any reason, the Examiner shall terminate the proceeding, unless a Party raises justifiable grounds for objection within a period of time to be determined by the Examiner.*

## Effect of Court Proceedings

1. To your knowledge, have there been instances of legal proceedings relating to URS proceedings and, if so, what effect did such instance(s) have?

MFSD: no, we have no knowledge about any.

Paragraph 15 of MFSD's Supplemental Rules provides that:

"If a party is aware of any proceedings that have been commenced or terminated in connection with or relating to the domain name subject of URS administrative proceeding, **the party shall promptly notify MFSD**, showing official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) of such proceedings.

The Examiner might decide, at its sole discretion, whether to suspend or terminate the URS proceeding or to proceed to the Determination.

If a party initiates any legal proceedings during the pendency of an URS administrative proceeding or after the issuance of the determination in connection with or relating to the domain name subject of URS administrative proceeding, **the party shall promptly notify MFSD**, showing official documentation (such as a copy

of a complaint, file stamped by the clerk of the court) of the legal proceedings" (emphasis added).

## Appeal

1. How do you implement URS Rule 19(b)? Do you conduct an administrative check on the data of any additional evidence sought to be introduced? How do you determine that the Appellant in seeking to introduce new evidence, is in fact, providing evidence that is material to the Determination and clearly pre-dates the filing of the Complaint?

MFSD: Section III. Appeal Grounds of our online Appeal form (accessible at <https://urs.mfsd.it/urs-forms-appeal> upon registration at our website and hereto enclosed for ease of reference) provides the following information to the Appellant: "In accordance with URS Procedure 12.1, identify the specific grounds on which you are appealing, including why you claim the Examiner's Determination was incorrect. In accordance with URS Procedure 12.2 and URS Rules 19(b), a limited right to introduce new admissible evidence that is material to the Determination will be allowed upon payment of an additional fee, provided the evidence clearly pre-dates the filing of the Complaint".

In the relevant box the Appellant may provide its arguments on the introduction of new admissible evidence and may attach files in file formats specified in MFSD's Supplemental Rules.

Upon receipt of the Appeal, MFSD will carry out the administrative review pursuant to paragraph 16 of its Supplemental Rules and check if:

- i) the Appellant has made any declaration in the Section III Appeal Grounds of the online Appeal form regarding the introduction of any new evidence;
- ii) any evidence different from those already submitted by the party who is filing the Appeal is being submitted;
- iii) the relevant additional fee has been paid.

In forwarding the case file to the Examiner(s) MFSD will inform the Appeal Panel about the findings of its administrative review. Admissibility, relevance, materiality and weight of the new evidence will be determined by the Examiner(s) pursuant to paragraph 8(d) of the URS Rules.

- *URS Rule 19(b): Appellant shall have a limited right to introduce new admissible evidence that is material to the Determination subject to payment of an additional fee, provided the evidence clearly pre-dates the filing of the Complaint.*

2. (To Forum) In appointing Examiners to the three-member Appeal Panel, did you encounter any difficulties appointing Examiners from each party's list to the Panel?

MFSD: no Appeal handled so far.

## Exclusion of Liability

1. Have you or any of your Examiners been sued in regard to the issuance of a URS Determination?

MFSD: no, never.

## Others

1. Have you undertaken any internal reviews of your Supplemental Rules? If yes, how often? Have you discerned a need to tighten or provide greater clarity to your Supplemental Rules?

MFSD: we have been approved by ICANN as 3rd URS Provider at the end of 2015 and received the first URS Complaints at the beginning of 2016. Supplemental Rules were revised in January 2017 due to the changes in our schedule of fees. We have never received any request of clarification or comment regarding our Supplemental Rules and retain that they are sufficiently clear.

2. Do you have any difficulties complying with the URS technical requirements (e.g., utilizing PGP Keys, etc.)?

MFSD: no, we have no difficulties complying with the URS Technical Requirements and using the PGP keys.

3. Do you maintain any regular communications with ICANN? If yes, did ICANN request any information or data from you via such communications? What other areas of the URS do such communications touch on? Please provide details.

MFSD: yes, we maintain regular communications with ICANN. We provide statistics on URS disputes filed with us on regular basis. We have also been asked about data regarding cases of abusive complaints and our practice on handling the abusive proceedings database. We inform ICANN if there is any change in our fees, registered office address and E&O policy. We exchanged communications on technical issues (e.g. change of password to access ICANN's repository, PGP key's fingerprint verification, access to SMDRL (SMD Revocation List) to validate the SMDs), coordination between ICANN and URS Providers for the presentation held at ICANN San Juan, issues related to GDPR and the Temporary Specification for gTLD Registration Data.

4. (To Forum) Did any party submit an individual file in excess 10MB? Did any party submit electronic case documents in excess of 10MB, in the aggregate, per domain name?

MFSD's Enclosures:

- Complaint form
- Checklist for Administrative Review of the Complaint
- Response form
- Checklist for Administrative Review of the Compliant

- Determination form
- Appeal form