

## EXAMINERS' VIEWS OF URS PROCEDURE AND RULES

### Introduction

#### Standard of Proof

Text

Comment

#### Jurisdiction to Maintain a URS Proceeding

Text

Examiners' Views

General Rules Applying to Both Parties

Complainants Burden

#### Legitimate Right or Interest in the Domain Name

Text

Examiners' Views

General Rules Applying to Both Parties

Complainant's Burden

Respondent's Rebuttal Burden

#### Registration and Use in Bad Faith

Text

Examiners' Views

General Rules Applying to Both Parties

Complainant's Burden

Respondent's Rebuttal Burden

### Default

Text

Examiners' Views

### The Record

Text

Examiners' Views

### Remedy

Text

Examiners' Views

### Appeal

Text

Examiners' Views

## **Introduction**

The Uniform Rapid Suspension System (URS) is one of three rights protection mechanisms (RPMs) implemented in 2013 by the Internet Corporation for Assigned Names and Numbers (ICANN) to protect rights holders from abusive registration of domain names with new gTLD extensions. ICANN states on its website that the URS “complements the existing Uniform Domain Name Dispute Resolution Policy (UDRP)” and goes on to describe it as “offering a lower-cost, faster path to relief for rights holders experiencing the most clear-cut cases of infringement.”<sup>1</sup> As the URS is currently written it does not apply to legacy gTLDs.

However, rights holders complaining of infringements with new gTLD extensions have the choice of the URS or the UDRP.<sup>2</sup> The URS is similar to the UDRP in both the language of its three-part structure and its evidentiary demand for proving conjunctive bad faith, but it is dissimilar in being heavily prescriptive. In essence, Examiners are not authorized to leave the track laid out for them in the URS Procedure and Rules. They may cite to UDRP decisions and quote from the WIPO Overview for the purpose of capturing core principles and applying factors long agreed upon by consensus, but they do not share the same license as UDRP Panels to construe the language of the URS.

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<sup>1</sup> Statement of policy as expressed on the [ICANN website](#).

<sup>2</sup> URS Procedure 8.5: “When there is any genuine contestable issue as to whether a domain name registration and use of a trademark are in bad faith, the Complaint will be denied, the URS proceeding will be terminated without prejudice, e.g., a URS Appeal, UDRP, or a court proceeding may be utilized.”

However, Examiners are authorized to draw inferences although under circumstances more limited than UDRP Panels.

One change of language (or really transposition) from the UDRP for the second limb is worthy of note: instead of “rights and legitimate interests” (UDRP), URS Procedure 1.2.6.2 demands “legitimate right and interest.” Moving the qualifier to the front changes the emphasis: not just a “right” but a “legitimate” one.

Overall, Examiners are told that 1) Complainants must prove their claims by submitting clear and convincing rather than a preponderance of the evidence; and 2) the URS is not available a) to unregistered marks or registered marks for which there is no proof of “current use.”<sup>3</sup> or b) for any dispute “with open questions of fact” or in which there are “genuine issues of material fact.” If Complainant prevails it is limited to a single remedy, of suspension for the duration of the registration as opposed to cancellation or transfer of registration available under the UDRP.

On average through 2017 there have been approximately 200 UDR complaints a year, although twice as many rights holders who could have chosen the URS opted for the UDRP. There are two possible reasons for this, namely the higher standard of proof and the limited remedy. As with the UDRP, a substantial percentage of claims (which could be 90% or more) are sustained. However, unlike UDRP Panels many URS Examiners provide no reasoning in their decisions favoring rights holders although they

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<sup>3</sup> Some URS Examiners cite UDRP decisions and the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, now in its third edition (2015), in their decisions, although whether this jurisprudence is transferrable to the URS is an open question that will have to be answered as “probably not.”

are more forthcoming (albeit, modestly so) in decisions favoring domain name registrants.<sup>4</sup>

The purpose of this Examiners' Views of the URS Procedure and Rules is to assist parties and their representatives in preparing to meet the evidentiary demands in asserting and defending claims of cybersquatting. In order to provide some instruction for navigating the evidentiary demands of the URS the views in this collection are culled from decisions in which Examiners have provided a modicum of reasoning regardless of the prevailing party.

## **1. STANDARD OF PROOF**

### **Text**

[URS Procedure 8.2] The burden of proof shall be clear and convincing evidence.

[URS Procedure 8.3] For a URS matter to conclude in favor of the Complainant, the Examiner shall render a Determination that there is no genuine issue of material fact.

[URS Procedure 8.5] Where there is any genuine contestable issue as to whether a domain name registration and use of a trademark are in bad faith, the Complaint will be denied.... The URS is not intended for use in any proceedings with open questions of fact, but only clear cases of trademark abuse.

[URS Procedure 8.6] If the Examiner finds that any of the standards have not been satisfied, then the examiner shall deny the relief requested, thereby terminating the URS proceeding.

[URS Procedure 9.1] There will be no discovery or hearing; the evidence will be the materials submitted with the Complaint and the Response, and those materials will serve as the entire record used by the Examiner to make a Determination.

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<sup>4</sup> This is not intended as a criticism. The reasoning or lack of it reflects the reality of the 5-day turnaround for decisions and the low compensation for writing them.

**Comment:**

The URS is not intended for use in any proceedings with open questions of fact or genuine contested issues, but only for clear cases of trademark abuse.<sup>5</sup> The “clear and convincing evidence” standard presumably applies to all three limbs of the URS, but most particularly to the third, conjunctive bad faith. The reason for the “presumably” is that the second and third limbs can be shown to have their own standards which control the assessments.

For the first limb, the difference between the UDRP and the URS is that the UDRP is a low bar model and the URS a high bar model. The clear and convincing evidence standard is satisfied if a rights holder has a registered mark in use in commerce that is also a “word mark.” For the second limb, Complainants in both RPMs are required to offer sufficient evidence for a *prima facie* case. While for the URS this is a notch higher than the UDRP, for both the proof must be sufficiently clear to shift the burden of production to respondent. The higher standard comes into full play in proving the third limb, conjunctive bad faith.

Complaints must be dismissed under one or three circumstances: 1) Respondent (or the facts of record) rebuts Complainant’s claims for the second requirement; 2) Complainants fall short of proving conjunctive bad faith under the third limb; or 3) there is evidence of “genuine contestable issues” or there are “open questions of fact.”

