

EXPERT DETERMINATION LEGAL RIGHTS OBJECTION

Scripps Networks Interactive, Inc. v. Dot Food, LLC

Case No. LRO2013-0020

1. The Parties

The Objector/Complainant is Scripps Networks Interactive, Inc., of Knoxville, Tennessee, United States of America, represented by Wolfe, Sadler, Breen, Morasch & Colby, LLC, of Cincinnati, Ohio, United States.

The Applicant/Respondent is Dot Food, LLC of Kansas City, Missouri, United States, represented by Kevin R. Sweeney of Polsinelli PC, Kansas City, Missouri, United States.

2. The applied-for gTLD string

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

3. Procedural History

The Legal Rights Objection (the "Objection") was filed by with the WIPO Arbitration and Mediation Center (the "WIPO Center") on March 13, 2013, pursuant to the New gTLD Dispute Resolution Procedure (the Procedure). In response to a notification of Objection Deficiency, the amended Objection was filed with the WIPO Center on March 20, 2013.

In accordance with Article 9 of the Procedure, the WIPO Center has completed the review of the amended Objection on March 21, 2013 and has determined that the amended Objection complies with the requirements of the Procedure and the World Intellectual Property Organization Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections (the WIPO Rules for New gTLD Dispute Resolution).

In accordance with Article 11(a) of the Procedure, the WIPO Center formally notified the Respondent of the Objection, and the proceedings commenced on April 16, 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 14, 2013.

On May 29 and 30, 2013, Objector submitted communications relating to consolidation of proceedings. On May 30, 2013, the Center advised the parties as follows: "pursuant to Articles 12 and 13 of the New gTLD Dispute Resolution Procedure and Paragraphs 7 and 8 of the WIPO Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections, the Center for its part sees no basis under the Procedure for making further requests relating to panel configuration and consolidation as such requests are out of the time provided."

The WIPO Center appointed Douglas M. Isenberg as the Panel in this matter on June 11, 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

In its Objection, Objector has provided the following relevant facts, among others, which are not in dispute:

- Objector is a publicly traded company in the United States which, “through its subsidiary or related entities Scripps Networks, LLC and Television Food Network, G.P.” owns a number of relevant FOOD trademarks, discussed below.
- Objector’s subsidiary Lifestyle Domain Holdings, LLC, has, like Applicant, filed an application for the gTLD <.food>.¹
- Objector’s “portfolio includes some of the most popular and famous media brands in the world, including Food Network, HGTV, Travel Channel, Cooking Channel and DIY Network.”
- “Objector has been operating its famous television network under the brands FOOD and FOOD NETWORK for twenty years, and its television programming is currently watched in over 150 countries around the world, including 24 hour networks in the U.S., Great Britain, Asia, India and Africa.”
- “Objector’s FOOD branded programming is enjoyed by almost 100 million television subscribers in the United States alone, and tens of millions more individuals throughout the world.”
- “Objector’s foodnetwork.com website averages over 225 million visitors each month, and Objector’s FOOD brand is the #1 brand relating to cooking and the culinary arts in social media with over 5 million collective fans and growing.”
- “Objector expends approximately \$30 million per year marketing its FOOD and FOOD NETWORK branded shows and products, and Objector’s programming is often the subject of considerable attention from other branches of media, including coverage in leading newspapers, magazines and radio and television talk shows.”
- “Scripps’ FOOD brand represents eight hundred million dollars (USD 800,000,000) in annual revenue.”
- “In addition to Objector’s famous television network, Objector has been operating a well-known website featuring recipes and information on cuisine and meal planning under the brand FOOD.COM since 2010.”
- Objector or a subsidiary is the owner of the following trademark registrations in the United States of America:

Mark	Reg. No.	Goods/services	Date of Reg.
FOOD	4,049,665	Entertainment services, namely, an on-going audio and visual program distributed over television, satellite, wireless, audio and video media, fiber optics, cable, and a global computer network in the fields of cooking and culinary arts, health, fitness, and nutrition	November 1, 2011
FOOD & Design	3,658,544	Providing information via a global computer information network in the fields of cooking and culinary arts	July 21, 2009
FOOD & Design	3,658,543	Entertainment services in the nature of	July 21, 2009

¹ Although not stated in the Objection, the Panel notes that Lifestyle Domain Holdings, LLC, also has applied for the gTLD <.foodnetwork> (Application ID 1-1326-10877), as well as a number of other strings.

		ongoing television programs in the field of cooking and culinary arts, health, fitness and nutrition; production and distribution of television programs	
FOOD & Design	3,658,542	Cable television broadcasting services	July 21, 2009
FOOD.COM & Design	4,106,214	Providing information via a global computer information network in the fields of cooking and culinary arts	February 28, 2012

- In addition to the above-listed trademark registrations, Objector also owns trademark registrations in “seventy-five or more countries” for marks that include the word FOOD (many of which include the words FOOD NETWORK or FOOD NETWORK & Design).

