



# National Arbitration Forum URS Suggestions and Thoughts

October 18, 2012

Presented By Kristine Dorrain  
National Arbitration Forum



# Overview

- Problems with URS as currently proposed
- Key components of FORUM's Proposal
- Demonstration of how FORUM could use a portal system like it uses for RES to save costs
- Questions still remaining in the URS (that could affect administrative burdens and costs)

# Problems with URS as currently proposed

- Too many administrative touchpoints require hiring additional staff
- Sending cases to an “Expert Examiner” during default (or prior to receipt of a late response) increases efficiencies.
  - Response cases with fees ~\$300-500USD will not allow Provider to cover costs.
  - Not paying for a Determination on defaults allows recovery of costs

# Key components of FORUM's URS Modifications

- Communications (other than commencement, aka “service”) to be provided electronically; this can include through automated emails directing users to a portal.
- Commencement still includes service via email as well as notice via email, fax and mail.

# Key components of FORUM's URS Modifications

- Currently, for each domain name in dispute, the complainant has to upload the registration and proof of use (proof can be validated by TMCH)
- A direct connect to TMCH (or a way for the complainant to transmit the data directly) would be helpful (though cost to provider could affect cost of URS process).

# Key components of FORUM's URS Modifications

- “Default” cases proceed to a “prima facie” check by an attorney. If they pass, Registry is directed to change resolution of the domain name.
- There is no public “Determination” for Defaults.
- Case that doesn’t pass does not qualify for inclusion as “bad faith complaint.”
- Default cure period is still 30 days for free, up to six months, paid.
- There is no six month extension.

# Key components of FORUM's URS Modifications

- Change “24 hour” designations to “one Business Day” with Business Day as a defined term. This accounts for weekends and holidays.

# Key components of FORUM's URS Modifications

- No deficiency check for Response
- Except if a fee is due from Respondent, submissions not considered a “Response” (that is, case remains a “default”) until the fee is paid.



# ICM Registry's RES system for .xxx

Log in as a party or representative. Agree to terms outlined in RES.

← → ↻ <https://secure.arb-forum.com/DDFILING/RES/Agree.aspx> ☆ ☰

Suggested Sites Free Hotmail Web Slice Gallery Imported From IE SPPS Comm Ed PayPams - Main Me... Welcome to Crossro... >>

**NATIONAL ARBITRATION FORUM** Domain Dispute

**RES Online Filing (Step 2 of 9)** Kristine Dorrain

**Agreements**

Filing As:  Complainant  
 Complainant Representative

Statement of Abuse: I affirm that neither I, nor my client if I am a party representative, nor any members of my firm located in the same jurisdiction have had three findings of abusive RES proceedings in the past three years.

I Agree with the Statment of Abuse

Hold Harmless Statement: I agree to hold the registrar, the Registry, the Provider, and the Evaluator harmless from any claim arising from operation of the RES. I may not name the registrar, the Registry, the Provider, or the Evaluator as a party or otherwise include the registrar, the Registry, the Provider, or the Evaluator in any judicial proceeding relating to the dispute or the administration of the RES policy.

I indemnify, defend and hold harmless the registrar, the Registry, the Provider, the Evaluator and their respective employees, contractors, agents and service providers from any claim arising from the conduct or result of a proceeding under this RES.

Neither the registrar, the Registry, Provider, the Evaluator and their respective employees, contractors, agents and service providers shall be liable to me for any act or omission in connection with any administrative proceeding under this RES or the corresponding Rules.

I understand I am directly and solely liable to the registrant in the event the complaint is granted in circumstances where the registrant is lawfully entitled to registration and use of the domain name in the .XXX TLD.

I Agree with the Hold Harmless Statement

# ICM Registry's RES system for .xxx

Once a party is in the system, profile information will fill in, but may be updated.

Domain Dispute Online Filing

https://secure.arb-forum.com/DDFILING/RES/Complainant.aspx

Suggested Sites Free Hotmail Web Slice Gallery Imported From IE SPPS Comm Ed PayPams - Main Me... Welcome to Crossro...