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<sup>5</sup> The Examiner in [Virgin Enterprises Limited v. Lawrence Fain](#), FA1402001545807 (Forum March 20, 2014) (<branson.guru>) pertinently noted that the “URS process is a narrow one” and that it is “without prejudice to the Complainant... proceed[ing] with an action in [a] court of competent jurisdiction or under the UDRP” (URS Procedure 8.5).

## 2. JURISDICTION TO MAINTAIN A URS PROCEEDING

### A. Text

[URS Procedure 1.2.5 Complaint must include] The specific trademark/service mark upon which the Complaint is based and pursuant to which the Complaining Parties are asserting their rights to them, for which goods and in connection with what services.

[URS Procedure 1.2.6 Complaint must include] An indication of the ground upon which the Complaint is based setting forth facts showing that the Complaining Party is entitled to relief, namely

[URS Procedure 1.2.6.1] The registered domain name(s) is/are identical or confusingly similar to a word mark: (i) for which the Complainant holds a valid national or regional registration and that is in current use; or (ii) that has been validated through court proceedings; or (iii) that is specifically protected by a statute or treaty in effect at the time the URS complaint is filed.

a. Use can be shown by demonstrating that evidence of use – which can be a declaration and one specimen of current use in commerce – was submitted to, and validated by, the Trademark Clearinghouse)

b. Proof of use may also be submitted directly with the URS Complaint.

[URS Procedure 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; and

8.1.2.1 Use can be shown by demonstrating that evidence of use – which can be a declaration and one specimen of current use – was submitted to, and validated by, the Trademark Clearinghouse.

8.1.2.2 Proof of use may also be submitted directly with the URS Complaint.

### B. Examiners' Views

#### General Rules Applying to Both Parties

2.01 The URS mandates specific proof for standing to maintain a proceeding, but

Complainant is assisted by the trademark principle that registration of a mark is

*prima facie* evidence of validity, which creates a rebuttable presumption that the trademark is inherently distinctive.<sup>6</sup>

2.02 Core factors for assessing whether a domain name is identical or confusingly similar are the same as applied in UDRP disputes, namely 1) the gTLD is disregarded as a functional element (except where it complements the second level domain by spelling out the mark) and 2) additions, omissions, and transpositions are confusingly similar for the purpose of establishing standing. (Some Examiners cite UDRP decisions for these propositions).

### **Complainant’s Burden**

2.03 Complainants have jurisdiction to maintain a URS proceeding when they submit evidence of registered “word marks” that are in commercial use.<sup>7</sup> Registration of a figurative mark does not qualify for standing.<sup>8</sup>

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<sup>6</sup> Respondent appeared in [TUI FRANCE v. Guillermo Pérez et al.](#), FA140600 1567455 (Forum July 10, 2014) (MARMARA and <marmara.club>).

<sup>7</sup> [Ambatana Holdings v. WhoisGuard, Inc.](#), FA1710001739009 (Forum July 31, 2017) (<letgogifts.win>. “Complainant alleges that Complainant’s users were massively spammed in their apps ... [but] the case records do not allow verifying this. The Panel finds that the case would require more thorough review than it is possible under the URS Policy.”) Complainant in [Sks365 Malta Ltd., MT v. Mansour Ben Khamsa](#), D5C230DE (MFSD December 28, 2016) failed to show it currently held any trademark rights “on the sign ‘planet win 365’”.

<sup>8</sup> [Silit-Werke GmbH & Co KG](#), FA1611001701189 (Forum November 7, 2016) (<silit.shop>. “The Examiner did find evidence of a *figurative* EU mark in the Complaint, but did not find any evidence of a *word* mark in the Complaint. The Complaint mentions that the Complainant owns a global portfolio of registered trademarks for its Silit brand. However, the Complaint did not contain any evidence of a word mark ‘Silit.’”)

- 2.04 Complainants also lack standing for claims that domain names infringe unregistered marks,<sup>9</sup> or use third level domains<sup>10</sup>
- 2.05 Complainants may comply with this requirement by submitting copies of the registration of the mark, or verification of mark acknowledged by the Trademark Clearing House (TMCH) (URS Procedure 8.1.2).
- 2.06 Unless the domain name contains the mark in whole or in material part, it cannot be concluded that it is confusingly similar to the mark.<sup>11</sup> If the domain name is neither identical nor confusingly similar to Complainant’s mark the complaint must be dismissed.

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<sup>9</sup> See [BestReviews Inc. v. Domains By Proxy, LLC et al.](#), FA1602001659117 (Forum February 17, 2016) (<bestreviews.guide>. “[The] lack of a Trademark on the Principal Registry [is] dispositive of the matter in this forum.”) Illustrating another point well established in UDRP assessment, Panels authority to research and verify facts.

<sup>10</sup> [LA PRESSE, LTÉE v. WhoisGuard, Inc.](#), FA1703001720989 (Forum March 30, 2017) (<ca-actualites.club>. “The Complainant contends that the WHOIS record is for the second level domain “caactualites” within the “.club” generic top level domain (gTLD), and that the Registrant has registered and is using the third level domain “lapresse”, within the second level domain “caactualites” of the gTLD “.club”.... Here, the registered domain name at issue is <ca-actualites.club>, not <lapresse.caactualites.club>. Therefore, the domain name <ca-actualites.club> is not confusingly similar or identical to Complainant’s “LA PRESSE .CA (&DESSIN)” mark under URS Procedure 1.2.6.1(i).”)

<sup>11</sup> [FIBO Consulting, Ltd v. Whois Privacy Corp. et al.](#), FA1802001772404 March 6, 2018) (“We note in passing that Complainant cites to an earlier National Arbitration Forum proceeding to which Complainant and Respondent were parties (*FIBO Consulting LTD v. Domain Admin / Whois Privacy*, FA 1772404 (Nat. Arb. Forum January 18, 2018)), arguing that the decision favorable to it there demonstrates that it should likewise prevail here. But the Complaint here fails to acknowledge that the domain name at issue in the prior proceeding was <fibo-forex.net>, which the presiding examiner specifically found to be confusingly similar to Complainant’s FIBOGROUP mark. This difference between the two cases is critical to the outcome here.



