

missed the opposition on the ground that the respective marks were insufficiently similar to one another for there to be any likelihood of confusion, an outcome which in this author's opinion is by far the more probable one.

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■ ICANN offers rapid relief to trade mark holders in clear cases of infringement

The Uniform Rapid Suspension System (URS) (<http://newgtlds.icann.org/en/applicants/urs>)

Today, cyber-squatting continues and consumers continue to be misled. Court action and even the Uniform Domain-Name Dispute Resolution Policy (UDRP) take time and money. With the impending launch of hundreds of new gTLDs, it became clear back in 2009 that the UDRP alone might not be sufficient in dealing with cyber-squatters and other mischievous third parties seeking fertile new ground to register other people's trade marks in bad faith and re-direct traffic or further mislead consumers and other Internet users in the upcoming new gTLD program of ICANN (<http://newgtlds.icann.org/en/>).

Legal context and facts

The Uniform Rapid Suspension System (URS) is one of the rights protection mechanisms specifically developed and proposed in order to assist rights owners who encounter the most clear-cut cases of infringement. Initially proposed by the Implementation Recommendation Team (IRT) (see 'Non-PDP—Trademark Protections' <http://gnso.icann.org/en/group-activities/inactive/2009/trademark-protection-irt> (accessed 10 April 2014)) at the request of the Board of Internet Corporation for Assigned Names and Numbers (ICANN), the URS evolved over the following years with a balance being sought between providing rights holders with a lower-cost, faster path to relief than that provided by the existing Uniform Domain-Name Dispute Resolution Policy (UDRP) which it is designed to compliment. However, between 2009 and 2013 there followed a process development period, which involved, among other things, a global consultation, input from the Generic Names Supporting Organization Council of ICANN, the formation of a Special Trademark Issues drafting team which revised the proposal and then further public comment. The result was a URS that included a number of compromises in the Policy and Procedure seeking to protect genuine registrants from inappropriate use of the URS, though some would arguably say the teeth have been removed from the URS.

The goal of the URS was to provide a lighter, more rapid and cheaper alternative to the UDRP. The scope was that of clear-cut cases of trade mark abuse. The remedy was a temporary suspension for the duration of the registration period, with a possibility of a successful complainant extending this. It can be thought of as a mini-UDRP as it has the same substantive requirements, but it has a higher burden of proof as it requires 'clear and convincing evidence' and the complainant must also prove use for instance. Many argue that the remedy of suspension rather than transfer is a 'non-remedy' but the objective of the URS as designed by the IRT was to not allow an appropriation of the domain name by a complainant. The UDRP is arguably the appropriate mechanism for that, as not all brand owners wish to acquire and be put to the cost of managing typosquatted domain names that have no intrinsic value.

Analysis

Have the teeth been removed from the URS? Only time will tell, but I can confirm that it remains a useful arm for brand owners to have in dealing with blatant infringement as we successfully assisted Facebook Inc in filing the first URS complaint (see decision of 27 September 2013 *Facebook Inc v Radoslav*, National Arbitration Forum <http://domains.adrforum.com/domains/decisions/1515825D.htm> (accessed 10 April 2014)). With a filing fee of \$375 compared to that of the UDRP at \$1,500 it is certainly cheaper. After an administrative review and locking of the domain name in question within 24 h of the receipt, once the proceedings had commenced the respondent was given 14 days to reply, and on failing to do so, a notice of default was sent, and the panel appointed and delivered its decision to suspend the domain name the very next day.

Practical significance

Should one file a URS or a UDRP? That is a question that needs to be considered carefully. Factors to consider include the time available, the cost and also the number of domain names and whether you want them in your portfolio. If you own a core brand and you wish to have an active domain name, then I would tend towards recommending that you file a UDRP, but if the domain name in question is a typo domain name of no or little interest, the URS may be the appropriate way forward.

In any event the URS is one of a number of arms available to brand owners, and the challenges and opportunities of the new gTLD process mean that it is timely to become aware of the tools that are available and their relative merits.

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