

EXPERT DETERMINATION LEGAL RIGHTS OBJECTION

Scripps Networks Interactive, Inc. v. Wild Orchard, LLC

Case No. LRO2013-0021

1. The Parties

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

The Applicant/Respondent (“Applicant”) is Wild Orchard, LLC of Bellevue, Washington, United States represented by The IP & Technology Legal Group, P.C. d/b/a “New gTLD Disputes”, United States.

2. The applied-for gTLD string

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

3. Procedural History

The Legal Rights Objection (“LRO” or “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”).

In accordance with Article 9 of the Procedure, the WIPO Center has completed its 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”).

In accordance with Article 11(a) of the Procedure, the WIPO Center formally notified the Applicant 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 Applicant timely filed its Response with the WIPO Center on May 17, 2013.

On May 17, 22, and 29, 2013, the Objector submitted e-mail communications to the Center relating to consolidation of proceedings. The Objector inquired as to possible consolidation of this proceeding and another objection from the Objector and involving the same gTLD though with a different applicant/respondent. Subsequently, on May 29, the Objector filed a formal request for consolidation. The Center, pursuant to Article 12 of the Procedure and Paragraphs 7 and 8 of the WIPO Rules and through a message dated May 30, 2013, concluded that the request was untimely. It invited both parties in this

proceeding to comment on its conclusion by June 3, 2013. Neither party provided any comments in response to the WIPO Center's invitation.

The WIPO Center appointed Peter L. Michaelson as the Panel in this matter on June 11, 2013. The Panel finds that it was properly constituted. On June 10, 2013, the Panel had submitted its 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.

In light of the interests at stake for both parties in this proceeding, the Panel, pursuant to Article 17 of the Procedure and through Expert Panel Order No. 1 issued on July 8, 2013, invited both parties to file a further set of submissions. Specifically, the order invited the Objector to file, in its discretion and within 15 days, a Reply, with the WIPO Center, limited to observations and arguments related to new or unforeseen arguments brought forward by the Applicant in its Response. Similarly, the order accorded the Applicant an opportunity to file, with the WIPO Center, in its discretion and within an immediately subsequent period of 15 days, a Sur-reply to observations and arguments set forth in the Reply.

On July 23, 2013, the Objector timely filed its Reply by e-mail with the WIPO Center. Subsequently, on August 6, 2013, the Applicant timely filed its Sur-Reply by e-mail with the WIPO Center.

Pursuant to Panel Order No. 1, the Panel's Expert Determination is due 45 days after the expiration of the 15-day Sur-Reply period, that deadline specifically being September 23, 2013.

4. Factual Background

A. Objector's FOOD Marks

The Objector, Scripps Networks Interactive, Inc ("SNI"), owns a portfolio of numerous United States and counterpart foreign registered trademarks for marks containing the term "food" with or without additional text and in block letters, lower case letters and/or as part of a design. The Objector has provided: (a) in Annex 2 to the Objection, a listing of all its FOOD Marks, and (b) in Annex 3 to the Objection, copies of its registration certificates for one of its Argentinian registrations and various ones of its US registrations. Pertinent details of a representative sample of those US registrations, depicting variations of the FOOD Marks across SNI's portfolio, are as follows:

- (1) FOOD (block letters)
US registration No.: 4,049,665
registered: November 1, 2011

This mark is registered for use in connection with: "[e]ntertainment services, namely an on-going audio and visual program distributed over television, satellite, wireless, audio and video media, fiber optics, cable, and a global computer network in the fields of cooking and culinary arts, health, fitness, and nutrition", all in International class 41. The registration certificate states that, in conjunction with these services, both first use and first use in commerce of the mark commenced as of January 2, 2003.

- (2) FOOD (design: white lower case text "food" within a black circle with a black background)
US registration No.: 3,658,544
registered: July 21, 2009

This mark is registered for use in connection with: "providing information via a global computer information network in the fields of cooking and culinary arts" in international class 43. The registration certificate states that, in conjunction with this service, both first use and first use in commerce of the mark commenced as of January 1, 2003.

- (3) FOOD NETWORK (block letters)
US registration No.: 3,874,130
registered: November 9, 2010

This mark is registered for use in connection with: “[p]rinted materials and publications, namely a magazine about food and cooking” in international class 16. The registration certificate states that, in conjunction with these goods, both first use and first use in commerce of the mark commenced as of November 1, 2008.

- (4) FOOD NETWORK-HD (block letters)
US registration No.: 3,319,967
registered: October 23, 2007

This mark is registered for use in connection with: “distribution of television programs for others; entertainment services, namely, providing television programs in the fields of food, cooking, recipes, restaurants, entertaining, nutrition, and the culinary arts via television, global computer networks, wireless global computer networks, cable, satellite, and fiber optics; audio-visual programming services, namely television programming”, all in international class 41. The registration certificate states that, in conjunction with these services, both first use and first use in commerce of the mark commenced as of June 30, 2006.

- (5) FOOD NETWORK (block letters)
US registration No.: 3,607,721
registered: April 14, 2009

This mark is registered for use in connection with: “[c]heese cloth; dish cloths; fabric table runners and table toppers; oven mitts; place mats not made of paper; place mats of textile material; table linen namely coasters, napkins and place mats; table mats not of paper; textile napkins, place mats and tablecloths”, all in international class 24. The registration certificate states that, in conjunction with these goods, both first use and first use in commerce of the mark commenced as of September 30, 2007.

- (6) FOOD NETWORK (design: white lower case text “food network” with “network” in a smaller font juxtaposed immediately below “food”, both within a black circle with a black background)
US registration No.: 2,924,169
registered: February 1, 2005

This mark is registered for use in connection with: “entertainment services in the nature of ongoing television programs in the field of cooking and culinary arts, health, fitness and nutrition and distribution for others and production of television programs”, all in international class 41. The registration certificate states that, in conjunction with these services, both first use and first use in commerce of the mark commenced as of February 27, 2003.

- (7) FOOD.com (stylized: “Food” in block letters, followed by a period with a raised balloon containing “.com” in white letters against a black background emanating from the period)
US registration No.: 4,106,214
registered: February 28, 2012

This mark is registered for use in connection with: “providing information via a global computer information network in the fields of cooking and culinary arts” in international class 43. The registration certificate states that, in conjunction with this service, both first use and first use in commerce of the mark commenced as of July 13, 2010.