### **3. LEGITIMATE RIGHT OR INTEREST TO THE DOMAIN NAME**

#### **A. Text**

[URS Procedure 1.2.6.2] Registrant has no legitimate right or interest to the domain name. [UDRP phrasing: “no rights or legitimate interests”]

[URS Procedure 5.4] [The Response should include the following:

[URS Procedure 5.4.3] Any defense which contradicts the Complainant’s claims.

[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.

[Similar but not identical to UDRP 4(c)(i-iii). For example, the UDRP includes the phrase “in particular but without limitation”].

[URS Procedure 5.8] The Registrant may also assert Defenses to the Complaint to demonstrate that the Registrant’s use of the domain name is not in bad faith show, for example one of the following:

[URS Procedure 5.8.1] The domain name is generic or descriptive and the Registrant is making fair use of it.

[URS Procedure 5.8.2] The domain name sites are operated solely in tribute to or in criticism of a person or business that is found by the Examiner to be fair use.

[URS Procedure 5.8.3] Registrant’s holding of the domain name is consistent with an express term of a written agreement entered into by the disputed Parties and that is still in effect.

[URS Procedure 5.8.4] The domain name is not part of a wider pattern or series of abusive registrations because the Domain Name is of a significantly different type or character to other domain names registered by the Registrant.

## **B. Examiners' Views**

### **General Rules Applying to Both Parties**

- 3.01 Passive holding of domain names can both support and undermine legitimate rights and interests. For well-known and famous marks, a Respondent's failure to justify its choice is conclusive that it lacks legitimate rights or interests. However, domain names composed of generic or common terms may support legitimate rights or interests unless there is compelling evidence Respondent has none.
- 3.02 Examiners adopt the same factors for assessing legitimate rights or interests as Panels in UDRP and cite UDRP decisions as consensus on this issue.
- 3.03 A basic rule formulated by UDRP Panels is that upon Complainant presenting a *prima facie* case showing that Respondent lacks legitimate right or interest rights in the domain name the burden shifts to Respondents to rebut the assertion,<sup>12</sup> and if it does so it prevails.
- 3.04 Complainant's burden is satisfied where Respondent 1) defaults and there is no evidence on the record evidencing any preparation to use the disputed domain name, 2) is not commonly known by the domain name, or 3) is not using the domain name for noncommercial or fair use.

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<sup>12</sup> Respondent appeared in *Tui France*, supra. and Examiner underscored two points: 1) MARMARA has no meaning in English or Spanish (Respondent's location); and 2) modifying the website after receipt of the complaint undercuts rather than supports rebuttal. Both these points are also factors in establishing abusive registration.

## Complainant's Burden

3.05 As it is Complainant's burden to prove its contention that Respondent has no legitimate right or interest to the domain name then Respondent must be presumed to be an innocent or good faith registrant until it is proved not to be.

3.06 Complainant supports its claim for the second requirement by presenting a *prima facie* case with evidence that is clear and convincing.

3.07 In assessing the facts, Examiner can draw evidentiary inferences for and against Respondent.<sup>13</sup>

3.08 Missing evidence supports the conclusion that such evidence either does not exist or if it exists it would be adverse to the interests of the party with the burden of proof or production.<sup>14</sup>

3.09 While use of a domain name to post parking and landing pages or PPC links may confer legitimate rights or interests arising from a "*bona fide* offering of goods or

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<sup>13</sup> [3S-Smart Software Solutions GmbH v. 1&1 Internet Limited et al.](#), FA1804001780832 (Forum April 27, 2018) (<codesys.expert>. “Although, the Complainant is not entitled to relief simply by default of the Respondent to submit a Response, the Examiner can however and does draw evidentiary inferences from the failure of the Respondent to respond. In view of the above, the Complainant has established a prima facie case of lack of rights and legitimate interest. Based on the record, the Respondent does not have rights or legitimate interests in the disputed domain.”

<sup>14</sup> [Express Scripts Strategic Development, Inc. v. Lan Qing Tian](#), FA1709001748589 (Forum October 3, 2017) (<expressscripts.top>) (“[E]ven though the Claimant mentioned ... correspondence between the Respondent and the Claimant, they also did not submit such correspondence.”)

services"<sup>15</sup> it does not if the content includes hyperlinks to goods or services competitive with those of the rights holder.<sup>16</sup>

3.10 If Complainant succeeds with its affirmative showing that Respondent lacks legitimate rights or interests, it moves on to the third limb with proof of conjunctive bad faith, and if it fails its complaint is dismissed.

### **Respondent's Rebuttal Burden**

3.11 Respondent's proof (or evidence in the record if it defaults) that the subject domain name was acquired for a bona fide purpose of offering goods and services supports a legitimate right or interest.<sup>17</sup>

3.12 A domain holder is always responsible for how the specific domain name is used and its content.<sup>18</sup> Respondents contention that it has not gained any benefit from the

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<sup>15</sup> [\*Dr. Ing. h.c. F. Porsche AG v. Interactiv Corporation\*](#), FA1407001571774 (Forum August 18, 2014 (<porsche.social>. The Examiner held that "Respondent states its intent is to create a free community to Porsche car enthusiasts and state a disclaimer on every webpage that Respondent is not affiliated to or authorized by the Complainant. The use of ".social" in the domain name, and the screenshot from Respondent's website are evidence of that intent. [Therefore,] Complainant has not established by clear and convincing evidence that Registrant has no right or interest in the domain name." ([Reversed on appeal](#) September 10, 2014)

<sup>16</sup> [\*Kingfisher France v. et al.\*](#), FA1805001788899 (Forum June 16, 2018) (<castorama.site>. "Complainant states that the webpage displays the CASTORAMA logo and contains business information on the Complainant (especially on its Russian stores) and on home improvement products (each time displaying them in impersonating the complainant).

<sup>17</sup> *Reinalt-Thomas Corporation d.b.a Discount Tire, supra.* (<discounttire.direct>: Examiner accepted the proposition that "Respondent has a legitimate interest in the domain name because the domain is a generic or descriptive term that describes the product that Respondents sell; discounted tires that are sold directly to consumers."

