

## **EXPERT DETERMINATION LEGAL RIGHTS OBJECTION**

Scripps Networks, LLC v. Charleston Road Registry Inc.

Case No. LRO2013-0019

### **1. The Parties**

The Complainant/Objector (the “Objector”) is Scripps Networks, LLC of Knoxville, Tennessee, United States of America, represented by Wolfe, Sadler, Breen, Morasch & Colby, LLC, United States.

The Respondent/Applicant (the “Respondent”) is Charleston Road Registry Inc. of Mountain View, California, United States, represented by Katten Muchin Rosenman LLP, United States.

### **2. The applied-for gTLD string**

The applied-for gTLD string is <.diy>.

### **3. Procedural History**

The Legal Rights Objection (the “Objection”) was filed with the WIPO Arbitration and Mediation Center (the “WIPO Center”) on March 13, 2013 pursuant to the New gTLD Dispute Resolution Procedure (the Procedure).

On March 18, 2013, the Center sent an email communication to the Objector, with a copy to the Respondent, noting that two email submissions of the Objection were received and attaching the email submission it was intending to use for compliance review purposes. On the same day, the Objector confirmed that two email submissions of the Objection were sent due to a bounce back notification.

In accordance with Article 9 of the Procedure, the WIPO Center has completed the review of the Objection on March 21, 2013 and has determined that the Objection complies with the requirements of the Procedure and the World Intellectual Property Organization Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections (the WIPO Rules for New gTLD Dispute Resolution).

In accordance with Article 11(a) of the Procedure, the WIPO Center formally notified the Respondent of the Objection, and the proceedings commenced on April 16, 2013. In accordance with Article 11(b) and relevant communication provisions of the Procedure, the Response was timely filed with the WIPO Center on May 15, 2013.

The WIPO Center appointed W. Scott Blackmer as the Panel in this matter on June 14, 2013. The Panel

finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the WIPO Center to ensure compliance with Article 13(c) of the Procedure and Paragraph 9 of WIPO Rules for New gTLD Dispute Resolution.

#### **4. Factual Background**

The Objector is a limited liability company established under the laws of the State of Delaware, United States, and headquartered in the State of Tennessee, United States. The Objector is a wholly owned subsidiary of Scripps Networks Interactive, Inc. (“SNI”), a publicly traded company on the NASDAQ stock exchange, and holds trademarks on behalf of the SNI group.

SNI develops “lifestyle-oriented content” for television and for online, mobile, and print media. SNI’s portfolio includes media brands such as DIY Network, Food Network, HGTV, Travel Channel, and Cooking Channel. Since 1999, the SNI group has produced “DIY Network” television programming on home-improvement, design, and self-help projects for subscription cable and satellite television distribution. According to the affidavit of an SNI executive, DIY-branded programming currently reaches 58 million television subscribers, and the associated website at “www.diynetwork.com” has 2.7 million unique visitors per month. The Objector states that the DIY brand generates more than USD 120 million in annual revenue and that SNI has invested “hundreds of millions of dollars” in “building the brand” since 1999.

The Objector holds numerous registered trademarks consisting of, or including, the acronym “DIY”, in 32 jurisdictions. These are summarized below under Section 6.B. “The Objector’s Existing Legal Rights”.

Another subsidiary of SNI, Lifestyle Domain Holdings, LLC, filed an application to ICANN for the identical new gTLD string <.diy>, with the purpose (as expressed in the application) of using it to create “an enhanced online experience from the existing family of SNI’s lifestyle branded .coms and diynetwork.com”, consistent with the brand’s reputation as a “trusted source for fun and interesting edutainment for do-it-yourself lifestyle related activities”. The Objection states that the new gTLD string <.diy> is meant to extend SNI’s “current online channel of distribution through the use of the brand top level domain.” As this string is identical to the one for which the Respondent applied, ICANN has placed both applications in a “string contention set”. As explained in Module 4 of the ICANN Applicant Guidebook (version 2012-06-04) (the “Guidebook”), string contention may be resolved in several ways, including an auction as a last resort.