- (8) FOODOGRAPHY (block letters)
US registration No.: 4,046,554
registered: October 25, 2011

This mark is registered for use in connection with: “educational and entertainment services, namely, a continuing program about cooking, accessible by radio, television, cable, fiber optic networks, wireless networks, satellite, audio video, and computer networks”, all in international class 41. The registration certificate states that, in conjunction with this service, both first use and first use in commerce of the mark commenced as of July 4, 2010.

B. Objector

The Objector, SNI, a publicly traded US company, develops lifestyle-oriented content for many media platforms, including television, digital, mobile and publishing. Its portfolio includes worldwide media brands, including Food Network, HGTV, Travel Channel, Cooking Channel and DIY Network.

SNI, through its subsidiary or related entities Scripps Networks, LLC and Television Food Network, G.P., owns the FOOD Marks. Many of these marks have been in existence for more than 10 years and used with SNI’s FOOD brand and in conjunction with, e.g., television broadcasting and entertainment services, online entertainment and information services, sweepstakes and contests, and other related goods and services.

SNI has been operating its television network under its marks FOOD and FOOD NETWORK for 20 years. Currently, its television programming is viewed in over 150 countries, including the United States, the United Kingdom of Great Britain and Northern Ireland, India, and further countries in Asia and in Africa. This programming is viewed by approximately 100 million subscribers in the United States alone, with tens of millions more throughout the world. SNI’s <foodnetwork.com> website averages over 225 million visitors each month. On social media and with respect to culinary arts and cooking, SNI’s FOOD brand has attracted over 5 million collective fans. Since 2010, SNI also operates another website at <food.com> through which, SNI under its mark FOOD.COM, provides recipes and information on cuisine and meal planning. This latter website currently experiences over 20 million monthly visitors. The brand FOOD.COM presently has social media following of over 300,000 fans. Further, SNI’s programming has gained attention from other forms of media, including newspapers, magazines and radio and television talk shows. Paragraphs 4-7, Declaration of Lori Hickok, Executive Vice President of Finance for SNI – a copy of the declaration appears in Annex 5 to the Objection.

At present, SNI expends approximately USD 30 million annually in marketing its FOOD and FOOD NETWORK branded shows and products. This marketing is conducted through print media, television advertising, television talk shows featuring talent, digital advertising, website and social media pages, and participation in and sponsorship of culinary events, such as food and wine festivals, food truck tours, cooking contests and other events. *Id.* at paragraph 9.

SNI’s FOOD brand generates more than USD 800 million of annual revenue. *Id.* at paragraph 5.

SNI, through its subsidiary, Lifestyle Domain Holdings, LLC, is the applicant for the conflicting gTLD string <.food>.

C. Applicant

Donuts Inc. (“Donuts”), the parent company of the Applicant, was founded to acquire and operate “new” gTLDs under ICANN’s New gTLD Program that officially launched in July 2011. It applied for 307 new gTLD strings (at a cost of USD 185,000 per application) for a cumulative investment of approximately USD 57 million in application fees – more than any other entity has invested (the next largest two are Google with 101 strings and Amazon with 78 strings). Paragraph 14, Declaration of Jonathon Nevett, a founder and Executive Vice President of Donuts – a copy of that declaration appears in Annex B to the Response.

Donuts intends to provide various services including a domain name registrar at each new gTLD it places in operation, thus creating a large-scale top-level domain (TLD) registry. It believes that, by achieving economies of scale through operating a large number of new gTLD name registries, it will: (a) expand consumer choice and expression, particularly for those Internet users who seek a specific Internet identity,

as well as (b) increase competition in the namespace by making available for registration and use second-level domain-gTLD name pairs that otherwise would not be economically viable and obtainable. See paragraphs 18(a) and 23 (first paragraph of answer text), New gTLD Application submitted to ICANN by Wild Orchard, LLC (for string: <.food>), application ID: 1-1462-36448 – a copy of which appears in Annex 1 to the Complaint (henceforth simply “New gTLD Application”).

Donuts selected the 307 gTLD strings, including <.food>, as delineating subject areas which it believed would be attractive and useful to a variety of Internet users as each one facilitates search, self-expression, information sharing and the provision of goods and services. *Ibid.* Donuts stated that it deliberately chose each string to be a common dictionary word so that consumers could use the corresponding gTLD in accordance with its well-understood meaning. Paragraph 7, Nevett Declaration.

Donuts states, that in an effort to preserve third-party rights and protect against potential abuse and misconduct that may arise during customer name registration, it will implement eight additional measures beyond those ICANN requires for use with every new gTLD it places in use: periodic audit of Whois data for accuracy, remediation of inaccurate Whois data including takedown where warranted, implementation of a domain protected marks list for trademark protection, new “claims plus” product for trademark protection, terms of use that prohibit illegal or abusive activity, limitations on domain proxy and privacy service, published policies and procedures that define abusive activity, and proper resourcing for all these measures. Paragraph 11, Nevett Declaration and Paragraph 18(a), New gTLD Application.

In addition to its USD 57 million investment in gTLD applications, Donuts has also invested additional sums, ranging in the millions of dollars, for technical and other support to operate name registries for its new gTLDs when and if they are issued to Donuts. Paragraph 15, Nevett Declaration. In that regard, Donuts has also engaged a number of companies that provide back-end technology, marketing, finance, legal and consulting services. *Id.* at paragraphs 9-13; and paragraph 18(a), New gTLD Application.

To accomplish all this, Donuts has raised more than USD 100 million from a number of capital sources, including venture capital and private equity funds, bank financing and from well-capitalized investors, and is capable of raising additional funds should the need arise. Paragraph 18(a), New gTLD Application.

5. Parties’ Contentions

A. Objector

Pursuant to Articles 2(e) and 8(a)(iii)(aa) of the Procedure, the Objector SNI asserts the present LRO as being generally predicated, pursuant to Article 8(a)(iii)(bb), on its belief that the applied-for <.food> gTLD infringes its existing legal rights that are recognized or enforceable under generally accepted international recognized principles of law. As set forth in the Objection, the rights are those resulting from its trademark registrations, both in the United States and in various foreign countries, for its FOOD Marks. Article 8(a)(iii)(bb) of the Procedure requires that the Objector explain why it believes its objection is valid and should be upheld. Pursuant to that paragraph, SNI asserts that the potential use of the Applicant’s applied-for <.food> gTLD:

- (a) takes unfair advantage of the distinctive character or the reputation of SNI’s marks; and/or
- (b) unjustifiably impairs the distinctive character or the reputation of those marks; and/or
- (c) otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and those marks.