<sup>18</sup> [\*Dr. Ing. h.c. F. Porsche AG v. Interactiv Corporation\*](#), FA1407001571774 (Forum August 18, 2014, reversed on appeal September 10, 2014) (<porsche.social>. "The Respondent denies to have actively created the site with the links and advertisements, and claims to have no commercial activities. However, as clearly stated in several UDRP cases, use of a domain name to post parking and landing pages or PPC links does not *of itself* confer rights or legitimate interests arising from a "bona fide offering of goods or services" or from "legitimate

websites (even assuming it is true) is irrelevant to actual gain of benefit since “the use mechanism of the disputed domain names to gain benefit is sufficient to recognize bad faith use of the disputed domain names.”<sup>19</sup>

3.13 Respondents may have a legitimate right and interest in domain names composed of lexical parts identical or confusingly similar to marks as long as they are capable of being used without infringing Complainant’s rights.<sup>20</sup>

3.14 Legitimate rights or interests extends to all Respondents whether they use domain names for their businesses<sup>21</sup> or offer them for resale on the secondary market,<sup>22</sup> so long as the domain names have not been acquired for an unlawful purpose.

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noncommercial or fair use" of the domain name, especially where resulting in a connection to goods or services competitive with those of the rights holder.”)

<sup>19</sup> [\*Interbrand Group v. WhoisGuard, Inc. et al.\*](#), FA1605001673323 (Forum May 23, 2016, reversed on appeal June 15, 2016) (<brandchannel.xyz> and <interbrand.club>. The quotation is from the appeal decision.

<sup>20</sup> *Ambatana Holdings v. WhoisGuard, Inc.*, supra. “[G]iven that the word mark in question [LET GO] is a dictionary term and its use in the disputed domain name is descriptive of the activities of its operator, Complainant [is required to provide] arguments and evidence in support of secondary meaning and reputation associated with the mark. While this Panel has no reasons to question Complainant’s allegations, it is found that Complainant has not met its burden of proof under the clear and convincing evidence standard provided by the URS Policy.”)

<sup>21</sup> [\*Reinalt-Thomas Corporation d.b.a Discount Tire v. Extreme Customs, LLC et al.\*](#), FA1709001749615 (Forum October 4, 2017) (<discounttire.direct>. Citing WIPO Overview 3.0: “Rights or legitimate interests in a domain name can be found based on its dictionary meaning, in particular if the domain name is genuinely used in connection with the relief-upon dictionary meaning.”)

<sup>22</sup> [\*HOLA S.L. v. North Sound Names et al.\*](#), FA1407001570171 (Forum August 9, 2014) (<hello.photo>. “Previous decisions involving domain names based on generic, commonly used terms are consistently denied, protecting the right of domain registrants to retain such domains against trademark owners. These include <hood.com> (FA0408000313566), <cotton.biz> (FA0205000114388), <deluxe.biz> (FA0204000 112601), <stage.com> (FA1203001434227), <target.org> (FA0405000267475), <ace.com> (FA080200 1143448), <shoppers.com> (FA0802001142605), <zero.net> (FA0712001118584), <acquire.com> (FA0604000671532), <tiger.com> (FA0311000214418), <boy.com> (FA0304000 154646), and <cartoys.net> (FA0002000093682) amongst others. In such cases, for the complainant to prevail, there must be some other proof to evidence bad faith, such as actual notice of trademark prior to registration

3.15 Domain names composed of dictionary words (alone or combined with other dictionary words), arbitrary letters,<sup>23</sup> and common terms such as geographic locations<sup>24</sup> and surnames<sup>25</sup> are presumed to have been registered innocently and in good faith unless Complainant offers affirmative evidence that Respondent lacks legitimate rights or interests.

3.16 Where Respondent has a plausible explanation for the registration of a domain name composed of generic or common terms but fails to offer evidence of demonstrable preparations it is nevertheless raises a genuine issue of material fact sufficient to rebut Complainant's contention that Respondent lacks legitimate rights or interests in the domain name.<sup>26</sup>

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(<ancestry.com> FA1405001560028) or evidence of a pattern of registering domains using protected marks (<despair.net> FA1203001435300).”

<sup>23</sup> *FUTBOL CLUB BARCELONA v. Joerg Lindemer et al.*, FA1409001580834 (Forum October 10, 2014) (<fcb.email>. “The Examiner notes that there are many trademarks including letters FCB registered all around the word – TMview displays 151 results while searching for ‘FCB.’”)

<sup>24</sup> *Eastbay, Inc. v. Page Howe et al.*, FA1606001680990 (Forum July 11, 2016) (<eastbay.xyz>. “The word ‘EAST BAY’ or ‘EASTBAY’ may refer to (a) geographical region(s) as well as to the Complainant’s trademarks. The Examiner cannot exclude that the Respondent has legitimate rights or interests in the domain name. The Complainant has not demonstrated the second element of the URS by a standard of clear and convincing evidence.”)

<sup>25</sup> *Virgin Enterprises Limited, supra*: “[T]he only use of the disputed domain name that has been provided by Complainant is what appears to be a generic, monetized parking page for the registrar, Go Daddy, which does not appear to include any references to Complainant, Richard Branson or the BRANSON trademark”). Branson is also a geographical term; there is a city by that name in the U.S.

<sup>26</sup> *Netflix, Inc. v. Masterclass Media et al.*, FA1509001639527 (Forum October 2, 2015) (<netflix.news>. An alleged fan website, not currently active, but “[b]ecause this record raises, but does not provide adequate information to conclude whether or not Respondent has a legitimate right or interest to the domain name, I must find for the Respondent on this element.”); *Deutsche Lufthansa AG. v. Global LLC*, FA1704001728186 (Forum May 11, 2017) (<lufthansa.review>. Offering reviews “could have a lawful, noninfringing use.”)

3.17 A second level domain “so generic that there is no better way to describe what respondent actually does” can be characterized as a lawful registration. (URS Procedure 5.8.1).

## **4. REGISTRATION AND USE IN BAD FAITH**

### **A. Text**

[URS Procedure 1.2.6.3] The domain name(s) was/were registered and is being used in bad faith [Word for word identical with the bad faith requirement under the UDRP].

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 online 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.

URS Procedure 5.9.1 Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves not indicia of bad faith under the URS. Such conduct, however, may be abusive in a given case depending on the circumstances of the dispute. The Examiner must review each case on its merits.

