

PANEL DETERMINATION LEGAL RIGHTS OBJECTION

Pinterest, Inc. v. Amazon EU S.à.r.l

Case No. LRO2013-0050

1. The Parties

The Objector/Complainant is Pinterest, Inc. of San Francisco, United States of America, represented by Harvey Siskind LLP, United States.

The Applicant /Respondent is Amazon EU S.à.r.l of Luxembourg, Luxembourg, represented by Covington & Burling LLP, United States.

2. The applied-for gTLD string

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

3. Procedural History

The Legal Rights Objection (“LRO”) was filed with the WIPO Arbitration and Mediation Center (the “WIPO Center”) on March 13, 2013 pursuant to the New gTLD Dispute Resolution Procedure (the “Procedure”).

In accordance with Article 9 of the Procedure, the WIPO Center completed the review of the Objection on March 25, 2013 and 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”).

On April 10, 2013, the Objector sent an email communication to the Center. The Center acknowledged receipt of the Objector’s email communication on the same day.

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 18, 2013. On April 19, 2013, the Applicant and the Objector each sent an email communication to the Center. The Center acknowledged receipt of such email communications on April 19, 2013. On May 17, 2013, the Applicant sent a further email communication to the Center, receipt of which was acknowledged on the same day. In accordance with Article 11(b) and relevant communication provisions of the Procedure, the Response was timely filed with the WIPO Center on May 18, 2013.

The WIPO Center appointed Alan L. Limbury as the Panel in this matter on June 17, 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

According to Bloomberg, the Applicant, with its related entities (“Amazon”), founded in 1994, is “the world’s largest online retailer.” Objection, Annex SS. It has over 150 million active accounts and generated about USD 62 billion in revenue last year. Its vision apparently is to be the earth’s most customer-centric company – a place where people can come to find and discover anything they might want to buy online.

In its new gTLD application submitted to ICANN for the proposed <.pin> gTLD, Amazon described the mission and operation of the <.pin> registry. Response, Annex 2. The following is an abbreviated summary.

Amazon’s mission is to provide a unique and dedicated platform for Amazon while simultaneously protecting the integrity of its brand and reputation. A <.pin> registry will provide Amazon with additional controls over its technical architecture, offering a stable and secure foundation for online communication and interaction; provide Amazon a further platform for innovation; and enable Amazon to protect its several thousand registered intellectual property assets of all types including trademarks, designs and domain names.

<.pin> will be a single-entity registry, in which Amazon and its subsidiaries will be the only eligible registrants, through a single registrar, for use in pursuit of Amazon’s business goals. There will be no re-sellers in <.pin> and there will be no market in <.pin> domains. Amazon will strictly control the use of <.pin> domains. All domains in the <.pin> registry will remain the property of Amazon. The <.pin> registry will respect third-party intellectual property rights.

Amazon’s Intellectual Property group will be responsible for the development, maintenance and enforcement of a Domain Management Policy, which will define the rules associated with eligibility and domain name allocation; the license terms governing the use of a <.pin> domain name; and the dispute resolution policies for the <.pin> gTLD.

Amazon has applied for numerous new gTLDs. They are predominantly common dictionary words.

The Objector (“Pinterest”) has produced documentation showing that it is the owner of the registered trademark PINTEREST, registered in the United States as a service mark on May 22, 2012, No. 4145087, in classes 42 and 45, and that it is the applicant to register PIN as a trademark in the United States (serial number 85698998).

Through its website at “www.pinterest.com”, Pinterest provides an online tool to help users gather images and other content and organize it into themed collections for other users to browse and discover. In its own words:

“Each piece of content posted on Pinterest is known as a PIN. Users are known as ‘PINNERS.’ They post content to Pinterest from their own collections or other websites by ‘PINNING’ it to a themed collection called a ‘PINBOARD.’ As users browse the millions of PINBOARDS available on Pinterest, they can PIN the content they find onto their own PINBOARDS, and follow the PINNERS and PINBOARDS they find most useful or inspiring. PINS link the sources from which they were PINNED. Pinterest therefore provides a way for people to express themselves, discover new things, and engage with the people who create them. It is an immersive, creative, and social experience, and becomes more and more personal over time as PINNERS follow the boards and the PINNERS that appeal to them... ‘When you open up Pinterest,’ says Co-Founder Ben Silbermann, ‘you should feel like you’ve walked into a building full of stuff that only you are interested in.’”