In its Response, Applicant has provided the following relevant facts, among others, which are not in dispute:

- “Horizon Hospitality Associates, Inc. along with its Founder and CEO, Scott Samuels, will direct Dot Food, LLC’s strategic initiatives and brand development.”
- “Over the past decade, Horizon Hospitality has developed partnerships with hundreds of prominent food-related companies including: Disneyland, Landry’s Restaurants, Hyatt Hotel Corporation, Aramark, Dean & DeLuca, Panera Bread and Applebee’s International.”
- “Dot Food, LLC actively manages the Dotfood.biz website which informs consumers about the marketing benefits of choosing a ‘.food’ extension for their business, SEO advantages, and of course the type of information that can be located on a .food site.”

In its Application, Applicant has described the mission/purpose of the proposed <.food> gTLD as follows:

“To provide a consistent, identifiable online industry marker for food related businesses, in order to better serve the ever growing Food Industry and consumer needs worldwide.

The purpose of “.FOOD” is to provide a commerce environment and information exchange platform for the food industry allowing businesses to create user friendly access to products and services instantaneously through accurate search engine classifications.

“.FOOD” will serve to unite all aspects of life and business associated with 'food' and create a marketing catapult to propel food related industries into the next wave of internet expansion. It is our mission that businesses bearing the “.FOOD” gTLD string would become leaders in their market and be instantly differentiated online as food producers, providers, or service professionals.”

Elsewhere in its Application, Applicant stated:

“On average, there are over 100 million searches a month for the words “food” online, which result in a monthly volume of page views totaling well over 700 billion clicks. The opportunity to enhance the consumer experience while driving competition in our market is paramount and we are excited to be apart [sic] of this evolution....

Our areas of specialty will be extremely widespread, including, but not limited to food manufacturers, food suppliers, food producers, retail food service operators, culinary institutes, restaurant operators, catering providers, food publications and food television networks. Consumers can be confident that domains bearing the “.FOOD “ gTLD will provide them with industry specific information, up to date restaurant listings, recipes, and access to leaders in this market.”

5. Parties' Contentions

A. Complainant

In its Objection, Objector contends that the Objection should be upheld because:

The potential use of the applied-for gTLD by the Applicant/Respondent

(i) takes unfair advantage of the distinctive character or the reputation of the Objector's registered or unregistered trademark or service mark ("mark"), 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 mark and/or

(iv) harms Internet users by misleading them into believing that the .food gTLD is related to the famous brand FOOD as evidenced by the long-standing global use in commerce of that mark and related registrations marks in more than seventy-five jurisdictions around the globe.

In support of the foregoing, Objector contends, in relevant part, as follows:

1. "The applied-for gTLD is identical and similar, including in appearance, phonetic sound, and meaning, to the Objector's existing mark and marks."
2. "Objector's acquisition and use of rights in the FOOD mark(s) has been *bona fide* as evidenced by the fact that those marks have been registered in more than seventy-five jurisdictions, in many instances for more than ten years, in identifiable and legitimate classes of goods and services that have consistently been associated with the FOOD brand including, but not limited to, television broadcasting and entertainment services, online entertainment and information services, sweepstakes and contests, and other related goods and services."
3. "If the .FOOD gTLD were to be available to Respondent to resell second string domains to the general public on an unrestricted basis (as stated in its application), it would irreparably damage the goodwill associated with Objector's FOOD and FOOD variant brands and the products and services provided by Objector by eroding consumer confidence in the brand as an authoritative source of information, programming, content and advice, and would ultimately confuse and mislead consumers into believing that the content, information and/or products in the .FOOD top level domain is provided by Objector."
4. "Respondent knew or should have known of Objector's trademark rights in and to the FOOD and FOOD-variant marks at the time of filing its application or could have reasonably been aware of that mark, given that those marks are registered in multiple jurisdictions around the world and have become famous through widespread use and promotion for well over 10 years."
5. "To date, other than the statements in its application, Respondent has made no discernible effort or preparation to use the sign at all let alone in a *bona fide* way that will not undermine Objector's rights in the mark."
6. "Objector's trademark rights are within the field of operating a web site, computer network, content and information. Therefore, use of .FOOD by Respondent as a top level domain would inherently infringe upon Objector's exact class of goods and services for which trademark protection has been granted."
7. "FOOD is commonly known by consumers as the famous FOOD brand as a source indicator to Scripps Networks high quality programming and content. In addition to the viewership and social media metrics already cited, as further evidence of the consumer connection between the FOOD

