

EXPERT DETERMINATION LEGAL RIGHTS OBJECTION

Defender Security Company v. Uniregistry, Corp.

Case No. LRO2013-0038

1. The Parties

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

The Applicant/Respondent is Uniregistry, Corp. of Grand Cayman, Cayman Islands, Overseas Territory of the United Kingdom of Great Britain and Northern Ireland, represented by John Berryhill, United States.

2. The applied-for gTLD string

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

3. Procedural History

The Legal Rights Objection (“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 Gabriel F. Leonardos as the Panel in this matter on June 14, 2013. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the WIPO Center to ensure compliance with Article 13(c) of the Procedure and Paragraph 9 of WIPO Rules for New gTLD Dispute Resolution.

4. Factual Background

Objector is a company based in Indiana, United States, which specializes in security services.

Objector is owner of:

United States Trademark Registration Number 3,404,246 for the mark TRUE HOME, granted on April 1, 2008;

United States Trademark Application Number 85/588,370 for the mark TRUE.HOME (and design);



United States Trademark Application Number 85/588,382 for the mark TRUE.HOME (and design);



United States Trademark Application Number 85/721,554 for the mark TRUE.HOME;

although not referenced in the Objection, Objector provided evidence in an annex of United States Trademark Application Number 85/721,544 for the mark TRUE HOME.

The present dispute concerns the TLD string <.home>.

5. Parties' Contentions

A. Objector

Objector provides residential security systems throughout the United States, markets, sells and installs residential heating, cooling, ventilation and plumbing products and offers domain name services through the website "www.dothome.net".

Objector alleges it is the second largest provider of residential security systems in the United States, serving customers from more than 140 locations nationwide.

Objector claims ownership of European Community Trademark Registration Number 010535201 for the mark .HOME (and design), granted on June 22, 2012, in the name of DotHome Limited of Limassol, Cyprus. It argues that this registration's owner is a wholly owned subsidiary of Objector.



Objector states that, since December 2011, through its wholly owned subsidiary, Dothome LTD, it has been a reseller of domains, using the .HOME mark to brand its domain reservation website, "www.dothome.net", and during that time, consumers have grown to identify the .HOME name with Objector's domain reservations services.

Objector argues that the <.home> gTLD is identical or similar to its Marks, and cites legal precedents and doctrine holding that, for the purpose of assessing the similarity of two marks, account should be taken of the overall commercial impression created by the marks in question.

Objector contends that the <.home> gTLD is identical to the "primary formative" in Objector's .HOME (and Design) European Community Trademark Registration Number 010535201, where the verbal element ".HOME" is dominant in the overall commercial impression of the mark, since the relevant public looking to reserve, register, maintain or manage an Internet domain name would focus on the verbal element ".HOME". This dominant verbal element ".HOME" is identical to the <.home> gTLD in sight, sound and meaning.

Objector also states the <.home> gTLD shares the ".HOME" formative with each of its United States Trademark Applications for TRUE.HOME and contends that Respondent's application for <.home> gTLD should be denied because it will necessarily trade upon the goodwill in the Objector's marks promoted by Objector's significant marketing efforts, creating a strong likelihood of confusion should Applicant's application be approved.

Objector affirms that its acquisition and use of the trademarks bearing .HOME has occurred in the ordinary course of trade and is a natural extension of its branding strategy, thus its acquisition and use are *bona fide*.

Objector claims that it has been a prominent and well known entity within the home services industry since 1998, with marks including ".HOME," "TRUE HOME," and "TRUE.HOME," which are all used within the home services and domain names industries targeted by the <.home> gTLD. It affirms that the number of Objector's .HOME mark followers on Facebook and Twitter alone attests to the recognition of .HOME in the domain registry sector. Furthermore, the more than eight billion pieces of print media and millions of inbound customer calls each year evidence Objector's recognition in the home services industry.

Objector argues that the allowance of Respondent's application for the <.home> gTLD will allow Respondent to impermissibly trade on Objector's goodwill in the .HOME mark, and that Respondent intends to target the disputed gTLD to the relevant sectors in which the Objector's marks are already known.