“[M]any retailers use [Pinterest] in their own marketing campaigns... Still more are encouraging

consumers to PIN branded products on their PINBOARDS... Last year, Rakuten – dubbed the ‘Amazon of Japan’ (and a fierce Amazon competitor) – led a \$100 million investment in Pinterest...”

In his Declaration in support of the Objection, Mr. Anthony Falzone, Pinterest’s Deputy General Counsel, says:

“Pinterest provides a PIN IT button that website owners can incorporate into their websites. Website owners place the PIN IT button next to images or other pieces of content they want to encourage people to PIN. The PIN IT button appears on hundreds of thousands of unique domains on the Internet, and many domains place the PIN IT button next to hundreds of thousands of different images. The PIN IT button is featured on some of the most widely viewed websites on the Internet, from Amazon to eBay to Zappos. Accordingly, it is likely that more than a hundred million people have seen the PIN IT button, likely billions of times.”

Pinterest launched in March 2010. It was recently declared the third most popular social website in the world, after Facebook and Twitter, and was recently valued at USD 2.5 billion.

The following appears at its website at <pininterest.com>:

Pinning 101. Here are the basics of getting started on Pinterest.

Pin A pin starts with an image or video you add to Pinterest. You can add a pin from a website using the Pin It bookmarklet or upload an image right from your computer. Any pin on Pinterest can be repinned, and all pins link back to their source.

Board A board is where you organize your pins by topic. You could pin ideas for remodeling your bathroom to your House Projects board, for example. Boards can be secret or public, and you can invite other people to pin with you on any of your boards.

Pin It Bookmarklet The Pin It bookmarklet lets you easily pin things you see on websites and blogs. To get the bookmarklet or learn more, check out our Goodies page.

Follow When you follow someone, their pins show up in your Pinterest home feed. You can follow all of someone's boards or just the ones you like best. To manage who you're following, go to your profile and click Following.

Home Feed Your home feed is a collection of pins from pinners and boards you follow. It's updated every time someone you follow adds a pin.

The <pininterest.com> “Goodies” webpage contains the following:

The Pin It Button Pin things you find on the web

Pin It ← Drag this button to your toolbar. The Pin It button (a bookmarklet) lets you easily pin things you find on websites and blogs. Drag the red button above to your toolbar—then click it when you see an image or video you want to pin!

The “Pin It” button appears on the <pininterest.com> Goodies page as a small red rectangle with white writing.

The “Pin It” button also appears on some retailers’ sites as a white rectangle with red stylized writing, including the letter P. Objection Annexes MM and PP.

5. Parties' Contentions

A. Objector

Pinterest helps people discover the things they love. Amazon helps people buy them. Many people use Pinterest as an online catalog. Amazon is an online store. They coexist in common streams of commerce, but they cannot remain distinct with a common name. PIN is a core brand for Pinterest and the foundation of its online identity. Amazon should not be allowed to co-opt PIN by adopting the exact same string as a gTLD.

Pinterest asserts that it is the owner of the following registered trademarks:

P (stylised/logo), registered in Australia on September 10, 2012, No. 1473126, in classes 09, 35, 42 and 45 and in the European Union on August 23, 2012, No. 010634021, in classes 09, 35, 42 and 45.

PIN IT (figurative), registered in the European Union on August 23, 2012, No. 010634046, in classes 09, 35, 38, 42 and 45.

PINTEREST, registered in Australia on November 1, 2012, No. 1473124, in classes 09, 35 and 42; in New Zealand on August 14, 2012, No. 953746, in class 45; in Norway on June 11, 2012, No. 265844, in class 45; in the Philippines on June 14, 2012, No. 42012001767, in class 45; in Switzerland on November 13, 2012, No. 636315, in class 45; and in the United States as a service mark on May 22, 2012, No. 4145087, in classes 42 and 45.

