

EXPERT DETERMINATION LEGAL RIGHTS OBJECTION

Defender Security Company v. Top Level Domain Holdings Limited

Case No. LRO2013-0037

1. The Parties

The Objector/Complainant is Defender Security Company of Indianapolis, Indiana, United States of America, represented by Maginot, Moore & Beck, United States (“Complainant”).

The Applicant/Respondent is Top Level Domain Holdings Limited of Road Town, Tortola, British Virgin Islands, Overseas Territory of the United Kingdom of Great Britain and Northern Ireland, represented by Minds + Machines, United States (“Respondent”).

2. The applied-for gTLD string

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

3. Procedural History

The Legal Rights Objection (“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 the review of the Objection on March 27, 2013 and has determined that the Objection complies with the requirements of the Procedure and the World Intellectual Property Organization Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections (“the WIPO Rules for New gTLD Dispute Resolution”).

In accordance with Article 11(a) of the Procedure, the WIPO Center formally notified the Respondent of the Objection, and the proceedings commenced on April 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. In response to a notification of Response deficiency, the Respondent filed an amended Response on May 23, 2013.

The WIPO Center appointed Gabriela Kennedy as the Panel in this matter on June 17, 2013. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the WIPO Center to ensure compliance with Article 13(c) of the Procedure and Paragraph 9 of WIPO Rules for New gTLD Dispute

Resolution.

4. Factual Background

The Complainant is Defender Security Company from Indiana, United States. Since 1998, the Complainant has been in the business of marketing, selling and installing residential security systems and residential heating, cooling, ventilation and plumbing products. In addition, through its wholly owned subsidiary, Dothome Limited, it offers domain name services via its website "www.dothome.net".

The Complainant asserts in the Objection that it has the following trade mark applications and registrations ("Complainant's Marks"):

- a) European Community trade mark registration for  , registered on June 22, 2012 ("EC Mark");
- b) United States service mark registration for TRUE HOME, registered on April 1, 2008 ("TRUE HOME Mark");
- c) United States service mark application for  filed on April 3, 2012;
- d) United States service mark application for  filed on April 3, 2012;
- e) United States service mark application for TRUE HOME filed on September 5, 2012; and
- f) United States service mark application for TRUE.HOME filed on September 5, 2012.

(Trade mark applications dated April 3, 2012 and September 5, 2012 above will collectively be known as "TRUE HOME Applications".)

The Respondent is Top Level Domain Name Holdings Limited from Tortola, British Virgin Islands. The Respondent filed a trade mark application for HOME in Chile on March 30, 2013. The Respondent's purpose for the <.home> gTLD application is primarily to cater to the real estate market and the home furnishings market in the United States and world-wide.

5. Parties' Contentions

A. Complainant

The Complainant's contentions can be summarised as follows:

1. The applied-for <.home> gTLD is similar or identical to the Complainant's Marks

The Complainant contends that in assessing the similarity of the <.home> gTLD and the Complainant's Marks, account should be given to the overall commercial impression created by the marks in question, which is denoted by similarity in sight, sound and meaning.

While the Complainant's EC Mark is a composite mark, the Complainant submits that the verbal "HOME" element is dominant in the overall commercial impression of the mark. In particular, when the relevant public is looking to reserve, register, maintain or manage an Internet domain name, they would focus on the "HOME" element of the mark. As a result, the Complainant's EC Mark is identical to the applied-for gTLD in sight, sound and meaning.

In respect of the Complainant's TRUE HOME Applications and TRUE HOME Mark, the Complainant

also asserts that the “HOME” element of the marks are dominant in the overall commercial impression of the mark, making it identical in sight, sound and meaning to the <.home> gTLD.

2. The Complainant’s acquisition and use of the Complainant’s Marks is *bona fide*

The Complainant states that it has been using the Complainant’s Marks in the ordinary course of trade in a *bona fide* manner. Since December 2011, the Complainant, through its wholly owned subsidiary, Dothome LTD, has been a reseller of domains and has used the EC mark to brand its domain reservation website “www.dothome.net”.

