

## **EXPERT DETERMINATION LEGAL RIGHTS OBJECTION**

Starbucks (HK) Limited v. Amazon EU S.à.r.l.

Case No. LRO2013-0027

### **1. The Parties**

The Objector/Complainant (“Objector”) is Starbucks (HK) Limited of Hong Kong, China, represented by Dechert LLP of the United Kingdom of Great Britain and Northern Ireland.

The Applicant/Respondent (“Applicant”) is Amazon EU S.à.r.l. of Luxembourg, represented by Covington & Burling LLP of the United States of America (USA).

### **2. The applied-for gTLD string**

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

### **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 21, 2013 and determined that the Objection complies with the requirements of the Procedure and the World Intellectual Property Organization Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections (the “WIPO Rules for New gTLD Dispute Resolution”).

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 17, 2013. In accordance with Article 11(b) and relevant communication provisions of the Procedure, the Response was timely filed with the WIPO Center on March 15, 2013.

The WIPO Center appointed Warwick Rothnie as the Panel in this matter on June 17, 2013. 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. The Panel finds that it was properly constituted.

On July 26, 2013, the WIPO Center notified the parties that the deadline for rendering the Panel’s expert determination had been extended by 14 days pursuant to Article 21(a) of the Procedure.

## 4. Factual Background

### A. The Objector

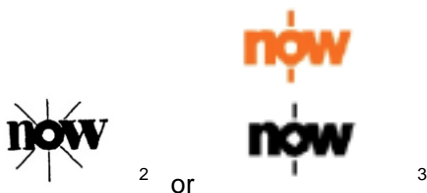
The Objector is based in Hong Kong and is a wholly owned subsidiary of PCCW Limited. Its function within the PCCW group is to hold assets including the group's registered trade marks and other rights. The PCCW group provides, amongst other things, television and media services to subscribers in Hong Kong and, according to the Objection, a number of other jurisdictions including Malaysia, China, Canada, the United Kingdom (UK) and on international air carriers. For present purposes, it is sufficient to refer to the Objector and the other members of the group just as PCCW.

According to the Objection, PCCW launched an IPTV (internet protocol television) network in Hong Kong in 2003 under the name Now Broadband TV. It says that its service, currently known as Now TV, provides over 190 channels of programming in Hong Kong including channels with names such as Now Sports and Now News. It is one of the largest pay TV operator in Hong Kong with apparently more than 1,165,000 subscribers or more than 50% of the households in Hong Kong. In 2007, PCCW was considered in one industry survey to be the most successful IPTV operator in the world. In 2009, another international media analyst considered PCCW's Hong Kong operation was the eighth largest IPTV operation in the world in terms of the number of subscribers. The Now TV platform is also accessible to subscribers through websites at "www.now.com" and "www.now-tv.com". PCCW's service, either under the name Now Broadband TV or Now TV, has been the subject of an Harvard Business School case study in 2008, a full page article in *Time* magazine in 2005 and other media reports. It has been the subject of at least eight international industry awards. PCCW executives have also made frequent presentations about Now TV to industry conferences in Asia, the UK and on at least one occasion in Chicago in the USA.

Although the figures are presented somewhat confusingly, the Panel understands them to demonstrate that PCCW's revenues from Now TV in Hong Kong are at least in terms of hundreds of millions of US dollars each year and advertising expenditures between 2006 and 2012 have ranged from USD 4 million to USD 12 million.

The Objector has provided a list of some 112 trade marks it owns around the world. Excluding pending applications,<sup>1</sup> 86 are registered trade marks in various countries or jurisdictions around the world. Forty-five of these are registered in Hong Kong. The registrations typically cover a wide range of goods or services in International Classes 9, 38 and 41 and in most cases also classes 35 and 42.

None of the registrations are for the word NOW alone. Except in four cases, the registrations outside Hong Kong all include the word NOW with device elements. Of these, the simplest or least adorned take the form:



In China, the Objector also has registrations for NOW BROADBAND TV as a plain word mark, registration numbers 4790565 to 4790573.

