

EXAMINERS' VIEWS OF URS PROCEDURE AND RULES

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NOTE: The purpose of this Examiners' Views of the URS Procedure and Rules is to assist parties and their representatives in understanding its evidentiary demands. In contrast to the reasoned decisions typically found in UDRP decisions, the reasoning in URS decision is minimal and thin. The views in this collection of Examiners' Views are culled from decisions in which Examiners have provided a modicum of reasoning to explain why the prevailing or losing party has satisfied or failed of proof.

Introduction

The Uniform Rapid Suspension System (URS) is one of four 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. The other three are the Trademark Clearinghouse (TMCH), Sunrise (a 90-day period during which owners whose trademarks have been verified by the TMCH may preregister names corresponding to their trademarks), and Trademark Claims Notices (a TMCH warning service to registrants of possible infringements intended to discourage them from completing purchases of domain names identical or confusingly similar to marks).

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.”¹ The phrase “clear-cut cases of infringement” announces the jurisdictional limitation of the URS. For disputes that are outside its scope, the remedy must be sought in the UDRP or courts of competent jurisdiction. As URS is currently written it does not apply to legacy gTLDs.

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

However, rights holders complaining of domain names within the scope of the URS have the choice of the URS or the UDRP.² This is a right expressly written into the URS Procedure.³ Indeed, there are two circumstances under which Complainants can use both successively: if they lose the URS⁴ or prevail with the URS and commence a UDRP to obtain the the transfer remedy.⁵

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. (The UDRP is lightly prescriptive). What “highly prescriptive”

² 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.”

³ URS Procedure 13: “The URS Determination shall not preclude any other remedies available to the appellant, such as UDRP ... or other remedies as may be available in a court of competent jurisdiction.”

⁴ *Bloomberg Finance L.P. v. zhang guo jie*, FA1703001721683 (Forum March 31, 2017) (<bloomberg.site>. A URS proceeding: “The Complaint is . . . devoid of any allegations or proof of facts tending to show, even *prima facie*, either that Respondent has no right to or legitimate interest in the <bloomberg.site> domain name, or that the domain name was registered and is being used by Respondent in bad faith.”) Complainant then commenced a UDRP with the same result, *Bloomberg Finance L.P. v. zhang guo jie*, FA1704001727926 (Forum June 8, 2017) (“[E]ven taking account of the public use which has been made of the trademark, it is a common family name . . . which might remain open to use in good faith by any number of traders. . . . This is not a case of an invented word with no connotation other than the goods or services of a single trader where it is difficult to perceive of any good faith use. Absent any use or other telling indicia, an inference of likely bad faith use could here only rest on supposition.

⁵ [Casale Media, Inc. v. PERFECT LLC et al.](#), FA1608001689725 (Forum September 6, 2016) (<casalemedia.support> Complainant won suspension, then commenced a UDRP for transfer of the domain name, [Casale Media, Inc. v. \(Name redacted\) / PERFECT PRIVACY, LLC](#), FA1610001696719 (Forum November 10, 2016); [Boursorama S.A. v. GDPR Masked et al.](#), FA1807001794828 (Forum July 18, 2018) and [Boursorama S.A. v coupe](#), CAC 102082 (ADReu September 4, 2018) (<redirect-bourso.tech>, <redirect-bourso.space>, <redirect-bourso.site>, and <redirect-bourso.online>). Though not done often, there is good reason for proceeding in this manner in that suspension (an injunction equivalent) is effective immediately upon filing the award and has the effect of taking down the website, while locking under the UDRP does not. Injunction first, then take the domain names out permanently by transfer.

means is that 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 even quote from the WIPO Overview, now in its Third Edition for the purpose of citing core principles and applying factors long agreed upon by consensus, but they do not have the same license as UDRP Panels to construe the language of the URS. They are authorized to draw inferences but the inferences must satisfy the higher standard of clear and convincing evidence. If a material fact can only be proved by inference is raises a genuine issue of material fact that is outside the scope of the URS.

