

## **EXPERT DETERMINATION LEGAL RIGHTS OBJECTION**

Defender Security Company v. DotHome Inc.

Case No. LRO2013-0034

### **1. The Parties**

- 1.1 The Objector/Complainant (“Objector”) is Defender Security Company of Indianapolis, Indiana, United States of America, represented by Maginot, Moore & Beck, United States.
- 1.2 The Applicant/Respondent (“Applicant”) is DotHome Inc. of Ras Al Khaimah, United Arab Emirates represented by Traverse Legal, PLC, United States.

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

- 2.1 The applied-for gTLD string is <.home> (the “Disputed gTLD”).

### **3. Procedural History**

- 3.1 The Legal Rights Objection (“LRO”) was filed by with the WIPO Arbitration and Mediation Center (the “WIPO Center”) in respect of the Disputed gTLD on March 13, 2013 pursuant to the New gTLD Dispute Resolution Procedure (the “Procedure”).
- 3.2 In accordance with Article 9 of the Procedure, the WIPO Center completed the review of the Objection on 26 March 2013 and 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”).
- 3.3 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 17, 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 17, 2013.
- 3.4 The WIPO Center appointed Matthew Harris as an Expert to form a single-member Panel in this matter on June 7, 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.

- 3.5 Having initially reviewed the papers, the Panel pursuant to subsection 3.4.5 of the Guidebook and Article 17 of the Procedure issued an Order directing the Objector to file a further written statement and giving the Applicant an opportunity to respond to any further written statement of the Objector. The text of that Procedural Order is set out at Annex A to this expert determination.
- 3.6 On July 1, 2013, the Objector filed a further statement pursuant to the Order and on July 10, 2013 the Applicant filed a further statement pursuant to the Order.

#### 4. Factual Background

- 4.1 The Objector is a company that was incorporated under the laws of Indiana in 1998. It is primarily engaged in the marketing, sale and installation of security systems.
- 4.2 The exact size of the Objector's business is not clear, but it claims to be the second largest provider of residential security systems in the United States, serving customers from more than 140 locations nationwide and receiving "several million inbound customer calls to its three call centers each year".
- 4.3 The Objector is the owner of United States Trademark registration no 3,404,246 for the mark TRUE HOME filed on December 21, 2006, published for opposition on January 15, 2008 and with a registration date of April 1, 2008. The trade mark is registered in class 42 in respect of the following:

"Environmental testing and inspection consulting services, namely, evaluation of heating, ventilation, air conditioning energy requirements and energy efficiency ratings of new and existing structures; designs for others in the field of ducting and heating ventilation and air conditioning equipment"

This trade mark was originally registered in the name of Carl Simpson but was transferred to the Objector in or about August 2012

- 4.4 The Objector is also the owner of two of what it describes as "allowed" United States Trademark Applications with serial numbers 85588370 and 85588382. Each was filed on April 3, 2012 and published for opposition on November 20, 2012. Each also sought registration in class 35 in respect of the following:

"Advertising, promotion and marketing services of the goods and services of others in the field of residential and commercial security systems and alarms; Negotiation and conclusion of commercial transactions in the field of residential and commercial security systems and alarms for third parties via telecommunications systems"

- 4.5 Application number 85588370 proceeded to registration on March 26, 2013 with registration no 4,310,530 and takes the following form:



- 4.6 Application number 85588382 has not yet proceeded to registration and takes the following form:



4.7 Each of these two applications is subject to the following disclaimer:

“NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE ‘HOME’ APART FROM THE MARK AS SHOWN”

4.8 The Objector is also the owner of two United States Trademark Applications with serial numbers 85721544 and 85721554 for TRUE HOME and TRUE.HOME. Each was filed on September 5, 2012 and published for opposition on February 26, 2013. Each also sought registration in class 35 and 37 as follows:

*Class 35*

*Advertising, promotion and marketing services for the goods and services of others in the field of residential and commercial security systems and alarms and in the field of satellite television products and services.*

*Class 37*

*Installation, repair and maintenance of plumbing, heating, air conditioning, geothermal, electrical, and security systems.*

4.9 Application 8571544 is subject to the disclaimer:

“NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE ‘HOME’ APART FROM THE MARK AS SHOWN”

There is no disclaimer in relation to application 85721554

4.10 The Objector also relies upon European Community Trade mark no 010535201 (the “Community Trade Mark”). The Community Trade Mark was filed in the name of Constantinos Roussos Limassol, Cyprus on December 30, 2011 and published on March 15, 2012. This is a figurative mark that takes the following form:



The trade mark is registered in classes 35, 42 and 45. The class 42 specification comprises the following:

“Domain name reservation, registration, maintenance and management services; domain name searching services; domain name registry services, namely co-ordinating the assignment of domain names and address space; legal research relating to Internet domain names”

4.11 The Community Trade Mark is one of a large number of similar community trade marks applied for by Mr. Roussos on or about the same time, all of which comprise cartoon style drawings into which stylised text corresponding to a possible TLD have been incorporated. They include:

.COOL	Trade mark No: 010647576
.HOT	Trade mark No: 010635902
.LOVE	Trade mark No: 010635878

.DOCTOR	Trade mark No: 010627545
.BLOG	Trade mark No: 010627511
.APP	Trade mark No: 010627503
.LAWYER	Trade mark No: 010576676
.ATTORNEY	Trade mark No: 010544385
.ARTIST	Trade mark No: 010544377
.VIDEO	Trade mark No: 010535441
.MOVIE	Trade mark No: 010535417
.STORE	Trade mark No: 010535383
.PROPERTY	Trade mark No: 010535342
.ONLINE	Trade mark No: 010535318
.MUS	Trade mark No: 010535301
.LAW	Trade mark No: 010535227
.FILM	Trade mark No: 010535169
.FASHION	Trade mark No: 010535111

- 4.12 In April 2012 Mr. Roussos assigned his interest in the Community Trade Mark to Dothome Limited. Dothome Limited is a company incorporated in Cyprus with registration no HE 303807.
- 4.13 The Community Trade Mark proceeded to registration on June 22, 2012. It would appear that on May 15, 2013, someone commenced cancellation proceedings at OHIM in relation to the Community Trade Mark.
- 4.14 The Applicant provides an address in the United Arab Emirates but according to paragraph 8(b) of the public portion of its gTLD application, it is a company incorporated in the Republic of Seychelles under the International Business Companies Act, 1994.
- 4.15 At paragraph 18(a) of that same application the Applicant describes its mission as follows:

“The mission of the .Home TLD is to serve as a home on the Internet for users across the world. .Home aims to be a generic TLD with no preconception of meaning whatsoever, no theme, no categorizations, no restrictions of use. .Home does not restrict its scope to businesses (.Biz), commercial websites (.Com), or organizations (.Org). Unlike country TLDs (ccTLDs), it is not associated with any country or region, .Home is a truly global TLD.

What you can do on .Home can be limited only by your imagination, which is in fact, infinite. .Home is your Home on the Internet, where you can be free, comfortable; express what you want to say, what you think. Or share interests, knowledge, or simply post information about your business, and interact with clients. .Home says nothing; it is a blank canvas for the users to paint on.

For users of the Internet, .Home brings many possibilities. Since you don't have a preconceived notion of what to expect, you can come across websites ranging from those of hobbyists, to entrepreneurs, to artists, kids, photographers, mums, geeks, what not.