The Objector further contends that the potential use of the Applicant’s applied-for <.food> gTLD harms Internet users by misleading them into believing that the <.food> gTLD is related to its famous brand FOOD as evidenced by the long-standing global use in commerce of its mark FOOD and registrations for the same or similar marks in many jurisdictions around the world.

Given these broad assertions, the basic grounds, in some specificity, that underlie SNI's objection to the applied-for gTLD are as follows:

1. The <.food> gTLD is similar and, in certain instances, identical in appearance, sound and meaning, to the SNI's FOOD Marks. SNI's acquisition and use of rights in these marks have been *bona fide* as evidenced by: (a) the long period during which the registrations have subsisted – over 10 years for some of the registrations, and (b) its use, for over 20 years, of the marks FOOD and FOOD NETWORK in conjunction with its global television programming. During this period and as a result of SNI's extensive use of its FOOD Marks, those marks have acquired substantial secondary meaning in the marketplace.

2. If the Applicant were to sell, as it purports to do, second-level domains to the general public on an unrestricted basis under the <.food> gTLD, that would erode consumer confidence in SNI's FOOD and FOOD-variant brands (e.g., the FOOD NETWORK brand) as authoritative sources of information, programming, content and advice, and would ultimately confuse and mislead consumers into believing that the content, information and/or products in the <.food> gTLD are provided by SNI – when they are not. Consequently, the goodwill associated with SNI's FOOD and FOOD-variant brands would be irreparably damaged. This result lies contrary to the legal protection provided to SNI under trademark law, both in the US and multiple foreign jurisdictions, which seeks to prevent consumer confusion and, as such, maintain goodwill associated with brands as source indicators.

3. Given SNI's worldwide registration and widespread use of its FOOD Marks for over 10 years, the Applicant knew or should have known of SNI's trademark rights in and to SNI's FOOD and FOOD-variant marks at the time the Applicant filed its application for the <.food> gTLD.

4. As evidenced through SNI's own gTLD application (through its subsidiary, Lifestyle Domain Holdings, LLC) for the <.food> gTLD, SNI intends to operate <.food> as a mechanism to extend its current online channel of distribution through the use of its FOOD brand as a TLD. This includes providing SNI's programming, content, information and connected experiences centered on cuisine, cooking and culinary arts. Only SNI can offer the consumer the experience and quality associated with SNI's FOOD and FOOD-variant brands. Allowing the Applicant to operate the <.food> gTLD would be contrary to: (a) ICANN's well-settled policy of protecting Internet users and consumers from infringers, and (b) the intention of the new gTLD program to ensure that those users are protected in the expanded Internet environment and also rightful brand owners, such as SNI, can reasonably protect their brands from misappropriation or unlawful use.

5. The Applicant has not made any demonstrable preparations to use the sign FOOD in connection with a *bona fide* offering of goods or services or a *bona fide* provision of information in a way that neither interferes with the legitimate exercise by SNI of its trademark rights nor undermines SNI's rights in its marks. While the Applicant intends to use the new gTLD "to increase competition and consumer choice at the top level", the manner through which it will do so will explicitly interfere with the existing rights of SNI. SNI's trademark rights are within the field of operating a web site, computer network, content and information. Therefore, use of <.food> by the Applicant as a gTLD would inherently infringe upon SNI's exact class of goods and services for which it has been granted trademark protection.

6. The Objector intends to function, per the ICANN-Registry Operator Registry Agreement, as a Specification 9 exempt system. In conjunction with doing so, SNI will carefully monitor and safeguard the user experience to provide users with confidence that they have found SNI's family of brands and the content, information and experiences associated with those brands, including the FOOD brand, that consumers throughout the world know and trust. SNI's operation of the <.food> gTLD will further benefit Internet users by creating additional opportunities to strengthen the consistency of delivery of SNI's FOOD brand. In doing so, SNI intends to create numerous subdomains under the <.food> gTLD that have not been available under the existing TLD namespace. Further, the <.food> gTLD creates the possibility that these to-be-created subdomains will be precisely targeted to Internet users who will use them, focused on content associated with the gTLD under which they will reside, and relevant to the gTLD (i.e., there will be an increased nexus between the gTLD and the content, information and experiences associated with SNI's

family of lifestyle brands). In other words, Internet users will benefit from the goodwill associated with FOOD brands on SNI's <.food> gTLD.

In contrast, the Applicant's intended use of the <.food> gTLD is to resell second-level domains in the open marketplace and become an authoritative online resource for content related to cuisine and the culinary arts. Such activity would not only irreparably damage SNI's FOOD brand, but also a significant likelihood exists that it would unlawfully trade upon the existing fame and goodwill of SNI FOOD Marks. In that regard, the Applicant has not articulated in its application for the gTLD how it will create a trusted environment for cuisine-related information, products and services. Should the Applicant operate <.food> as an open registry, then SNI's consumers will be confused and misled into believing that second-level domains on the <.food> gTLD are somehow related or connected to SNI's FOOD brand, when they are not; and that the content provided through those second-level domains emanates from, is somehow associated with or has the same quality level as that provided by SNI when it does not. This will devalue and dilute the integrity of SNI's FOOD brand which SNI has built over many years and the substantial investment SNI has made in that brand, thus causing irreparable harm to SNI.

B. Applicant

In its Response, the Applicant takes a markedly contrary view. Its principal arguments in support for denying the Objection are:

(a) The Objector failed to satisfy its burden of proof. Its mark FOOD has no distinctive character. Moreover, the Applicant's proposed use of the <.food> gTLD is consistent with the generic meaning of the word "food" and, as such, would not unjustifiably impair or take unfair advantage of the Objector's marks or their distinctive character or reputation. As such, no likelihood of confusion would arise between the Applicant's proposed use of the <.food> gTLD and SNI's FOOD Marks.

(b) There is no evidence of infringement.

(c) The applied-for <.food> gTLD promotes free speech, competition and consumer choice on the Internet. The present objection thwarts these goals. If the objection succeeds, it would prevent the Applicant from offering a generic dictionary term as a gTLD. This would create an improper Internet-wide monopoly over an English-language word.