Pinterest has also made many presently pending applications to register these marks, as well as PIN, in many countries, including the application to register PIN in the United States (serial number 85698998). Pinterest claims ownership of the trademark PIN based on common-law use and its many worldwide registration applications. It also claims trademark rights in several PIN-formative marks, including PINTEREST, PIN IT and P, based on common law use, its registrations and its applications.

According to *Fast Company*, Pinterest solved one of the biggest problems Amazon and other online retailers face: how to help consumers discover new things they want. Pinterest's solutions to that problem are already driving greater and greater volumes of referral traffic and commerce. This makes Pinterest a potential partner to Amazon as a referral source, and a potential threat to Amazon as a referral source to other online retailers.

On a typical day, on average: 50,000 Pinterest users PIN or RE-PIN content from Amazon; over 3 million Pinterest users see 16 million PINS from Amazon; and Pinterest users click through from Pinterest to Amazon more than 50,000 times. People who click through from Pinterest to Amazon are all potential purchasers. They see an item on Pinterest, click it, then head to Amazon, where they can buy it. Amazon also maintains a branded PINBOARD at "www.pinterest.com" and prominently features the PIN IT button next to a huge array of products on its website, "www.amazon.com".

The potential use of <.pin> as a gTLD by Amazon:

- (i) creates an impermissible likelihood of confusion between the applied-for gTLD and the PIN and other PIN family marks; and
- (ii) takes unfair advantage of the distinctive character and reputation of the PIN and other PIN family marks; and
- (iii) unjustifiably impairs the distinctive character and reputation of the PIN and other PIN family marks.

Pinterest and Amazon are both subject to the jurisdiction of the United States Court of Appeals for the Ninth Circuit, which hears appeals from United States District Courts throughout the Western United States, including those in the State of Washington, where Amazon has its principal place of business, and the State of California, where Pinterest has its principal place of business. According to that court, the following factors govern “likelihood of confusion”: (1) the similarity of the marks; (2) the relatedness of the underlying goods or services; (3) the marketing channels used; (4) the strength of the senior mark; (5) the degree of consumer care; (6) the likelihood of expansion of the goods or services; (7) evidence of actual confusion, and (8) the intent of the junior user. See *Rearden LLC v. Rearden Commerce*, 683 F.3d 1190, 1209-10 (9th Cir. 2012) (citing *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979)). These factors overlap the non-exclusive factors published by ICANN for consideration in a LRO. See Applicant Guidebook, Section 3.5.2; Procedure, Article 8(a)(iii)(bb).

In this case all these factors favor the Objector, so Amazon should not be allowed to register the <.pin> gTLD.

B. Applicant

Amazon applied in good faith for the <.pin> gTLD, which it seeks for its legitimate, non-infringing business objectives. Pinterest objects to Amazon’s <.pin> gTLD application on the basis of alleged trademark rights in the dictionary word “pin” and in other so-called “PIN-formative marks.” Through its LRO against Amazon’s <.pin> gTLD application, Pinterest effectively seeks to appropriate worldwide exclusive rights to use the dictionary word “pin” for one of its dictionary meanings.

Pinterest has failed to prove that it owns rights in a PIN trademark; that Amazon’s <.pin> gTLD creates an impermissible likelihood of confusion with any PIN mark Pinterest claims to own; that Amazon’s applied-for <.pin> gTLD “unjustifiably impairs the distinctive character and reputation of” the alleged PIN mark; and that Amazon’s applied-for <.pin> gTLD “takes unfair advantage of the distinctive character and reputation of” the alleged PIN mark. The Panel should dismiss Pinterest’s LRO.

An important factor behind Amazon’s applications for new gTLDs is to find new and innovative ways, mechanisms, and platforms to surprise and delight its customers. Amazon identified the mission of the <.pin> registry as “to provide a unique and dedicated platform for Amazon while simultaneously protecting the integrity of its brand and reputation.” Amazon’s <.pin> registry will fulfill this mission by “provid[ing] Amazon with additional controls over its technical architecture, offering a stable and secure foundation for online communication and interaction,” “provid[ing] Amazon a further platform for innovation,” and “enabl[ing] Amazon to protect its intellectual property rights.”

