

I refer to a communication by the Objector in WIPO cases LRO2013-0009, LRO2013-0010, LRO2013-0011, forwarded by the WIPO Arbitration and Mediation Center on September 23, 2013 under the following cover e-mail message:

“Please find attached a document which the WIPO Arbitration and Mediation Center has received today from the Objector in WIPO Cases LRO2013-0009/10/11. With this document, the Objector seeks revision of the Expert Determinations in these cases on the basis of an apparent error of fact forming part of the record underlying the Expert Determinations, coupled with an asserted mistaken reliance on UDRP principles.

While an LRO party may avail itself of other options that may exist, the WIPO Center stresses that the applicable Procedure does not foresee the possibility of an appeal within the LRO system, and that the role of a Panel concludes with the issuance of the Expert Determination. While fully respecting these conditions, the WIPO Center finds it appropriate to inform you about the aforementioned document.

(At this stage the WIPO Center has not received a reaction from the Applicant, whom the Objector has copied. Only for the event you would wish to let the WIPO Center have a material reaction on your part, you may wish to consider obtaining an Applicant reaction through the WIPO Center.)”

In the circumstances, the Panelist finds it appropriate to react as follows, and for this reaction (including the above paragraphs) to be published as an addendum to the Expert Determinations issued in LRO2013-0009, LRO2013-0010 and LRO2013-0011.

It is correct that the Expert Determinations under 6. (Discussion and Findings) under the heading Trademark Infringement, under non-exclusive factor viii, should not have included the following sentence:

“Applicant has made it clear that it will take all necessary measures, including geo-targeting, to avoid that Internet users in the territories in which Objector has trademark rights, will be able to visit websites that use the Disputed gTLD String.”

Such inadvertent inclusion has resulted from parallels which exist more generally, on the level of pleadings and expert determinations, between LRO2013-0068, LRO2013-0069, LRO2013-0009, LRO2013-0010 and LRO2013-0011.

Having noted this, the Panelist should make clear that, in reviewing LRO2013-0009, LRO2013-0010 and LRO2013-0011, he was in fact aware of the distinction in this regard, as reflected in the pleadings as cited and summarized in the Expert Determinations, between the latter three cases and cases LRO2013-0068 and LRO2013-0069 in relation to the competing applications at stake.

In any event, the Panelist considers it important to confirm that the above-mentioned sentence as such is immaterial to the conclusion which the Panelist reached in rejecting the Objections.

That conclusion is phrased on page 6 of the Expert Determinations and rests on the following considerations expressed therein:

“The question is whether a bona fide trademark owner that owns trademark rights in certain countries but does not have rights to a certain trademark in all countries of the world, should for that reason be prevented from obtaining a gTLD. In the view of the Panel, such a proposition does not make sense. If the opposite view would be accepted, it would be expected from any trademark owner interested in a gTLD to have trademark registrations in all countries of the world as otherwise another party could register one trademark in an ‘uncovered’ country and thus prevent the first trademark owner from applying for and using its own gTLD.

In essence there should not be a significant difference between the criteria for the legal rights objection as included in the Guidebook on the one hand and the provisions included in the Uniform Domain Name Dispute Resolution Policy ('UDRP'). If the applicant for a new gTLD is bona fide, it will not be likely that one of the three criteria will be met. It might be that advantage of the distinctive character or the reputation of the objector's registered trademark is taken, but it is then likely not unfair. It might be that the distinctive character or reputation of the objector's registered trademark is being impaired, but it is likely justified. It might be that a likelihood of confusion between the Disputed gTLD String and the objector's mark is created, but it is not necessarily impermissible."

It is clear from the foregoing, both on a substantive and on a textual level, that these considerations (which, UDRP comparisons notwithstanding, contrary to the Objector's assertion directly apply the specific LRO criteria) are not conditioned on the presence or absence of geo-targeting or similar measures on the part of the Applicant.

The Panelist additionally notes that the Expert Determinations, beyond the above core substantive findings, provide as follows:

"Of course a rejection of the Objection does not preclude Objector from taking regular legal action should the use of the Disputed gTLD String by Applicant be infringing. It is, however, not for this Panel to anticipate all the possible types of use Applicant could make of the Disputed gTLD String.

It is also not for this Panel to interpret the existing coexistence agreements and arrangements between the Parties. Should the application of a new gTLD allegedly violate any such agreement or arrangement, it will be for the Parties to settle their dispute by means of the dispute resolution provisions of the contracts governing their relationship or as provided under applicable law."

The Panelist trusts that the above in any event serves to clarify the factual record of cases LRO2013-0009, LRO2013-0010 and LRO2013-0011 as compared to cases LRO2013-0068 and LRO2013-0069.

Willem Leppink  
September 24, 2013