Having set forth these broad arguments, the Applicant primarily asserts the following specific grounds:

1. The <.food> gTLD does not infringe upon any legitimate right of SNI; nor has the Applicant provided any evidence that it does. Moreover, the Applicant bears no ill intent towards SNI including any intent to infringe its marks; here too, SNI has not provided any evidence to the contrary.

The sign FOOD is a common dictionary word having multiple meanings which, if SNI successfully opposes, would prevent an entire segment of the Internet community from using the word consistent with its generic and non-trademark meanings, *i.e.*, as an adjective describing a characteristic of domain names or web sites that contain information on or goods/services concerning food. Neither ICANN nor any other regulatory body imposes prior restraints on freedom of expression to use an ordinary dictionary term simply because certain uses may implicate trademark rights. SNI cannot use this proceeding as a bludgeon to beat down legitimate uses of new gTLDs to preserve its limited, non-exclusive trademark rights. Rather, SNI must turn to other tools which ICANN has provided, such as the Uniform Domain Name Dispute Resolution Policy, to enforce its rights against abuse by third parties. It is well established in trademark law that one who claims a common, descriptive word as a trademark takes the risk that many others will use the same or a similar term to identify their companies, goods and/or services. Although one may own trademark rights in such a term, such rights will not prevent others from using the word in good faith in its descriptive sense, and not as a trademark.

2. SNI is not the only content provider descriptively using the word "food" to identify its business of providing cooking related content to the public. In that regard, "The Food Channel," is a registered trademark of Foodchannel.com, LLC. "The Food Channel," just like SNI's FOOD NETWORK provides information to

consumers, via the Internet, regarding cooking and cuisine. A hardcopy of the home page of the web site <foodchannel.com> appears in Annex C to the Response. While the “Food Channel” may not be as large or successful as SNI’s offering, two content providers with highly similar names have been and are now coexisting within the identical market. The same is true in print media, where, although SNI has its own *Food Network* magazine, other third-party food-related publications exist which offer the same or similar content as does SNI’s magazine and include the term “food” in their names, such as, e.g.: *the FOOD magazine* (a copy of the front cover of this publication appears in Annex D to the Response), *Food and Wine*, *Good Food*, *Food and Travel* and *Food and Home Entertaining*. Furthermore, in the absence of any direct evidence provided by SNI that establishes any consumer association between the term “food” and SNI’s content offerings and licensed products, the consuming public does not perceive SNI, contrary to its view, as a sole source of food-related content.

Hence, there is no reason whatsoever why the Applicant cannot utilize the sign FOOD as a gTLD without causing confusion among the public or harming SNI’s FOOD Marks.

3. SNI has not proven that the relevant sector of the public would recognize the sign FOOD as its claimed mark. For a gTLD, that sector encompasses everyone in the world with Internet access. SNI claims that “Internet users and consumers around the world regularly rely upon the goodwill and reputation associated with SNI’s FOOD brands in seeking out culinary content and advice.” Objection at Paragraph 6. Yet, SNI offers no support for this claim. While members of the public, either via television or the Internet, access SNI’s “FOOD NETWORK” content for informational purposes, SNI has not provided any proof whatsoever that consumers exclusively or even regularly associate the use of the generic term “food” with SNI, or, more generally speaking, with cuisine shows on television.

As such, SNI does not and cannot demonstrate that Internet users sufficiently associate the generic word “food” with SNI such that SNI’s claimed trademark rights in that word can prevent the Applicant from using it as a gTLD.

Trademark rights do not prevent the non-trademark use of a dictionary term in or with a top-level domain. See, e.g., *Image Online Design v. ICANN*, 2013 U.S. Dist. LEXIS 16896, 22-24 (C.D. Cal. 2013) (finding no protectable interest in the proposed top-level domain name <.web>); see also *Advertise.com v. AOL Advertising*, 616 F.3d 974, 978-979 (9th Cir. 2010) (AOL’s “advertising” usage insufficient to prevent use of advertising.com as each identifies a type of service and not the supplier of it, or merely a “genus” of which the particular service of each is a “species”); *Hasbro v. Clue Computing*, 66 F. Supp. 2d 117, 133 (D. Mass. 1999), affirmed, 232 F.3d 1 (1st Cir. 2000) (summary judgment entered in favor of defendant registrant of <clue.com> site against rights holder in “Clue” board game; trademark law does not support monopoly over domain name uses, such that “[i]f another Internet user has an innocent and legitimate reason for using the ... mark as a domain name and is the first to register it, that user should be able to use” the name).

4. To mitigate possible rights abuse and, concomitantly, provide a more secure environment than currently exists, the Applicant will provide additional levels of trademark rights protection as part of its <.food> gTLD registry, such as through a “Domain Protected Marks List” and a “Claims Plus” service, beyond even the enhanced levels required by ICANN for use with any of the new gTLDs (such as the Uniform Rapid Suspension system, the Post Delegation Dispute Resolution Procedure and the Trademark Clearinghouse). Paragraphs 9-13, Nevett Declaration.

5. SNI has not provided any actual evidence establishing the alleged popularity of its marks as the Hickok declaration is uncorroborated, conclusory and self-serving. Further, since neither SNI nor Ms. Hickok identifies the specific source for their data and does not attach the reports from which that data is derived, all statistical references which either provides are of dubious evidentiary value and should be discounted accordingly.

6. The Applicant has invested considerable sums in applying for and provisioning 307 gTLD strings including planning and preparing to use the string “food” and each of its other applied-for strings in a manner that

protects the rights of others. Paragraph 7, Nevitt Declaration. The Applicant will have terms and conditions that prohibit unlawful conduct, as well as implement additional trademark protection mechanisms and abuse mitigation measures beyond those currently required by ICANN. Further, the Applicant reserves the right to delete second-level domains used in an illicit manner. *Id.* at paragraphs 9-13. Thus, SNI has failed to prove that the Applicant will operate the <.food> gTLD in other than in a *bona fide* manner.

C. Objector's Reply

In its Reply, SNI raises several principal arguments as follows, some of which appear to amplify arguments it has previously made:

1. The applied-for gTLD is identical, in all respects, in appearance, sound and meaning to SNI's FOOD Marks and sufficiently similar to those marks where the term "food" is a dominant component, e.g., the marks FOOD NETWORK and FOOD.COM. In the latter marks, the term is not used in a generic manner.
2. SNI reiterates its position that if the Applicant is permitted to use its applied-for gTLD, then consumer confusion and infringement will certainly occur with irreparable dilution and damage to the integrity and value of SNI's FOOD brand.