None of the trademark registrations or applications on which Pinterest relies cover “registry services,” which are the services for which Amazon intends to use the <.pin> gTLD.

Of the 233 applications and registrations on which Pinterest relies, there are:

- 3 P Stylized and P Logo registrations and applications, which are irrelevant as neither contains “pin” and Pinterest has not shown that the letter P and the word “pin” are legal equivalents.
- 63 pending PIN registration applications, only two of which (European Union and the Russian Federation) were filed before Amazon applied for the <.pin> gTLD and before June 13, 2012, the date on which ICANN’s “Reveal Day” disclosed that Amazon had applied for the <.pin> gTLD. The European Union application is being opposed by two different third parties.
- 0 PIN registrations anywhere (including the United States).
- 6 registrations and 159 pending registration applications for PINTEREST marks. 92 of the pending registration applications were filed after June 13, 2012, the date on which ICANN’s “Reveal Day” disclosed that Amazon had applied for the <.pin> gTLD.

- 2 PIN IT Logo registrations and applications, neither of which is in the United States. Even if the pending application matures to registration, its effective date is later than the <.pin> gTLD application submission date and “Reveal Day.”
- 0 registrations or applications for PINS, PINNING, PINBOARD, and PINNERS marks.

Although it is true that Pinterest owns the only pending U.S. application for a PIN mark in Classes 9, 38, or 42, Pinterest failed to disclose that its pending PIN registration application is the subject of a U.S. Patent and Trademark Office (“PTO”) Office Action and may not register. The PTO has referenced a third-party, earlier-filed PIN & Design registration application (now matured to registration) with which the PTO contends Pinterest’s PIN mark may be likely to cause confusion. If (and only if) the PIN registration application matures to registration can Pinterest claim that its rights in the PIN mark are exclusive – and then only to the goods and services covered by that registration, 15 U.S.C. §1057(b), which does not cover “registry services.”

Pinterest’s purported common law use of its alleged PIN mark contradicts and undermines its claim that “PIN” is a “core brand.” Pinterest actually uses “pin,” “pins,” “pinning,” “pinboard,” and “pinners” descriptively, even in its LRO.

Pinterest’s LRO lacks the usual facts used to prove secondary meaning such as advertising expenditures, survey evidence and market research.

Pinterest’s United States trademark rights (if any) are the relevant rights for the LRO and Response because Pinterest was founded in the United States; its principal place of business is in the United States; most of its users are in the United States; its website is operated and controlled from the United States; California law governs Pinterest’s Terms of Service; and Pinterest applies in its LRO the likelihood of confusion factors used by the U.S. Court of Appeals for the Ninth Circuit.

If the PIN IT Logo mark has acquired secondary meaning, why has Pinterest not sought registration of it in the United States, its primary market? Of the hundreds of registration applications Pinterest filed in nearly 100 countries over the past 18 months, why did it not file a United States PIN IT Logo registration application? Given Pinterest’s numerous filings, resources are not an issue. The most logical explanation is that Pinterest believes that the PTO would refuse registration of the PIN IT Logo because it is merely descriptive and Pinterest cannot provide secondary meaning, or likely to cause confusion with an earlier third-party registration. Regardless, without a United States Principal Register registration or proof of secondary meaning, Pinterest has not proven that its PIN IT Logo mark is valid in the United States and cannot rely on it in the LRO.

Pinterest bases its ownership claims of the PIN mark on “worldwide applications to register.” None of those applications has registered and 61 of them were filed after Amazon’s <.pin> gTLD application became public knowledge. Only two PIN applications were filed before Pinterest could have known of Amazon’s <.pin> gTLD application – one is the subject of two pending oppositions and the other is in the Russian Federation. Accordingly, Pinterest’s “worldwide applications to register” the PIN mark afford it no meaningful trademark rights – especially not in the United States, where trademark rights are based on use, not registration, and Pinterest’s pending United States PIN application *omits* any claim of United States use.

