

## **EXPERT DETERMINATION LEGAL RIGHTS OBJECTION**

Defender Security Company v. Charleston Road Registry Inc.  
Case No. LRO2013-0032

### **1. The Parties**

The Objector is Defender Security Company of Indianapolis, Indiana, United States of America, represented by Maginot, Moore & Beck, United States.

The Respondent/Applicant is Charleston Road Registry Inc. of Mountain View, California, United States ("Respondent"), represented by Steptoe & Johnson LLP, United States.

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

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

### **3. Procedural History**

The Objection was filed by 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 26, 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).

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 17, 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 M. Scott Donahey 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.

#### 4. Factual Background

##### A. Objector

##### i. Facts Established in Objector's Annexes

DotHome Limited (the purported subsidiary of Objector) is the current holder of a certificate of registration No. 010535201 issued by the Office for Harmonization in the Internal Market, Trademark and Designs of the European Community (the "E.C. trademark"). The application was filed December 30, 2011, and the certificate issued on June 22, 2012. The certificate is for a word and design mark utilizing four colors and consisting of the word .HOME in stylized capital letters together with a drawing of a home in a balloon like design. Dot Home Limited gives an address in Limassol, Cyprus. Objection, Annex 1.



Objector is the present owner of the registration of the standard character mark TRUE HOME with the USPTO for use in conjunction with environmental testing and inspection consulting service in relation to heating, ventilation, and air conditioning (HVAC) equipment. The serial number of the registration is 3404246. The application was filed on December 21, 2006, by one Carl Simpson of Wylie, Texas and shows a first use in commerce of June 15, 2006. The registration issued on April 1, 2008. The registration indicates that an assignment has been recorded. Objection, Annex 1.

Objector is the applicant of a design plus words, letters, and/or numbers mark with the USPTO for "TRUE." in white against a black background of a five-sided figure and just below "TRUE." is "HOME" in white against the same black background. The serial number for the application is 85588370, and the application was filed on April 3, 2012. The printout of the application included in Annex 1 to the Objection indicates that an assignment of the application was recorded and states as a disclaimer: "NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HOME" APART FROM THE MARK AS SHOWN." Objection, Annex 1.



Objector is also the applicant for a Design plus words, letters, and/or numbers mark for the word TRUE in black against a white background above the word HOME in black against a white background all below a black stepped version that could be said to suggest a house. The serial number for the application is 85588382, and the application was filed on April 3, 2012. The printout of the application included in Annex 1 to the Objection indicates that an assignment of the application was recorded and states as a disclaimer: "NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HOME" APART FROM THE MARK AS SHOWN." Objection, Annex 1.



Objector is also the applicant for a standard character mark with the USPTO for the character mark TRUE.HOME. The serial number of the application is 85721554, and the application was filed on September 5, 2012. The printout of the application included in Annex 1 to the Objection indicates that an assignment of the application was recorded. Objection, Annex 1.

Additionally, in Annex 1 to the Objection the Panel notes a further trademark application for a standard character mark with the USPTO for the character mark TRUE HOME in the name of Objector which has not been referenced in the pleadings. The serial number of the application is 85721544, and the application was filed on September 5, 2012. The printout of the application included in Annex 1 to the Objection states as a disclaimer: "NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HOME" APART FROM THE MARK AS SHOWN." No assignment of the application was recorded. Objection, Annex 1.

## **ii. Facts Alleged by Objector**

Objector contends that it is the second largest provider of residential security systems in the United States. Objector also contends that it offers domain name services through the web site to which the domain name <dothome.net> resolves. Objector alleges that more than 8 billion annual marketing impressions in print media, millions of outbound sales and marketing calls, and millions of visitors to its various web sites result in several million calls annually to its three call centers.

Objector asserts that its acquisition and use of the trademark applications and registrations set out in Annex 1 to the Objection occurred in the ordinary course of trade.

