



**I C A N N**

**COMMUNITY FORUM**

**61**

**SAN JUAN**

10-15 March 2018

# Right Protection Mechanisms GNSO PDP – URS Practitioners Sub Team

Status Update Presentation to the Working Group

Sunday, 11 March 2018



# Agenda

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1

Current Status and  
Next Steps

2

Questions for URS  
Practitioners

3

List of URS  
Practitioners

# Current Status & Next Steps

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## ⦿ Current Status:

- Developing questions for URS practitioners;
- Developing a list of URS practitioners for outreach;
- Discussion with full Working Group at ICANN61.

## ⦿ Next Steps:

- Finalize questions;
- Develop questionnaire/survey;
- Obtain contact information for practitioners;
- Send questionnaire/survey.

# Questions for URS Practitioners

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## 1. Procedural Issues

1. Since its inception, in how many URS proceedings have you been involved?
2. In each proceeding, did you serve as counsel for Complainant or Respondent?
3. If for Complainant, what triggered your decision to file a URS claim? What was the factual basis for your claim?
4. If for Respondent, what were your defenses to the claim?
5. As an overview, and leaving aside the result for the moment, in filing or responding to a URS claim, was your overall experience with the process generally positive? Were the rules and procedures for filing or responding to a claim under the URS clear? Did you encounter any material procedural problems?

# Questions for URS Practitioners, Cont.

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## 1. Procedural Issues, Cont.

7. Do you have any comments or observations as a practitioner about the ability to refile after 6 months following a default? -- Have you refiled after a default or been involved in one?
8. Do you have any comment as a practitioner about the appeals process provided under Paragraph 6.4 of the URS Procedure, where a losing registrant who fails to file a response can seek de novo review for up to six months (plus an additional six-month extension), and under Paragraph 12 either party can seek a de novo appeal of the determination within 14 days. Have you filed an appeal or been involved in one?
9. Do you have any comment about the extension mechanisms noted above that are provided for appeals under the URS?

# Questions for URS Practitioners, Cont.

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2. Substantive Issues – 2.1 Burden of Proof and Remedies Provided Under URS
  1. The burden of proof is “clear and convincing evidence.”
  2. Do you believe this is an understandable standard?
  3. Should this standard be modified? If so, why? If not, why not?
  4. In any of your cases, did it appear that the panelist did not consider each of the three required elements?
  5. In any of your cases, did it appear that the panelist did not address certain aspects of the URS which it was required to do?
  6. In any of your cases, did the panelist appear to be unsure of the test or application of the standards?

# Questions for URS Practitioners, Cont.

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2. Substantive Issues – 2.1 Burden of Proof and Remedies Provided Under URS, Cont.
7. Should there be more guidance for practitioners and/or providers regarding what satisfies the "clear and convincing" standard?
8. As a practitioner, how confident were you in each case that the WHOIS data necessary for filing your URS claim was accurate and/or authentic?
9. In each of your cases, did you find the decisions adequate to understand the basis of the ruling?
10. Did you consider using past URS cases as precedent in your submission? If so, were you able to effectively use past URS cases as precedent? Were some decisions unusable due to their brevity or lack of discussion of the rationale for the decision? If so, did you find another case or cases to use as precedent?



# Questions for URS Practitioners, Cont.

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2. Substantive Issues – 2.1 Burden of Proof and Remedies Provided Under URS, Cont.
  11. Do you believe that there should be more guidance on the elements that need to appear in a decision?
  12. Are you finding that the URS is being used for the types of cases for which it was intended -- clearly abusive cases?
  13. For those who are practitioners, do you believe the relief provided by the URS (i.e. suspension) is adequate, and, if not, what would you like to see as the relief (e.g., transfer of domain name)?
  14. Have you encountered any problems with the relief awarded following a URS decision. Why or why not? If so, please describe the problem encountered.
  15. Is it valuable for the URS to follow the UDRP elements?
  16. Do you believe that the remedy provided by the URS is adequate? If not, what remedy would you propose?

# Questions for URS Practitioners, Cont.

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2. Substantive Issues – 2.2 Practical Issues (filing mechanics, word limitations, etc.)
  1. Under URS Rules, proof of use can be submitted with the complaint, or an .SMD file can be submitted to demonstrate that proof of use was submitted to and accepted by the TMCH. Do you believe that this is adequate proof of use for a URS case? If not, what would you recommend and why?
  2. Fees: As a brand owner or practitioner representing brand owners, how do you feel about the URS fee? Do you believe the fee is too high or too low? Does the fee structure work for the URS? How does the fee factor into deciding whether or not to file a URS case? As a respondent or practitioner, please answer the first three questions.

