



.HBO .Brand TLD Designation Application

Internet Corporation for Assigned Names and Numbers (“ICANN”)
12025 Waterfront Drive, Suite 300
Los Angeles, California 90094
Attention: New gTLD Program Staff

RE: Application for .Brand TLD Designation

HBO Registry Services, Inc. (“Registry Operator”), in connection with the execution of the Registry Agreement for the .HBO TLD (the “Registry Agreement”), hereby applies for the .HBO TLD (Application ID: 1-1783-76510) to be qualified by ICANN as a .Brand TLD.

Registry Operator confirms and represents to ICANN that the TLD meets each of the criteria for the TLD to be qualified as a .Brand TLD, as described in the .Brand TLD Application Process and Specification 13 attached thereto, and that all supplemental material accompanying this application is accurate and not misleading in any respect. Registry Operator also represents that the trademark registration attached hereto as Exhibit A and the registration policies attached hereto as Exhibit B are complete and accurate copies of the official trademark registration and Registry Operator’s registration policies for the TLD, respectively.

Registry Operator also submits detailed information, including particular evidence, attached hereto as Exhibits C-D, supporting the TLD’s satisfaction of the .Brand TLD criteria set forth below.

- i. **TLD And Trademark Identity.** The HBO TLD string is identical to the textual elements protected by Registry Operator’s United States Service Mark Registration for HBO (Reg. No. 1,020,101) (the “HBO Mark”). See Exhibit A.
 - a. **Trademark Clearinghouse Entry.** Registry Operator recorded the HBO Mark with proof of use with the Trademark Clearinghouse. A copy of the Signed Mark Data file [REDACTED] issued by the Trademark Clearinghouse for the HBO Mark is attached hereto as Exhibit C.
 - b. **Trademark Ownership.** The HBO Mark is owned and used by Registry Operator’s parent entity, Home Box Office, Inc., a Delaware corporation, in connection with the offering of the cable television and/or master antenna



.HBO .Brand TLD Designation Application

programming services claimed in the submitted service mark registration, as demonstrated by the submitted service mark registration attached as Exhibit A and the specimen attached as Exhibit D.

- c. **Registration Timing.** The submitted trademark registration for the HBO Mark was issued on September 9, 1975 (See Exhibit A), well before ICANN opened its new gTLD application window on January 12, 2012 and the Registry Operator submitted its TLD registry application.
 - d. **Continuous Trademark Use.** Registry Operator has continuously used the HBO Mark in connection with the services identified in the submitted trademark registration since at least as early as 1972, and intends to maintain such use throughout the Term of the Registry Agreement.
 - e. **No Punctuation.** The HBO Mark does not begin with a period or dot. See Exhibits A, D.
 - f. **Trademark Unrelated To Registry Services.** Registry Operator has continuously used the HBO Mark in connection with at least some of the cable television programming services identified in the submitted service mark registration since at least as early as 1972, and intends to maintain such use throughout the Term of the Registry Agreement. See Exhibits A, D. The services identified in the submitted trademark registration and supporting specimen do not reference the provision of any TLD Registry Service, as defined in Section 2.1 of Specification 6 of the Registry Agreement.
- ii. **Registrants and DNS Record Control.** As detailed in its registration policies (See Exhibit B), only Registry Operator or its Affiliates (as defined in the Registry Agreement) will be registrants of domain names in the TLD and control the DNS records associated with domain-names at any level in the TLD.
 - iii. **Non-Generic String.** The applied-for HBO TLD is not a Generic String TLD as defined in Specification 11 of the Registry Agreement. As defined in Section 3(c) of Specification 11 of the Registry Agreement, “Generic String” means a string consisting of a word or term that denominates or describes a general class of goods, services, groups, organizations or things, as opposed to distinguishing a specific brand of goods, services, groups, organizations or things from those of others. “HBO” is not a dictionary term or general class of goods or services, but is a specific brand of goods or services offered by Registry Operator. At the United States Patent & Trademark Office, Trademark



.HBO .Brand TLD Designation Application

Examining Attorneys substantively analyze trademark applications to determine if they are unregistrable for being generic in relation to the applied-for goods and services under Sections 2(e) and 23 of the Trademark Act. See Trademark Manual of Examining Procedure (TMEP) §§1209.01-.02. Registry Operator submitted a presumptively valid United States trademark registration for the HBO Mark, meaning that it is the opinion of the United States Patent and Trademark Office that the word HBO is not generic, and that it distinguishes a specific brand of cable television services from the services of others. Indeed, no court of law has ever held that HBO is a generic term for any class of goods or services.

- iv. **Registration Certificate.** Registry Operator has provided ICANN with an accurate and complete copy of a United States service mark registration for the HBO Mark. See Exhibit A.

Registry Operator agrees that if Registry Operator makes any changes to its registration policies for the TLD (whether before or after this application has been approved) that may disqualify the TLD as a .Brand TLD, it will promptly provide ICANN with a complete and accurate copy of the revised registration policies. In addition, if Registry Operator fails to maintain the trademark registration underlying its .Brand TLD application, it shall promptly notify ICANN of such failure. Registry Operator also agrees to maintain the criteria required to qualify as a .Brand TLD and to immediately notify ICANN of any changes in circumstances that could alter the statements made, and supporting materials provide with, this application.

