

## **EXPERT DETERMINATION LEGAL RIGHTS OBJECTION**

I-REGISTRY Ltd v. Vipspace Enterprises LLC

Case No. LRO2013-0014

### **1. The Parties**

The Objector is I-REGISTRY Ltd. of Berlin, Germany, represented by Bettinger Schneider Schramm, Germany.

The Respondent/Applicant is Vipspace Enterprises LLC incorporated in the United States of America with its principal place of business in Munich, Germany (“Respondent”) represented internally.

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

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

### **3. Procedural History**

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 has completed the review of the Objection on March 21, 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”).

The WIPO Center received a proposal from the Objector to consolidate the LRO Objections LRO2013-0014, LRO2013-0015, LRO2013-0016, LRO2013-0017 and LRO2013-0018 on April 23, 2013. The Respondent indicated opposition to aspects of the Objector’s 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 LRO 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 Respondent of the Objection, and the proceedings commenced on April 16, 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 10, 2013.

The WIPO Center appointed Tony Willoughby as the Panel in this matter on June 10, 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 13, 2013, the Objector, expressing surprise at some of the arguments raised in the Response by the Respondent, sought the Panel's leave to file a further submission. The Respondent objected by way of an email to the WIPO Center on June 13, 2013 stating that the Procedure made no provision for further filings. The Respondent contended that to accede to the Objector's request would be particularly unfair given the Objector's refusal at an earlier stage to mediate the dispute.

On June 18, 2013, the WIPO Center informed the parties that the Panel was prepared to receive a further submission from the Objector provided that (a) it was limited to matters in the Response that the Objector could not reasonably have foreseen; and (b) the Objector explains why the Respondent's offer of mediation was rejected.

On June 19, 2013, the Objector filed its further submission, a Sur-Reply. The Panel has read it, but it contains nothing that was not already evident to the Panel from the Objection and the Response and the Panel finds it difficult to accept that the points raised were not in fact foreseen by the Objector at the time of the Objection. The Objector's reason for not having accepted the Respondent's offer of mediation (there being six applicants for the <.vip> gTLD, mediation with only one of the applicants would have served no useful purpose) seems to the Panel to have been a reasonable one. That is disputed by the Respondent in its response to the Objector's Sur-Reply dated June 21, 2013, but the Panel does not need to resolve that issue in the context of this dispute. One new topic that was raised in the further submissions and giving rise to dispute was as to the criteria that ICANN will regard as important when deciding upon the grant of the new gTLDs and whether or not the parties have met those criteria. This debate has nothing to do with the Legal Rights Objection and the Panel does not need to address it.

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

##### **The Respondent**

The Respondent is a limited liability company incorporated in the State of Texas, United States of America with its principal place of business in Munich, Germany.

The principal shareholder and President of the Respondent, Herbert Scheuerer, is the registered proprietor of Community Trade Mark ("CTM") No. 010077998 DOTVIP (word) filed June 27, 2011 and registered October 21, 2011 in classes 35 (Advertising; Business management; Business administration; Office functions), 38 (Telecommunications) and 42 (Scientific and technological services and research and design relating thereto; Industrial analysis and research services).

On November 1, 2011, Herbert Scheuerer granted to his company, the Respondent, an exclusive licence to use the above CTM in Europe. For simplicity the Panel proposes to refer to this CTM as "the Respondent's trade mark".

The Respondent's New gTLD application for the <.vip> string was originally posted on June 13, 2012 under Application ID: 1-851-9629. In that application the mission/purpose of the application was described in the following terms: "DOTVIP (.vip) is the new Top Level Domain exclusively developed for very important persons and very important projects."

Elsewhere in the application it is made clear that that "exclusivity" is to be of limited scope: "The .vip TLD is available as an open registry. As well as a Sunrise Period, Founders' Programs will be made available to a restricted circle of users. Prior to General Availability, a global, top-down outreach initiative will ensure that authorized registrants and internet users alike are aware of the TLD and its benefits."

The Respondent operates a website at “www.vipspaces.com”. Annexed to the Response are a number of pages from the website featuring news items about international celebrities. Annex 7 features a notice reading “.VIP (DOTVIP) is to become the global Top Level Domain for VIPs – reserve a domain name without obligation now!” The notice is dated August 17, 2011.