Too often today, when a potential registrant goes to a registrar's site to get a new domain name, the domain name is unavailable and the registrant is presented with a long list of permutation options that are not their preferred choice – either for the name or the TLD. Our research shows that today, close to 70% of all .com 'check-availability' lookups result in names not being available (Internal Research data). The registrant is left with no choice but to register substandard names that do not exactly denote what visitors should expect to find on the website. With .Home registrants can be sure of finding a name that they like on a fresh, new namespace that is global and unrestricted.

The .Home Registry will aim to serve as an open and available-to-all namespace, which we positively believe, will invite innovation and fresh possibilities at a global level. ...”

- 4.16 Dothome Ltd has also applied for the Disputed gTLD in its own right. The mission statement to be found at paragraph 18(a) of its application reads as follows:

“To establish an online extension that is immediately identifiable, secure, and exclusive for entities and individuals showcasing their online identity under a TLD that directly communicates residential home and home services-related content; and managing the domain name in a manner fitting the high integrity and home services policy requirements in .HOME.

Under this mission .HOME will be operated as a critical public resource in an open, responsible, stable and secure manner with the highest level of technical security resources and mechanisms that are aligned with technical advancement and innovation. DotHome Ltd. will support homeowners with an active everyday life who turn to DotHome Ltd. as their go-to provider of home services and products. The .HOME TLD will enable consumers to access home-related quality products, services and information.

DotHome Ltd. will engage in activities, other than registry services as described in response to question #23, that will benefit the home and home services related industries, such as launching a dedicated Premium Channel under .HOME TLD that includes:

- The parent company of DotHome Ltd, (Defender Security) has a significant brand presence and operations in home products and services. .HOME is being established to serve as a flagship in the promotion and operation of these existing products and services. It will also serve to introduce new products and brands to the home products and services marketplace.
- A list of premium names corresponding to generic terms that will be reserved for the registry to use for promoting the TLD using Defender Security’s existing diverse and innovative business activities that include home security, home heating and cooling services, real estate, and television network services.
- A list of regional or locally focused premium names that will be reserved for the registry to focus on local marketing efforts and to develop destinations dedicated to the home and home services community and clients searching for home and home-services related information and businesses. All participants must adhere to an open policy that allows inclusion of all home and home services related businesses and entities that fulfill the .HOME Policy.
- A list of premium names corresponding to home services industry names will be reserved and developed internally to bring innovation to DotHome Ltd.’s existing activities or in strategic partnership with leading home and home-services related entities. Partner selection criteria for some of the premium keywords can include RFP or an auction mechanism with the pre-requisite of fulfilling the criteria set forth in the .HOME Policy.”

- 4.17 The Objector has also filed objections against eight other applicants for the Disputed gTLD. As at the date of this decision, a decision has been published in respect of only one of those objections; *i.e.* *Defender Security Company v. Charleston Road Registry Inc.*, WIPO Case No. LRO2013-0032. The Objector’s objection was rejected in that decision.

## 5. The Legal Rights Objection Regime

- 5.1 The LRO regime is set out in the ICANN gTLD Applicant Guidebook (the “Guidebook”).

- 5.2 Subsection 3.2.1 of the Guidebook, *inter alia*, states:

“A formal objection may be filed on any one of the following four grounds:

*Legal Rights Objection* – The applied-for gTLD string infringes the existing legal rights of the objector.

The rationales for these objection grounds are discussed in the final report of the ICANN policy development process for new gTLDs. For more information on this process, see "<http://gnso.icann.org/issues/new-gtlds/pdp-dec05-fr-parta-08aug07.htm>".

5.3 Subsection 3.2.2 of the Guidebook, *inter alia*, states:

"Objectors must satisfy standing requirements to have their objections considered. As part of the dispute proceedings, all objections will be reviewed by a panel of experts designated by the applicable Dispute Resolution Service Provider (DRSP) to determine whether the objector has standing to object. Standing requirements for the four objection grounds are:

Legal rights: Rightsholders"

5.4 Subsection 3.2.2.2 of the Guidebook, *inter alia*, states:

"A rightsholder has standing to file a legal rights objection. The source and documentation of the existing legal rights the objector is claiming (which may include either registered or unregistered trademarks) are infringed by the applied-for gTLD must be included in the filing."

5.5 Subsection 3.5 of the Guidebook, *inter alia*, states:

"The objector bears the burden of proof in each case".

5.6 Subsection 3.5.2 of the Guidebook, *inter alia*, states:

"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 ...."

In the case where the objection is based on trademark rights, the panel will consider the following non-exclusive factors:

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, of the applicant or of a third party.
4. 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".

5.7 Subsection 3.3 of the Guidebook provides:

"The information included in this section provides a summary of procedures for filing:

- Objections; and
- Responses to objections.

For a comprehensive statement of filing requirements applicable generally, refer to the New gTLD Dispute Resolution Procedure ("Procedure") included as an attachment to this module. In the event of any discrepancy between the information presented in this module and the Procedure, the Procedure shall prevail.

Note that the rules and procedures of each DRSP specific to each objection ground must also be followed. See <http://newgtlds.icann.org/en/program-status/objectiondispute-resolution>."

5.8 Article 2(e) of the Procedure, *inter alia*, provides:

"The grounds upon which an objection to a new gTLD may be filed are set out in full in Module 3 of the Applicant Guidebook. Such grounds are identified in this Procedure, and are based upon the Final Report on the Introduction of New Generic Top-Level Domains, dated 7 August 2007, issued by the ICANN Generic Names Supporting Organization (GNSO), as follows:

(ii) "Existing Legal Rights Objection" refers to the objection that the string comprising the potential new gTLD infringes the existing legal rights of others"

5.9 Article 20 of the Procedure provides

"(a) For each category of Objection identified in Article 2(e), the Panel shall apply the standards that have been defined by ICANN.

(b) In addition, the Panel may refer to and base its findings upon the statements and documents submitted and any rules or principles that it determines to be applicable.

(c) The Objector bears the burden of proving that its Objection should be sustained in accordance with the applicable standards."

## **6. Parties' Contentions**

### **A. Objection Document**

6.1 In its Objection document, the Objector refers to its business and relies upon the various trade marks and trade mark applications already described. So far as European Community Trade mark no 010535201 is concerned, it claims that as Dothome Ltd is "a wholly owned subsidiary of [the Objector,

it] is authorized to represent the interests of Dothome Ltd in this Legal Rights Objection”.

6.2 The Objector also claims that:

“In addition to security goods and services, [the Objector] markets, sells and installs residential heating, cooling, ventilation and plumbing products and offers domain name services through the site [www.dothome.net](http://www.dothome.net).”

6.3 However, no evidence provided with the Objection document which evidences that use. Further, later on in the Objection document, it claims that “Dothome Limited has been a reseller of domains and has used the .HOME mark to brand its domain reservation website, <http://www.dothome.net>”.

6.4 The Objector claims that the Disputed gTLD is “identical or similar” to the various trade marks and trade mark applications relied upon asserting that in assessing similarity account should be taken of “the overall commercial impression created by the marks in question”.

6.5 In this respect, it contends that the Disputed gTLD is identical to “primary formative” in the Community Trade Mark registered in the name of Dothome LTD. Although it recognises that this mark is a composite mark, it claims that “the verbal element ‘.HOME’ is dominant in the overall commercial impression of the mark”.