# Questions for URS Practitioners, Cont.

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2. Substantive Issues – 2.2 Practical Issues (filing mechanics, word limitations, etc.), Cont.
3. Response Fee (for 15 or more domains): As a brand owner or practitioner representing brand owners, how do you feel about the response fee for 15 or more domains? Do you believe the fee is too high or too low? Does the fee structure work for the URS? How does the fee factor into deciding whether or not to file a URS case? As a respondent or practitioner, please answer the first three questions.
4. Have you found the word limits to be adequate?
5. If you are a brand owner or practitioner: How did you get to know about the existence of URS? How do they make a decision about whether should they propose a URS or just let it go?

# Questions for URS Practitioners, Cont.

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2. Substantive Issues – 2.2 Practical Issues (filing mechanics, word limitations, etc.), Cont.
  6. If you are a registrant: How did you learn about the responses to the URS and the affirmative defenses?
  7. Did any of the decisions in your cases include unintelligible or meaningless language (i.e., “gibberish”)?
  8. Are there effective means available online for searching cases? In your experience, is this true of all providers? How can search be improved?

# Questions for URS Practitioners, Cont.

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2. Substantive Issues – 2.3 Tactics and Approaches (Both URS and non-URS practitioners)
  1. Evidence of Use: If representing Complainant, do you use the .SMD file from the TMCH, a printout from an active web site, or something else? Why did you choose one type of evidence over another?.
  2. Whether and when do you choose to use the URS? If not, why do you bypass the URS?
  3. What do you think about the suspension for the duration of the registration? Should there be an extended time of the suspension? How does suspension as the sole remedy affect your decision whether or not to use the URS as a protection mechanism?
  4. Should there be an “Overview of URS” similar to WIPO's Overview of Panel Views on Selected UDRP Questions?

# Questions for URS Practitioners, Cont.

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2. Substantive Issues – 2.3 Tactics and Approaches (Both URS and non-URS practitioners), Cont.
  1. As drafted and currently interpreted, do you feel that the URS is a reliable mechanism such that parties can reasonably rely upon a uniform application and interpretation of the Policy? If not, why not, and how can this be improved upon? Do you believe this has improved over time, as more decisions have been issued?
  2. For those who have only filed one URS case, was there a reason why you didn't file any more? (e.g. procedural limitation, lack of claims, etc.)
  3. Have you encountered any problems after a successful UDRP decision with the suspension or the extension of the suspension? if so, please describe the problem encountered. Can you recommend any correction or improvement?
  4. What impact, if any, do you believe the GDPR [add a note explaining what GDPR stand for] that will take effect on 25 May 2018 will have on the URS?

# List of URS Practitioners – From Sub Team

Stobbs Julius E Stobbs of Cambridge (does a lot of the Virgin work)	53	
Doug Isenberg	25	Includes "Gigalaw" cases; also has 18 cases as examiner
David Taylor	18	
John Berryhill	5	All for Respondent
Richard Biagi	2	Includes one case where his firm is named but not him
Zak Muscovitch	1	
David E. Weslow of Washington, DC	1	
David Bernstein	0	
Flip Petillon	0	18 as examiner
Mark Monitor	0	
China Trademark Association to help identify practitioners	N/A	

