

## **EXPERT DETERMINATION LEGAL RIGHTS OBJECTION**

planet.ECO, LLC v. Top Level Domain Holdings Limited  
Case No. LRO2013-0053

### **1. The Parties**

The Objector/Complainant (“Objector”) is planet.ECO, LLC of Stamford, Connecticut, United States of America, represented internally.

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

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

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

### **3. Procedural History**

The Legal Rights Objection was timely filed with the WIPO Arbitration and Mediation Center (the “WIPO Center”) on March 14, 2013 pursuant to the New gTLD Dispute Resolution Procedure (the “Procedure”). In response to a notification from the WIPO Center that the Objection was deficient, the Objector filed an amended Objection with the WIPO Center on March 20, 2013.

In accordance with Article 9 of the Procedure, the WIPO Center completed the review of the amended Objection on March 22, 2013 and has determined that the amended 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 18, 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 18, 2013. In response to a notification from the WIPO Center that the Response was deficient, the Applicant/Respondent filed an amended Response with the WIPO Center on May 23, 2013.

The WIPO Center appointed Luca Barbero as the Panel in this matter on June 14, 2013. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of

Impartiality and Independence, as required by the WIPO Center to ensure compliance with Article 13(c) of the Procedure and Paragraph 9 of WIPO Rules for New gTLD Dispute Resolution.

By procedural order made on July 26, 2013, the deadline for the Panel to give its decision was extended by 14 days, to August 14, 2013. By a subsequent procedural order, the due date for decision was extended to August 26, 2013.

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

The following facts are based on the parties' allegations, the documentary evidence submitted by the parties, the Panel's review of public documents available through the United States Patent and Trademark Office ("USPTO") Trademark Electronic Search System ("TESS") database, and the Panel's review of the parties' <.eco> gTLD applications as posted on the Internet Corporation for Assigned Names and Numbers ("ICANN") web site.

##### The Objector

According to the Objector's allegations, the Objector is an American company which was created to provide a global web platform that promotes and supports international sustainability efforts across the globe. The Objector states that "eco" is instantly and globally recognizable as being synonymous with the ecology and economy, as it relates to interactions between organisms and their environment.

The Objector is the owner of a trademark registration for .ECO, filed on April 20, 2008 before the USPTO with the number 3716170 and registered on November 24, 2009, for the following services in class 42: "Design, creation, hosting and maintenance of Internet sites for third parties; Hosting of digital content on the Internet; Providing specific information as requested by customers via the Internet". The first use date according to the trademark certificate is December 2, 2008, and the first use in commerce date is September 18, 2009.

The Objector asserts that Moses Boone, one of the partners of planet.ECO, LLC, initially applied for the trademark .ECO "to be used in the green travel event and planning industry on April 20, 2008" and states that the "original idea was to create a unique trademark that would provide products and services for entities that are seeking hosting, website and Internet services", with the desire "to bridge the gap between the real world and the virtual world".

The Objector's mark .ECO was subject of cancellation proceedings (USPTO 92051924 and 92055469) and of one legal action (California Civil Court Case CV12-1812-PA), all of which were dismissed without prejudice.

The Objector applied to ICANN, in terms of ICANN's New gTLD Program, for permission to operate the gTLD string <.eco>.

As to its application for the new gTLD <.eco>, the Objector asserts that it will promote responsible human interaction with the environment and provide a niche Internet informational platform focused on collaborative environmental stewardship and sustainability. The Objector further states that the availability of <.eco> domains will create a sense of inclusivity, community, and specificity for online participants in the green/sustainability sector that is not presently available through existing available domain names.

##### The Applicant and the applied-for string

The Applicant is a private company that applied to ICANN for the license to manage the gTLD string <.eco>.

The Applicant applied also for 70 new gTLDs, including the following: <.home>, <.book>, <.blog>, <.deals>, <.fashion>, <.green>, <.style>, <.vip>, <.sale>, <.website>, <.inc>, <.hotel>.

The Applicant's application for the <.eco> string ("the Application") was originally posted on June 13, 2012, under Application ID: 1-1039-91823.

In the section 18(a) of the Application, describing the mission/purpose of the proposed gTLD, the Applicant stated:

"The .ECO top-level domain will benefit concerned companies and individuals who wish to either rebrand under .ECO, or use the suffix to showcase what they are doing for the environment. As with .ORG, we feel that .ECO should not be run with an authoritative view on who is "eco" and who is not, but rather as a self-selecting badge for companies and customers who genuinely care about the environment (...) The .ECO top-level domain will offer businesses and people the opportunity to advertise their association with environmentally-friendly products, services, and materials through the purchase and use of a .ECO top-level domain. The .ECO domain is dedicated to accurate information about green, sustainable, and eco-friendly products, allowing customers to make informed decisions about the items they use, and helping to drive the positive image of green products and their benefits to the environment".

If the Application proceeds to delegation, registrations of ".eco" second-level domain names will be available to all registrants on an "open" basis, except during the mandatory Sunrise period.

In section 29 of the Application, the Applicant states that it has developed a series of mechanisms intended to prevent infringing registrations and to identify and address the abusive use of registered domain names, including, besides the mandatory ICANN Rights Protection Mechanisms ("RPM"), a "Naming Policy, which defines which names can be registered, and by whom; the Acceptable Use Policy, which describes permitted and non-permitted uses of registered names; the Whois and Privacy Policy, which helps registrants understand what we can and cannot do with their personal data; and the Complaint Resolution Services".