The Respondent is a business corporation established under the laws of the State of Delaware and headquartered in the State of California, United States. It is a wholly owned subsidiary of Google Inc. (“Google”), a publicly traded American multinational company listed on the NASDAQ stock exchange. Google, founded in 1998, is an international leader in Internet search and related services. In December 2012, Alexa.com listed “www.google.com” as the most visited website in the world. The Respondent has applied for more than 100 new gTLD strings, most if not all of which consist of dictionary words, acronyms, or generic terms. The Respondent’s stated intention is to make the new gTLD string <.diy> available for domain names with content relevant to the “do-it-yourself” market:

“As stated in its Application, the proposed gTLD will provide the marketplace with direct association to the term, ‘diy,’ a common acronym for the phrase ‘do-it-yourself.’ The mission of this open registry is to provide a dedicated domain space in which registrants can enact second level domains that provide content relating to do-it-yourself activities, including but not limited to home improvement or arts and crafts.”

#### **5. Parties’ Contentions**

##### **A. Objector**

The Objector asserts that the new gTLD string <.diy> is identical to its registered DIY mark and confusingly

similar to its other marks that incorporate the acronym “DIY”. The Objector argues that the Respondent “knew or should have known” of these marks and intends to use the new gTLD string <.diy> “in a way that explicitly intends to interfere with the existing rights of the Objector”, as the Respondent states that it “aspires to become an authoritative online resource for content related to do-it-yourself activities.”

The Objector contends that the Respondent does not currently use the acronym “DIY” in connection with a *bona fide* offering of goods or services and has not made demonstrable preparations to use the new gTLD string <.diy> “in a way that does not interfere with the legitimate exercise by Objector of its trademark rights.” The Objector points out that its trademark rights cover “the field of operating a web site, computer network, content and information”, concluding that “any use of DIY by Respondent as a top level domain operator would inherently infringe upon Objector’s exact class of goods and services for which protection has been granted in more than thirty-two jurisdictions.”

The Objector foresees harm to consumers as well as to the Objector if the Respondent’s application for the new gTLD string <.diy> is granted:

“Should Respondent operate .diy as an open system, consumers will be confused and misled into believing that second string domains on the top level domain. DIY are somehow related or connected to the famous DIY brand. They will be damaged when they trust content that is not of the same quality that Objector promises. Not only will consumers be misled and potentially harmed as a result, but this erosion of the DIY brand will cause irreparable harm to Scripps Networks by devaluing and diluting the integrity of its brand which it has built over many years and as the result of substantial investment.”

The Objector concludes that the Respondent’s use of the applied-for <.diy> string would take unfair advantage of the reputation associated with the Objector’s marks, impair the distinctive character and reputation of the marks, create a likelihood of confusion with the marks, and harm Internet users by misleading them in believing that this new gTLD string is related to the Objector.

## **B. Respondent**

Citing dictionaries and the Wikipedia entries for “DIY” and “Do-it-yourself”, the Respondent argues that “DIY is a common, everyday generic word that means ‘do-it-yourself’, *i.e.*, the activity of doing or making something (as in woodworking or home repair) without professional training or assistance.” According to the Wikipedia article on “DIY”, the term has been in use since the 1950s but has expanded beyond home improvements and crafts:

“Subsequently, the term DIY has taken on a broader meaning that covers a wide range of skill sets. DIY is associated with the international alternative rock, punk rock, and indie rock music scenes; indymedia networks, pirate radio stations, and the zine community. The abbreviation DIY is also widely used in the military as a way to teach commanders or other types of units to take responsibility, so that they’d be able to do things themselves just as a preparation for their own future.”

The Respondent acknowledges the Objector’s registered DIY mark but observes that the Objector uses the term in the marketplace only in a stylized form with NETWORK or another term, as reflected in the most recent trademark use specimen submitted to the United States Patent and Trademark Office (“USPTO”) for the DIY mark. The Respondent concludes that the applied-for new gTLD string <.diy> “should be considered different in appearance from Objector’s Marks because based on how Objector uses the term in the marketplace, consumers solely associate the unitary mark ‘DIY NETWORK,’ and not DIY alone, with Objector.”