<sup>1</sup> *Pinterest Inc. v. Amazon EU S.à.r.l.*, WIPO Case No. LRO2013-0050.

<sup>2</sup> For example, the registered trade marks in China No. 1455984 and 1505733 and in Kuwait No. 37833 in class 38.

<sup>3</sup> This trade mark is also registered in Hong Kong as Trade Mark No. 300391266.

In three cases, Bahrain, Saudi Arabia and Singapore,<sup>4</sup> there is a registered trade mark for:



The registered trade marks in Hong Kong do not include the representations in the first or last trade marks identified above. They do include, however, registrations for NOW in plain type with other words, such as: NOW BBTV, NOW FAMILY, NOW GAMES, NOW KIDS, NOW TV and NOWTV.COM. Amongst the various logos and devices registered is also registered trade mark No. 300608607 for a series mark in the second form set out above, with the letters TV in a circle underneath and to the side of the “w”.

## B. The Applicant

According to the Response, the ultimate parent of the Applicant is Amazon.com Inc. The subject gTLD string is not the only new gTLD that the Applicant has applied for.

According to its application for the <.now> new gTLD:

“The mission of the .NOW registry is:

To provide a unique and dedicated platform for Amazon while simultaneously protecting the integrity of its brand and reputation.

A .NOW registry will:

- Provide Amazon with additional controls over its technical architecture, offering a stable and secure foundation for online communication and interaction.
- Provide Amazon a further platform for innovation.
- Enable Amazon to protect its intellectual property rights.”

It is not immediately clear from this description what the Applicant intends to use the proposed gTLD for or how.

Also according to its application, second-level domains in a <.now> gTLD (if the Applicant is authorized to operate the gTLD) will need to comply with the Uniform Dispute Resolution Policy (“UDRP”) as well as other rights protection mechanisms.

## 5. Discussion and Findings

An objection to a new gTLD may be made on one of the four grounds set out in Section 3.2.1 of Module 3 to the ICANN Applicant Guidebook (version 2012-06-04) (the “Guidebook”).

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<sup>4</sup> The registration in Singapore does not include the bottom two representations.

The present Objection is brought on the basis of one of those grounds, a Legal Rights Objection:

“The applied-for gTLD string infringes the existing legal rights of the objector. (Section 3.2.1 of the Guidebook)”

According to Section 3.5.2 of the Guidebook:

“Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law.”

Section 3.5.2 of the Guidebook further prescribes that an objection on this basis must establish that:

- (i) 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 (“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.

Accordingly, there are two steps in the inquiry. First, it is necessary to identify the legal rights of the Objector that are said to be infringed. The rights may be registered or unregistered. Secondly, an assessment must be made whether the applied-for gTLD takes “unfair advantage of” or “unjustifiably impairs” or “otherwise creates an impermissible likelihood of confusion [with]” the Objector’s rights.

In determining the second stage of the inquiry, Section 3.5.2 sets out eight factors which must be taken into consideration. These are set out below. While they must be taken into account, they are not an exclusive listing of considerations. Moreover, the analysis is not a simple accounting exercise of counting up which party wins the most factors. Rather, it is a qualitative exercise requiring the force and effect of each to be weighed and the cumulative effect of all, and any other relevant considerations, to be assessed in the circumstances of the case.

As the learned panelist in *Right at Home v. Johnson Shareholdings Inc.*, WIPO Case No. LRO2013-0030 explained:

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

The foregoing concepts are not uniformly defined or understood in the international trademark community. Indeed, the word ‘unfair’ in the context of ‘unfair competition’ is a notoriously elusive concept. An excellent and colorful discussion of the quicksilver quality of that term may be found in McCarthy’s treatise, wherein it is observed: “The word ‘unfair’ is no more precise than many other legal terms whose purpose is to give discretion to a judge, such as ‘reasonable’ or ‘adequate.’” J Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* 4th (Thomson Reuters/West) section 1:8.

