

## **EXPERT DETERMINATION LEGAL RIGHTS OBJECTION**

### **Motorola Trademark Holdings LLC v. United TLD Holdco Ltd**

### **Case No. LRO2013-0054**

#### **1. The Parties**

Objector/Complainant (“Objector”) is Motorola Trademark Holdings LLC of Libertyville, Illinois, United States of America, represented by Katten Muchin Rosenman LLP, United States.

Applicant/Respondent (“Applicant”) is United TLD Holdco Ltd, of George Town, Grand Cayman, Cayman Islands, Overseas Territory of the United Kingdom of Great Britain and Northern Ireland, represented by Finnegan, Henderson, Farabow, Garrett & Dunner LLP, United States.

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

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

#### **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 28, 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”). While reviewing the Objection for formal compliance, the Center noticed that Exhibits 4, 15, 17 and 19 to the Objection were not accompanied by a certified translation or otherwise official translation of all relevant text. In accordance with Article 5(b) of the Procedure, the Center advised the Parties that any issues concerning untranslated materials would be for the consideration of the Panel, once appointed.

In accordance with Article 11(a) of the Procedure, the WIPO Center formally notified Applicant 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.

The WIPO Center appointed Roberto Bianchi 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.

On June 25, 2013, while noticing that Applicant did not request any translation of Objection Exhibits 4, 15, 17 and 19, nor otherwise complained about the lack of translations, the Panel by Expert Panel Order No. 1 decided, a) not to request a translation of Exhibit 15 given that the few words of the song in the commercial spot are in English, and b) to request Objector to submit a certified translation into English of Exhibits 4, 17 and 19 by July 5, 2013.

On July 1, 2013, Objector sent to the Center the translations into English of Exhibits 4, 17 and 19, in compliance with Expert Panel Order No. 1.

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

Objector is a wholly owned subsidiary of Motorola Mobility LLC ("Motorola"), a leading company in the mobile communications industry. Since 1928, through its predecessors-in-interest, affiliated companies and licensees, Motorola has been in the business of communication and electronics. Motorola's products include mobile phones, smartphones, tablets, wireless accessories, end-to-end video and data delivery, and management solutions, including set-tops and data-access devices.

Objector owns the following U.S. trademark registrations for MOTO:

MOTO, Reg. No. 3402839, Reg. Date March 25, 2008, filed on January 15, 2002, for telephones, cellular telephones, radio telephones, pagers, two-way radios, radio transmitters, radio receivers, radio transceivers, electronic organizers, and related accessories for the foregoing goods, namely, headsets, microphones, speakers, carrying cases, and belt clips; radio base stations, switches, routers, computers, computer software and programs used for transmission or reproducing or receiving of sound, images, video or data over a telecommunications network or system between terminals and for enhancing and facilitating use and access to computer networks and telephone networks; computer software for use in general purpose database management; computer e-commerce software to allow user to safely place orders and make payments in the field of electronic business transactions via a global computer network or telecommunications network; computer software for training and product support for computers and mobile phones in the field of communications; computer utility software for performing computer maintenance work; computer game software for mobile handsets; computer software and programs featuring music, movies, animation, electronic books, games in the field of general entertainment; computer software for the distribution of information and interactive multimedia content containing text, images, video and sound to users in the field of communications; computer software and programs for management and operation of wireless telecommunications devices; computer software for accessing, searching, indexing and retrieving information and data from global computer networks and global communication networks, and for browsing and navigating through web sites on said networks; computer software for sending and receiving short messages and electronic mail and for filtering non-text information from the data; analog and digital radio transceivers or receivers for data, voice, image and video communication, modems, global positioning units, batteries, battery chargers, power adapters, and antennas, of international class 9; first use/first use in commerce June 30, 2006.

Objector also owns a Community Trade Mark in MOTO, Reg. No. 002565935, Reg. Date October 2, 2003 for various products and services in international classes 9, 37, 38 and 42.

Objector further owns trademark registrations for MOTO in numerous countries. Most of these registrations are in international classes 9, 37, and 38. Several of them are in international classes 35 and 42.

Objector also owns various trademark registrations consisting of the characters MOTO, either on their own or

together with other words or characters, such as MOTOSPEAK, MOTOACTIV, MOTOBLUR and HELLOMOTO, in numerous countries, with the first registration dating from 2005.

Motorola advertises its products on its websites “www.moto.com”, “www.motorola.com” and “www.motoactiv.com”, among others. Motorola products and services are also offered for sale over the Internet.

Applicant is a wholly owned subsidiary of DMIH Limited, which is a subsidiary of Demand Media, Inc.

Applicant submitted its Application for the gTLD <.moto> string as part of the ICANN New gTLD Program. In its response at question 18(a) of its Application, Applicant described the mission/purpose of its proposed gTLD as follows:

“The term “moto” is a generic and broadly used word that holds particular affinity for people and organizations interested and engaged in the world of motorcycles and other motor-equipped vehicles. Global in scope, today a passionate and engaged group of hundreds of millions of consumers and tens of thousands of organizations identify with this word. The mission and purpose of the .moto TLD is to establish an easily recognized and accessible namespace for this large and dynamic international group.”

In its response to Question 18(b) (“How do you expect that your proposed gTLD will benefit registrants, Internet users, and others? i. what is the goal of proposed TLD in terms of specialty, service levels or reputation”), Applicant stated the following:

“The .moto TLD seeks to establish a widely recognized and desirable address. Creating a distinct sense of identity, interest and belonging not achievable with existing TLDs, .moto will provide a well-regarded address for the sharing of information, ideas, experiences, entertainment and the sale of relevant goods and services. The desired reputation of .moto is that of an open namespace where everyone is welcomed as engaged participants. As such, we expect that participants will create innovative and specialized products and services that connect with their audience. For example, a motocross fan club may congregate to discuss recent races or share experiences with specific kinds of equipment and accessories. Manufacturers might market their lines of motorcycles and after-market parts. Racetracks may promote their upcoming slate of races and recent results.”

In the current round of applications for new gTLDs, Applicant has applied for the following gTLDs: <.actor>, <.airforce>, <.army>, <.bar>, <.cam>, <.dance>, <.democrat>, <.engineer>, <.fishing>, <.gay>, <.gives>, <.green>, <.immobilien>, <.kaufen>, <.map>, <.moda>, <.mom>, <.moto>, <.navy>, <.ninja>, <.pub>, <.rehab>, <.republican>, <.rip>, <.social>, and <.wow>.

## **5. Parties' Contentions**

### **A. Objector**

In its Objection, Objector contends as follows:

Objector has standing to file a legal rights objection because it is the owner of the rights to the MOTO trademark and to numerous trademark registrations around the world for the MOTO mark.