The Respondent argues that confusion is unlikely because the public associates DIY NETWORK with the Objector’s television programming and recognizes the “DIY” acronym as generic. The Respondent argues that “because of the generic nature of DIY, Objector is entitled to only a limited scope of protection and cannot prevent others from using DIY as a generic term. The use of DIY as a TLD for domain names is a generic use.” The Respondent points out that third parties currently own “DIY” domain names, including

<diy.com>, <diy.net>, <diy.org>, <diy.biz>, and <diy.info>. The Objector itself uses <diynetwork.com> for its website relating to the DIY NETWORK, not any domain name consisting of “DIY” alone.

The Respondent denies any intention to use the “DIY” acronym as a trademark associated with goods or services and cites authorities for the proposition that using a term in its generic sense does not interfere with a third-party’s trademark rights.

The Respondent contends that an open registry using the generic term would increase consumer choice and competition in the marketplace for “DIY” goods, services, and information, and would do so without infringing, impairing, or taking unfair advantage of the Objector’s trademarks.

## **6. Discussion and Findings**

### **A. Standards for Decision**

Section 3.2.1 of the Guidebook provides that before ICANN approves an application to operate a new gTLD, trademark owners are allowed to submit a Legal Rights Objection on the ground that “the applied-for gTLD string infringes the existing legal rights of the objector”.

As provided in Section 3.2.2.2 of the Guidebook, a rights holder must establish its standing to file a Legal Rights Objection by furnishing “the source and documentation of the existing legal rights”, which may include either registered or unregistered trademarks. The rights holder must then establish that the proposed new gTLD would infringe or impair those rights.

Decisions on Legal Rights Objections are based on the evidence introduced by the parties, the standards set forth in Module 3 (“Objection Procedures”) attached to the Guidebook, the Procedure, the WIPO Rules for New gTLD Dispute Resolution, and applicable substantive law.

Section 3.5.2 of Module 3 of the Guidebook, provides this direction for panels evaluating Legal Rights Objections:

“In interpreting and giving meaning to GNSO Recommendation 3 (‘Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law’), a DRSP panel of experts presiding over a legal rights objection will determine whether the potential use of the applied-for gTLD by the applicant takes unfair advantage of the distinctive character or the reputation of the objector’s registered or unregistered trademark or service mark (‘mark’) [...], or unjustifiably impairs the distinctive character or the reputation of the objector’s mark [...], or otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector’s mark [...].”

This section of Module 3 continues by instructing panels to consider eight non-exclusive factors when Legal Rights Objections are based on trademark rights, as they are in the current proceeding. Other potentially relevant factors are not precluded in assessing the Objections, and the Guidebook does not indicate what relative weight should be placed on each of the listed factors. The Panel addresses each of these factors in the discussion further below.

### **B. The Objector’s Existing Legal Rights**

The Objector holds United States Registration No. 2457989 (registered June 5, 2001) for DIY. The mark is registered in International Class 042 as a standard-character service mark for “providing a website of information about television programming; news and weather; gardening and landscaping; crafts and hobbies; sewing and quilting; furniture and antiques; interior design and decorating; home building, improvement, repairs and renovation; and similar projects and topics.”

The Objector also holds numerous other trademark registrations in the United States and some 32 other jurisdictions for word or design marks incorporating DIY with other relevant words, such as DIY NETWORK, DIY DOMINATOR, DIY DO IT, DIY DO IT YOURSELF, DIY KIDS, DIY ON DEMAND, DIY TO THE RESCUE, ASK DIY, DISASTER DIY, and DIY DO IT YOURSELF NETWORK.

The Panel concludes that these registered marks give the Objector standing to pursue a Legal Rights Objection against the Respondent's application for the new gTLD string <.diy>.