3. There is recognition of the Complainant’s Marks in the relevant sectors

Since early 2011, the Complainant claims to have spent over USD 500,000 for expert brand research and analysis to develop its brand recognition strategies. The Complainant’s EC Mark enjoys more than 20,700 individual fans for its domain name registration services since its introduction in 2011. Further, as mentioned above, through promotion and enormous marketing efforts, the Complainant’s business is driven by over 8 billion pages of print advertising, 3 million visits to the Complainant’s websites, 7 million outbound calls and 3.5 million inbound calls to the Complainant’s call centers. The Complainant also has at least 20,000 followers on its Twitter account and over 2,700 Facebook followers worldwide.

4. The Complainant is unaware of any use of the “Home” formative by the Respondent

The Respondent does not own any trade marks for HOME, is not commonly known by the word “home”, and has not shown any use of, or demonstrable preparations to use the <.home> gTLD. The Complainant is therefore unaware of any circumstances by which the Respondent’s use of the <.home> gTLD can peacefully coexist with the Complainant’s prior rights.

5. The Respondent’s intended use of the <.home> gTLD creates a likelihood of confusion with the Complainant’s Marks

The Complainant’s Marks comprise the “HOME” formative and are used with home and domain registration services. Since the applied-for <.home> gTLD is substantially identical in sight, sound and connotation to the dominant aspect of each of the Complainant’s Marks, the Respondent’s intent to combine domain registry services with home services will create a likelihood of confusion as to the origin of the Complainant’s Mark.

The Complainant has received, and continues to receive, unsolicited inquiries for pre-registration of domain names under the <.home> gTLD. The Complainant contends that such inquiries are strongly indicative that the grant of the Respondent’s <.home> gTLD application would cause actual confusion between the services offered by the Respondent and those offered by the Complainant.

6. Complainant’s right will be harmed if Respondent is allowed its intended use of the <.home> gTLD

The Complainant has several trade mark applications and registrations incorporating or consisting essentially of the “HOME” formative. As mentioned above, the Complainant has expended a lot of time and resources in promoting and marketing its brand, all of which would be traded upon if the Respondent was allowed to register the <.home> gTLD.

As evidenced by the size of the Complainant’s business and its active social media platforms, the Respondent would take unfair advantage of the Complainant’s Mark and its reputation if the applied-for <.home> gTLD is granted.

B. Respondent

The Panel notes that the Respondent's contentions are inappropriately based predominantly on arguments under the Uniform Domain Name Dispute Resolution Policy ("UDRP"). For the purposes of evaluating the merits of the Objection, the Panel will consider the statements and documents submitted by the Respondent which are relevant to the standards defined by ICANN at Article 20 of the Procedure and Section 3.5, Module 3 of the gTLD Applicant Guidebook ("Guidebook").

The Respondent's contentions can be summarised as follows:

1. The Respondent has relevant rights on which its applied-for gTLD and Response are based

The Respondent has legitimate interests in the HOME mark by virtue of a trade mark application which was filed with the Chilean Ministerio de Economía, Fomento y Turismo on March 30, 2013 (and annexed to the Response).

The Respondent contends that the Respondent and Complainant both have competing rights for HOME, and in the case of competing marks, in the absence of bad faith, the Panel must allow both to proceed.

2. Whether the top-level domain is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights

The applied-for <.home> gTLD is not identical or confusingly similar to the Complainant's TRUE HOME Mark and TRUE HOME Applications.

The Complainant's TRUE.HOME mark reads as a domain name itself. It is a well-established rule that in making an enquiry as to whether a trade mark is identical or confusingly similar to a domain name, the domain extension, in this case <.home> should be disregarded.

3. Whether the top-level domain name has been registered and is being used in bad faith

The Respondent submits that it did not apply for the <.home> gTLD:

- a) primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, as the alleged owner of the trade mark or service mark, or to a competitor of the Complainant; or
- b) in order to prevent the Complainant from reflecting the mark in a corresponding domain name and, in connection therewith, the Respondent has not engaged in a pattern of such conduct; or
- c) primarily for the purpose of disrupting the Complainant's business as the Respondent had no knowledge of the Complainant's Marks prior to the application for the <.home> gTLD and could not have registered the <.home> gTLD with the purpose of disrupting the Complainant's business; or
- d) to intentionally attempt to attract, for commercial gain, Internet users to the Respondent's TLD, by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's TLD or of a product or service in the Respondent's TLD. Instead, the Respondent's primary purpose for applying for the <.home> gTLD is to cater to the real estate market and home furnishings / home decor market.