Objector owns trademark registrations for MOTO in over 38 countries. Objector also owns various trademark registrations consisting of the characters MOTO, either on their own or together with other words or characters, such as MOTOSPEAK, MOTOACTIV, MOTOBLUR, and HELLOMOTO (collectively the “Motocodes”). The Motocodes are registered in over 100 countries, with the first registration dating from 2005. Objector contends that Motorola is also the owner of common law rights in thousands of Motocodes.

Accordingly, Motorola has established that it is a rightsholder and has standing to bring this legal rights objection. Objector further contends that the potential use of the applied-for gTLD by Applicant (i) takes unfair advantage of the distinctive character or the reputation of Objector's registered or unregistered trademark or service mark ("mark"), and/or (ii) unjustifiably impairs the distinctive character or the reputation of Objector's mark, and/or (iii) otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and Objector's mark.

Objector also argues that Motorola's valuable established rights in the famous MOTO brand would be irreparably harmed, tarnished, diluted, and impaired if Applicant's applied-for string is approved for delegation. Since at least 2002, Motorola has internationally marketed and promoted its products using the famous mark MOTO and its family of Motocodes such that MOTO and the Motocodes are uniquely identified in the mind of the consuming public with Motorola and its products. The MOTO mark has been prominently featured in advertising and promoting Motorola products worldwide, on television, in print media and on the Internet. Motorola has spent an enormous amount of time, money and effort, in designating and manufacturing, promoting and selling its mobile devices and numerous other associated goods and services in connection with the MOTO mark, through advertisements and promotions in newspapers, magazines, on television, and through its websites. Motorola has sold billions of dollars' worth of such goods and services around the globe. Additionally, Motorola is the owner of a family of "MOTO" marks, which includes hundreds of thousands of MOTO-formative marks. The Motocodes are advertised and promoted together in television commercials, print advertisements, sponsorship at global sporting and entertainment events, and Internet advertising. Since 2002, Motorola has spent hundreds of millions of dollars on advertising featuring MOTO and the Motocodes.

Objector contends that as result of Motorola's worldwide advertising and promotional efforts featuring the Motocodes, the common characteristic "MOTO" has acquired significant goodwill and recognition and serves to uniquely identify Motorola's products and services. Motorola has vigorously defended its trademark rights in the MOTO mark and the family of Motocodes, including against infringing domains, succeeding in Uniform Domain Name Dispute Resolution Policy ("UDRP") proceedings related to numerous MOTO-related domain names.

Objector also contends that the MOTO trademark has become famous, acquired distinctiveness and significant goodwill, and serves to uniquely identify Motorola and its products and services.

Objector states that Applicant is a domain name investor, and that Applicant's applications have received 11 Early Warnings from ICANN's GAC regarding the <.airforce>, <.army>, <.engineer>, <.green>, and <.navy> gTLDs.

Other specific contentions of Objector are considered under each of the eight non-exclusive factors further below.

## **B. Applicant**

In its Response, Applicant contends as follows:

The word "moto" is a generic term that has widely been used around the world by millions of individuals and organizations to refer to motorcycles, motor-equipped vehicles, and other things "moto". In the expert report filed with the Response, Dr. Ronald Butters, a linguistics expert from Duke University, explains the generic nature of the word "moto" based on a linguistic analysis of dictionaries and other sources. This comes as no surprise, as several UDRP panels have recognized that "moto" is a generic term.

Applicant argues that it seeks to use the <.moto> gTLD to establish a widely recognized Internet address for the sharing of information, ideas, expression, experiences, entertainment, and the commercialization of goods and services relating to the motorcycling and motor-vehicle field.

Applicant states it is a wholly owned subsidiary of DMIH Limited, which is a subsidiary of Demand Media,

Inc. Applicant is a well-funded company established by highly experienced domain industry executives to secure the rights to operate a portfolio of gTLDs that increase choice and provide avenues for the expression and sharing of ideas online. Applicant carries a wealth of experience in the domain industry. It has been a dedicated contributor to ICANN's new gTLD program for many years as an active participant in Internet policy development and implementation, working on topics such as vertical integration, rights protection mechanisms, and the Trademark Clearinghouse. The <.moto> string is one of 26 gTLDs Applicant seeks in this current round to provide fresh and exciting new options for millions of consumers, businesses, and other organizations on the web today and into the future.

As set forth in Applicant's gTLD Application, <.moto> will provide an open namespace that participants can use to create innovative and specialized communities, products, and services that connect with their audience and others interested in "moto" fields and applications. The string will provide a resource for a community filled with enthusiasts and fans that love to congregate online to share ideas relating to their hobby and sport, manufacturers and marketers who want to promote and sell their goods and services, and a wide range of others interested in "moto" fields.

Objector states that five of Applicant's gTLD applications received early warnings from the ICANN Governmental Advisory Committee ("GAC"). These early warnings are not relevant to this proceeding, and were merely cited by Objector to suggest that Applicant's gTLD activities are somehow controversial. Objector has partnered with Google's subsidiary, Charleston Road Registry Inc., to apply for the identical <.moto> string (a fact it withheld from the Panel) and Charleston Road Registry Inc. itself received early warnings from the GAC on 5 of its gTLD applications. Objector cannot have it both ways.

Applicant has committed to implementing a suite of additional protection mechanisms that exceed the ICANN mandated protections and will help further reduce the incidence of abusive domain registrations. This demonstrates Applicant's commitment to providing a safe and responsible namespace under the <.moto> string. These protection mechanisms will be applied on top of those already mandated by ICANN, such as providing a dedicated point-of-contact to address abusive activities; providing thick Whois; using the trademark clearing house, sunrise process, and trademark claims process; and adhering to the URS and UDRP, among others.

Applicant contends that the potential use of the applied-for gTLD by Applicant does not (i) take unfair advantage of the distinctive character or the reputation of Objector's registered or unregistered trademark or service mark ("mark"), and/or (ii) unjustifiably impair the distinctive character or the reputation of Objector's mark, and/or (iii) otherwise create an impermissible likelihood of confusion between the applied for gTLD and Objector's mark.

Objector argues that the Panel should deny delegation of <.moto> to Applicant on the grounds that Objector's alleged rights in MOTO will be "irreparably harmed, tarnished, diluted, and impaired." Applicant states that these are unsubstantiated assertions about the alleged fame and recognition of its MOTO trademark, while disregarding the generic nature of the word "moto" and the undeniable fact that Objector does not exclusively own MOTO, but sits in a crowded field where many entities use (and/or have registered) MOTO and other MOTO-formative marks around the world. For this reason, and as detailed below and in the analysis and report of Dr. Butters, people simply will not confuse (let alone associate) <.moto> with Objector.