On March 30, 2012, the Applicant also filed a trademark application in Chile for ECO (word mark), in class 42.

## **5. Parties' Contentions**

### **A. Objector**

The Objector states that, with "the advent and discovery of global warming and the melting of the poles in the [N]orth and the [S]outh, as water levels rose and droughts manifested themselves in different parts of the [E]arth, a pool of collective consciousness swept the [E]arth and coagulated in an undeniable effort to inspire others to save the [E]arth. Thus, the words 'green' and 'clean' took on a new meaning where caring for the [E]arth was concerned." The Objector thus became a part of this movement.

The Objector asserts that its trademark .ECO has met every requirement of trademark protection, including the support of continuous use and sustained growth over the past several years.

In particular, the Objector argues that, upon the registration of its trademark .ECO with the USPTO, it continued its mission toward the refinement and constant updating of its Internet service provider and platform entitled "planet.ECO, LLC" and beginning recruitment of consumers and clients into its .ECO platform.

As to the use of its trademark, the Objector states that, since the registration was granted, in 2009, there has not been a day gone by where it has not done everything possible in furtherance of the mission and goal of protecting the .ECO trademark, and asserts that it has registered hundreds and thousands of members, through social media and other means, in an effort to persuade the public of the importance of saving the planet through ecological consciousness and care. The Objector further states that its multi-layered platform allows members an opportunity to participate in online newsreels, blogs, opinions, surveys and other

miscellaneous activities as part of the .ECO consumer base and that this association may have a positive ring among consumers, clients and the customer base of those entities. According to the Objector, this effect, multiplied by the advent of many new Top Level Domains (TLD's), would result in increased competition among the existing registration providers, as it will create a need to compete more freely for the remaining business interest in their existing TLDs, with many new organizations offering registration of new TLD domain names.

The Objector also alleges that its trademark .ECO satisfies the use component of the post 1989 registration requirement or the Lanham Act for federal protection as a trademark and states that it continued to improve and build upon its model and practice by encouraging new memberships to its platform and through interstate exchange and involvement with consumers electronically and otherwise, making efforts to maintain, sustain and continue to grow its customer base through solicitation and the dissemination of information and materials germane to the .ECO domain and planet.ECO, LLC platform. The Objector states that its customer base has grown throughout the period of the trademark registration and that it operated an interstate commerce activity and exchange throughout the period of registration as well.

The Objector additionally claims that its trademark has satisfied any and all rules of transport in commerce through the dissemination of information and materials through its company.

In order to keep its United States trademark registration live, the Objector states that it plans to file a Declaration of Continued Use in the sixth year of the registration, as well as a Declaration of Continued Use and Incontestable Status for the .ECO registration and trademark, and to file a renewal application during the tenth year of the current registration. The Objector also states that it is the only company with such or similar designation and registration in the United States.

The Objector contends that, since it owns a registered trademark .ECO issued by the USPTO, it is best suited to serve and protect the integrity of ICANN and that the Objector represents a genuine and authentic opportunity for legitimate and committed individuals who are dedicated to the proposition of making the Internet and the world a better place rather than making money as the sole primary concern. The Objector underlines that its proponents have worked on its social platform for a number of years increasing their knowledge, skill, user base and expertise in the broad spectrum of Internet use.

The Objector highlights that it owns the only registered .ECO trademark issued by the USPTO, and reiterates that all challenges to its trademark have been defeated, twice with the USPTO and once in the court system. The Objector therefore asserts that, as a result, it would be in the best position of all else to secure and serve ICANN and its intended beneficiaries throughout the world in an honest, genuine and respectful manner.

The Objector emphasizes that with the advent of the license granted by ICANN, its gTLD <.eco> "can embark on a new sojourn filled with endless possibilities coupled with a consciousness around the globe in support of its platform", the vision for .ECO being expansive and its applications and ancillary uses endless.

The Objector underlines that new gTLD strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law and concludes that, since the Objector's trademark is first in time, the Applicant's trademark creates confusion in the marketplace.

The Objector contends that it has standing under the Procedure and submits that the potential use of the applied-for gTLD by the Respondent (i) takes unfair advantage of the distinctive character or the reputation of the Objector's registered mark; (ii) unjustifiably impairs the distinctive character or the reputation of the Objector's said mark; and (iii) creates an impermissible likelihood of confusion between the applied-for gTLD and the Objector's said mark.

## B. Applicant

The Panel notes, as other panel have found in legal rights objection proceedings involving this same Applicant, that the Applicant appears to have mistakenly applied principles and arguments under the Uniform Domain Name Dispute Resolution Policy (“UDRP”) which are not relevant to this proceeding. See *I-Registry Ltd v. Top Level Domain Holdings Limited*, WIPO Case No. LRO2013-0018, and *Defender Security Company v. Top Level Domain Holdings Limited*, WIPO Case No. LRO2013-0037. Pursuant to Article 20(b) of the Procedure, the Applicant’s contentions will be considered to the extent that such are relevant to the Panel’s considerations.

The Applicant states that it has legitimate interests in the sign corresponding to the new gTLD applied-for by virtue of its trademark application for ECO in Chile and of its application for the new gTLD <.eco>.

The Applicant claims that both the Applicant and the Objector have rights in the trademark ECO, that the Applicant has rights and legitimate interests in the top-level domain <.eco> and there has been no bad faith on its part.

