

Expert Determination LEGAL RIGHTS OBJECTION

DotMusic Limited v. DotMusic Inc.

Case No. LRO2013-0060

1. The Parties

The Objector/Complainant (the “Objector”) is DotMusic Limited of Lemesos, Cyprus, represented by Constantinos Roussos, the United States of America.

The Applicant/Respondent (the “Applicant”) is DotMusic Inc. of Al Khaimah, the United Arab Emirates, represented by Traverse Legal, the United States.

2. The applied-for gTLD string

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

3. Procedural History

The Legal Rights Objection (the “Objection”) was filed with the WIPO Arbitration and Mediation Center (the “WIPO Center”) on March 14, 2013 (March 13, 2013 UTC) 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 22, 2013 and determined that the Objection complied 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”).

The WIPO Center received a proposal from a third-party to consolidate the objections LRO2013-0057, LRO2013-0058, LRO2013-0059, LRO2013-0060, LRO2013-0061, LRO2013-0062, and LRO2013-0063 on April 25, 2013. The Objector indicated support to aspects of the consolidation proposal, which was opposed by other parties in the objections referred to in the consolidation proposal. In accordance with Article 12 of Procedure and Paragraph 7(d) of the WIPO Rules for New gTLD Dispute Resolution, the WIPO Center did not make a decision to consolidate the objections for purposes of Article 12(b) of the Procedure.

In accordance with Article 11(a) of the Procedure, the WIPO Center formally notified the Applicant of the Objection, and the proceedings commenced on April 19, 2013. In accordance with Article 11(b) and relevant communication provisions of the Procedure, the Response was timely filed with the WIPO Center on May 17, 2013.

The WIPO Center appointed Mark Partridge as the Panel in this matter on June 19, 2013. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the WIPO Center to ensure compliance with Article 13(c) of the Procedure and Paragraph 9 of WIPO Rules for New gTLD Dispute Resolution.

4. Factual Background

The Objector, one of several competing applicants for the <.music> gTLD, is the owner of European Community Trademark Registrations for .MUSIC (and design), number 008139792, and DOTMUSIC (and design), number 008139834, under goods and services classifications 35, 42, and 45 for use with, among other things:

“domain name reservation, registration, maintenance and management services; domain name searching services; domain name registry services, namely coordinating the assignment of domain names and address space; technical and legal research relating to Internet domain names” (class 45);

“Computer services, namely research, reservation, recording and administration of Internet domain names namely technical expertise relating to Internet domain names and projects; management of a web based commercial platform of Internet domain names and projects, surveying for Internet domain names and projects, design and development of Internet projects” (class 42); and

“management of databases, management of a database for Internet domain names and projects, also containing Internet domain names and other Internet addresses; administrative services provided in connection with registration and allotment of Internet domain names and other internet addresses, including renewal and assignment services” (class 35).

Representations of the marks are set out as below:



The Applicant has also applied for the <.music> gTLD with the intention of “run[ning] the registry as an open platform allowing domain registrations subject to a variety of legal rights protection procedures, including the Trademark Clearinghouse.”

5. Parties Contentions

A. The Objector

The Objector asserts that it was incorporated in 2005 to engage in e-commerce, affiliate marketing, and domain-related activities. The Objector’s business further involved domain name acquisition and monetization of an array of “.MUSIC”-themed domains, including its principal website at “www.music.us”.

The Objector filed evidence purportedly showing the fame of .MUSIC, including event sponsorships, press clippings, web search results, social media activity, and Internet traffic to its various “.MUSIC”-themed websites. The Objector asserts that it has “spent millions of dollars acquiring, developing and appropriately monetizing” its “.MUSIC”-themed domains.

The Objector alleges that the potential use of the applied-for gTLD by the Applicant:

- (i) takes unfair advantage of the distinctive character and reputation of the Objector's marks and business;
- (ii) unjustifiably impairs the distinctive character and reputation of the Objector's marks and business; and
- (iii) creates and impermissible likelihood of confusion between the applied-for gTLD and the Objector's marks and business.