**NATIONAL ARBITRATION FORUM** Domain Dispute

**RES Online Filing (Step 3 of 9)** Kristine Dorrain

**Complainant Information**

Full Name: \* Kristine Middle Dorrain

Business: \*

Address 1: \* 123 Test Way

Address 2:

Address 3:

City: \* Golden Valley

State: Marshall Islands (MH)

Postal Code: \* 4546464

Country: \*

Primary Phone: \* 952-516-456

Alternate Phone:

Fax:

Email: \* kdorrain@adforum.com

Complainant has a Representative

Previous Step Save and Continue

©2012 National Arbitration Forum

# ICM Registry's RES system for .xxx

Enter the domain name.

The rest of the data fills in from Whois, but may be updated.

Domain Dispute Online Filing x

https://secure.arb-forum.com/DDFILING/RES/Respondent.aspx

Suggested Sites Free Hotmail Web Slice Gallery Imported From IE SPPS Comm Ed PayPams - Main Me... Welcome to Crosso...

**NATIONAL ARBITRATION FORUM** Domain Dispute

**RES Online Filing (Step 5 of 9)** Kristine Dorrain

**Domain/Registrar Information**

Domain Name: \* sex.xxx

Registrar: \* GoDaddy.com, Inc. (R3218-XXX)

**Registrant Information**

Full Name: \* ICM Middle Registry

Business: \* ICM Registry, LLC

Address 1: \* PO BOX 30129

Address 2:

Address 3:

City: \* Palm Beach Gardens

State:

Postal Code: \* 33420

Country: \* United States of America (US)

Primary Phone: \* +1.8778093182

Alternate Phone:

Fax:

Email: \* pat@dotxxx.com

Registrant has a Representative

Previous Step Save and Continue

©2012 National Arbitration Forum

# ICM Registry's RES system for .xxx

Choose type of filing.

The screenshot shows a web browser window with the URL <https://secure.arb-forum.com/DDFILING/RES/DomainInfo.aspx>. The browser's address bar and tabs are visible at the top. The page header features the National Arbitration Forum logo on the left and "Domain Dispute" on the right. The main content area is titled "RES Online Filing (Step 7 of 9)" and includes the name "Kristine Dorrain" in the top right corner. Below the title, there is a section for "Claim Information" with the following text and options:

Claim Type:

- Trademark Abuse
- Impersonation

Only one claim type may be made. If you select one type, then go back and select the other one, only the last-prepared complaint will be submitted.

At the bottom of the form area, there are two buttons: "Previous Step" and "Save and Continue".

©2012 National Arbitration Forum

# ICM Registry's RES system for .xxx

Substantive complaint entry.

Recommended that filers have this prepared in a doc and just copy/paste it in.

The screenshot shows a web browser window with the URL <https://secure.arb-forum.com/DDFILING/RES/DomainInfo.aspx>. The page is titled "Claim Information" and contains the following sections:

- Claim Type:** Two radio buttons are present: "Trademark Abuse" (selected) and "Impersonation". Below them is a note: "Only one claim type may be made. If you select one type, then go back and select the other one, only the last-prepared complaint will be submitted."
- Trademark Abuse Details:** A section titled "Identical or Confusing Similarity. In 300 words or less, describe how your mark meets the requirements for RES Policy [Section 2\(a\)\(i\)](#)." It includes a text area with a word count of "0 / 300". Below the text area is a note: "\* Please upload your trademark registration certificate and any other annexes on which the complaint will rely related to use of the mark or domain name." and a "Select" button.
- Legitimate Rights and Interests:** A section titled "Legitimate Rights and Interests. In 300 words or less, describe how respondent does not meet the requirements for RES Policy [Section 2\(a\)\(ii\)](#)." It includes a text area with a word count of "0 / 300".
- Registration and Use in Bad Faith:** A section titled "Registration and Use in Bad Faith. In 300 words or less, describe how respondent has registered and used the domain name in bad faith under RES Policy [Section 2\(a\)\(iii\)](#)." It includes a text area with a word count of "0 / 300".

# ICM Registry's RES system for .xxx

RES has “additional factors” and clicking on one will expand that option and allow more text.