The Applicant informs the Panel that it has a business model centered around establishing and running top-level domains, of which <.eco> is one, and highlights that its purpose in applying for the gTLD <.eco> is to “benefit concerned companies and individuals who wish to either rebrand under .ECO, or use the suffix to showcase what they are doing for the environment” (as stated in section 18 of its Application). The Applicant contends that this is a legitimate use of the term “eco” and is not an illegitimate use of the Objector’s mark. As an additional argument supporting its legitimate interests in the gTLD <.eco>, the Applicant states that it has been planning and marketing this prospective gTLD since 2007, when the Applicant formed a subsidiary, Doteco LLC, to market the <.eco> gTLD; this included also a Facebook page which was removed pursuant to an asserted violation of the Objector’s trademark rights in 2009, but was later restored.

As to the Objector’s allegation that it intends to “provide products and services for entities [...] seeking hosting, website, and Internet services”, the Applicant observes that top-level domains are not hosting or website services and are not Internet services within the common meaning of the term, as illustrated by the fact that the USPTO does not allow them to be registered as trademarks and by the fact that the North American Industry Classification System (“NAICS”), a common breakdown of industry categories, has no category for the provision of registry services.

Regarding the Objector, the Applicant asserts that the Objector “has a history of harassing [it] with frivolous law suits. The most recent of which, in 2012, alleged trademark infringement, false designation, counterfeiting, cybersquatting, and unfair competition under various state and federal laws. [The Applicant] answered with the affirmative defenses of laches, acquiescence, waiver, and estoppel, among others, and counterclaimed for cancellation of [the Objector’s] mark on various grounds. This objection is merely the latest”.

The Applicant states that the applied-for top-level domain <.eco> is not identical or confusingly similar to the Objector’s alleged trademark planet.ECO as the string applied for by the Applicant, “eco”, is only one-third of the Objector’s trademark Planet.ECO.

The Applicant contends that the Objector does not have a valid trademark for .ECO, since the United States Patent and Trademark Office (“USPTO”) does not grant trademarks rights in top level domain names where they are non-source indicating. The Applicant also alleges that, to be valid under United States patent law, the mark would have to be used by the Objector to indicate “ecology and economy” and not “hosting, website and Internet services”. The Applicant confirms that it previously sought to invalidate the Objector’s trademark registration but the invalidation was withdrawn voluntarily by the Applicant as part of the dismissal of the Objector’s most recent action against the Applicant.

The Applicant argues that the Objector has previously attempted to prevent it from applying for the TLD <.eco> through ICANN but, however, neither party prevailed, since the matters were dismissed without admission of liability rather than being decided on their merits.

The Applicant highlights that the Objector did not state that the Applicant applied for the TLD <.eco> in bad faith and contends that there was no bad faith on the Applicant's part, based on the following circumstances:

- i) The gTLD <.eco> was not registered by the Applicant in an intentional attempt to attract, for commercial gain, Internet users to the Applicant's gTLD, by creating a likelihood of confusion with the Objector's mark as to the source, sponsorship, affiliation, or endorsement of the Applicant's gTLD or of a product or service in the Applicant's gTLD, since the Applicant's business model is to establish and run top level domains and the Applicant plans to market and sell second level domains in the <.eco> TLD namespace;
- ii) the Applicant's intended use of the gTLD <.eco>, as highlighted in the Application, in response to ICANN's Question 18, is directed to "companies and individuals who wish to either rebrand under .ECO, or use the suffix to showcase what they are doing for the environment";
- iii) the Applicant did not submit an application for the gTLD <.eco> primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Objector, as the alleged owner of the trademark or service mark, or to a competitor of the Objector;
- iv) ICANN's rules for applications for gTLDs in this round allowed anyone to apply for gTLDs as long as they met certain technical and financial criteria;
- v) ICANN procedures specifically allowed for multiple gTLD applications for all gTLDs, including <.eco> (which was applied by the Applicant and two additional third parties in addition to Respondent);
- vi) the gTLD <.eco> was not applied for by the Respondent primarily to disrupt the Objector's business.

The Applicant furthermore indicates that the Objector has caused financial harm to the Applicant by filing a frivolous Objection in bad faith. Therefore, the Applicant requests that the Panel find a case of reverse hijacking and disallow the Objector's application for the gTLD <.eco> from proceeding.

## **6. Discussion and Findings**

### **A. The Standing Requirement**

A Legal Rights Objection refers to the objection that the string comprising the potential new gTLD infringes "the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law" (Article 2(e)(ii) of the Procedure).

Article 20 of the Procedure provides the standards the Panel may adopt in examining a Legal Right Objection:

- (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."

The grounds on which an Existing Legal Rights Objection may be made are set out in full in Module 3 of the ICANN gTLD Applicant Guidebook (v. 2012-06-04) Module 3 (the “Guidebook”), and are based upon the Final Report on the Introduction of New Generic Top-Level Domains dated August 8, 2007, issued by the ICANN Generic Names Supporting Organization (GNSO).

The definition of what constitute “existing legal rights” is provided at Section 3.2.2.2 of Guidebook, where it stated that “[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” (emphasis added).

## **B. Objector’s Standing to File the Objection**

The Procedure is silent regarding the relevant date on which the Objector must have acquired “existing rights” for the purposes of establishing standing. In *AC Webconnecting Holding B.V. v. Dot Agency Limited*, WIPO Case No. LRO2013-0007, the Panel considered the date of the filing of the Objection, while in *Starbucks (HK) Limited v. One.com A/S*, WIPO Case No. LRO2013-0028 it was stated: “[i]n the Panel’s view ‘existing legal rights’ means rights that exist at the time that the application for the gTLD under objection is filed”.

