

## **EXPERT DETERMINATION LEGAL RIGHTS OBJECTION**

Latin American Telecom, LLC v. Charleston Road Registry Inc.

Case No. LRO2013-0055

### **1. The Parties**

The Objector/Complainant is Latin American Telecom, LLC of Pittsburgh, Pennsylvania, United States of America, represented by ESQwirecom, P.C., United States.

The Applicant/Respondent is Charleston Road Registry Inc. of Mountain View, California, United States, represented by Katten Muchin Rosenman LLP, United States.

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

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

### **3. Procedural History**

The Legal Rights Objection (the "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 completed the review of the Objection on March 25, 2013, and determined that the Objection complies with the requirements of the Procedure and the World Intellectual Property Organization Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections (the "WIPO Rules for New gTLD Dispute Resolution").

In accordance with Article 11(a) of the Procedure, the WIPO Center formally notified the Applicant of the Objection, and the proceeding 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 16, 2013.

The WIPO Center appointed Professor Ilhyung Lee 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 19, 2013:

- The Objector transmitted to the WIPO Center, with a copy to the Applicant, the “Objector’s Additional Submission and Reply to Applicant’s Response,” and “Request for Leave to File an Additional Submission”.
- The WIPO Center acknowledged receipt of the Objector’s transmission, and stated, with a copy to the Applicant, “The Expert Panel will be notified of the receipt of your communication and any further steps in this regard will be a matter for the Panel to consider in its discretion.”
- The Applicant transmitted to the WIPO Center, with a copy to the Objector, its objection to the Objector’s additional submission, and requested “that the Panel deny Objector’s request to file additional written statements in this objection, and that the Additional Submission be stricken from the record.”
- The Objector replied to the Applicant’s objection, and stated in conclusion, “please forward our Additional Submission to the Panelist . . . .”

On June 26, 2013, the Panel issued Procedural Order No. 1, stating:

“[T]he Panel hereby grants the Objector’s request for leave to file its additional submission (‘Additional Submission’). The Applicant will have the opportunity to submit a reply (‘Reply’).

The Applicant’s Reply should relate only to observations and arguments brought forward in the Additional Submission. The Reply should be filed electronically with the Center . . . (copied to the Objector) within seven (7) days from the date of this Procedural Order.

It will remain at the discretion of the Panel to rely on any of these submissions (i.e., Additional Submission and Reply) when drafting its Expert Determination.”

On July 4, 2013 (at 12:10 a.m. Geneva, Switzerland time), the Applicant submitted to the WIPO Center, with a copy to the Objector, its Reply, with annexes.

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

The Objector identifies itself as a Delaware limited liability company, with its principal place of business in Pittsburgh, Pennsylvania. On April 3, 2012, it received from the United States Patent and Trademark Office registration for the service mark TUBE (Registration No. 4,122,107), for: “Advertising and commercial information services, via the internet . . .” (International Class 35); “Audio and video broadcasting services over the Internet . . .” (International Class 38); “Education information; Entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials . . .” (International Class 41); “Computer services in the nature of customized web pages featuring user-defined information, personal profiles and information . . .” (International Class 42); and “Providing on-line information via the Internet in the fields of animals and pets . . .” (International Class 44).

According to its chief executive officer, the Objector filed with the Internet Corporation for Assigned Names and Numbers (“ICANN”) its own application for the new gTLD <.tube>, on April 12, 2012. Another entity, Boss Castle, LLC, not party to the present case, also applied for the <.tube> gTLD.

The Applicant identifies itself as a Delaware corporation, with its principal place of business in Mountain View, California, and states that it is wholly owned by Google Inc. The Applicant filed its gTLD application for the <.tube> string, originally posted on June 13, 2012. The application includes the following statements:

- “Google is an American multinational public corporation and global technology leader focused on improving the ways its hundreds of millions of users connect with information.”