To aid interpretation of this general concept, the Procedure sets forth eight non-exclusive factors which should be considered by the Panel when applying the Section 3.5.2 standards to the facts of this case. These factors may be viewed collectively as analytical proxies for the more general

concepts discussed above. The Panel underlines that as these 8 factors are stated to be nonexclusive, it thereby leaves room for the interpretation of this general concept. It also bears noting that the relevant importance of each factor is not fixed in advance of the Panel's inquiry; rather, depending on the facts and circumstances of each case, some factors may prove more significant than others. Deciding a case under the LRO Procedure is not simply a matter of tallying the factors (e.g. 5-3) and declaring the winner on that basis."

Other panelists have adopted and applied that approach.<sup>5</sup>

#### **A. The Objector's legal rights**

PCCW has established ownership of a number of registered trade marks in many parts of the world which include NOW. With the exception of the three trade marks registered in Bahrain, Saudi Arabia and Singapore referred to above, however, none is for NOW *simpliciter* alone.

PCCW also contends for a strong common law reputation or unregistered rights arising from use in NOW. The matters set out in section 4 above satisfy the Panel that PCCW has a strong reputation in NOW TV and a wide range of its channels such as NOW SPORTS and NOW FAMILY (to mention just two). The Objection refers to use in a number of territories other than Hong Kong, however the evidence in the Objection falls short of substantiating that claim at least insofar as places other than Hong Kong are concerned. Indeed, paragraph 10(i) of the Objection makes specific claim to common law rights in NOW as a trade mark only in "*inter alia*, Hong Kong".

#### **B. Section 3.5.2 of the Guidebook**

On the second part of the inquiry, Section 3.5.2 of the Guidebook requires consideration be given to the eight specified 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.**

PCCW contends that the applied-for gTLD string is identical to its NOW trade mark or confusingly similar to its registered trade mark.

The Applicant contends, however, that PCCW has not proved ownership of a trade mark for NOW *simpliciter*. While accepting that the applied-for gTLD string is identical in sound and appearance to the NOW component of PCCW's trade marks, the Applicant contends that it is nonetheless not confusingly similar.

In this connection, it relies on both the nature of the word "now" and also what it says are the very different nature of the parties' respective services. The Applicant points out that the word "now" is a common English word. It is also an acronym used by a number of different entities for a wide range of different activities. As to the second point, the Applicant cites the proposition:

"That the goods or services of the parties are both found on the Internet proves little, if anything, about the likelihood that consumers will confuse similar marks used on such goods or services."<sup>6</sup>

The Applicant's arguments more properly fall under factor 8 discussed below rather than this first factor. Given the inclusion of factor 8 (discussed below), it is appropriate to undertake a simple comparison

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<sup>5</sup> For example, *The Canadian Real Estate Association v. Afilias Limited*, WIPO Case No. LRO2013-0008 and *Pinterest, Inc. v. Amazon EU S.à.r.l.*, WIPO Case No. LRO2013-0050.

<sup>6</sup> Citing 4 *McCarthy on Trademarks and Unfair Competition* §24:53.50 and *Network Automation Inc. v Adv. Suys. Concepts Inc.* 638 F 3d 1137, 1151 (9<sup>th</sup> Cir 2011).

between the alpha-numeric string in the applied-for gTLD and the sign that comprises the Objector's trade mark under this first factor.

While the Applicant quite rightly points out that PCCW does not have a registered trade mark specifically for NOW *simpliciter*, the applied-for gTLD string looks and sounds exactly the same as the, or a significant part of the, verbal element of many of PCCW's trade marks. Accordingly, this factor falls in favour of the Objector.

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

In line with the recitation of the history of PCCW's Now TV business outlined above, there can be no doubt that the Objector has acquired its rights in its various trade marks in good faith. There is therefore no reason to reject the Objection on this basis.

## **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.**

There is no evidence in the record to suggest that the Applicant has any recognition in any sector of the public with the sign NOW. It does not appear to claim any such recognition in its Response.

