



MFSD

RIGHT PROTECTION MECHANISMS:
THE NEW UNIFORM RAPID SUSPENSION SYSTEM (URS) AND THE
LONGSTANDING UNIFORM DOMAIN NAME DISPUTE RESOLUTION
POLICY (UDRP) - HOW TO CHOOSE THE RIGHT PROCEEDING?

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***URS Domain Dispute Case
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Seminar

“Online brand protection”

ECIJA – Barcelona 22 May 2017





Agenda

- **THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP)**
- **THE UNIFORM RAPID SUSPENSION SYSTEM (URS)**
- **TOP 7 THINGS TO KNOW ABOUT THE URS**
- **URS PROCEDURE**
- **URS VS. UDRP**
- **CASE STUDY**
- **MFSD'S ONLINE DISPUTE MANAGEMENT PLATFORM**



The Uniform Domain Name Dispute Resolution Policy (UDRP)

- **Expedited administrative proceeding** established by ICANN in **1999**
- **Trademark-based** domain name disputes to tackle abusive registration (e.g. cybersquatting)
- A complainant in a UDRP proceeding must establish **three elements** to succeed:
 1. The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
 2. The registrant does not have any rights or legitimate interests in the domain name; and
 3. The domain name has been registered and the domain name is being used in bad faith.
- **Outcome: transfer or cancellation**



The Uniform Rapid Suspension System (URS)

- **Right protection mechanism (RPM)** implemented in 2013 within the New gTLD Program to **supplement** the longstanding **Uniform Domain Name Dispute Resolution Policy (UDRP)**
- **Scope:** provide trademark owners with a **quick** and **low-cost** process to **take down** websites in case of **clear-cut infringement** of their IP rights caused by domain name registrations and to fight against cybersquatting

Top 7 things to know about the URS

1. APPLICABILITY OF THE URS

- The URS applies to:
 - to all **new generic TLDs** (<https://newgtlds.icann.org/en/program-status/delegated-strings>)
 - .online, .shop, .luxury, .brand
 - certain **legacy gTLDs**
 - .pro, .xxx, .cat, .jobs, .travel, .mobi
 - .com, .info, .net(?)
 - certain **country code TLDs**
 - .pw
 - .es, .co.uk

Top 7 things to know about the URS

2. REMEDY AVAILABLE IN THE URS

- **Only remedy** available is the **suspension** of the domain name for the **remaining registration period** (extendable for an additional year)

necessity of quick solution: take down



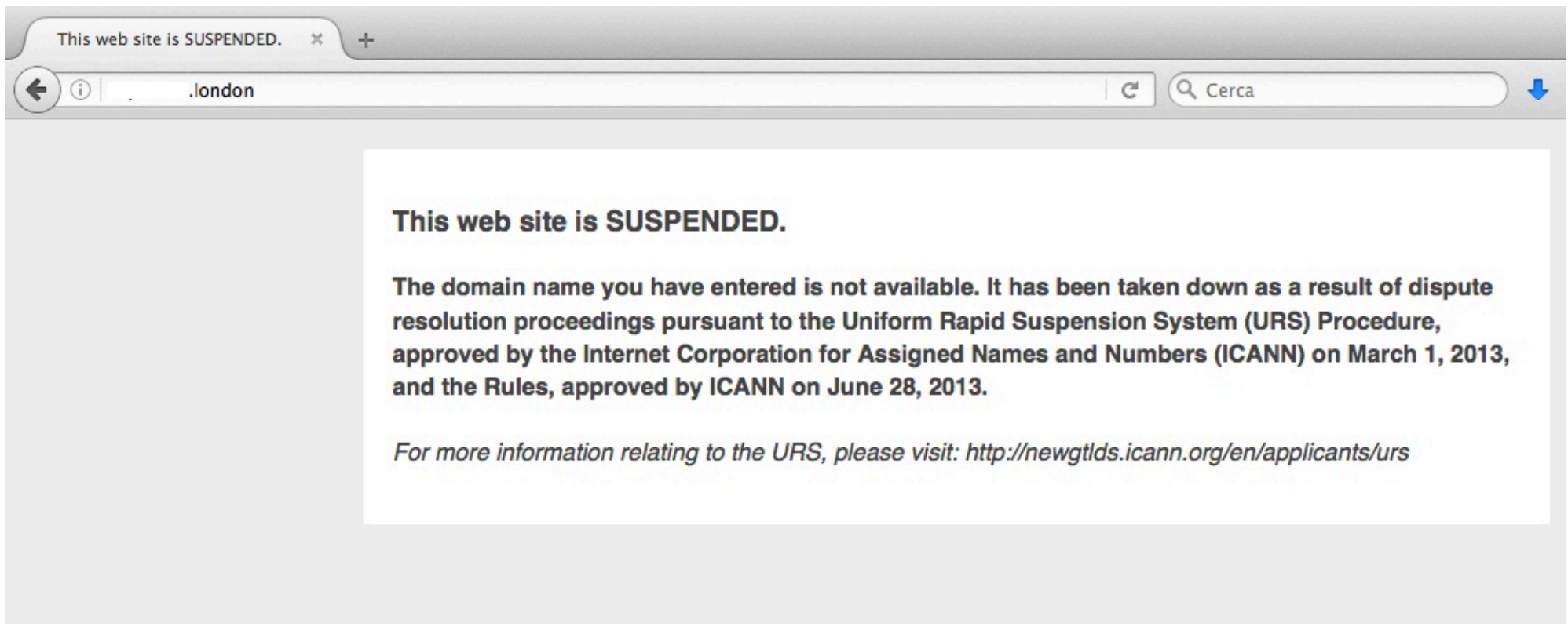
necessity of ownership of the domain name: transfer



