

EXPERT DETERMINATION LEGAL RIGHTS OBJECTION

DotMusic Limited v. Amazon EU S.à.r.l.

Case No. LRO2013-0057

1. The Parties

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

The Applicant/Respondent (the “Applicant”) is Amazon EU S.à.r.l., Luxembourg, represented by Edwards Wildman Palmer UK LLP, the United Kingdom of Great Britain and Northern Ireland.

2. The applied-for gTLD string

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

3. Procedural History

The Legal Rights Objection (the “Objection”) was filed with the WIPO Arbitration and Mediation Center (the “WIPO Center”) on March 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 22, 2013 and determined that the Objection complied with the requirements of the Procedure and the World Intellectual Property Organization Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections (the “WIPO Rules for New gTLD Dispute Resolution”).

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

In accordance with Article 11(a) of the Procedure, the WIPO Center formally notified the Applicant of the

Objection, and the proceedings commenced on April 19, 2013. In accordance with Article 11(b) and relevant communication provisions of the Procedure, the Response was timely filed with the WIPO Center on May 18, 2013.

The WIPO Center appointed Kiyoshi Tsuru as the Panel in this matter on June 18, 2013. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the WIPO Center to ensure compliance with Article 13(c) of the Procedure and Paragraph 9 of WIPO Rules for New gTLD Dispute Resolution.

On April 26, 2013, the Objector made a request to the WIPO Center that Mr. Jason Schaeffer of ESQwire.com P.C. be copied on the correspondence related to this case. However, on July 10, 2013, Mr. Schaeffer himself sent the following communication to the Center:

“I write to clarify, and avoid confusion that appears in some recent communications, for the .MUSIC, .SONG, and .TUNES LRO proceedings. Please note that Objector is still represented by the original filer of the Objections, Constantine Roussos and should remain the representative and primary point of contact.

DotMusic Limited has asked that our firm be copied on correspondence.”

In similar WIPO Cases LRO2013-0065 (<.tunes>) and LRO2013-0064 (<.song>) involving the same parties as this present case, the panels have found these requests to be unusual:

“The Panel has considered this request, which is somewhat surprising given the Objector’s earlier notice that Mr. Schaeffer would be assisting the Objector. In any event, the Panel does not consider it appropriate that a person or party, who is not a party to proceedings and is not, or no longer, the formal representative of a party, be copied on correspondence. The Panel therefore determines that Mr. Schaeffer and his firm not be included on any further communication in this case.” (WIPO Case No. LRO2013-0065 (<.tunes>))

This Panel agrees with previous panels in that these requests are out of place, and determined that Mr. Schaeffer no longer be copied on any correspondence related to this case.

On July 16, 2013, the Objector sent an uninvited communication to the WIPO Center, the Panel, and parties, with an “Objector’s Additional Submission.”

On July 22, 2013, the Applicant sent an uninvited submission to the WIPO Center, the Panel, and parties, regarding the “Objector’s Additional Submission.”

On July 25, 2013 the Panel issued Expert Panel Order No. 1 stating that according to Article 17(a) of the Procedure, the admissibility of additional submissions is a matter left to the discretion of the Panel, and inviting the Applicant to file a submission addressing the “Objector’s Additional Submission” so that both parties would have an equal opportunity to argue the case.

On July 30, 2013 the Applicant sent a submission to the WIPO Center in response to the Expert Panel Order No. 1.

4. Factual Background

The Objection relies on the following European Community Trademarks registered with the Office for Harmonization in the Internal Market (“OHIM”) (the “DotMusic trademarks”):

Registration No.	Trademark	Class	Registration Date
008139792	.MUSIC	35, 42, and 45	November 3, 2009
008139834	DOTMUSIC	35, 42, and 45	November 11, 2009

5. Parties' Contentions

A. Objector

The Objector asserts the following:

1. That it is the owner of a business regarding e-commerce, affiliate marketing and domain-related activities; that since 2005 said business has driven hundreds of millions of pageviews and millions of visitors.
2. That the consumers have grown to identify the DotMusic trademark and related trademarks such as .SONG, .TUNES, .ARTIST; that said trademarks have over five million followers/fans across social media sites.
3. That the DotMusic trademarks have been featured alongside leading and globally-recognized brands, such as GOOGLE, VERISIGN, PEPSI, and COMEDY CENTRAL.
4. That the Applicant had knowledge of the DotMusic trademarks at the time of the application for the gTLD, given the significant marketing efforts made by DotMusic.
5. That the Applicant's intended use of the gTLD would create a strong likelihood of confusion with the trademark DotMusic confusing people into believing that the goods and/or services they identify come from the same source.
6. That the potential use of the applied-for gTLD by the Applicant (i) takes unfair advantage of the distinctive character and reputation of the DotMusic trademarks and business; (ii) unjustifiably impairs the distinctive character and reputation of the DotMusic trademarks and business; (iii) creates an impermissible likelihood of confusion between the applied-for gTLD and the DotMusic trademarks and business.
7. That the Objector's trademarks are well-known or famous.
8. The Objector claims that MCMO, the Music Community Member Organization, has millions of members.