Objector claims not to be aware of any other trademark registrations for .HOME or similar marks, or of any use, or demonstrable preparations to use, the sign corresponding to the <.home> gTLD.

Objector states that, in light of its pre-existing use of, and registrations for, the .HOME formative, and the demonstrable recognition of its trademarks in the home services sector and domain registry services sector, Respondent's intended use of the <.home> gTLD would result in a likelihood of confusion as to source, sponsorship, affiliation, or endorsement between the Respondent and Objector. It also defends that, if Respondent's application is allowed, Respondent will unjustly enrich at Objector's expenses, since Objector has spent a large amount of money on investments to gain public recognition, which it has achieved due to the .HOME brand.

B. Respondent

Respondent claims that Objector is one of several parties who were solicited some months ago to purchase any of a number of cookie-cutter European trademark documents lacking any substantial basis in actual goodwill or commerce, which were filed solely to game this process, and do not reflect a *bona fide* acquisition of substantial rights.

It also states that, apart from US trademark registrations for TRUE HOME, the Objector does not demonstrate ownership of rights or goodwill in a trade or service mark, and has made a number of false statements in the Objection.

It affirms that it is well established that pending United States trademark applications are not evidence of an extant trade or service mark right. In this sense Respondent cites previous UDRP cases - *Juniper Networks, Inc. v. Kenneth Crossman*, WIPO Case No. DTV2010-0010 (“A mere pending trademark application does not of itself provide a basis for actionable rights under the policy.”); *Quiksilver Inc., Biarritz Holdings v. Martin Kejval*, WIPO Case No. D2011-1708 (“The preponderance of opinion under the Policy is that pending applications do not qualify as rights in a trademark for the purposes of this requirement. See, e.g., *Mk-Net-Work v. IVE Technologies*, WIPO Case No. D2004-0302.”).

Respondent further argues that Objector’s United States Applications were all filed in bad faith, with an obvious intent to elude the gTLD Program.

It also affirms that in two of the Objector’s trademark registrations/applications, the following disclaimer applies: “no claim is made to the exclusive right to use “HOME” apart from the mark as shown”. Thereby, Respondent concludes that as .HOME is the only relevant portion of the alleged marks which is asserted to be identical or similar to Respondent’s proposed TLD, the Objector’s express disclaimer “HOME” from these alleged “TRUE.HOME” marks cannot establish a relevant right for the purpose of this Proceeding.

Respondent contends that Objector cannot imply that a trademark application for heating, ventilation and air conditioning services, such as United States Trademark Registration Number 3,404,246, extends to a monopoly in “HOME” for general purposes. Regarding Objector’s claim that “HOME” is the dominant verbal element of Objector’s mark, Respondent argues that there is nothing in the presentation of the words “TRUE” and “HOME” in Objector’s alleged marks which renders “HOME” to be “dominant”, and there is certainly nothing which renders the word “HOME” apart from the Objector’s mark as a whole to be at all exclusive or distinctive of the Objector’s claimed services in connection with home heating and air conditioning systems.

Respondent argues that the EU registration is not owned by Objector, and Objector presents no evidence of ownership, but only states that its true owner is a wholly owned subsidiary of Objector, and therefore it is authorized to represent the interests of such subsidiary entity. Respondent criticizes the fact that the Panel is supposed to simply take this assertion of corporate ownership on faith, as the Objector provides no evidence whatsoever of its ownership of this entity, nor of authorization by the owner of the EU registration to advance any claims on its behalf.

Respondent states that the Objector could not be running a domain registration site since December 2011 (as per Exhibit I of the Response), as claimed, given that as of December 30, 2011, the registrant of *dothome.net* was neither the Objector nor “DotHome Limited”, but was instead “Constantinos George Roussos Ecommerce Ltd (CGR Ecommerce Ltd)” having name servers at <roussosgroup.com>. It further states that Objector’s claimed subsidiary, DotHome Ltd. was formed on March 28, 2012, and so could not have been in action since December 2011.