- **Suspension =**
 - domain name will **not resolve** to the **original website**, but will redirect to an **informational website** of the dispute resolution provider
 - **ownership** of the domain name will **remain** with the original **registrant until expiry**, **substitution of the nameservers** (Whois)

Top 7 things to know about the URS

Suspension



Top 7 things to know about the URS

3. ELEMENTS OF CLAIM – RIGHTS OF THE COMPLAINANT

- The complainant shall hold a **valid nationally or regionally registered or court validated or statute/treaty protected word mark** which is in **current use**

registered trademark



court validated mark



trademark application



design trademark



composite mark (device and word elements)



unregistered trademark, trade name or other distinctive sign





Top 7 things to know about the URS

3. ELEMENTS OF CLAIM – IDENTICAL OR CONFUSINGLY SIMILAR

- The complainant shall prove that the **domain name is identical or confusingly similar** to its mark



Top 7 things to know about the URS

3. ELEMENTS OF CLAIM – RIGHTS OR INTERESTS OF THE REGISTRANT

- The complainant shall prove that the Registrant has **no legitimate right or interest** to the domain name
 - fair use of a descriptive or generic domain name
 - fair use of a domain name in tribute or criticism
 - written agreement in force between the parties



Top 7 things to know about the URS

3. ELEMENTS OF CLAIM – BAD FAITH

- The complainant shall prove that the domain name **was registered and is being used in bad faith**
 - trading in domain name for profit or holding a large portfolio in itself 
 - sale of traffic (parking pages, click-per view) in itself 


Top 7 things to know about the URS

4. STRICT BURDEN OF PROOF IS TO BE MET

- **Examination standards:**
 - all disputes are reviewed on the merits of the claim
 - clear and convincing evidence on the 3 elements of claim
 - no genuine issue of material fact exists
 - clear case of trademark abuse 
 - open questions of fact 

Top 7 things to know about the URS

5. EVIDENCE AND BRIEF EXPLANATORY STATEMENT (500 WORDS)

- No amendment is possible – all documentary evidence is to be filed with the complaint:
 - **proof of complainant's trademark rights**
 - certificate of TM registration 

Top 7 things to know about the URS

5. EVIDENCE AND BRIEF EXPLANATORY STATEMENT (500 WORDS)

- **proof of complainant's use of trademark**

declaration of TM use



brochure, catalogue, product manuals of complainant



screenshot of complainant's website



Trademark Clearinghouse validated SMD file



Top 7 things to know about the URS

5. EVIDENCE AND BRIEF EXPLANATORY STATEMENT (500 WORDS)

- **proof of registrant's infringing use of the domain name**
 - Whois record of disputed domain name
 - screenshot of the domain name's website

