

EXPERT DETERMINATION LEGAL RIGHTS OBJECTION

Biotechnology Industry Organization v. Starting Dot

Case No. LRO2013-0056

1. The Parties

Objector/Complainant (“Objector”) is Biotechnology Industry Organization of Washington, United States of America, represented by Foley & Lardner LLP, United States of America.

Respondent/Applicant (“Respondent”) is Starting Dot of Neuilly sur Seine, France, represented by Dreyfus & associés, France.

2. The applied-for gTLD string

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

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 has completed the review of the Objection on March 25, 2013 and has 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 18, 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 15, 2013.

The WIPO Center appointed Christopher J. Pibus as the Panel in this matter on June 15, 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

A. Objector

Objector is Biotechnology Industry Association, an association serving the biotech industry and broader life sciences community in the United States and internationally. Objector has adopted the name, trade-mark and acronym BIO in providing advocacy, business development and educational services since 1993.

Objector relies on 15 trade-mark registrations which comprise or include the BIO. The most senior registrations were obtained through the United States Patent and Trademark Office (“USPTO”) in 1995 (Nos. 1,889,271 and 1,894,719), for class 16 and 42, respectively. These registrations protect the unadorned word mark BIO; the rest of Objector’s portfolio is comprised of design marks and BIO-prefixed combination marks. Objector describes its referenced services corresponding to class 16 and 42 as follows:

“Class 16: Newsletters and publications, including newsletters and publications in the field of biotechnology”

“Class 41: Association services in the nature of promoting the interests of biotechnology companies”

Objector also owns a number of more recent registrations in the United States (BIO BUSINESS SOLUTIONS), European Union (BIO EUROPE), France (BIO INTERNATIONAL), Switzerland (BIO EUROPE SPRING) and the United Kingdom of Great Britain and Northern Ireland (BIO-EUROPE SPRING) which cover class 35:

“Class 35: Conducting trade shows exhibitions in the field of biotechnology; association services, namely promoting the industry of biotechnology companies through politics, education and public relations”

The public recognition of Objector is founded in part on the annual conference it conducts and has conducted under the title the BIO International Convention since 1993. Objector describes the convention as “the premier worldwide annual conference for the biotechnology community”. Support for this characterization of the event is evidenced through the number of attendees, the number of countries represented, the presence of international governmental delegations, and the scope of media coverage.

B. Respondent

Respondent is Starting Dot, a “société anonyme simplifiée”, organized under the laws of France. Respondent has applied to register the <.bio> gTLD string. It identifies its primary target market as the organic industry. Respondent’s stated goal is to provide a reliable platform for Internet sales and distribution by organic suppliers. Domain name registrants will be subject to Respondent’s certification process to ensure that their organic products adhere to regulated standards. This level of compliance, according to Respondent, does not exist among existing TLD’s serving the food industry.¹

Respondent also identifies a secondary target market for the <.bio> gTLD: life sciences. In its gTLD application, Respondent only briefly mentions this secondary purpose, noting that “The <.bio> gTLD will service as a unique source of information on life sciences, while ensuring that these contents are dissociated from organic related information”.

Respondent owns European Community trade-marks for DOT.BIO (No. 010565455) and BIO DOT-BIO.NET (No. 010565729), both of which registered in June 2012 and correspond to classes 35, 38, 42 and 45. A related domain name <dot_bio.net> was registered in November 2011. To date, there is no indication that

¹ In this decision, the Panel has only referenced the Respondent’s “New gTLD Application – No. 1-1000-94806” for the description of its goals, benefits, etc., in the form attached as Annex 1 to the Objection.

Respondent has actually used these “dot.bio” indicators in any tangible way, except to describe its future plans.

5. Parties’ Contentions

A. Objector

Objector relies on its strong rights and reputation in the BIO trade-mark. It points to its portfolio of registered marks, which extend not only to the United States but to the European Community and individual European countries including France, where the Respondent is based. In terms of reputation, Objector places emphasis on the long-standing success of its annual Bio International Convention and the broad range of participants and media coverage over 20 years. Objector claims that this demonstrates the extent to which the mark BIO is closely associated with Objector, and the public’s level of recognition of the BIO mark.