With regard to Objector contention that it owns a family of MOTO trademarks and has rights in "thousands" or "hundreds of thousands" of MOTO-formative marks, Applicant argues that Objector provides insufficient support for these allegations, which are debunked by Applicant's evidence of widespread third-party use and registration of MOTO and MOTO-formative marks.

Applicant contends that instead of being a domain speculator with a pattern of bad faith domain registration, as painted by Objector, it has commitment to providing an abuse-free domain registration environment and its *bona fide* interest in operating registries for 26 gTLDs.

Applicant further contends that the public will associate “moto” with its generic meaning, not Motorola. As detailed in the Expert Report of Dr. Butters, the term “moto” has a number of defined, generic meanings in the English language, virtually all of which relate to the motorcycling field: shortened form of the word “motocross”; heat or portion of a cross-country motorcycle race; motorcycle race; bike; motorbike; motorcycle. Similar definitions are found in Italian, Spanish, and Portuguese dictionaries.

Applicant contends that it searched the Zone file for existing registered domain names under the most common gTLDs that contain the suffix “-moto” or “-motos”, and found, evidencing the generic nature of the word “moto” in the domain space, that nearly 22,000 such domain names are currently registered. Of the 22,000 domains ending in “-moto” or “-motos”, only seven appear connected with Motorola. This evidence shows that the public associates and uses MOTO-formative domain names with things other than Motorola.

Applicant further contends that Objector does not own exclusive rights in the term “moto”. While Objector argues that its alleged mark MOTO and its Motocodes are internationally famous and serve to uniquely and exclusively identify Motorola and its products and services, many other companies claim rights in MOTO or MOTO-formative marks.

Applicant argues that Objector’s claims of exclusivity and uniqueness are overstated and incorrect. Applicant states that myriad third-party websites use the term “moto” in connection with motorcycle and motor-vehicle related content and in other ways, including as the name of a restaurant, the name of a music band, and more.

Applicant states that Objector provides only three examples of advertising showing the term “moto” *per se* as proof of prominent use in international advertising and promotion which does not support Objector’s claim of fame, particularly given the existence of extensive third-party MOTO marks and the generic meaning of the term.

With regard to Objector’s claim that it owns a family of MOTO marks, Applicant contends that Objector provided less than a dozen examples purporting to show its promotion of multiple MOTO-formative marks together. Moreover, the examples provided range from showing only one alleged “Motocode” in an ad, to only as many as ten. No matter the number of marks asserted, the record is devoid of the amount and type of evidence needed to establish a family of marks. Applicant notes that a UDRP panel has already rejected Objector’s allegation of rights to a family of MOTO marks and, in addition to noting Objector’s failure to prove a family, that Objector should not be able to stop generic uses of “moto” when combined with other terms. (*Motorola, Inc. v. R3 Media*, WIPO Case No. D2006-1393).

Finally, Applicant notes that although Objector mentions that it owns the <moto.com> domain name, it fails to mention that this domain name was acquired in February 2013—after Applicant applied for the <.moto> gTLD.

Other contentions of Applicant are considered under each of the non-exclusive factors below.

## **6. Discussion and Findings**

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

According to Section 3.2.2.2 of the gTLD Applicant Guidebook (“Guidebook”), a rightsholder that claims that an applied-for gTLD infringes its legal rights on either registered or unregistered trademarks has standing to file a legal rights objection. Objector must include the source and documentation of its existing legal rights in the filing.

The Panel notes that the requisite for standing under Procedure is rather straightforward, and can be met by, a) claiming that objector has rights in a mark (whether registered or not) and, b) claiming that the applied-for gTLD infringes such rights in the specified manner and c) including the source and documentation of the

existing legal rights in the filing.

Objector contends that the applied-for gTLD infringes its existing rights in its MOTO marks and in its Motocodes or family of marks including the term MOTO. In the filing, Objector submitted evidence to the satisfaction of the Panel as to the source and documentation of its existing rights on registered trademarks and service marks that contain the term “moto”. Accordingly, the Panel is satisfied that Objector has standing for the purpose of this proceeding.

The Panel will make a more complete finding as to the existing rights of Objector under the first non-exclusive factor. Whether infringement exists or not will have to be determined after examining the submissions and evidence under the eight non-exclusive factors referred to in Section 3.5.2 of the Guidebook.

## **B. General Principles (Standards) for Adjudication of a Legal Rights Objection**

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

According to Section 3.5.2 of the Guidebook, in interpreting and giving meaning to Recommendation 3, a panel of experts presiding over a legal rights objection will determine whether the potential use of the applied-for gTLD by applicant:

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

## **C. Factors Considered in Adjudicating the Objection**

As indicated in Section 3.5.2, since the Objection is based on trademark rights, in adjudicating the Objection the Panel will consider the contentions of the Parties and evidence under the eight non-exclusive factors below.

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

Objector contends that the applied for string is identical in appearance, sound and meaning to Motorola’s MOTO mark and that the similarity factor alone can be dispositive of the confusion issue.

Objector concludes that the identical nature of the applied-for string should be sufficient to establish that there is an impermissible likelihood of confusion between the applied for gTLD and Motorola’s famous MOTO trademark and that the <.moto> string unjustifiably impairs the distinctive character of, or reputation of, Motorola’s famous MOTO mark.

Applicant contends that the <.moto> string is not identical in appearance or sound to Objector’s alleged mark. Pronounced “dot moto,” the gTLD string creates a different overall commercial impression than, and is sufficiently distinguishable from, Objector’s alleged MOTO mark. Applicant adds that the <.moto> string can coexist with Objector’s alleged mark without creating a likelihood of confusion. As to the alleged similarity in meaning, Applicant contends that consumers will view <.moto> in its generic sense, and not to refer to Objector’s trademark.

Applicant considers that Objector fails to provide any support for its hypothesis that any segment of the

public is actually aware that “.brand” strings may be coming, or that the public is more likely to associate <.moto> with any particular brand rather than its long-established generic meaning. Given that only generic and country-code TLDs have been operational in the DNS, Objector’s arguments are speculative at best. Objector offers no empirical (e.g., survey) or other evidence to show that its purported mark will trump, in people’s minds, the ubiquitous, recognized generic meaning of “moto” – or one of the many thousands of MOTO-formative trademarks that exist worldwide.

### **Panel’s Findings under Factor 1**

Evidently, the “moto” portion of the applied-for gTLD is identical letter-by-letter to Objector’s mark MOTO. If the “.” sign (read “dot”) is visually and aurally considered, the applied-for gTLD is almost identical to Objector’s MOTO mark.