# List of URS Practitioners

Listed with duplicates removed;(*from "representative sample"/** from Forum database full text search) Practitioner	Sample Cases*	Total Cases**	Notes
Rauschhofer Rechtsanwälte of Wiesbaden, Germany	35	74	
Nameshield of Angers, France.	37	73	Laurent Becker, Anne Morin named in most cases
Stobbs Julius E Stobbs of Cambridge	37	53	
Bloomberg L.P. of New York, New York, USA.	10	32	
The GigaLaw Firm, Douglas M Isenberg, Attorney at Law, LLC of Atlanta, Georgia, USA.	36	25	
Cowan, Liebowitz & Latman, P.C. of New York, New York, USA.	10	24	
Mayer Brown JSM	23	23	ADNDRC
Marchais Associes Philippe MARTINI-BERTHON of Paris, France	21	19	
David Taylor of Paris	17	18	
McDermott Will & Emery LLP of Irvine, California, USA.	6	18	
INSIDERS Mathieu Lamotte of Paris	3	18	Lamotte not named in all cases
IBM of Armonk, New York	5	17	Includes "International Business Machines" cases
Kelley Drye & Warren LLP of New York, New York,	10	16	
Partridge IP Law P.C. Mark V.B. Partridge of Chicago, IL, USA	11	15	
DOMAINOO Joanna Aknin of Paris, France	13	13	
Fross Zelnick Lehrman & Zissu, P.C. Todd Martin of New York, NY,	3	13	
Aaron B Newell of London, UK	12	12	
Holland & Hart LLP Darin L. Brown of Boulder, CO	7	12	
Kleinberg & Lerner, LLP Marshall A Lerner of Los Angeles, CA,	5	12	
DLA Piper LLP (US) of Washington, District of Columbia, USA.	2	10	
Faegre Baker Daniels, LLP Stephanie A. Gumm of Indianapolis, IN, USA	4	9	



# List of URS Practitioners, Cont.

Beetz&Partner Patentanwaelte	1	8	
CSC Digital Brand Services of Wilmington, DE	7	7	
BARDEHLE PAGENBERG Pascal Boehner of München, Germany	2	7	
Boehmert & Boehmert Lawfirm of Potsdam, Germany.	1	7	
Baker McKenzie of London, United Kingdom.	5	6	
Katten Muchin Rosenman LLP Jessica M Garrett	3	6	
Dreyfus & associés Nathalie Dreyfus of Paris, France	2	6	
HK2 Rechtsanwälte of Berlin, Germany.	5	5	
John Berryhill of Ridley Park, Pennsylvania, USA.	4	5	All as Respondent's counsel
Jaburg & Wilk, P.C. of Phoenix, Arizona	2	5	
GED Testing Service LLC of Bloomington, Minnesota	2	5	Includes "American Council on Education" cases
Steven M Levy of Philadelphia, USA	2	5	
William J Seiter of Santa Monica, CA, USA	1	5	
Denmeyer & Associates S.A Clémence Le Cointe of HOWALD, Luxembourg	1	5	
Wolfram Group LLC Noah K Tilton of Champaign	1	5	
Cohen Business Law Group, apc Jeffrey A Cohen of Los Angeles, CA, USA	2	4	
Blank Rome LLP Megan E Spitz of Philadelphia, PA, USA	1	4	
Cyveillance of Reston, VA, USA	6	3	
Lichtenstein, Körner and Partners of Stuttgart	4	3	
Husch Blackwell LLP Michelle W. Alvey of St. Louis, MO	3	3	
Porter Wright Morris & Arthur LLP of Columbus, Ohio, USA.	3	3	
CORE Association of Geneva, Switzerland	2	3	
Cabinet Plasseraud of Paris, France.	1	3	

# List of URS Practitioners, Cont.

Fernanda Quarles van Ufford of the Hague	1	3	
Cozen O'Connor of Philadelphia, Pennsylvania, USA.	1	3	
K&L Gates Jonathan A Feder of Melbourne, --, Australia	1	3	
IP TWINS of Paris, France.	<b>1</b>	<b>3</b>	
euromaier - Industrieberatung Maier AG of Sissach, Switzerland	4	2	
Neal & McDevitt, LLC Richard B Biagi of Northfield, IL	3	2	Biagi only named in one case
Orrick, Herrington & Sutcliffe LLP	2	2	
Cabinet SANTARELLI of Paris, France.	2	2	
Michael Best & Friedrich LLP Laura M Konkel of Madison, WI, USA	2	2	
Norton Rose Fulbright US LLP Brandon M. Ress of Austin, TX, USA	2	2	
Wild Schnyder AG Barbara K Mueller of Zürich, Switzerland	2	2	
Lewis Silkin LLP of London, United Kingdom.	2	2	
Shook, Hardy & Bacon LLP Leonard Searcy of Kansas City, MO, USA	2	2	
Greenberg Traurig, LLP of New York, New York, USA.	2	2	
Marshall & Melhorn, LLC John A Borell	1	2	
Weight Watchers International, Inc. Terri J Frank of New york, NY,	1	2	
LOZA & LOZA, LLP of Upland, California	1	2	
Pattishall, McAuliffe, Newbury, Hilliard & Geraldson, LLP Robert W Sacoff of Chicago, IL, USA	1	2	
Travis L Bachman of Minneapolis	1	2	
Brittany L Kaplan of New York	1	2	
GEISTWERT (TM) = Kletzer Messner Mosing Schnider Schultes Attorneys-at-Law OG Max Mosing of Vienna, Austria	1	2	
Bird & Bird LLP of London, United Kingdom	1	2	
VKK Patentanwälte of Hamburg, Germany.	1	2	
Dykema Gossett PLLC Eric T Fingerhut of Washington, DC, USA	2	1	