- "In line with Google's general mission, [the Applicant's] mission is to help make information universally accessible and useful by extending the utility of the DNS while enhancing the performance, security and stability of the Internet for users worldwide. . . . [The Applicant's] business objective is to manage Google's gTLD portfolio and Google's registry operator business."
- "The sole purpose of the proposed gTLD, .tube, is to host select YouTube channels' digital content. The proposed gTLD will introduce a dedicated Internet space in which select YouTube channel providers can link to the content hosted on their respective YouTube page. All registered domains would automatically be delegated to YouTube's DNS servers, which would in turn provide authoritative DNS responses pointing the user's web browsers to the YouTube service."<sup>1</sup>

Google Inc. holds trademark registrations in the YOUTUBE mark.

## 5. Parties' Contentions

### A. Objector

The Objector contends principally that: it is a rights holder in the TUBE mark, which it has used and for which it has received registration; it has standing to file an objection; the string comprising the potential new gTLD <.tube> infringes the Objector's existing legal rights that are recognized or enforceable under generally accepted and internationally recognized principles of law; and 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 mark, (ii) unjustifiably impairs the distinctive character or the reputation of the Objector's mark, and (iii) otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the Objector's mark.

The Objector also states, *inter alia*:

- "Since 2008, Objector has invested substantial time and money to create the largest network of '.com' TLD websites with domain names that contain the word 'tube.' . . . Objector has taken a concept, built a business unit, and developed the TUBE<sup>®</sup> brand that culminated in the filing of Objector's gTLD Application for the string .TUBE."<sup>2</sup>
- "Objector has been planning for the development and launch of its own .TUBE gTLD since shortly after ICANN's Board voted to proceed with the development of applicable rules for the submission of new gTLD applications . . . in June 2008."<sup>3</sup>
- "Conversely, Applicant applied for .TUBE without any trademark rights and with the stated intent to run the gTLD as a closed registry and as an extension of its YouTube brand. . . . Applicant's sole intent is to dominate the online video marketplace and expand its own brand at the expense of Objector's Trademark rights and brand. Applicant is further trampling the rights of Objector by seeking an exemption from ICANN to run .TUBE as a closed registry to promote YOUTUBE . . . ."<sup>4</sup>
- "Applicant's plan is to maintain YouTube's dominance in online video distribution in a manner that would bar bona fide third party domain registrations in .TUBE from potential competitors, like Objector. Notwithstanding the clearly stated anticompetitive actions Applicant would take were the gTLD granted to Applicant, it would irreparably harm Objector by rendering Objector's Trademark rights and years of investment and development of TUBE<sup>®</sup> useless."<sup>5</sup>

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<sup>1</sup> Annex 1 to Objection at 7.

<sup>2</sup> Objection at 4-5.

<sup>3</sup> *Id.* at 5.

<sup>4</sup> *Id.*

<sup>5</sup> *Id.* at 6.

The Objector's other relevant contentions are included herein.

## **B. Applicant**

The Applicant contends principally that the applied-for gTLD will not infringe the existing legal rights of the Objector, and that the potential use of the gTLD by the Applicant does not (i) take unfair advantage of the distinctive character or the reputation of the Objector's mark, (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 Applicant's gTLD and the Objector's mark.

The Applicant also states, *inter alia*:

- "Applicant/Respondent has based its applied-for TLD and Response on the right to use terms in their common everyday generic sense that is guaranteed under the principles of free expression set forth in the Paris Convention for the Protection of Industry Property, the Universal Declaration of Human Rights . . . , and the International Covenant on Civil and Political Rights . . . . As stated in its application, Applicant intends to use .TUBE in its generic sense, i.e., television or video content, to offer domain names for website owners that want to immediately indicate to Internet users that the content of the website is the website owner's video content."<sup>6</sup>
- "The mission of the proposed gTLD is to strengthen the relationship between YouTube and its content partners and to simplify the YouTube user experience. Select YouTube content distributors will be able to register a branded .tube domain (e.g., brand.tube) which will be used to host short and simple URLs that point to the distributor's YouTube page or specific offering."<sup>7</sup>
- "'TUBE' is a commonly used generic word that means, among other things, 'television' or 'online video content.'"<sup>8</sup>
- "Generic use of a term is a complete defense against all of the harms alleged by Objector."<sup>9</sup>

The Applicant's other contentions are incorporated herein.