The Objector has clearly established recognition in Hong Kong at least in NOW TV. It also no doubt has strong recognition at least in Hong Kong in the names of its channels such as Now Sports, Now News and Now Family etc.<sup>7</sup>

Although the Objection claims PCCW's NOW TV service is provided in territories other than Hong Kong, that claim is not supported by sufficient evidence to warrant a finding that that is in fact the case. This is particularly important in the present case as the word "now" is a plain, ordinary English word in everyday use. Thus, any recognition by the public of the word "now" as a trade mark of PCCW will turn on the context of its use.

This issue also extends into the level of PCCW's recognition in Hong Kong. The Panel would readily accept that the public in Hong Kong is likely to think of PCCW when NOW is used in a trade mark sense in the context of broadcasting or pay TV. On the record in this case, however, it may be debatable whether such recognition would extend further than that. It may also be important to consider the word order. Apart from the figurative versions, PCCW's trade marks use the form NOW (some other element). As the word "now" is a common, everyday word in English, the analysis may be different if the word order be reversed.

## **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 Applicant states that it had no knowledge of PCCW's trade marks before the application for the <.now> gTLD was made. Instead, it says it chose the string for its dictionary meaning.

PCCW does not assert that the Applicant had specific knowledge of PCCW's Now TV service or its trade marks. Some of its evidence might lead to an inference that someone in the Amazon group may have been aware of Now TV. However, any such inference would be very slender. Moreover, it would not be strong

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<sup>7</sup> The Harvard Business School case study included in Annex 8 to the Objection is headed "PCCW now" but, assuming contrary to the Applicant's objections it does illustrate public perception, the body of the article itself consistently refers to "now TV" and even the title qualifies "now" with PCCW. The Time article included in Annex 9 uses NOW as a defined acronym for Network of the World or in composite phrases such as NOW Broadband TV and NOW broadband.

enough to override the Applicant's specific denial particularly as that denial is not inherently implausible given the meaning of "now" in English and the nature of many of the Amazon group's services such as, for example, offers of differential pricing to facilitate speedier delivery of packages ordered online.

There is no evidence in the record in this case that the Applicant has applied to register other TLDs based on other parties' trade marks let alone engaged in a pattern of such conduct.

**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.**

At this stage, there is no evidence that the Applicant has made any use of the sign corresponding to the <now> gTLD in connection with the goods or services it offers. According to the Objector, it commissioned a worldwide trade mark search that revealed the Applicant did not have any registered trade marks in those places searched. Nor is the applied-for string derived from the Applicant's name. The Applicant has not contested those claims.

This being said, in the present case, it is significant that the applied-for string is in fact a very common English word which can describe the Applicant's services.

While there is no history of *bona fide* use of the applied-for string as a trade mark to bolster the Applicant's claims to that applied-for string, the fact that the applied-for string is a very common English word leads the Panel to consider that this factor does not point strongly in the Objector's favour either.

**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 considerations under this factor have essentially been addressed when dealing with the fifth factor above.

**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 considerations under this factor have also been addressed when dealing with the fifth factor above.

**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.**

PCCW contends that the applied-for gTLD string is identical to its trade mark and the services that the Applicant would be providing if it operated the applied-for gTLD are identical or have a high degree of similarity to the services PCCW provides by reference to its trade marks. Consequently, PCCW contends that there is an inevitable likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the applied-for gTLD.

The Applicant disputes all these contentions at every level.

First, the Panel notes there is no evidence of actual confusion in this case, but nor could there be as the

applied-for gTLD has not been granted and is not in use. Nor is there any consumer survey evidence.<sup>8</sup> The Panel notes that, while consumer surveys are used in some jurisdictions to test trade mark infringement issues, there is a considerable degree of scepticism towards them in many parts of the world particularly where, as here, the alleged infringement is not in use. In these circumstances, it becomes a matter of inference.

The Applicant does not accept that PCCW has established trade mark rights in NOW *simpliciter* around the world or in numerous countries. With the possible exception of the registrations in Bahrain, Saudi Arabia and Singapore noted above, all the registrations identified by PCCW in the Objection consist of NOW with another word (or words) or represented in a figurative or highly stylized manner. This is not surprising since, as the Applicant contends, the word is a very common English word in everyday use.