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 of the phrase changes the emphasis: not just a “right” but the right must be “legitimate.” This is consistent with the clear and convincing standard of proof.

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.”⁶ or b) for any dispute “with open questions of fact” or in which there are “genuine issues of material fact.”

⁶ 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 depends on the principal for which it is being cited.

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 although it has the option “to extend the registration period for one additional year”⁷ which in essence means extending the suspension of the infringing domain name.

On average through 2017 there have been approximately 200 UDR complaints annually, although more than twice as many rights holders opted for the UDRP. There are two possible reasons for rejecting the URS, 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 are more forthcoming in providing reasons when they favor domain name registrants.⁸

Finally, the default language under the URS is English. This contrasts with the UDRP which provides that it “shall be the language of the registration agreement” (Rule 11(a)). URS Procedure 4.2 provides that “[t]he Notice of Complaint shall be in English and translated by the Provider into the predominant language used in the Registrant’s country or territory.”

⁷ URS Procedure 10.3.

⁸ This is not intended as criticism. The reasoning or lack of it reflects the reality of the 3-day turnaround for decisions and the low compensation for writing them. See URS Procedure 9.6: “[T]he stated goal [is for decisions to] be rendered within three (3) business days.”

Examiners have discretion to rule on which language is “predominant” for the complaint.⁹ URS Rule 9(c) provides that the appointed Examiner “shall be fluent in English and in the language of the Response and will determine in which language to issue its Determination, in its sole discretion”; and (d) In the absence of a Response, the language of the Determination shall be English.

Key Points

1. Like the UDRP, the URS has three limbs. Complainants have the burden of proof on all three limbs but in contrast to the UDRP the standard is clear and convincing evidence (URS Procedure 8) rather than a preponderance.

2. Clear and convincing evidence is defined as that quantum of evidence that is conclusive of Complainant’s claim. If there is any doubt or dispute that Complainant has made out a case of cybersquatting, the complaint must be dismissed.

3. For the first element, Complainants must establish they have registered trademarks in current use. There is no jurisdiction, hence no standing, for alleged unregistered marks, or for marks not in existence when the domain name was registered. (This is in contrast to the UDRP in which Complainants may have standing even though they have no actionable claims if Respondents have priority).

4. For the second element, Complainants succeed by offering an unrebutted *prima facie* case. As with the UDRP, the burden shifts to Respondent. In addition to the defenses identical to those in the UDRP, URS Procedure 5.8 and 5.9 set forth palettes of

⁹ [Association Des Centres Distributeurs E.LECLERC \(ACD Lec\), FR v. Xitromedia, Andre Ahner, DE, 6DDAB859 \(MFSD January 23, 2017\) \(<leclerk.shop>\).](#)

additional circumstances that are not prescribed under the UDRP, that is, they are not part of the UDRP text even though they have become accepted factors under its jurisprudence.

These additional circumstances are:

“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”; and

“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.”

5. However, there is a question as to whether the circumstances under the second limb (that is, whether domain name holder has legitimate rights or interests) should be characterized as defenses or affirmative defenses. If a simple defense, a sufficiency of evidence by a preponderance would undercut complainant’s prima facie regardless of the standard of proof. However, if the circumstances are held to be affirmative defenses, then respondent would have to prevail by the higher standard.

6. A close reading of the URS suggests that respondent’s burden of persuasion is satisfied by a preponderance of the evidence. This construction would be consistent with the language in several sections of the URS Procedure that emphasizes that the existence of any contestable issue favors Respondent. For example, in Section 8.5 the text

reads: “The URS is not intended for use in any proceedings with open questions of fact, but only clear cases of trademark abuse.”

7. As with the UDRP, the term “bad faith registration” is measured from the date the domain name is acquired by Respondent. If a Respondent is a successor in interest to an original registrant who acquired the domain name prior to Complainant’s trademark the successor’s good or bad faith is measured from the date it acquired the domain name.¹⁰

8. Drawing of inferences is permissible (URS Rules 5(i) (the Response) and 12(f) (Default)). Rule 5(i) reads: “If the 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”; Rule 12(f) reads: “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.”