marks and Objector, it is telling that the first organic search result from popular web searches for 'food' is Objector's website."

8. "Respondent's intended use of the top level domain is to resell second string domains in the open marketplace and become an authoritative online resource for content related to cuisine and the culinary arts. In addition to the fact that such activity would irreparably damage the famous FOOD brand, there is a significant likelihood that such activity would unlawfully trade upon the fame and goodwill of Objector's marks."
9. "If Respondent is permitted to proceed with its gTLD application as an open system to resell second string domains in the .FOOD top level domain, the millions of consumers with known source identification to FOOD will be confused and potentially harmed."

B. Respondent

In its Response, Applicant contends that the Objection should be denied because:

The potential use of the applied-for gTLD by the Applicant/Respondent does not

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

(ii) unjustifiably impair the distinctive character or the reputation of the Objector's mark...;

(iii) otherwise create an impermissible likelihood of confusion between the [<.food>] applied-for gTLD and the Objector's mark.

In support of the foregoing, Objector contends, in relevant part, as follows, in response to each of the points raised in the Objection set forth numerically above:

1. "The applied for gTLD .food is not identical to the all of the marks claimed to be owned and referred to by the Objector," given that many of the marks are "used in combination with design elements, or other marks combining 'FOOD' with other words and designs." Further, "Respondent believes that the term 'FOOD' or 'FOOD.COM' is inherently generic under US trademark law (and foreign equivalents) and should not be afforded protection through the TLD application and objection process."
2. "Respondent is aware that at least one of the United States Trademark applications for FOOD cited by Objector as a basis for its objection to Respondent's .food TLD application – U.S. App. Ser. No. 77/690,148 – was filed on an intent-to-use basis under Section 1(b) and abandoned as of October 17, 2012, well in advance of Objector's filing of the Objection. See *Annex 4*. Objector also cites numerous examples of the use of FOOD as a mark (e.g., U.S. Registration 3,658,542 for FOOD, U.S. Registration 3,658,544 for FOOD, and U.S. Registration 3,658,543 for FOOD) without properly indicating in the Objection that the word 'food' is used in connection with design elements, namely a shaded circle, and that such registrations were granted on a Section 2(f) basis indicating an acknowledgement that the original mark is descriptive and not capable of registration without further evidence of use in commerce over a period of time. Respondent believes this may be evidence [of] bad faith on the part of Objector in suggesting that Objector's claim of trademark rights in the term 'FOOD' is greater than might otherwise be believed. Additionally, it is important to note that the two other most relevant United States trademark registrations (U.S. Reg. No. 4,049,665 for 'FOOD'; U.S. Reg. No. 4,106,214 for 'FOOD.COM') were each filed and registered under Section 2(f), indicating that the Objector acknowledges that each trademark is not inherently distinctive and were in fact descriptive, but rather were only capable of registration due to a claim that each mark was used in commerce for a sufficient period of time to qualify for federal registration."