6.6 The Objector also claims that the Disputed gTLD “shares the ‘.HOME’ formative with each of Defender’s United States Trademark Applications for TRUE.HOME noted above”. Given these are described as “composite marks” this appears to be a reference to Application no’s 85588370 and 85588382. Again it claims that “the verbal element ‘.HOME’ is dominant in the overall commercial impression of [those] mark[s]”.

6.7 The Objector claims that the acquisition and use of its marks has occurred in the “ordinary course of trade and is a natural extension of its branding strategy”. It claims such acquisition and use to be *bona fide* citing *Aycock Engineering, Inc. v. Airflite, Inc.* 560 F.3d 1350 (Fed. Cir. 2009); EJC Case C-40/01 *Ansul v. Ajax*, paragraph 36, and EJC Case C-234/06 P *Il Ponte Finanziaria v OHIM*, paragraph 72.

6.8 It further contends that it “has a history of actual and *bona fide* use of the ‘HOME’ and ‘.HOME’ formative in association with its home services, domain name services and advertising of those services.” In this respect:

- (i) it refers to Dothome Limited’s activities from “[www.dothome.net](http://www.dothome.net)”;
- (ii) it claims that the TRUE HOME trade mark “identified in U.S. Trademark Registration Number 3,404,246” was in use by December 21, 2006, in association with various services including “evaluation of heating, ventilation, air conditioning energy requirements and energy efficiency ratings of new and existing structures; designs for others in the field of ducting and heating ventilation and air conditioning equipment”;
- (iii) it claims that the “TRUE.HOME” marks the subject of application no’s 85588370 and 85588382 were “in use by [the Objector] at least as early as April 30, 2012, in association with various services including “advertising, promotion, and marketing services ... in the field of residential and commercial security systems and alarms”; and
- (iv) it claims that it has spent “in excess of US\$500,000 for expert brand research and analysis to develop its brand recognition strategies using the [Objector’s] Marks”.

6.9 The Objector claims that the marks it relies upon have “recognition ... in the various sectors” and that if the Applicant obtains the Disputed gTLD, the Applicant would be able to “impermissibly trade” on the



Objector's goodwill in its trade marks. In this respect, it contends that the Applicant's use of the Disputed gTLD will "obviously relate to registry services and the open registration of domain names under the [Disputed gTLD]" and that the "Applicant's target for domain name registrants will undoubtedly include, in large part, the home services industries".

- 6.10 The Objector claims that it is unaware of any marks that include the term "HOME" owned by the Applicant, any use of or demonstrable preparation to use a sign corresponding to the Disputed gTLD or of the Applicant being commonly known by a name including the term ".HOME".
- 6.11 The Objector claims that the Applicant's use of the Disputed gTLD will create both a likelihood of confusion and actual confusion with its trade marks (and cites various US and European case law in this respect).
- 6.12 Further, it claims that:

"[the Objector], through its wholly owned subsidiary Dothome LTD, has invested significantly in the EU Community .HOME Mark, the associated business, and the marketing and promotion of the business and associated trademark. These investments include trademark application fees and costs, operation of a website for promotion of the trademark and business, and related costs and expenses. The Applicant would take unfair advantage of the EU Community .HOME Mark and its reputation and devalue the mark if the [Disputed gTLD] is attributed to the Applicant."

- 6.13 Finally, the Objector claims that its rights will be harmed if the Applicant is allowed its intended use of the Disputed gTLD. In this respect it refers once again to the USD 500,000 it has spent "for expert brand research and analysis to develop its brand recognition strategies". It claims that "[t]here is no doubt that a large number of consumers in the relevant markets will identify the [Disputed] gTLD with the [Objector's] Marks."

## **B. Applicant's Response**

- 6.14 The Applicant contends in its response that by presenting its complaint and given its status as a competing applicant for the Disputed gTLD, is trying to "game" the new gTLD application process. It claims that the Objector is claiming "trademark rights in the dictionary word 'HOME' related to home security and related services without any legal support and against all established trademark law".
- 6.15 So far as the marks and application relied upon by the Objector are concerned, the Applicant:
- (i) claims that the Community Trade Mark relied upon by the Objector "claims no trademark protection for the verbal word 'HOME' or '.HOME'; and
  - (ii) refers to the disclaimers in respect of the term "HOME" in US Application no's 85588370 and 85588382.
- 6.16 It further contends that international trade mark law does not support an argument that top level domains that comprise dictionary words that describe categories of services can be protected as trade marks. Further it claims that no "recognized trademark law" provides for "exclusive use of the work 'home' standing alone describing home/residential/building security related products or services".
- 6.17 Further, the Applicant denies that the marks relied upon by the Objector would be infringed by the operation of an open registry from the Disputed gTLD. At one point in its Response it asserts that the Objector has "knowingly misrepresented their trademark rights ... [in that it] failed to disclose their prior admissions that they have no trademark rights in the [Disputed gTLD] or the word 'HOME'".
- 6.18 It complains that "no proof" is provided to support the Objector's claims as to the size of its business, which in any event is said to be of no relevance to the Objector's claims in relation to the use of the

word "HOME".

- 6.19 It further contends that the Objector's claims that it has been offering domain services through a website operation from the <dothome.net> domain "for a substantial time", are "false and deceptive". In this respect it provides a Declaration from a Mr. Enrico Schaefer, who is the managing partner of the Applicant's attorneys. In that Declaration Mr. Schaefer contends and provides evidence that:
- (i) the Internet archive Way Back Machine shows that (a) no website operated from that domain name in April 2004; (b) by November 2005 the domain name forwarded Internet users to a parking page at <searchtermresults.com>; (c) by September 2011, a parking page operated directly from that domain name; and (d) by March 2012 the website operating from that page displayed the design that is the subject of the Community trade mark relied upon by the Objector but no substantive content.
  - (ii) the Whois history for the <dothome.net> domain name shows that this domain name was registered to "Constantinos George Roussos Ecommerce Ltd (CGR Ecommerce Ltd)" until March 2012, when the domain name was transferred into the name of a domain name proxy service. According to Mr. Schaefer the domain name was "presumably purchased by the Objector" at this time.
- 6.20 The Objector also claims that that the evidence establishes that the "Objector inherited the domain name [<dothome.net>] as part of its gTLD application purchase from Constantinos Roussos, and it has a Google page rank of '0', no discernible traffic and limited archive history".
- 6.21 So far as the Objector's claims to have engaged extensive marketing activity, to benefit from large numbers of visitors to its websites and to both make and receive many millions of calls are concerned, the Applicant observes that these are "blanket statements" and that no evidence has been submitted in relation to its marketing spend so far as the term HOME is concerned. Further, it contends that the Objector itself uses the word "home" in a generic sense and provides as evidence in this respect copies of Google search results limited to the Objector's website at "www.defenderdirect.com" in relation to the terms "home security", "home" and "True Home".
- 6.22 Further, the Applicant claims that "[the Objector] and its counsel have tried to deceive this panel concerning its business model and [its] marketing of trademarks".
- 6.23 The Applicant also contends that the Disputed gTLD is neither identical or similar to the trade mark rights relied upon by the Objector. In this respect it denies that the "HOME" element in any of these marks has any trade mark protection given its descriptive meaning. It further denies that "HOME" is the dominant element of any of the marks relied upon.
- 6.24 Further the Applicant claims that there is no evidence of any use of the trade marks in commerce "beyond filing for registration as part of an unlawful attempt to gain leverage over other applicants".
- 6.25 So far as the Objector's reliance on Twitter tweets is concerned, the Applicant contends that only a single tweet out of the 9,732 tweets at "www.twitter.com/dot\_home" related to domain registration services, and that the vast majority are "related to home/real estate purchasing, financing or improving your 'home'".
- 6.26 The Applicant appears to accept that the Objector has a <.HOME> Facebook page with 8,368 "likes" but claims that this page only has two posts. It claims that it is unclear why any consumer would "follow a twitter address or Facebook Page with virtually no relevant content" and states that it is "possible that [the] Objector used 'black hat' methods or paid for" these followers and "likes".