## **6. Discussion and Finding**

### **A. Additional Submissions**

Initially, the Panel must address its authority to permit additional submissions by the Parties, who engaged in a lively exchange as to whether the Procedure allows such submissions in this matter. The Objector, "[i]n accordance with Article 17 of [the Procedure]", requested leave to file an additional submission in reply to the Applicant's Response. The Applicant objected, stating that allowing the additional submission is "in contravention of [the Procedure]" and would "unnecessarily extend the resolution of this objection"; the Applicant also described the Objector's additional submission as providing "no 'new information'" and "merely an attempt by Objector to have another bite at the apple".

In acknowledging receipt of the Objector's request, the WIPO Center stated, with a copy to the Applicant, "As noted in your message [the Procedure] envisages the submission of an Objection and a Response, with additional written submissions addressed at Article 17 of the Procedure, indicating that the provision for such

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<sup>6</sup> Response at 3.

<sup>7</sup> *Id.* at 3-4.

<sup>8</sup> *Id.* at 4.

<sup>9</sup> *Id.* at 8.

submissions would be a matter solely for the Expert Panel in its determination.”

Indeed, Article 17 states in full:

“(a) The Panel may decide whether the parties shall submit any written statements in addition to the Objection and the Response, and it shall fix time limits for such submissions.

(b) The time limits fixed by the Panel for additional written submissions shall not exceed thirty (30) days, unless the Panel, having consulted the [Dispute Resolution Service Provider, here, the WIPO Center], determines that exceptional circumstances justify a longer time limit.”

In this case, the Panel, in its sole discretion as provided in Article 17 – and in an effort to allow the Parties to present their objection and response in full – permitted the Objector to file its additional submission (a five-page document), and also granted the Applicant the opportunity to submit a responsive reply. The Applicant did so, submitting a reply (equivalent in length to the Objector’s additional submission), along with annexes that exceeded 140 pages. The Parties have submitted their complete arguments, and the Panel has considered them.

## **B. Objector’s Standing**

Section 3.2.2.2 of the ICANN Guidebook states in relevant part: “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.” Although the Applicant vigorously challenges the notion that the Objector has trademark rights in TUBE, the Objector has met the requirement of including in its submissions the necessary documentation to establish standing.

## **C. The Merits**

With respect to the applicable standards, Article 20(a) of the Procedure gives the Panel initial guidance: “(a) For each category of Objection identified in Article 2(e) [which includes the ‘Existing Legal Rights Objection’], the Panel shall apply the standards that have been defined by ICANN.” ICANN’s gTLD Applicant Guidebook (“ICANN Guidebook”) in turn states in Section 3.5.2:

“[A] DRSP panel of experts presiding over a legal rights objection will determine whether the potential use of the applied-for gTLD by the applicant takes unfair advantage of the distinctive character or the reputation of the objector’s registered or unregistered trademark or service mark (‘mark’) . . . , or unjustifiably impairs the distinctive character or the reputation of the objector’s mark . . . , or otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector’s mark . . . .”

The Parties disagree as to whether the Objection meets the standards. A basic premise of Section 3.5.2 is that the Objector has *trademark* rights. The Objector asserts that it holds rights in the TUBE mark; the Applicant insists that “tube” is a generic term for the products or services at issue here, with no trademark significance. If the Applicant is correct, then the Objector has no rights in the TUBE mark,<sup>10</sup> and under Section 3.5.2, the Objection cannot be sustained.