In addition, the Complainant's TRUE HOME Marks have been registered to promote residential security and residential heating, ventilation and cooling systems, which are not similar to the category of providing Internet services and domain name services to which the applied-for <.home> gTLD belongs.

Accordingly, the Respondent asserts that it did not apply for the <.home> gTLD in bad faith.

4. Reverse Domain Name Hijacking

The Respondent submits that the Complainant has wasted the Panel's time and the Respondent's time and money by ignoring the Respondent's trade mark. The Complainant omitted evidence of the Respondent's trade mark which is easily discoverable, which is clearly an attempt to defraud the Panel.

Further, the Respondent applied for the <.home> gTLD in good faith and in accordance with the rules set out by ICANN. The Complainant failed to assert the Respondent's bad faith or any evidence of any likelihood of confusion because it knows that no such evidence exists. As a result, the Complainant filed a frivolous Objection and the Panel should find a case of "reverse hijacking" and disallow the Complainant's application for the <.home> gTLD.

6. Discussion and Findings

A. Burden of proof

Section 3.5 of the Guidebook provides that the Complainant bears the burden of proof in each case. The Complainant has to satisfy the Panel that the potential use of the <.home> gTLD by the Respondent:

- i. takes unfair advantage of the distinctive character or the reputation of the Complainant's registered or unregistered trade mark or service mark; or
- ii. unjustifiably impairs the distinctive character or the reputation of the Complainant's mark; or
- iii. otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the Complainant's mark.

On page 67 of the New gTLD Draft Applicant Guidebook Version 3 – Public Comments Summary and Analysis, it is noted that there is a presumption generally in favour of granting new gTLDs to applicants who can satisfy the requirements for obtaining a gTLD. Hence, there is a corresponding burden upon a party that objects to the gTLD to show why that gTLD should not be granted to the applicant.

In *Express, LLC v. Sea Sunset, LLC*, WIPO Case No. LRO2013-0022, the complainant, who operated clothing retail stores, objected to the application of the <.express> gTLD. Despite having rights for its EXPRESS mark all over the world dating back to 1979, the objection was denied on the basis that "express" was a common dictionary word in the English language with a number of possible meanings that had no reference to clothing and apparel, and the respondent had at least a reasonable argument that it had chosen the gTLD because of its dictionary meaning. The presumption in favor of granting the new gTLD was exercised.

Similarly, in *I-Registry Ltd v. Vipospace Enterprises LLC*, WIPO Case No. LRO2013-0014, the complainant was found to have registered rights in the "VIP" mark. Nonetheless, the objection of a <.vip> gTLD string was denied on the basis that the <.vip> gTLD identifier is seen as a descriptive indication of a "Very Important Person", rather than a trade mark. As a result, the panel concluded that even though the complainant had trade mark rights to VIP, its relevance was outweighed by the descriptive quality of the term.

In this case, the sign in question is "home", which has a common meaning of house, apartment, shelter, residence or abode. Consequently, the Panel must be satisfied by the Complainant's arguments and evidence that the mark has been sufficiently used in trade to the extent that it displaces the primary descriptive meaning of the term.

In addition, the use of the terms “unfair,” “unjustifiably,” and “impermissible” as modifiers, respectively, of “advantage,” “impairs,” and “likelihood of confusion” in Section 3.5.2 of the Guidebook 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 Respondent were granted the applied-for gTLD (*Right At Home v. Johnson Shareholdings, Inc.*, WIPO Case No. LRO2013-0030 and *Limited Stores, LLC v. Big Fest LLC*, WIPO Case No. LRO2013-0049).

In view of the above, the Panel is of the opinion that in order to succeed in this Objection, the Complainant has to clear a high bar.

