

Executive Summary

Since the launch of the New gTLD Program, brand owners have been preparing for a change in the domain landscape and with that, the potential increase in abuse against their brands by cybersquatters. Gone are the days when brand owners could register every brand and misspelling in every possible extension. Brand owners need to have domain registration, brand protection and domain recovery strategies in place. Even the most prepared brands may find themselves having to act against an infringing domain registration which aims to cause consumer confusion or damage the reputation of the brand. In addition to the existing Uniform Domain Name Dispute Resolution Policy (UDRP), companies now have access to several new gTLD Rights Protection Mechanisms (RPMs) developed by the Internet Corporation for Assigned Names and Numbers (ICANN) to help protect brand holder's rights.

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Complaints Against a Registrant

UDRP allows brand owners to dispute registrations that they believe were intentionally registered with the knowledge that doing so would infringe on the brand owner's rights. Generally the registrant is holding the domain name in an attempt to make a profit from the brand owner itself, or from misdirected traffic as a result of the domain name being an exact match to or a minor typographical variation of the trademark. A key element of a successful UDRP claim is a demonstration of bad faith. A successful UDRP will result in the transfer of the domain name to the brand owner or complainant.

A brand owner must establish that:

1. There is damage to the brand as a result of the registration, which is an exact match to a trademark or is confusingly similar.
2. The registrant has no independent, legitimate interest in the name or mark.
3. The registrant has operated in "bad faith," which is demonstrated when:
 - a. the primary purpose of registering the domain name is to extort money from the brand owner through the sale or transfer of the domain name.
 - b. the domain name is used to perpetuate initial interest confusion, intentionally misdirecting traffic to websites that contain advertising, counterfeit products, phished content, etc.
 - c. the domain name is registered with the intent to damage the brand owners business (non-commercial content or content protected by free speech is exempt from a showing of bad faith).

The UDRP Policies and Rules were developed by ICANN and the World Intellectual Property Organization (WIPO) Arbitration and Mediation Center and can be found here: <https://www.icann.org/resources/pages/rules-be-2012-02-25-en>.

UDRP filings can be made through the:

- WIPO Arbitration and Mediation Center
- National Arbitration Forum
- Czech Arbitration Court
- Asian Domain Name Dispute Resolution Centre
- Arab Centre for Domain Name Dispute Resolution

The UDRP applies to all gTLDs and any country code top-level domain (ccTLD) that has voluntarily adopted the procedure.

The Uniform Rapid Suspension System (URS) is designed to address clear-cut cases of brand abuse by domain name registrants. It is meant to provide brand owners with a lower-cost and quicker alternative to the UDRP. Filings are much shorter, and brand owners can include multiple domain names in one filing. A successful URS will result in the suspension of the domain name at the Registry, for the life of the current registration. It does not result in the transfer of the domain name to the brand owner or complainant.

With the launch of new gTLDs, brand owners should prepare for an increase in brand abuse.

Companies have access to several new gTLD Rights Protection Mechanisms to help combat brand abuse.

The URS is stricter than the UDRP and brand owners must demonstrate infringement by a clear and convincing standard of evidence whereas the UDRP, by contrast, only requires proof by a preponderance of the evidence.

A brand owner filing a URS must demonstrate that:

1. The registered domain name is identical or confusingly similar to a mark:
 - a. for which the brand owner holds a national or regional (e.g. Community Trademark) registration that is currently in use; or
 - b. is validated through a court proceeding (such as UDRP filing); or
 - c. is protected by statute or treaty (such as Article 6ter of the Paris Convention).
2. The registrant has no independent, legitimate interest in the domain name or mark.
3. The registrant has operated in “bad faith.” The URS Procedures offer a non-exhaustive list containing examples of “bad faith.”

Unlike the UDRP, the URS has an appeals process, put in place due to the rapid response time given to the registrant once a complaint is validated and the domain name is locked at the Registry. There are also safeguards against abusive filings by brand owners to protect against reverse domain-name hijacking. The URS rules and procedures were developed by the ICANN community in conjunction with the development of the New gTLD Program. They can be found here:

<http://newgtlds.icann.org/en/announcements-and-media/announcement-05mar13-en>.

URS filings can be made through the:

- National Arbitration Forum

Decisions can be found here: <http://domains.adrforum.com/decision.aspx>

- Asian Domain Name Dispute Resolution Centre

The URS only applies to new gTLDs; however, it can be voluntarily applied to existing gTLDs and ccTLDs.

Complaints Against a New gTLD Registry

The Public Interest Commitment Dispute Resolution Procedure (PICDRP)

allows a complainant to challenge that a new gTLD Registry is complying with the Public Interest Commitments made in their application for a new gTLD. Examples may include failure to provide special RPMs, or registration restriction policies that were promised in the application. Such promises may have formed the basis of non-objection from the brand protection community, or the Governmental Advisory Committee (GAC).