However, Examiners should be careful in drawing inferences, particularly as the trademark descends the scale from fanciful, arbitrary, and suggestive to descriptive and generic. Where Respondent offers competent evidence either rebutting Complainant’s *prima facie* contentions under 8.1.2 or undermining its contentions of conjunctive bad faith under 8.1.3, the Complaint must be denied. URS Procedure 8.5 states that “Where

¹⁰ As of the date of this analysis of Examiners’ Views, there have been no decisions on this concept, but it is a solid principle in the UDRP jurisprudence.

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.

9. If the domain name registration predates the mark that corresponds to it, Complainant has no actionable claim and the complaint must be dismissed. (This is in contrast to a UDRP proceeding in which Complainant has standing simply by having a trademark *whenever acquired* but it does not have an actionable claim if it has no distinctive registered or unregistered mark that predates the registration of the domain name).

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.

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.¹¹ The “clear

¹¹ 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).

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 first and second 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.”¹² 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.”

In meeting its rebuttal burden that it has legitimate rights or interests in the disputed domain name, Respondent prevails on the lower preponderance of the evidence standard in that such evidence even if it were questionable raises a “genuine contestable issue.”

¹² URS Procedure 1.2.6.1.

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. Standing

2.01 The right to maintain a URS proceeding is limited to rights holders with registered

marks that are in “current use.”¹³ Where there is any discrepancy between the

¹³ [*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

names of complainants and rights holders the complaint must be dismissed. Thus, a business entity who is arguably a member of a family of businesses whose mark is registered to a principal corporate entity does not have standing to maintain the proceeding. It is not sufficient to have a nexus with the rights holding party.¹⁴

2.02 Registration of a figurative mark does not qualify for standing.¹⁵

2.03 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.¹⁶

2.04 Complainants also lack standing for claims that domain names infringe unregistered marks,¹⁷ or use third level domains¹⁸

[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’”.

¹⁴ [Wolfram Research, Inc. v. Andrew Davis et al.](#), FA1553139 (Forum April 12, 2014) (Complaint dismissed). The principle corporate entity, Wolfram Group LLC. then commenced its own action and was successful in suspending <wolfram.cea>).

¹⁵ [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.’”)

¹⁶ Respondent appeared in [TUI FRANCE v. Guillermo Pérez et al.](#), FA140600 1567455 (Forum July 10, 2014) (MARMARA and <marmara.club>).

¹⁷ 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.

¹⁸ [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-

- 2.05 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 or summon up complainant’s business¹⁹) and 2) additions, omissions, and transpositions are confusingly similar for the purpose of establishing standing. (Some Examiners cite UDRP decisions for these propositions).
- 2.06 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).
- 2.07 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.²⁰ If the domain name is neither identical nor confusingly similar to Complainant’s mark the complaint must be dismissed.

actualites.club> is not confusingly similar or identical to Complainant’s “LA PRESSE .CA (&DESSIN)” mark under URS Procedure 1.2.6.1(i).”)

¹⁹ [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.”)

²⁰ [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.

Comment: The URS and the UDRP differ in the second limb element. For the UDRP it is “rights and legitimate interests.” For the URS it is “legitimate rights and interests.” Moving the qualifier from “interests” to “rights” raises the evidentiary demand.

NOTE: Complainant establishes a *prima facie* case by alleging that Respondent’s use (or non-use) of the domain name does not support any legitimate right or interest. It is for Respondent to establish that its use or non-use of the domain name either is or can conceivably support a legitimate right or interest. The key for this requirement rests on Respondent’s credibility in explaining its choice and persuading the Examiner that there is a genuine issue of material fact. If Respondent defaults, and there is no explanation, Complainant succeeds on this requirement.