B. Standing to object

Section 3.2.2.2 of the Guidebook gives a rights holder standing to file a legal rights objection. According to Section 3.2.2.2, the source and documentation of the existing legal rights the objector is claiming are infringed by the applied-for gTLD must be included in filing. This may include registered or unregistered trade marks. Accordingly, the Complainant must satisfy the Panel that it has relevant existing legal rights in the sign corresponding to the applied-for gTLD string.

i) EC Mark

The Complainant asserts that it is the parent company of Dothome LTD, the registered owner of the EC Mark. However, the Complainant has not submitted any evidence to prove its relationship with Dothome LTD. The Panel has conducted a Whois search for < dothome.net>, which the Complainant alleges is registered by Dothome LTD, and has found that the domain name is registered by a proxy service. As a result, the Panel was not able to determine who the actual registrant is nor was the Panel able to ascertain Dothome LTD’s affiliation with the Complainant. The Panel considers that the Complainant has failed to meet a minimum standard of proof required to prove it has rights in the EC Mark.

ii) TRUE HOME Applications

The Panel is satisfied from the evidence that the Complainant has valid applications for the TRUE HOME Applications in the United States. Since no registrations have been issued for these marks, the Complainant would have to rely on common law rights in order to claim rights in the TRUE HOME Applications (see *Gen. Healthcare Ltd. v. Qashat*, 364 F.3d 332, 335 (1st Cir. 2004) and *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918), which establishes that the common law right to a particular mark is conditioned upon use in commerce).

Is the use of the TRUE HOME Applications in commerce sufficient enough to establish unregistered or common law rights in the marks? The Complainant cites *Aycock Engineering, Inc. v. Airflite, Inc.*, No. 08-1154 (Fed. Cir. Mar. 30, 2009), ECJ Case C-40/01 *Ansul v Ajax*, paragraph 36 and C-234/06 P II *Ponte Finanziaria v OHIM*, paragraph 72 in support of the fact that its use of the above-mentioned marks occurred in the ordinary course of trade and is not merely a token use.

The Panel has examined the cases on “use in commerce” cited by the Complainant and notes that the threshold to establish use in commerce is high. In *Aycock Engineering, Inc. v. Airflite, Inc.*, No. 08-1154 (Fed. Cir. Mar. 30, 2009), it was held that for service marks, the “use in commerce” requirement is met when (1) a mark is “used or displayed in the sale or advertising of services” and (2) either (i) the services are “rendered in commerce” or (ii) the services are “rendered in more than one State or in the United States and a foreign country and the person rendering those services is engaged in commerce in connection with the services.” Further as explained in paragraph 36 of ECJ Case C-40/01 *Ansul v Ajax* and paragraph 72 of C-234/06 P II *Ponte Finanziaria v OHIM*, “genuine use” must not merely be token use solely to preserve rights conferred by the mark. It must be used to guarantee the identity of

the origin of goods or services and distinguish the product and service from another origin without confusion.

The Complainant contends that it has heavily marketed itself through all channels of media, including direct mail, broadcast and the Internet such that the relevant public will immediately associate the Complainant's marks with its home services and domain name services. However, the Panel notes that the Complainant has failed to produce any documentary evidence that these marks have been used in commerce. In order to satisfy the requirement that the TRUE HOME Applications have been used in commerce, the Panel expects to see evidence such as samples of sale or advertising material, sales and financial figures, length and amount of sales under the trade marks, the nature and extent of advertising, consumer surveys and media recognition. The Panel also conducted a general Google search and was unable to find results relating to the Complainant's TRUE HOME Applications.

Consequently, the Complainant has failed to establish that it has unregistered or common law rights to the TRUE HOME Applications for the purposes of this procedure.

iii) TRUE HOME Mark

As evidenced by the trade mark registration certificate submitted by the Complainant, it appears that the United States TRUE HOME Mark was initially registered on April 1, 2008 by an individual named Carl Simpson in Texas, United States. Upon review of the United States Patent Trademark Office trade mark database, the Panel confirmed that the TRUE HOME Mark was assigned to the Complainant on August 29, 2012. Accordingly, the Panel is satisfied that the Complainant has rights to the TRUE HOME Mark for the purposes of bringing these proceedings. The validity and weight placed on this mark will be further discussed below.

C. Consideration of non-exclusive factors in Section 3.5.2 of the Guidebook

In addition to the above, the Panel is required to 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 Complainant's existing mark.

As mentioned above, the Complainant has not persuaded the Panel on the basis of its submissions that it has established rights in the EC Mark and TRUE HOME Applications. However, the Complainant has shown that it has rights in the TRUE HOME Mark by virtue of its assignment on August 29, 2012. For the sake of completeness, the Panel will briefly discuss whether or not all the marks submitted by the Complainant are identical or similar, including in appearance, phonetic sound, or meaning to the <.home> gTLD.