3. "It is reasonable to assume (though the Respondent is not specifically aware of any studies or demographics associated to this assumption) that a sizable portion of basic cable television viewers interested in 'life style' programming are familiar with the Food Network, its affiliated websites, as well as other entertainment properties owned and managed by Scripps Networks. Nevertheless, throughout the world, the English word 'food', as a noun, is associated to products consumed to provide nourishment necessary to maintain physical health and ongoing existence. The term 'food' may also be associated with the processes, equipment, infrastructure, and social aspects of goods and services associated with the consumption of nutrients to be converted to energy. The reach of the term 'food' simply cannot be confined to discussions only related to the Food Network or its affiliated websites, magazines and products or those websites deemed appropriate by Objector and its properties. To place restrictions on the usage of such a common and necessary word, would alienate a diverse a substantial and thriving industry of production, retail, and consumption."
4. "The Respondent was unaware of the Objector's trademarks prior to receiving notification of the Objection... Additionally, a review of US federal trademark registrations and pending applications containing the noun 'food' (alone or in combination with other words) and any owner other than [Objector] in the USPTO Trademark Electronic Search System of the United States Patent and Trademark Office shows more than 10,000 active records... While the Objector represents a vast and successful food related business, it is only a small segment of the total industry associated to 'food' globally. Processed food sales worldwide are approximately \$3.2 trillion. According to Plunkett Research, LTD: US consumers spend approximately \$1 trillion annually on food. This represents nearly 10 percent of the Gross Domestic Product (GDP). The US Food Industry consists of nearly 100,000 grocery stores and supermarkets; generating nearly \$500 million in food sales annually, 960,000 US restaurants and dining establishments; generating \$604 billion, and employs over 16.5 million people, with approximately 900,000 of those working within restaurants."
5. Applicant registered as a limited liability company in Kansas on January 23, 2012, and has stated in its Application that it "will not interfere with the legitimate exercise of any trademark rights." Accordingly, Applicant "has taken all appropriate steps to indicate its intended use of the .FOOD TLD per its Application and, through the use of "www.dotfood.biz", has clearly indicated its intention to respect third party trademark rights."
6. "Respondent respectfully disagrees that Objector has sole and exclusive rights to the term 'FOOD' or 'FOOD.COM' such that no third party use is permitted as a trademark."
7. With respect to Objector's contentions set forth above under item #7, Applicant refers to its "response in Section #5 above in response to this point."
8. "The Respondent in no way implies any affiliation to the Objector's 'fame or goodwill' nor does it plan to capitalize on the Food Network's brand image. There is nothing confusing about the use of the word food in affiliation to the Food Industry, nor is it reasonable to assume that a consumer would confuse a domain such as www.berriesproduce.food with the food network or any of its conglomerate entities." Further, "Respondent has taken care to ensure that Registrants of the '.FOOD' gTLD will not be allowed to register names that infringe on the legal rights of individuals or companies and plans to participate in all trademark protection procedures implemented through ICANN's Registry Agreement."
9. With respect to Objector's contentions set forth above under item #9, Applicant refers to its "response to Section #2 above in response to this Section #9."

6. Discussion and Findings

A. Status of Legal Rights Objection Proceedings

As an initial matter, the Panel notes the unprecedented nature of this proceeding. That is, the Objection filed by Objector that has led to this decision was among the first such objections ever filed, given the new gTLD program that resulted in ICANN revealing 1,930 applications in June 2012.

As a result, as of the date on which this decision is being written, only a handful of decisions under the applicable Legal Rights Objection section of the Procedure have been published. Of those, the Panel finds the following overview informative:

“ICANN has created a framework for the establishment of a set of new domain name registries identified by newly-established gTLDs. Like the existing gTLDs, these new gTLDs will be comprised of “strings”. Many of these strings will represent words in some language. These words may in some cases be identical from a visual and auditory standpoint to words adopted and functioning as trademarks. String-similarity or identicalness between applied-for gTLDs and common dictionary or generic terms was certainly foreseeable – it was, as a practical matter, inevitable. That being the case, ICANN might have prescribed a rule that common dictionary or generic terms are automatically entitled to serve as gTLDs notwithstanding the presence of an identical trademark term, and that any misuse of the trademark term by a third party with a second-level domain needs to be addressed in ex post dispute settlement proceedings. Alternatively, ICANN could have decided that a trademark owner with rights in a common dictionary or generic term (e.g., based on arbitrary usage) was automatically entitled to block third-party adoption of the common term as a gTLD, placing a strong premium on brand protection, with trademark ownership trumping common dictionary or generic usage. ICANN chose neither of these categorical options, instead placing assessments of disputes between owners of trademarks making use of common dictionary or generic terms and new gTLD applicants asserting legitimate interests in use of those terms in the hands of panels such as this one.

The relative interests of trademark owners and prospective users of common terms may be sufficiently nuanced or context-sensitive that automatic or general rules would constantly be in search of exceptions, or that such rules would lead to unintended consequences. Whatever might have motivated ICANN’s approach, it puts this Panel where it is now – with this Panel charged with deciding whether a trademark owner of a common dictionary or generic term used in an arbitrary way should be permitted to prevent an applicant for a new gTLD to secure that common term.”