Objector contends that since December 2011, through its wholly owned subsidiary, Dothome LTD, it has been a reseller of domain names and has used the .HOME mark to brand its domain reservation web site, to which <dothome.net> resolves.

Objector alleges that its .HOME brand has 20,793 individuals that follow Objector's more than 9,700 tweets under the .HOME trademark as its avatar (username @dot\_home). Objector asserts that it has over 2,700 Facebook followers, including followers in the United States, the European Union, and numerous other territories throughout the world.

Objector contends that the TRUE.HOME trademarks that are the subject of USPTO application have been in use since at least as early as April, 2012 in conjunction with advertising, promotion and marketing services in the field of residential and commercial security systems and alarms.

Objector alleges that its use of the .HOME and TRUE.HOME marks are natural extensions of its branding strategies, including its registered TRUE HOME mark, with a first use in 2006, and its TRUE BLUE mark with its first use in 2011.

Objector asserts that it has spent in excess of USD 500,000 for expert brand research in connection with its branding strategies.

Objector alleges that it has been a prominent and well known entity within the home services industry since 1998.

Objector contends that through its wholly owned subsidiary Dothome LTD, it has invested "significantly" in the E.C. trademark .HOME, the associated business, and the marketing and promotion of the business and the mark, including "trademark application fees and costs, operation of a website [sic] for promotion of the trademark and business, and related costs and expenses."

## **B. Respondent**

### **i. Facts Established in Respondent's Annexes**

"Home" is a common English word for abode, domicile, or residence. Response, Annex 2.

"Home" has been registered as a second-level domain in three different gTLDs by three different registrants. Response, Annex 3.

A web site has been established at the URL "www.dothome.net" that features E.C. trademark 010535201 and offers domain name registration services. The web site contains the following copyright notification: "© 2009-2012 dotHOME (.HOME) Generic Top Level Domain (gTLD) Extension Web Address – dot.HOME TLD". The capture of the web site was made on May 14, 2013. Response, Annex 4.

Apparently in 2010, according to a printout of an Internet Archive Search for the URL "www.truehomeenergysolutions.com", a web site was "under construction" for TRUE HOME™ Energy Solutions. *Id.*

Someone at some time apparently created a business card that included the following: "TRUE HOME™ Heating and Cooling, HVAC Consulting Services, Carl Simpson" and giving an address in Wylie, Texas, and including a URL of "www.truehomeenergysolutions.com", and an email address of "[...]@truehomeenergysolutions.com". *Id.*

A printout of the application of the Redirect Checker tool provided by InternetOfficer.com shows that at some unknown time, but at least prior to May 15, 2013, when the printout was made, the URL "www.truehomeenergysolutions.com" had been redirected to the URL "www.assuredhomeperformance.com". *Id.*

As of May 15, 2013, a web site had been established at "www.assuredhomeperformance.com" that advertised consulting services in the area of energy efficiency for home owners and home builders provided by Assured Home Performance. The web site indicated that Assured Home Performance was the successor to TRUE HOME Energy Solutions, providing email addresses of "[s...]@truehomeenergysolutions.com" and "[p...]@truehomeenergysolutions.com". The web site indicated that Assured Home Performance was located in Richardson, Texas. *Id.*

Searches of the web sites of the USPTO and of the OHIM, the Trademarks and Designs Registration Office of the European Union, established that there are thousands of trademarks and design marks which include the word "home." Response, Annex 5.

Google maintains a web site with numerous and extensive provisions for the filing of copyright and trademark complaints, and reports on and statistics regarding their handling and resolutions. Response, Annex 6.

### **ii. Facts Alleged by Respondent**

Respondent asserts that it is wholly owned by Google, Inc. an American multinational public corporation and global technology leader.

Respondent contends that Google intends to use the <.home> gTLD in its generic sense, to offer domain names to potential registrants who want to provide information, goods or services related to "homes," as used in its generic sense.

Respondent alleges that Google does not intend to profit from the goodwill established in the trademark of Objector or of any third party.