The Objector also raises arguments under each of the eight non-exclusive factors relevant to a determination under the Procedure, each of which are set forth below:

1. The Objector first claims that the applied-for <.music> gTLD is similar or identical in appearance, phonetic sound, and meaning to its existing .MUSIC and DOTMUSIC marks. Objector claims that the applied-for gTLD "consists essentially of the primary formative of each of" its marks, which would "result in trading upon the brand equity and goodwill in the mark created by DotMusic's substantial global marketing efforts."
2. The Objector claims that its acquisition and use of the rights in the DOTMUSIC and .MUSIC marks has been *bona fide*. In support of this contention, the Objector notes (and appends evidence of) his "history of actual and *bona fide*" use of the .MUSIC and DOTMUSIC marks in relation to domain name registration and music services, and its "extensive marketing" in those areas. According to the Objector, it has been using these marks "to brand its domain name reservation and related services sites," which generate heavy traffic and revenues for the Objector. The Objector also reiterates its holding of European Community Trademarks, and notes that it and its marks have been "featured at major events globally relating to both the domain and music sectors in a *bona fide* manner." Finally, the Objector argues that its receipt of "letters of interest from leading and globally recognized music organizations ... to resell domains under [the Objector's] marks" evidences *bona fide* use, as well as a close association between the applied-for gTLD and the Objector's marks.
3. The Objector contends that there is substantial global recognition in the relevant sectors of the public of the sign corresponding to the gTLD as the Objector's mark. Objector claims this conclusion is supported by its marketing efforts, "significant social media presence and following," high ranking search engine results for relevant keywords, pre-registration requests, the aforementioned letters of interest, "the .MUSIC Initiative petition signed by over 1.5 million in support of DotMusic's mark," etc.
4. The Objector next claims that the Applicant had knowledge of its marks at the time the Applicant applied for the <.music> gTLD. The Objector cites its significant marketing efforts, its media exposure, and the fact that the Applicant has attended ICANN meetings as support for this contention.
5. The Objector claims to be unaware of any Applicant trademarks in .MUSIC corresponding to the gTLD, and that any use of the sign corresponding to the <.music> gTLD by the Applicant "will materially interfere with [the Objector's] marks prior and existing legal rights and create significant economic and reputational harm to [the Objector]."
6. The Objector is "unaware of the Applicant being commonly known or recognized by the relevant sector with a name using the 'DOTMUSIC' or '.MUSIC' formative."
7. The Objector argues that the Applicant's intended use of the <.music> gTLD would create a strong likelihood of confusion with the Objector's mark as to the source, sponsorship, affiliation, and endorsement of the gTLD. The Objector believes that this likelihood is especially prevalent because the "Applicant is also targeting the same recognized public as [the Objector]." The Objector argues that because the applied-for <.music> gTLD is substantively identical to the formative of the Objector's mark, and the relevant sectors are closely related, if not identical, "there should be no dispute that the Applicant's intended use of the gTLD will result in a likelihood of confusion with [the Objector's] marks" and give Applicant and "unfair advantage by piggyback [sic] [the Objector's] substantial branding equity". The Objector concludes that because it is

commonly known and recognized globally with its .MUSIC and DOTMUSIC marks by mainstream media, trade publications, and consumers, there will exist a likelihood of confusion between its marks and the applied-for gTLD “through the eyes of the average consumer in the music internet-related and domain name services sectors ... who relies upon the imperfect picture of the Mark’s [sic] kept in his mind.” This creates the “inescapable risk” that the public will believe that the domain registry services for the applied-for gTLD come from the Objector and not the Applicant.

8. Finally, the Objector contends that its rights will be impaired and harmed if the Applicant is granted authority to use the <.music> gTLD, while the Applicant has no such risk if its application is denied. The Objector again cites its extensive marketing and branding efforts, as well as the large amounts of resources expended in pursuing those efforts.

B. The Applicant

The Applicant’s overarching argument is that the Objector has not obtained legally recognized trademark rights in the generic descriptive word “music” and that its operation of the <.music> gTLD would thus not infringe upon any existing trademark rights of the Objector. The Applicant contends that the Objector’s European Community Trademarks are figurative marks, and that the Objector’s rights in those marks extend only to the design elements of the mark, not to the characters or word “music” or “.music”.

The Applicant further argues that there is no distinctive character in the words “music” or “.music”. No recognized trademark law extends protection to the dictionary word “music” alone when used to describe music-related services. For these reasons, the Applicant claims that the Objector’s marks are only protected as far as their figurative and design elements, and therefore are not infringed by the operation of an open <.music> gTLD “which, at most, describes a category of services for various dictionary meanings of the word ‘music’.”