### **The Objector**

The Objector is a German company with its principal place of business in Berlin, Germany.

On July 29, 2011, the Objector’s parent company, i-content Ltd, filed application at the German Patent and Trade Mark Office for a German national registration of VIP (word). That application is still pending.

The Objector’s parent company is the registered proprietor of CTM No. 010437051 VIP (word) filed November 22, 2011 and registered April 11, 2012 in classes 36 (Organization and management of collections; organization of charitable fundraising; monetary affairs and financial sponsorship and consultancy, exclusively in the field of donations; organization and management of fundraising campaigns; financial consultancy in the field of humanitarian relief operations and projects), 41 (Training and further training consultancy; training and instructional services; organizing, arranging and conducting of conference, seminars, tuition and workshops (training)), 44 (Therapeutic support and medical care; medical, dental, psychological and veterinary services; healthcare; conducting medical, veterinary and clinical studies; hospitals, medical clinics and animal hospitals; hygienic and beauty care; animal grooming; agriculture, horticulture and forestry) and 45 (Personal and social services rendered by others to meet the needs of individuals, in particular within the framework of humanitarian relief operations; consultancy in the field of humanitarian relief operations and projects; connection and management of internet domains).

On April 13, 2012, the Objector’s parent company granted to the Objector an exclusive licence to use the trade mark and not limited to the countries covered by the registration. For simplicity the Panel proposes to refer to this CTM as “the Objector’s trade mark”.

On March 1, 2013, the CEO of the Objector’s parent company signed a document on behalf of that company certifying that *inter alia* the Objector is an authorized licensee of the Objector’s trade mark registration, has been authorized to apply for the New gTLD space, <.vip>, and to file Legal Rights Objections with regard to some or all of the competing applications for the <.vip> gTLD space. Finally, the document certifies that the Objector is authorized to manage and operate the <.vip> gTLD if it is successful in its application for that space.

The Objector’s New gTLD application for the <.vip> string was originally posted on June 13, 2012 under Application ID: 1-1003-40726.

In this application the Objector described its plans in the following terms:

“The .VIP TLD and its domain names are dedicated and thereby specialized to create identity and content, facilitate communication and foster business in connection with the VIPs. Until today there are no specialized domain names available to this target group. The string is dedicated and thereby specialized for the comparably small group of people and entities which are very important.”

As with the Respondent’s plans, the scope for the domain will not be as narrow as the description suggests. The Objector describes its registration policy thus: “The .VIP space will operate following an unrestricted registration model, meaning that no eligibility criteria or registration restrictions will be imposed upon prospective registrants in the space.”

The Objector operates websites at “www.i-registry.com” and “www.vip-registry.com”. The latter site is devoted to the <.vip> gTLD in anticipation of the Objector succeeding with its application for the space. A typical notice reads:

“Celebrities stick together with VIP® - VIP® domain allocation ensures that only a select circle of clients may register a VIP® domain. Managed personally by us, the namespace guarantees that both private individuals and companies can enjoy on the internet exactly the same exclusivity and attention that they are used to in their daily lives – thanks to VIP®.”

## **5. Parties’ Contentions**

### **A. Objector**

The Objector’s case is in essence very simple. It has rights in respect of a registered trade mark for VIP, which is the applied-for gTLD, the Respondent’s planned use of the <.vip> gTLD includes domain name registration services, which are expressly covered by the Objector’s trade mark (“connection and management of internet domains” in class 45) and if the Applicant is awarded the <.vip> gTLD, its operation of that domain will inevitably lead to confusion among Internet users as to the source, sponsorship, affiliation, or endorsement of the gTLD.

The Objector distinguishes itself from the Respondent on the basis that whereas operation of the <.vip> gTLD and its current plans for that eventuality (as evidenced by screenshots from its website) are expressly covered by the Objector’s trade mark, the Respondent’s trade mark “does not offer any protection with regard to the operation or management of a TLD, nor with the sale of second level domain names”. Similarly, the Respondent’s website “does not promote any goods or services logically related to the DOTVIP mark, and merely advertises the [Respondent’s] application for the .VIP TLD, the services it intends to offer in connection with the TLD and provides some promotional material for charity-related causes.” The Objector contends, in short, that the Objector’s trade mark gives the Objector a right to use the VIP mark in relation to domain name registry services whereas the Respondent’s trade mark does not give to the Respondent an equivalent right.