In considering whether a contested mark is generic, the Panel must examine the consuming public’s understanding of the term. In this inquiry, courts have looked to “purchaser testimony, consumer surveys, dictionary definitions, trade journals, newspapers and other publications.”<sup>11</sup> A 2002 print edition of *Webster’s* provides a lengthy list of definitions of “tube”, including: “a hollow elongated usu. cylindrical body that is

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<sup>10</sup> 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12:1 (4th ed. 2013) (“The name of a product or service itself – what it is – [c]annot [b]e a [t]rademark for [t]hat [t]hing. . . . The terms ‘generic’ and ‘trademark’ are mutually exclusive.”).

<sup>11</sup> In re *Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344 (Fed. Cir. 2001).

used esp. to convey fluids and is mechanically nearly or precisely the same as a pipe but in use is arbitrarily associated with particular items and devices . . . a tunnel for vehicular or rail traffic . . . a tunnel housing an aqueduct or other underground duct . . . *Brit*: SUBWAY . . . INNER TUBE . . . ELECTRON TUBE . . . VACUUM TUBE".<sup>12</sup> Dictionary sites available on the Internet offer similar, if more abbreviated, definitions, and also add: "CATHODE-RAY TUBE; especially: a television picture tube . . . TELEVISION",<sup>13</sup> and "*Informal* . . . television . . . a television set."<sup>14</sup> In its submissions, the Applicant provides multiple examples of the use of "tube" in the media as a substitute for "television". It maintains that this meaning of the word "has carried over into the online space, where 'tube' has taken on a meaning for a class of websites that display audiovisual content like online 'televisions.'"<sup>15</sup> In support of this proposition, the Applicant refers to two decisions under the Uniform Domain Name Dispute Resolution Policy, in which a sole panelist described "tube" as "a common suffix for Internet sites using video material."<sup>16</sup>

In addition to dictionaries and media usage, there is, in trademark infringement actions, the matter of the use of the contested term by the plaintiff, which asserts trademark rights in the contested term (while the defendant alleges genericism). Here, the Applicant (equivalent to the defendant in the trademark infringement setting) asserts that the "Objector admits that TUBE is a generic term".<sup>17</sup> In this light, the Applicant refers to statements in the Objector's press release announcing the Objector's own application for the <.tube> gTLD:

"The term 'Tube' has become the most accepted synonym for 'video online.' What originated in Britain as slang for television has been adopted by Internet users worldwide, independent of their native language, to identify projects where uploaded videos play a considerable role in the user experience. . . .

. . . .

The market trend indicates that the term 'Tube' is being adopted by webmasters, programmers, companies, investors and consumers around the globe, and is widely associated with websites where content in video format play a central role, where consumers and users with a common/shared interest in mainstream contents create communities or affiliate with such sites."<sup>18</sup>

Undaunted, the Objector avers that it has trademark rights in TUBE, and relies heavily on the registration of its mark with the U.S. Patent and Trademark Office. The Objector warns that "a trademark registered with a national authority is sufficient evidence of trademark rights. Presentation of a federally registered trademark and/or service mark is sufficient to confer rights to Objector."<sup>19</sup> The Applicant counters, correctly, that, at least in the U.S. jurisdiction, it is not registration that confers rights in a trademark (instead, it is use), and that registrations issued by the U.S. trademark office are still subject to cancellation if deemed to be generic.

The Panel acknowledges the Applicant's case alleging the generic nature of TUBE. The Panel must also note the U.S. Patent and Trademark Office's registration, which includes the notation of "first use" and "in commerce" of the mark, in February 2012 (for Class 35), August 2008 (Classes 38 and 41), February 2009 (Class 42), and May 2010 (Class 44).

The Panel notes that it 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. With registration of the TUBE mark confirmed by the U.S. Patent and

<sup>12</sup> *Webster's Third New International Dictionary of the English Language Unabridged* 2459 (2002).