Objector characterizes its evidence as proving (1) its significant efforts to build goodwill and reputation in BIO; (2) the fact that the BIO mark has become synonymous with Objector’s services, in the public’s mind; and (3) Objector’s strong trade-mark rights.

Following the requirements set out in the ICANN New gTLD Applicant Guidebook, Module 3 (“Guidebook”), Objector argues that the disputed <.bio> gTLD takes unfair advantage of the distinctive character and goodwill in the BIO mark. Objector anticipates that members of the biotech community may register <.bio> domain names, and thereby take advantage of Objector’s reputation. The core complaint appears to be that members of the public encountering a <.bio> domain name in the name of a biotech business will mistakenly assume that the domain name and its registrant are associated or affiliated with, or sponsored or endorsed by the Objector.²

Secondly, Objector submits that the registration of <.bio> will unjustifiably impair the distinctive character or reputation of the BIO mark. This argument is founded on perceived fundamental conflicts between the interests of the biotech community and the organics community. Objector submits that the reputation and distinctive character of BIO will be fundamentally harmed by Respondent’s deliberate association of the BIO name with a philosophical opposition to biotechnology, and advocacy for positions (such as the elimination of genetic engineering) which are antithetical to the views of Objector’s members.

Finally, Objector submits that the disputed gTLD “<.bio> is likely to cause confusion with [Objector’s] mark”. The similarity of the marks in question is emphasized, not only as compared to the registered BIO word marks but also to the BIO-formative marks, where BIO is the first and dominant feature. Objector relies on the connection between its services to the biotech community, and the fact that Respondent has identified the life sciences field as its secondary target market. The anticipated confusion will involve the wrongful association of registered <.bio> domain names with the Objector’s organization, where no such association exists.

B. Respondent

Respondent raises many issues, both procedural and substantive. By way of preliminary arguments Respondent complains of non-disclosure by Objector, covering (1) opposition to Objector’s BIO application (Community Trademark 010999266); (2) Objector’s parallel Community objection to the <.bio> gTLD; (3) registrations of Respondent; and (4) trademark rights of Respondent in relevant DOT.BIO marks.

In substantive terms, Respondent objects to the strength and ambit of protection for the Objector’s BIO marks. Respondent argues that “bio” lacks distinctiveness because it is commonly understood as a descriptive word in the European Community (and other countries) which denotes a number of different

² The Panel will refer to this hereafter as the “wrongful association” argument

meanings, including biography, biology and most importantly, organic products. Among other evidence, Respondent relies on a survey which purports to show that the word “bio” in France and Germany is primarily understood to involve organic farming and products.

Respondent submits that it cannot be taking unfair advantage of the distinctive character of the BIO trademark, because the mark is in fact non-distinctive, functioning as a generic term used as a prefix or abbreviation for words such as biography or biology, or functioning as a French word meaning “without fertilizers or synthetic pesticides, natural” (Larousse). Respondent identifies many third party users of bio-related domain names, against which Objector has never taken any action.

Respondent argues that its use of <.bio> will not unjustifiably impair the distinctive character or reputation in Objector’s mark, relying on the multiple meanings of “bio” in different fields. Respondent asserts its rights to use <.bio> even if its organic community espouses divergent views from the biotechnology community, relying on freedom of speech.

Finally, Respondent denies that the use of <.bio> would create a likelihood of confusion with Objector’s trade-marks, because those marks are based on a term with only a low degree of distinctiveness, and the <.bio> gTLD string will be understood as a generic term. Respondent submits that Objector has failed to acknowledge that mere likelihood of confusion is not the standard established in the Guidebook: the criteria requires “impermissible” likelihood of confusion. The wrongful association argument is criticized on the basis that Objector has not provided any basis for this anticipated response among the public.

6. Discussion and Findings

A. Preliminary Objections

Respondent has raised a number of preliminary challenges, based on non-disclosure and evidentiary issues. The Panel has reviewed all these arguments, and acknowledges the additional information provided by Respondent which appropriately expands the record in this proceeding. The principal allegations of non-disclosure are made: (1) additional Community and United States trade-mark filings for BIO Designs and a related opposition proceeding; and (2) Community Objection initiated by Objector.