### **C. Potential Infringement of the Existing Legal Rights of the Objector**

The applied-for string <.diy> is identical to the letters comprising the Objector's registered DIY mark. The record amply demonstrates, however, that "DIY" is a commonly used, generic acronym for the phrase "do it yourself", as found in dictionaries, online and print media, Internet domain names, retail industry market reports, and Internet search engine results. The Objector concludes that the new gTLD string <.diy> could not be used by the Respondent without infringing its existing legal rights.

The Panel does not agree with this conclusion. The acronym "DIY" has generic meanings that are not exclusively associated with the Objector's television programming and associated website content. The Objector's DIY trademark, as described in the United States registration, is for use in connection with "a website". As such, the Objector cannot displace all other uses of the generic term. Where a mark consists of a dictionary word or acronym, as it does here, the scope of trademark protection must necessarily be construed narrowly to avoid giving a company exclusive rights to use a term in its generic sense. See Paris Convention for the Protection of Industrial Property, Art. 6 (quinquies) (B)(2) (a sign registered in one country may not be registered, or may be invalidated, in another country if it has become "customary in the current language or in the *bona fide* and established practices of the trade" in that country); J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12: 2 ("Generic names are regarded by law as free for all to use. They are in the public domain."); 1 Anne Gilson LaLonde, GILSON ON TRADEMARKS § 2.02[1] ("A generic name is free for use by anyone when applied to the products it signifies, is often a competitive necessity, and can be used in its generic sense notwithstanding its registration for other products").

The operation of a gTLD registry is not the same business as the operation of a commercial website, and a *generic* gTLD would not normally serve as a source identifier for goods or services in any event. See MCCARTHY ON TRADEMARKS § 7: 17.50; United States Patent and Trademark Office, TRADEMARK MANUAL OF EXAMINING PROCEDURE 5th Ed. (2007) § 1215.02. The Respondent asserts that it has no intention of using the <.diy> new gTLD as a trademark or service mark, and this is plausible given the stated purpose of the open registry, which would not be limited to any particular DIY manufacturer, retailer, or content provider. The Respondent itself and its parent company, Google, are not in the business of selling DIY products or programming. The Respondent proposes, in its application for the new gTLD string <.diy>, to use it for its broadest generic signification. The Panel finds this is consistent with the Respondent's application for more than a hundred new gTLDs, most if not all of which are comprised of generic terms. One cannot rule out the possibility that a second-level domain registered under the new gTLD string <.diy> may eventually be considered as misusing the Objector's trademark<sup>1</sup> but this does not mean that the use of this new gTLD as such should itself be considered as infringing the Objector's existing legal rights in the DIY trademark.

The Panel notes that the issue of the generic quality of the acronym "DIY" has arisen previously in the context of a dispute concerning the domain name <diy.biz>. In 2002, a UDRP panel dismissed the complaint brought by a United Kingdom company claiming rights in the unregistered mark DIY, remarking, "it is in practice impossible to run a business in do-it-yourself products without using the letters DIY in a wholly generic, descriptive way." *B & Q Plc v. Jolyon Orme*, WIPO Case No. DBIZ2002-00084. The Panel is inclined to find similarly that a new gTLD intended for use by DIY manufacturers, retailers, and enthusiasts may appropriately, even necessarily, use the generic acronym for the very products and activities in which they are interested.

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<sup>1</sup> The Panel notes that the Respondent has promised to adopt rights protection mechanisms in its plans for overseeing the second-level domains that would be registered under the new gTLD string <.diy>.

Apart from the DIY mark, the other registered marks held by the Objector all add words, and in some cases design elements, to DYI. This distinguishes the marks more successfully from the generic “DYI” acronym – and also from the proposed new gTLD string. The Respondent points out that the Objector’s most recently filed trademark specimens, found on the USPTO database, display DIY NETWORK, not DIY alone. The Panel also found only the marks with an additional word or words, predominantly DIY NETWORK, displayed on the documents submitted in the record of this proceeding and, indeed, on the Objector’s website, which is at “www.diynetwork.com”. It is not evident, on the present record, that the DIY mark alone is widely recognized as relating to the Objector’s programming or website or that a significant segment of the public associates the “DIY” acronym, standing alone, with the Objector.<sup>2</sup> Moreover, the Panel does not find that the Respondent’s intended use of the applied-for new gTLD – which is solely comprised of the generic acronym “DYI” – would necessarily create a likelihood of confusion with the Objector’s other marks.