The Objector contends that the Respondent is not currently conducting any trade under and by reference to its DOTVIP trade mark.

Further, the Objector contends that when the Respondent filed its application for the <.vip> gTLD, it was on notice as to the Objector’s rights, given that the application for the Objector’s trade mark had been filed by then and was a matter of public record.

### **B. Respondent**

The Respondent expressly denies the Objector’s contentions.

It points to the fact that the application for registration of the Objector’s trade mark post-dated the equivalent date for the Respondent’s trade mark. Moreover, the Respondent’s trade mark rights date from June 27, 2011 whereas the earliest filing date upon which the Objector can rely is the date of filing of its parent company’s German national application just over a month later (July 29, 2011). It contends that its rights are superior to those of the Objector.

The Respondent further contends (contrary to the contentions of the Objector) that its trade mark rights cover its proposed activities in respect of the <.vip> gTLD. It refers to its “DOTVIP Footprint” which it contends is already an online marketing activity within the scope of the Respondent’s trade mark registration and “already established as a brand”. It refers to its website, which it contends “documents already how many ‘DOTVIP Footprints’ an organization or person continuously leaves through philanthropic activities”. In its response to the Objector’s Sur-Reply it produces an article said to have been written for its website, and states:

“To date, the objector’s VIP trademark is not in active operation, whereas the DOTVIP trademark is seeing a steadily increasing popularity in the internet. There are indeed extensive contacts in the

target market; in LinkedIn alone there are more than 1,000 people and companies in the field of NPOs, celebrities and the entertainment industry connected with the President of Vipspace Enterprises LLC, Mr. Herbert Scheuerer (we would be happy to submit a detailed list). Another current, public example is the article by Mr. Daryl Upsall, CEO of Daryl Upsall Consulting International, in our 'DOTVIP Footprint Group', on the DOTVIP Footprints' publication "Elton John Record Collection Reveals Hidden Treasures". As the active Fundraiser Director, he provides a detailed look at the "Elton John Aids Foundation" campaign. See screenshot from 20.06.2013 (Annex\_1\_Elton\_John\_Comment\_LinkedIn)."

The Respondent states that its reason for applying for the <.vip> gTLD is "to present the service brand 'DOTVIP' on the Internet with the corresponding top level domain ..."

The Respondent contends that awarding the <.vip> gTLD to anyone other than the Respondent would lead to inevitable Internet user confusion.

The substantive part of the Response concludes in the following terms (*verbatim*):

"Regardless of the higher priority of the brand 'DOTVIP' the registration of the word mark 'VIP' for the application to ICANN for a new TLD 'vip' will not be legally relevant. This, because the term 'VIP' is a worldwide established and descriptive acronym for 'very important persons'. As such, the term "VIP has no recognizable distinctiveness. Trade mark protection, however, has only a brand with an enough distinctiveness. A word mark has only enough distinctiveness if the word in question can not be assigned to a in the foreground standing, descriptive term and/or as a word in use to a German or known foreign language. Because of this background it will be also necessary to consider whether the word mark of the Objectors 'VIP' in general has trade mark protection. This especially because the Objector currently has no active use of the word mark 'VIP' for a service or a product proven".

As per Article 17 of the Procedure the Panel made a decision to allow the parties to submit written statements in addition to the Objection and the Response. The Panel did not find the exchange of further submissions to be of any significant assistance.

## 6. Discussion and Findings

### Introduction

Pursuant to Paragraph 3.2.1 of the ICANN Applicant Guidebook (version 2012-06-04) (the "Guidebook") a formal objection to an application for a New gTLD may be filed on any one of four grounds, one of which is the Legal Rights Objection. The basis for a Legal Rights Objection is that "the applied-for gTLD string infringes the existing legal rights of the objector".

By virtue of Paragraph 3.2.2.2 of the Guidebook: "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."

Accordingly, for a Legal Rights Objection to succeed the Objector has to satisfy the Panel that it has relevant existing legal rights and that use of the string comprising the potential new gTLD infringes those rights. In this case the Objector relies upon its rights as a licensee in respect of the Objector's trade mark, details of which are provided in the Factual Background (Section 4 above).