### **C. Objector's Further Statement**

- 6.27 In a further statement filed in response to the Panel's Order requiring further statements, the Objector sets out further details in support of its contention that it is entitled to rely upon the Community Trade

Mark initially applied for by Mr. Roussos and transferred to Dothome Limited in April 2012. In particular it claims that:

- (i) Dothome Acquisition Group LLC, an Indiana (USA) limited liability corporation, is a wholly owned subsidiary of the Objector. In support of that contention it exhibits a letter signed by the Objector dated May 4, 2012 marked "To Whom it Concerns" and which contains the text:  
"Defender Security Company ... hereby accepts your offer to purchase one hundred percent (100%) interest ... in Dothome Acquisition Group LLC... (the "Company") ... including a 100% interest in the profits, losses, distributions, and capital of the Company ... . I understand that this subscription may be rejected in whole or in part, in the sole discretion of the Company".
- (ii) In May 2012 Dothome Limited's shareholders, (the majority shareholder being CGR E-Commerce Limited) sold all the legal and beneficial ownership in the shares of Dothome Ltd to Dothome Acquisition Group LLC. In support of this contention it exhibits two pages of a Share Sale and Purchase Agreement dated May 29, 2012, that is consistent with this claim.

6.28 Accordingly, the Objector maintains that Dothome Limited is a "second-tier wholly owned subsidiary of the Objector". It claims that in accordance with Generally Accepted Accounting Principles, the assets and liabilities of the Objector include Dothome Acquisition Group LLC and Dothome Limited. It also claims that "a parent corporation had standing based on use of a trademark by a wholly owned subsidiary" and cites various US cases in this respect. It, therefore, claims to be a "rightsholder" under section 3.2.2 of the Guidebook.

6.29 The Objector also makes further submissions in relation to *bona fide* use. It asserts that *bona fide* use is commonly defined as use of a trade mark in the ordinary course of trade that is not mere token use. It then claims that it:

"is evident at the site [www.dothome.net](http://www.dothome.net) through which three domain names were registered in the second quarter of 2013 (the only period for which data is available from the reseller GoDaddy)"

6.30 It further disputes the Applicant's contention that a Google page rank of 0 is significant (and annexes various printouts from the Internet in this respect). It also claims that the Applicant has "no way of assessing 'discernible traffic'".

6.31 It further submits evidence in the form of a Google search engine print out in respect of the search terms ".home domain name", ".home gtld" and ".home tld" in which the Dothome Limited's Facebook page and the "www.dothome.net" website appears in the search results. It also provides a printout from Dothome Limited's Facebook page which shows 8,274 "likes" and its twitter page which shows 18,965 followers.

6.32 Finally, the Objector denies that the statement set out in full at paragraph 6.12 above is false and/or misleading. It asserts that

"Objector in fact paid \$75,000 to the shareholders of Dothome LTD to acquire their capital shares. ... Objector also paid \$50,000 in additional consideration to consummate Dothome LTD acquisition. It is neither false nor misleading to state that Objector, through its subsidiary, invested significantly in the mark and paid the Dothome LTD shareholders a sum equal to the value of their shares and the shareholders' costs to start the business and acquire its assets."

#### **D Applicant's Further Statement**

6.33 In its further statement, the Applicant claims that the Objector does not have standing under subsection 3.2.2.2 of the Guidebook so far as the Community Trade Mark is concerned. In this respect, it calls into question the letter of May 4, 2012 in respect of Dothome Acquisition Group LLC, noting that it is not addressed to any specific person or signed by anyone other than the Objector.

Further, it notes that only two pages of a Share Sale and Purchase Agreement dated May 29, 2012 are provided and that the signature pages are missing.

- 6.34 As to *bona fide* use of the Community Trade Mark, the Applicant claims that the Objector has not responded to the “direct suggestion that false information was provided in order to make it appear that Objector’s use was bona fide, rather than a thinly veiled attempt to gain leverage over other Applicants for the [Disputed gTLD]”.
- 6.35 It claims that the original Objection document should be read as suggesting that so far as the Community Trade Mark is concerned there were “eight billion annual marketing impressions”. This is said to be “a gross exaggeration by Objector at best and at worst an intentional attempt to deceive this expert panelist”.
- 6.36 It further contends that the evidence suggests that “the Objector’s predecessor in interest filed a figurative Community mark nearly identical to 18 other figurative marks incorporating dictionary words for the sole purposes of misrepresenting trademark rights against legitimate competing Applicants for a variety of gTLD registries”.
- 6.37 It claims that the evidence establishes that the Objector
- “put up a bare bones website and social media pages with little traffic, little engagement and doing virtually no business as further subterfuge for its bad faith attempt to exert leverage against other gTLD applicants in direct derogation of ICANN’s stated purpose to encourage applicants and the expansion of the gTLD registry system. The lack of effort in these ‘parked’ sites including dothome.net speaks volumes.”
- 6.38 It also provides a declaration by Anirudh Kumar, who is the head of Digital Marketing at Radix FZC, which is the Applicant’s parent company. He attaches to that declaration a Google key word analysis in respect of the terms “.home domain name”, “.home gtld” and “.home tld”, which suggests, *inter alia* that the average monthly searches for these terms is no more than 20. Mr. Kumar claims that such low search volume implies that there is likely very little traffic for these terms.
- 6.39 Mr. Kumar accepts that PageRank “is not the most important signal to determine relevance and ranking of a page” but that it is still “one of the more important of the 200 signals that Google use”.
- 6.40 Mr. Kumar further observes that the Twitter account that the Objector relies upon almost exclusively contains tweets about real estate topics. As to the Facebook page, he notes that there were a total of 6 posts in the last year and a half, and only one of these posts seemed to be an enquiry about the .Disputed gTLD.
- 6.41 Finally the Applicant asks that “to the extent such authority exists”, the Panel award the Applicant its costs and attorney fees associated with defending this opposition.

## **7. Discussion and Findings**

### **A. Standing**

- 7.1 There are a number of trade marks and trade mark applications that are relied upon by the Objector in this case. It is, therefore, convenient to address the question of standing by reference to each of these marks in turn.

#### *(i) The Community Trade Mark*

- 7.2 There is a dispute in this case as to whether the Objector has standing so far as the Community Trade

Mark is concerned. The Applicant contends that the documents filed by the Objector in respect of its claims that the Community Trade Mark is owned by a wholly owned subsidiary, are incomplete and/or fail to show the Objector's ownership of that mark.