Factors for consideration:

- the inherent distinctiveness, exclusivity, or scope of the mark at issue, and whether there is no conceivable good faith or legitimate use of the domain name(s) in the .XXX TLD

\* Total word Count : 0 / 300



- the extent of presumptive effect afforded by the national registration(s) shown by the Complainant in the relevant jurisdiction(s)
- the scope and extent of actual use of the mark by the Complainant
- whether the domain name in the .XXX TLD consists of common word(s) used primarily in association with their primary meaning by the respondent for sale or advertising of goods or services related to such primary meaning
- indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services offered or advertised by the respondent
- use of the mark to the extent necessary to indicate the intended purpose of a product or service, provided it is used in accordance with honest practices in industrial or commercial matters
- whether the domain name in the .XXX TLD was registered or acquired prior to the acquisition of rights in the mark by the Complainant, or whether circumstances indicate the domain name in the .XXX TLD was likely registered in willful anticipation of the acquisition of such rights
- the reasonability of available time in which to develop or demonstrate plans to develop a corresponding web site for the domain name in the .XXX TLD at issue
- whether the Complainant offers its goods or services under the same or similar domain name in another TLD, and the respondent's use of the domain name in the .XXX TLD manifests a clear predatory intent with respect to the same or similar goods or services.


©2012 National Arbitration Forum

# ICM Registry's RES system for .xxx

Email service to parties.

From: DomainDispute  
To: CMSMSG; CMSMSG; CMSMSG; CMSMSG; CMSMSG  
Cc: Dorrain, Kristine  
Subject: Notice of Commencement and Evaluator Appointment for National Arbitration Forum Case

 Message  20121012-1129527055kaf.doc (96 KB)

 OnlineFiling\_\_2012-10-12\_10-57-17-806\_\_ComplaintFA1210001325911.pdf (69 KB)

FA1210001325911

Kristine F Dorrain v. ICM Registry, LLC ICM Registry

Attached is the Complaint and Notice of Commencement and Appointment for the above case.

**Kristine Dorrain**

Domain Dispute Case Coordinator

# ICM Registry's RES system for .xxx

Email sent to Respondent.  
Contains explanation and link.

From: DomainDispute  
To: CMSMSG  
Cc: Dorrain, Kristine  
Subject: Response Filing Information for National Arbitration Forum Case FA1210001325911

Sent: Fri 10/12/2012 11:30 AM

FA1210001325911  
Kristine F Dorrain v. ICM Registry, LLC ICM Registry

Domain Name: <sex.xxx>  
Current Status: Pending Preliminary Hearing Until 10/16/2012  
Pending Response Until 10/26/2012

The domain name listed above is the subject of a domain name dispute with the National Arbitration Forum and a new case has been created on the Portal. The complaint has been emailed to you. Please click on the encrypted link below to file a Response; if the link doesn't work, the path is located at the bottom of this email, please copy and paste it into your browser. Case timelines are very short so please review these documents promptly. You have ten business days from the date of this email to file your Response. If you would like an extension to respond please use the username and link from the email with the subject "Welcome to the National Arbitration Forum domain name dispute case portal", sent at the same time as this email, to submit your request and pay the \$100 fee.

[Click Here to File a Response](#)

Please contact me at the email address below if you have any difficulties accessing the online response filing system. If you are not currently set up on the Portal, clicking the link will take you to a page to get set up. If you wish to have access to the Portal without immediately filing a Response, please contact me to get set up. If you are set up but your user id is not yet linked to this case, please email me with that information and I will link your user profile to this case.

Sincerely,

**Kristine Dorrain**  
Domain Dispute Case Coordinator



# ICM Registry's RES system for .xxx

- Entry screens are the same for Respondent.
- Respondent can update contact information.
- Respondent is presented with the Policy and Complainant's Assertions.
- Respondent has equal space to respond.
- Respondent can check additional boxes for applicable defenses (unique to RES).

**Response Information**

You may provide a response of 300 words or less to each of the following claims made by the Complainant.

Claim Type:  Trademark Abuse  
 Impersonation

Trademark Abuse Details: Identical or Confusing Similarity. Response to Complainant's assertion of how claimant's mark meets the requirements for RES Policy.  
[Section 2\(a\)\(i\) Complainant's Assertion](#)  
\* Total word Count : 1 / 300

Legitimate Rights and Interests. Response to Complainant's assertion of how you do not meet the requirements for RES Policy.  
[Section 2\(a\)\(ii\) Complainant's Assertion](#)  
\* Total word Count : 1 / 300

You may upload one responsive document.