Guidance as to how the Panel is to approach Legal Rights Objections is to be found in paragraph 3.5.2 of the Guidebook, which reads as follows:

"In interpreting and giving meaning to GNSO Recommendation 3 ('Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized

principles of law'), a DRSP panel of experts presiding over a legal rights objection will determine whether the potential use of the applied-for gTLD by the applicant takes unfair advantage of the distinctive character or the reputation of the objector's registered or unregistered trademark or service mark ('mark') or IGO name or acronym (as identified in the treaty establishing the organization), or unjustifiably impairs the distinctive character or the reputation of the objector's mark or IGO name or acronym, or otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector's mark or IGO name or acronym."

In substance, this wording bears a close similarity to the wording of Article 9.1 ("Rights conferred by a Community trade mark") of Council Regulation (EC) No 207/2009, the law relating to Community trade marks. This is useful considering that the basis for the Objector's claim to an existing legal right is a Community trade mark.

The Guidebook then goes on to provide that in the case where the objection is based on trade mark rights, the panel will consider eight listed non-exclusive factors. The Panel will deal with each of these factors further below.

### **The Objector's Existing Legal Right**

The Objector relies for its existing legal right upon CTM Registration No. 010437051 VIP (word) filed November 22, 2011 and registered April 11, 2012 in classes 36, 41, 44 and 45 for the services set out in full in the Factual Background at Section 4 above, covering *inter alia* organization and management of collections; organization of charitable fundraising; organizing, arranging and conducting of seminars, healthcare; consultancy in the field of humanitarian relief operations and projects; connection and management of internet domains.

The priority date for this registration is stated to be the date of an earlier application on July 29, 2011 for a German national registration of the same mark. That application is pending and has not yet matured into a registration.

The Objector is not the proprietor of the above CTM; nor is it the applicant for the German national registration. The registered proprietor of the above CTM and the applicant for the German national registration is the Objector's parent company, i-connect Limited.

The Panel is satisfied that the above CTM is a relevant existing legal right upon which to found a Legal Rights Objection. But is it a sufficient basis for this Objection by the Objector, which is merely a licensee?

The Panel believes that it is. As can be seen from the Factual Background (Section 4 above), the Objector is the exclusive licensee of that CTM. Under most (if not all) other ICANN dispute resolution policies, including the Uniform Domain Name Dispute Resolution Policy (UDRP), trade mark licensees and companies related to the trade mark owner are generally held to have rights in the trade mark or trade marks in question [See, for example, paragraph 1.9 WIPO Overview of Panel Views on Selected UDRP Questions, Second Edition]. The Objector has produced satisfactory evidence of the licence and the Panel sees no reason to depart from that approach.

A matter that has concerned the Panel has been the validity of the Objector's trade mark. It is axiomatic that while SOAP, for example, may be a perfectly satisfactory trade mark for cars, it cannot serve as a trade mark for the cleaning product "soap". On that basis, how can VIP serve as a satisfactory trade mark for "VIP services", "VIP" being a common term used *inter alia* to describe a service of suitable quality for a very important person? However, it is not for the Panel to look behind a trade mark registration which is on its face valid and, as already observed, the specification of services makes no reference to the target audience of very important persons.

The Panel finds that the Objector has a relevant existing trade mark right in respect of the trade mark, VIP.

## Trade Mark Infringement

The Objector contends that the Respondent cannot operate the <.vip> gTLD domain without infringing the Objector's trade mark.

The Objector contends that this Objection is valid and should be upheld because the potential use of the applied-for gTLD by the Respondent:

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

If the Respondent is granted the <.vip> gTLD, necessarily, as contended for by the Objector, the Respondent will be using "VIP" in the course of trade. It will be using in the course of trade a sign, which is identical to the Objector's trade mark in relation to identical services. There can be no dispute between the parties on that score as the operation of the <.vip> gTLD will necessarily involve the Respondent in using the top level domain identifier in the course of its "connection and management of internet domains", being services covered by the Objector's registration in Class 45.

On the face of it, therefore, unless the Respondent is able to attack the validity of the trade mark (not something that the Panel feels it appropriate to address) or unless a defence is available to the Respondent under the relevant trade mark legislation, the Respondent would be guilty of trade mark infringement.