<sup>13</sup> <http://www.merriam-webster.com> ("tube").

<sup>14</sup> <http://dictionary.com> ("tube").

<sup>15</sup> Applicant Reply at 2.

<sup>16</sup> *E.g., Prada S.A. v. Redemption Ltd.*, D2009-1183 (Panelist Michael J. Spence) (<pradatubes.com>); *Prada S.A. v. Roberto Baggio*, D2009-1187 (same) (<pradatube.com>).

<sup>17</sup> Response at 4.

<sup>18</sup> *Latin American Telecom LLC Applies for Top Level Domain Name: ".TUBE"*, <http://www.tubegtld.com/news/o/latin-american-telecom-llc-applies-for-top-level-domain-name-tube>.

<sup>19</sup> Objector Additional Submission at 3.

Trademark Office, and with no evidence offered to contest the registration's validity or existence, there is a presumption of validity.

Acknowledging the Objector's colorable rights in the mark TUBE then, Section 3.5.2 of the ICANN Guidebook instructs, "where the objection is based on trademark rights, the panel will consider the following non-exclusive factors", which the Panel will address in turn.

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

The Objector's existing mark is TUBE. The applied-for gTLD is <.tube>. This factor favors the Objector.

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

The Panel concludes that the Objector's acquisition and use of rights in its mark, TUBE, is bona fide. There is no evidence to suggest the contrary. The trademark registration materials indicate that the Objector began use of the mark in August 2008, and filed its application for registration that same month. This factor also favors the Objector.

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."

The Objector states that since 2008, it "has owned and/or developed at least 1878 \*\*\*TUBE.com domain names."<sup>20</sup> The Objector also emphasizes its substantial efforts to advertise and promote its domain channels. Yet it is unclear to the Panel whether the consuming public associates the Objector with the TUBE mark, or instead, with the hundreds of domain names that merely contain the "tube" phrasing, preceded by another term. The record simply does not reveal evidence to indicate public recognition of the gTLD as the mark of the Objector, or for that matter, as that of any party. According to the Applicant, this is because of the generic nature of the term. This factor leans to the Applicant.

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."

The Objector contends that "it is more likely than not that the Applicant was aware of Objector's Trademark rights when Applicant applied for the .TUBE gTLD string."<sup>21</sup> The Applicant emphasizes again the generic nature of the term, and states that its "actual or constructive knowledge of Objector's Marks" is "irrelevant to this analysis."<sup>22</sup> Moreover, this is not a situation, the Applicant argues, where the applicant has applied for or operates TLDs that are identical or confusingly similar to the marks of others.<sup>23</sup>

Given the Parties' contentions in Section 5 herein, the matter of the Applicant's intent in applying for the new gTLD requires a more full examination. In its application, the Applicant stated that it "intends to apply for an exemption to ICANN's Registry Operator Code of Conduct and operate the proposed gTLD with Google as the sole registrar and registrant. This facilitates Google's ability to further enhance the YouTube brand and the reputation of YouTube offerings . . . ."<sup>24</sup> The Objector contends that this indicates the Applicant's intent "to dominate the online video marketplace and expand its own brand at the expense of Objector's Trademark rights and brand", which would "bar bona fide third party domain registrations in .TUBE from potential

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<sup>20</sup> Objection at 10.

<sup>21</sup> *Id.* at 12.

<sup>22</sup> Response at 7.

<sup>23</sup> *Id.*

<sup>24</sup> Annex 1 to Objection at 9.

competitors, like Objector”<sup>25</sup>.

On the record before it, the Panel cannot say that the Applicant’s intent in applying for the gTLD, or the exemption, is improper or untoward.

Whether this factor is relevant here, or favors either party, is uncertain.

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.”