SNI owns trademark rights in the mark FOOD specifically for use in conjunction with providing information via "a global computer information network in the fields of cooking and culinary arts, health, fitness and nutrition". Unlike brand protection for apparel or other consumer goods, SNI's trademark rights are directly related to the use of the applied-for gTLD. Here, SNI's FOOD brand has been built around and is inherently tied to digital online media content related to "food", the very item from which the Applicant is attempting to profit through use of its applied-for gTLD. There are not many common usages of the term "food" which lie outside the scope of cooking, culinary arts, health, fitness and nutrition. SNI's brand is built around these concepts as it relates to digital media content. The Applicant's applied-for gTLD is an attempt to capitalize on the same type of food-based digital media content by selling domains which would be confusingly similar to SNI's brand. There is not a wide range of second-level domains available in the <.food> gTLD which would not directly infringe upon SNI's trademark rights. As such, the use of "food" as the primary source indicator for online digital content, as would result from the Applicant's use of the term, would infringe on SNI's FOOD Marks.

3. The Applicant should have been reasonably aware of SNI's FOOD Marks at the time it applied for the gTLD and that those marks were not generic.

D. Applicant's Sur-reply

In its Sur-reply, the Applicant responded to the Reply by raising the following primary arguments:

1. In a companion LRO administrative proceeding involving the same <.food> gTLD, *Scripps Networks Interactive, Inc. v. Dot Food, LLC*, WIPO Case No. LRO2013-0020, the panel rejected SNI's objection, despite specific arguments which SNI made there and now makes here in support of its new gTLD application:

- (a) its federal registration of its FOOD Marks;
- (b) perceived similarities in sight, sound and meaning between the sign FOOD and the FOOD Marks and the goods and services marketed thereunder;
- (c) the Hickok Declaration; and
- (d) infringement is highly likely to occur, including by second-level <.food> domain names made through the Applicant's registry.

The fundamental reason underlying the panel's rejection in the above case was its view that the term "food" was used in the applied-for gTLD in accordance with its generic sense, *i.e.*, common dictionary meaning. That usage cannot by itself cause any likelihood of confusion with any of SNI's marks. Precluding the

applicant from using the term “food” as its gTLD would effectively prevent third-parties from using the term in many common usages in which they are entitled to do so. Thus, the panel concluded that it would be unreasonable to foreclose its use by the applicant as a gTLD.

2. No matter how similar the applied-for gTLD is to the Applicant’s registered FOOD Marks, neither the similarity nor any allegation of infringement can overcome the generic use of the term in the applied-for gTLD which will not interfere with the legitimate exercise by SNI of its trademark rights in its FOOD Marks.

3. The Applicant will implement a number of additional protective measures, over and above those required by ICANN, to prevent trademark infringement.

6. Discussion and Findings

A. Procedural Framework

ICANN has created a framework for establishing a set of new domain name registries identified as the so-called “new gTLDs”. Similar to the conventional gTLDs (*e.g.*, “.com”, “.org”, and “.net”), the new gTLDs will be comprised of textual strings, many of which will likely constitute words in a given language.

ICANN GNSO (Generic Names Supporting Organization) Recommendation 3 states that “[s]trings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law.”

To interpret and give meaning to this recommendation, ICANN instituted a process through which trademark rights holders may lodge an objection, specifically one predicated on that holder’s legal rights, to an applicant’s adoption of an applied-for new gTLD. Section 3.2.1 of the gTLD Applicant Guidebook, Module 3 (June 4, 2012) (“Applicant Guidebook”).

In order for a panel to consider a LRO, a rights holder must establish, under Section 3.2.2 of the Applicant Guidebook, that, as a threshold requirement, it has standing to object. Specifically, under Section 3.2.2.2 of the Applicant Guidebook, the objector must delineate the basis, through source and documentation, of its existing legal rights which the holder believes would be infringed by an applied-for gTLD. The source of these rights may include registered or unregistered trademarks.

Once the objector alleges standing, then, pursuant to Section 3.5.2 of the Applicant Guidebook, the objector has a burden of showing that the potential use of the applied-for gTLD by the applicant:

- (1) takes unfair advantage of the distinctive character or the reputation of the objector’s registered or unregistered trademark or service mark, or
- (2) unjustifiably impairs the distinctive character or the reputation of the objector’s mark, or
- (3) otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector’s mark.

Where an objection is based on trademark rights, this paragraph enumerates eight non-exclusive factors which the panel will then consider in determining whether the objector has satisfied its burden or not:

- (1) Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound, or meaning, to the objector’s existing mark.
- (2) Whether the objector’s acquisition and use of rights in the mark 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, the applicant or a third party.
- (4) The applicant’s intent in applying for the gTLD, including whether the applicant, 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 applicant 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.

(5) Whether and to what extent the applicant 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.

(6) Whether the applicant 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 applicant is consistent with such acquisition or use.

(7) Whether and to what extent the applicant 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 applicant is consistent therewith and *bona fide*.

(8) Whether the applicant'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.

B. Analysis

1. Standing under Section 3.2.2.2

As noted above, under Section 3.2.2.2 of the Applicant Guidebook, the Objector SNI must first delineate the basis, through source and documentation, of its existing legal rights which it believes would be infringed by the applied-for <.food> gTLD.

SNI has done so by basing its rights on its portfolio of registered FOOD Marks which it has specified in Annex 2 to its objection and of which, in Annex 3, it has provided copies of some of its registration certificates. The details of a representative sample of its United States registrations have been delineated in section 4(A) above. The Objector claims these marks would be infringed by the applied-for <.food> gTLD.

As such, there can be no question that SNI has established requisite standing for its objection, and thus has satisfied its burden under Section 3.2.2.2.

2. Multi-factor assessment under Section 3.5.2

With standing established, the focus shifts to Section 3.5.2 of the Applicant Guidebook under which the Panel determines whether SNI has sufficiently shown that the Applicant's intended use of the applied-for <.food> gTLD would:

- (1) take unfair advantage of the distinctive character or the reputation of the SNI's FOOD Marks; or
- (2) unjustifiably impair the distinctive character or the reputation of any of those marks; or
- (3) otherwise create an impermissible likelihood of confusion between the applied-for gTLD and any of the FOOD Marks.