Top 7 things to know about the URS

6. LANGUAGE OF THE PROCEEDING

- **Complaint:** always in **English**, independently from the language of the registration agreement
- **Response:** in **English** or in the predominant **language spoken** in the **registrant's country**
- **Examiner:** fluent in **English** and in **the language of the Response** and determines, in its sole discretion, the appropriate language for the issuance of the Determination
- **English** is the language of the Determination if **no Response** filed (**default proceeding**)

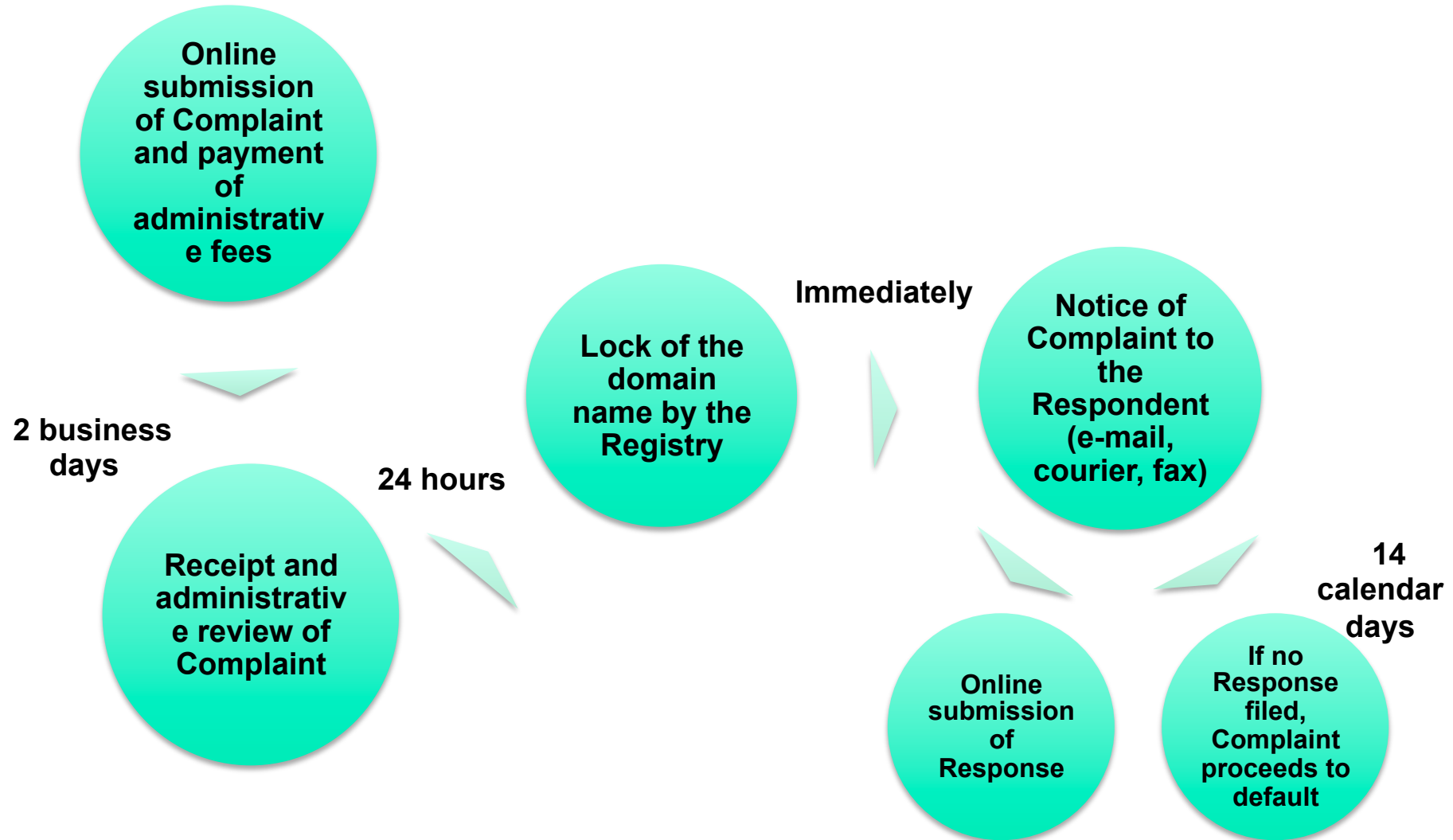
Top 7 things to know about the URS

7. OTHER PROCEEDINGS RELATED TO THE DOMAIN NAME

- URS is to be initiated if **no other proceeding** is pending concerning the disputed domain name
 - pending UDRP
 - pending court proceeding