The Applicant affirms that it has made demonstrable preparations to use the gTLD, and also promises “to adopt rights protection mechanisms above and beyond those required by ICANN in the Guidebook and to act in good faith to minimize the interference with the legitimate exercise by the objector and others of their mark rights.”<sup>26</sup> The Objector states that the Applicant’s “use will directly interfere” with the Objector’s rights in its mark.<sup>27</sup> It appears to the Panel that in light of the circumstances of this Objection, the fifth factor – apart from the reference to the applicant’s use or preparations to use – returns to the ultimate question of whether the Applicant’s use of the applied-for gTLD string infringes the Objector’s valid trademark rights. This factor as such does not shed much light.

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.”

Regarding this factor, the Objector states only, “Applicant does not have trademark rights for TUBE”,<sup>28</sup> to which the Applicant responds that “tube” is a generic term, and that it intends to use the term in the generic sense, and not to acquire intellectual property rights in the gTLD. The Applicant also urges that “this factor should be weighed neutrally or less than the other factors because it is less relevant where the gTLD at issue is a generic term and the gTLD[’]s intended use is as a generic term.”<sup>29</sup> The Panel notes that if this factor should be read to weigh in favor of the Applicant *only* if it can show that it meets the condition identified (i.e., ownership of a mark or rights in the sign corresponding to the gTLD), then it would favor the Objector here.

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.”

The Applicant does not assert that it is commonly known by the sign corresponding to the gTLD. It also questions the relevance of this factor here.

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.”

As Professor McCarthy informs, “likelihood of confusion” is the “basic test”, indeed, “the [k]eystone”, of trademark infringement.<sup>30</sup> Courts have employed “a multi-factor test to assist in the difficult determination of

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<sup>25</sup> Objection at 5-6.

<sup>26</sup> Response at 7.

<sup>27</sup> Objection at 12.

<sup>28</sup> *Id.*

<sup>29</sup> Response at 8.

<sup>30</sup> 4 *McCarthy*, *supra* note 10, § 23:1.



whether there is or is not a likelihood (probability) of confusion”.<sup>31</sup> For instance, the U.S. Court of Appeals for the Third Circuit has applied the “*Lapp* factors”:

“(1) degree of similarity between the owner’s mark and the alleged infringing mark; (2) strength of the owner’s mark; (3) price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase; (4) length of time the defendant has used the mark without evidence of actual confusion; (5) intent of the defendant in adopting the mark; (6) evidence of actual confusion; (7) whether the goods, though not competing, are marketed through the same channels of trade and advertised through the same media; (8) the extent to which the targets of the parties’ sales efforts are the same; (9) the relationship of the goods in the minds of consumers because of the similarity of function; and (10) other facts suggesting that the consuming public might expect the prior owner to manufacture a product in the defendant’s market or that he is likely to expand into that market.”<sup>32</sup>

The Court of Appeals for the Ninth Circuit employs the similar “*Sleekcraft* factors”:

“Those factors include: (1) strength of the allegedly infringed mark; (2) proximity or relatedness of the goods; (3) similarity of the sight, sound, and meaning of the marks; (4) evidence of actual confusion; (5) degree to which the marketing channels converge; (6) type of the goods and degree of care consumers are likely to exercise in purchasing them; (7) intent of the defendant in selecting the allegedly infringing mark; and (8) likelihood that the parties will expand their product lines.”<sup>33</sup>

Courts have noted that the list of factors “is neither exhaustive nor exclusive”,<sup>34</sup> “[t]he presence or absence of a particular factor does not necessarily drive the determination of a likelihood of confusion”,<sup>35</sup> and “[n]o single . . . factor is determinative.”<sup>36</sup>

(The Panel notes that two of the factors in determining likelihood of confusion in trademark infringement have equivalent counterparts in the ICANN Guidebook. The similarity of the plaintiff’s and defendant’s marks in the likelihood of confusion analysis is equivalent to the similarity of the objector’s mark to the applicant’s gTLD in the ICANN Guidebook version. Likewise, the defendant’s intent in using the mark in the infringement context is akin to the applicant’s intent in applying for the gTLD string.)