Respondent asserts that Objector is no longer using the TRUE HOME mark.

Respondent contends that Objector applied to register the domain name <dothome.net> where Objector is allegedly offering domain name services on December 29, 2011.

Respondent alleges that Objector failed to establish that its marks had acquired secondary meaning.

Respondent asserts that Respondent's application for the <.home> gTLD shows that Respondent has made demonstrable preparations to use the gTLD in connection with a *bona fide* offering of goods and services.

Respondent contends that it has promised to adopt rights protection mechanisms that exceed the ICANN Guidebook requirements.

## **5. Legal Contentions**

### **A. Objector**

Objector contends that Objector has standing to pursue its Objection, since it is the owner of a European Community mark for .HOME, the owner of four United States Trademark applications and one United States trademark registration for the marks TRUE HOME and TRUE.HOME, as well as having common law rights in those marks. Objector contends that the acquisition and use of the marks were *bona fide*, because the acquisitions occurred in the ordinary course of business and that the marks have been used in the ordinary course of business, such that the use is not merely token use.

Objector contends that the Objection is valid and should be upheld, because Respondent's use of the applied-for gTLD <.home> would take unfair advantage of the distinctive character or reputation of Objector's marks, would unjustly impair the distinctive character or reputation of the marks, and would create an impermissible likelihood of confusion between the applied-for <.home> gTLD and Objector's marks.

### **B. Respondent**

Respondent contends that Respondent's intended use of the applied-for gTLD <.home> is in the common generic sense that would not violate trademark law, as Respondent intends to use the <.home> gTLD to offer domain names for web site owners that want to supply Internet users with information, goods, or services related to homes. Respondent contends that neither the beginning of a URL ("http://www") nor the gTLD (e.g., ".com") have any source-indicating significance.

Respondent argues that Objector has never used the mark HOME by itself, but rather that Objector has disclaimed any exclusive rights to use the mark HOME, or that the mark has been used as part of a character and design mark or that the applied for mark is included in an intent to use application.

Respondent further contends that Objector's asserted rights in the TRUE HOME mark are not *bona fide*, because 1) Respondent did not apply for registration of the European Community Trademark until December 30, 2011, only two weeks prior to the launch of the New gTLD Program and the opening of the window in which to file New gTLD applications, and, 2) the use of the trademark was not genuine, but merely token, serving solely to preserve the rights conferred by the mark.

Respondent alleges that Objector failed to provide any evidence of recognition in the relevant sector of the public of the sign corresponding to the gTLD, as the mark of the Objector. Evidence of such recognition could be in the form of survey evidence, sales figures, affidavits, market share, geographical extent of reputation, or unsolicited media coverage of the product. Objector failed to submit any such evidence.

Respondent asserts that it intends to use the gTLD <.home> in its generic sense, and does not intend to interfere with any trademark rights of Objector or of any third party. Respondent contends that it is well

settled that a use of a term in its generic sense does not interfere with the trademark rights of any third party. Respondent further alleges, citing United States trademark authorities and treatises, that “a top level domain indicator has no source indicating significance and cannot serve any trademark purpose . . . .”

Respondent asserts that its application shows that it has made demonstrable preparations to use the sign corresponding to the gTLD in connection with a *bona fide* offering of goods or services that does not interfere with the legitimate use by Objector of its marks.

## 6. Discussion and Findings

### A. Burden of Proof

Objector bears the burden of proof in each case. Module 3, Section 3.5, New gTLD Applicant Guidebook.

### B. Standing

“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.*” Module 3, Section 3.2.2.2, New gTLD Applicant Guidebook (emphasis added).

Objector attached as the source and documentation of its legal rights two trademark registrations and four trademark applications. Each will be examined in turn to ascertain whether the Objector met its burden by attaching documentation sufficient to establish that the Objector is a rightsholder.