Indeed, the Applicant points out that in securing allowance of its trade mark application in the USA<sup>9</sup> in the face of objections to prior marks for NETWORK NOW and THE NOWNETWORK, PCCW argued that “[t]he most distinguishing feature is the design element of applicant’s mark, which is obviously not included as part of either cited mark.”

Moreover, in Annex 9 to the Response, the Applicant provides evidence of many other registered trade marks in the USA, the European Union and some Asian jurisdictions (but not Hong Kong) based on the word NOW. The registrations include many in International Class 38 for services the same as or closely related to those for which PCCW has obtained registrations. By way of example, they include:

- in the USA: Trade Mark No. 4133450 NOW registered by Sprint Communications, Trade Mark No. 3998708 NOW VOD registered by Cequel Communications, Trade Mark No. 3625941 for NOW-AGAIN, Trade Mark No. 3937297 for OnNowTV, Trade Mark No. 3793476 for WATCH NOW;
- Community Trade Marks Nos 7153505 NOW (cancellation action pending), 9150781 for NOWNESS, 6030365 NOW PLAY IT, 5099973 for NOW MOVIES and design, 5862321 PlayNow and device and many more;
- in India: Bennett Coleman & CO Ltd’s registrations for marks including TIMES NOW and device, BIZ NOW, ET NOW and device, BUSINESS NOW and SPORTS NOW and Sony Ericsson Mobile Communications’ trade mark, PLAY NOW;
- in Malaysia: Digi Telecommunications Sdn Bhd’s registrations for MOVIES NOW!, MUSIC NOW!, TRAFFIC NOW!, OFFICE NOW! and LIFESTYLE NOW!, Virgin Records Limited’s registration for NOW and Sony Ericsson Mobile Communications registration for PLAYNOW;
- in Japan: Web X Communications Inc.’s registration for PCNOW, EMI (IP) Ltd’s registration for NOW, Registration No. 5402886 for NOWNESS, At Net Home KK’s registration for SEOUL NOW and KK South Japan Broadcasting’s registration for MBC NEWS NOW.

Secondly, the Applicant points out that the services for which PCCW has registered its marks do not extend to domain name registry services. Those services properly fall within International Class 45. While the different classes in which the respective services fall are not decisive, the difference in the services is important. As the Applicant contends, the fact that PCCW’s services and those of the Applicant in operating the proposed gTLD involve the Internet does not in itself lead to a likelihood of confusion.

In these circumstances, the Panel does not find that there is an inevitable likelihood of confusion between the applied-for gTLD and PCCW’s trade marks. In some parts of the world, such as the USA, the European

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<sup>8</sup> Given the time frames under the Procedure and the WIPO Rules for New gTLD Dispute Resolution the Panel is conscious that there is not much time to prepare a survey.

<sup>9</sup> Registration No. 3769608, for the first device depicted in section 4 above.



Union, India and Japan where there are many other registered trade marks which include the word NOW even in International Class 38, the likelihood of confusion would seem very low. The potential likelihood for confusion may likely be higher in Hong Kong where, on the evidence in this record, PCCW has a strong reputation from its very extensive use. To the extent that its rights depend on use rather than registration, however, PCCW's position may well be limited to protection only against identical marks for the same services. As the High Court of Australia explained in a different context:

“There is a price to be paid for the advantages flowing from the possession of an eloquently descriptive trade name. Because it is descriptive it is equally applicable to any business of a like kind, its very descriptiveness ensures that it is not distinctive of any particular business and hence its application to other like businesses will not ordinarily mislead the public. In cases of passing off, where it is the wrongful appropriation of the reputation of another or that of his goods that is in question, a plaintiff which uses descriptive words in its trade name will find that quite small differences in a competitor's trade name will render the latter immune from action (*Office Cleaning Services Ltd. v. Westminster Window and General Cleaners Ltd.* (1946) 63 RPC 39, at p 42, per Lord Simonds). As his Lordship said (1946) 63 RPC, at p 43, the possibility of blunders by members of the public will always be present when names consist of descriptive words – ‘So long as descriptive words are used by two traders as part of their respective trade names, it is possible that some members of the public will be confused whatever the differentiating words may be.’ The risk of confusion must be accepted, to do otherwise is to give to one who appropriates to himself descriptive words an unfair monopoly in those words and might even deter others from pursuing the occupation which the words describe.”<sup>10</sup>