However, there is an important difference in meaning between these signs. The meaning of Objector’s MOTO mark when used in the advertisings and promotion of cell phones as shown by Objector appears to be related to Motorola, of which “moto” appears to be a short or “clipped” form, as noticed by Dr. Butters in his report. Instead, the Applicant alleges that the purpose or intended use for the applied-for gTLD is based on the meaning of “moto” as related to the world of motorcycles and motor-powered vehicles.

Several facts show that “moto” is a generic or common term related to motorcycles.

First, according to the report of Dr. Butters submitted with the Response, the term “moto” in and by itself is generic, and descriptive of motorcycles and motor-powered vehicles. This expert in linguistic science summed up his conclusions as follows:

“The word moto has a number of different meanings in contemporary American English, (as well as, e.g., Spanish, French, Italian, and Portuguese). Most prominent among these meanings is as a noun referring to certain kinds of motorcycles and cross-country motorcycle races. The term has also appeared in names for such products and services as power-driven sleds, bicycles, and photography services. It is also an acronymic slang term. Historically, and by phonological association, it is a kind of shortening or clipped form of the word motor, and participates as a prefix in various combined forms (e.g., motocross ‘cross-country motorcycle race’). It is also used as a portion of a trademark as a name of an international gold mining company and as an alleged trademark of the electronics marketer Motorola, of which Moto is apparently an abbreviation (CLIPPED FORM).

Used as a generic TLD (gTLD), the form ‘.moto’ will differ so significantly from Motorola Trademark Holdings’ alleged trademark, ‘Moto’, that there is virtually no linguistic basis for construing ‘.moto’ as being related to the alleged trademark ‘Moto.’ In the linguistic dimension of sight, ‘.moto’ differs from ‘Moto’ because ‘Moto’ must be capitalized and ‘.moto’ normally is not. Furthermore, in meaning, Motorola’s ‘Moto’ is an alleged trademark – that is, it is putatively not generic – whereas the public understands that each and every TLD that is operational today is generic (e.g., ‘.com’, ‘.net’, ‘.info’, ‘.gov’, ‘.org’) or country specific (e.g., ‘country-code’ top level domain names such as ‘.fr’ and ‘.us’). Finally, in actual use, ‘Moto’ in the sense of referring to Motorola products is quite rare, accounting for as little as 5.5% of the actual spoken and printed data in standard corpora drawn from various media. Linguistically, it is predictable that internet users will interpret ‘.moto’ as referring to something other than Motorola’s ‘Moto.’

The most common meaning of moto is to refer to motor-equipped vehicles and races of motos and motorcycles. This conclusion is supported by considerable evidence in dictionaries, and it is confirmed to the strongest degree of scientific certainty by an examination of the empirical record of use, using standard dictionary-making methodology to carry out the investigation. The American and international publics most frequently associate moto with referents other than any brand owner, such as Motorola – in particular, the most common association is with motor-equipped vehicles, and the most likely understanding of the gTLD string ‘.moto’ will be as a generic word that relates to the world of motorcycles and other motor-equipped vehicles.”



Annex 3 to the Response, pages 1-3.

Since on the case file there were no elements showing how many speakers speak each of the languages mentioned by Dr. Butters, the Panel independently conducted a search on the Internet and found that Spanish, French, Italian and Portuguese presently are spoken by several hundred million people, as follows: Spanish total speakers amount to 466 million; Portuguese is spoken by a total of 217 million; French total speakers are 118.5 million, and Italian total speakers are 61.1 million.<sup>1</sup> This suggests that there is a substantial international public for whom “moto” is a term associated with motorcycles and related matters.

Second, UDRP panels have found that “moto” is a generic or common name referring to motorcycles. See, for example, *eBay Inc. v. María Cecilia Vieites*, WIPO Case No. D2011-1212. In this case the panel found that the <ebaymotos.info>, <ebaymotos.net> and <ebaymotos.org> domain names contained the complainant’s EBAY mark in its entirety and merely added the generic prefix “motos”. See also *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)*, WIPO Case No. D2003-0696 (relating to 71 domain names incorporating the mark PEPSI, including <pepsimoto.com>, <pepsimoto.net>, <pepsimotogp.com> and <pepsimotogp.net>). The panel found that the disputed domain names were confusingly similar to the complainant’s distinctive mark PEPSI, since all of the contested domain names fully incorporated the mark, and added, “The mere addition of common terms such as “sports”, “basketball”, “soccer”, “volleyball”, “rugby” and the like to the “PEPSI” mark, does not change the overall impression of the designations as being a domain names connected to the Complainant”. It is clear that “moto” was considered “a common term” by the panel.

Third, Objector’s trademark registrations for MOTO in the United States and elsewhere cover goods and services of international classes 9, 35, 37, 38 and 42. Objector does not appear to own any MOTO mark protecting goods of international class 12, which *inter alia* includes motorcycles.

Fourth, Objector submits as Exhibit 8 to the Objection a “Moto- Trademarks Clearance” document containing legal advice given to Objector. In this document, region-specific advice is given to Objector as to possible trademark registration or use of the so-called Motocodes, *i.e.* compound expressions that include the term “moto” as suffix or prefix. In each case advice is given as to whether registration or use is feasible, and if so, under which conditions a trademark registration or use would be possible.

In the opinion of the Panel, this “Clearance document” shows not only that in many jurisdictions these Motocodes would be refused registration to protect motorcycles due to the descriptive character of the “moto” term, but also that Objector is aware of such advice.

Fifth, under international trademark law there is a limit to the protection of trademarks registered in the country of origin when they are devoid of any distinctive character, or “consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the *bona fide* and established practices of the trade of the country where protection is claimed.”<sup>2</sup>

These facts, considered together, confirm to the Panel that the term “moto” has a generic, common name, meaning or short for “motorcycle”. Of course this does not mean that Objector’s registered marks in MOTO are anything but legitimate, but the Panel would also like to stress that whatever distinctive character or reputation these marks may enjoy, is due to the fact that MOTO is not descriptive of the goods and services it protects. Instead, in the applied-for gTLD, the term “moto” is asserted to be descriptive of motorcycles and motor-powered vehicles and related activities.

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<sup>1</sup> Wikipedia, “List of languages by number of native speakers”, at “[http://en.wikipedia.org/wiki/List\\_of\\_languages\\_by\\_number\\_of\\_native\\_speakers#Nationalencyklopedin\\_.282007.29](http://en.wikipedia.org/wiki/List_of_languages_by_number_of_native_speakers#Nationalencyklopedin_.282007.29)”, visited by the Panel on July 23, 2013. According to the Wikipedia entry, the list was taken from Ethnologue (2013, 17th edition). See “<http://www.ethnologue.com/>” .