URS Procedure 5.9.2 Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) does not in and of itself constitute bad faith under the URS. Such conduct, however, may be abusive in a given case depending on the circumstances of the dispute. The Examiner will take into account:

5.9.2.1. the nature of the domain name;

5.9.2.2. the nature of the advertising links on any parking page associated with the domain name; and

5.9.2.3. that the use of the domain name is ultimately the Registrant’s responsibility.

[URS Rules, Rule12(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.

NOTE 1: In determining whether the conduct is actionable, Examiners have cited as authority UDRP decisions and the WIPO Overview as guides to their assessments. URS Procedure acknowledges the existence of a secondary market in domain names in Paragraph 5.9.1: “Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves not indicia of bad faith under the URS.”<sup>27</sup>

## **B. Examiners’ Views**

### **General Rules Applying to Both Parties**

4.01 While a finding in Complainant’s favor that Respondent lacks legitimate rights or interests is not conclusive of abusive registration it is a compelling factor in determining that it is, always with the proviso that any doubt favors Respondent.

4.02 On the issue of passive holding, use in bad faith does not require Complainant prove in every instance that a respondent is taking positive action. The consensus view deriving from UDRP decisions is that “inaction is within the concept [of use]” in that by “[o]ccupying an entry in the DNS is ‘use’ . . . it has a blocking function.”<sup>28</sup>

4.03 Critical factors in concluding that Respondent is using the domain name in bad faith includes knowledge or awareness of the mark and whether Respondent had it in mind at the time of the registration of the domain name. Although the Procedure and

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<sup>27</sup> In *Wolfram Group LLC v. Andrew Davis et al.*, FA1404001554143 (Forum May 5, 2014) (<wolfram.ceo> the appeal Panel misstated the law--- “[It] considers that holding such a large portfolio of domain names is an indicia of bad faith, particularly considering that, as seen in this case, an identical trademark owned by a third party is involved (See URS Case #1550814 (“*ArcelorMittal vs Andrew Davis*” [<mittal.ceo>]---although declared Respondent registered and was using the domain name in bad faith on the merits.)

<sup>28</sup> A concept initially formulated in *Telstra Corporation Limited v. Nuclear Marshmallows*, D2000-0003 (WIPO February 18, 2000) that quickly became the consensus view.



Rules make no reference to knowledge or lack of it as a factor Examiners have adopted the requirement from UDRP consensus.

4.04 Complainant is expected to offer evidence that Respondent registered the domain name with knowledge of its mark and with the intention of taking advantage of the goodwill and reputation that has attached to it. Respondent has the opportunity of rebutting knowledge of the mark even if it is found to lack legitimate rights or interests to the domain name.

4.05 Factors to be considered in assessing a mark include its reputation at the time the domain name was registered, the respective locations of the parties, or the lexical quality of the term, whether it is composed of random letters, dictionary words, or common phrases.

4.06 Proof of spoofing (payment instruction fraud), phishing and other kinds of fraud (such as pretending to be a company offering career opportunities) are *per se* violations of the Policy.<sup>29</sup>

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<sup>29</sup> [Anastasia Berverly Hills, Inc. v. Dimitrije Zivadinovic](#), FA1706001734622 (Forum June 26, 2017) (<anastasiaberlygiveaway.xyz>. “This is classic fraudulent ‘phishing’ and in and of itself shows bad faith registration and use. Such use further shows actual knowledge by Respondent of Complainant’s rights and interests in its own protected mark and goods and services and supports findings here that Respondent registered and uses this site in bad faith.”)

## Complainant's Burden

4.07 The URS is designed for “rights holders experiencing the most clear-cut cases of infringement.” The term “clear and convincing evidence” means concrete evidence.<sup>30</sup>

4.08 It is Complainant's duty to explain why the domain being challenged violates the prior trademark rights,<sup>31</sup> and support its claim with relevant documentary evidence.<sup>32</sup>

4.09 Infringement is determined upon the entire record, which may include evidence of the content of the resolving website, such as offering competitive products<sup>33</sup>, of

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<sup>30</sup> [Wikimedia Foundation, Inc. v. WhoisGuard, Inc.](#), FA1804001780755 (Forum April 26, 2018) (<Wikipedia.kim>. The Examiner deplores the fact that the Complainant has not submitted any evidence supporting its claim of bad faith use and registration. The Examiner would have expected the Complainant to provide evidence of, for instance, the website associated with the disputed domain name. The Examiner notes that the Complainant submitted a screenshot of its own website (associated with its own domain name <Wikipedia.org>), but not of the Respondents website (associated with the disputed domain name <Wikipedia.kim>.”)

<sup>31</sup> [Skechers U.S.A. Inc. II v. Privacy Protect, LLC \(PrivacyProtect.org\)](#), FA1805001786732 (Forum June 7, 2018) (<skx.science>. “Even though the Complainant claimed that the domain name resolves to a parking page where no information is displayed, according to the screen shot provided by the Complainant, it seems that there is an active literary website managed by Andres Thomas Conteris and there is not any clear evidence which shows the Respondent's commercial gain over the disputed domain. In this respect, the Examiner finds that the bad faith of the Respondent is not proven by the Claimant.

<sup>32</sup> [MultiHost LLC v. Sergey Ermilov](#), FA1610001697738 (Forum November 2, 2016) (<multihost.pro>. “Even though the Claimant has in their complaint that the disputed domain name resolves to the commercial website for game hosting servers and the function of the website is strictly commercial, and that the evidence was annexed, the complaint did not have relevant annexes (as stated in the complaint) showing the commercial use and bad faith of the Respondent. The Examiner finds that the bad faith of the Respondent is not proven by the Claimant.”)

<sup>33</sup> [ASOS plc et al. v. WhoisGuard, Inc.](#), FA1804001781372 (Forum May 2, 2018) (asosstore.store. “[Also] use[s] ... the Complainant's logo ‘ASOS’ on the website available through the domain name, combined with the use of the domain name for selling products that compete with the products offered for sale by the Complainant.”)

