

Alternative Dispute Resolution Related to ccLTD ".it" Domain Names: A Brief Overview of the Italian Rules

By *Alessandro del Ninno of Studio Legale Tommeci, Rome,*
e-mail: adelninno@tommeci.it

Since July 2000, a specific ADR related to domain names registered in the country code ".it" has been available in Italy. This procedure, called the "Re-assignment Procedure of Challenged ".it" domain names", has been set up by the Italian Naming Authority, which is the organisation responsible for defining the rules for the ".it" domain names assignment. The organisation has also established the operating procedures to be followed by the Italian Registration Authority (the body responsible for the assignment of domain names, the management of the National Registry and the primary Nameserver for the Top Level Domain ".it").

The Re-assignment Procedure is an administrative procedure, applicable to all domain names registered under the ccLTD ".it" which have been previously challenged under Article 14 of the Italian Naming Rules 3.7.¹ Its purpose is threefold. First to check the entitlement to use and/or the licit availability of the domain name by the registrant, secondly that the domain name has not already been registered, and finally, that it is not maintained in bad faith.

The Re-assignment Procedure is governed by the Italian Naming Rules; specifically by the rules contained in the document "Domain Name Re-assignment Procedure 1.3" and by the supplementary provisions set forth by the so-called Execution Bodies, specifically in charge of the Re-assignment Procedure.

The Procedures may be enforced and managed by special organisations (public or individual legal persons, professional law firms located in the European Union) which have been previously approved by the Italian Naming Authority on the basis of specific requirements (Article 17 Nam. Rid.).

The appointed Execution Body is required to set up a List of Arbitrators, comprising of at least 15 people. Parties challenging an ".it" domain name then use the list to select an arbitrator (in the case of a sole arbitrator) or three arbitrators (in the case of a board of arbitrators) who shall enact the decision of the Procedure.

The selection of an Execution Body to enforce and manage the Re-assignment Procedure pertains exclusively to the subject interested in challenging an ".it" domain name. All costs related to the procedure are the sole responsibility of the party disputing the domain name. This rule applies whether the procedure is successful or not.

The Italian Naming Authority and the Italian Registration Authority are not involved in the Re-assignment Procedure and as such, are not responsible for the work carried out by the Execution Bodies.

In particular, the Re-assignment Procedure shall regard any challenged ".it" domain name when a third party (hereinafter referred to as the "claimant") states the following:

- the disputed domain name is identical, or similar to a trademark on which the claimant claims rights, so as to be misleading;
- the challenged domain name is identical to the claimant's name and surname;
- the current assignee (hereinafter referred to as the "defendant") has no right or title with respect to the disputed domain name; and
- the domain name has been registered and is used in bad faith.

If the claimant proves the co-existence of *all* the conditions listed above, the disputed domain name shall be transferred to the claimant.

On the other hand, the defendant shall be deemed as entitled to the disputed domain name if they prove that:

- before being informed of the dispute, they used or objectively got ready to use the domain name or a name corresponding to the same to supply goods and services to the public; or
- they are known personally, or as an association or commercial organisation with the name which corresponds to the registered domain name, even if they have not registered the related trademark; or
- they are making lawful use of the domain name for non-commercial purposes, or for commercial purposes without the intention to mislead the claimant's customers or breach the claimant's registered trademark.

The following circumstances, if proved, shall be considered as evidence of registration and use of the domain name in bad faith:

- where the domain name is considered as having been registered with the main intention of selling or transferring the domain name for use or otherwise to the claimant (who holds rights in the trademark or name) or one of his competitors for a consideration (money or other) that exceed the costs reasonably incurred by the defendant for registration and maintenance of the domain name;
- where the domain name has been registered by the defendant in order to prevent the holder of an identical trademark from registering the domain name as their own, and in order to use it for activities which compete with the claimant's activities;
- where the domain name has been registered by the defendant for the main purpose of damaging a competitor's business or usurping the claimant's name and surname;

■ where the domain name has been expressly used to attract Internet users for profit, by originating reasons for confusing it with the claimant's trademark.

This list is not exhaustive, being only intended as an example. The Execution Bodies may, therefore, argue or consider other elements of bad faith in the registration and use of the ccTLD ".it" domain name, from circumstances other than those listed above.

The Re-assignment Procedure is not of a jurisdictional nature, and as such, does not prevent the parties from appealing, even at a later time, to the Courts or to the Arbitration Procedure provided for by Article 15 of the Italian Naming Rules.