“Pin” is descriptive because it “directly and immediately conveys some knowledge of the characteristics” of Pinterest’s services. “Pinterest is a pinboard for online photos,” to which “you pin things” Pinterest is a virtual version of a classic method of collecting and displaying objects, using pins to attach them to a pinboard. *The New York Times* observes, “[u]nlike most start-up Web site names, ‘Pinterest’ actually makes sense. You pin things based on your interests.” Pinterest merely replaces a physical pinboard and pin with a virtual pinboard and pin. That usage is descriptive, not distinctive.

6. Discussion and Findings

To succeed in its Existing Legal Rights Objection to Amazon's application, Pinterest must establish, on the balance of probabilities, that the string comprising the potential new gTLD, namely <.pin>, infringes Pinterest's existing legal rights that are enforceable under generally accepted and internationally recognized principles of law. Procedure, Article 2(e)(ii).

Under Module 3, Section 3.2.2.2 of the New gTLD Applicant Guidebook, to show that it has standing as a rightsholder to file a legal rights objection, Pinterest must include in its filing the source and documentation of the existing legal rights (which may include either registered or unregistered trademarks) which it claims are infringed by the applied-for gTLD.

Pinterest relies on asserted trademark rights in PINTEREST, PIN, PIN IT and P.

Although it appears to be common ground between the Parties that the principles of law enunciated by the United States Court of Appeals for the Ninth Circuit apply in determining likely confusion between Amazon's proposed <.pin> gTLD and any trademark owned by Pinterest, the Panel does not accept Amazon's contention that Pinterest's United States trademark rights (if any) are "the relevant rights" for the LRO and Response. This is because the Internet has global reach, so the use of gTLDs is not limited by geography. Accordingly, in determining whether Pinterest has trademark rights for the purpose of considering its objection, any such rights shown by Pinterest to exist, including outside the United States, must appropriately be taken into account. In this respect the approach adopted by panelists under the Uniform Domain Name Dispute Resolution Policy (the "UDRP") is to be preferred.

Pinterest has provided (Objection, Annex G) a copy of the registration certificate of its United States registered PINTEREST mark, No. 4,145,087, registered on May 22, 2012 for:

"Providing a web site featuring technology that enables Internet users to create, bookmark, annotate, and publicly share data, in Class 42", claiming first use and first use in commerce on March 1, 2010,

and for:

"Internet-based social networking services, in Class 45", claiming first use and first use in commerce on March 10, 2010.

This certificate establishes Pinterest's standing to make this objection so far as concerns the trademark PINTEREST.

Pinterest has provided no documentation demonstrating its claimed registered trademark rights in P or PIN IT. It claims common law trademark rights in those marks, as it does also in PIN, which is not registered anywhere but is the subject of pending registration applications, including United States application No. 85698998 dated August 8, 2012. Objection, Annex E.

Both in the interests of consistency with the UDRP, which has led panelists to consider whether trademark applications constitute rights, and to avoid panels having to anticipate the outcome of contested registration applications, the Panel considers that in LRO proceedings, the approach to pending trademark registration applications should be that they do not, in and of themselves, *i.e.* in the absence of evidence of actual as distinct from constructive use, constitute trademark rights. *Fxopen Investments Inc. v. Tong Tingyun*, WIPO Case No. D2009-1527, *La Française des Jeux v. Tavenost Voyeurism Inc*, WIPO Case No. D2002-0439 and see the following discussion in *HQUK Limited v. Head Quarters*, WIPO Case No. D2003-0942:

"7.11 As to the question whether a trade mark application is sufficient to constitute a trade mark for the purposes of the Policy, yet again there is uncertainty. In *Netdokter A/S v. Jens Nielsen*, WIPO Case

No. DBIZ2002-00109 the panel decided that the pending United Kingdom trade mark application for NETDOCTOR.CO.UK was to be disregarded, on the grounds that a trade mark application did not give the applicant any trade mark rights before a trade mark registration is granted. In contrast, in *La française des Jeux v. L Welsr*, WIPO Case No. D2002-0305, the Complainant sought to rely on two CTM applications and the Panel held that the applications for CTMs revealed no obvious grounds for denying the registrations and as such the trade mark applications were considered sufficient for the purposes of the Policy.