URS procedure

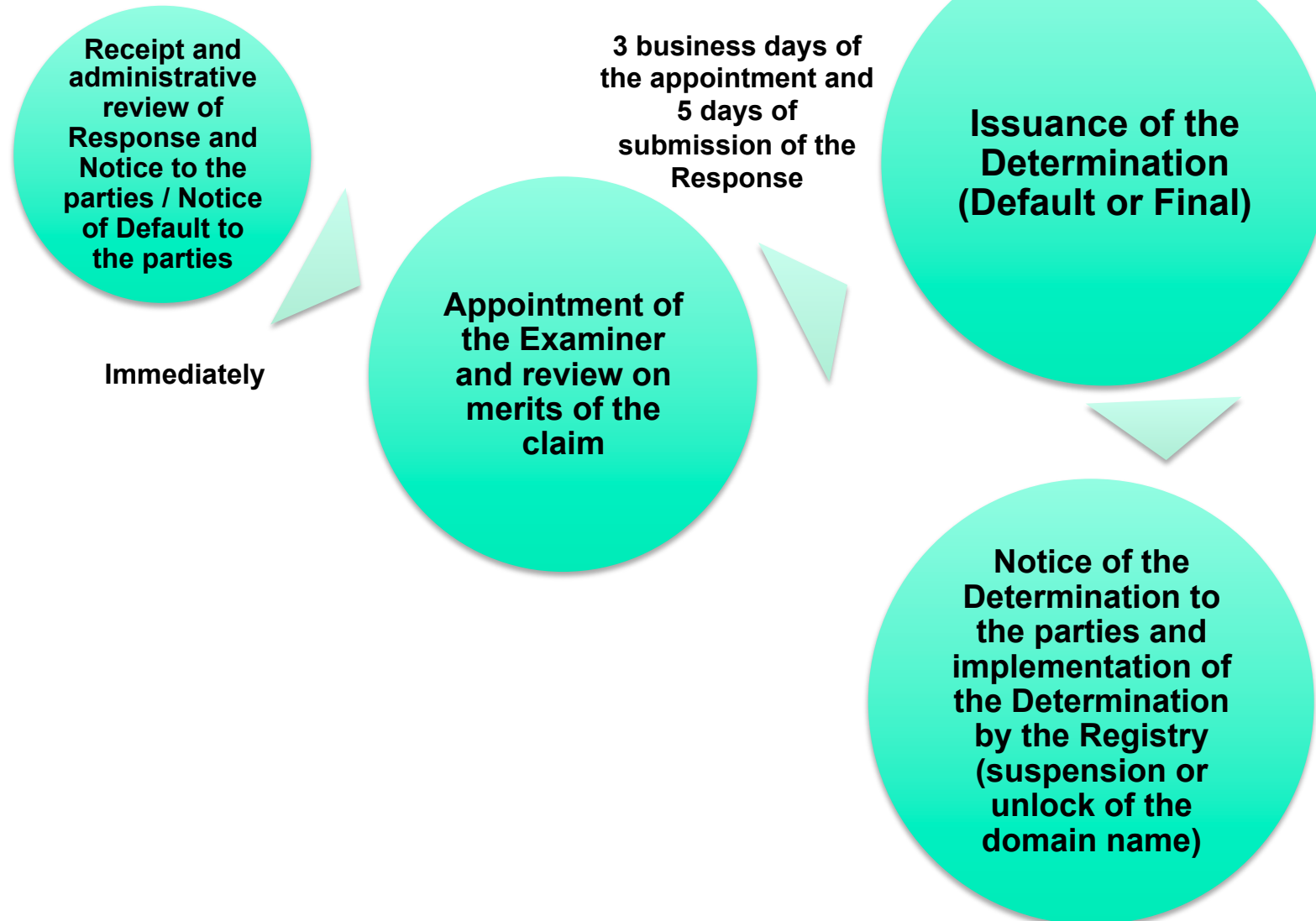
Introduction of the procedure



URS procedure

Procedure and outcome

On the same day of receipt / Upon expiry of the due date



URS vs. UDRP

Remedy: suspension	transfer or cancellation
Complainant's rights: word mark (composite mark)	trademark
Duration: 21 days	60-90 days
Standard of proof: clear and convincing evidence	on the balance of the probabilities
Appeal: yes	no
Language: Complaint – English Response – English or language of the registrant's country	language of the registration agreement