As stated by the panelist in *Right At Home v. Johnson Shareholdings, Inc.*, WIPO Case No. LRO2013-0030 (see also *Pinterest, Inc. v. Amazon EU S.à.r.l.*, WIPO Case No. LRO2013-0050):

"The use of the terms 'unfair,' 'unjustifiably,' and 'impermissible' as modifiers, respectively, of 'advantage,' 'impairs,' and 'likelihood of confusion' in Section 3.5.2 suggests that there must be something more than mere advantage gained, or mere impairment, or mere likelihood of confusion for an Objection to succeed under the Procedure. It seems, rather, that there must be something untoward – even if not to the level of bad faith – in the conduct or motives of Respondent, or something intolerable in the state of affairs which would obtain if the Respondent were permitted to keep the String in dispute."

The Panel concludes that the potential use of the applied-for gTLD by the Applicant would not take unfair advantage or unjustifiably impair the distinctive character or the reputation of SNI's FOOD Marks, or otherwise create an impermissible likelihood of confusion with any of those marks.

In reaching its conclusions, the Panel has carefully considered, in light of the specific facts at issue and the relevant substantive legal principles, the eight non-exclusive factors set forth in Section 3.5.2 of the Applicant Guidebook and now provides its corresponding reasons as follows.

i. Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound, or meaning, to the objector's existing mark.

SNI's FOOD Marks encompass registered marks that have either the term "food" standing alone or as a formative in conjunction with one or more terms, such as, e.g., NETWORK or .COM. Assessing this factor requires a simple comparison between the applied-for gTLD and SNI's marks, regardless of the public perceptions of these marks and whether use of that gTLD would cause any likelihood of confusion to arise (which are respectively addressed in factors (iii) and (viii) below).

Accordingly, it is obvious to the Panel, from a simple visual comparison, that the applied-for <.food> gTLD is identical to a number of those marks and quite similar to many of the rest. This factor appears to serve as an outcome-determinative threshold test. If SNI were unable to prove that identity or sufficient similarity exists, i.e. the test fails, then its objection will in all likelihood be rejected on that ground already.

ii. Whether the objector's acquisition and use of rights in the mark has been bona fide.

SNI's FOOD Marks have been in existence for more than 10 years and remain in use, in conjunction with SNI's branded goods and services enumerated in the corresponding registrations. Presently, SNI spends approximately USD 30 million per year marketing its goods and broadcast services under its FOOD Marks.

There is no evidence of record whatsoever that SNI has acquired or used any of its registered marks in other than a *bona fide* manner – nor has the Applicant even implicitly raised this issue.

Just as with the immediately preceding factor, the Panel views the present factor as simply another outcome-determinative threshold test. If the Applicant were to successfully prove that SNI acquired or used its marks in bad faith, then its objection would in all likelihood be denied on that ground already.

iii. 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 applicant or of a third party.

SNI strenuously argues, based on its rather comprehensive use of its marks FOOD and FOOD NETWORK for many years in conjunction with its television broadcasting and entertainment services directed to aspects of cuisine, cooking and culinary arts, that those terms have developed sufficient secondary meaning in the minds of the relevant viewers as to be source-indicative of the particular services and products with which those terms are used by SNI.

The Applicant does not dispute that such secondary meaning may have been established in the relevant viewers for the mark FOOD NETWORK – namely those who seek out food-related content from SNI (or its licensees) whether through television, the Internet or other mass media. However, there is sharp disagreement amongst the parties, based on the meaning and public use of the term "food" alone, whether any such secondary meaning carries over just to that term and, if it exists, just how extensive it is.

SNI contends that the term "food" has acquired secondary meaning in the food industry, as source-indicative of its goods and services, sufficient to differentiate that term from its generic meaning and thus support SNI's contention of potential infringement by the applied-for gTLD should it come into use.

No independent, corroborating evidence has been presented by SNI sufficient to persuade this Panel that SNI has developed secondary meaning in just the term "food" such that more than, at most, a *de minimis* amount of the viewing public likely associates that term with SNI (or its licensees) not merely in the context of being a source of entertainment and broadcast television shows related to the cuisine, cooking and the culinary arts – as its registrations indicate for its services – but rather in the much broader context of being

source of goods and services in the entire food industry. Overwhelming usage of that word by Internet users who seek information regarding some aspect of that industry is consistent with the commonly understood, *i.e.* generic, meaning of the word. Words that are so used are simply incapable of ever possessing any distinctiveness and hence trademark significance. Should, over time, the public usage of that term and hence its generally perceived meaning change, then such significance may arise at some point. There is no showing of record that any such change has happened here or is in process of happening among any relevant Internet user community.

Further, as the Applicant has not yet used the term “food” at all, but will apparently only do so in its generic sense as a gTLD for a registry of food-related second-level domains, the Applicant has yet to develop any trademark significance in that term and, once it starts using the term as it intends, is highly unlikely in the Panel’s opinion to ever develop any such significance.

As such and based on the evidence of record, the Panel concludes that the sign FOOD has no significance as a mark in the relevant sector of the viewing public as a mark of SNI, the Applicant or even a third party.

This factor favors neither party here.

iv. The applicant’s intent in applying for the gTLD, including whether the applicant, 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 applicant 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.

As set forth in the New gTLD Application, Donuts, the Applicant’s parent company, intends to provide a large-scale TLD registry composed of a separate registrar for each new TLD, of the 307 for which it has applied, that it eventually obtains and places into operation. By doing so, Donuts intends to make available second-level domain-gTLD name pairs for registration and use that otherwise would not be economically viable and obtainable in the namespace, thus, in its view, expanding competition and, particularly for those who seek a specific Internet identity, consumer choice and expression. See paragraphs 18(a) and 23 (first paragraph of answer text), New gTLD Application. Donuts stated that, for each applied-for gTLD, it intentionally selected a common dictionary word as the gTLD string, that would be used in accordance with its well-understood dictionary meaning. Paragraph 7, Nevett Declaration. <.food> is one of them.

The Applicant, consistent with its Response, manifested what appears to be a good-faith belief, at the time it applied for the <.food> gTLD, that inasmuch as it will use this gTLD in accordance with the string’s well-understood dictionary meaning, no infringement of any mark would result – whether any of SNI’s FOOD Marks or those of any other party.