7.12 Again, looking at this question from first principles, in the United Kingdom, where a trade mark is registered it is deemed to have been registered from the date of the filing of the application (see Ss 9(3) and 40(3) of the Trade Marks Act 1994). Therefore, an applicant for a UK trade mark has rights in that trade mark from the date of application; albeit rights that are conditional upon a future event that has retrospective effect. Are these sufficient rights for the Policy? Similarly, in the case of CTMs, Article 9(3) of the Community Trade Marks Regulation grants certain rights of compensation from the date of publication of the CTM if that mark should subsequently be granted.

7.13 However, if these are sufficient trade mark rights for the purposes of the Policy, how is a panel to decide complaints the validity of which depend upon whether or not a registration will subsequently occur? So far as trade mark litigation in the United Kingdom is concerned, the problem is avoided by section 9(3) of the Trade Marks Act 1994, which expressly provides that no proceedings can be commenced until the date of registration. Similarly, the Community Trade Mark Regulation provides that no court may decide upon the merits of a claim for compensation until the registration is published (Article 9(3)). However, no equivalent provisions exist in the Policy.

7.14 The approach of the panel to this problem in *La française des Jeux* appears to have been that in the absence of any argument or obvious reason why that the applications would not proceed to grant, then it could be assumed that they would. However, the Panel finds this approach problematic. Even if a respondent need only show an arguable case that the application will fail, a panel will still risk being drawn into an argument as to the merits of the application that it is likely to be ill-placed to deal with.

7.15 Indeed the difficulties and dangers of asking a panel to make a decision in such a case were illustrated for the Panel when it conducted a cursory online trade mark registry search in respect of the Trade Mark Applications shortly prior to issuing this decision. The results of this search suggested that two of the Trade Mark Applications either had been or were still subject to opposition proceedings, a fact that had not been alluded to or mentioned in the Complainant's Complaint."

Regarding trademark applications as not by themselves constituting rights is also consistent with 15 U.S.C. §1057(b) and (c).

Accordingly, in the absence of evidence of registered trademark rights, it is necessary for Pinterest to establish that, through use, PIN, P and PIN IT have come to identify Pinterest and its goods or services, such as to entitle Pinterest to exercise the right at common law to prevent passing off.

Trademarks "identify the source of one seller's goods and distinguish that source from other sources." McCarthy on Trademarks and Unfair Competition § 3:1 (4th ed.) (2013). To establish common law rights in a mark, a complainant must show that its mark has acquired secondary meaning, i.e., that the public associates the asserted mark with the complainant's goods and services. See *Australian Trade Commission v. Matthew Reader*, WIPO Case No. D2002-0786. ICANN Panels have found relevant evidence of secondary meaning to include "length and amount of sales under the mark, the nature and extent of advertising, consumer surveys and media recognition", *Amsec Enterprises, L.C. v. Sharon McCall*, WIPO Case No. D2001-0083.

The word PIN is a common descriptive English word, used as a noun or as a verb (as are the nouns PINNER and PINBOARD, in which Pinterest is not here claiming trademark rights).

“Descriptive names are capable of acquiring distinctiveness (e.g. BRITISH AIRWAYS and BRITISH PETROLEUM), but the more descriptive the name, the more by way of evidence that a court will require to establish reputation and goodwill; moreover, the more descriptive the name, the narrower the ambit of protection that a court will afford to the name.” *UK Betting PLC v. Pam Oldfield*, WIPO Case No. D2005-0637.

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

“The crux of the secondary meaning doctrine is that the mark comes to identify not only the goods but the source of those goods. To establish secondary meaning, it must be shown that the *primary* significance of the term in the minds of the consuming public is not the product but the producer (citations omitted). This may be an anonymous producer, since consumers often buy goods without knowing the personal identity or actual name of the manufacturer.” *8-12002007* [United States] *Trademark Manual of Examining Procedure (TMEP) 1212*. Response, Annex 5.