B. General Views 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 provide an explanation for 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.²¹

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

²¹ [Oracle International Corporation v. N/A et al.](#), FA1602001659358 (Forum March 1, 2018) (<supercluster.space>. “Complainant’s mark is fanciful and distinct in regards to computers but is merely descriptive regarding astronomy and cosmology. Superclusters are found in space and have been part of the common vernacular relative to space discussion since the early 20th century. Use of superclusters in connection with space does not indicate that Registrant is any way acting in bad faith per Complainant’s computer business. Complainant’s assertions that its business is worldwide and therefore Registrant must have registered the .space domain name in recognition of the scope of Complainant’s business is logically inconsistent. Complainant’s business may be worldwide but it is not out of this world. Procurement of a trademark for a common term does not preclude others from using the term in its common manner.”

the domain name the burden shifts to Respondents to rebut the assertion,²² 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.

C. 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.²³

²² 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.

²³ [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."

- 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.²⁴
- 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 services"²⁵ it does not if the content includes hyperlinks to goods or services competitive with those of the rights holder.²⁶
- 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.

²⁴ [*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.”)

²⁵ [*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)

²⁶ [*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).

D. 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.²⁷
- 3.12 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.²⁸
- 3.13 However, a domain name holder is always responsible for how the specific domain name is used and its content.²⁹ Respondents contention that it has not gained any benefit from the websites (even assuming it is true) is irrelevant to actual gain of

²⁷ *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.")

²⁸ *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.")

²⁹ *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 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.")

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.”³⁰

3.14 A genuine issue of material material fact sufficient to undermine a *prima facie* case the Respondent lacks a legitimate right or interest in the domain name is not achieved by Respondent contending without supporting evidence of demonstrable preparations that it intends to use the domain name in the future in such a such a way.³¹

3.15 Legitimate rights or interests extends to all Respondents whether they use domain names for their businesses³² or offer them for resale on the secondary market,³³ so long as the domain names have not been acquired for an unlawful purpose.

³⁰ [*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.

³¹ [*PLARIUM GLOBAL LTD v. Max Baker et al.*](#), FA1709001748753 (Forum October 5, 2017) (<plarium.online>. “Despite the fact that the Respondent stated that the website related to the dispute is using for public benefit it will not be in affiliation with or it will not infringe the Complainant’s trademark and that their intention is not to sell the domain name to the Complainant or deprive the Complainant from the domain, the Respondent did not submit sufficient evidence for such usage of the domain name.”)

³² [*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,”)

³³ [*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

3.16 Domain names composed of dictionary words (alone or combined with other dictionary words), arbitrary letters,³⁴ and common terms such as geographic locations³⁵ and surnames³⁶ are presumed to have been registered innocently and in good faith unless Complainant offers affirmative evidence that Respondent lacks legitimate rights or interests.

3.17 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.³⁷

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

³⁴ [*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.’”)

³⁵ [*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.”)

³⁶ *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.

³⁷ [*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.”)

3.18 A second level domain that incorporates Complainant’s mark (and is therefore identical or confusingly similar to the mark) but describes Respondent’s business³⁸ or a second level domain “so generic that there is no better way to describe what respondent actually does” arguably have a good defense for fair use (or nominative fair use) and can be characterized as a lawful registration. (URS Procedure 5.8.1).

³⁸ [Dana Limited v. FleetTruckParts.com et al.](#), FA1501001598840 (Forum February 4, 2015(<dana.parts> and <spicer.parts>. “Respondent has raised questions about legitimate or fair use of the disputed domain names for the sale of second hand parts. These issues would more properly be determined through the UDRP or through a court process. These issues are not appropriate for determination under the URS.”

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.”³⁹ This prescription undoubtedly discourages rights holders from using the URS to contest domain names composed from dictionary words and common expressions.

NOTE 2: The principle under UDRP jurisprudence that good or bad faith registration is measured from the date Respondent acquired its interest in the subject domain name has not been tested in URS, but when it is it will follow the consensus view of Panels under the UDRP.