The Panel interprets the phrase “pattern of conduct” in the context of this factor to require that an applicant, in applying for or using multiple TLDs, intentionally selected or additionally used those strings as TLDs which are each identical or confusingly similar to another’s mark(s) so as to repeatedly intend to cause or have caused a likelihood of confusion in the minds of Internet users between each successive TLD and a corresponding mark(s) and, there through, thus provide an opportunity for that applicant to exploit the confusion for its own benefit. Here, the Panel finds the Applicant most likely not only had no such intention but also acted in a manner entirely inconsistent with one which would.

This factor favors the Applicant.

v. Whether and to what extent the applicant 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 Applicant has made a considerable investment in preparing to use the <.food> gTLD in connection with a *bona fide* offering of goods or services but equally importantly in a manner which it professes will respect the trademark rights of the Objector SNI and not interfere with its legitimate exercise of those rights.

As discussed above, the Applicant's parent company, Donuts, has expended approximately USD 57 million in filing fees alone to acquire 307 gTLDs – far more than any other applicant has done thus far – to form a massive TLD registry. In addition to that investment, Donuts has indicated it has also invested considerable sums to obtain ancillary support, including technical, legal and other necessary third-party services, to properly operate its registry for all its new gTLDs when and if they are issued to Donuts. Paragraph 15, Nevett Declaration.

As part of that investment, Donuts reports it is instituting additional mechanisms beyond those required by ICANN to operate any new gTLD to protect third-party rights holders, including SNI, against potential abuse and misconduct that may arise during customer name registration. These additional mechanisms include: periodic audit of Whois data for accuracy, remediation of inaccurate Whois data including takedown where warranted, implementation of a domain protected marks list for trademark protection, new “claims plus” product for trademark protection, terms of use that prohibit illegal or abusive activity, limitations on domain proxy and privacy service, published policies and procedures that define abusive activity, and proper resourcing for all these measures. Paragraph 11, Nevitt Declaration and Paragraph 18(a), New gTLD Application.

To fund this entire effort, Donuts has raised more than USD 100 million in funding. The Panel recognizes the significance of this cumulative investment and the extent of the efforts already undertaken and currently underway by the Applicant in implementing its registry. There is no question in the Panel's mind, nor has SNI raised any, as to the legitimacy of the preparations underway by the Applicant.

SNI's concerns are principally directed to whether third-party registrations of second-level domains for the food industry under the Applicant's applied-for <.food> gTLD will interfere with SNI's legitimate exercise of its trademark rights. As discussed in detail below with respect to the last factor, the Panel finds that the Applicant's proposed use of the gTLD in serving the entire food industry will not in and of itself interfere with SNI's legitimate exercise of its trademark rights in its FOOD Marks in conjunction with those segments of that industry, as set forth in its registrations, in which SNI uses its marks. To the extent SNI's rights are compromised by any third-party user registration of a second-level domain under the Applicant's <.food> name registry and insufficient protection is accorded through the Applicant's rights' protection mechanisms (both those required by ICANN and those additional mechanisms put in place by the Applicant), SNI can utilize an appropriate post-registration dispute resolution mechanism to seek suitable redress against that user. The Panel finds that such potential for abuse in this case has not been demonstrated to have reached an “impermissible” level, which would have more strongly warranted a finding in favor of the Objector.

This factor also favors the Applicant.

vi. Whether the applicant 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 applicant is consistent with such acquisition or use.

There is no evidence in the record and the Applicant has made no corresponding claims that it has any marks or other intellectual property rights in the sign FOOD.

Taken as such, this factor slightly favors the Objector.

vii. Whether and to what extent the applicant 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 applicant is consistent therewith and bona fide.

There is no evidence of record that the Applicant has ever been commonly known by the term “food” and, given the common understood meaning of this term, the Panel has every belief that the Applicant is not so known.

Taken as such, this factor also slightly favors the Objector.

viii. Whether the applicant’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.

Federal trademark law in the United States recognizes the public’s unfettered right to use a word in accordance with whatever commonly understood meaning it then has. Descriptive or generic words, when used as such, are simply incapable of acquiring any distinctiveness and functioning as trademarks.

The word “food” is an extremely widely-used generic term – which the Applicant cannot and does not dispute. Its meaning is consistent and well-understood, as reflected in the following illustrative dictionary definitions:

“nutriment in solid form;
something that nourishes, sustains, or supplies;
material consisting essentially of protein, carbohydrate, and fat used in the body of an organism to sustain growth, repair, and vital processes and to furnish energy; *also*: such material together with supplementary substances (as minerals, vitamins, and condiments);”
Merriam-Webster Online Dictionary (accessible at <merriam-webster.com>);

“a nourishing substance that is eaten, drunk, or otherwise taken into the body to sustain life, provide energy, promote growth, etc.;

more or less solid nourishment, as distinguished from liquids;

a particular kind of solid nourishment: a breakfast food, dog food;

anything serving for consumption or use”
Dictionary.com (accessible at <dictionary.com>); and

“[m]aterial, usually of plant or animal origin, that contains or consists of essential body nutrients, such as carbohydrates, fats, proteins, vitamins, or minerals, and is ingested and assimilated by an organism to produce energy, stimulate growth and maintain life.
A special kind of nourishment: breakfast food, plant food.
Nourishment eaten in solid form: food and drink.
Something that nourishes or sustains in a way suggestive of physical nourishment.”
The Free Dictionary (accessible at <thefreedictionary.com>).

SNI uses the word “food” in its FOOD Marks both as a single-term mark and as a term in a composite mark, such as FOOD NETWORK. However, this word is used in those marks in connection with, generally speaking, a service of providing food-related content over network and other broadcast media, and various products including printed publications containing the same content and various goods, such as specific cooking utensils, accessories and related goods used in connection with the culinary field.

As the word “food” is a generic descriptor of some of the content itself which SNI provides, SNI is unable to claim any trademark rights in the use of that word to describe the subject matter of that content or, more generally, in connection with any aspect of the food industry that falls within the generic ambit of the word.