#### i. E.C. Trademark Registration 010535201

Objector attached a printout from the website of the Office for Harmonization in the Internal Market which consists of a copy of the E.C. Trademark registration No. 010545201. It lists the registrant as DotHome Limited of Limassol, Cyprus. Objector alleges that Dothome LTD is its wholly owned subsidiary. However Objector has failed to attach any documentation that the DotHome Limited identified as the registrant of E.C. Trademark 010535201 is a wholly owned subsidiary of Objector. Accordingly, Objector has failed to establish for the purposes of the present proceeding that it is a rightsholder by virtue of E.C. Trademark registration 010535201.

#### ii. U.S. Trademark Registration 3404246

Objector attaches a printout from the USPTO web site of USPTO trademark registration 3404246 for the trademark TRUE HOME. The printout shows that the trademark was applied for on December 21, 2006, and on April 1, 2008 a trademark issued to Carl Simpson, an individual residing in Wylie, Texas. The printout shows that sometime subsequent to the registration the trademark was assigned to Objector. The printout does not show the details of the assignment, which can be found on the USPTO web site. A visit to that page of the USPTO web site shows that the assignment to Objector was recorded on August 29, 2012.

Objector also alleges that Objector “markets, sells and installs residential heating, cooling, ventilation and plumbing products and offers domain name services through the site ‘www.dothome.net’”. No printout of the web site or other documentation of the assertion is attached as an annex to the Objection.

U.S. trademark law is clear that a trademark cannot be assigned apart from the good will that is associated with it. The most common way to ensure that the goodwill attached to the trademark is transferred in connection with the assignment of the trademark is a concurrent sale and transfer of the products or services with which the trademark has been associated. *Visa U.S.A. v. Birmingham Trust Nat’l Bank*. 696 F.2d 1371 (Fed. Cir. 1982); 15 U.S.C. § 1060; McCarthy, *Trademarks and Unfair Competition*, § 18.2. A “transfer in gross” (an assignment of a trademark without a transfer of the goodwill associated with the trademark) is

invalid. See, *Berni v. International Gourmet Restaurants, Inc.*, 838 F.2d 642 (2d Cir. 1988).

Objector has failed to attach any documentation that shows that the products or services associated with the transfer were transferred to Objector or that the assignment of the trademark was other than an in-gross transfer. Accordingly, Objector has failed to establish for the purposes of the present proceeding that it is a rightsholder by virtue of USPTO Trademark registration 3404246.

iii. U.S. Trademark Application 85588370

Objector attaches a printout from the USPTO web site of USPTO trademark application 85588370 for the trademark and design TRUE.HOME. Objector filed its application for the trademark on April 3, 2012. Objector disclaimed the exclusive right to use "HOME" apart from the mark and design as depicted in the application. No registration has issued for this mark.

In order to establish trademark rights in an unregistered trademark in the context of domain names, it is well established in domain name jurisprudence what a party seeking to establish such rights (including an objector) must produce in the form of evidentiary facts:

[A party seeking to show rights in an unregistered trademark] must show that the name has become a distinctive identifier associated with the [party seeking to establish such rights] or its goods or services. Relevant evidence of such "secondary meaning" includes length and amount of sales under the trademark, the nature and extent of advertising, consumer surveys and media recognition. The fact that the secondary meaning may only exist in a small geographical area does not limit the [party's] rights in a common law trademark. For a number of reasons, including the nature of the Internet, the availability of trademark-like protection under passing-off laws, and considerations of parity, unregistered rights can arise for the purposes of the UDRP even when the [party seeking to establish such rights] is based in a civil law jurisdiction. However, a conclusory allegation of common law or unregistered rights (even if undisputed) would not normally suffice; specific assertions of relevant use of the claimed mark supported by evidence as appropriate would be required. Some panels have also noted that in cases involving claimed common law or unregistered trademarks that are comprised of descriptive or dictionary words, and therefore not inherently distinctive, there may be a greater onus on the [party seeking to establish such rights] to present compelling evidence of secondary meaning or distinctiveness. Some panels have noted that the more obvious the viability of a [party]'s claim to common law or unregistered trademark rights, the less onus there tends to be on that [party] to present the panel with extensive supporting evidence. However, unless such status is objectively clear, panels will be unlikely to take bald claims of trademark fame for granted.

WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 1.7.

Objector fails to attach any evidence of any of the factors that would tend to establish "secondary meaning" in support of rights in the unregistered USPTO trademark 8588370. Accordingly, Objector has failed for purposes of the present proceedings to establish that it is a rightsholder by virtue of USPTO trademark application 85588370.

iv. U.S. Trademark Application 85588382

Objector attaches a printout from the USPTO web site of USPTO trademark application 85588382 for the trademark and design TRUE.HOME. Objector filed its application for the trademark on April 3, 2012. Objector disclaimed the exclusive right to use "HOME" apart from the mark and design as depicted in the application. No registration has issued for this mark.

In order to establish trademark rights in an unregistered trademark, it is well established in the context of domain names that the party seeking to establish such rights must produce relevant evidence of "secondary meaning." See Section 6(B)(iii), *supra*. Objector fails to attach any evidence of any facts that would tend to

establish “secondary meaning” in support of rights in the unregistered USPTO trademark 85588382. Accordingly, Objector has failed to establish for purposes of the present proceedings that it is a rightsholder by virtue of USPTO trademark application 85588382.

v. U.S. Trademark Application 85721554

Objector attaches a printout from the USPTO web site of USPTO trademark application 85721554 for the trademark TRUE. HOME. Objector filed its application for the trademark on September 5, 2012. No registration has issued for this mark.

In order to establish trademark rights in an unregistered trademark, it is well established in the context of domain names that the party seeking to establish such rights must produce relevant evidence of “secondary meaning.” See Section 6(B)(iii), *supra*. Objector fails to attach any evidence of any facts that would tend to establish “secondary meaning” in support of rights in the unregistered USPTO trademark 85721554. Accordingly, Objector has failed to establish for purposes of the present proceedings that it is a rightsholder by virtue of USPTO trademark application 85721554.

vi. U.S. Trademark Application 85721544

Objector attaches a printout from the USPTO web site of USPTO trademark application 85721544 for the trademark TRUE HOME. Objector filed its application for the trademark on September 5, 2012. No registration has issued for this mark.

In order to establish trademark rights in an unregistered trademark, it is well established in the context of domain names that the party seeking to establish such rights must produce relevant evidence of “secondary meaning.” See Section 6(B)(iii), *supra*. Objector fails to attach any evidence of any facts that would tend to establish “secondary meaning” in support of rights in the unregistered USPTO trademark 85721544. Accordingly, Objector has failed to establish for purposes of the present proceedings that it is a rightsholder by virtue of USPTO trademark application 85721544.

## **Conclusion**

Accordingly, as Objector has failed to include in its filing the source and documentation that would establish under the Legal Rights Objection procedure that it is a rightsholder by showing registered or unregistered trademark rights in any of the trademarks or trademark applications it has attached as Annex 1 to the Objection, the Panel finds that Objector failed to establish that it has appropriate trademark rights under the Legal Rights Objection procedure to pursue the Objection.

### **C. What Objector Has the Burden to Establish:**

Although Objector has failed to establish that it has appropriate trademark rights to file its Objection, the Panel will briefly address the merits of the Objection as such.

In order to prevail in its objection, Objector must prove:

- i. that the potential use of the applied-for gTLD by the Respondent takes unfair advantage of the distinctive character or the reputation of the objector’s registered or unregistered trade mark or service mark; or
- ii. that the potential use of the applied for gTLD by the Respondent unjustifiably impairs the distinctive character or the reputation of the Objector’s mark; or
- iii. that the potential use of the applied for gTLD by the Respondent creates an impermissible likelihood of confusion between the applied for gTLD and the Objector’s mark.

Module 3, Section 3.5.2, New gTLD Applicant Guidebook.