The Applicant also responds to each of the Objector’s arguments under the eight non-exclusive factors, laid out below:

1. The Applicant first contends that the operation of a <.music> gTLD is neither similar nor identical in appearance, phonetic sound, or meaning to any trademark rights of the Objector. The Applicant reiterates that the Objector’s trademark rights are not standard character or verbal marks, but rather are limited to the figurative and stylized design elements of the mark. The Applicant argues that “no consumer would identify the standard characters for the word ‘music’ with the design elements claimed as trademark rights by the Objector.”

2. The Applicant contends that though the Objector’s acquisition and use could be *bona fide* in regards to the design and figurative elements of the marks, “to the extent Objector claims trademark rights on the dictionary word ‘music’ ... [t]he Objector’s present objection is not ‘*bona fide*.’” The Applicant notes that all promotion and sponsorship conducted by the Objector appears to be related to its figurative/design logo, which the Applicant does not intend to use, saying “Objector’s Appendix G shows marketing effort [sic] around its stylized design/figurative marks.” The Applicant further contends that unsolicited offers on any gTLD application website “establishes little more than the possible consumer awareness that the applicant might be awarded the registry,” and that the Objector has provided no evidence to support claims that consumers identify the word “music” with the Objector or its domain name registration services.

3. The Applicant reiterated much of its above argument in refuting Objector’s claim of global recognition in the relevant sector of the public.

4. The Applicant concedes that it “may have seen Objector’s logo design previously,” but reiterates that it has no intention of using Objector’s stylized figurative logo.

5. The Applicant also concedes that it has no trademark rights in the word “music”.

6. The Applicant states that it has no intention of running the <.music> gTLD registry or extension as a brand or trademark. Rather, the Applicant intends to run the registry as “an open platform allowing domain registrations subject to a variety of legal rights protection procedures.”

7. The Applicant argues that the Objector has not provided evidence that the operation of the <.music> gTLD would create any likelihood of confusion with the Objector’s figurative/design marks. The Applicant maintains its position that the Objector has no rights in the word “music,” and that the Objector is “misusing the ICANN objection process to gain leverage over other legitimate applicants for the <.music> registry.” The Applicant further posits that to the extent consumers understand that the Objector has applied for the <.music> gTLD, that is “a risk all competing applicants took in submitting to the process designed by ICANN to encourage competing bids.”

6. Discussion and Findings

In analyzing this Objection, the Panel begins with an examination of the Objector’s alleged trademark rights. To the extent that the Objector claims rights in “.music” (or “dotMusic”) *per se*, the Panel is compelled to conclude that the Objector lacks enforceable rights. The term “.music” (or “dotMusic”) would in the Panel’s opinion be recognized as a generic designation for a top-level domain name directed at or relating to music and music-related services. As a result, the Panel is of the opinion that the Objector cannot own trademark rights in the terms “.music” (or “dotMusic”) *per se* as a matter of law, even if it has developed awareness of that term as being associated with it as the name of an entity. The name is a generic term for the intended use. This conclusion is confirmed by the fact that the claimed trademark registrations utilize a design element, and do not afford trademark rights to the words alone. Similar, the action by the United States Patent and Trademark Office (the “USPTO”) to refuse registration of .MUSIC and DOTMUSIC as trademarks is based on the conclusion that the name is generic and does not serve as trademarks for a domain name registry relating to music. This situation is readily distinguishable from a situation where the senior user has established trademark rights in a brand and is seeking to prevent the use of a gTLD that matches its protectable brand. Here, the Objector lacks a protectable brand in “.music” (or “dotMusic”) *per se* because they are generic terms for its claimed services.

The analysis in this case is similar to the analysis applied to the attempted protection of LITE for beer.¹ The term “lite” was recognized as generic for beer and was therefore unprotectable as a trademark for beer. Protection was later granted in the LITE logo for the design portion only, with no protection to the generic word component of the logo. The Panel believes the same principle applies to this case.