NOTE 3: Legal principles identified under UDRP jurisprudence are equally applicable to the URS, as are the palette of factors Examiners consider in determining infringement. Thus, for example, the concept of “use” is co-extensive with nonuse. In practice, Complainants are not required in every instance to prove that Respondents are taking positive actions. The consensus is traceable to an early UDRP decision in which the Panel held 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.”⁴⁰

B. Factors in Determining Conjunctive Bad Faith

4.01 Infringement is determined upon the entire record, which may include evidence of solicitation,⁴¹ the content of the resolving website, such as offering competitive

³⁹ 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.)

⁴⁰ A concept initially formulated in *Telstra Corporation Limited v. Nuclear Marshmallows*, D2000-0003 (WIPO February 18, 2000) that quickly became the consensus view under the UDRP and is the consensus view under the URS.

⁴¹ URS Procedure 1.2.6.3(a). In *Kohl's Illinois, Inc. v. Krista Goodwin*, FA1810001812065 (Forum November 3, 2018) (kohls.cloud> Respondent responded to demand by stating that “[y]our client is going to have to offer something substantial in exchange for our parked domain, if they would like to purchase this domain that we bought and currently have parked in our portfolio.”

products⁴², of Respondent admitting knowledge⁴³, implying knowledge on proof Respondent has received information⁴⁴; Respondent redirecting the domain name to its own website⁴⁵ or pointing the domain name to an active website referring to Complainant's goods⁴⁶, or of Respondent admitting a material fact that supports bad faith use.⁴⁷

⁴² [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.”)

⁴³ [Association Des Centres Distributeurs E.LECLERC \(ACD Lec\), FR v. Xitromedia, Andre Ahner, DE](#), 6DDAB859 (MFSD January 23, 2017) (<leclerk.shop>).

⁴⁴ *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](#), 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.”

⁴⁵ *Deutsche Lufthansa AG v. aopc interactive GmbH, supra.* (Redirecting).

⁴⁶ [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.”)

⁴⁷ [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.](#)

- 4.02 Infringement is reinforced by the top level domain, as for example <weirdfish.clothing> in which the rights holder operates clothing stores.⁴⁸
- 4.03 When the evidence submitted by the Complainant is not in line with the actual use of the disputed domain name the case must fail.⁴⁹
- 4.04 Where a domain name resolves to a website that copies the images and designs of Complainant’s website,⁵⁰ or mimics the “digital trade dress” of Complainant’s website,⁵¹ or the website is populated with links to competitive goods or services, Complainant has proved abusive registration. Copying and linking are factors in determining lawful or abusive registration.
- 4.05 While a finding in Complainant’s favor that Respondent lacks legitimate rights or interests is not dispositive of bad faith it can be a persuasive factor in determining abusive registration, although any doubt favors Respondent.

⁴⁸ [Weird Fish Limited v. Tom Wolsey et al.](#), FA1809001804515 (Forum September 24, 2018).

⁴⁹ [BNP PARIBAS v. GDPR Masked](#), FA1810412 (Forum October 29, 2018) (<bnp-paribas.icu>. “The evidence submitted by the Complainant show a picture showing a parked page with pay-per-click links which appears to target the Complainant. However, the website under the disputed domain name does not resolve to a parked page.”)

⁵⁰ [Reima Oy v. \[Not named\]](#), D99DCA22 (MFSD April 16, 2018) (<reima.top>. “[N]ot only [is] the disputed domain name ... identical with the Complainant s trademark, but also the website to which the disputed domain name resolves uses the Complainant s trademarks (both word and graphical representation, though the latter in a reversed colour set).”)

⁵¹ [DPDGroup International Services Gmbh v. WhoisGuard Protected](#), 369BOFE1 (MFSD September 20, 2017) (<dpd.solutions>. “The Disputed Domain Name resolves to website that reproduces dominant elements from the Complainant website's digital trade-dress, which includes the look and feel and the apparent services provided by the Complainant. This leads the Examiner to determine that the registration of the Disputed Domain Name was made with the clear intention of deceiving the consumers, through identity theft of the Complainant's name and business.”)