<sup>2</sup> Paris Convention, Article 6quinquies, B(ii).

The Panel concludes that considering appearance and phonetic sound, the <.moto> gTLD is nearly identical to Objector's existing mark MOTO. The Panel also finds that there is a substantial difference in meaning of the term as used by Objector in its MOTO marks covering mostly goods and services of international classes 9, 35, 37, 38 and 42, and as intended by Applicant in the applied-for gTLD, *i.e.* referring to motorcycles, motor-powered vehicles and related matters. In the overall impression, this difference in meaning favors Applicant.

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

Objector contends that its acquisition and use of rights in the MOTO mark and the family of Motocodes is *bona fide*. Applicant does not dispute that the acquisition and use of any rights of Objector in alleged MOTO or MOTO-formative marks, to the extent such rights exist, have been *bona fide*.

### **Panel's Findings under Factor 2**

There is nothing on the record suggesting that Objector acquisition or use of its MOTO marks in respect of the protected goods and services is anything other than *bona fide*.

While thus the Objector benefits from *bona fide*, the Panel does not attach particular weight to this factor.

## **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.**

Objector contends that consumer recognition can be shown through advertising expenditures, unsolicited media coverage of the product, sales success, and length and exclusivity of the mark's use. Objector states that Motorola has spent hundreds of millions of dollars annually to extensively advertise its MOTO mark and family of Motocodes globally in television commercials, print advertisements, at sporting and other entertainment events and on the Internet. The MOTO brand advertising and campaigns have been the subject of unsolicited media coverage. Motorola has won numerous awards for its MOTO products, including, but not limited to: CES 2012 Best of Bluetooth technology; CNET's Best of CES award; and 2006 Best 3GSM Handset.

Objector contends that these facts, as well as its long and exclusive use of its MOTO brands, establish that the MOTO mark is the subject of extremely strong consumer recognition and is famous and exclusively associated with Motorola and its products and services. Objector contends that in light of the numerous brand strings applied for as part of the new gTLD program, it is highly likely that the public, seeing the applied-for string, will associate it with Motorola.

Applicant contends that Objector failed to provide any empirical or other evidence showing how the relevant public will view the <.moto> gTLD, and whether it will be associated with Objector – versus the generic meaning of "moto" or some other entity or mark. Applicant's expert Dr. Butters conducted a linguistic analysis showing that the public would likely interpret "moto" as a generic term (*e.g.*, motorcycle, motocross, etc.), rather than Objector's purported trademark. Applicant also provided evidence of rampant third-party use of "moto" generically, and as or as part of third-party trademarks, names, and domain names.

Applicant contends that the money that Objector purports to spend annually to advertise its mark and its alleged revenues are insufficient to overcome Applicant's evidence that the public will view <.moto> as a gTLD.

Applicant also argues that the fact that the USPTO assigned a "pseudo mark" to Objector's 2012 application to register the mark MOTO for retail store services is without consequence. As stated directly on the notice, the USPTO may assign a pseudo mark "to assist in searching the USPTO database for conflicting marks. They have no legal significance and will not appear on the registration certificate."

Applicant concludes that Objector's chosen sampling of allegedly unsolicited media coverage of its MOTO campaigns – consisting of a mere five articles dated between 2002 and 2006 – is unconvincing, and its sampling of media articles using “MOTO” as a shorthand for “Motorola” is questionable. Of the mere 20 total articles submitted as Exhibit 24 to the Carroll Declaration, 13 are from the same three publications (*Crain's Chicago Business*, *Engadget*, and *The Register*). Of the remaining seven articles, one is Objector's own press release. Thus, these articles do not show that “the media and press routinely refer to Motorola by using the abbreviation MOTO” as asserted by Objector. Given the massive amount of searchable media materials available, this slim evidence actually undercuts Objector's claim.

Applicant contends that the public has only ever known TLDs to be generic (e.g., <.com> and <.net>) or country-specific (e.g., <.us> and <.fr>), virtually eliminating any likelihood that Internet users would associate the gTLD string <.moto> with a particular brand or company with the generic term “moto” and its long-established meanings connected with motorcycles, motor-equipped vehicles, motor sports, and other things “moto”. Thus, Applicant's proposed use of <.moto> should also be considered a permissible “fair use.”

Applicant further contends that, as Dr. Butters explains, the public will interpret “moto” as a generic term (e.g., for motorcycles, motocross, etc.), rather than as referring to Objector's purported trademark. The American and international publics much most frequently associate “moto” with referents other than any brand owner, such as Motorola – in particular, the most common association is with motor-equipped vehicles, and the most likely understanding of the gTLD string <.moto> will be as a generic word that relates to the world of motorcycles and other motor-equipped vehicles. (Butters Report, at 3.)

### **Panel's Findings under Factor 3**

The Parties neither dispute nor agree as to which is “the relevant part of the public”. While Objector refers to “consumer recognition”, “the public” and “the international public”, Applicant mentions “the relevant public” (without defining it), “the public”, “Internet users” and “American and international publics”. Nor have the Parties submitted any evidence such as surveys or opinion polls that would allow the Panel to draw conclusions about a previously defined population or universe. Therefore it is up to the Panel to determine on the existing evidence, whether the relevant part of the public, more likely than not, would recognize the “moto” term as the mark of Objector or as a generic term associated with motorcycles and the like.

The Panel notes that in the graphic advertisements and the TV commercials submitted with the Objection, the word “moto”, and the Motocodes (combinations of “moto” with common words) typically are accompanied by images of cellular phones together with the mark Motorola, the typical “M” of Motorola, and the legend “Motorola Intelligence Everywhere”. Thus the Panel finds in such advertisements the distinctive character of “MOTO” is given not by this term on its own, but by all these elements together. Thus, it is legitimate to conclude that were the “MOTO” term standing alone without the addition of the supporting elements, a non-negligible portion of the targeted public, more likely than not, would not recognize the term as linked to a Motorola product. Of course, the Panel does not deny that some portion of the public might recognize “moto” as associated with Motorola or its products, but in the Panel's estimation it likely would not be a substantial portion of the public.

Moreover, the Panel considers that many present users and/or potential buyers of cell phones and smartphones are also speakers of or knowledgeable in languages in which “moto” is a common noun related to motorcycles or motor powered vehicles. See Panel's opinion under Factor 1, above. Having this in mind, and on the available evidence, the Panel does not believe that among the international public recognitions of “moto” as Objector's mark would outnumber or even match recognitions of “moto” as a generic term, or would not recognize both meanings of the term, more likely than not.