On the material presented by Pinterest in support of its Objection, the Panel is not satisfied that the word PIN has been used, either by Pinterest itself or by the very large number of Internet users, retailers and media commentators since Pinterest started in 2010, in such a way as to give rise to secondary meaning (*i.e.*, as primary significance) identifying Pinterest as the source of its goods or services. Rather, that word has not been shown to have been used otherwise than in its common ordinary English meaning, as a verb to describe the process of connecting things together or as a noun to describe the connection itself. The fact that the connection is made online, *i.e.* virtually rather than physically, does not alter this conclusion. Because Pinterest and others use this dictionary term for its dictionary meaning and not as a trademark, the Panel is not satisfied that PIN functions as a mark to identify Pinterest or its goods or services.

Pinterest’s website and the websites of retailers, including Amazon, depict the P (stylised/logo) and PIN IT (figurative) marks. Given the massive growth of Pinterest and the large number of Internet users exposed to these marks, the Panel is prepared to accept that they have come to identify Pinterest in the public mind, in the form in which they are displayed, such that Pinterest has common law rights in those marks.

Accordingly, in accordance with Module 3, Section 3.5.2 of the New gTLD Applicant Guidebook, the issue to be determined is whether the potential use of <.pin> as a gTLD by Amazon:

- (i) creates an impermissible likelihood of confusion between the applied-for gTLD and Pinterest’s P (stylised/logo), PINTEREST (word) or PIN IT (figurative) marks; or
- (ii) takes unfair advantage of the distinctive character and reputation of any of those marks; or
- (iii) unjustifiably impairs the distinctive character and reputation of any of those marks.

As stated by the learned panelist in *Right At Home v. Johnson Shareholdings, Inc.*, WIPO Case No. LRO2013-0030 (<.rightathome>), July 3, 2013:

“The use of the terms ‘unfair,’ ‘unjustifiably,’ and ‘impermissible’ as modifiers, respectively, of ‘advantage,’ ‘impairs,’ and ‘likelihood of confusion’ in Section 3.5.2 suggests that there must be something more than mere advantage gained, or mere impairment, or mere likelihood of confusion for an Objection to succeed under the Procedure. It seems, rather, that there must be something untoward – even if not to the level of bad faith – in the conduct or motives of Respondent, or something intolerable in the state of affairs which would obtain if the Respondent were permitted to keep the String in dispute.”

Under Section 3.5.2, relevant factors to be considered by the Panel in cases in which trade marks are relied on include, without limitation, the following, with this Panel's findings set out in relation to each of them:

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

The <.pin> gTLD is not identical or similar to the P mark. It has some similarity to the PINTEREST mark, although, as in the case of HEAT and THEATRE, even if the proposed gTLD is wholly incorporated within the trademark, the similarity is weak. It is similar in appearance, phonetic sound and meaning to the words of the figurative PIN IT mark. Because PIN and IT are descriptive words and because PINTEREST is a blend of the two descriptive words PIN and INTEREST, the following passage from the Australian High Court case of *Hornsby Building Information Centre Pty. Ltd. v. Sydney Building Information Centre Ltd* (1978) 140 CLR 216 at 229 is apposite:

"There is a price to be paid for the advantages flowing from the possession of an eloquently descriptive trade name. Because it is descriptive it is equally applicable to any business of a like kind, its very descriptiveness ensures that it is not distinctive of any particular business and hence its application to other like businesses will not ordinarily mislead the public. In cases of passing off, where it is the wrongful appropriation of the reputation of another or that of his goods that is in question, a plaintiff which uses descriptive words in its trade name will find that quite small differences in a competitor's trade name will render the latter immune from action (*Office Cleaning Services Ltd. v. Westminster Window and General Cleaners Ltd.* (1946) 63 RPC 39, at p 42, per Lord Simonds). As his Lordship said (1946) 63 RPC, at p 43, the possibility of blunders by members of the public will always be present when names consist of descriptive words – "So long as descriptive words are used by two traders as part of their respective trade names, it is possible that some members of the public will be confused whatever the differentiating words may be." The risk of confusion must be accepted, to do otherwise is to give to one who appropriates to himself descriptive words an unfair monopoly in those words and might even deter others from pursuing the occupation which the words describe."

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

Pinterest's acquisition of the P, PINTEREST and PIN IT marks has been *bona fide*, even though many of its applications to register the marks were filed after it became known that Amazon had applied for the <.pin> gTLD.