- 4.06 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 Rules make no reference to knowledge or lack of it as a factor Examiners have adopted the requirement from UDRP consensus.
- 4.07 Factors to be considered in assessing the reputation of a mark includes the level of its market presence 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.
- 4.08 If, despite the prohibition in URS Procedure 6.2 that “[d]uring 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” it changes the content of the website this will be regarded as an additional factor in determining registration and use in bad faith.
- 4.09 Passive holding is a factor in determining bad faith registration. It is dispositive in Complainant’s favor when the incorporated mark is well-known globally in that it supports an inference the domain name was registered with knowledge of Complainant’s mark. It is dispositive in Respondent’s favor when the domain name is composed of generic and common elements that could as equally be associated with others than Complainant.⁵²

⁵² [Boucheron Holding SAS v. zhouhaotian et al.](#), FA1605001676556 (Forum June 12, 2016) (<boucheron.pub>. “While this Examiner can envision numerous hypotheticals where a

C. Complainant's Burden

4.10 The URS is designed for “rights holders experiencing the most clear-cut cases of infringement.” The term “clear and convincing evidence” means concrete evidence.⁵³

4.11 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.

4.12 Registrations are unlawful if Complainants have priority and submit un rebutted evidence of bad faith use.

4.13 It is not proof of a fact for which there is no corroborative evidence. So for example, it is not sufficient to allege goods sold on a resolving website are counterfeit if there is no supporting proof.⁵⁴ (Under UDRP jurisprudence is it not unlawful to

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.)

⁵³ [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>.”)

⁵⁴ [Eli Lilly and Company v. Ubajdullaev](#), FA1705001733940 (Forum June 17, 2017) (<cialis.casa>. “The disputed domain name resolves to a website, in Complainant’s words, “advertising counterfeit and competitive pharmaceutical products sold through various online pharmacies”. However, “the resolving website does not disclose any ‘competitive pharmaceutical products’; all are referenced by the trademark and there are none carrying other brand names. Further, there is no evidence that the products so marked are “counterfeit”.”

incorporate marks in domain names if the evidence in the record supports nominate fair use.)

4.14 It is Complainant's duty to explain why the domain being challenged violates the prior trademark rights,⁵⁵ and support its claim with relevant documentary evidence.⁵⁶

4.15 Concrete evidence includes offering 1) documentary evidence of complaints and reports regarding using the domain name for an improper purpose⁵⁷, 2) screenshots of the resolving website impersonating Complainant,⁵⁸ 3) selling counterfeit goods,⁵⁹ 4) linking to goods or services competitive with Complainant or covered

Complaint denied because “[t]here is no clear evidence one way or another as to whether the products so marked were first put on the market by Complainant.”

⁵⁵ [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.

⁵⁶ [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.”)

⁵⁷ *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.”)

⁵⁸ [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 "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.”)

⁵⁹ [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

by the Complainant's trademark registrations⁶⁰, or 5) redirecting domain name to respondent's website.⁶¹

4.16 To prevail on the bad faith limb Complainant must include proof of the scope of its business⁶², that Respondent had actual knowledge of its mark⁶³ 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.

Common or ordinary expressions or two word phrases raise genuine issues of material fact but registration of dictionary words corresponding to coined phrase-marks having priority over the domain name supports registration in bad faith.⁶⁴

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).

⁶⁰ *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.")

⁶¹ *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.")

⁶² *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.")

⁶³ 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.")

⁶⁴ *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

4.17 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.⁶⁵

D. Respondents Rebuttal Burden

4.18 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, and if rebutted the registration cannot have been unlawful.

4.19 Since there is no limitation period for commencing a URS, the interposition of a laches defense raises a genuine contestable issue and would thus be outside the scope of the URS, with the proviso that if, despite the lapse of time, Complainant's evidence clearly and convincingly establishes otherwise.

4.20 It is not a defense that Complaint failed to acquire a domain name corresponding to its mark during the Sunrise period.⁶⁶

the suffix.app, knows the trademark since it's impossible to coin an identical word by coincidence.”

⁶⁵ [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.”)