As to the examples of specialized media coverage submitted by Objector, where “Moto” is used as short for Motorola, the Panel believes that they are not necessarily representative of the use of the term by typical consumers or users of cell phones and smartphones. The media articles submitted with the Objection are highly specialized and clearly addressed to the business, advertising and marketing sectors. These articles do not provide examples of use of the term “moto” by the general public, or even by consumers of Motorola

products in general. Moreover the readers of these publications are sophisticated and presumably familiar with the existence of TLDs and therefore not likely to fall into any confusion of the applied-for gTLD with Motorola or Objector's MOTO marks. Also, the Panel believes that it is likely that they also are aware that "moto" is a generic term usually referred to motorcycles.

As to Internet users in general, the Panel believes that nowadays they are used to Internet addresses and TLDs. Users see, type in, and obviously recognize TLDs appearing on the screens of their PCs, notebooks, notepads and smartphones on a daily basis. Since these artifacts are increasingly converging into one another, there appears to be no serious risk that the users of these items or "the Internet public" more likely than not would recognize <.moto> as Objector's MOTO mark other than occasionally or temporarily. There is no concrete evidence showing otherwise.

Finally, there is no evidence on the record that either Applicant or any third party owns any mark in "moto".

The Panel believes that this factor should count as neutral.

**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.**

Objector contends that Applicant had knowledge of Motorola's rights in the internationally famous MOTO mark, with extremely strong consumer recognition and media presence. Objector further contends that since this mark is famous, Applicant certainly had knowledge of Motorola's trademark rights when it applied for the <.moto> string. Applicant could not have reasonably been unaware of Motorola's MOTO mark. Moreover, adds Objector, given the sophisticated nature of the publicly owned entity operating Applicant, it cannot be reasonably argued that Applicant or its parent company is unaware of Motorola or the MOTO marks.

Objector further contends that Applicant's parent company and affiliates have engaged in a pattern of applying for, operating, and/or permitting registrations identical or confusingly similar to the marks of others. Applicant's parent company, Demand Media, and its numerous other Demand Domains subsidiaries are part of the more than 140 entities that comprise the Demand Media "family" of entities. Public filings reveal that the Demand Media Group has, collectively, been the respondent in at least 39 adverse UDRP decisions. Thus, there is evidence to indicate that Applicant and its parent and affiliated companies engaged in a pattern of conduct whereby it applied for or operates TLDs or registrations in TLDs that are identical or confusingly similar to the marks of others.

Applicant contends that whether it knew of Objector's alleged trademark rights at the time of filing its gTLD application is irrelevant. Applicant disputes that Objector owns exclusive rights in MOTO or any MOTO-formatives because "moto" is generic. As <.moto> is one of many generic gTLDs Applicant has applied for, Applicant's good-faith intent is clear.

Applicant further contends that Objector's attempt to portray Applicant as having a pattern of applying for registrations in TLDs that are confusingly similar to the marks of others has no merit. Applicant has not been the subject of any adverse UDRP decisions. Moreover, Applicant has cleared ICANN's background checks in connection with five of its gTLD applications, demonstrating that ICANN has cleared and approved Applicant's eligibility to operate gTLD registries.

**Panel's Findings under Factor 4**

Objector is right that it would be hard to believe for sophisticated parties such as Applicant that they would not conduct appropriate trademark and Internet searches. Indeed it is reasonable to assume that an applicant for the operation of a TLD registry would conduct reasonable and affordable searches for a sign used in an applied-for gTLD on the most obvious databases, such as TESS of the USPTO, and similar

others elsewhere, as well as searches on the Internet by using regular search engines. The rationale for this assumption is the one adopted by some UDRP panels, as reported in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”), paragraph 3.4.

Also, Applicant does not deny that it knew of Objector’s MOTO mark when it applied for the <.moto> gTLD, but argues that this knowledge would be irrelevant.

Accordingly, the Panel finds that Applicant likely knew of Objector’s MOTO marks when it applied for the <.moto> gTLD.

Also, the Panel believes that the evidence provided in this case does not support that Applicant itself, for purposes of this Factor, 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.

Here, while Applicant has been found to have known of Objector and its MOTO mark by the time of the Application, the use of the generic term “moto” in the applied-for gTLD is consistent with the stated purpose.

This factor is assessed as neutral.

**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.**

Objector contends that Applicant is a newly formed entity with no history of *bona fide* offering of goods or services or *bona fide* provision of information in a way that does not interfere with the legitimate exercise by Objector of its mark rights. Nor is there any indication in the application that Applicant has made preparations to use the <.moto> gTLD so as not to interfere with Motorola’s famous MOTO mark and family of Motocodes.

Applicant contends that as stated above and in the application, Applicant has made demonstrable preparations to use <.moto> in a *bona fide* manner as a generic TLD along with 25 other generic TLDs, to provide new options for millions of consumers, businesses, and other organizations on the Internet to share information, experiences, and ideas, and the commercialization of goods and services relating to the motorcycling, motor-vehicle, and other moto fields.

Applicant concludes that it has committed to implementing numerous trademark protection mechanisms that go beyond the requirements mandated by ICANN. These are more than sufficient to address the concerns articulated by Objector over abuse at the second level.

**Panel’s Findings under Factor 5**

The Panel notes that the sign corresponding to the gTLD is the term “moto”, and that there is no contention or evidence on the record that previous to its Application, Applicant has ever used it in connection with an offering of goods or services or provision of information, *bona fide* or otherwise.

However, it is clear to the Panel that the application process for a new gTLD requires serious efforts in time, money, and technical abilities. In this regard, the Panel notes that Applicant appears committed to that process. There is no evidence that Applicant’s proposed rights protection mechanisms stated in the Application do not address the ability for misuse of the gTLD, or that the <.moto> gTLD will likely unjustifiably impair the distinctive character and reputation of the MOTO mark and the Motocodes, and that the lack of safeguards at the second-level will likely result in unfair advantage being taken of the MOTO mark and the Motocodes.

As concluded by the Panel under Factor 1, when the meaning is considered the applied-for gTLD is not similar in important ways to Objector's MOTO marks. As to the risk of confusion created by the gTLD itself with Objector's MOTO marks due to possible registrations of generic terms at the second level, the Panel sees no reason that the operator of a new gTLD should be held responsible for eventual fraudulent or other illegal or reprehensible actions perpetrated by future registrants of domain names, provided that such actions are not attributable to the gTLD operator. As stated in the Application, Applicant intends to apply adequate measures and mechanisms to minimize abusive activities and protect the legal rights of others.<sup>3</sup>

Whether such measures and other additional precautions proposed by Applicant once the gTLD is delegated will be sufficient to afford reasonable protection to trademark owners, the Panel cannot say with certainty.