B. Applicant

The Applicant argues the following:

1. That the applied-for gTLD <.music> will be used to describe the music-related goods and services it offers, distinguished by second and lower level domain names, to help average consumers to understand the goods and services being offered at a particular URL.
2. That the Applicant does not propose to use the applied-for gTLD as a separate trademark or for the provision of advertising services, software or web design services or any of the other services listed in classes 35 or 42 of the Objector's registrations.
3. That DotMusic Limited was incorporated on March 26, 2012.
4. That Mr. Roussos applied to register the marks on which it relied regarding these proceedings in March, 2009, eighteen months after the Generic Names Supporting Organization (GNSO) announced that existing trademarks should be capable of blocking the delegation of new gTLDs.

5. That the Objector registered 20 figurative marks, each of them incorporating a “.” followed by a generic or descriptive word with some stylization characterized by figurative elements.
6. That the trademarks .MUSIC and DOTMUSIC do not have inherent distinctiveness and that the average consumer will understand the gTLD <.music> to refer to music-related goods and services and will not perceive the term “music” to be designation of a single commercial origin of such goods and services.
7. That there is a lack of double-similarity of i) signs; and ii) goods/services making it impossible to create “likelihood of confusion”.

6. Discussion and Findings

Section 3.5.2 of ICANN’s gTLD Applicant Guidebook (the “Guidebook”) requires the Objector to prove that the Applicant’s potential use of the applied-for gTLD:

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

In this analysis, considering that the Objection relates to registered trademarks, the following (non-exclusive) factors should be taken into consideration.

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

The Objector’s trademark .MUSIC (and design) is formed by the term “music” and a design of a stylized reversed treble clef, a staff, notes, a star and colors:



The Objector’s trademark DOTMUSIC (and design) is formed by the term “dotmusic” and a design of a stylized reversed treble clef, a staff, notes, a star and colors:



The design elements of these trademarks cannot be reproduced in the Domain Name System (“DNS”). If we put these design elements (which have no relevance in the DNS) aside, the Objector’s trademarks are reduced to the terms “music” and “dotmusic”. The Panel therefore finds that the Objector’s trademark .MUSIC (and design) is similar but not identical to the gTLD <.music>, and that the Objector’s trademark DOTMUSIC (and design) is also similar but not identical to the gTLD <.music>.

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

The Objector has presented some evidence to argue that it has rights to object this new gTLD application. This evidence consists of some Community Trademark Registrations (“CTM”).

The panel in *DotMusic Limited v. dot Music Limited*, WIPO Case No. LRO2013-0059 <.music> stated that the applicant/respondent in that case “brought to the [p]anel’s attention that prior to the filing of the CTM applications, Mr. Constantinos Roussos had been refused trade mark registration in the United States for ‘DOTMUSIC’, ‘MUSIC.US’, and ‘.MUSIC and Design’ filed on December 19, 2007, March 3, 2009, and

December 31, 2010, respectively.” This fact is relevant to the present case, because the competent authority in the jurisdiction of the Objector thought that these terms were not protectable.

The family of CTM registrations obtained by the Objector reveals to the Panel a pattern of conduct: most of the registrations filed by the Objector as evidence in this proceeding consist of descriptive and generic terms, plus a design and colors:

	Trademark	Filing date	Registration Date
1		06/01/2012	03/08/2012
2		06/01/2012	03/07/2012
3		30/12/2011	25/06/2012
4		30/12/2011	22/06/2012
5		30/12/2011	25/06/2012
6		30/12/2011	22/06/2012
7		30/12/2011	22/06/2012
8		30/12/2011	22/06/2012
9		30/12/2011	22/06/2012
10		30/12/2011	22/06/2012
11		30/12/2011	22/06/2012

	Trademark	Filing date	Registration Date
12		30/12/2011	25/06/2012
13		30/12/2011	22/06/2012
14		20/01/2012	09/07/2012
15		08/02/2012	-
16		08/02/2012	05/07/2012
17		08/02/2012	04/07/2012
18		10/02/2012	06/07/2012
19		10/02/2012	06/07/2012
20		15/02/2012	13/07/2012

All of these trademarks were registered after the Guidebook was published. In the Panel's opinion, this trademark portfolio seems to be more part of a strategy or mechanism for challenging possible new gTLD applications, as opposed to a model for protecting trademarks that distinguish goods or services in commerce *i.e.* that the Objector has positioned itself within statutory mechanism of the Guidebook.