6. Discussion and Findings

The Panel acknowledges Objector’s ownership of the following trademark registration and applications:

United States Trademark Registration Number 3,404,246 for the mark TRUE HOME, granted on April 1, 2008, to a Mr. Carl Simpson, which was later assigned to Objector. The attachment does not show the details of the recordal of assignment;

United States Trademark Application Number 85/588,370 for the mark TRUE.HOME (and design);

United States Trademark Application Number 85/588,382 for the mark TRUE.HOME (and design);

United States Trademark Application Number 85/721,554 for the mark TRUE.HOME;

United States Trademark Application Number 85/721,544 for the mark TRUE HOME.

The Panel does not recognize the Objector's claimed ownership of European Community Trademark Registration Number 010535201 for the mark .HOME (and design), granted on June 22, 2012. Since this registration is rightfully owned by DOTHOME LTD, and there is no evidence presented in this Objection to support that this company is a wholly owned subsidiary of Objector.

Despite the fact that the Objector failed to provide details of the recordal of assignment regarding United States Trademark Registration Number 3,404,246, the Panel accepts that the Objector may hold trademark rights to trademark TRUE HOME, but it does not acknowledge any rights held by the Objector regarding trademark .HOME.

According to paragraph 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), in the context of domain names, in order to establish trademark rights in an unregistered trademark, the party seeking to establish such rights must produce relevant evidence of "secondary meaning" (*i.e.* that the name has become a distinctive identifier associated with the party or its goods or services). In the present Objection, Objector did not provide evidence of this "secondary meaning" in connection with US Trademark Applications nos. 85/588,370, 85/588,382, 85/721,554, and 85/721,544 and the Panel will therefore not consider these Applications as proof of legitimate rights over the respective trademarks.

According to Module 3, Section 3.5.2 of the new gTLD Applicant Guidebook, where the Objection is based on trademark rights, the Panel will consider eight non-exclusive factors:

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

The fact that both the gTLD <.home> and TRUE HOME (even if the latter two words can only be considered together, in light of the disclaimer applying to two of the Objector's trademark registrations/applications that "*no claim is made to the exclusive right to use "HOME" apart from the mark as shown*") have the term "home" in common suggests a degree of similarity.

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

The Panel accepts Respondent's observations as to the timing of Objector's trademarks acquisitions in relation to the New gTLD Program, and concurs with Respondent that the Objector did not attempt to acquire or use any of the referenced trademarks until after the New gTLD Program had been announced. It thus appears that Objector attempted to acquire the referenced trademarks specifically to create a basis for filing the present Objection and under the gTLD Program.

Also, the Panel agrees that the Objector could not have been running a domain registration site since December 2011 through the domain <dothome.net>, since DotHome Ltd. appears to have only been formed on March 28, 2012, and before that, the owner of the domain name <dothome.net> was "Constantinos George Roussos Ecommerce Ltd (CGR Ecommerce Ltd)".

In light of the above, the Panel finds that the acquisition and use of the trademarks in question 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, or of a third party.

There is no evidence in the Objection or in the Response that any sector of the public recognizes <.home> as the mark of Objector, of Respondent, or of a third party.

iv. 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.

Considering the evidence submitted in this case, the Panel considers that the Respondent did not have knowledge of Objector's trademarks at the time of the application for the gTLD <.home>. In fact, given the small window of time utilized by Objector to acquire rights to trademarks TRUE HOME and TRUE.HOME in connection with the opening of the New gTLD Program, it is very unlikely that Respondent could have had any prior knowledge in this regard.

Also, there is no evidence and no allegation has been made that the Applicant is engaged in a pattern of conduct of applying for TLDs which are identical or confusingly similar to marks of others.

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

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.

Respondent states that it intends to provide services to permit registration of ".HOME" domain names as is inherent in gTLD registry services and that its proposed registry services relate only to the non-distinctive use of the word "HOME" as a TLD string.

vi. 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.

Respondent claims no interest in marks or other intellectual property rights in the sign corresponding to the new gTLD <.home>.

vii. 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*.

There is no evidence that Respondent has been commonly known by the sign .HOME.

viii. 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.

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

Conclusion

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

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

7. Decision

For the above reasons, the Panel rejects the Objection.

[signed]

Gabriel F. Leonardos

Sole Panel Expert

Date: July 17, 2013