Respondent's knowledge of Complainant's mark<sup>34</sup>, of Respondent redirecting the domain name to its own website<sup>35</sup> or pointing the domain name to an active website referring to Complainant's goods<sup>36</sup>, or of Respondent admitting a material fact that supports bad faith use.<sup>37</sup>

4.10 Concrete evidence includes offering 1) documentary evidence of complaints and reports regarding using the domain name for an improper purpose<sup>38</sup>, 2) screenshots of the resolving website impersonating Complainant,<sup>39</sup> 3) selling counterfeit

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<sup>34</sup> *3S-Smart Software Solutions GmbH, supra.*: “The Registrant is required to have clicked on the notice Acknowledge claim when presented with the Trademark Claims notice to complete registration of the name. Thus, respondent Registrant at the time of registration of the disputed domain name knew of the existence of the Complainant's trademarks and, e.g. by reviewing the English Language contents of the Complainant's website [www.codesys.com](http://www.codesys.com), readily may have taken notice of active and intensive use of the term codesys both as a trademark for the designation of services and goods in relation to automation software and software for industrial controllers, as well as in the form of a second level domain under the TLD.com. Thus, clearly and convincingly, codesys has been registered as a second level domain under <codesys.expert> in bad faith for any or all of the exemplary purposes according to 1.2.6.3 a through d.”

<sup>35</sup> *Deutsche Lufthansa AG v. aopc interactive GmbH, supra.* (Redirecting).

<sup>36</sup> *GFPI S.A. v. Michael Meyer et al.*, FA1702001716444 (Forum February 21, 2017) (“The use, even if it is not traditionally active use, to point <greubel-forsey.watch> to a parking site, with just general information on what a holder of a domain name can do with activating e-mail, creating web sites, etc, are further indications and messages to the Complainant that this domain name - clearly referring to the goods provided by the Complainant - can or will shortly be used in some way. The Examiner cannot see this in any other way than a "hidden" message to the Complainant to quickly buy <greubel-forsey.watch> from the Respondent - likely for valuable consideration in excess of documented out-of pocket costs directly related to the domain name.”)

<sup>37</sup> *Aeropostale Procurement Company, Inc. v. Michael Kinsey et al.*, FA1403001550933 (Forum april 28, 2014) (<aeropostale.uno>. “The rule stemming from URS 1.2.6.3 (d) is satisfied since the Respondent admitted that he has registered the domain to take "an opportunity similar to when .com first came into existence" so purely for a reason of expected gain resulting from using the ‘AEROPOSTALE’ mark.” [Initially denied; reversed and suspended on appeal.](#)

<sup>38</sup> *Ambatana Holdings, supra.*: “Complainant alleges that Complainant's users were massively spammed in their apps ... [but] the case records do not allow verifying this. The Panel finds that the case would require more thorough review than it is possible under the URS Policy.”)

<sup>39</sup> *Wolford Aktiengesellschaft v. dawei et al.* FA1705001733550 (Forum June 14, 2017) (“Respondent's use of the domain name is to impersonate Complainant, claiming to operate an

goods,<sup>40</sup> 4) linking to goods or services competitive with Complainant or covered by the Complainant's trademark registrations<sup>41</sup>, or 5) redirecting domain name to respondent's website.<sup>42</sup>

4.11 To prevail on the bad faith limb Complainant must include proof of the scope of its business<sup>43</sup>, that Respondent had actual knowledge of its mark<sup>44</sup> and is targeting it. Factors considered include locations of the parties, and if different jurisdictions the penetration of the mark in Respondent's jurisdiction, and whether the domain name is composed of dictionary words or other common and descriptive terms.

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"Official" site selling Complainant's goods. The website further copies the look and feel of Complainant's website, and copies various product photos of Complainant's goods. This is not a bona fide use of the domain name nor does it establish any lawful rights under the policy.")

<sup>40</sup> [W.L. Gore & Associates Inc v. WhoisGuard, Inc. et al.](#), FA1711001758178 (Forum December 6, 2017) (<goretexgiyim.world>. "[T]he impression created by ... Registrant's website is [that it is] an original online shop of the Complainant with even more convenient prices but offering counterfeit products"); [Eli Lilly and Company v. Shaternik et al.](#), FA170500 1731038D (Forum June 1, 2017) (Offering counterfeit products on dozens of websites).

<sup>41</sup> [ASOS plc et al. v. WhoisGuard, Inc.](#), FA1804001781372 (Forum May 2, 2018) (asosstore.store. "[Also] use[s] ... the Complainant's logo 'ASOS' on the website available through the domain name, combined with the use of the domain name for selling products that compete with the products offered for sale by the Complainant.")

<sup>42</sup> [Deutsche Lufthansa AG v. aopc interactive GmbH](#), FA1804001781509 (Forum April 20, 2018) (<milesmore.online>. "Complainant has shown that the Respondent uses the domain to host content about services of his company regarding Windows and redirects to the domain iis.net.")

<sup>43</sup> [MISSLER SOFTWARE SA v. Jonas Kropf](#), FA1707001738392(Forum February 17, 2016) (<topsolid.xyz>. "The Complainant has not provided any information with regard to its scope of business activity, especially in Switzerland, where the Respondent is located. Furthermore, the disputed domain name is a combination of the generic words "top" and "solid" and the Complainant provided no evidence that the Respondent deliberately targets its trademark.")

<sup>44</sup> Respondent in [Canon Kabushiki Kaisha v. North Sound Names et al.](#), FA1507001628473 (Forum September 11, 2015 [determination of bad faith confirmed on appeal](#)) (<eos.blackfriday>. "concedes it had express notice of Respondent's rights in its EOS trademark by virtue of Complainant's registration of the EOS trademark with the Trademark Clearinghouse.")

4.12 Common or ordinary expressions or two word phrases raise genuine issues of fact but registration of dictionary words corresponding to coined phrase-marks having priority over the domain name supports registration in bad faith.<sup>45</sup>

### **Respondents Rebuttal Burden**

4.13 Any use of a domain name that is not clearly infringing raises a “genuine issue of material fact” as does nonuse that could conceivably be used in a noninfringing way.<sup>46</sup>

4.14 Respondent satisfies its burden of production by offering proof that contradicts Complainant’s claims or the record contains extrinsic or countervailing evidence of genuine issues of material fact, for example that Respondent acquired the subject domain name for a bona fide purpose of offering goods and services.<sup>47</sup>

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<sup>45</sup> [Deutsche Lufthansa AG v. Domains By Proxy, LLC](#), FA1805001788624 (Forum June 15, 2016) (<staralliance.app>. “The Complainant stated that someone who uses an identical trademark that evidently belongs to a third party to build a domain name where only difference is the suffix.app, knows the trademark since it’s impossible to coin an identical word by coincidence.”