In any case, a Re-assignment Procedure cannot be started pending another judgment related to the disputed domain name before either an ordinary judge or the Board of Arbitrators, as provided for by Article 15 Nam. Rul (the Arbitration Procedure being different from the Re-assignment Procedure). If a judgment is filed before the ordinary judge, or an Arbitration Procedure is started as provided by Article 15 pending the Re-assignment Procedure, then the Procedure shall be extinguished.

If multiple Re-assignment Procedures are started with respect to one domain name, all subsequent procedures begun following the initial one will be suspended, pending the outcome of that initial procedure. If the first procedure is concluded by an Execution Body decision to transfer the disputed domain name to the claimant, the other Procedures shall be extinguished.

The Re-assignment Procedure shall be carried out in Italian. The board of Arbitrators may decide, after considering the specific circumstances of each procedure and upon either party's request, to carry it out in a different language. The board of arbitrators may order that any document produced in a language other than Italian be accompanied by a full or partial translation into the language of the procedure.

The board of arbitrators settle the claim based on the parties' statements and the documents submitted and in compliance with the Italian Naming Rules, the Domain Name Re-assignment Procedure Regulation and the Italian law principles.

The Re-assignment Procedure is very quick. Barring exceptional circumstances, the board of arbitrators communicates its decision on the claim to the Execution Body within 15 days of its establishment, or 30 days if additional documents are required. This usually means that the entire process takes around 45 days from start to finish.

If, at the outcome of the preliminary investigation, the board of arbitrators becomes convinced that the claim has been filed in bad faith, for instance to discredit the domain name holder, it shall specify in the decision that the claim has been filed in bad faith and that it constitutes an abuse (reverse domain name hijacking).

The Execution Body must communicate the full text of the decision reached by the board of arbitrators

to the claimant, the defendant, the Italian Registration Authority and the President of the Italian Naming Authority within four days of receiving the verdict from the board.

In case the board of arbitrators deliberates the transfer of the disputed domain name, the Registration Authority shall immediately inform the claimant, the defendant, the administrator and the President of the Naming Authority of the date on which they intend to enforce the decision.

Unless otherwise determined by the board of arbitrators, the Execution Body shall publish the full text of the decision and the date of its enforcement in a publicly accessible website. In any case, the part of the decision stating that the claim has been filed in bad faith shall always be published.

If the parties reach an agreement before the board of arbitrators issue the decision, the board of arbitrators shall cancel the procedure. If any circumstance should occur to make it useless or impossible to continue the procedure before the board of arbitrators issue their decision, the board of arbitrators shall cancel the procedure, unless either party raises valid objections for continuation within the term established by the board of arbitrators.

Furthermore, if either party brings a lawsuit pending the administrative procedure concerning a domain name that is disputed in a claim, it shall promptly inform the board of arbitrators and the execution Body thereof.

If the Execution Body decides that the disputed domain name has to be re-assigned, the Board's deliberation shall be enforced by the Italian Registration Authority, unless the Registration Authority receives, within 15 days from reception of the Board's deliberation, a suitably documented release from the defendant that proves that the defendant has filed legal proceedings or arbitration with respect to the disputed domain name. In this case, the rules under Articles 14.5 and 14.6 Nam. Rul. shall apply.

If the legal proceedings or arbitration filed by the defendant are otherwise extinguished, the Italian Registration Authority shall enforce the Board's deliberation on the claimant's request.

Further information is available from the following websites:

- Official website of both the Italian registration Authority and the Italian Naming Authority, which can also be viewed in English: www.nic.it
- Italian Naming Rules - Version 3.7 in force starting from March 5, 2002 (text in English): www.nic.it/NA/regole-naming-cur-engl.txt
- Domain Name Re-assignment Procedure Regulation - version 1.3 of which came into force on August 14, 2001 (text in English): www.nic.it/NA/riassegnazione-cur-engl.txt
- 1 Article 14 ("Disputation procedure"). Anyone can dispute domain names assigned by the Italian Registration Authority that are in use and listed in the Registry of Assigned Names.
Article 14.1 ("Introduction to disputation"). Complainants professing to have been subject to prejudice as a result of an object assigned in use to (an) other(s) can begin the dispute process by stating their case in writing to the Italian Registration Authority. A letter must be sent to the organisation by registered post. (omissis).