In the consideration of the various factors to determine likelihood of confusion, some courts have emphasized certain factors over others, as the Parties note. The Objector relies on the pronouncement by one court that “[t]he single most determinative factor . . . is mark similarity”,<sup>37</sup> while the Applicant emphasizes another court’s declaration that the strength (or weakness) of the plaintiff’s mark is “[a] vital factor”.<sup>38</sup> Other courts have noted that actual confusion is “obviously the most probative proof”<sup>39</sup> and “the most persuasive evidence”.<sup>40</sup> Yet another court has advised that “the similarity of the marks, evidence of actual confusion, and the defendant’s intent are the three ‘most important’ factors in the likelihood of confusion analysis,” but adds, “there is ‘no hard and fast requirement’ that all three of these factors must weigh in the plaintiff’s favor

<sup>31</sup> *Id.*

<sup>32</sup> *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 224 (3d Cir. 2005) (citing *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 463 (3d Cir.1983); *Scott Paper Co. v. Scott’s Liquid Gold, Inc.*, 589 F.2d 1225, 1229) (3d Cir.1978)).

<sup>33</sup> *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1290 (9th Cir. 1992) (citing *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–54 (9th Cir.1979)).

<sup>34</sup> *Id.*

<sup>35</sup> *Id.* at 1290-91.

<sup>36</sup> *Plus Products v. Plus Discount Foods, Inc.*, 722 F.2d 999, 1004 (2d Cir. 1983). See *Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.*, 269 F.3d 270, 280 (3d Cir. 2001) (“[n]one of these factors is determinative”).

<sup>37</sup> *A&H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 216 (3d Cir. 2000).

<sup>38</sup> *Sun Banks of Florida, Inc. v. Sun Federal Savings & Loan Ass’n*, 651 F.2d 311, 315 (5th Cir. 1981).

<sup>39</sup> *U.S. Structures, Inc. v. J.P. Structures, Inc.*, 130 F.3d 1185, 1190 (6th Cir. 1997) (quoting *Frisch’s Restaurant, Inc. v. Shoney’s Inc.*, 759 F.2d 1261, 1267 (6th Cir.1985)).

<sup>40</sup> *Tana v. Dantanna’s*, 611 F.3d 767, 779 (11th Cir. 2010).

in order to find that a likelihood of confusion exists”.<sup>41</sup> Finally, the Court of Appeals for the Second Circuit has advised that strength of the plaintiff’s mark, similarity of marks, and “proximity of the products or services” are “perhaps the most significant in determining the likelihood of confusion”.<sup>42</sup>

Of the above factors highlighted in the case law: similarity of the marks (in the context of this Objection, the similarity of the Objector’s mark to the applied-for gTLD) favors, as noted above, the Objector; strength of the mark, as discussed further herein, favors the Applicant; as there is no evidence of actual confusion, this factor favors the Applicant; the relevance of the defendant’s intent in using the mark (here, the Applicant’s intent in applying for the gTLD string) is uncertain, as discussed above; given the close proximity of the Parties’ products and services, this factor favors the Objector.

The Panel acknowledges that the task of determining likelihood of confusion “must give appropriate weight to the factors that are *particularly* important based on the facts of *each* case.”<sup>43</sup> In the Panel’s view, in the present Objection, the strength of the Objector’s mark deserves significant attention. Professor McCarthy provides a good beginning point: “‘Strong’ marks are given ‘strong’ protection – protection over a wider range of related products and services and a greater spectrum of variations on visual format. Conversely, relatively weak marks are given a relatively narrow range of protection both as to products and format variations.”<sup>44</sup> The relative strength of a mark can be determined by considering “(1) Conceptual Strength: the placement of the mark on the spectrum of marks; and (2) Commercial Strength: the marketplace recognition value of the mark.”<sup>45</sup>

There is indeed a spectrum, or hierarchy, of categories of terms that trigger trademark protection. In ascending order, the four classes are: (i) generic; (ii) descriptive; (iii) suggestive; and (iv) arbitrary and fanciful.<sup>46</sup> Suggestive and arbitrary and fanciful marks are inherently distinctive, and thus, are accorded the highest level of protection. Descriptive marks may receive protection, but only with a showing of secondary meaning, that is, the consuming public’s association of the mark with the source. Generic terms have no trademark protection. The Panel concludes that when used for online video sites, the “tube” term is not particularly distinctive; it is descriptive at best.