The Panel accepts that the <.home> gTLD is similar to the Complainant's EC Mark. The Complainant's EC Mark is a composite mark consisting of a cartoon house figure inside a speech bubble with ".HOME" displayed prominently next to it. Although visually the EC Mark is not similar to the <.home> gTLD, the Panel is of the view that the ".HOME" alphabet element of the mark is identical in sound and meaning. The Panel refers to *DotTunes Limited v. Amazon EU S.a.r.l.*, WIPO Case No. LRO2013-0065 where it was held that the <.tunes> applied-for gTLD is similar phonetically but not visually to the Complainant's composite mark consisting of a figure wearing headphones with the term ".TUNES" next to it.

The TRUE HOME Applications and TRUE HOME Mark are composite and word marks. They are found to be similar to the <.home> gTLD only in the sense that the word "home" is present.

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

The Panel is not satisfied that the acquisition and use of the Complainant's TRUE HOME Mark has

been *bona fide*.

The Complainant submits that it has been using the Complainant's Marks, including the EC Mark, TRUE HOME Applications and TRUE HOME Mark, in relation to its home and domain name services since 1998. The Complainant alleges that the Complainant's business is driven by over 8 billion pages of print advertising, 3 million visits to the Complainant's websites, 7 million outbound calls and 3.5 million inbound calls to the Complainant's call centers. The Complainant claims to have at least 20,000 and 2,700 followers on its Twitter and Facebook account respectively from all over the world for its domain name registration services.

The Panel notes that, aside from these mere allegations, the Complainant has not provided any evidentiary proof that the Complainant's Marks have been used extensively and heavily promoted. In addition, the Panel asserts that the chronology of events is important in determining whether a trade mark application or registration was made or obtained merely to bolster the Complainant's Objection or to defend an application.

A brief examination of the key dates casts doubt as to whether the Complainant's Marks have been acquired and used in a *bona fide* manner:

Date	Event
December 29, 2011	<dothome.net> domain name is registered
December 30, 2011	Complainant files EC Mark application
January 12, 2012	Application period for new gTLD string opens
April 3, 2012	Complainant files two applications for TRUE.HOME composite marks with USPTO
June 13, 2012	Respondent's and Dothome LTD's application for <.home> gTLD published
June 22, 2012	EC Mark registered
August 29, 2012	TRUE HOME Mark assigned to Complainant from an individual named Carl Simpson
September 5, 2012	Complainant files applications for TRUE HOME and TRUE HOME with USPTO
March 13, 2012	Complainant files Objection against Respondent's <.home> gTLD application

The Panel finds the Complainant's timing of the EC Mark application suspicious as it was merely two weeks before the new gTLD application period opened. In addition, the Complainant's repeated assertion that the first use of the TRUE HOME Mark dates back to 2006 is unconvincing and misleading, especially since the Complainant was not assigned rights to the TRUE HOME Mark until August 2012 (a fact that the Complainant omitted to mention). The timing of the applications together with the lack of evidence showing use of the Complainant's Marks has raised suspicion in relation to the *bona fide* of this acquisition and use (see also *Defender Security Company v. Charleston Road Registry Inc.*, WIPO Case No. LRO2013-0032). The Panel considers that the Complainant only acquired rights in the Complainant's Marks for the sole purpose of filing an Objection or defending an application for a <.home> gTLD string.

The "www.dothome.net" website displays a footer stating "©2009-2012 dotHOME (.HOME) Generic Top-Level Domain Name (gTLD) Extension Web Address - dot.HOME TLD". Given that the <dothome.net> domain name was not established until December 29, 2011 and by the Complainant's own submission that it only started its DotHome services in 2011, the Panel is of the view that the Complainant is attempting to mislead the public into believing it has had rights in the Complainant's Marks since prior to 2011. Moreover, the Panel is not convinced by the Complainant's contention that domain name registration services are a natural extension of its residential security, heating, cooling, ventilation and plumbing services.

Given the above, the Panel is of the view that the Complainant's Marks were not acquired or used in a *bona fide* manner.

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 Complainant, of the Respondent or of a third party.

As discussed above, there is nothing before the Panel beyond mere assertions to show that the Complainant's Marks, the Respondent's Chilean application for HOME, or any third-party rights corresponding to the <.home> gTLD are recognized by the public.