Express, LLC v. Sea Sunset, LLC, WIPO Case No. LRO2013-0022.

B. Standing

Pursuant to subsection 3.2.2.2 of the Procedure, a “rightsholder” has standing to file a legal rights objection. “The source and documentation of the existing legal rights the objector is claiming (which may include either registered or unregistered trademarks) are infringed by the applied-for gTLD must be included in the filing.”

Here, as set forth above, Objector has included in the Objection references to a number of trademark registrations that consist of or include the word “FOOD,” which marks are alleged or appear to be owned by Objector or a subsidiary and which Objector effectively claims are infringed by the applied-for gTLD <.food>. The Panel has identified no reason to question Objector’s standing, nor has Applicant disputed this requirement. Accordingly, the Panel finds that Objector has satisfied the standing requirement for this proceeding.

C. Dispute Resolution Principles

Pursuant to subsection 3.5.2 of the Procedure, this Panel must “determine whether the potential use of the

applied-for gTLD by the applicant takes unfair advantage of the distinctive character or the reputation of the objector's registered or unregistered trademark or service mark... or unjustifiably impairs the distinctive character or the reputation of the objector's mark... or otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector's mark...." In making this determination, the Procedure requires this Panel to "consider the following non-exclusive factors:"

1. Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound, or meaning, to the objector's existing mark.
2. Whether the objector's acquisition and use of rights in the mark has been *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.
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.
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.
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.
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*.
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.

Accordingly, the Panel now proceeds to consider each of these factors in turn.

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

As set forth above, Objector has provided information about and evidence supporting its ownership of numerous trademark registrations worldwide that consist of or contain the word "FOOD", including the U.S. registrations listed above.

The Panel agrees with Applicant that Objector may have overstated the scope of its trademark rights because, for example, many of the listed registrations contain a design element and/or words in addition to the word "FOOD." Nevertheless, it is apparent that Applicant has at least one valid trademark registration for (only) the word FOOD, that is, U.S. Reg. No. 4,049,665.

Accordingly, it is apparent that the applied-for gTLD <.food> is identical to a mark owned by Objector; therefore, this factor favors Objector.

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

As set forth above, Objector contends that it has used the FOOD mark (whether alone, as part of a design or in association with other words) in connection with various services in more than 75 jurisdictions, in some instances more than 10 years. At the least, it has used U.S Reg. No. 4,049,665 for the word mark FOOD in connection with certain entertainment services since, according to the registration, at least January 2, 2003. Further, Applicant has stated that it operates a popular television network and website using the "FOOD" mark, and that it expends \$30 million annually marketing its FOOD and FOOD NETWORK shows and products.

Although Applicant has argued that the word "FOOD" is in many cases generic, it is not appropriate for this Panel to question the legitimacy of a federally granted trademark registration. Further, Applicant has not disputed Objector's facts as to how it has used the FOOD mark.

Accordingly, it is apparent that Objector's acquisition and use of rights in the FOOD mark has been *bona fide*; therefore, this factor favors Objector.

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.

As set forth above, Objector states that its Food Network television network is watched in more than 150 countries with more than 100 million television subscribers globally, that it spends approximately \$30 million a year marketing its FOOD and FOOD NETWORK branded shows and products, and that its FOOD and FOOD NETWORK brands represent more than \$800 million in annual revenue. These statements are supported in the Objection by an affidavit from Lori Hickok, executive vice president of Scripps Network Interactive, Inc. Ms. Hickok's affidavit further states that Objector averages more than 225 million visitors every month to its foodnetwork.com website.

Although impressive, the figures cited above do not provide any indication as to the recognition in the relevant sector of the public of the FOOD mark, such as survey evidence. Further, other statements in the Objection regarding this issue are unsupported by an affidavit or any other evidence; for example, the Objection contains an unsupported assertion that "FOOD is commonly known by consumers as the famous FOOD brand as a source indicator to Scripps Networks high quality programming and content."

As to the extent of any recognition of the FOOD mark as the mark of the Applicant, the Response states only that Applicant was created as a limited liability company only on January 23, 2012, and that it operates a website at "www.dotfood.biz", using a domain name that this Panel has identified was created on the same date. Thus, the record contains no relevant information as to whether the FOOD mark is recognized as a mark of Applicant.