In the case at hand, the Objector relies on asserted trademark rights in the mark .ECO based on a trademark registration granted by the USPTO prior to both the above-mentioned dates. As indicated in Section 4, the Objector is the owner of the United States trademark registration No. 3716170 for .ECO, filed on April 20, 2008 and registered on November 24, 2009, for the following services in class 42: “Design, creation, hosting and maintenance of internet sites for third parties; Hosting of digital content on the Internet; Providing specific information as requested by customers via the Internet”. The Objector claimed first use on December 2, 2008, and first use in commerce as of September 18, 2009.

The Panel acknowledges the Applicant’s objections regarding this trademark registration and has reviewed the documents related to the trademark registration process and the cancellation proceedings which involved the trademark, all of which, as mentioned previously, have been terminated without prejudice.

The Panel notes that, according to the United States Trademark Act and the guidelines provided in the Trademark Manual of Examining Procedure (TMEP Section 1215.02(d)), when a trademark or service mark is composed, in whole or in part, of a domain name, the top level domain should not be held as having a source-indicating significance and, if a trademark consisting only of a top level domain is filed solely for domain name registry services, a trademark registration may be refused under Trademark Act §§1, 2, 3, and 45, 15 U.S.C. §§1051, 1052, 1053, and 1127, on the ground that the TLD would not be perceived as a mark.

Therefore, to the extent that the mark .ECO referred to a gTLD <.eco>, the mark would likely have been considered descriptive of the registry services. However, in the case at hand, the Panel finds that the mark .ECO is not necessarily merely descriptive with respect to the services for which the mark is registered, as the “.eco” term does not describe any of the above-mentioned services (see, along these lines, *TLDDOT GmbH v. InterNetWire Web-Development GmbH*, WIPO Case No. LRO2013-0052).

The Panel also considers that, while a United States trademark registration is entitled to a presumption of validity (as underlined, amongst others, in *Latin American Telecom, LLC v. Charleston Road Registry Inc.*, WIPO Case No. LRO2013-0055), in the United States jurisdiction, it is not registration that confers rights in a trademark, but its use.

In the case at hand, the Objector has not produced convincing material evidence of use of .ECO in trade or commerce to identify the services covered by its trademark registration, except for the statements that, upon registration of the mark, it “continued to improve and build upon its model and practice by encouraging new memberships to the platform and through interstate exchange and involvement with consumers electronically and otherwise” making efforts to “maintain, sustain and continue to grow its customer base through

solicitation and the dissemination of information and materials germane to the .ECO domain and [the Objector's] platform".

The Panel has reviewed the Objector's site, where it is currently stated that the Objector "has a mission to shed light on any activity which promotes the green/sustainability sector and responsible stewardship of our planet by, INCLUSIVELY, providing .ECO domain designations around the world"; where two links published on the home page redirect, respectively, to another site of the Objector, "<http://www.dot-eco.com/>", where web hosting services are offered, besides domain name registration services, and to the Objector's Facebook page "PlanetDotEco", created in 2011, where information about environmental and social efforts are provided and it is stated – in the "About us" section – that the Objector's company was created to "provide an Internet platform where those who are concerned about our planet can connect, engage, and find goods and services that promote sustainability".

The Panel also notes that, according to the documents made available through the Trademark Status & Document Retrieval (TSDR) of the USPTO web site, the Objector's predecessor in right, in response to an Office Action stating that the specimen enclosed to the Statement of Use was not acceptable, as it was "merely a photocopy of the drawing or a picture or rendering of the applied-for mark and does not show the applied-for mark in actual use in commerce", submitted a new specimen, consisting of pages from the Objector's web site "[www.thedoteco.com](http://www.thedoteco.com)", including "the mission page, the why .eco, the birth of .eco, and faqs", with a notation that: "[t]he website is being used to solicit investors and support prior to application to ICANN for a new environmental domain extension. <https://sites.google.com/a/thedoteco.com/doteco/start-page>". A notice of acceptance of the Statement of Use was then issued by the USPTO on October 22, 2009.

The Panel additionally notes that the cancellation proceedings that involved the mark and were based on various grounds (the entitlement of the Objector's predecessor in right to be the owner of a trademark since it was not a registered company; the generic or descriptive character of the mark; the alleged non use of the mark in connection with the registered services), were not decided on the merits as they were terminated without prejudice.

The Panel is mindful that, as held in *Latin American Telecom, LLC v. Charleston Road Registry Inc.*, WIPO Case No. LRO2013-0055, "[t]he Panel serves upon appointment by the Dispute Resolution Service Provider (here, the WIPO Center)" and that "the Panel's authority is governed principally by the Procedure. The Panel is not a court of law; its 'jurisdiction' is limited".

In view of the fact that the registration of the mark .ECO was confirmed by the United States Patent and Trademark Office (with assignment recorded), in the absence of a judicial determination on the asserted invalidity of the trademark alleged by the Applicant and other third parties, and considering that the weaknesses of the Objector's claim for standing would in any case be relevant in the assessment of the merits of the present case, the Panel finds that the Objector has standing for the purpose of this proceeding.