Moreover, there is no evidence in the record to indicate that the consuming public’s recognition of TUBE is strong. As the Applicant notes, the Objector’s primary use of TUBE is with an additional term preceding it. The Objector itself states that it has created “the largest network of ‘.com’ TLD websites with domain names that contain the word ‘tube.’ Each domain name is comprised of the word ‘tube’ preceded by a generic or descriptive word to create a ‘\*\*\*TUBE.com’ domain name system.”<sup>47</sup> The Panel is inclined to agree with the Applicant’s statement that to the extent there is public association of TUBE with the Objector, it is primarily “with specific TUBE domains preceded by an additional term, and not by TUBE alone.”<sup>48</sup>

Publicly available sources indicate that the U.S. Patent and Trademark Office has allowed registration of numerous marks that incorporate the term TUBE, of which, as the Applicant notes, its parent “Google’s YOUTUBE is by far the most famous mark.”<sup>49</sup> TUBE alone may be an example of a mark that is “weak because it is merely one in a crowded market of similar marks.”<sup>50</sup>

In summary, regarding the eighth factor provided in Section 3.5.2 of the ICANN Guidebook, the Panel is

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<sup>41</sup> *CAE, Inc. v. Clean Air Engineering, Inc.*, 267 F.3d 660, 686 (7th Cir. 2001).

<sup>42</sup> *Mobil Oil Corp. Pegasus Petroleum Corp.*, 818 F.2d 254, 258 (2d Cir. 1987).

<sup>43</sup> *CAE, Inc.*, 267 F.3d at 686-87 (emphasis added).

<sup>44</sup> 4 *McCarthy*, *supra* note 10, § 23:40.50 (footnotes and citations omitted).

<sup>45</sup> *Id.*

<sup>46</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

<sup>47</sup> Objection at 4.

<sup>48</sup> Response at 4-5.

<sup>49</sup> *Id.* at 5.

<sup>50</sup> 4 *McCarthy*, *supra* note 10, § 23:40.50.

unable to conclude that the Applicant's intended use of the <.tube> gTLD would create a likelihood of confusion with the Objector's TUBE mark as to the source, sponsorship, affiliation, or endorsement of the gTLD. This factor favors the Applicant.

### **Conclusion**

The Panel concludes that the string comprising the applied-for <.tube> gTLD does not infringe the Objector's existing legal rights that are recognized or enforceable under generally and internationally recognized principles of law. More specifically, in consideration of the ICANN Guidebook's multiple factors, including and especially the likelihood of confusion analysis, the Panel is of the view that the potential use of the <.tube> gTLD by the Applicant does not: take unfair advantage of the distinctive character or the reputation of the Objector's mark; or unjustifiably impair the distinctive character or the reputation of the Objector's mark; or otherwise create an impermissible likelihood of confusion between the applied-for gTLD and the Objector's mark.

The burden is on the Objector, to "prov[e] that its Objection should be sustained in accordance with the applicable standards".<sup>51</sup> The Objector has not met this burden.

### **7. Decision**

For the reasons stated above, the Objection is rejected.

[signed]

**Ilhyung Lee**  
Sole Panel Expert  
Date: July 29, 2013

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<sup>51</sup> Procedure art. 20(c). See ICANN Guidebook § 3.5 ("The objector bears the burden of proof in each case.").