A long and well-established principle of federal trademark law is that “a generic name is free for use by anyone when applied to the products it signifies ... and can be used in its generic sense notwithstanding its

registration for other products” and that “genericness is a defense to a trademark infringement action.” *Gilson on Trademarks* § 2.02[1] (Matthew Bender 2012). In light of this, one who adopts and uses a generic term as a mark or as part of a composite mark bears the risk inherent in that attribute: (a) that others will use the same or similar term in its generic sense to identify their respective companies, goods and/or services, and also (b) any confusion that might arise out of such use. Although one may own trademark rights in such a term (such as through so-called arbitrary usage, *i.e.* use of a generic or descriptive term in a totally different sense), “such rights will not prevent others from using the word ... in good faith in its descriptive sense, and not as a trademark.” See, *e.g.*, *Car-Freshener Corporation v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 269 (2d Cir. 1995). Very little weight is given in the analysis of confusing similarity to generic terms used in their generic sense. See, *e.g.*, *Banff, Ltd. v. Federated Dep’t Stores, Inc.*, 841 F.2d 486, 491 (2d Cir. 1988) (“The long-standing view that the *nongeneric components* of a mark must be compared in the context of the overall composite mark... remains the rule in this Circuit.”) (emphasis added); *American Cyanamid Corp. v. Connaught Laboratories, Inc.*, 800 F.2d 306, 308 (2d Cir. 1986) (“[A] trademark infringement finding thus cannot be based on the use of a generic or descriptive term.”).

As discussed previously, the Applicant intends to use its string in accordance with its commonly understood dictionary meaning, *i.e.* in its generic sense, as a gTLD to provide second-level domain - <.food> name pair availability throughout the entire food industry. Substantial segments of that industry exist – far more so than just the relatively small markets served by SNI and for which its marks are registered – for which use of the term FOOD in that manner would simply be as a generic modifier or descriptive attribute.

The Panel can easily think of illustrative name pairs where the FOOD portion of the gTLD is generic, *e.g.*, <vegetable.food>, <fish.food>, <cereal.food>, and <restaurant.food>, which would likely neither interfere with nor implicate any of the Objector’s FOOD Marks. Undoubtedly, huge numbers of other such name pairs could similarly be formed. None of these would create a likelihood of confusion with any of SNI’s FOOD Marks, as to the source, sponsorship, affiliation, or endorsement, of the gTLD.

SNI emphatically asserts that the Applicant’s proposed activity would “irreparably damage the famous FOOD brand, there is a significant likelihood that such activity would unlawfully trade upon the fame and goodwill of Objector’s marks. ... Should Respondent operate .FOOD as an open system, consumers will be confused and misled into believing that second string domains on the top level domain .FOOD are somehow related or connected to the famous FOOD brand. They will be damaged when they trust content that is not of the same quality that Objector offers.” (Objection at paragraph 8). SNI has not provided any independent, let alone persuasive, support of the accuracy and certainty of its predictions. As such, these predictions are just speculative. Further, SNI in having chosen the generic word “food” as its mark and a component of its composite marks must tolerate the risk of confusion emanating from third-party generic usage of this word and whatever ensuing damage that use will occasion to its marks and goodwill.

SNI further asserted that “... there are no meaningful registration restrictions in Respondent’s application, Respondent has not articulated how it will achieve the creation of a trusted environment for cuisine-related information, products and services” (Objection at paragraph 8). The Panel notes that the Applicant appears to be implementing such restrictions by incorporating additional rights protection mechanisms, beyond those required by ICANN for use with a new gTLD, to remediate possible registration abuse.

Generic use cannot create any likelihood of confusion as to source, sponsorship, affiliation or endorsement as words used consistent with their generic meanings are incapable of acquiring any distinctiveness for trademark purposes. As such, the Applicant is well within its rights to so use <.food> as its gTLD in the manner for which it has applied to do so.

Consistent with federal trademark law, previous LRO decisions have held that the use of a common English word generically or descriptively weighs against – or entirely precludes – a finding of a likelihood of confusion. See, *e.g.*, *I-REGISTRY Ltd v. Vipospace Enterprises LLC*, WIPO Case No. LRO2013-0014 (“Respondent’s intended use of the gTLD will lead to the gTLD being seen first and foremost as a descriptive term describing the purpose and characteristics of the domain... The Panel does not believe that confusion with the Objector’s mark is likely.”); *Defender Security Company v. Charleston Road Registry Inc.*,

WIPO Case No. LRO2013-0032 (“Respondent’s intended use of the new gTLD <.home> would not create a likelihood of confusion...since Respondent intends to use the sign corresponding to the New gTLD in its generic sense.”); *United States Postal Service v. Charleston Road Registry Inc.*, WIPO Case No. LRO2013-0045 (“ ... Objector has not shown a likelihood of confusion between the intended use of the <.mail> string and Objector’s marks. As discussed above, Objector does not have trademark rights in the word ‘mail,’ which retains generic meaning as a term relating to any postal system and any system of email”); *DotMusic Limited v. Charleston Road Registry Inc.*, WIPO Case No. LRO2013-0058 (One objective of the Objector has been to obtain precisely the type of competitive advantage (in this case in the application process for the <.music> gTLD string) that the doctrine of generic names is designed to prevent. However, as the Applicant proposes to use the <.music> gTLD string in a generic sense it is immune from this challenge.); *DotTunes Limited v. Amazon EU S.a.r.l.*, WIPO Case No. LRO2013-0065 (“Given the generic nature of the sign and the limited use of the Objector’s mark, the Panel finds that there is little or no likelihood of confusion.”); and, of particular note as the companion case to this one for the <.food> gTLD, *Scripps Networks Interactive, Inc. v. Dot Food, LLC*, WIPO Case No. LRO2013-0020 (“Such intended use of the word would appear to be only for its dictionary meaning and not because of Objector’s trademark rights. In other words, use of the word ‘food’ as a gTLD in connection with food is a generic usage of the term that cannot, by itself, create a likelihood of confusion.”).

This factor strongly favors the Applicant.

The Procedure does not instruct a panel to weight each factor in any particular fashion; rather, the Procedure only requires that the panel consider and evaluate these factors in whatever manner it deems most appropriate under the specific facts at issue. Consequently, under those facts here, the Panel views this last factor, of all six non-threshold factors, as the most critical and decisive of all these factors, and hence one that is outcome-determinative in this case. In that regard and given the total lack of any evident intention of the Applicant to create a likelihood of confusion emanating from a word, “food”, that will be used in its generic sense across an entire industry, this Panel considers it basically impossible to find that use of that word as a gTLD by the Applicant would take unfair advantage of any of SNI’s marks, unjustifiably impair the distinctive character or reputation of any of those marks or, obviously, create an impermissible likelihood of confusion with any of those marks.

Hence, the Objector has failed to meet its burden under the Procedure.

7. Decision

Pursuant to Article 21(d) of the Procedure and for the foregoing reasons, the Objection is rejected.

[signed]

Peter L. Michaelson

Sole Panel Expert

Date: September 11, 2013