Registration and Use in Bad Faith. Response to Complainant's assertion of how you have registered and used the domain name in bad faith under RES Policy.  
[Section 2\(a\)\(iii\) Complainant's Assertion](#)  
\* Total word Count : 1 / 300

The following were selected for consideration by the Complainant:

whether the Complainant offers its goods or services under the same or similar domain name in another TLD, and the respondent's use of the domain name in the .XXX TLD manifests a clear predatory intent with respect to the same or similar goods or services.  
[Complainant's Assertion](#)

The following were not selected for consideration by the Complainant, but may be selected by you:

the inherent distinctiveness, exclusivity, or scope of the mark at issue, and whether there is no conceivable good faith or legitimate use of the domain name(s) in the .XXX TLD.

the extent of presumptive effect afforded by the national registration(s) shown by the Complainant in the relevant jurisdiction(s).

the scope and extent of actual use of the mark by the Complainant.

# Portal Case Management

Cases shown at a glance.

**NATIONAL ARBITRATION FORUM** Case Management

Dashboard My Cases FAQs and Technical Questions FA # or Last 7 digits

### My Cases

Forum File #:  Atty Ref #:  Domain Name:

Forum File #	Case Name	Status	Due Date
1325714	Kristine F Dorrain v. ICAN	Pending Final Decision	11/14/2011
1325756	Kristine F Dorrain v. Respondent	Pending Final Decision	11/29/2011
1325754	Kristine F Dorrain v. PrivacyProtect.org PrivacyProtect.org	Pending Final Decision	12/07/2011
1325803	Kristine F Dorrain v. test TEst e Test	Pending Preliminary Decision	12/30/2011
1325804	Kristine F Dorrain v. test Test t test	Pending Preliminary Decision	12/30/2011
1325805	Kristine F Dorrain v. test t test	Pending Preliminary Decision	12/30/2011
1325873	Kristine F Dorrain v. ICM Registry LLC ICM Registry Account	Pending Deficiency Check	07/05/2012
1325874	Kristine F Dorrain v. ICM Registry LLC ICM Registry Account	Pending Deficiency Check	07/05/2012
1325875	Kristine F Dorrain v. ICM Registry, LLC ICM Registry	Pending Final Decision	07/24/2012
1325882	Kristine F Dorrain v. Name Administration Inc.(BVI) Name Administration Inc.(BVI)	Pending Deficiency Check	08/03/2012
1325888	Kristine F Dorrain v. Name Administration Inc.(BVI) Name Administration Inc.(BVI)	Pending Deficiency Check	08/17/2012
1325911	Kristine F Dorrain v. ICM Registry, LLC ICM Registry	Pending Preliminary Decision	10/16/2012

**Cases Closed within the last 90 days:**

Forum File #	Case Name	Status	Closed Date
No cases to display			

# Portal Case Management

Interact with case through portal.

**NATIONAL ARBITRATION FORUM** Case Management

Dashboard My Cases FAQs and Technical Questions FA # or Last 7 digits

**FA Number: FA1210001325911** [Discuss this case](#)

**Case Information**

FA1210001325911 - Kristine F Dorrain v. ICM Registry, LLC ICM Registry

Filing Date: 10/12/2012  
Commencement Date: 10/12/2012  
Status: Pending Preliminary Decision  
Due Date: 10/16/2012  
Ruleset: RES  
Language: English  
Response Date: 10/12/2012  
Panelist (Single-Member):  
Petter Rindforth - [View Resume](#)

Complainant Contact Info:  
Kristine F Dorrain  
St. Louis Park, MN 55117  
United States of America  
kdorrain@adrforum.com

Respondent Contact Info:  
ICM Registry  
ICM Registry, LLC  
Palm Beach Gardens, 33420  
United States of America  
pat@dotxxx.com