Under most trade mark laws with which the Panel is familiar, an infringing use of a sign has to be a use which is (or is likely to be taken to be) a trade mark use. In the SOAP example given above it is plain that when one is concerned with common dictionary terms, much will depend upon the use to which the term is to be put. If one sees the word "soap" used in an advertisement for soap, inevitably it will be taken to be a description of the product being advertised rather than a brand. Accordingly, the mere fact that the word may be registered as a trade mark for example for cars does not render every use of the word an infringing use.

In most trade mark systems an honest descriptive use of a dictionary term is most unlikely to be found to be an infringement of a trade mark registration of the term.

The Objector has produced an impressive array of evidence to demonstrate that while TLD identifiers such as ".com", ".net", ".org" and the like have traditionally held no trade mark significance for anybody, public perception is likely to change with the introduction of the new gTLDs, some of which will comprise very well-known trade marks. The Objector has also been able to demonstrate that many gTLDs or would-be gTLDs are already registered as trade marks in one shape or form. They include:

- (a) DOTAM (typed drawing) for *inter alia* "providing online directories for locating computer network addresses ... accessible through a global computer network"
- (b) DOTFM (typed drawing) for *inter alia* "providing online directories for locating computer network addresses ... accessible through a global computer network"
- (c) DOTCOOP (word) for *inter alia* "domain name registration services for others on a global computer network"
- (d) .NU DOMAIN (words) for *inter alia* "domain name registration services"
- (e) .mobi (figurative) for *inter alia* "business administration and office functions all relating to domain names"
- (f) .tel (figurative) for *inter alia* "telecommunications services that use DNS (domain-names system)"

- (g) .fr (figurative) for *inter alia* “technical management for the assigning of domain names and addresses allocated to all computer equipment using a communication protocol”
- (h) .ART (figurative) for *inter alia* “domain name registration services for identification of users ...”
- (i) .CLUB (word) for *inter alia* “operating online marketplaces for buyers and sellers of domain names”
- (j) .Music (figurative) for *inter alia* “administrative services provided in connection with registration and allotment of Internet domain names ...”
- (k) .HOME (figurative) for *inter alia* “Domain name, reservation, registration, maintenance and management services”.

The Objector has also been able to demonstrate that VIP is not only an acronym for “Very Important Person(s)”. It also appears to be an acronym for, amongst many others, “ventral intraparietal sulcus in the lateral parietal lobe”, “vasoactive intestinal peptide”, “The Vanilla Ice Posse” (a band), “Voices in Public” (a band), “vacuum insulated panel”, “variable information printing” and “Virgin Islands Party” (a political party).

However, none of that detracts from the basic proposition, acknowledged by both parties in their applications for the <.vip> gTLD, that to the Internet community at large “VIP” is going to be seen to be a reference to “Very Important Persons”.

Having examined the parties’ applications to ICANN for the <.vip> gTLD and their planned uses of the domain as evidenced by the material on their websites (see Factual Background at section 4 above), the Panel is satisfied that to the Internet community at large, the use of the <.vip> gTLD is most likely to be seen as “an indication concerning the kind, quality, ... intended purpose ... of rendering of the service, or other characteristics of the ... service”.

The Panel recognizes that there might be scope for infringement of the Objector’s trade mark at the second level. However, the Panel is here concerned only with the top level.

The Panel is not able to find, on the evidence before it, that if the Respondent is awarded the new <.vip> gTLD, the Respondent’s use of that domain, even for the registration of <.vip> domain names, will be likely to infringe the Objector’s registered trade mark.

In coming to this conclusion the Panel has concentrated on the fundamental descriptive quality of the term “VIP”. The Panel has not been influenced by the fact that the Applicant’s trade mark rights appear to have a priority date senior to that of the Objector (albeit for differing services).

The Panel rejects the Objector’s argument that its position is materially different to that of the Respondent because the Respondent’s trade mark registration does not cover domain name registration services whereas the Objector’s trade mark registration does. If the Panel is correct in its conclusion that the <.vip> gTLD identifier will be seen as a descriptive indication rather than a trade mark, the scope of the parties’ respective trade mark registrations is irrelevant and, in any event, the Panel is not persuaded that the advertising and telecommunications services covered by the Respondent’s trade mark will necessarily be regarded as insufficient to cover to some degree its services as a domain name service provider.