Prior to filing a PICDRP, the complainant must utilize the online complaint system through ICANN and attempt to resolve the issue with the Registry directly. If that fails, filings may be made through an external third party provider. Detailed rules for a PICDRP filing can be found here: <http://newgtlds.icann.org/en/program-status/pdrp>.

The PICDRP is exclusively applicable to new gTLDs only.

The Trademark Post-Delegation Dispute Resolution Procedure

(Trademark PDDRP) is meant to address general egregious behavior by a new gTLD registry operator, which is either actively infringing on a trademark at the top level or is complicit in trademark infringement at the second level of the new gTLD.

A successful Trademark PDDRP at the top level must establish that the Registry is operating a gTLD that is identical to or confusingly similar to the brand owner's mark — and that in so operating, is:

1. taking unfair advantage of the distinctive character or reputation of the mark; or
2. impairing the distinctive nature or reputation of the mark (dilution by tarnishment or blurring); or
3. creating a likelihood of confusion as to the source and beneficiary of the mark.

A Trademark PDDRP at the top level would only need to be filed if the complainant missed the opportunity to file a Legal Rights Objection to a new gTLD application, or if that objection was dismissed.

A Trademark PDDRP at the second level must establish (by a clear and convincing standard of evidence) that the registry operator, through a substantial pattern of behavior, has demonstrated a “bad faith” intent to allow and profit from the sale of second-level domain names which infringe on trademark rights. The infringing registration(s) must be directly affiliated with the registry operator, or encouraged (directly or indirectly) by the registry operator — and must give a direct benefit to the registry operator that rises above a reasonable registration fee. It is not enough to establish that the registry operator knows or knew about infringing registration(s) within the gTLD.

At least 30 days prior to filing a Trademark PDDRP, the brand owner must notify the registry operator of the infringing conduct and “must express a willingness to meet to resolve the issue.”

Detailed rules for a Trademark PDDRP can be found here: <http://newgtlds.icann.org/en/program-status/pddrp>.

Trademark PDDRP filings can be made through the:

- WIPO Arbitration and Mediation Center
- National Arbitration Forum
- Asian Domain Name Dispute Resolution Centre

The Trademark PDDRP is exclusively applicable to new gTLDs only.

Brand holders must have domain registration, brand protection and domain recovery strategies in place.

The Registration Restriction Dispute Resolution Procedure (RRDRP) may be utilized when a community-based or geographic new gTLD registry operator is non-compliant with the registration restrictions outlined in its application and/or registry agreement with ICANN.

Only established institutions associated with the community or region affected by the registration restrictions can file an RRDRP. The complainant must establish measurable harm to the complainant and the community as a result of non-compliance to the registration restrictions. Prior to filing an RRDRP, the complainant must make use of the ICANN-based complaint system to resolve the issue directly with the registry operator.

Detailed rules for an RRDRP can be found here:

<http://newgtlds.icann.org/en/program-status/pddrp>.

RRDRP filings can be made through the:

- National Arbitration Forum

The RRDRP is exclusively applicable to new gTLDs only.

The Sunrise Dispute Resolution Procedure (SDRP) is specific to new gTLD registry operator(s). It allows a brand owner to dispute the allocation of a domain name during a Sunrise Registration period to the registry operator directly. The processes and procedures of the SDRPs vary widely as a result of each Registry's interpretation of the requirements for such a Dispute Resolution Procedure (DRP), as outlined by ICANN in the New gTLD Program Applicant Guidebook.

Should the results of an SDRP proceeding through the registry operator prove unsatisfying, a complaint may be filed through ICANN Contractual Compliance, but only if:

1. the complainant can establish that the registry operator did not follow its own SDRP rules; or
2. one or more of the provisions in the registry operators SDRP are non-compliant with the requirements of the RPMs outlined by ICANN in the Applicant Guidebook, or the rules and procedures outlined by the Trademark Clearinghouse (TMCH).

Complaints Against The Trademark Clearinghouse

There are three types of disputes allowed between a brand owner and the TMCH:

1. Disputes brought by a brand owner or a TMCH agent alleging that the TMCH incorrectly *rejected* a trademark record for registration in the TMCH.
2. Disputes brought by a third party (can be a competing brand owner) alleging that the TMCH incorrectly *accepted* a trademark record for registration in the TMCH.
3. Disputes brought by a third party (can be a competing brand owner) that a trademark record is no longer valid based on new information (such as a successful opposition, cancellation or challenge of use), which would result in the record being deleted by the TMCH.

These disputes are submitted and filed with the TMCH directly. These forms, as well as detailed rules and procedures can be found here:

<http://trademark-clearinghouse.com/dispute>.

Summary

With over 600 new gTLDs being added to the domain landscape, brand owners should prepare themselves for the likely increase in abusive registrations against their brands. In addition to revising domain registration, brand protection and domain recovery strategies, companies should familiarize themselves with the available RPMs so that if an infringing domain registration is identified, it can be addressed quickly using the most appropriate and cost-effective approach.

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