

EXPERT DETERMINATION LEGAL RIGHTS OBJECTION

DotMusic Limited v. Entertainment Names Inc.

Case No. LRO2013-0061

1. The Parties

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

The Respondent/Applicant (“Applicant”) is Entertainment Names Inc. of Tortola, British Virgin Islands, Overseas Territory of the United Kingdom of Great Britain and Northern Ireland, represented by Minds + Machines, California, United States.

2. The applied-for gTLD string

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

3. Procedural History

The Legal Rights Objection (“Objection”) was timely filed with the WIPO Arbitration and Mediation Center (the “WIPO Center”) on March 14, 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”).

The WIPO Center received a proposal from a third-party to consolidate the Objections LRO2013-0057, LRO2013-0058, LRO2013-0059, LRO2013-0060, LRO2013-0061, LRO2013-0062, and LRO2013-0063 on April 25, 2013. The Objector indicated support to aspects of the consolidation proposal, which was opposed by 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.

On March 22, 2013, in accordance with Article 11(g) of the Procedure, the WIPO Center notified the Applicant of a deficiency in the filed Response, specifically, that the Response had not been filed using the appropriate model form which is required for use to respond to an objection filed under the Procedure. The WIPO Center in its notification requested the Applicant to file an amended response curing the deficiency within five days.

On May 23, 2013, the Applicant filed an Amended Response, the receipt of which was acknowledged by the WIPO Center on the same day.

The WIPO Center appointed Miguel B. O'Farrell 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 July 15, 2013 the Objector of its own accord submitted an Additional Submission. On July 16, 2013 the Applicant objected to any additional submissions and requested the Panel that should it allow the submission Applicant should be given the opportunity to rebut it.

On July 17, 2013 the Panel issued a Procedural Order granting Applicant a term of five days for rebuttal of the Objector's Additional Submission, without prejudice to the Panel's determination of the admissibility of such submission. The Applicant filed a timely Response to the Objector's Additional Submission.

In the same Procedural Order, the Panel decided that, as decided by another panel in a similar case (*Dot Tunes Limited v. Amazon EU S.à.r.l.*, WIPO Case No. LRO2013-0065), Mr. Jason Schaeffer and his firm were not to be included on any further communication in this case.

The Panel accepts the Additional Submissions submitted by both parties and will consider them to the extent that the Panel finds that they contain anything useful to help decide the case.

4. Factual Background

The Objector is the registered owner of the figurative European Community Trade Marks ("CTM") No. 00139792 .MUSIC and device (applied for on March 5, 2009 and granted on November 3, 2009) and No. 008139834 DOTMUSIC and device (applied for on March 5, 2009 and granted on November 11, 2009) in classes 35, 42 and 45. The specification of the marks cover, *inter alia*:

"domain name reservation, registration, maintenance and management services; domain name searching services; domain name registry services, namely coordinating the assignment of domain names and address space; technical and legal research relating to Internet domain names (45), "Computer 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 (42), "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 (35)."

In both marks, the letter “s” in “music” is the representation of a treble clef flipped horizontally on a figure of a stylized star, with a green, white and blue-gray color combination as set out below:



The Applicant has applied for the gTLD <.music> which has been objected to by the Objector based primarily upon the above-mentioned trademarks rights and other arguments which will be dealt with below.

5. Parties' Contentions

A. Objector

The Objector asserts that it is an e-commerce company that does business with “.MUSIC”-themed marks, including .MUSIC, DOTMUSIC and others such as .SONG, .TUNES, and .ARTIST.

The Objector has produced evidence to prove the fame of DotMusic, including the sponsorship of various events, press releases and Internet traffic.

The Objector alleges that “if the Applicant assumes the goodwill created by DotMusic then the Applicant will take unfair advantage of the millions of dollars invested by DotMusic in its business related to its Marks” and continues to argue that “Applicant would unfairly benefit from the significant reputation and goodwill established by DotMusic’s actual bona fide use of its Marks creating an inevitable likelihood of confusion among consumers and target audience the services are targeted for.”