The rationale of the Guidebook is to award trademark holders a chance to defend their intellectual property rights in the process of the rollout of new gTLDs. In other words, the Guidebook seeks to protect the existing holders of trademarks that could be affected during the launch of new gTLDs. In the Panel's view, the impression is that the Objector was not a holder of these trademarks prior to the creation of the Guidebook, but that said Objector decided to create the conditions that would allow it to challenge gTLD applications. As such, the Panel is of the opinion that the Objector's acquisition and use of its trademarks was not *bona fide*.

3. Whether and to what extent there is recognition in the relevant sector of the public of the sign corresponding to the gTLD, as the mark of the objector, of the applicant or of a third party.

The Panel finds that the Objector has not submitted sufficient evidence to establish that there is recognition in the relevant sector of the public of the sign corresponding to the <.music> gTLD. The Objector submitted some information regarding campaigns, sponsorships and follower figures on Facebook and Twitter, but did not prove to the Panel's satisfaction that the relevant sector of the Internet-using public recognizes MUSIC or DOTMUSIC as distinctive marks of the Objector, of the Applicant, or of a third party.

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

The Objector's trademarks MUSIC and DOTMUSIC incorporate the term "music" together with some designs and colors. In the DNS, only the word elements of trademarks are relevant, and the word "music" is generic. See WIPO Case No. LRO2013-0059 <.music>, *supra*:

"Similarly, the Panel notes that OHIM has consistently refused registration of word marks containing the term 'music' as being devoid of any distinctive character. See Second Board of Appeal's decision of September 6, 2007, in Case R527/2007-2 ("Clearly and indisputably the individual words 'hear' and 'music' are as banal and non-distinctive in respect to anything musically related as it is possible to dream up ... [and accordingly] it is difficult to detect even the faint beat of a trade mark pulse in ['HEAR MUSIC']"); also First Board of Appeal's decision of September 14, 2007, in Case R 431/2007-1 (noting that the proposed mark 'MUSIC EVERYWHERE' was composed of two extremely common terms in the English language which would be perceived by the relevant public as an indication of the intended purpose of the services, namely services enabling the reception and listening to music everywhere."

The Panel cannot infer that the Applicant intended to apply for a gTLD that was identical or confusingly similar to a trademark of others. The Applicant requested a string that comprises the common and generic term "music".

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

The Applicant has proved no demonstrable preparations to use the sign corresponding to the gTLD in connection with a *bona fide* offering of goods or services. Considering that "music" is a generic and descriptive term, the Panel does not find such use to be of much relevance at this point. See *DotTunes Limited v. Amazon EU S.à.r.l.*, WIPO Case No. LRO2013-0065 where given the generic nature of the gTLD and the very limited use made by the Objector of the mark .TUNES the Panel did not consider the element relevant to deciding this case.

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

The Applicant has not sought to provide any evidence of trademark ownership for the sign corresponding to the applied-for gTLD.

7. Whether and to what extent the applicant has been commonly known by the sign corresponding to the gTLD and if so, whether any purported or likely use of the gTLD by the applicant is consistent therewith and *bona fide*.

The Applicant has not sought to show that it has been commonly known by the sign corresponding to the gTLD.

8. Whether the applicant's intended use of the gTLD would create a likelihood of confusion with the objector's mark as to the source, sponsorship, affiliation, or endorsement of the gTLD.

The Objector has not proved to the Panel's satisfaction that MUSIC or DOTMUSIC are recognized by the public. As such, the Panel finds it unlikely that the Applicant's intended use would create a likelihood of confusion with the Objector's marks in the DNS as to the source, sponsorship, affiliation, or endorsement of the gTLD.

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 trademarks and/or
- (ii) unjustifiably impairs the distinctive character or the reputation of the Objector's mark and/or
- (iii) otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the Objector's marks.

7. Decision

For the above reasons, the Objection is rejected.

[signed]

Kiyoshi Tsuru

Sole Panel Expert

Date: August 21, 2013