The Objector’s protectable trademark therefore consists of the design component of its logo without protection for the generic portion comprised of “.music” (or “dotMusic”). In other words, the Panel disregards the generic portion of the mark in identifying the Objector’s trademark. In comparing the Objector’s protectable mark – specifically, the design portion of its logo – with the disputed <.music> gTLD it is apparent that they are not identical or similar. The only similarity resides in the generic and unprotectable portion of the Objector’s logo. This leads the Panel to the conclusion that the Objection must be denied.

Even if the Panel assumes that Objector has protectable rights in the terms “.music” (or “dotMusic”) the Panel believes its claim still fails because the Applicant proposes a *bona fide* use of <.music> as a generic term for a domain name registry related to music. *Bona fide* use of a generic term in its ordinary generic sense does not violate the rights of another user of that term. The Panel sees no basis for concluding that the Applicant’s use is not *bona fide* or that it is a pretext for trading on the established trademark rights of another.

It is worth noting that the Objector has had several Legal Rights Objections relating to the applied-for <.music> gTLD decided against it. In *DotMusic Limited v. Charleston Road Registry Inc.*, WIPO Case No.

¹ *Miller Brewing Co. v. G. Heilemann Brewing Co.*, 561 F.2d 75 (7th Cir. 1977); *In re Miller Brewing Co.*, 226 U.S.P.Q. 666 (T.T.A.B.).

LRO 2013-0058, the objection was rejected by the panel based initially on a finding that the Objector did not possess standing to object. The panel in that case found that the trademark rights upon which the Objector relied were not registered in the name of Objector (DotMusic Limited), but rather in the name of “Constantinos Roussos.” Further, the various domain name registrations relied upon by the Objector were registered in the name of “CGR E-Commerce Ltd.,” not the name of the Objector. As such, the panel in that case ruled that the Objector did not own the trademarks, nor the relevant domain names, and thus did not have the necessary standing to object on the basis of trademark infringement.

Nevertheless, the panel continued with its analysis in this case and found that the objection failed on the relevant factors as well. The panel began by noting that the Objector claims common law rights in .MUSIC based on its operation of “www.music.us”. However, because the main purpose of that site is to promote the Objector’s own concept of the <.music> gTLD, the Objector essentially “relies upon its own preparations for use of the <.music> gTLD string ... in order to defeat a competitor’s application for the same string” a position which the panel described as circular.

Next, the panel determined that the gTLD string must read as consisting merely of “music”, rather than “.music” (“dotMusic”). Based on that determination, the panel found that there was little similarity between the marks as registered and the <.music> string in terms of phonetic sound and meaning. While the panel felt that the Objector’s rights in its marks were acquired and used in good faith, it ruled out any possibility of public recognition of the sign corresponding to the gTLD <.music> as the mark of the Objector. Essentially, because the sign “music” is a generic word, there is no recognition of it as the mark of either the Objector or the applicant.

The panel concluded the factor analysis in *DotMusic Limited v. Charleston Road Registry Inc.*, *supra* by recognizing that there was some possibility that some consumers could recognize the <.music> gTLD as being related to the Objector’s marks, as it has been the intention of the Objector to create that association in hopes of acquiring the <.music> gTLD itself. Nevertheless, the panel rejected the objection concluding that the potential use of the applied-for gTLD in relation to the promotion, sampling or purchase of music on the Internet would not infringe the existing legal rights of the Objector.

The Panel here notes that Legal Rights Objections filed by Objector in relation to <.music> were also rejected in *DotMusic Limited v. dot Music Limited*, WIPO Case No. LRO2013-0059; *DotMusic Limited v. Entertainment Names Inc.*, WIPO Case No. LRO2013-0061; and *DotMusic Limited v. Victor Cross*, WIPO Case No. LRO2013-0062.

This Panel has similarly concluded that the Objection before it is not valid and should be rejected. The Panel’s basic rationale stated above leads to the following independent analysis of the non-exclusive factors, while remaining mindful of the guidance afforded by the decision of the previous and above-referenced determinations.