Registry Operator acknowledges and agrees that this letter is binding on Registry Operator and, if any of the foregoing representations and agreements becomes untrue or not complied with, it shall be deemed a breach of the Registry Agreement by Registry Operator, and ICANN may assert its rights under the Registry Agreement, including by determining that the TLD no longer qualifies as a .Brand TLD pursuant to the terms of Specification 13.

Questions about this request should be directed to [REDACTED].

Submitted by: [REDACTED]
Position: Partner, Katten Muchin Rosenman LLP
Counsel for HBO Registry Services, Inc.
Dated: August 27, 2014
Email: [REDACTED]



.HBO .Brand TLD Designation Application

Exhibit A

Trademark Registration

Int. Cl.: 41

Prior U.S. Cl.: 107

United States Patent Office

Reg. No. 1,020,101

Registered Sept. 9, 1975

SERVICE MARK

Principal Register

HBO

Home Box Office, Inc. (Delaware corporation)
1271 Avenue of the Americas
New York, N.Y. 10020

For: SUPPLYING AND DISTRIBUTING PRO-
GRAMS TO CABLE TELEVISION AND/OR MASTER
ANTENNA SYSTEMS, in CLASS 41 (U.S. CL. 107).
First use Nov. 8, 1972; in commerce Nov. 8, 1972.

Ser. No. 8,169, filed Dec. 6, 1973.

Int. Cl.: 41

Prior U.S. Cl.: 107

United States Patent and Trademark Office
10 Year Renewal

Reg. No. 1,020,101
Registered Sep. 9, 1975
Renewal Term Begins Sep. 9, 1995

**SERVICE MARK
PRINCIPAL REGISTER**

HBO

TIME WARNER ENTERTAINMENT
COMPANY, L.P. (DELAWARE LIM-
ITED PARTNERSHIP)
75 ROCKEFELLER PLAZA
NEW YORK, NY 10019, BY ASSIGN-
MENT, CHANGE OF NAME AND AS-
SIGNMENT FROM HOME BOX
OFFICE, INC. (DELAWARE CORPO-
RATION) NEW YORK, NY

FOR: SUPPLYING AND DISTRIBUT-
ING PROGRAMS TO CABLE TELEVI-

SION AND/OR MASTER ANTENNA
SYSTEMS, IN CLASS 41 (U.S. CL. 107).

FIRST USE 11-8-1972; IN COMMERCE
11-8-1972.

SER. NO. 73-008,169, FILED 12-6-1973.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Aug. 22, 1995.*

COMMISSIONER OF PATENTS AND TRADEMARKS



.HBO .Brand TLD Designation Application

Exhibit B

.HBO TLD Registration Policies

As stated in its new gTLD application for .HBO, Applicant is a wholly-owned subsidiary of the world's most successful pay-tv service, Home Box Office, Inc. ("HBO"), providing HBO® and Cinemax® services to approximately 127 million subscribers worldwide. Internationally, HBO branded television networks, along with the subscription video-on-demand products HBO On Demand and HBO GO®, bring HBO services to over 70 countries. HBO programming is sold into over 150 countries worldwide. Applicant's mission is to operate the proposed gTLD ("the TLD") on behalf of, and for the benefit of, its corporate parent, HBO. The purpose of the TLD is to serve HBO, for internal purposes and/or as a digital marketing tool. Although initially the TLD will not be used to provide any information or services to the public, Applicant plans to diligently evaluate the best possible uses for the TLD to benefit HBO pursuant to the inter-company arrangement between Applicant and HBO, and therefore reserves the right to use the TLD for internal purposes.

In line with its current domain name registration guidelines, only Registry Operator or its affiliates (as defined in the Registry Agreement) through authorized employees will be allowed to register and control the DNS records of domain names within the TLD for purposes related to the brand under strict internal guidelines. Under these guidelines, each domain name requested must be for an internally approved justification and match a naming scheme that is aligned to the purpose of the justification. Each name will be reviewed by relevant legal and technical personnel, and finally approved by Registry Operator's Domain Name Team to ensure the proper procedure was fulfilled. Thereafter, the Domain Name Team will review the ongoing use of registered names to ensure the guidelines are met on an ongoing basis.

Accordingly, it is Registry Operator's intention that non-affiliated third parties will not be allowed to register, buy, or sell domain names in the TLD, or control their DNS records. Applicant, however, reserves the right to sell, distribute, or transfer control or use of any registrations in the TLD to any third party that is an affiliate of Registry Operator (as defined in the Registry Agreement) for the exclusive use of Registry Operator.



.HBO .Brand TLD Designation Application

The TLD's domain name registration and use policies will be subject to its abuse prevention and rights protection policies discussed in its new gTLD application, and Applicant will strive to avoid registering domain names that are confusingly similar to third-party's trademarks and related rights. Obscene, explicit, and offensive domain names will not be entitled to registration.