### **C. Grounds for upholding a Legal Rights Objections**

The "standards defined by ICANN" referred to in Article 20(a) of the Procedure are set out in Section 3.5 ("Dispute Resolution Principles (Standards)") of Module 3 ("Dispute Resolution Procedures") of the Guidebook. The standards in relation to Legal Rights Objections are indicated in Section 3.5.2, where it is stated that "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 IGO name or acronym (as identified in the treaty establishing the organization), or *unjustifiably impairs* the distinctive character or the reputation of the objector's mark or IGO name or acronym, or otherwise creates an *impermissible likelihood of confusion* between the applied-for gTLD and the objector's mark or IGO name or acronym" (emphasis added).

To determine whether the existing legal rights of the Objector are being infringed, the Panel is required to consider eight non-exclusive factors, which are listed in the same article of the Guidebook and will be analyzed in Section 6D of this decision.

With reference to the interpretation of the italicized words in the first paragraph of this section, the Panel in *Right At Home v. Johnson Shareholdings, Inc.*, WIPO Case No. LRO2013-0030 stated that “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 Applicant, or something intolerable in the state of affairs which would obtain if Applicant were permitted to keep the String in dispute”.

This interpretation was seconded by a number of panels in several legal rights objection cases, including *Limited Stores, LLC v. Big Fest LLC*, WIPO Case No. LRO2013-0049, *Defender Security Company v. Lifestyle Domain Holdings Inc.*, WIPO Case No. LRO2013-0035, *The Canadian Real Estate Association v. Affiliis Limited*, WIPO Case No. LRO2013-0008, and *Pinterest, Inc. v. Amazon EU S.a.r.l.*, WIPO Case No. LRO2013-0050.

The panel in *Defender Security Company v. Baxter Pike LLC*, WIPO Case No. LRO2013-0031 interpreted these clauses as requiring a demonstration of bad faith on the part of the Applicant, as it stated: “[w]hile not creating bright lines (quite the opposite, in fact), these terms imply some malfeasance on the applicant’s part or obvious adverse impact upon the objector’s mark. To this Panel’s way of thinking the italicized words, in the context of the new gTLD process, require a showing of systemic or regular confusion that would be found actionable under applicable trademark law. Stated differently, an objector would need to show that all or most, or perhaps an identifiable and substantial subset, of the names to be registered under the applied-for string would give rise to a colorable claim for infringement or unfair competition. An essential element of these torts, which exist under most regimes regulating labeling of goods or services, is arrogating the inherent value of another’s recognized identifier. In domain name jurisprudence, this is called targeting”.

In *AC Webconnecting Holding B.V. v. United TLD Holdco Ltd*, WIPO Case No. LRO2013-0006, the Panel highlighted that the wording of the first two of the three grounds for determination under Section 3.5.2 of the Guidebook are in line with the language adopted in two WIPO Joint Recommendations which reflect fundamental principles applicable across jurisdictions, namely, Articles 3(1)(e)(ii) and 4(2)(ii) of the Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet (adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization, September 24 to October 3, 2001) and Articles 4(1)(b)(ii) and (iii) of the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks (adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization, September 20 to 29, 1999). As underlined by the panel in such legal rights objection proceeding, the Explanatory Notes to Articles 4(1)(b)(ii) and 4(1)(b)(iii) clarify that “impair in an unfair manner” the distinctive character of a well-known trademark includes using the trademark on goods or services which are “of an inferior quality or of an immoral or obscene nature”, in a manner that is “contrary to honest commercial practice” and that that to “take unfair advantage” of the distinctive character of a well-known trademark is to take “a free ride on the goodwill” of the trademark. With reference to the third matter for determination under Section 3.5.2 of the Guidebook, the panel noted that a simple likelihood of confusion is not sufficient to determine an infringement of rights according to the Procedure since the Objector must prove that such likelihood of confusion is indeed “impermissible”, *i.e.* it cannot be justified, an interpretation shared by the present Panel.

#### **D. Analysis of the eight non-exclusive factors**

As indicated above, Section 3.5.2 of the Guidebook sets out eight non-exclusive factors to be considered by the Panel in order to determine whether the Objection should be accepted. The Panel will provide in this Section its views under each of the factors.

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

In the case at hand, the Panel is required to compare the Objector's trademark .ECO with the Applicant's applied-for TLD <.eco>.

In *DotMusic Limited v. Charleston Road Registry Inc.*, WIPO Case No. LRO2013-0058, where the Panel was required to compare the TLD <.music> with the objector's trademark .MUSIC (word and design), it was stated that "although the dot always precedes the gTLD string, this Panel considers that it has an independent function in the domain name system, and therefore is not part of the top-level domain for the purposes of the comparison with a trademark for the purposes of the first factor of Section 3.5.2".

The Panel in *TLDDOT GmbH v. InterNetWire Web-Development GmbH*, WIPO Case No. LRO2013-0052 compared the gTLD string <.gmbh> with the objector's trademark .GMBH, finding: "[i]n the present case, the applied-for string to be used by the Applicant is <.gmbh>, which will be separated from the second-level domain names to be registered under such TLD by a '.'. The Panel finds the Objector's trademark and the Applicant's applied-for gTLD similar in appearance, sound and meaning."

Whether or not the dot in the gTLD <.eco> should be considered for the purpose of assessment of this first factor, the Panel finds that the Applicant's applied-for string <.eco> is substantially identical in appearance, phonetic sound and meaning to the Objector's registered trademark .ECO.