URS vs. UDRP

Panel: 1 (3 in appeal)	1 or 3
Deficiencies: no amendment of the Complaint	5 calendar days for amendment
Length: 500 words - Complaint; 2.500 words - Response	5.000 words – Complaint 5.000 words – Response
Fees: € 350-375 / \$ 360 / \$ 375	\$ 1.300 / \$ 1.500 / € 1.300 (500+800)

Case study

Impact of the new gTLDs on the jurisprudence UDRP 1° element – identity or confusing similarity

- Tyre.plus – WIPO Case no. D2016-2465 – 13 Jan 2017 – Accepted (transfer)
- *“The Panel further concludes that the Domain Name is confusingly similar to the TYREPLUS mark. If one ignores the “dot” between the Second-Level Domain (“tyre”) and the Top-Level Domain (“plus”), the mark and the Domain Name are identical. In most cases under the Policy, the Top-Level Domain (“TLD”) is ignored when considering confusing similarity. In recent years, however, and particularly with the emergence of numerous new TLDs, panels in certain circumstances have deemed it appropriate to consider the text on “both sides of the dot” when addressing the “confusing similarity” issue.”*

Case study
URS
1° element – mark





Case study
URS
1° element – mark

- **Sanofi.xin – NAF Case no. FA1604001672049 – Final Determination – 6 May 2016 – Rejected**
- *“URS 1.2.6.1 requires Complainant to establish that the registered domain name is identical or confusingly similar to a **word mark** for which Complainant holds a valid national or regional registration that is in current use. In seeking to rely on its registration for the **word and device mark SANOFI**, Complainant has not satisfied the requirements of 1.2.6.1.”*

Case study
URS
1° element – mark



- **Sanofi.xin – NAF Case no. FA1604001672049 – Appeal Determination – 28 June 2016 – Accepted (suspended)**
- *“interpretation that the use of the words “word mark” in URS 1.2.6.1 does not specifically exclude trademarks which are combined of a word element and a graphical element, provided the word element is clear, and sufficiently distinct and separate from the graphical element.”*

Case study
URS
1° element – mark



FLOSSY



**Case study
URS
1° element – mark**

- **Flossy.shoes – MFSD Case no. 7B10562D –
Default Determination – 29 giugno 2016 –
ACCOLTO**
- *“for the purpose of this URS proceeding, the
Examiner will take into consideration only the word
trademarks of the Complainant.”*