B. Applicant

The Applicant asserts that it has legitimate interests in the mark MUSIC by virtue of a trademark application that was published in Chile and adds that “Applicant and Complainant, then, both have legitimate rights in the mark MUSIC.”

The Applicant argues that it has legitimate interests in the top-level domain and that there has been no bad faith on the part of the Applicant, but that there has been bad faith on the part of the Complainant and requests the Panel to make a finding for reverse top-level domain name hijacking.

The Panel notes that the Amended Response filed by the Applicant is mistakenly based on the Uniform Domain Name Dispute Resolution Policy (“UDRP”) rather than the Procedure. In spite of this, for the purposes of evaluating the merits of this Objection the Panel will consider the Applicant’s statements and documents which are relevant to the Procedure and Module 3 of the gTLD Applicant Guidebook (“Guidebook”).

6. Discussion and Findings

To succeed in a legal rights objection pursuant to the Procedure, the Objector bears the burden of proof to demonstrate that the potential use of the applied-for gTLD by the Applicant (i) takes unfair advantage of the distinctive character or reputation of the Objector’s registered or unregistered trademark or 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.

Due to the similarities between this case and the <.song> and <.tunes> cases the Panel, to the extent that it finds them applicable to the case, will incorporate here significant elements of those determination's wordings.

The Objector's trademark .MUSIC is identical to the applied-for string gTLD <.music> (this identity is expressly acknowledged by Applicant in paragraph V(A)(2) of the Amended Response).

However, the word "music" is clearly generic and descriptive when used in relation to music and music-related goods or services, which is the intended use of the Applicant for the applied-for gTLD string in dispute <.music>.

The Applicant has indicated that the purpose of the <.music> TLD is to "[p]rovide a trusted TLD for musical artists, trade and union organizations, record labels, publishing companies, music distribution and marketing companies, DSPs, consumer brands, and music fans that will bring security, convenience, trust and efficiency to their music related activities," and further, to "enhance consumer's ability to discover and legitimately consume music[.]"

Should the trademark .MUSIC not have included the additional graphical elements shown above, it would likely not have been granted for anything related to music.

This means that while the Objector may have valid rights in the .MUSIC and DOTMUSIC trademarks, the Panel finds such rights are limited to the extent that they cannot be enforced in this proceeding to prevent the Applicant from using the word "music" for "music" or including it in a TLD which is to be used for the above-mentioned music-related activity.

Section 3.5.2 of the Guidebook sets out eight non-exclusive factors to be considered by the Panel. The Panel will address each of these factors below.

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

The gTLD <.music> and the Objector's trademark .MUSIC are phonetically identical. However, there are considerable differences between the registered mark as shown above and how it would be used as a string in a gTLD.

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

There is nothing in the case file that prevents the Panel from making a finding of good faith in the Objector's acquisition and use of rights in the .MUSIC mark.

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 a third party.

The Objector has produced evidence to show that his mark must be known and even perhaps well known in a relevant sector. Nevertheless, in the Panel's view, such recognition is not sufficient to accept that the descriptive term "music" has acquired a secondary meaning. Rather, it is the Panel's view that consumers of music and music-related activities on the Internet would more likely interpret the gTLD <.music> as a descriptive term and not necessarily associated with the Objector. The Applicant has not demonstrated any use or recognition of its asserted .MUSIC registration (discussed below) and none of the parties rely on third-party marks in their pleadings.

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.

Considering the generic and figurative aspects of the Objector's marks, for the purposes of this case the Panel attaches little importance to the fact of whether Applicant had knowledge of those marks. There is no allegation that the Applicant is engaged in a pattern of conduct of applying for TLDs which are identical or confusingly similar to marks of others.

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 the *bona fide* offering of goods or services or *bona fide* provision of information in a way that does not interfere with the legitimate exercise by the objector of its mark rights.