##### **(ii). Whether the Objector's acquisition and use of rights in the mark has been *bona fide*.**

Based on the statements submitted by the parties and on the documents made available on the USPTO web site that the Panel reviewed, the Panel finds that the Objector applied for the trademark .ECO in 2008 with the ICANN process in mind. The Objector's explanation in its response to the Office Action (see section B), that the specimens attached to the Statement of Use of the trademark were used "to solicit investors and support" for a new top level domain make it clear that the main purpose of the registration was to reserve rights in view of a future application for the new gTLD <.eco>.

In *Defender Security Company v. Lifestyle Domain Holdings, Inc.*, WIPO Case No. LRO2013-0035, it was stated that "[b]ased on the timeline in this case, it is obvious that the Objector has acquired these trademark registrations and filed these applications for the strategic purpose of trying to bolster its trademark portfolio, with the hope that it would provide assistance in the new gTLD application process. The Panel does not read the Applicant Guidebook or the Procedure to prohibit such conduct".

Similarly, in *AC Webconnecting Holding B.V. v. Dot Agency Limited*, WIPO Case No. LRO2013-0007, the Panel found: "[o]n the balance of probabilities, the Objector applied to register the Objector's [Community Trademarks (CTMs)] and made similar applications in the United States to reserve rights in the hope of success in the ICANN application process. In the circumstances, this Panel must accept the Objector's CTMs as valid unless and until they are successfully challenged and revoked".

After having reviewed the documents publicly available relating to the cancellation proceedings which involved the Objector's mark, the Panel notes that the Objector used its trademark rights acquired via the registration before the USPTO in order to attempt to prevail against other potential applicants for the gTLD <.eco>. The Objector sent cease and desist letters, requested the removal of a Facebook page and filed suit against the Applicant and another company in an apparent attempt to impede concurring applications for the same Top Level Domain.

In view of the above conduct and considering the generic character of the term “eco”, which is the core of the Objector’s trademark, and the fact that the registered trademark .ECO was obtained for services differing from domain name registry services, and in the absence of evidence of possible recognition of the Objector’s mark among the public, the Panel finds the Objector’s conduct in this regard questionable but not determinative in this Panel’s assessment of the present case.

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

Based on the documents and statements submitted by the parties, there is no evidence that any sector of the public recognizes the sign corresponding to the applied-for gTLD string <.eco> as being the mark of the Objector, of the Applicant, or of a third party.

As stated in *Defender Security Company v. Baxter Pike LLC*, WIPO Case No. LRO2013-0031, the Panel notes that, unless an objector can demonstrate strong recognition of its marks in an identifiable sector, its objection is likely to fail. In addition, the Panel considers that “eco” is a prefix mostly relating to ecological or environmental terms, and any association with the Objector is not a result of the recognition of “eco” as a trademark.

See also, along these lines, the following decisions:

*TLDDOT GmbH v. InterNetWire Web-Development GmbH*, WIPO Case No. LRO2013-0052:

“Based on the evidence provided by the parties in the case file, neither of them has received a noteworthy recognition in the relevant sector of the public of the string <.gmbh>, neither as trademark nor in any other way. The Objector’s website at “www.gmbhtld.de” and its promotion activities are not sufficient for a finding in this regard. The record does not substantially address any specific third-party rights”;

*Defender Security Company v. Merchant Law Group LLP*, WIPO Case No. LRO2013-0036:

“the Panel considers that a “home” is a descriptive concept denoting an online location which the public can obtain through the registration of a domain name. It is possible for a secondary meaning to be established in a descriptive term, however the Panel does not find that either of the Parties has established such a secondary meaning in the sign corresponding to the gTLD, nor is there any evidence before the Panel of a third party having done so. In particular, the Panel considers that the relevant sector of the public will not recognize the <.home> gTLD as, or identify it with, the Objector’s US Mark”.

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

According to the evidence on record, the Panel notes that the Applicant was made aware of the existence of the Objector’s trademark registration .ECO before the Applicant’s submission to ICANN of its application for the new gTLD <.eco>.

However, the Panel finds that, whether the Applicant was or was not aware of the Objector’s trademark at the time of its application for the gTLD <.eco>, it is not necessarily relevant for the determination in this proceeding as such awareness does not necessarily imply bad faith. See, along these lines, *TLDDOT GmbH v. InterNetWire Web-Development GmbH*, WIPO Case No. LRO2013-0052, stating: “The Panel finds that the question of whether the Applicant was aware of the Objector’s trademark at the time of the application for the gTLD <.gmbh> is not relevant for the decision in this proceeding. Such awareness, by itself, does not automatically equate to bad faith or some other mischievous motive for purposes of this proceeding. Rather, the core question is whether the Applicant’s intentions here were *bona fide*”.

In the present case, the Applicant has demonstrated that it applied for the new gTLD <.eco> to offer domain name registration services to businesses and people which desire to “advertise their association with environmentally-friendly products, services, and materials through the purchase and use of a .ECO top-level domain”.

The Panel finds that the Applicant’s use of the gTLD <.eco> in a descriptive way is not infringing the Objector’s rights in its United States trademark. In addition, the Panel finds that the Applicant has not engaged in a pattern of conduct in applying to operate gTLDs or registrations in gTLDs which are identical with or confusingly similar to the marks of others. As highlighted in section 5B, the Applicant has applied for other gTLDs corresponding to generic terms, circumstances which appear to be consistent with a legitimate business plan to offer for sale domain names in the correspondent top level domains.