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

The Panel notes that the Respondent has made approximately 70 applications for gTLD strings including <.app>, <.beauty>, <.blog>, <.cloud>, <.data> and <.property>. Since the applications made appear to largely, if not entirely, consist of generic terms, and the Complainant has not asserted otherwise, the Panel does not find that the Respondent has engaged in a pattern of conduct whereby it applies for gTLDs which are identical or confusingly similar to the mark of others. The Panel finds nothing in the record to question that the Respondent's intent in applying for the <.home> gTLD is anything other than what it has asserted in its Application, namely, to serve the real estate market and the home furnishings/home décor market.

The Panel also does not accept that the Respondent would have had any knowledge of the Complainant's Marks because at the time the applications for the <.home> gTLD were announced on June 13, 2012, the Complainant did not have any registered marks comprising the word "home".

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

The Panel has not been provided with any evidence by the Respondent to illustrate that it has used, or has made demonstrable preparation to use the .HOME sign corresponding to the <.home> gTLD. Despite the lengthy submission in section 18 of the Respondent's Application regarding the Respondent's purpose for obtaining the <.home> gTLD and the potential benefits it may bring to Internet users, the Panel finds that this is merely descriptive and is not persuasive enough to convince the Panel that the Respondent has used, or has expended time and resources in preparation of use, the <.home> gTLD. In any event, the sign the Respondent is relying on is a common dictionary term and the Panel is of the opinion that the relevant public would not immediately associate such dictionary term with the Complainant's Marks. Accordingly, the Panel finds the Respondent's preparations to use the <.home> gTLD are unlikely to interfere with the Complainant's trade mark rights.

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

The Respondent's claim regarding their trade marks or other intellectual property rights in the HOME sign is not persuasive.

The Panel notes that at the time of the publication for the Application for the <.home> gTLD, the Respondent did not have any trade mark applications or registrations for the .HOME or HOME mark. It was only after the Respondent received the Complainant's Objection on March 13, 2013 (together with the many objections filed by unrelated third parties), that the Respondent submitted a trade mark application to the Ministerio de Economía, Fomento y Turismo in Chile on March 30, 2013 for HOME. In the Panel's view, a trade mark application made subsequent to notice of the dispute may be indicative of a lack of *bona fide* acquisition and use of the sign.

Further, the Panel considers that the connection, or lack of it, between the Respondent and the jurisdiction in which trade mark registration is sought, may indicate whether the trade mark application or registration is *bona fide*. Here, the Respondent had no reason to file a trade mark application in Chile given that it does not appear to be located in Chile and has not shown plans of making *bona fide* use of the mark in commerce in Chile.

As a result, the Panel finds that the mere application of a trade mark in Chile after notice of the Objection is insufficient to justify a determination under this factor that the Respondent has rights to a sign corresponding to the <.home> gTLD.

In any event, the Panel does not find this factor particularly relevant in its analysis.

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

The Respondent has not provided any evidence showing it has been commonly known by ".home" or "home".

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

Given the limited use demonstrated by the Complainant of the sign corresponding to the <.home> gTLD, the Panel does not find that the Respondent's intended use of the <.home> gTLD would create a likelihood of confusion with the Complainant's Marks as to source, sponsorship, affiliation or endorsement of the applied-for gTLD.

D. Reverse Domain Name Hijacking

The Legal Rights Objection mechanism does not relate to domain name disputes under the UDRP, but to applications under ICANN's New gTLD Program. Accordingly, an argument of reverse domain name hijacking is irrelevant and will not be considered by the Panel. Furthermore, the Complainant is not required to show that the Respondent has made the application for the <.home> gTLD in bad faith.

7. Decision

Taking into account the abovementioned factors, the Panel rejects the Objection because the potential use of the applied-for gTLD by the Respondent does not:

- i. take unfair advantage of the distinctive character or the reputation of the Complainant's registered or unregistered trade mark or service mark; or
- ii. unjustifiably impairs the distinctive character or the reputation of the Complainant's mark; or
- iii. otherwise create an impermissible likelihood of confusion between the applied-for gTLD and the

Complainant's mark.

[signed]

Gabriela Kennedy
Sole Panel Expert
Date: August 8, 2013