⁶⁶ [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 Respondent claimed that the disputed domain name was available for purchase in the commercial market once the sunrise period expired. The Panel disagrees. The Sunrise period provides a priority for trademark owners to register their marks as domain names.... However, trademark rights are not released or waived as a result of the passage of the Sunrise period or for that matter any other period relating to the registration of domain names.”

- 4.21 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.⁶⁷
- 4.22 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.⁶⁸
- 4.23 A domain name composed of a dictionary word mark,⁶⁹ alone or combined with another word at the second or top level⁷⁰ 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.⁷¹

⁶⁷ [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).

⁶⁸ [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.”)

⁶⁹ [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.”)

⁷⁰ [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.”)

⁷¹ [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).

- 4.24 Registrations are not unlawful if dictionary words, alone or combined, letters or common phrases are plausibly capable of having other or multiple associations,⁷² although infringement may be supported by website content.⁷³
- 4.25 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.
- 4.26 Passive holding of domain names is not *per se* evidence of bad faith.⁷⁴ Common words and descriptive phrases are legitimately subject to registration as domain names on a 'first-come, first-served' basis.⁷⁵ 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.⁷⁶

⁷² *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.)

⁷³ *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.

⁷⁴ [*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.)

⁷⁵ *HOLA S.L., supra*, dictionary words.

⁷⁶ See *Boucheron Holding SAS, supra*.

4.27 However, resolution to an inactive website can support a conclusion of bad faith registration and bad faith use based on principles established under URDP jurisprudence that an inference will be drawn from respondent’s choice of 1) second level domain 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”⁷⁷; and 2) choice of gTLD when it reinforces reference to Complainant’s business.⁷⁸

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

4.29 The registration of domain names composed of short letter strings that Complainants contend are identical to acronyms of their registered marks and

⁷⁷ *Telstra Corporation Limited, supra*. Although *Telstra* is not specifically referred to see [Allianz SE v. chen jishan et al.](#) FA1408001575411 (Forum September 11, 2014) (<allianz.wang>. “Respondent has offered the disputed domain name for sale on <www.onlydomainnames.com>. Respondent does not deny in its Response that it knew of Complainant when it registered the domain name, nor does Respondent deny having offered the domain name for sale on <www.onlydomainnames.com>.”)

⁷⁸ [Kraft Foods Group Brands LLC v. Domains By Proxy, LLC et al.](#), FA1409001581977 (Forum October 16, 2014) (<Maxwell-house.coffee>. “Not only is the domain name clearly confusing with the Complainant’s well-known MAXWELL HOUSE mark extensively used on coffee products, *the fact that the mark is also used in association with the .coffee extension only further contributes to the confusion in the minds of consumers with the Complainant’s mark and business*” (emphasis added)).

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 Procedure 6.2] 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.

[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 by Respondent making an appearance after a default ruling. Depending on the result of a merits review, the suspension can be reimposed or discharged:

[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.

8. APPEAL

A. Text

[URS Procedure 12.1] “Either party shall have a right to seek a de novo appeal of the Determination based on the existing record with the URS proceeding.”

[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.

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 and if the appellant is the Complainant the record within the URS proceeding or “new admissible evidence” (if accepted) must be clear and convincing to prevail.

8.01 Examiners' Views

8.02 The Examiner may take “new admissible evidence” into account on appeal if it

“clearly pre-dates the filing of the complaint”⁷⁹ and for assessing whether it satisfies the clear and convincing evidence standard.⁸⁰

8.03 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.⁸¹

⁷⁹ *GFPI S.A. v. Michael Meyer, supra.* (<tagheuer.digital>. “The Complainant submitted additional evidence, which, however, does not pre-date the filing of the Complaint... Complainant did not argue why the additional evidence is material and under the circumstances of this specific case we deny the filing of new evidence and rely on the evidence filed within the URS Proceedings.”

⁸⁰ [LVMH SWISS MANUFACTURES SA v. GiftSMS et al.](#), FA1509001637103 (Forum November 24, 2015)

⁸¹ *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.”)