See, along these lines, *Limited Stores, LLC v. Big Fest LLC*, WIPO Case No. LRO2013-0049:

“It also bears noting that Applicant and its affiliates have applied for more than 300 gTLDs and Objector has mentioned only three of them in this case. Without being exhaustive here, the Panel observes that a sampling of the other TLDs applied for by the Donuts family includes: <.art>, <.accountants>, <.agency>, <.food>, <.football>, <.forsale>, <.style>, <.sucks>, and <.supplies>. These common terms appear to be consistent with a legitimate plan to attract various people and entities to purchase Internet addresses tailored to their interest or sphere of activity”.

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

The Applicant filed a trademark application for ECO in Chile for services in class 42, but has not submitted any evidence showing that it made preparations to use a sign corresponding to the applied-for gTLD other than with respect to the application for the gTLD <.eco>.

With reference to the use of the applied-for string, the Applicant in section 18(b) of its Application stated: “[t]he .ECO top-level domain will (...) provid[e] registrants with an efficient, effective, prominent, instantly understood way of showing their association with eco-consciousness, and provide those registrants who desire it a domain that that can effectively communicate information to such Internet users in an identifiable way. At the same time, .ECO provides competition with the existing TLDs and new gTLDs that will be approved by ICANN, benefiting the Internet community at large by increasing consumer choice”. The Applicant also indicated that it will implement the mandatory rights protection mechanisms prescribed by ICANN and additional measures to ensure remedies to possible infringement of third party rights.

In view of the above, of the Applicant’s payment of the substantial filing fee required for a new gTLD application and of its efforts to establish the technical and administrative infrastructure necessary to operate the registry, the Panel finds that it has made preparation to use the <.eco> string in good faith. See, along these lines, *Defender Security Company v. Baxter Pike LLC*, WIPO Case No. LRO2013-0031.

With reference to the issue whether the Applicant’s proposed operation of domain name registry services under the new gTLD <.eco> will interfere with the legitimate exercise of the Objector’ trademark rights, the Panel finds that, since, as mentioned above, the Applicant’s proposed use of the string <.eco> is stated to be in a generic sense, the proposed use does not interfere with the legitimate exercise by the Objector of its trademark rights. See *TLDDOT GmbH v. InterNetWire Web-Development GmbH*, WIPO Case No. LRO2013-0052.

**(vi). 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.**

As indicated above, the Applicant filed a trademark application for ECO in Chile in class 42 on March 30, 2012.

As to the relevance of trademark applications in the present proceeding, the Panel shares the view expressed in *Pinterest, Inc. v. Amazon EU S.à.r.l.*, WIPO Case No. LRO2013-0050, where it was stated: “in LRO proceedings, the approach to pending trademark registration applications should be that they do not, in and of themselves, *i.e.* in the absence of evidence of actual as distinct from constructive use, constitute trademark rights”.

Therefore, the Panel finds that the mere application of a trademark in Chile is insufficient to justify a determination whether the Respondent has rights to a sign corresponding to the gTLD <.eco>.

**(vii). 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 Applicant in its submissions has not claimed to be commonly known by the sign ECO, corresponding to the applied-for new gTLD.

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

As mentioned above, the Applicant intends to use the applied for string <.eco> to provide registration services of second level domain names. The Panel finds that, in light of the generic nature of the word “eco”, which constitutes the core of the Objector's mark, of the limited demonstrable use of the mark .ECO, and of the absence of evidence showing that the gTLD <.eco> might be seen as an identifier with regard to the origin of the goods or services, the Panel finds that the Applicant's intended use of the gTLD <.eco> would not create a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the gTLD.

Among others, the following previous legal rights objection determinations have held that the use of a generic or descriptive term as top level domain weighs against a finding of a likelihood of confusion.

*I-REGISTRY Ltd v. VipSPACE Enterprises LLC*, WIPO Case No. LRO2013-0014, concerning the gTLD <.vip>:

“Respondent's intended use of the gTLD will lead to the gTLD being seen first and foremost as a descriptive term describing the purpose and characteristics of the domain (...) The Panel does not believe that confusion with the Objector's mark is likely”;

*DotTunes Limited v. Amazon EU S.a.r.l.*, WIPO Case No. LRO2013-0065, concerning the gTLD <.tunes>:

“Given the generic nature of the sign and the limited use of the Objector's mark, the Panel finds that there is little or no likelihood of confusion”;

*Defender Security Company v. Charleston Road Registry Inc.*, WIPO Case No. LRO2013-0032, concerning the TLD <.home>:

“Respondent's intended use of the new gTLD <.home> would not create a likelihood of confusion (...) since Respondent intends to use the sign corresponding to the New gTLD in its generic sense”;

*United States Postal Service v. Amazon EU S.à.r.l*, WIPO Case No. LRO2013-0044, concerning the gTLD <.mail>:

“Mail’ is a generic word, and the Panel has not been presented with indications that over time US consumers will be unable to distinguish between the providers of a mail delivery service under various trademarks, including U.S. MAIL, and online business services under the <.mail> gTLD”;

*DotMusic Limited v. Charleston Road Registry Inc.*, WIPO Case No. LRO2013-0058, concerning the gTLD <.music>:

“In his case the Objector has attempted to associate, perhaps not without some success, the LRO Trademarks and related domain name registrations with the <.music> gTLD string. One objective of the Objector has been to obtain precisely the type of competitive advantage (in this case in the application process for the <.music> gTLD string) that the doctrine of generic names is designed to prevent. However, as the Applicant proposes to use the <.music> gTLD string in a generic sense it is immune from this challenge”;

*I-REGISTRY Ltd v. John Corner LLC*, WIPO Case No. LRO2013-0015, regarding another application for the gTLD <.vip>:

“The use to date of the Objector’s Trade Mark has been limited. The Objector’s Website promotes the intended use of the mark, if the Objector’s application for registration of the applied-for gTLD string is successful. The Panel is unable to conclude, in all the circumstances of this proceeding, that such contingent use gives rise to a likelihood of confusion”.