Accordingly, although the Panel does not question whether Objector has widely used the FOOD mark, the record contains no evidence as to the extent to which there is recognition in the relevant sector of the public of the FOOD mark as the mark of the Objector or of the Applicant (or of a third party); therefore, this factor favors neither Objector nor Applicant.

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.

As set forth in its Response, Applicant has said that its mission is to "provide a credible and easily identifiable online industry market for food related businesses, does not in any way unjustifiably infringe on or damage the reputation of the FOOD trademark held by the Objector. The Respondent's application intends

to serve the food industry as a whole – particularly as an open registry – and more fully meet the needs of Internet users throughout the world, not merely those businesses associated with or that will inure benefit from the Objector’s conglomerate.” This is consistent with the Application itself, in which Applicant stated that its mission is to “provide a consistent, identifiable online industry marker for food related businesses, in order to better serve the ever growing Food Industry and consumer needs worldwide.”

As stated above, Applicant has said in its Response that it “was unaware of the Objector’s trademarks prior to receiving notification of the Objection.” Given also the widespread use of the FOOD and FOOD NETWORK marks by Objector, the Panel questions this statement but finds no conclusive information in the record, which is limited to an Objection and a Response.

The record contains no evidence as to “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.”

In the Panel’s view, this factor on balance favors Applicant.

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.

As set forth above, Applicant was created as a limited liability company only on January 23, 2012, the same date on which it apparently registered the domain name <dotfood.biz>, which it uses in connection with a website regarding the proposed <.food> gTLD. However, these actions alone do not necessarily provide Applicant with any rights in the mark FOOD, and Applicant has not asserted that it has any such rights.

Despite Applicant’s lack of rights in the mark FOOD, Applicant clearly has made preparations to use the <.food> gTLD. For example, the Panel has observed that Applicant’s website at “www.dotfood.biz” provides information about the <.food> gTLD and even includes a link to a website at “www.fooddomainia.com”, apparently operated by Applicant, offering “pre-registration” of <.food> domain names. The Panel observes that such “pre-registrations” are apparently without charge on Applicant’s website, which is appropriate given that it is obviously unclear whether Applicant ultimately will be approved by ICANN to operate the <.food> gTLD. Therefore, such pre-registrations are actually premature. Whether Applicant has properly disclosed the <.food> status on its website is unclear given that, among other things, the Panel was unable to successfully click on a link labeled “Terms and Conditions” on Applicant’s website. In any event, should Applicant’s Application be approved by ICANN, its websites offering information about the <.food> gTLD are evidence of its demonstrable preparations to use the sign corresponding to the gTLD in connection with a *bona fide* offering of goods or services.

As to the impact of Applicant’s actions on Objector’s rights in the FOOD mark, the Panel finds that, as discussed in detail below, use of the applied-for <.food> gTLD in connection with services related to the food industry, as proposed by the Applicant, does not in and of itself interfere with the legitimate exercise by the Objector of its rights in the FOOD mark.

Accordingly, this factor favors Applicant.

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.

As set forth above, Applicant has not asserted that it has any intellectual property rights in the mark FOOD. Accordingly, this factor favors Objector.

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 record contains no evidence that the Applicant has been commonly known by the FOOD mark. Accordingly, this factor favors Objector.

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.

As set forth above, Applicant has stated in its Response that its mission is to "provide a credible and easily identifiable online industry market for food related businesses, does not in any way unjustifiably infringe on or damage the reputation of the FOOD trademark held by the Objector. The Respondent's application intends to serve the food industry as a whole – particularly as an open registry – and more fully meet the needs of Internet users throughout the world, not merely those businesses associated with or that will inure benefit from the Objector's conglomerate." This is consistent with the Application itself, in which Applicant stated that its mission is to "provide a consistent, identifiable online industry marker for food related businesses, in order to better serve the ever growing Food Industry and consumer needs worldwide."

The Application contains no indication that Applicant intends to use the <.food> gTLD in a way that would indicate any association with Objector or Objector's FOOD mark. To the contrary, the Application contains commitments that Applicant will seek to avoid any such likelihood of confusion by, among other things, "implement[ing] a series of Rights Protection Mechanisms (RPM) included, but not limited to: Support for and interaction with the Trademark Clearinghouse ('Clearinghouse'), use of the Trademark Claims Service, segmented Sunrise Periods allowing for the owners of trademarks listed in the Clearinghouse to register domain names that consist of an identical match of their listed trademarks, subsequent Sunrise Periods to give trademark owners or Registrants that own the rights to a particular name the ability to block the use of such name, stringent take-down services and Uniform Dispute Resolution Policies."