With respect to applications for the new BIO designs, it is not clear to the Panel that the failure to disclose these filings is worthy of any finding adverse to Objector. Respondent has now placed all the relevant materials before the Panel. With respect to the Community Objection, the Panel is of the view that it would have been more appropriate for Objector to have disclosed such Community Objection. However, the existence of the parallel objection does not prevent this proceeding from moving forward to a determination, as it is a separate matter to be adjudicated under its own criteria and process. The Panel will restrict its analysis and comments in this matter to the potential for infringement of existing legal rights of Objector, and will not comment on the Community Objection.

B. Analysis

The potential use of the applied-for gTLD by the Respondent must be evaluated in terms of whether it:

- (i) takes unfair advantage of the distinctive character or the reputation of the Objector in its BIO trade-marks; or
- (ii) unjustifiably impairs the distinctive character or the reputation of Objector’s BIO mark; or
- (iii) otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the Objector’s BIO mark

In performing its analysis, the Panel is directed by the Guidebook to consider the non-exclusive factors set

out below, and the Panel's conclusions are noted in connection with each factor:

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

The <.bio> gTLD string is clearly identical to Objector's trade-mark.

This factor favours Objector.

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

Objector has submitted strong evidence in support of its rights to the BIO trade-marks in connection with its industry association in the biotechnology field. Objector's use extends over the past 20 years, and there is no suggestion that its use of BIO has been anything other than *bona fide*.

This factor favours 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 Respondent or of a third party.

A fundamental issue in this proceeding is the appropriate recognition of the word "bio" by different sectors of the public, founded on differences in the basic meaning of the word, and on differences in uses in different parts of the world. From the Objector's perspective, the word "bio" has become recognized as a powerful brand, signifying the services of its industry association and related activities. From the Respondent's perspective, the word "bio" itself is not perceived as a trade-mark, but as a word in common currency (in France and Germany in particular) which denotes organic characteristics in food or farming, and a variety of other meanings.

Objector points to its association members and the wider life sciences community as its relevant public, and argues that there is significant recognition for its BIO marks in that sector. The evidence supports that contention so far as it goes. However, the Respondent has shown convincingly that the word "bio" actually has a strikingly different connotations in what is arguably a broader public located in Europe and other parts of the world. The meaning ascribed to BIO by the Respondent is not that of a sign designating a source, in the terms conventional to trade-mark theory, but rather a generic set of meanings that include an organic designation, biography, biology and other descriptive terms.

Respondent has gathered evidence showing that the word "bio" is widely used in third party trade-marks and domain names. It also appears that Objector has tolerated widespread use of the term for many purposes (which even includes some examples of conferences in the field of biology). No examples of enforcement against bio-formative domain names under the Uniform Domain Name Dispute Resolution Policy were identified. In the Panel's view, this tends to show co-existence among many users of "bio" related signs, supporting Respondent's contention that "bio" has many meanings and functions as a multi-faceted generic descriptor.

This factor favours the Respondent.

4. Respondent's intent in applying for the gTLD, including whether the Respondent, 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 Respondent 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 clearest evidence of Respondent's intent is set out in its application to secure the <.bio> gTLD string. As discussed above under Section 4 "Factual Background". Respondent has chosen the string to serve as a platform primarily for the organics industry. Respondent has identified a lack of compliance with governmental standards among Internet vendors of organic wares, and has developed a plan to permit only

those parties who are certified as meeting organic standards to own domain names under the <.bio> gTLD. By virtue of this plan, Respondent has managed to obtain approval for its application from the International Federation of Organic Agricultural Movements (IFOAM), the umbrella organization for organic agriculture with members from over 100 countries.

Significantly, no specific conduct on the part of Respondent which could constitute evidence of an intention to trade on Objector's reputation or the core elements of its business has been identified. On the evidence, the Panel therefore finds that Respondent intends to use the <.bio> string for the legitimate purposes described in its application.

In terms of awareness of Objector's trade-mark rights, it appears likely that Respondent might have had at least some awareness, given the Internet presence of Objector's business and its international registrations of the BIO marks. However, in this Panel's view, this factor does not carry significant weight when there is otherwise no evidence that Respondent is attempting to trade on those rights.

In this matter, there has also been no suggestion that Respondent has engaged in a serial pattern of acquiring questionable gTLD strings.

The Panel concludes that this factor favours the Respondent.