#### **E. Panel’s Findings**

The Objector has alleged that the potential use of the applied-for gTLD by the Applicant (i) takes unfair advantage of the distinctive character or the reputation of the Objector’s registered trademark; (ii) unjustifiably impairs the distinctive character or the reputation of the Objector’s said mark; and (iii) creates an impermissible likelihood of confusion between the applied-for gTLD and the Objector’s said mark.

In particular, the Objector contended that:

- i) since it owns the only registered .ECO trademark issued by the USPTO, it would be in the best position of all else to secure and serve ICANN and its intended beneficiaries throughout the world in an honest, genuine and respectful manner;
- ii) since the Objector’s trademark is first in time, the Applicant’s trademark creates confusion in the marketplace.

As to the scope of the Legal Rights Objection proceedings, the Panel concurs with the views expressed in *Defender Security Company v. Merchant Law Group LLP*, WIPO Case No. LRO2013-0036, stating:

“The general intent behind the Guidebook and Procedure is to provide the holder of registered or unregistered trademark rights, which have been acquired and used on a genuine and *bona fide* basis, with an opportunity to object to an applied-for gTLD on the ground that such gTLD would infringe those existing legal rights (Section 3.2.1 of the Guidebook). The Procedure is not intended to provide a facility whereby existing or prospective applicants for a new gTLD may attempt to gain an advantage over other applicants for the same gTLD by way of the deliberate acquisition of trademark rights for no purpose other than to bring a Legal Rights Objection”.

In addition, as noted in *DotMusic Limited v. Charleston Road Registry Inc.*, WIPO Case No. LRO2013-0058, “the Legal Rights Objection procedure does not require the Panel to make any abstract determination of the suitability of the applied for gTLD registry. The Public Interest and Community Objections procedures are

available to address some broader concerns (...) There may be multiple applicants and multiple objectors in respect of the same gTLD string, and each must succeed or fail on its own merits”.

For the reasons discussed below, the Panel concludes that the potential use of the applied-for gTLD by the Applicant does not take unfair advantage or unjustifiably impair the distinctive character or the reputation of the Objector’s mark, or otherwise creates an impermissible likelihood of confusion.

**(i) Take unfair advantage of the distinctive character or the reputation of the Objector’s registered or unregistered trademark or service mark.**

The Panel finds that the intended use of the Applicant’s applied-for gTLD string <.eco> does not free ride on the goodwill of the Objector’s mark .ECO, since there is no evidence before the Panel that the Objector might have a reputation in the mark and the intended use of the Applicant’s gTLD string <.eco>, according to the statements made by the Applicant in its Application, would be pertinent with the descriptive meaning of the word “eco”.

As stated in *AC Webconnecting Holding B.V. v. United TLD Holdco Ltd*, WIPO Case No. LRO2013-0006, “[a] taking of the descriptive function of a trademark cannot be said to be contrary to honest commercial practices, at least where it has not been established that the trademark has a reputation and hence goodwill. Thus, use of an applied-for gTLD string in the string’s descriptive sense does not take unfair advantage of a descriptive trademark lacking reputation”.

**(ii) Unjustifiably impair the distinctive character or the reputation of the Objector’s mark.**

According to the public portion of the Applicant’s gTLD string application, as stated above the Applicant intends to use the gTLD <.eco> in relation to the provision of domain name registration services. The Panel finds that the Applicant’s proposed use of the gTLD <.eco> would not impair the distinctive character or reputation of the Objector’s mark since, as stated in the paragraphs above, the Objector has failed to establish to the satisfaction of the Panel the requisite level of distinctive character or reputation in its mark. See, along these lines, *I-REGISTRY Ltd v. John Corner LLC*, WIPO Case No. LRO2013-0015.

Accordingly, the Panel finds that the Objector has not proven that the Applicant’s potential use of the applied-for gTLD string <.eco> unjustifiably impairs the Objector’s trademarks.

**(iii) Otherwise create an impermissible likelihood of confusion between the applied-for gTLD and the Objector’s mark.**

As indicated above, the Applicant’s applied-for gTLD string <.eco> is substantially identical in appearance, sound and meaning to the Objector’s registered mark .ECO.

However, even assuming that, in view of the substantial identity of the applied-for string and the mark .ECO, there could be a likelihood of confusion between the two, the Panel finds that it would not be “impermissible”, since there is no evidence that the public would perceive it as a source identifier as opposed to as a descriptive term or prefix relating to ecology or environment.

**F. Reverse Domain Name Hijacking**

As highlighted in *Defender Security Company v. Top Level Domain Holdings Limited*, WIPO Case No. LRO2013-0037, 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, the request for reverse domain name hijacking is not pertinent and will not be addressed by the Panel.

## 7. Decision

The Panel finds that the potential use of the applied-for gTLD by the Applicant does not:

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

The Objection is rejected.

[signed]

**Luca Barbero**  
Sole Panel Expert  
Date: August 26, 2013