# List of URS Practitioners, Cont.

aitor montenegro of SABADELL, ES.	1	1
Marc SABATIER of Paris	1	1
Lidl Stiftung & Co. KG	1	1
David E. Weslow of Washington, DC	1	1
Kilpatrick Townsend & Stockton LLP of New York, New York	1	1
Proskauer Rose LLP Jenifer d Paine of New York, NY	1	1
The Gioconda Law Group PLLC of New York, New York	1	1
Domain and Intellectual Property Consultants, Dipcon AB of Stockholm, Sweden	1	1
BAS Services & Graphics, LLC. Alper Uzmezler of Austin, TX,	1	1
Dickinson Wright PLLC Melissa Alcantara of Washington, DC	1	1
HOLA S.L. of Madrid, Spain.	1	1
RMIT University Karen A Lewis of Melbourne, Australia	1	1
Fish & Richardson, P.C. of Minneapolis, Minnesota	1	1
LVMH Moët Hennessy Louis Vuitton of Paris, France.	1	1
SEPHORA Claire Combot of Boulogne Billancourt, France	1	1
Pillsbury Winthrop Shaw Pittman, LLP of Los Angeles, California, USA	1	1
Baker & McKenzie LLP Ruth Burstall of London, United Kingdom	1	1
Weight Watchers International, Inc. of New York, New York, USA.	1	1
Stéphanie Buchillot	1	1
Polsinelli PC of Chicago, Illinois, USA.	2	1
Marine Watine	1	1
Jeevan Jdali	1	1
Frankfurt Kurnit Klein & Selz of New York	1	1

# List of URS Practitioners, Cont.

Bacal Andersen & Garrison Law Group Sean Garrison of Scottsdale, AZ, USA	1	1	
Madwire, LLC of Fort Collins, Colorado, USA	1	1	
Muscovitch Law P.C. of Toronto, ON, Canada	1	1	As Complainant's counsel
Stephen M Werner of Indianapolis, IN, USA	1	1	
Singh & Singh Lall & Sethi Tia Malik of New Delhi, India	1	1	
Jim Chen / Burberry Limited, London, United Kingdom	1	1	
Thompson Hine LLP Carrie A. Shufflebarger of Cincinnati, OH, USA	1	1	
Express Scripts, Inc. Arkadia Olson of St. Louis, MO, USA	1	1	
RiskIQ, Inc. of San Francisco, CA, USA	1	1	
Butler Snow LLP Benjamin L Mitchell of Ridgeland, MS, USA	1	1	
Hogan Lovells (Paris)	6		Included in David Taylor listing
Rauschhofer Rechtsanwalte of Wiesbaden, Germany	6		Included in first Rauschofer listing
Hajo Rauschhofer of Wiesbaden, Germany	4		Included in first Rauschofer listing
William M. Ried of New York	3		Included in Bloomberg listing
Lockheed Martin Corporation of Bethesda, Maryland	2		Included in McDermott Will cases
Philippe Boos	2	1	
Kassam Amin	1		Included in Bloomberg cases
Anne Morin of Angers	1		Included in Nameshield cases
Steven M. Levy of Philadelphia, PA, USA	1		Included in Steven M Levy cases
William M Ried / Bloomberg Finance LP	1		Included in Bloomberg cases
Bloomberg Finance L.P. Amin Kassam of New York, NY, USA	1		Included in Bloomberg cases
Entertainment One UK Limited (ADNDRC)	1		ADNDRC
Marc Muraccini	1		ADNDRC
WILKINSON & GRIST	1		ADNDRC
NIDEC CORPORATION (ADNDRC)	1		ADNDRC
Baker & McKenzie Limited	1		ADNDRC

**Thank You and Questions**