Coordinator:  
Kristine Dorrain - kdorrain@adrforum.com

Domains (1):  
<sex.xxx>

**Documents**  
[Expand All](#) | [Collapse All](#)

- Complaint
  - TM Registration - Discussion Paper- Uniform Rapid Suspension.pdf - 0 Bytes - 10/12/2012
  - Complaint - ComplaintFA1210001325911.pdf - 68.44 KB - 10/12/2012
  - Notice of Commencement and Appointment - Notice of Commencement and Appointment - 95.50 KB - 10/12/2012
- Response
  - Response - ResponseFA1210001325911.pdf - 68.09 KB - 10/12/2012
- Complainant Other Correspondence
- Respondent Other Correspondence
- Non-Party Correspondence
- Panel Correspondence
- Procedural Documents
- Decision

**Case Actions**  
Select an Action to take on this case

Actions	Amount	
Request a Stay	--	<a href="#">Select</a>
Request a Withdrawal	--	<a href="#">Select</a>

©2012 National Arbitration Forum

# Portal Case Management

Panel Determination in Response case made through Portal.

## Case Actions

### Preliminary Determination

- Selected Action: \*
- Take down website at sex.xxx
  - Dismiss case
  - No finding until Final Determination

- Decision Type: \*
- Upload Decision
  - Build Decision

Build Decision: \* Section 2(a) of the Policy, regarding Trademark Abuse, requires Complainant to prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred. Section 3 highlights evidentiary standards and additional considerations.

(i) the domain name in the .XXX TLD is identical or confusingly similar to a registered, textual trademark or service mark of national effect that the Complainant owns and uses in the relevant jurisdiction(s) where it is registered;

Complainant has provided evidence of a registered, textual trademark. The domain name is identical or confusingly similar to the trademark.

(ii) the respondent has no rights or legitimate interests in respect of the domain name in the .XXX TLD; and

Complainant has established a prima facie case that Respondent has no rights or legitimate interests in the <sex.xxx> domain name.

(iii) the domain name in the .XXX TLD has been registered and is being used in bad faith or, if unused, is not conceivably susceptible to use in good faith.

Respondent has registered and used the <sex.xxx> domain name in bad faith, or the domain name is incapable of being used in good faith by Respondent.

(iv) Any additional factors considered by the Panel.

Complainant has set forth arguments for additional factors.

Submit

Cancel

# Open Questions

- URS 1.1(c): Multiple Respondents are ok if “related.”
  - Since proceedings are against the registrant in the Whois, what does that do for/about privacy services?
  - If we proceed against multiple domain names registered to a privacy service:
    - What happens if there are multiple Responses (in multiple languages?)?
    - What if they all filter in over a period of six months?
    - How many times is one Examiner expected to review a complaint?
    - How many Determinations could exist for a single Complaint?

# Open Questions

- URS 1.2
  - URS 1.2.6 No word/page limit for three elements of complaint.
  - URS 1.2.7 allows Complainant 500 words of “explanatory text.”
- URS 5.4 Allows Respondent 2500 words
- Must standardize word count for Complaint/Response

# Open Questions

- URS 4.2 and language
  - Language of notice is English + language of Respondent's region
  - What language is the Complaint?
  - What language is the Response?
  - What language is the Determination?
  - What if multiple Responses in multiple languages?
- Administratively handling complaints/responses in every language will raise costs.
- Examiners are available in most/all languages (affect on Defaults?)

# Open Questions

- URS 1.2.6.1(a) allows proof of use to be shown as validated by TMCH, but there is no provision for how that will happen.
  - No requirement that the Provider “go get it.”
    - If that is added, that add cost and administrative steps, as well as puts the burden for getting accurate data on the Provider
  - Requirement is that the Complainant submit it.
    - How will Complainant tell TMCH to send specific validated proof of use data?



# Open Questions

- URS 6 restricted the changing of content after the complaint defaulted.
  - This serves no purpose and creates issues with respect to:
    - Who polices this?
    - What happens if the content does change?
  - If there is a restriction on changing content, it needs to be placed at the time of lock.

# Open Questions

- URS 6 If a Response is received after Default, the domain name shall again resolve to the original IP Address.
  - As this could be anywhere up to a year after the Default, under the current iteration, who keeps track of what that IP Address was?

# Open Questions

## ■ URS 11

- Abusive complaints or material falsehoods: URS appears to hold these against the “party” not counsel. Confirm?
- What if there are multiple complainants/respondents?
- Privacy/proxy services?
- Party uses a fictitious name?
- Does the Providers’ list of “bad actors” need to be public?