- 7.3 They are contentions that have some force. This is particularly so in the case of the letter of May 4, 2012 that is said to evidence the Objector's acquisition of Dothome Acquisition Group LLC (*i.e.* the claimed intermediary company) that is said to own Dothome Limited, which in turn owns the Community Trade Mark). The letter is not on headed notepaper, is addressed to Dothome Acquisition Group LLC rather than the owners of that company and is marked "To Whom it Concerns". As the Applicant points out, it is also expressed as a "subscription" that is subject to rejection "in whole or in part, in the sole discretion of the Company".
- 7.4 Further, even if the questions that these documents raise are disregarded, there is a more fundamental problem here. Dothome Limited is a separate corporate entity from the Objector. Dothome Limited is *prima facie* the "rightsholder" under section 3.2.2 of the Guidebook, not any ultimate parent. It might have brought a Legal Rights Objection in its own right. Further, "Objector" is defined in Article 2 of the Procedure as "one or more persons or entities who have filed an objection against a new gTLD for which an application has been submitted". This appears to contemplate that a number of persons or entities might jointly bring a single objection. However, Dothome Limited neither brought its own proceedings nor was named as a party to the current proceedings.
- 7.5 The Objector responds that under Generally Accepted Accounting Principles, the assets and liabilities of the Objector include Dothome Acquisition Group LLC and DotHome Limited. It may well be so that the assets and liabilities of wholly owned subsidiaries are taken into account in the accounts filed by a parent company. Nevertheless, a parent and its subsidiaries are still likely to be separate legal persons. It does not follow that specific assets of the subsidiary, and in particular the subsidiary's registered trade mark rights, can be deemed to be owned by the parent, and therefore that the parent should be classed as the "rightsholder" for the purposes of LRO proceedings.
- 7.6 The Objector also cites various US cases to the effect that a parent corporation has standing to bring opposition proceedings against the mark of another that are based upon a mark owned by its subsidiary. The Panel is not in a position to judge whether this contention is correct, but is unpersuaded that even if it is, this would make a difference. Under Article 20 of the Procedure a panel should take into account "any rules or principles that it determines to be applicable". Admittedly, it is a somewhat circular definition; *i.e.* the test for whether a rule or principle is applicable is whether a Panel determines it to be so. However, this Panel sees no good reason why any particular local law should prevail on the question of who is a "rightsholder". It makes more sense in the context of the LRO process that insofar as is reasonably possible this should have an independent meaning under the Guidebook and Policy. Further, it is certainly not an invariable rule (and the Panel doubts that it is a common rule) among legal systems that a parent can always rely upon the trade mark rights of a subsidiary by reason of its mere ownership of the subsidiary.
- 7.7 Were the mark one that was actively being used by the Objector, the Panel might have taken a different position. For example, the Panel can see the force in the argument that the mere fact that a trademark that is used across a corporate group is held by a holding company within that group, should not prevent the company or companies that are actually using those marks to bring LRO proceedings. However, in such a case the company will have a real commercial interest in the mark (over and above any interest that it may have by reason of its direct or indirect shareholding in the company that holds the mark) and is also likely to be the beneficiary of either an express or implied licence from the holding company in respect of its use.
- 7.8 For reasons that the Panel goes on to explain in greater detail later on in this expert determination the Panel is of the view that the Objector is not actively using the Community Trade Mark in this fashion. In the circumstances, this Panel finds that the Objector is not a rightsholder for the purposes of the LRO procedure so far as the Community Trade Mark is concerned.

*(ii) The TRUE HOME mark (i.e. US registered trade mark no 3,404,246)*

7.9 The Panel is prepared to proceed on the basis (without formally deciding the issue) that the Objector has standing so far as this mark is concerned. It notes that the panel in *Defender Security Company v. Charleston Road Registry Inc.*, WIPO Case No. LRO2013-0032 came to a different conclusion. It appears to have been the view of the panel in that case that the Objector had failed to show that the transfer of this trade mark to the Objector in August 2012 involved the transfer of any goodwill attached to the trade mark and that under US law the transfer was not effective.

7.10 This is not a point that has been argued by the Applicant in this case and accordingly the Panel is prepared to assume for the purposes of this decision that the Objector has standing so far as this mark is concerned. However, the issue of reputation and goodwill is one to which the Panel returns when it comes to the question of whether the Disputed gTLD infringes the rights of the objector.

*(iii) U.S. Trademark Application 85588370 (now US registered trade mark no 4,310,530)*

7.11 The Panel is prepared to proceed on the basis (without formally deciding the issue) that the Objector has standing so far as this mark is concerned. It notes that the panel in *Defender Security Company v. Charleston Road Registry Inc.*, WIPO Case No. LRO2013-0032 came to a different conclusion. Central to the panel conclusion in that case appears to have been the fact that the trade mark relied upon was merely an application rather than a registered mark and that by analogy with the position in UDRP proceedings, this provided insufficient rights for the purposes of the Policy.

7.12 However, in its Objection document the Objector claimed that the application had already been “approved” by the US trade mark office. Although no evidence is filed in support of that contention nor argument offered as to what that means either as a matter of US law or the standing requirements of the LRO procedure, the Panel notes that just 13 days after the Objection document was filed, the application proceeded to grant. Further, the Applicant raised no objection to this mark on the ground that it was an application at the time the Objection document was filed.

*(iv) U.S. Trademark Application 85588382*

7.13 This is another trade mark application relied upon by the Objector and which the Objector also claims has been “approved” by the US trade mark office. However, (in contrast with U.S. Trademark Application 85588370) as far as the Panel can tell as at the date of this decision the application has not proceeded to grant. In the circumstances, and given that the burden of proof is on the Objector, the Panel is not even prepared to proceed on the basis (without formally deciding the issue) that the Objector has standing so far as this application is concerned. In the circumstances, the Panel finds that the Objector is not a rightsholder for the purposes of the LRO procedure so far as this trade mark application is concerned.

*(v) US Trademark Applications 85721544 and 85721554 for TRUE HOME and TRUE.HOME.*

7.14 In the case of these two applications relied upon by the Objector, the Objector does not even claim that the applications are “approved”. In the absence of further submissions or argument by the parties, this Panel is not prepared to hold that a mere trade mark application provides “rights” for the purposes of the LRO procedure in respect of which a person or entity might be a rightsholder under the LRO procedure. The Objector does not have standing in this respect.

**B. Infringement of the Objector’s rights**

7.15 Insofar as the Objector is a “rightsholder” for the purposes of the LRO the Panel must determine whether the Objector has shown that the Disputed gTLD has infringed those rights which are “recognized or enforceable under generally accepted and internationally recognized principles of law” (subsection 3.5.2 of the Guidebook).

7.16 Although the Panel has concluded that the Objector is not a rightsholder so far as the Community Trade Mark is concerned, it is nevertheless convenient (and given the statement about separate business at paragraphs [7.7 and 7.8] of this decision, necessary) briefly to examine whether the test is satisfied in the case of that mark before addressing those marks where the Panel is prepared to proceed on the assumption that the Objector is a rightsholder.

*(i) The Community Trade Mark*

7.17 A remarkable feature of the initial submissions of the Objector in this case is that they mix up the Objector's business activities in the home security sector with domain name related activities, both of which are said to be conducted under some variant of a ".HOME" mark. Further, the overall impression one gets when first reading the Objection document is that the Objector is a very substantial business of which domain name-related activities form a significant part.