In reaching the above conclusion, the Panel has considered the following non-exclusive list of eight factors. The Panel addresses each of them in turn:

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

The Panel finds that the applied-for gTLD is identical or similar, including in appearance, phonetic sound, or meaning, to the Objector’s existing mark.

- ii. Whether the Objector’s acquisition and use of rights in the mark has been *bona fide*.



It appears that the Objector's acquisition and use (such as it is) of rights in the mark forms part of a strategy to support its application for the <.vip> gTLD. Considering the broader circumstances of this case, the Panel finds no basis to conclude that such acquisition and use was not *bona fide*.

- iii. Whether and to what extent there is recognition in the relevant sector of the public of the sign corresponding to the gTLD, as the mark of the Objector, of the Applicant [respondent] or of a third party.

While the parties have used the term, "VIP", in various forms on their website to indicate the manner in which the term will be used if they are successful in being awarded the domain, there is nothing before the Panel (beyond mere assertion) to show that either of them has yet traded under their marks sufficiently to displace the primary descriptive meaning of the term and establish a brand or at all. The Panel finds that the Internet community at large is likely to recognize the term "VIP" in the context of a gTLD as a descriptive term rather than anybody's trade mark.

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

The Panel is satisfied on the evidence before it that the parties each applied for the <.vip> gTLD with the *bona fide* intention of operating the domain for commercial gain and for the benefit of Very Important Persons and others wishing to be so labeled.

The Panel believes it to be probable that each of the parties was aware of the other's trade mark registrations when filing their applications for the <.vip> gTLD. The Panel refers to the concluding passage of the Response quoted in full in Section 5B above. The Panel accepts that that reflects the honestly held view of the Respondent and that there is no reason to question the Applicant's *bona fides*.

The Objector has not suggested that the Respondent "has engaged in a pattern of conduct whereby it applied for or operates TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others" and there is nothing before the Panel to suggest otherwise.

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

The Panel finds that the Respondent's use to date of the term VIP, both descriptively and as part of its registered trade mark, DOTVIP, is consistent with its stated aim of operating the <.vip> gTLD. The extent of the use is not known to the Panel beyond what appears in the parties' exhibited extracts from the Respondent's website. The Panel believes it likely that neither party is likely to make any substantial use of the sign until confirmed as the operator of the domain.

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

The Respondent has the benefit of an exclusive licence to use its President's CTM, DOTVIP, details of which appear in Section 4 above. The Panel finds that the acquisition of those rights was in line with the Respondent's *bona fide* intention of applying for the <.vip> gTLD. It is true, as the Objector points out, that the specification of services for this domain does not expressly refer to the operation of the <.vip> gTLD, but

it does cover advertising and telecommunications services, which, in the view of the Panel, are apt. The Panel finds that the criteria are met.

- vii. Whether and to what extent the Applicant [respondent] has been commonly known by the sign corresponding to the gTLD, and if so, whether any purported or likely use of the gTLD by the Applicant [respondent] is consistent therewith and *bona fide*.

There is nothing before the Panel to demonstrate that the Respondent has been commonly known by the sign.

- viii. Whether the Applicant's [respondent's] intended use of the gTLD would create a likelihood of confusion with the Objector's mark as to the source, sponsorship, affiliation, or endorsement of the gTLD.

The Panel is satisfied that, as currently disclosed in the Respondent's application to ICANN for the <.vip> gTLD and in the screenshots from the Respondent's website, the Respondent's intended use of the gTLD will lead to the gTLD being seen first and foremost as a descriptive term describing the purpose and characteristics of the domain (i.e. a domain for Very Important Persons). The Panel does not believe that confusion with the Objector's mark is likely.

Whether or not confusion of the kind contemplated occurs in time to come will depend largely upon whether and how the Objector uses its trade mark if it is not awarded the domain and partly, no doubt, upon whether the Respondent is able to create a brand out of the string.

Accordingly, the Objection fails. The Panel has come to its decision on the case papers and on the basis of the terms of reference set out in the Guidebook.

## 7. Decision

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

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

The Panel rejects the Objection.

[signed]

**Tony Willoughby**  
Sole Panel Expert  
Date: July 4, 2013