.HBO .Brand TLD Designation Application

Exhibit C

Signed Mark Data File

Marks: HBO

smdID: [REDACTED]

U-labels: hbo



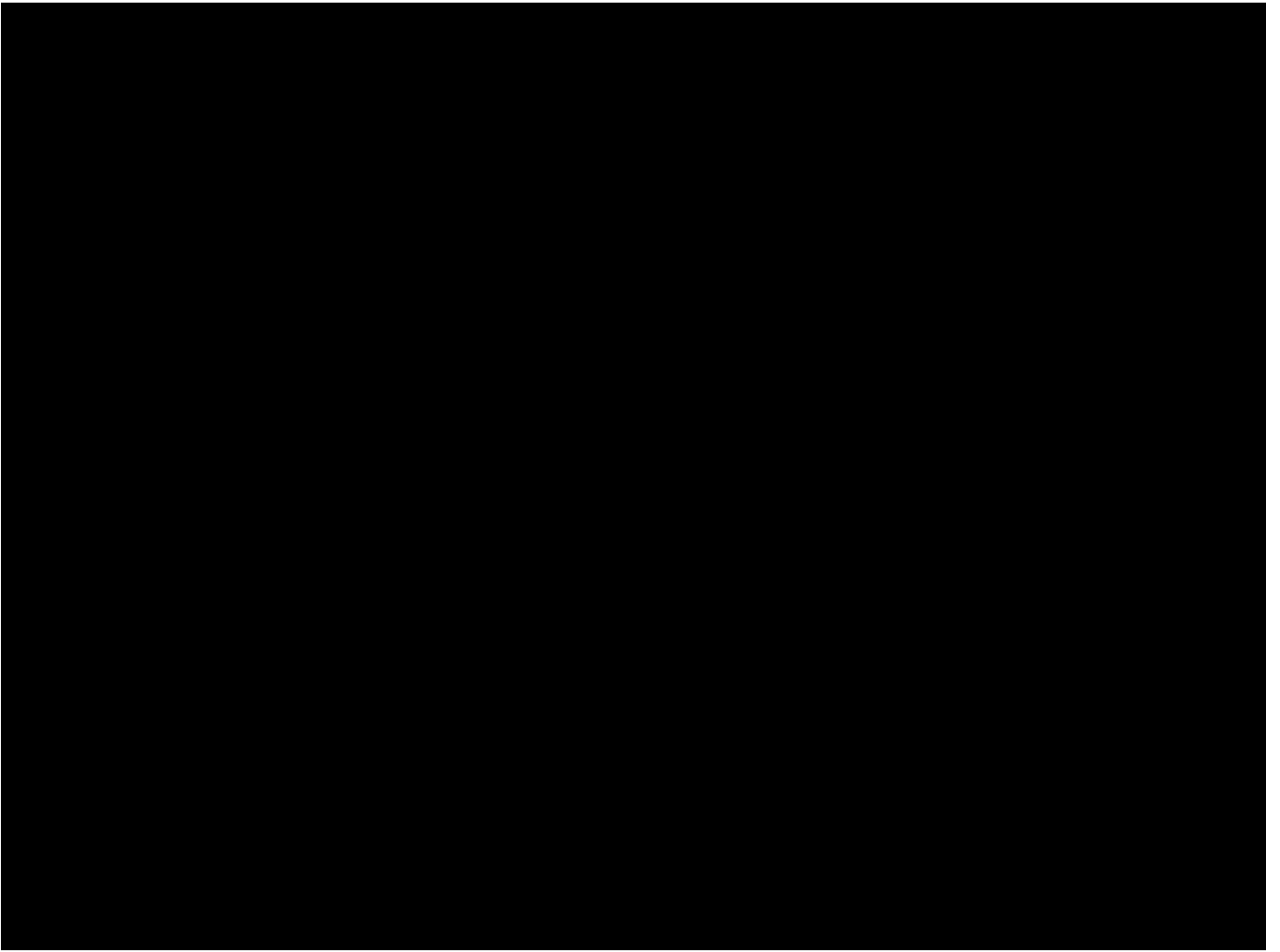




.HBO .Brand TLD Designation Application

Exhibit D

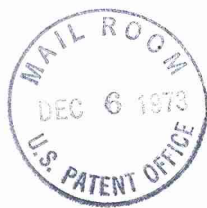
Specimens of Use





HOME
BOX OFFICE
INC.

TIME & LIFE BUILDING / ROCKEFELLER CENTER / NEW YORK, N.Y. 10020 / 212-247-7233



8169

APPLICATION FOR UNITED STATES TRADEMARK

Home Box Office, Inc.
1271 Avenue of the Americas
New York, N. Y. 10020

Mark: HBO Logo

Class: 41

SPECIMENS

Home Box Office, Inc.
1271 Avenue of the Americas
New York, N. Y. 10020

2

Mark: HBO
Class: 41

SPECIMENS