<sup>46</sup> [The Prudential Insurance Company of America v. Terrance McQuilkin et al.](#), FA1505001618256 (Forum May 29, 2015) (<rocksolid.financial>. Complainant has no exclusive right to “rocksolid” or “financial” if the domain name can be used without infringing its rights).

<sup>47</sup> [Reinalt-Thomas Corporation d.b.a Discount Tire, supra.](#) (<discounttire.direct>: Examiner accepted the proposition that “Respondent has a legitimate interest in the domain name because the domain is a generic or descriptive term that describes the product that Respondents sell; discounted tires that are sold directly to consumers.”

- 4.15 A domain name composed of a dictionary word mark,<sup>48</sup> alone or combined with another word at the second or top level<sup>49</sup> that describes complainant’s business is clear and convincing evidence of abusive registration only when the combined words cannot plausibly be used without infringing complainant’s right.<sup>50</sup>
- 4.16 Registrations are not unlawful if dictionary words, alone or combined, letters or common phrases are plausibly capable of having other or multiple associations,<sup>51</sup> although infringement may be supported by website content.<sup>52</sup>
- 4.17 Passive holdings of domain names that cannot be said to be clearly and convincingly infringing Complainant’s rights cannot be found to have been registered in bad faith.

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<sup>48</sup> [Principal Financial Services, Inv. v. T YS et al.](#), FA1407001570598 (Forum August 11, 2014) (<principal.services>. Holders of protected marks which are also commonly used, generic terms should ensure prompt registration of their desired domains, as their trademarks, on their own accord, will not suffice to succeed on claims against legitimate registrants of such domain names.”)

<sup>49</sup> [Roofoods Ltd v. Henri Luecke](#), FA1804001781112 (Forum May 1, 2018) (<deliverooo.delivery>. “Such finding [of bad faith [ is supported by the fact that the gTLD of the disputed domain name clearly refers to the Complainant’s core business.”)

<sup>50</sup> *Michael Page Recruitment Group Limited v. Tassanee Atsawasakundee, KTI Recruitment Consultants Co. Ltd.*, HKS-1400001 (ADNDRC May 11, 2014) (<michaelpage.careers>. Suspended. Michael Page is in the business of career counseling).

<sup>51</sup> *Reinalt-Thomas Corporation d.b.a Discount Tire, supra*. Examiner approves Respondent’s citation to *Eauto, LLC v. Triple S Auto Parts*, (WIPO March 24, 2000) (“eautolamps”, which was similar to the complainant’s “EAUTO” for a domain that describes the product Respondent sold, which he had a legitimate interest in because he sold auto lamps online.)

<sup>52</sup> *Canon Kabushiki Kaisha, supra.*: “[I]n accordance with Paragraph 5.9.2, of the URS Procedure, a domain name redirecting to a website displaying pay-per-click links does not in and of itself constitute bad faith under the URS. Nonetheless, such conduct may be abusive, as in the current circumstances. Blackfriday is the day after Thanksgiving Day in the United States in which stores and manufacturers offer promotional sales. Hence, it is understood as an expression referring to promotions. Taking that into account, «eos.blackfriday» would attract consumers interested in EOS goods.

4.18 Passive holding of domain names is not *per se* evidence of bad faith.<sup>53</sup> Common words and descriptive phrases are legitimately subject to registration as domain names on a 'first-come, first-served' basis.<sup>54</sup> Potential lawful noninfringing use trumps allegations of bad faith registration unless the lexical composition of the domain names or resolving website clearly establishes unlawful registration.<sup>55</sup>

4.19 However, resolution to an inactive website can support a conclusion of bad faith registration and bad faith use based on a principle established under URDP jurisprudence that an inference will be drawn from respondent's choice of name when "it is not possible to conceive of any plausible actual or contemplated active use of the Domain Name by respondent that would not be illegitimate."<sup>56</sup>

4.20 However, 1) merely holding large portfolios of domain names would not, of itself, constitute an indicia of bad faith, and 2) resolution of a domain name composed of common terms (dictionary words, letters, descriptive phrases, etc.) to an active

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<sup>53</sup> [\*The Prudential Insurance Company of America v. Terrance McQuilkin et al.\*](#), FA1505001618256 (Forum May 29, 2015) (<rocksolid.financial>. Complainant has no exclusive right to "rocksolid" or "financial" if the domain name can be used without infringing its rights). Compare with *BNP PARIBAS v. Privacy Protect, LLC (PrivacyProtect.org)*, FA1803001775308 (Forum March 27, 2018) (<hellobank.club> in which the addition of "bank" to "hello" specifically identifies Complainant as the target of the registration and is therefore abusive even though the domain name does not resolve to an active website.)

<sup>54</sup> *HOLA S.L.*, *supra*, dictionary words.

<sup>55</sup> [\*Boucheron Holding SAS v. zhouhaotian et al.\*](#), FA1605001676556 (Forum June 12, 2016) (<boucheron.pub>. "While this Examiner can envision numerous hypotheticals where a registrant's passive holding of a domain name would support, by clear and convincing evidence, that a domain name is being used in bad faith, Complainant has put forth no facts to support such a conclusion in this case." The word "boucheron" (aka *Bûcheron* and *Bucheron*) apart from being a well-known jewelry and watch house is also a goat's milk cheese native to the Loire Valley in France.)

<sup>56</sup> *Telstra Corporation Limited*, *supra*.

website that contains links unrelated to Complainant's business raises triable issues that support denial of the complaint.

4.21 The registration of domain names composed of short letter strings that Complainants contend are identical to acronyms of their registered marks and Respondents contend are random letters fail the URS test, namely for the reason that there are "open questions of fact" (URS Procedure 8.5).

## **5. DEFAULT**

### **A. Text**

[URS Rules, Rule 5(i)] If a response is determined to be non-compliant for reasons other than non-payment, the Examiner is permitted to make any reasonable inferences from the inadequacy of the Response.

[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, 5.7.2, and 5.7.3 are identical to the defenses set forth in the UDRP].