7.18 In fact, as is apparent from at least the additional submission filed by the Objector, this is not the case. Instead, it is apparent that insofar as domain name-related activities are concerned, these have been conducted by Dothome Limited from a website operating from the <dothome.net> domain name. It is also clear that the level of commercial activity in which Dothome Limited has been involved is very small and has been conducted over a really short period of time. For example, the Objector admits that only three domain names were registered in the second quarter of 2013. As far as the Panel can tell, this is the only revenue-generating business activity in which Dothome Limited has been engaged.

7.19 Further, the Panel finds compelling the Applicant's evidence that the traffic to the website <dothome.net> domain name is very small, or even trivial. This is not a business which can credibly be claimed to have developed any significant reputation so far as Internet users are concerned.

7.20 Of course, Dothome Limited has also applied for the Disputed gTLD and presumably incurred substantial expenditure in this respect. Further, it seems to have been engaged in some marketing in anticipation of successfully acquiring the Disputed gTLD (although there seems to be a real question as to whether that marketing insofar as it took the form of Twitter posts or a Facebook page was of any real substance). However, these activities are, and this expenditure is, essentially speculative and relates to a business that Dothome Limited hopes to have in future (*i.e.* the running of a registry from the Disputed gTLD) rather than one that has any significant existence at present.

7.21 Further, so far as it is claimed that this has been done under a common HOME mark, the reality is that the only mark incorporating the term "HOME" that has been used in connection with Dothome Limited's business is the Community Trade Mark.

7.22 The evidence suggests that this mark was registered by a Mr. Roussos at about the same time as a large number of other trade marks all of which comprise cartoon style drawings into which stylised text corresponding to a possible gTLD have been incorporated. Each of these marks were registered in the same classes and in respect of the same specifications and covered the operation of domain name registries and related services. The obvious inference to be drawn from these facts is that the applications had nothing to do with any marks already being used by any pre-existing business. Instead, they had been registered with the forthcoming new gTLD application process in mind.

7.23 The exact extent of the dealings and commercial arrangements between the Objector, Dothome Limited and/or Mr. Roussos is unclear. The Panel does not know to what extent, if at all, the Objector and/or Dothome Limited were involved in Mr. Roussos' initial decision to apply for these trade marks. Nevertheless, it is reasonably clear that the Community Trade Mark was acquired by Dothome Limited and/or the Objector has acquired an interest in Dothome Limited, not because the design of the mark reflects the branding of any pre-existing business, but because it incorporates the text ".home" and that the mark might provide the owner with some advantage in the gTLD process and/or form the basis of some claim against any third party who was successful in securing the Disputed gTLD.

- 7.24 Subsection 3.5.2 of the Guidebook makes it clear that to succeed under the LRO an objector must show that the gTLD (i) takes unfair advantage of the distinctive character or the reputation of the Objector's registered or unregistered trademark or service mark ..., and/or (ii) unjustifiably impairs the distinctive character or the reputation of the Objector's mark ..., and/or (iii) otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the Objector's mark.
- 7.25 Given the very limited use made of the Community Trade Mark and the fact that the mark takes the form of a device mark which incorporates the ".home" text, and the Applicant's stated intent to use the Disputed gTLD for a registry that relies upon the generic or descriptive nature of the word "home", the Objector in this case has failed to prove to the Panel's satisfaction that (a) the Disputed gTLD either takes unfair advantage of the mark; or (b) that the mark has any significant distinctive character which the Disputed gTLD would take advantage of or might unjustifiably impair; or (c) there would be an impermissible likelihood of confusion between the Disputed gTLD and the mark.
- 7.26 Further, subsection 3.5.2 of the Guidebook also sets out a series of non-exclusive factors that a Panel shall take into account when considering whether a disputed gTLD. Only one of those factors relates to the Objector's conduct (rather than the Applicant's conduct). This is the second factor which requires a panel to consider "whether the objector's acquisition and use of rights in the mark has been *bona fide*".
- 7.27 The Objector appears to contend that the only relevant question so far as this factor is concerned is whether Dothome Limited has used the Community Trade Mark for anything other than token use. It contends that the mark has been used in relation to a real business in relation to real sales (albeit of only a very small number) and that this use is therefore *bona fide*.
- 7.28 This Panel does not believe that the term "*bona fide*" in subsection 3.5.2 should be construed in such narrow terms. First, it is clear from the wording of the second factor that what matters is not just the use of the mark but how it is acquired. Second, the Panel sees no good reason why if a mark has been acquired or used primarily with the intention of providing the owner of the mark with an advantage in the gTLD process rather than for use in conjunction with a pre-existing business, a panel cannot conclude that this registration and use is not *bona fide*.
- 7.29 In the present case, the Panel has formed the view that this was not only the primary but the predominate reason why the mark was acquired and used. Or to put it more crudely using the language of Applicant, the Panel has formed the view that the Community Trade Mark was registered, acquired and used not as part of any pre-existing business unrelated to gTLDs but in an attempt to "game" the gTLD process. In the opinion of the Panel, this provides an independent reason why any objection based on that mark should fail.
- 7.30 Finally, the Panel is bound to express a concern with the manner in which the Objector and its legal advisers have put the Objector's case. The Panel has already remarked that the Objection document when first read gives the reader the impression that the Objector is a very substantial business of which domain name related activities form a significant part, when this is not in fact the case. The Panel has little doubt that the document has been skilfully drafted so as to give that impression, but that for the most part the actual words used have been carefully chosen to ensure that it is difficult to say that anything claimed in that document is false.
- 7.31 However, at one stage the Objector went so far as to claim that:
- "[the Objector], through its wholly owned subsidiary Dothome LTD, has invested significantly in the EU Community .HOME Mark [(i.e. the Community Trade Mark)], the associated business, and the marketing and promotion of the business and associated trademark. These investments include trademark application fees and costs, operation of a website for promotion of the trademark and business, and related costs and expenses"



- 7.32 This is a statement that is misleading and in part simply untrue. It is misleading in that it disguises (particularly when read in conjunction with the rest of the Objection document) the fact that the Community Trade Mark was in fact applied for by a third party (*i.e.* Mr. Roussos) and that the Objector only obtained an indirect (if any) interest in the mark as a result of the transfer of the mark to Dothome Limited, the subsequent acquisition of Dothome Limited by Dothome Acquisition Group LLC and the subsequent acquisition of Dothome Acquisition Group LLC by the Objector. It is untrue in that (a) it is Mr. Roussos not Dothome LTD who made the application and therefore would have incurred trademark application fees; and/or (b) it could not be sensibly said that the Objector incurred those costs through Dothome Limited given that even on the Objector's case, it only acquired an interest in Dothome Limited in May 2012 (*i.e.* several months after the Community Trade Mark application).
- 7.33 The Objector sought to justify that statement by claiming that the Objector "paid \$75,000 to the shareholders of Dothome LTD to acquire their capital shares. ... [and] also paid \$50,000 in additional consideration to consummate Dothome LTD acquisition". Given this it contends that it is:
- "neither false nor misleading to state that Objector, through its subsidiary, invested significantly in the mark and paid the Dothome LTD shareholders a sum equal to the value of their shares and the shareholders' costs to start the business and acquire its assets".
- 7.34 The Panel finds this explanation unconvincing. This statement appears to confuse the acquisition of Dothome Limited by Dothome Acquisition Group LLC and the acquisition of Dothome Acquisition Group LLC by Objector. However, leaving this to one side, this is not an adequate explanation. The Objector would have been well aware that the exact circumstances in which it acquired the Community Trade Mark were likely to be highly relevant to these proceedings. Given this, to make claims based upon "investment" in that mark, without properly explaining that "investment" was simply a share purchase in a company that held that mark, is highly misleading. The Objector must have known this to be the case. Further, it strains credulity to suggest (if this is what the Objector is attempting to do) that it was legitimate for the Objector to assert that it had paid the trade mark application fees because the sum paid for the company was "equal to the value of their shares and the shareholders' costs to start the business". The words that the Objector chose (at least without further qualification and explanation) simply do not bear that meaning.
- 7.35 It is a stance that does the Objector and its advisors no credit. It also colours the Panel's reading of other unsupported assertions of fact in the Objection document.