The Panel cannot conclude, on this record, that the applied-for new gTLD string <.diy> infringes the Objector’s existing legal rights.

#### **D. Conclusions**

The parent companies of both parties clearly have an interest in operating the new gTLD string <.diy>, for different purposes. The Objection can only be upheld if it meets the Guidebook standards, and the Objector “bears the burden of proof in each case.” Section 3.5. of Module 3 of the Guidebook. With that in mind, the Panel’s conclusions follow, on each of the factors for which the Guidebook (Section 3.5.2 of Module 3) requires consideration in a case based on trademark rights.

*1. Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound, or meaning, to the Objector’s existing mark.*

The new gTLD <.diy> is identical to the Objector’s registered DIY mark. It is similar in appearance and sound to the Objector’s other marks that include DIY, and it is similar in meaning to the extent that all of the marks, like the string itself, appear to use the acronym “DIY”, which represents the phrase “do it yourself” to a large segment of the English-speaking population.

*2. Whether the Objector’s acquisition and use of rights in the mark has been bona fide.*

It is undisputed in this proceeding that the Objector has lawfully acquired and used the various marks incorporating DYI. It is not established on this record that the Objector currently uses the DYI mark alone.

The Panel finds that the Objector’s acquisition and use of rights in the DIY marks has been *bona fide*.

*3. Whether and to what extent there is recognition in the relevant sector of the public of the sign corresponding to the gTLD, as the mark of the Objector, of the Respondent or of a third party.*

The record supports the conclusion that the mark DYI NETWORK is widely recognized and associated with the Objector in connection with the Objector’s television programming and the related website (as well as events and contests promoted on the television programs and website). However, the record does not support a conclusion that the DYI mark alone is widely recognized as relating to the Objector’s programming or website. To the contrary, the record indicates that the acronym “DYI” alone is predominantly associated with common, generic, dictionary meanings referring to a range of activities, products, and services rather than to the Objector’s television programming and website. Accordingly, based on the present record, the Panel does not find that “there is recognition in the relevant sector of the public of the sign corresponding to the gTLD, as the mark of the Objector, of the Respondent or of a third party.”

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<sup>2</sup> The Panel notes that a “jpeg” image where the DIY mark alone is displayed is referenced in and attached to Annex 5 to the Objection. In the Panel’s view, this image alone is insufficient to establish that the DIY mark alone is widely recognized as relating to the Objector’s programming or website or that a significant segment of the public associates the “DIY” acronym, standing alone, with the Objector.

*4. Respondent's intent in applying for the gTLD, including whether the Respondent, at the time of application for the gTLD, had knowledge of the Objector's mark, or could not have reasonably been unaware of that mark, and including whether the Respondent has engaged in a pattern of conduct whereby it applied for or operates TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others.*

The Respondent does not deny prior awareness of the Objector's marks but challenges their relevance, as the Respondent sought to operate a new gTLD concerned with "DIY" in its generic sense. The record amply demonstrates that "DIY" has both a trademark and a generic sense. It is undeniably used in the Objector's marks, but it is also undisputed that "DIY" refers, among other things, to an industry sector with products and services catering to the needs of "do it yourself" consumers. As discussed above, the Panel agrees with the Respondent that it is possible to use the new gTLD string <.diy> without necessarily infringing the Objector's existing legal rights.

The Respondent has applied for more than a hundred new gTLD strings, most if not all of which appear to be comprised of dictionary words and common acronyms or abbreviations. There is no evidence in the record, or from a perusal of this list of applications, that the Respondent has engaged in a pattern of seeking to operate gTLDs that are identical or confusingly similar to the marks of others.

