

EXPERT DETERMINATION LEGAL RIGHTS OBJECTION

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

Case No. LRO2013-0065

1. The Parties

The Objector is DotTunes Limited of Lemesos, Cyprus, represented by Mr. Constantine Roussos, Cyprus.

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

2. The applied-for gTLD string

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

3. Procedural History

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

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

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 Douglas Clark 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 wrote to the WIPO Center requesting that Mr. Jason Schaeffer of ESQwire.com P.C. who was stated to be assisting the Objector on the case be copied on correspondence related to the case. On July 10, 2013, Mr. Schaeffer wrote to the WIPO Center as follows:

"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 [sic] should remain the representative and primary point of contact.

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

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 entity 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.

4. Factual Background

The Objector is the registered proprietor of a European Community Trademark .TUNES & device, number 010535409 in classes 35, 42 and 45. The mark was applied for on December 30, 2011. The specification of the mark covers, *inter alia*:

"domain name reservation, registration, maintenance and management services; domain name searching services; domain name registry services, namely co-ordinating the assignment of domain names and address space; legal research relating to Internet domain names" (class 45), "[c]omputer services, namely research, reservation, recording and administration of Internet domain names; ... technical expertise relating to Internet domain names and projects; ... management of a web based commercial platform of Internet domain names and projects, surveying for Internet domain names and projects, design and development of Internet projects" (class 42) and "management of databases, management of a database for Internet domain names and projects, also containing Internet domain names and other Internet addresses; administrative services provided in connection with registration and allotment of Internet domain names and other Internet addresses, including renewal and assignment services" (class 35).

A representation of the mark is set out below.



The Applicant and its related entities are involved in the sale over the Internet of a large range of products and services. The Applicant registered the gTLD <.tunes> with the intention of being a single-entity register to allow related entities of the Applicant to make use of the gTLD.

5. Parties' Contentions

A. Objector

The Objector asserts that it is an e-commerce company that does business under ".MUSIC" themed domain names, including .MUSIC, .SONG and .TUNES. In its Objection the Objector states that it "conducts business as 'DotTunes', '.TUNES', 'DotMusic', '.MUSIC' or 'Music.us' and is referenced hereinafter as 'DotMusic.'" This definition caused the Panel some difficulty, because it is not always clear if the Objector was referring to ".tunes" or ".music". In setting out the Objector's contentions, the Panel has kept this

definition where it appeared.

The Objector filed evidence showing the fame of .MUSIC including the sponsorship of various events, press releases and Internet traffic. Very little evidence was filed showing any fame of .TUNES; the Objector relied upon the following Twitter and Facebook accounts:

"www.twitter.com/dot_tunes" (over 50,000 followers with over 1,000 account posts)
"www.facebook.com/dottunes" (over 20,000 fans).

The Objector also produced a screen shot for "www.dottunes.info" where the .TUNES trademark is shown and advertised as "the new web address for tunes" and inviting pre-registration.

The Objector alleges that the potential use of the applied-for gTLD by the Applicant:

- (i) takes unfair advantage of the distinctive character and reputation of DotMusic's Marks and DotMusic's business; and
- (ii) unjustifiably impairs the distinctive character and reputation of DotMusic's Marks and DotMusic's business; and
- (iii) creates an impermissible likelihood of confusion between the applied-for gTLD and DotMusic's Marks and DotMusic's business.

B. Applicant

The Applicant's principal response is that there is no distinctive character, either inherent or acquired, in the generic and descriptive word "tunes". The Objector's trademark is for a figurative mark depicting stylised wording, colours, graphics representing a speech bubble and a person wearing headphones. Accordingly, the Applicant argues the trademark's distinctive character resides solely in the appearance and arrangement of its graphical elements, including its colouring and font, the speech bubble and the large, imposing image of a person wearing headphones.