*(ii) The US Trade Marks*

- 7.36 As the Panel has already explained, it is prepared to proceed on the assumption that the Objector is the "rightsholder" in relation to two US registered trademarks; *i.e.* (i) US registered trade mark no 3,404,246 for TRUE HOME in respect of environmental testing and inspection consulting services; and (ii) US registered trade mark no 4,310,530 being a device mark that incorporates the text "true.home" and which has been registered in respect of residential and commercial security systems and the installation, repair and maintenance of plumbing, heating, air conditioning, geothermal, electrical, and security systems.
- 7.37 Neither mark is identical to the Disputed gTLD. At best there is some degree of similarity. In the case of trade mark no 3,404,246 that similarity resides in the common use of the word home. In the case of trade mark no 4,310,530 that similarity resides in the use of the text ".home", subject to a disclaimer that no rights are claimed in respect of the word "home" by itself.
- 7.38 In such circumstances, an important part of any assessment of whether the Disputed gTLD either takes unfair advantage of the distinctive character or the reputation of those marks, unjustifiably impairs the distinctive character or the reputation of those marks or otherwise creates an impermissible likelihood of confusion with those marks, is the level of goodwill and reputation associated with those marks and to what extent the terms "home" and ".home" used in those marks

have come to be associated in the minds of the relevant public with the Objector's services. Indeed, the importance of public recognition is expressly identified in the third factor in the list of factors that the Guidebook states a panel should take into account.

- 7.39 The difficulty that immediately arises in this respect is that the Objector has simply failed to bring forward any coherent evidence as to the extent of the reputation of those marks, let alone as to how the terms "home" and ".home" are perceived. There are assertions as to the size of the Objector's business, which are not evidenced. Even if these assertions are taken at face value there is simply no explanation let alone evidence of how these marks have been used or of how much business has been conducted under either of these two marks in respect of the goods or services for which the marks have been registered. Similarly there is no evidence as to how these marks or the relevant portions of those marks are perceived by the public.
- 7.40 Given this the Objector has simply failed to get off the starting blocks so far as these marks are concerned.
- 7.41 There are also aspects of the materials before the Panel that strongly suggest that the Panel is not being told the full story so far as the use of those marks is concerned. For example, the Objector claims to have been in business since 1998, and yet US registered trade mark 3,404,246 was initially registered in the name of Carl Simpson and only was transferred to the Objector in August 2012. As has already been mentioned in this decision, the panel in *Defender Security Company v. Charleston Road Registry Inc.*, WIPO Case No. LRO2013-0032 suggested that there was no evidence that there had been a transfer of any goodwill attached to the trade mark. Whether or not that is so and/or relevant to the current proceedings, the fact that this mark was in the name of someone else and was transferred to the Objector relatively recently cries out for an explanation and yet none is provided by the Objector.
- 7.41 Further, even had evidence been forthcoming both in respect of the Objector's use of these marks and how they are perceived, that would not be the end of the matter. There would still be significant questions as to whether even if the public associated the text "home" or ".home" with the Objector's marks, the use in the Disputed gTLD of the ordinary English word "home" in the context of an open registry seeking to take advantage of the descriptive use of that term (as the Applicant's public application suggests is intended) should nevertheless still be permitted (see in this respect the analysis of the panel in *Express, LLC v. Sea Sunset, LLC*, WIPO Case No. LRO2013-0022).
- 7.42 In the circumstances, the Objector has got nowhere near bearing the burden of proof that is imposed upon it by the LRO procedure in establishing that the gTLD string infringes the existing legal rights of the Objector.

## 8. Decision

- 8.1 In the circumstances, the Objector has failed to show that it is a rightsholder for the purposes of these proceedings in respect of many of the trade marks it seeks to rely upon in these proceedings. Further, the Objector has failed to meet the burden of showing that the potential use of the applied-for gTLD by the Applicant:
- (i) takes unfair advantage of the distinctive character or the reputation of Objector's trade marks, or
  - (ii) unjustifiably impairs the distinctive character or the reputation of those marks, or
  - (iii) otherwise creates an impermissible likelihood of confusion between the Applicant's applied-for gTLD and the Objector's marks.
- 8.2 Accordingly the Panel rejects the Objection.

- 8.3 The Applicant asks that the Panel award the applicant its costs and attorney fees associated with defending this opposition “to the extent such authority exists”. Article 21(d) of the Procedure makes it clear that:

“[t]he remedies available to an Applicant or an Objector pursuant to any proceeding before a Panel shall be limited to the success or dismissal of an Objection and to the refund by the DRSP to the prevailing party, as determined by the Panel in its Expert Determination, of its advance payment(s) of Costs pursuant to Article 14(e) of this Procedure and any relevant provisions of the applicable DRSP Rules”.

- 8.4 The Applicant is the prevailing party in this case. There is no need to specifically direct the Center to refund the Applicant the relevant fees given the automatic effect of Article 14(e) of the Procedure.

[signed]

**Matthew S. Harris**

Sole Panel Expert

Date: July 16, 2013

ANNEX A

ORDER REQUIRING ADDITIONAL WRITTEN STATEMENTS

Defender Security Company v. DotHome Inc.  
Case No. LRO2013-0034

**WHEREAS** the Panel has reviewed the case file and, without prejudice to any subsequent findings of fact or law or any decision on the interpretation of any aspect of Module 3 to the New gTLD Applicant Guidebook (the “Guidebook”), the New gTLD Dispute Resolution Procedure (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”), notes as follows:

(I) The gTLD string in dispute in these proceedings is <.home> (the “Disputed gTLD”).

(ii) Subsection 3.2.2 of the Guidebook, *inter alia*, states:

“Objectors must satisfy standing requirements to have their objections considered. As part of the dispute proceedings, all objections will be reviewed by a panel of experts designated by the applicable Dispute Resolution Service Provider (DRSP) to determine whether the objector has standing to object. Standing requirements for the four objection grounds are:

...

Legal rights: Rightsholders”

(iii) Subsection 3.2.2.2 of the Guidebook, *inter alia*, states:

“A rightsholder has standing to file a legal rights objection. The source and documentation of the existing legal rights the objector is claiming (which may include either registered or unregistered trademarks) are infringed by the applied-for gTLD must be included in the filing.”