*5. Whether and to what extent the Respondent has used, or has made demonstrable preparations to use, the sign corresponding to the gTLD in connection with a bona fide offering of goods or services or a bona fide provision of information in a way that does not interfere with the legitimate exercise by the objector of its mark rights.*

The Respondent has not used a sign corresponding to the new gTLD string <.diy> as a mark for goods or services and denies any intention of doing so. The Respondent has described, in its application for the new gTLD string <.diy> and the Response, a plausible plan to use the string in its generic sense for an open new gTLD available for the construction of websites associated with second-level domains that could be operated by "DIY" vendors, consumers, and information providers. For the reasons discussed above in Section 6.C. "Infringement of the Existing Legal Rights of the Objector", the Panel concludes that it is likely this can be accomplished without necessarily infringing the Objector's existing legal rights. Moreover, the Respondent's parent company, Google, has relevant experience in operating Internet services and has introduced mechanisms on its hosted platforms through which "trademark owners can contact Google and discuss third party use of their marks". The Respondent has promised to adopt rights protection mechanisms in its plans for overseeing the second-level domains that would be registered under the new gTLD string <.diy>.

*6. Whether the Respondent has marks or other intellectual property rights in the sign corresponding to the gTLD, and, if so, whether any acquisition of such a right in the sign, and use of the sign, has been bona fide, and whether the purported or likely use of the gTLD by the Respondent is consistent with such acquisition or use.*

The Respondent does not claim intellectual property rights in the sign corresponding to the new gTLD string <.diy>. It seeks instead to use the string only in its generic sense.

*7. Whether and to what extent the Respondent has been commonly known by the sign corresponding to the gTLD, and if so, whether any purported or likely use of the gTLD by the Respondent is consistent therewith and bona fide.*

The Respondent is not known by the sign corresponding to the new gTLD string <.diy> and plans to use it only for its broad, generic signification.

*8. Whether the Respondent's intended use of the gTLD would create a likelihood of confusion with the objector's mark as to the source, sponsorship, affiliation, or endorsement of the gTLD.*

The Panel concludes on the available record that confusion in the marketplace is not likely, for these reasons:

- It is not evident, on the present record, to find that the DIY mark alone is widely recognized as relating to the Objector's programming or website or that a significant segment of the public associates the "DIY" acronym, standing alone, with the Objector.
- "DIY" is a common, generic, dictionary term, referring to an industry and a range of activities beyond the television programming and related website operated by the Objector.
- Many third parties – including retailers, manufacturers, analysts, reporters, and consumers – use the "DIY" acronym in connection with an array of products, services, crafts, hobbies, music, and domain names that have nothing to do with the Objector.
- The abundance of generic uses of "DIY" suggests that the acronym alone is not distinctive to the Objector. The Objector has not demonstrated otherwise. The Objection does not include evidence showing that consumers associate the "DIY" acronym distinctly with the Objector. The Objector's evidence concerning website visitors and social media contacts relates to sites on which the DIY NETWORK mark is used, or other marks adding words to the acronym.
- The Respondent's planned use of the new gTLD string <.diy> is concerned with "DIY" in its generic sense and not focused on the products and services of a single company or the interests of a particular "DIY" community. It is possible that the second-level domains registered under this new gTLD might compete with the Objector as "DIY" content providers but without the inclusion in the applied-for string of distinguishing elements traditionally used in the Objector's brands, such as "network", the Panel finds it unlikely that the new gTLD string <.diy> itself would mislead Internet users as to source or affiliation.

## 7. Decision

For the reasons discussed above, the Panel concludes that the Respondent's intended use of the new gTLD string <.diy> does not:

- (i) take unfair advantage of the distinctive character or the reputation of the Objector's registered trademarks, or
- (ii) unjustifiably impair the distinctive character or the reputation of the Objector's marks, or
- (iii) otherwise create an impermissible likelihood of confusion between the applied-for gTLD and the Objector's marks.

The Objection is accordingly rejected.

[signed]

**W. Scott Blackmer**

Sole Panel Expert

Date: August 12, 2013