[URS Procedure 5.8] The Registrant may also assert Defenses to the Complaint to demonstrate that the Registrant's use of the domain name is not in bad faith by showing, for example, one of the following:

5.8.1 The domain name is generic or descriptive and the Registrant is making fair use of it.

5.8.2 The domain name sites are operated solely in tribute to or in criticism of a person or business that is found by the Examiner to be fair use.

5.8.3 Registrant's holding of the domain name is consistent with an express term of a written agreement entered into by the disputing Parties and that is still in effect.

5.8.4 The domain name is not part of a wider pattern or series of abusive registrations because the Domain Name is of a significantly different type or character to other domain names registered by the Registrant.

[URS Procedure 6.3] All Default cases proceed to Examination for review on the merits of the claim.

[URS Procedure 6.6] If after Examination in Default case, the Examiner rules in favor of Registrant, the Provider shall notify the Registry Operator to unlock the name and return full control of the domain name registration to the Registrant.

Of Particular Note: Suspension can be temporarily lifted under the following circumstances and (depending on the circumstances) suspension can be reimposed:



[URS Procedure 6.4] If after Examination in Default cases, the Examiner rules in favor of Complainant, Registrant shall have the right to seek relief from Default via de novo review by filing a Response at any time up to six months after the date of the Notice of Default. The Registrant will also be entitled to request an extension of an additional six months if the extension is requested before the expiration of the initial six-month period.

## **B. Examiners' Views**

**5.01** Default in responding to a complaint is neither an admission nor conclusive of liability, but Respondent's silence will have consequences.

**5.02** Even though Respondents may be found to lack legitimate rights or interests, that determination is not conclusive of abusive registration (third limb requirement) but it is nevertheless a compelling factor that the registration targets Complainant's mark.

## **6. THE RECORD**

### **A. Text**

[URS Procedure 9.1] [T]he evidence will be the materials submitted with the Complaint and the Response, and those materials will serve as the entire record used by the Examiner to make a Determination.

### **B. Examiners' Views**

**6.01** Documentary proof that fails to make it into the record because untimely submitted is excluded from consideration in assessing the merits of a claim. However, the exclusion can be corrected if Complainant pays for a reconsideration on appeal. See URS procedure 12.1: "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."

## **7. REMEDY**

### **A. Text**

[URS Procedure 10.1] If the determination is in favor of the Complainant, the decision shall be immediately transmitted to the Registry Operator, the Complainant, the Respondent and the Registrar.

[URS Procedure 10.3] There shall be an option for a successful Complainant to extend the registration period for one additional year at commercial rates.

[URS Procedure 10.4] No other remedies should be available in the event of a Determination in favor of the Complainant.

**Note:** As currently written, suspension is the sole remedy. Complainants who prefer a transfer remedy have a right to initiate a UDRP proceeding. Twice as many Complainants who would otherwise qualify for standing in a URS proceeding have opted for the UDRP.

### **B. Examiners' Views**

**7.01** Issue dictated by URS Procedure.

## **8. APPEAL**

### **A. Text**

[URS Procedure, Paragraph 12.2 and Rules, 19(b)] Appellant shall have a limited right to introduce new admissible evidence that is material to the Determination . . . provided the evidence clearly pre-dates the filing of the Complaint.

[URS Rules, 19(a)] The Provider is responsible for providing the entire record in the underlying proceeding to the Appeal Panel.

[URS Rules, 19(f)] The remedies for an Appeal are limited to

(i) Affirmation of the Final Determination and the Remedy ordered. If the domain name is suspended, it shall remain suspended. If the domain name is with the Registrant, the Registry Operator shall promptly unlock the domain name following receipt of the Appeal Determination.

(ii) Overruling of the Final Determination and the Remedy ordered. If the domain name is suspended, the Registry Operator shall unlock the name and return full control of the domain name registration to the Registrant. If the domain name is with the Registrant, the Registry Operator shall immediately follow the steps in URS Procedure Paragraph 10.2 to suspend the domain name.

[URS Procedure 12.1] "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.”

**Note:** The URS Procedure and Rules do not prescribe a standard for sustaining or reversing an Examiner’s decision, but appellant has the burden of demonstrating error either as a matter of fact or as a matter of law.

## **B. Examiners’ Views**

**8.01** The Examiner may take “new admissible evidence” into account on appeal if it “clearly pre-dates the filing of the complaint”<sup>57</sup> and for assessing whether it satisfies the clear and convincing evidence standard.<sup>58</sup>

**8.02** While Respondent is not governed by the clear and convincing standard, it does have the burden on appeal of demonstrating that the decision to suspend is not supported by the law or facts.<sup>59</sup>

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<sup>57</sup> [\*GFPI S.A. v. Michael Meyer et al.\*](#), FA1702001716444F (Forum February 21, 2017) (<tagheuer.digital>. Initially denied; reversed and suspended on appeal [FA1702001716444A](#) (Forum March 22, 2017) (“The Complainant submitted additional evidence, which, however, does not pre-date the filing of the Complaint.”))

<sup>58</sup> [\*LVMH SWISS MANUFACTURES SA v. GiftSMS et al.\*](#), FA1509001637103 (Forum November 24, 2015)

<sup>59</sup> *GFPI S.A.*, *supra*: ([Appeal decision](#)): “The Respondent again points to the fact that the disputed domain name was registered but not used in connection with a website by the Respondent. The Respondent argues that, consequently, no trademark rights are infringed. It also questions the URS proceeding and the FORUM's role *per se* and argues that the Complainant targets the Respondent. The Respondent states that it is willing to consider reasonable offers for the disputed domain name). Compare with *Grey Global Group LLC v. i-content Ltd. et al.*, FA1606001681062 (Forum July 8, 2016) (<grey.email>. Complaint initially denied; denial confirmed on appeal).

*Canon Kabushiki Kaisha*, *supra*. ([Appeal decision](#)): “The top-level domain <.blackfriday> is a direct reference to what has become traditionally the biggest annual shopping day in the United States, where retail goods are offered at significant discounts.... On Respondent’s own case, Respondent’s website ‘lander’ has been designed to include categorical suggestions which resonate with the user’s reason for typing in <eos.blackfriday>, which demonstrates that users interested in purchasing Complainant’s EOS goods at a discount on Black Friday would be provided with sponsored links relating to such goods.”)