Case study URS Procedural issues

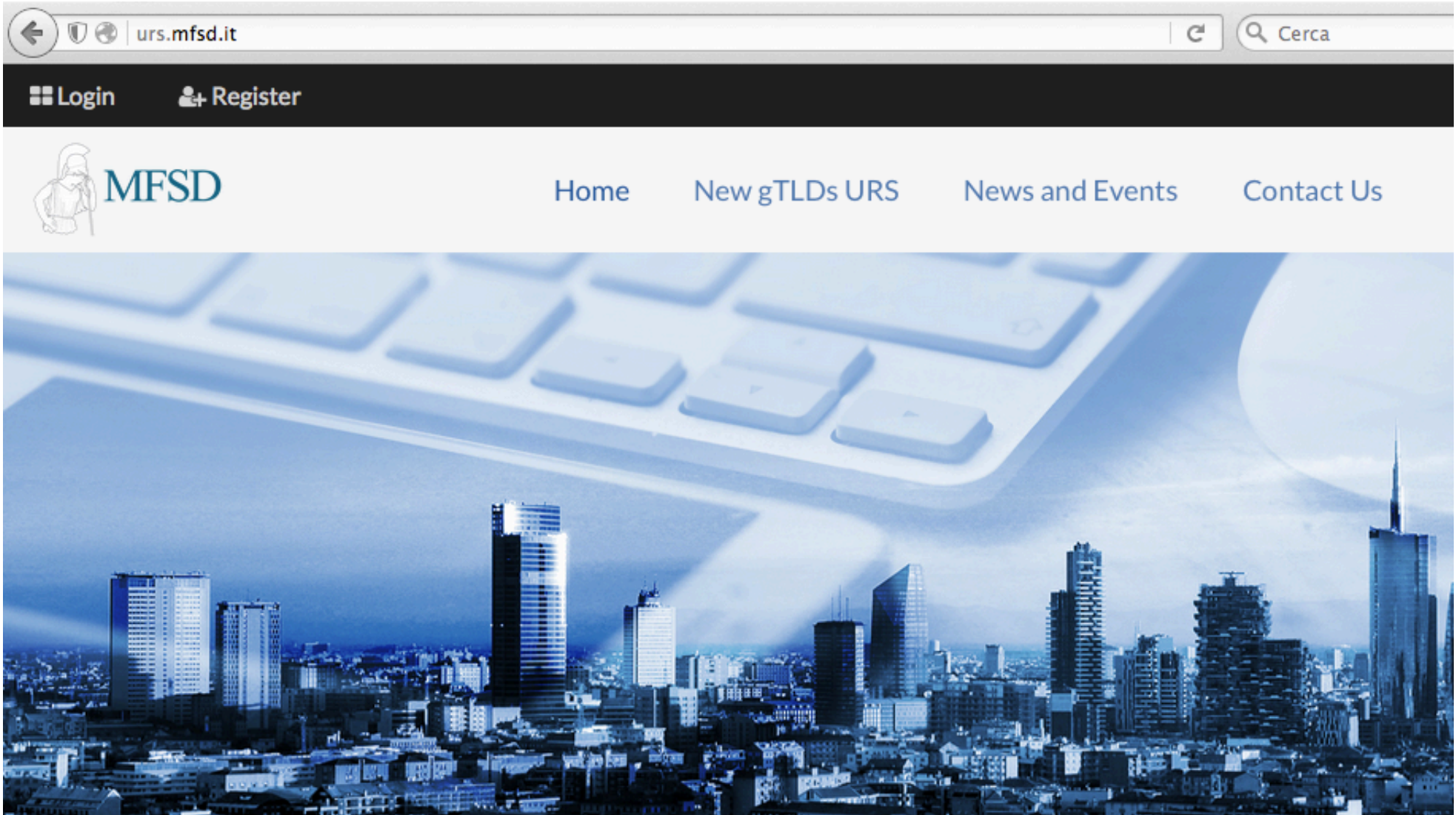


**◦ Lovemoncler.shop +84 – NAF Case no. FA1701001713119
– Default Determination – 8 Feb 2017 – Accepted
(suspended)**

◦ “On the evidence, by registering and using disputed domain names to resolve to websites selling counterfeit goods and/or purporting to be websites established by Complainant, Respondent is using the disputed domain names to create a confusion among Internet users, taking predatory advantage of Complainant’s goodwill and reputation. Furthermore, Respondent’s registration of eighty five domain names in issue in this case is indicative of a “pattern” of bad faith registration by Respondent.”

MFSD'S ONLINE DISPUTE MANAGEMENT PLATFORM FOR URS

urs.mfsd.it



MFSD'S ONLINE DISPUTE MANAGEMENT PLATFORM

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Dispute Number	Domain name(s)	Submission Date	Decision Date	Status	
6DDAB859	le-clerc.shop leclerc.shop	2016-12-27 10:19	2017-01-23 16:44	Suspended	
D70B9442	eleclerc.club	2016-12-01 15:08	2016-12-20 15:58	Suspended	
D5C230DE	planetwin365.paris	2016-12-06 11:27	2016-12-28 16:44	Claim Denied	
F52833A5	orangemoney.cash	2016-07-07 15:52	2016-08-05 12:00	Suspended	
429EC571	reinhausen.international	2016-06-07 09:26	2016-07-05 16:53	Suspended	
7B10562D	flossy.shoes	2016-06-06 16:01	2016-06-29 12:29	Suspended	
837FDF94	royalmail.space	2016-05-10 16:29	2016-06-01 12:39	Suspended	
31D42E70	royalmail.xyz	2016-02-15 11:03	2016-03-08 01:00	Suspended	
8422F178	e-leclerc.paris	2016-02-16 10:51	2016-03-11 01:00	Suspended	
A75D6EBE	royalmail.london	2016-02-15 11:17	2016-03-07 01:00	Suspended	



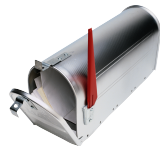
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