Under Section 3.5.2, the Panel is to consider the eight factors set out therein, whereby these factors are non-exclusive. Therefore, the Panel will consider the evidence presented in light of each of the non-exclusive factors set out in Section 3.5.2.

Apart from the fact that the Objector has failed to establish appropriate trademark rights, the Panel further considers the Response valid on the merits, in light of the following analysis.

- i. Is the applied-for gTLD identical or similar, including in appearance, phonetic sound, or meaning, to the Objector's existing mark?

Even if Objector's .HOME mark contains a graphical element as a design mark, the Panel finds similarity in appearance between the applied-for gTLD and this mark asserted by Objector, in that the term "home" is present in both.

The Panel finds that the applied-for gTLD is similar at least in appearance to the TRUE HOME and TRUE.HOME marks asserted by Objector, in that the term "home" is present in both.

- ii. Has the Objector's acquisition and use of rights in the mark been *bona fide*?

In considering whether the acquisition and use of the mark is *bona fide*, the Panel must consider the timing of the acquisition as it relates to the use of mark. The Panel must also consider the timing and the circumstances surrounding acquisition and use in relation to the New gTLD Program.

There is no evidence in the available record that Objector is using the TRUE HOME or TRUE.HOME marks.

However, Objector asserts that it is using the domain name <dothome.net> to resolve to a web site at which Objector offers domain name services. Respondent alleges that Objector registered the domain name on December 29, 2011. Neither Objector nor Respondent provide evidence, either a copy of the registration agreement or a printout from the Whois as to the actual registrant of the domain name <dothome.net>, nor as to when that domain name was first registered.

The Panel consulted the Whois and found that the domain name <dothome.net> appears to be first registered on December 29, 2011, as alleged by Respondent. However it is impossible to determine from the Whois who the actual registrant of the domain name is, because the actual registrant employed a privacy service, in this case Domains By Proxy LLC to act as the titular registrant.

It is helpful to construct a timeline of the acquisition and use of the marks relative to the New gTLD Program.

June 20, 2011 – ICANN approves New gTLD Guidebook and comments period begins.

December 29, 2011 – <dothome.net> domain name is registered.

December 30, 2011 – application for E.C. trademark .HOME and design is filed.

January 12, 2012 – Application Window for New gTLDs opens.

April 3, 2012 – Objector files two applications for marks TRUE.HOME and design with USPTO.

May 30, 2012 – Application Window for New gTLDs closes.

June 13, 2012 – New gTLD applications are published online. Formal objection period begins. Application comments period begins.

June 22, 2012 – E.C. trademark registration for .HOME and design issues.

August 29, 2012 – USPTO trademark for TRUE HOME is assigned to Objector.

September 5, 2012 – Objector files applications for marks TRUE. HOME and TRUE HOME with USPTO.

March 13, 2013 – Last day to file objections to New gTLD applications. Date Objector filed Objection.

The attempted acquisition of trademark rights appears to have been undertaken to create a basis for filing the Objection, or defending an application. There appears to have been no attempt to acquire rights in or use any marks until after the New gTLD Program had been announced, specifically two weeks before the period to file applications for new gTLDs was to open.

Questions of timing aside, the only use of the domain name <dothome.net> registered shortly before the application period opened appears to have been to resolve to a web site at which the E.C. word and design mark was prominently displayed opposite the message, “NEW WEB ADDRESS FOR HOMES, DOMAIN PRE-REGISTRATION ENQUIRY: *DOMAIN@DOTHOME.NET*.” At the bottom of the web site the following copyright notice appears: “© 2009-2012 dotHome (.HOME) Generic Top-Level Domain Name (gTLD Extension Web Address – dot.HOME TLD)”. This is misleading at best, in that Objector did not register the domain name <dothome.net> until December 29, 2011, and did not file an application for a trade mark until December 30, 2011. The domain name <dothome.net> could not have resolved to a web site prior to its creation on December 29, 2011.