5. Whether and to what extent the Respondent 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 indicated above, Respondent's application sets out the most reliable evidence of its plans for the <.bio> string. In this Panel's view those stated plans indicate a *bona fide* offering of services related primarily to the operation of a platform for the sale and distribution of properly certified organic wares. At this point, there is no tangible use of the <.bio> gTLD by Respondent which would allow the Panel to truly test how and what it will offer. In the present circumstances, the Panel must deal with the evidence as it exists, and is led to the conclusion that the Respondent's preparations to use the <.BIO> sign are *bona fide*.

Finally, the Panel must evaluate Respondent's plans to determine if the intended services will be provided in a way that does not interfere with the legitimate exercise of Objector's rights in the BIO mark. In this regard, Objector apprehends that the public will be deceived into thinking that registrants using domain names under the <.bio> gTLD are somehow endorsed, sponsored or associated with the Objector's business, but has not filed convincing evidence to support this assertion. In any event the Panel finds it is equally plausible that members of the public encountering <.bio> domain names will view the gTLD string as evoking one of the other meanings of the word, such as biography, biology or organic. This factor favours the Respondent.

6. Whether the Respondent 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 Respondent is consistent with such acquisition or use.

Respondent has recently acquired registered rights in two related Community trade-marks. However, these rights have only been obtained over the past year. The trade-mark rights, such as they are, are not inconsistent with the planned acquisition and use of the <.bio> string.

This factor favours the Objector.

7. Whether and to what extent the Respondent 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 Respondent is consistent therewith and *bona fide*.

There is no evidence that Respondent has been commonly known or identified by the BIO sign, except for activities relating to its planned acquisition of the <.bio> string. However, as indicated above, the *bona fides* of Respondent have been established in the evidence.

This factor is neutral.

8. Whether the Respondent'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.

Given the generic nature of the word "bio" and its manifold and diverse meanings not only in English but in other languages, proof of the likelihood of confusion is very difficult to establish. Objector has not satisfied the Panel on this point. If situations arise in the future, where second-level domain name registrants use the <.bio> gTLD string in a manner or combination which infringes Objector's rights in its field, Objector will certainly be at liberty to enforce those rights as circumstances may demand. Nothing in this decision is intended to limit the Objector's enforcement rights in such future situations.

This factor favours the Respondent.

7. Conclusion and Decision

The Panel concludes that the Objector has failed to make out its case under the first criteria of Section 3.5.2 of the Guidebook. The evidence does not establish that the Respondent's use of the <.bio> string will take unfair advantage of the distinctive character or reputation of the Objector's BIO trade-marks. Objector has not proven, on the balance of probabilities that is unfair for Respondent to adopt as an identifier a descriptive term which is directly related to the organics industry which Respondent's enterprise intends to serve.

With respect to the second criteria of Section 3.5.2 of the Guidebook, the evidence has failed to show how the Respondent's use of the <.bio> string will unjustifiably impair the distinctive character or reputation of Objector's BIO marks. In fact, the evidence tends to show that Objector has chosen as its mark a word that bears multi-faceted meanings in many different languages. As a consequence, there are many other users who have adopted "bio" -formative identifiers. In this context, it is difficult to see how any unjustifiable impairment can occur, so long as Respondent actually holds fast to its planned use of the <.bio> string as described in its application.

With respect to the third criteria of Section 3.5.2 of the Guidebook, the evidence does not establish that the Respondent's planned use for the applied-for gTLD will otherwise create an impermissible likelihood of confusion with Objector's BIO mark. As set out above, likelihood of confusion has not been proven to the Panel's satisfaction. In addition, the Panel notes that the qualifier "impermissible" is built into the criteria: Objector must not only show likelihood of confusion, but that it is impermissible. Prior WIPO LRO decisions have commented on this point, and this Panel particularly notes with approval the discussions in *Right at Home v. Johnson Shareholdings Inc.*, WIPO Case No. LRO2013-0030, and *Del Monte Corporation v. Del Monte International GmbH*, WIPO Case No. LRO2013-0001. Applying the same reasoning, the Panel does not find any evidence of untoward behaviour on the part of the Respondent, or anything intolerable in the situation if Respondent is permitted to adopt the gTLD in question, as planned.

For the foregoing reasons, the Panel rejects the Objection.

[signed]

Christopher J. Pibus
Sole Panel Expert
Date: August 19, 2013