

Comments of .ORG, the Public Interest Registry on the Draft Uniform Rapid Suspension System (URS) -- Revised February 2010

The Public Interest Registry (PIR) joins the ICANN Community in welcoming the new provisions of the Trademark Clearinghouse and the URS as important protections for trademark owners in the new gTLDs. We join the Intellectual Property Constituency in recognizing that the URS “[p]roperly implemented, will be an important remedy for brand owners to effectively and efficiently address clear cut cases of abusive domain name registrations.” *IPC Comments to the STI Review Team*, http://www.ipconstituency.org/PDFs/2010_Jan26_IPC_STI_Comments.PDF.

However, key changes in the language regarding Registrant Responses in the final version of the URS proposal now under evaluation in this comment period significantly alter and erode the rights and protections that the STI drafted for Registrants. PIR regards this as a matter of deep concern and requests an immediate change back to the original STI language. A change back to the original language will protect good faith Registrants and achieve the long-time promise of the URS that it deals with cases of “clear-cut” abuse.

A. The STI contained two clear and unequivocal protections for good faith registrants: the protections of UDRP Policy, Section 4(c), and the Safe Harbors of Nominet.

The STI report pointed out the need to balance and protect the rights of both Complainants and Respondents in URS proceedings:

“The STI recognizes that the URS could provide trademark holders with a cost effective, expedited process in instances of clear cut instances of [sic] trademark abuse, ***provided that the procedure includes appropriate safeguards to protect registrants who engage in legitimate uses of domain names.***” STI Report, p. 15 (emphasis added)
<http://gnso.icann.org/issues/sti/sti-wt-recommendations-11dec09-en.pdf>

To that end, the STI added two protections for Registrants.

1. To ensure that the whole of the UDRP, including its protections, was fully embraced by the URS, the STI added back in the language of UDRP 4(c), namely,

“c. How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint. When you receive a complaint, you should refer to Paragraph 5 of the Rules of Procedure in determining how your response should be prepared. Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your 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

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial 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. <http://www.icann.org/en/udrp/udrp-policy-24oct99.htm>”

In addition, based on experience in the administration of the UDRP, the STI expressly embraced the language of both the UDRP and added, with slight edits, the Safe Harbors of the Nominet domain name dispute policy:

“2. Evaluation of the Answer

2.1 The Registrant may submit an Answer refuting the claim of abusive and bad faith registration by setting out any of the following circumstances which mirror the ‘Rights to and Legitimate Interests in the Domain Name’ of the UDRP, namely:

a. before any notice to you of the dispute, your 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

b. you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

c. you are making a legitimate non-commercial 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.

2.2 Such claims, if found by the Examiner to be proved based on its evaluation of all evidence presented, shall result in a finding in favor of the Registrant.

3. Safe Harbors available to the Registrant

3.1 The Registrant may further demonstrate that its use of the domain name is not in bad faith by showing one of the following factors:

a. The Domain Name is generic or descriptive and the Registrant is making fair use of it.

b. Domain Name sites operated solely in tribute to or in criticism of a person or business may constitute fair use and therefore shall not be considered abuse under this policy.

c. Registrant's holding of the Domain Name is consistent with an express term of a written agreement entered into by the disputing Parties.

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

e. 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 the other domain names registered by the Registrant..." STI Report, pp. 45-6, <http://gnso.icann.org/issues/sti/sti-wt-recommendations-11dec09-en.pdf>

The STI insertion of the Safe Harbors language was done for two reasons:

- *To provide clear and unequivocal protections for good faith Registrants and a bar to their loss of their domain names under specific, enumerated circumstances; and*
- *To provide clear and unequivocal guidance to Complainants that certain categories of use clearly did not meet the finding of "bad faith" and did not qualify for the special and expedited review of the URS.*

We note that these recommendations received the "Unanimous Consent" of the STI members and Unanimous Approval of the GNSO Council.

B. ICANN's current draft strips away the rights of good faith registrants.

The current language of the draft URS and particularly the proposed language of Section 5, "The Response," strip away key protections from Registrants – and changes absolute protections for good faith Registrants to relative ones left to the discretion of the Examiner.

The Revised language now under consideration allows the Registrant to "assert Defenses to the Complaint to demonstrate that the Registrant's use of the domain name is not in bad faith..." Similarly, the Safe Harbors are reduced to factors for "consideration of bad faith." Draft URS, p. 5, <http://www.icann.org/en/topics/new-gtlds/draft-urs-redline-15feb10-en.pdf>.

We assume that the factors of "**good faith**," labeled in draft URS Section 5.8 as factors of "**bad faith**," are an inadvertent error which will be corrected in the next version.

The central issue is that reducing both the URDP 4 (c) and the Safe Harbors protections to mere defenses clearly does not provide the clarity that the STI intended, that the GNSO Council approved, and that the community expects. Mere defenses are not absolute protections.

C. Conclusion and Recommendation

By all accounts, the URS is intended as a rapid review mechanism. It is a special, expedited carve out of the “clear-cut” cases of abuse for rapid evaluation. Discarding the clarity of the STI language, including its express protections for good faith registrants, and express guidance and specific criteria for URS Examiners will very likely open a flood of cases never intended for the URS. Even worse, these cases will not have the balance of protections intended by the STI. PIR strongly recommends that the original language of the STI be reinstated.