These commitments are further made clear in Applicant's Response, where, for example, Applicant has stated that it "in no way implies any affiliation to the Objector's 'fame or goodwill' nor does it plan to capitalize on the Food Network's brand image."

Objector obviously disagrees with Applicant, arguing notably that Applicant's sale of second-level domains within the <.food> gTLD "would irreparably damage the famous FOOD brand" because "there is a significant likelihood that such activity would unlawfully trade upon the fame and goodwill of Objector's marks." Further, Objector's position is that, "[s]hould Respondent operate .FOOD as an open system, consumers will be confused and misled into believing that second string domains on the top level domain .FOOD are somehow related or connected to the famous FOOD brand. They will be damaged when they trust content that is not of the same quality that Objector."

Objector's arguments are unsupported by reference to any authority and, therefore, are at best speculative. Moreover, Objector's concerns, although understandable, should to an extent be met by Applicant's stated intentions, that is, that Applicant does not intend to capitalize on Objector's FOOD mark and that it will take action, whether required by ICANN or otherwise, that will help avoid a likelihood of confusion. Of course, to the extent that registration and use of a particular second-level domain within the <.food> gTLD actually creates a likelihood of confusion, then Objector will have remedies available to it, including the established Uniform Domain Name Dispute Resolution Policy, the forthcoming Uniform Rapid Suspension System and relevant laws. The fact that such disputes at the second level may arise is inherent in ICANN's new gTLD program and is not in the circumstances of this case sufficient to uphold the present legal rights objection.

Objector's rights in the FOOD mark do not confer upon it the exclusive right to use of the word "food" in all circumstances, particularly where, as here, Applicant intends to use the <.food> gTLD in connection with the

food industry. Such intended use of the word would appear to be only for its dictionary meaning and not because of Objector's trademark rights. In other words, use of the word "food" as a gTLD in connection with food is a generic usage of the term that cannot, by itself, create a likelihood of confusion. As another panel wrote, in denying an objection for the applied-for gTLD <.express>, although the "trademark is reasonably well known among a relevant segment of consumers in the United States, there are so many common usages of the term 'express' that it is not reasonable to foreclose its use by Respondent as a gTLD." *Express, LLC v. Sea Sunset, LLC*, WIPO Case No. LRO2013-0022.

Similar conclusions have been reached in all of the similar legal rights objection proceedings for which decisions have been published as of the date of this writing. See, e.g., *Limited Stores, LLC v. Big Fest LLC*, WIPO Case No. LRO2013-0049 ("Objector's commercial activity is largely confined to the sale of women's clothing and accessories at retail stores in the United States and via the Internet. Outside of that field of activity, there are myriad legitimate third-party uses of the term 'limited' which cause no confusion with Objector's THE LIMITED mark."); *United States Postal Service v. Amazon EU S.à.r.l.*, WIPO Case No. LRO2013-0044 ("a trademark owner that incorporates a generic term into its trademark must bear the risk of confusion resulting from the use of the term in its generic sense, even by potential competitors") (rejecting objection for <.mail>); and *Defender Security Company v. Charleston Road Registry Inc.*, WIPO Case No. LRO2013-0032 ("Respondent's intended use of the new gTLD <.home> would not create a likelihood of confusion with Objector's asserted mark as to the source, sponsorship, affiliation, or endorsement of the gTLD, since Respondent intends to use the sign corresponding to the New gTLD in its generic sense").

Accordingly, this factor favors Applicant.

7. Decision

In evaluating the eight factors listed above, the Panel notes that four of them favor Objector, three of them favor Applicant, and one of them favors neither Objector nor Applicant. However, the Procedure does not require that a Panel give equal weight to each factor; rather, the Procedure only requires that a Panel "consider" these factors. In so doing, this Panel gives the greatest weight to the eighth factor because, in the absence of an intention to create a likelihood of confusion in the case of a word to be used in its generic sense, this Panel considers it impossible to find that such a word as a gTLD would take unfair advantage of a trademark, unjustifiably impair the distinctive character or reputation of a trademark or, obviously, create an impermissible likelihood of confusion.

For the reasons set forth above, the Panel rejects the Objection.

[signed]

Douglas M. Isenberg

Sole Panel Expert

Date: July 24, 2013