Without evidence showing otherwise, the Panel believes that the intended use in a gTLD of the generic term "moto" in respect of motorcycles and related activities, under the circumstances demonstrated in this case, is legitimate and *bona fide*.<sup>4</sup>

Accordingly, the Panel finds that Applicant has made demonstrable preparations to use the corresponding sign to the applied-for 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 Objector of its mark rights.

This factor favors Applicant.

**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.**

Objector contends that Applicant has no trademark rights or other intellectual property rights that would correspond to the <.moto> string.

Applicant contends that its purpose in seeking the generic gTLD <.moto> is to provide an open namespace for those interested in the gTLD because it generically refers to motorcycles, motor-equipped vehicles, and the like. Applicant does not claim to own any proprietary rights in the generic word "moto" and, accordingly, this factor is irrelevant. Moreover, Applicant's activities regarding <.moto> and its other generic gTLD applications are and have always been *bona fide*.

**Panel's Findings under Factor 6**

Applicant does not state that it has marks or other intellectual property rights in the "moto" term.

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<sup>3</sup> In the Application, Applicant stated "United TLD is implementing a broad array of protection mechanisms that we believe will make this TLD a safer place than existing TLDs, with fewer instances of abuse. These protections include eight innovative mechanisms that substantially exceed the protections specified in the TLD applicant guidebook. These mechanisms are: 1. Periodic audit of Whois data for accuracy; 2. Remediation of inaccurate Whois data, including takedown, if warranted; 3. A new Domain Protected Marks List (DPML) product for trademark protection; 4. A new Claims Plus product for trademark protection; 5. Terms of use that prohibit illegal or abusive activity; 6. Limitations on domain proxy and privacy service; 7. Published policies and procedures that define abusive activity; and 8. Proper resourcing for all of the functions above. Our protection mechanisms also include fourteen new measures that were developed specifically by ICANN for the new TLD process. These are: 1. Controls to ensure proper access to domain management functions; 2. 24/7/365 abuse point of contact at registry; 3. Procedures for handling complaints of illegal or abusive activity, including remediation and takedown processes; 4. Thick Whois; 5. Use of the Trademark Clearinghouse; 6. A Sunrise process; 7. A Trademark Claims process; 8. Adherence to the Uniform Rapid Suspension system; 9. Adherence to the Uniform Domain Name Dispute Resolution Policy; 10. Adherence to the Post Delegation Dispute Resolution Policy; 11. Detailed security policies and procedures; 12. Strong security controls for access, threat analysis and audit; 13. Implementation DNSSEC; 14. Measures for the prevention of orphan glue records.")

<sup>4</sup> See Paris Convention, Article 6quinquies, B(ii).

Accordingly, the Panel finds that Applicant does not have marks or other intellectual property rights in the sign corresponding to the applied-for gTLD.

Applicant stated in the Application that it intends to dedicate the applied-for gTLD to activities related to motorcycles and motor-powered vehicles. Since as found under Factor 1 “moto” is a word with dictionary or generic meanings referring to motorcycles or moto-related activities, the Panel would find it extremely unlikely if not impossible to obtain a trademark registration for MOTO to protect motorcycles..

Accordingly, the Panel considers that this factor is neutral.

**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*.**

Objector contends that Applicant, a newly formed entity for purposes of the New gTLD Program, is not known by or associated with the <.moto> gTLD or motor equipment enthusiasm of any kind. Objector further contends that Applicant is a domain name investor and its <.moto> gTLD trades off the already established and existing goodwill in the MOTO mark and the family of Motocodes.

Applicant does not claim to be commonly known by the sign corresponding to the gTLD, and argues that the word “moto” is a generic term, and that Applicant’s proposed use of <.moto> is consistent with that generic meaning.

**Panel’s Findings under Factor 7**

The Panel finds that Applicant has not been commonly known by the sign corresponding to the applied-for gTLD. Also, the Panel finds no evidence on the case file suggesting that the purported or likely use of the gTLD by Applicant as stated in the Application might not be *bona fide*.

This factor is neutral.

**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.**

Objector argues that Motorola’s MOTO mark is identical in sight, sound and meaning to the <.moto> string, and contends that as discussed above, this factor alone should be dispositive of a finding of a likelihood of confusion. Here, argues Objector, the MOTO mark is identical to the proposed <.moto> gTLD. therefore the goods or services that are provided need not be similar or related for there to be a likelihood of confusion. There is no limitation on how the public can use the <.moto> gTLD. Applicant is planning on operating an open registry that would allow anyone to register a domain name at the second level, such as <mobile.moto> or <phones.moto> and offer goods and services directly competing with Motorola. As a result consumers would believe that such domains are associated with, sponsored by, or otherwise affiliated with Motorola. Such use of the gTLD would create a likelihood of confusion as to the source, sponsorship, and affiliation of Motorola in connection with the gTLD and associated second level domain name registrations. Objector Motorola advertises its products on its websites available at the “www.moto.com”, “www.motorola.com” and “www.motoactiv.com” websites, among others. Motorola products and services are also offered for sale over the Internet. Thus, delegating a <.moto> gTLD would undeniably cause consumers to believe that such gTLD is a source for Motorola products and services. This factor weighs in favor of a finding of likelihood of confusion. As to the sophistication of purchasers, Objector contends that the purchasers of Motorola’s products are ordinary consumers, which are more likely to be confused than professional buyers. Objector contends that purchasers of Motorola’s products, the domain name registrants, and the consuming public viewing <.moto> second level domains are ordinary consumers that are not sophisticated in viewing domains and the content therein with any discrimination or significant level of care and as a result may be easily confused. Therefore, this factor must weigh heavily in favor of a finding of a likelihood of confusion.

Objector concludes that when these factors are weighed, it is clear that Applicant's intended use of <.moto> is likely to create confusion as to the source, as well as Motorola's sponsorship, affiliation, and endorsement of the gTLD. Given the prominence of Motorola in the telecommunications, software, hardware, and related fields, the applied-for gTLD is likely to unjustifiably impair the distinctive character or the reputation of the Motorola's MOTO marks, and to create an impermissible likelihood of confusion between the <.moto> gTLD and Motorola's MOTO marks.