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.

The P mark does not correspond to the gTLD. Nor does the PIN IT mark, given that its distinctiveness is in its figurative element. The following assessment being confined to this administrative proceeding and not implying any wider applicability, the Panel finds insufficient evidence in the record presented in this case that PIN is primarily recognized by the public generally, by Internet users generally, by visitors to Pinterest's website, by visitors to the websites of retailers who use Pinterest in their own marketing campaigns, by the media or by any other sector of the public as the mark of Pinterest. Nor is there any evidence before the Panel that PIN is recognized by any sector of the public as the mark of Amazon or anyone else. The descriptive meaning of the word is universally recognized.

iv. 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.

Amazon intends to operate a domain name registry, engaging a single registrar who will issue to Amazon-

related entities domain names in the <.pin> gTLD space. Amazon must have been aware of the PINTEREST trademark at the time of application for the gTLD, even though that mark had not then been registered. It is likely that Amazon was also then aware of the P and PIN IT marks, since it had engaged with Pinterest in promoting the use of the Pinterest website and had encouraged its own visitors to pin items of interest. Amazon has applied for numerous new gTLDs but they are predominantly common dictionary words. There is no evidence before this Panel that any of them are identical or confusingly similar to the 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.

There is no evidence that Amazon has used PIN in any way, other than for the purpose mentioned above at iv. In applying to register <.pin> as a gTLD, it has made demonstrable preparations to use that sign in connection with a *bona fide* offering of registry services in a way that has not been shown to be likely to interfere with the legitimate exercise by Pinterest of its P, PINTEREST and PIN IT trademark rights.

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.

There is no evidence before the Panel that Amazon has marks or other intellectual property rights in the sign PIN.

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 before the Panel that Amazon has been commonly known by the sign PIN.

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.

Despite the similarities mentioned in answer to question i, there is a significant difference between Amazon's proposed <.pin> gTLD and Pinterest's P mark; the difference between the gTLD and the PINTEREST mark is less significant; and the difference between the gTLD and the word element of the PIN IT mark is small. When the figurative element of the latter mark is taken into account, (as it must be, since that is the mark's distinctive element), the difference is greater. As explained above in *Hornsby*, where descriptive words are used in a trade name, quite small differences in a competitor's trade name will render the latter immune from action and the risk of confusion must be accepted.

Amazon's intended use of the <.pin> gTLD is to operate registry services for entities within its ownership and control, and also itself to register and use domain names in the <.pin> gTLD space, such as (perhaps) <amazonbooks.pin> and <specialthingsto.pin>. Further, Amazon has indicated in its application an awareness of the need to respect the trademark rights of others. Should a complaint be made about a second level registration in the <.pin> gTLD space, Amazon itself would be the respondent. Accordingly, it is unlikely that Amazon's Intellectual Property Group would permit registration of a domain name such as <pinterest.pin> and even if it were to do so, the confusion that would arise would spring primarily from the use of the second-level registration rather than from the <.pin> gTLD.

For these reasons and because the word PIN is a common, descriptive word, the Panel finds that, on the evidence provided by Pinterest in this proceeding, Amazon's intended use would not create a likelihood of confusion with Pinterest's P, PINTEREST or PIN IT marks as to the source, sponsorship, affiliation, or

endorsement of the <.pin> gTLD.

Finally, the Panel notes that any other legal issues that might arise as a consequence of Pinterest's and Amazon's respective activities, relationships and intentions involving the use of the word PIN on the Internet would fall outside the scope of this administrative, trademark-based procedure.

7. Decision

The Panel concludes that the Response is valid and should be upheld because the potential use of <.pin> as a gTLD by Amazon:

- (i) does not create an impermissible likelihood of confusion between the applied-for gTLD and Pinterest's P (stylised/logo), PINTEREST (word) or PIN IT (figurative) marks; and
- (ii) does not take unfair advantage of the distinctive character and reputation of any of those marks; and
- (iii) does not unjustifiably impair the distinctive character and reputation of any of those marks.

For the above reasons, the Objection is rejected.

[signed]

Alan L. Limbury
Sole Expert Panel
Date: July 16, 2013