(iv) The trade marks relied upon by Defender Security Company (the “Objector”) in relation to the Disputed gTLD, include European Community trade mark no 010535201 (the “Community Trade Mark”). This is a mark that takes the following form:



(v) According to the publically available Office for Harmonization in the Internal Market (“OHIM”) online database (available at <http://oami.europa.eu/ows/rw/pages/QPLUS/databases/searchCTM.en.do>), the Community Trade Mark was originally applied for on 30 December 2011 in the name of Constantinos Roussos of [] Limassol, Cyprus

(vi) According to the publically available OHIM online database, Mr Roussos on or after 30 December 2011 also applied for a large number of community trade marks that are similar in design to the Community Trade Mark. Attached at Annex A hereto is a print out listing trade marks that remain in Mr Roussos’ name. Each application appears to have been in respect of the same goods and

services in classes 32, 42, and 45.

- (vii) The Community Trade Mark is currently registered in the name of “DotHome Limited”.
- (viii) Dothome Ltd is also recorded as the applicant in respect of a separate application for the Disputed gTLD with ICANN ID no 1-2021-47438. In the public portion of that application available on the ICANN website, Dothome Ltd is identified as a company registered under the laws of Cyprus (see paragraph 8(a)) and described itself as a “wholly owned by Dothome Acquisition Group, LLC, an Indiana limited liability company” (see paragraph 9(b)). However, it also describes itself in that same document as having “Defender Security” as its “parent” (see paragraph 18).
- (ix) Dothome Ltd is described by the Objector in its Objection document as “a wholly owned subsidiary of [the Objector]” (see paragraph 10(a)). This appears not to be disputed by the Applicant in its Response. Further, the Objector claims that it “is authorized to represent the interests of Dothome LTD in this Legal Rights Objection”. However, even if this is correct, it is unclear why that makes it a “rightsholder” in respect of the Community Trade Mark within the meaning of subsections 3.2.2 and 3.2.2.2 of the Guidebook.
- (x) In an earlier version of the public portion of application for the Disputed gTLD with ICANN ID no 1-2021-47438, also available in the ICANN website, the applicant is instead identified as DotHome/ CGR E-Commerce Ltd and describes its parent as “CGR E-Commerce Ltd/Roussos Group of Companies”. Constantinos Roussos is identified as the contact in relation to that application.
- (xi) The Objector *inter alia* claims to offer offers domain name services through the site operating at www.dothome.net. The Applicant has brought forward evidence in the form of historic Whois history for the <dothome.net> domain name which suggests that this domain name was registered to “Constantinos George Roussos Ecommerce Ltd (CGR Ecommerce Ltd)” until March 2012, when it transferred into the name of a domain name proxy service.
- (xii) The matters identified at paragraphs (v), (vi), (viii), and (x) above appear not to be expressly referred to in any submission or document filed to date in these proceedings. However, they suggest, together with the other matters referred to in the Response, that the Community Trade Mark was registered as part of a broader strategy by Mr Roussos and/or CGR Ecommerce Ltd and/or CGR E-Commerce Ltd to register trade marks the sole or main purpose of which was to support applications for new gTLDs and/or in connection with a proposed (rather than any pre-existing) business under new gTLDs and/or for use in proceedings or threatened proceedings (whether under the Legal Rights Objection process or otherwise) against other persons who applied for or obtained a new gTLD.
- (xiii) Further there is no evidence before the Panel that the Community Trade Mark has been used to and real degree to promote “domain reservation services”, other than as part of the web page currently operating from the <dothome.net> domain name, which appears to promote the Disputed gTLD as the “new web address for homes” and encourages “pre-registration” enquiries.
- (xiv) Further, according to the Applicant, the “objector inherited the domain name [<dothome.net>] as part of its TLD application purchase from Constantinos Rousos which has a Google page rank of “0”, no discernible traffic and limited archive history”. However, the sole evidence provided by the Applicant in this respect appears to be an assertion in a declaration provided by an attorney for the Applicant<sup>1</sup>.
- (xv) The matters identified in paragraphs (iv) to (xiv) above appear to be of potential relevance to the consideration non-exclusive factor number 2 identified at paragraph 3.5.2 of the Guidebook (i.e. “Whether the objector’s acquisition and use of rights in the mark has been *bona fide*”), at least so far

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<sup>1</sup> The relevant part of the Declaration refers to <www.dothome.com>, but as far as the Panel can tell, this appears to be a typographical error and a reference to dothome.net was intended

as the Community Trade Mark is concerned.

- (xvi) Further, the Panel notes that at page 11 of the Objection document that the Objector claims as follows:

“Furthermore, [the Objector], through its wholly owned subsidiary Dothome LTD, has invested significantly in the EU Community .HOME Mark [(i.e. the Community Trade Mark)], the associated business, and the marketing and promotion of the business and associated trademark. These investments include trademark application fees and costs, operation of a website for promotion of the trademark and business, and related costs and expenses. The Applicant would take unfair advantage of the EU Community .HOME Mark [(i.e. the Community Trade Mark)] and its reputation and devalue the mark if the [Disputed gTLD] is attributed to the Applicant.”

- (xvii) Given the matters identified at paragraphs (iv) to (xiii) above and if the Applicant’s claims as identified at (xiv) above are correct, then the statement quoted at paragraph (xvi) above would appear to be false and/or misleading. In particular, (a) at no time can the Objector be said to have incurred any trademark application fees and costs in relation to a trade mark that was registered not by it but by Mr Roussos; and (b) there appears to have been no significant investment in the promotion of the Community Trade Mark in respect of any real pre-existing business (as opposed to a prospective business should the Objector acquire the Disputed gTLD).
- (xviii) In the circumstances, the Panel is of the view that the parties to these proceedings should be provided with an opportunity to file a further written submission in relation to these matters.

The Panel, pursuant to subsection 3.4.5 of the Guidebook and Article 17 of the Procedure Rules **HEREBY ORDERS AS FOLLOWS:**

- (1) The Objector shall, by no later than Monday, 1 July 2013 (Geneva Time) file an additional written submission (together with supporting evidence) addressing the facts and matters set out in the Recitals to this Order.
- (2) The Applicant shall, if it so wishes, by no later than Thursday, 11 July 2013 (Geneva Time) file an additional written submission (together with supporting evidence) identifying to what extent it wishes to rely upon the facts and matters set out in paragraphs (v), (vi), (viii), and (x) of the Recitals to this Order, otherwise addressing the facts and matters set out in the Recitals to this Order and/or responding to the Objector’s submission filed pursuant to paragraph (1) of this Order.
- (3) Any submission filed pursuant to paragraph (1) or (2) of this Order should:
  - (i) be forwarded to the Center by email in accordance with paragraph 3(a) of the WIPO Rules for New gTLD Dispute Resolution.
  - (ii) include a declaration signed by a named individual as follows:

“[name of individual] certifies that the information contained in this submission is to the best of [his/her] knowledge complete and accurate, that this submission is not being presented for any improper purpose, such as to harass, and that the assertions in this submission are warranted under the Guidebook the Procedure and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.”
  - (iii) identify that named individual’s connection with the party upon whose behalf the submission has been filed and to what extent that individual has direct personal knowledge of the matters referred to in the submission, and insofar as that individual does not have direct personal knowledge of those matters the source of that knowledge.

- (iv) either be in a form that is text searchable (for example, a .doc Word document or a text searchable .PDF document) or be accompanied by a copy that is text searchable.

**Matthew S. Harris**

Sole Expert

Date: 19 June 2013