The Panel has no evidence that the Applicant has used or made demonstrable preparations to use the sign corresponding to the gTLD in connection with the *bona fide* offering of goods or services other than the reference made by Applicant to the intent to use it through its answer to Question 18: Mission and Purpose discussed above.

In this connection, the Applicant also refers to an application it has filed for the trademark MUSIC in Chile under Serial No. 1000890 for services falling in class 42, as shown in the copy of the relevant application added to the file which shows that the name of the applicant is "ENTERTAINMENT NAMES, INC." which coincides with the name of the Applicant. However, by checking the web page of the Chilean trade mark office Instituto Nacional de Propiedad Industrial ("INAPI"), the Panel notices that the application stands in the name of "TOP LEVEL DOMAIN HOLDINGS, LTD."

Nevertheless, given the generic nature of the gTLD the Panel does not consider this element relevant for 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 such acquisition of such 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 use.

Given that the Panel considers the gTLD to be generic and descriptive, there is no need for the Applicant to prove any intellectual property rights to successfully defend against the Objection. The Panel however notes the Applicant's asserted application for the trademark MUSIC in Chile but finds such application alone cannot form the basis for any Panel finding of intellectual property rights of the Applicant corresponding to the <.music> gTLD, for purposes of this proceeding.

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*.

From the evidence provided, the Applicant does not appear to have been commonly known by the sign .MUSIC or MUSIC. It has expressed the intention of creating a business under the gTLD.

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

The Applicant's stated intention is to use of the gTLD <.music> in connection with music-related activities. Such use of the word "music" would seem to be only for its dictionary meaning and therefore it is unlikely that it should be viewed by Internet users including music fans and others involved in music-related activities as

mark of the Objector.

Moreover, the Applicant has indicated that its policies and agreements are designed to include *inter alia* the protection of trademarks and intellectual property rights and will make sure that their mechanisms for enforcing rights and preventing abuse (such as their Complaint Resolution Service) operate effectively, efficiently and fairly.

In other words, given the generic nature of the sign, the Panel finds that there is little or no likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the gTLD. Should the Applicant use the disputed gTLD string in such a manner that it infringes the Objector's trademark rights, the Objector could then take the appropriate legal actions to defend such rights. However, in the Panel's view, this does not seem likely to occur, at least seen from this point in time.

Concluding, the Panel finds that the purported use of the applied for gTLD by the Applicant:

- (i) does not take unfair advantage of the distinctive character or the reputation of the Objector's marks,
- (ii) does not unjustifiably impair the distinctive character or the reputation of the Objector's marks, and
- (iii) does not otherwise create an impermissible likelihood of confusion between the applied-for gTLD and the Objector's marks.

Reverse TLD Name Hijacking

The Applicant claims that the Complainant has acted in bad faith and has requested the Panel to make a finding of Reverse TLD Domain Name Hijacking and "disallow Complainant's application for .music from proceeding."

To such effect, the Applicant has made the following contentions.

- (a) "Complainant is attempting to defraud the Panel by omitting pertinent evidence – evidence of Applicant's trademark for "music" – that was easily discoverable". However, as mentioned above, the trademark application "music" which the Applicant claims to have filed in Chile, as it appears in the data base of INAPI, is in the name of a third party (TOP LEVEL DOMAIN HOLDINGS, LTD), and
- (b) "Complainant has offered no evidence of likelihood of confusion because it knows that no such evidence exists and, further, that no such evidence *can* exist." Clearly, since there has been no use of the gTLD <.music> nor has the Applicant claimed to have made any use of the trademark "music" there is no possibility of producing evidence to prove the alleged confusion.

While the Panel would not have found on the evidence that a finding of Reverse Domain Name Hijacking or abuse of process would be called for under the UDRP standards (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition, paragraph 4.17), the Panel notes in any event no provision for such finding is available under the Procedure.

7. Decision

For the foregoing reasons, the Objection is rejected.

[signed]

Miguel B. O'Farrell

Sole Panel Expert

Date: August 15, 2013