Applicant contends that <.moto> is neither identical nor confusingly similar to Objector's alleged trademark. Regarding the parties' respective goods and services, Applicant's domain name registry services clearly differ from Objector's telecommunications services. Objector's argument that the goods and services are competitive and the channels and advertising methods the same simply because a customer might register a mobile-phone related second-level domain under <.moto> misses the mark. Virtually all goods and services are promoted online today, but this does not make them all similar. Applicant argues that it is not the case, as Objector claims that ordinary consumers are unsophisticated in viewing domains with any significant level of care and may easily be confused.

Applicant concludes that a balancing of these factors favors Applicant, since there is a presumption generally in favor of granting new gTLDs to applicants who can satisfy the requirements for obtaining a gTLD – and, hence, a corresponding burden upon a party that objects to the gTLD to show why that gTLD should not be granted to applicant.

#### **Panel's Findings under Factor 8**

Objector essentially contends that since the applied-for gTLD is open, registrants could register second level domains names such as "cellular" or the like, and that in combination with <.moto> such domain names would unavoidably create a likelihood of confusion with Objector's mark.

This factor requires that the Panel anticipate the consequence of the intended use of the applied-for gTLD, which, as stated by Applicant in the Application, is to create a namespace dedicated to those interested in, or with activities related to motorcycles and motor vehicles. See Factual Background above.

The Panel, assuming that future second level domains in <.moto> would largely reflect such affinity or interests, does not see any special reason to conclude that Applicant's intended use would create an *impermissible* likelihood of confusion with Objector's mark as to the source, sponsorship, affiliation or endorsement of the gTLD. In this regard, the Panel considers that Objector's MOTO and MOTO-formative marks are being used to protect goods and services in classes 9, 35, 37, 38 and 42, which are not related to motorcycles and motor vehicles, while the applied-for gTLD has a chiefly generic and common meaning for motorcycles and motor-vehicles. See Panel's Findings under Factor 1 above.

As any other provision reasonably construed, the Panel believes that the expression "intended use" means in the LRO context "use by Applicant as stated in its Application" rather than the mere possibility for some abusive registrations at the second level. As put by the panel in *Express, LLC v. Sea Sunset, LLC*, WIPO Case No. LRO2013-0022, "[a]s manifest from the long functioning of the .com, .org, .net and other gTLD registries, and the literally thousands of disputes under the UDRP (as well as national court proceedings) there are a myriad of ways in which second-level domains may create a likelihood of confusion with respect to trademarks. Does the use by existing registries of the .com, etc., gTLDs 'create' a likelihood of confusion with respect to trademarks? Yes, in a sense, because without the operation of those registries, prospective domain name registrants would have more limited *fora* in which to take unfair advantage of trademark rights. But, as a general proposition, registries operating in a *bona fide* manner are not held legally responsible for allowing domain names to be registered that create a likelihood of confusion with respect to existing trademarks. It is the domain name registrants that are legally responsible."

The Panel certainly does not deny that potentially, some second-level domains in any open registry might interfere with third-party marks. However in the case of the applied-for gTLD, Applicant intends that several



mechanisms and remedies be in place to counter or control undesirable consequences of some domain name registrations. Differing from the first round of gTLDs, the launching of the present round provides for new mechanisms adding several layers of protection for rights holders. In particular, Applicant has stated in its Application that it will apply such protection measures.

It is the burden of Objector to convince the Panel that the intended use of the applied-for gTLD, more likely than not, will be operated other than *bona fide*, but Objector failed to do so.

The Panel concludes that Applicant's intended use of the gTLD would not create a likelihood of confusion with Objector's mark as to the source, sponsorship, affiliation, or endorsement of the gTLD.

This factor favors Applicant.

#### **D. Conclusion**

The Panel's finding under Factor 8 refers to the *intended* use of the applied-for gTLD, while the present conclusion regards the *potential* use of the gTLD by Applicant. This requires a broad anticipation of possible actions of Applicant in conjunction with the actions of third parties, to a reasonable extent. As stated by the panel in *AC Webconnecting Holding B.V. v. United TLD Holdco Ltd*, WIPO Case No. LRO2013-0006, "[t]he applicant's potential use includes both actual proposed use and reasonably likely use."

Since a registrant may register a second level domain that, in conjunction with the gTLD, might be confused with Objector's compound marks, the likelihood of confusion cannot be discarded. However, for a likelihood of confusion to constitute infringement of a trademark holder's rights under the Procedure, it should be *impermissible*. This is a term that sets a heavy burden on an objector, in that mere likelihood does not suffice, as stated by the panel in *Right At Home v. Johnson Shareholdings, Inc.*, WIPO Case No. LRO2013-0030: "[t]he use of the terms 'unfair,' 'unjustifiably,' and 'impermissible' as modifiers, respectively, of 'advantage,' 'impairs,' and 'likelihood of confusion' in Section 3.5.2 suggests that there must be something more than mere advantage gained, or mere impairment, or mere likelihood of confusion for an Objection to succeed under the Procedure. It seems, rather, that there must be something untoward – even if not to the level of bad faith – in the conduct or motives of Respondent, or something intolerable in the state of affairs which would obtain if the Respondent were permitted to keep the String in dispute."

Thus, a certain level of coexistence of signs, including mere likelihood of confusion, must be tolerated by trademark holders, and especially so if the likelihood is due even in part to the fact that the term constituting the gTLD has a generic or dictionary meaning. As concluded by the panel in *United States Postal Service v. Amazon EU S.à.r.l*, WIPO Case No. LRO2013-0044, "a trademark owner that incorporates a generic term into its trademark must bear the risk of confusion resulting from the use of the term in its generic sense, even by potential competitors".

The Panel believes that to the extent that the mark MOTO, used as shown in the advertising and TV commercials submitted by Objector, has acquired distinctive character and reputation in respect of cell phones, it would probably be recognized as such by a portion of the relevant public. Similarly, as seen under Factor 1, other portions of the relevant public, and particularly, but not only, those speaking Spanish, Portuguese, French or Italian would likely recognize the term "moto" as referring to motorcycles. Still others – whatever their language – may also come to recognize the term as a new gTLD. Accordingly, the Panel does not believe that any distinctive character or reputation that Objector's MOTO mark may enjoy, could be *unfairly* impaired by, or taken advantage of, by Applicant's potential use of the <.moto> gTLD.

In conclusion, the Panel finds as follows:

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

- (i) take unfair advantage of the distinctive character or the reputation of objector's registered or unregistered trademark or service mark, or

- (ii) unjustifiably impair the distinctive character or the reputation of objector's mark, or
- (iii) otherwise create an impermissible likelihood of confusion between the applied-for gTLD and objector's mark.

#### **7. Expert Determination**

For all the above reasons, the Objection is rejected.

[signed]

**Roberto Bianchi**  
Sole Panel Expert  
Date: August 8, 2013