In addition, while the web site at <dothome.net> purports to register domain names in existing gTLDs, the registration agreement identifies the registrar as “.MUSIC – Music.us – CGR, an individual (“New Generic Top Level Domain (gTLD) TLD Extension”)”. Objector is not among those listed by ICANN as an applicant for the <.music> new gTLD.

In all of the circumstances, the Panel finds that Objector has failed to meet its burden to show that its acquisition and use of rights in the marks has been *bona fide*.

- iii. Is there recognition in the relevant sector of the public of the sign corresponding to the gTLD, as the mark of Objector, of Respondent, or of a third party, and, if so, to what extent?

Neither Party has submitted any evidence that any sector of the public recognizes <.home> as the mark of Objector, of Respondent, or of any third party.

- iv. What was Respondent’s intent in applying for the gTLD, and did Respondent, at the time of application for the gTLD, have knowledge of the Objector’s mark, or could Respondent not have reasonably been unaware of that mark, and has Respondent engaged in a pattern of conduct whereby Respondent applied for or operates TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others?

There is no evidence that at the time Respondent applied for the new gTLD <.home> Respondent had any knowledge or could not have been unaware of the Objector’s marks, as the application for the E.C. word and design mark was made less than two weeks before the New gTLD Application Period opened, and no E.C. registration issued until almost a month after the New gTLD Application Period closed. The only other applications for a mark by Objector were made after the New gTLD application window had been open for two months, and those were for the word and design marks TRUE.HOME. On both of these applications, Objector expressly disclaimed the exclusive right to use the word “HOME” apart from the word and design marks as depicted on the applications.

There is no evidence or even a contention that Respondent engaged in a pattern of conduct whereby Respondent applied for or operated TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others.

- v. Has Respondent used, or has Respondent 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 Objector of its mark rights? If so, to what extent?

Respondent states in Respondent's application and in its Response that it intends to use the New gTLD <.home> in its generic sense to allow Internet users that provide goods, services, or information related to "homes" in the generic sense to register identifying domain names.

It should be noted that Respondent's arguments and citations for the proposition that "[a] top level domain indicator has no source indicating significance and cannot serve any trademark purpose" may not necessarily apply in the new gTLD era. Apart from the fact that Respondent, who identifies itself as a wholly owned subsidiary of Google, Inc., itself applied for the new gTLD <.google> as a branded domain, it is possible that new gTLDs with more general dictionary meaning may appropriately form part of any assessment of the legal status in trademark terms of such domain or registrations made therein.

- vi. Does the Respondent have interest in marks or other intellectual property rights in the sign corresponding to the gTLD, and, if so, was the acquisition of such a right in the sign, and use of the sign, been *bona fide*, and is the purported or likely use of the gTLD by the Respondent consistent with such acquisition or use?

Respondent claims no interest in marks or other intellectual property rights in the sign corresponding to the new gTLD <.home>. Respondent has stated in its application and its Response that it intends to use the new gTLD in the generic sense.

- vii. Has Respondent been commonly known by the sign corresponding to the gTLD? If so, to what extent, and is any purported or likely use of the gTLD by Respondent consistent therewith and *bona fide*?

Respondent has not been commonly known by the sign corresponding to the new gTLD.

- viii. Would Respondent's intended use of the gTLD create a likelihood of confusion with Objector's mark as to the source, sponsorship, affiliation, or endorsement of the gTLD?

Respondent's intended use of the new gTLD <.home> would not create a likelihood of confusion with Objector's asserted mark as to the source, sponsorship, affiliation, or endorsement of the gTLD, since Respondent intends to use the sign corresponding to the New gTLD in its generic sense.

## 7. Decision

Because Objector has not met its burden to show that it is a rightsholder for purposes of this proceeding, and even had Objector met that burden, the potential use of the applied-for gTLD by Respondent does not:

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

the Panel rejects the Objection.

[signed]

**M. Scott Donahey**  
Sole Panel Expert  
Date: July 5, 2013