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

In common speech, the Panel finds it is likely that Objector’s marks for .MUSIC and DOTMUSIC, and the <.music> gTLD would be phonetically pronounced as “dot music.” The Objector’s European Community Trademarks, however, are figurative marks, primarily composed of many stylized and design elements that in no way resemble the simple text string <.music>. The Panel notes that the Objector has previously tried to register the character marks .MUSIC and DOTMUSIC with the USPTO, only to have those applications denied for, among other reasons, descriptiveness. Because the Objector’s trademark rights in its figurative marks bestow upon it no exclusive right to the character marks .MUSIC and DOTMUSIC, and because the Objector has no further trademark rights in the standard character mark, the Panel is of opinion that the comparison must be made to the figurative elements of the mark. In this regard, the marks and the applied-for gTLD <.music> differ substantially.

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

The Panel is in agreement with the panel's decision in *DotMusic Limited v. Charleston Road Registry Inc.*, *supra*, that the Objector's rights were acquired and used in a good faith and *bona fide* manner. Ultimately however, due to the purely generic character of "music" and the figurative design protections of the Objector's marks, this factor does not support the Objector's claim.

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 introduced evidence purporting to show its extensive use of its marks in commerce and public recognition of those marks, including "social media presence," press clippings, event sponsorships, and search engine results for relevant keywords. However, the majority of this evidence spoke to the Objector's use of its figurative, stylized marks.

Another panel decision in an unrelated case is instructive here. *Limited Stores, LLC v. Big Fest LLC*, WIPO Case No. LRO2013-0049, involved a clothing manufacturer's legal rights objection concerning an application for the gTLD <.limited>. In this case the panel determined that, though the objector established that there was general public recognition of its mark THE LIMITED, it produced no evidence that the public similarly viewed the generic term "limited", standing alone, as source indicative of the objector.

Similarly here, the Objector has given evidence that, at most, indicates that the relevant sectors of the public associate its figurative marks with its services. The word "music" is a generic term when applied to the field of music and music-related services, as evidenced by the existence of literally thousands of domain names that incorporate the word "music". There is insufficient evidence to show the Panel that upon seeing or hearing the generic term "music" (or "dotMusic") that the relevant Internet-using public views the term as source indicative of the Objector. Even if there were an association with the Objector, the Panel notes that the Objector is not able to claim protectable rights in a generic term for its generic use, which is the type of use at issue here. As such, the Panel does not find that there is recognition in the relevant sector of the public that the sign corresponding to the gTLD is the mark of the Objector, of the Applicant, or of a third party.

4. The 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 Applicant has admitted that there is a good likelihood that it was aware of the Objector's mark prior to applying for the <.music> gTLD. The Applicant's intentions, however, in applying for the gTLD appear to the Panel to be legitimate and in good faith. In many of the Objector's own exhibits, especially relevant press clippings, the Applicant is named as a widely supported and competitive frontrunner for receiving the rights to the <.music> gTLD. Conversely, there is no evidence before the Panel that the Applicant has engaged in a pattern of conduct whereby it applied for TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others.

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

The Applicant intends to operate the <.music> gTLD registry as an "open platform allowing domain registrations subject to a variety of legal rights protection procedures," and has set forth in its application detailed plans for doing so, which would constitute a legitimate and *bona fide* offering of services.

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.

The Applicant concedes that it has no trademark rights in the word “music”. Nevertheless, the Applicant has shown a legitimate interest in using <.music> in its ordinary generic sense as the generic term for a domain name registry relating to music.

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 has not been known publicly as “music”.

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.

Due to the purely figurative nature of the Objector’s registered European Community Trademarks, the Panel finds that the Objector has not acquired rights in the character marks .MUSIC or DOTMUSIC. To the extent any confusion arises it would appear to be the result of common use of generic terms for a generic purpose. Such confusion is not a basis for legal protection, however, and in the Panel’s view is likely to dissipate once a single operator of the <.music> gTLD is selected.

Conclusion

The Panel finds the potential use of the applied-for <.music> gTLD by Applicant would not infringe the existing legal rights of Objector that are recognized or enforceable under generally accepted and internationally recognized principles of law, and in particular it does not:

- (i) take unfair advantage of the distinctive character or the reputation of the Objector’s registered or unregistered trademarks or service marks;
- (ii) unjustifiably impair the distinctive character or the reputation of the Objector’s marks; or
- (iii) otherwise create an impermissible likelihood of confusion between the applied-for gTLD and the Objector’s marks.

7. Decision

For all the foregoing reasons, the Panel rejects the Objection.

[signed]

Mark V.B. Partridge

Sole Panel Expert

Date: August 26, 2013