PCCW contends that registration of the applied-for gTLD by the Applicant will take unfair advantage of PCCW's trade marks because of the risk the public will wrongly associate the gTLD with PCCW. In this connection, PCCW repeats its contention based on its claim to a massive reputation as a leading trade mark in the global IPTV market and the potential overlap between its services and those of the Applicant.

PCCW further contends that the registration of the applied-for gTLD by the Applicant will unjustifiably impair PCCW's rights because the use of what PCCW contends is an identical sign for highly similar services will lead to the dilution of the exclusivity of PCCW's trade mark. It contends that it is extremely unlikely that the Applicant's service will be as high in quality as the internationally acclaimed services provided by PCCW under the trade mark and so invokes the risks to its excellent reputation which may flow from any difference in quality. PCCW further argues that its trade mark will be unjustifiably impaired because, no matter what processes the Applicant puts in place to prevent the registration of second level domain names that infringe trade marks, PCCW will have lost control over its trade mark.

The central premise of these arguments is PCCW's claim that the applied-for gTLD string, <.now>, is identical or confusingly similar to PCCW's trade mark and being used for the same or overlapping services. For the reasons set out in relation to the eighth factor above under Section 3.5.2 of the Guidebook, the Panel does not accept that premise. That conclusion makes it strictly unnecessary to address PCCW's argument based on the risks posed by the potential registration of second-level domains. The Panel notes, however, that the word order of such names would be the reverse of the usage made by PCCW. More importantly, whether or not any particular second-level domain would infringe, or breach other available rights protection mechanisms, would depend very much on the particular context including who sought to register the second-level domain, what second-level domain that person sought to register and how, if at all, that person used or proposed to use the name including consideration of what rights that person may have in the name in question.

In *The Canadian Real Estate Association v. Afilias Limited (supra)*, the learned panelist noted that there was no mechanism by which the Panel could allow a gTLD to be registered except for use in a particular country, in that case Canada. The learned panelist continued:

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<sup>10</sup> *Hornsby Building Information Centre Pty Ltd v. Sydney Building Information Centre Ltd* (1978) 140 CLR 216 at 229.

“The Panel cannot see the justification for refusing to allow the Applicant to operate in every country because the Objector has a certification mark for a generic term in Canada. Had the Objector’s certification been other than a generic term, its case might have been stronger but MLS it is a generic term used in English-speaking jurisdictions.”

In the present case, the word “now” is a plain English word in common everyday and widespread use. PCCW has registered trade marks in many countries which include NOW, however save for the registrations in Bahrain, Saudi Arabia and Singapore none are for NOW *simpliciter*. Hong Kong may, arguably, be added to those jurisdictions given the extent of use proved in that territory. As discussed above, however, PCCW’s services are very different to those of the Applicant. The Panel therefore respectfully adopts the approach taken by the learned panelist in *The Canadian Real Estate Association case*.

While the Applicant did not have a history with NOW as a trade mark or service before making the application for the new gTLD, there is nothing in the record which supports a finding that there is anything untoward in the Applicant’s adoption of the applied-for string. It is a common everyday word in plain English which is logically apt for the sorts of services the Applicant’s corporate group provides. In these circumstances, PCCW has failed to establish any of the three grounds required to be shown under Section 3.5.2 of the Guidebook.

## **6. Decision**

For the foregoing reasons, the Panel rejects the Objection.

[signed]

**Warwick Rothnie**  
Sole Panel Expert  
Date: August 21, 2013