The Applicant argues that it is a generally accepted and internationally recognised principle of trademark law that whether a sign is distinctive is assessed from the perspective of the average consumer of the goods and services supplied under the mark. Further, it is generally accepted that to be protectable as a trademark, a sign must possess sufficient distinctive character to enable an average consumer to distinguish one supplier's goods and services from those of another supplier. If a sign has no distinctive character, it is not capable of performing this essential function of designating origin, and cannot be protected as a trademark.

The Applicant argues that there is no inherent distinctiveness in the text strings "tunes" or ".tunes". The average consumer will understand "tunes" to refer to music-related goods and services and will not perceive "tunes" as a designation of a single commercial origin of such goods and services. The addition of "." to the generic and descriptive sign "tunes" does not affect this analysis since these minor elements will be disregarded by the average consumer, particularly the average Internet consumer, as incapable of distinguishing or otherwise changing the meaning of the (generic and descriptive) dominant element of that sign.

The Applicant accepts that a non-distinctive mark may acquire distinctiveness. However, the Applicant emphasizes that none of the Objector's evidence went anywhere to show that the Objector's trademark had acquired distinctiveness.

For these reasons the Applicant argues that the Applicant's gTLD would not affect the repute of the Objector's .TUNES trademark nor would it take unfair advantage or be an unjustifiable impairment, or create an impermissible likelihood of confusion in relation thereto.

6. Discussion and Findings

The Panel finds that the Objection should be rejected.

The Objector's trademark .TUNES is phonetically similar to the gTLD <.tunes>. The word "tunes" is, however, a generic and descriptive mark when used in relation to music, which is the intended use of both the Objector and the Applicant. The .TUNES trademark as registered includes many other elements, including, colours, a speech bubble and the image of a person wearing headphones. None of these are similar to the <.tunes> gTLD. It is in fact likely that an application for "TUNES" by itself as a trademark without these additional features would have been rejected for registration.

The Objector has produced very little evidence of use of .TUNES in trade or commerce. More substantial evidence was produced in relation to the use of .MUSIC. However, no substantive argument was put forward as to why this was relevant to the application for TUNES. The panel can see no relevance other than that they are related words. The Panel does not consider that any consumer seeing the gTLD <.tunes> would relate it to the Objector. (For the avoidance of doubt, the Panel wishes to make it clear it is not making findings in relation to distinctiveness of .MUSIC. That gTLD is the subject of other LRO proceedings.)

Section 3.5.2 of the ICANN Applicant Guidebook provides that where the Objection is based on trademark rights, the Panel will consider eight non-exclusive factors. To the extent still relevant in light of the above, the Panel sets out its views under each of these factors below.

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

The gTLD <.tunes> is similar to the Objector's registered trademark phonetically. There are, however, as set out above, substantial differences to the mark as registered and how it would be used as a string in a gTLD.

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

Given its findings, the Panel does not consider it necessary to make a finding in relation to the Objector's *bona fides*.

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.

As set out above, there is very little evidence of any recognition by the public of the mark of the Objector. As to the Applicant, see vi and vii, below. The Parties' pleadings do not focus on third-party marks.

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.

Given the generic and figurative nature of the Objector's mark, whether the Applicant had knowledge of the Objector's mark is not particularly relevant in this case. 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.

There was no evidence from the Applicant as to preparations it had made to use the gTLD <.tunes>. In any event, given the generic nature of the gTLD and the very limited use made by the Objector of .TUNES the Panel does not consider the element relevant to deciding this case.

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.

The Applicant bases its case on the argument that the gTLD is generic and descriptive. It therefore has not sought to prove any intellectual property rights.

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*.

The Applicant has not been commonly known by the sign <.tunes> or TUNES. It intends to build a business using the gTLD.

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.

Given the generic nature of the sign and the limited use of the Objector's mark, the Panel finds that there is little or no likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the gTLD.

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 Objection is rejected.

[signed]

Douglas Clark
Sole Panel Expert
Date: July 14, 2013