

EXPERT DETERMINATION LEGAL RIGHTS OBJECTION

Regtime Ltd. and Legato Ltd. v. Public Interest Registry

Case No. LRO2013-0067

1. The Parties

The Objectors are Regtime Ltd. and Legato Ltd., LLC, Russian Federation, represented by Winston & Strawn LLP, United States of America.

The Respondent/Applicant is Public Interest Registry, United States of America, represented internally.

2. The applied-for gTLD string

The applied-for gTLD string is <.opr> [xn--c1avg].

3. Procedural History

The Objection was filed with the WIPO Arbitration and Mediation Center (the “WIPO Center”) on March 13, 2013 (UTC), 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 22, 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 22, 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 20, 2013.

The WIPO Center appointed Assen Alexiev as the Panel in this matter on June 13, 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.

On June 27, 2013, the Respondent filed a supplemental submission. On July 3, 2013, the Objectors filed a response to it. These submissions of the Parties were made without a prior invitation by the Panel, as

required under Article 17 of the Procedure. The Panel reviewed the supplemental submissions of the Parties and decided to accept them and take them into account in its Expert Determination, as they dealt with certain issues that were to some extent relevant to the dispute, and their acceptance provided the Parties with an additional opportunity to present their case and to address issues that they considered relevant.

In view of the supplemental submissions of the Parties, on July 18, 2013, the Panel extended the deadline for the issuance of its Expert Determination until August 12, 2013. On August 6, 2013, the Panel further extended the deadline until August 23, 2013.

4. Factual Background

The Objector Regtime Ltd. (“Regtime”) and the Objector Legato Ltd. (“Legato”) are companies registered in the Russian Federation. Regtime has functioned as an ICANN-accredited registrar since 2007.

Regtime was the original owner of the word trademark ОПГ, registered in the Russian Federation on December 22, 2008, with registration number 368,116 (the “ОПГ trademark”). The ОПГ trademark is registered for services in International Classes 35 and 38, listed in the Russian language in the following way:

“35 - абонирование телекоммуникационных услуг для третьих лиц; агентства по импорту-экспорту; агентства по коммерческой информации; агентства рекламные; анализ себестоимости; аренда площадей для размещения рекламы; аудит; бюро по найму; ведение автоматизированных баз данных; ведение бухгалтерских книг; выписка счетов; демонстрация товаров; запись сообщений; изучение общественного мнения; изучение рынка; информация деловая; информация и советы коммерческие потребителям; исследования в области бизнеса; исследования в области маркетинга; комплектование штата сотрудников; консультации по вопросам организации и управления бизнесом; консультации по вопросам штата сотрудников; консультации по организации бизнеса; консультации по управлению бизнесом; консультации профессиональные в области бизнеса; макетирование рекламы; менеджмент в области творческого бизнеса; обзоры печати; обновление рекламных материалов; обработка текста; обслуживание секретарское; обслуживание стенографическое; организация выставок в коммерческих или рекламных целях; организация подписки на газеты [для третьих лиц]; организация торговых ярмарок в коммерческих или рекламных целях; оформление витрин; оценка коммерческой деятельности; оценка леса на корню; оценка шерсти; подготовка платежных документов; поиск информации в компьютерных файлах [для третьих лиц]; поиск поручителей; помощь в управлении бизнесом; помощь в управлении коммерческими или промышленными предприятиями; представление товаров на всех медиасредствах с целью розничной продажи; прогнозирование экономическое; продажа аукционная; продвижение товаров [для третьих лиц]; прокат офисного оборудования и аппаратов; прокат рекламного времени на всех средствах массовой информации; прокат рекламных материалов; прокат торговых автоматов; прокат фотокопировального оборудования; публикация рекламных текстов; работы машинописные; радиореклама; расклейка афиш; распространение образцов; распространение рекламных материалов; редактирование рекламных текстов; реклама; реклама интерактивная в компьютерной сети; реклама почтой; реклама телевизионная; репродуцирование документов; сбор и предоставление статистических данных; сбор информации по компьютерным базам данных; сведения о деловых операциях; систематизация информации в компьютерных базах данных; составление налоговых деклараций; составление отчетов о счетах; составление рекламных рубрик в газете; тестирование психологическое при найме на работу; управление гостиничными делами; управление коммерческое лицензиями на товары и услуги для третьих лиц; управление процессами обработки заказов на покупки; услуги в области общественных отношений; услуги манекенщиков для рекламы или продвижения товаров; услуги по переезду предприятий; услуги по сравнению цен; услуги снабженческие для третьих лиц [закупка и обеспечение предпринимателей товарами]; услуги субподрядчика управление [коммерческое]; услуги телефонных ответчиков [для отсутствующих абонентов]; фотокопирование; экспертиза деловая.

38 - агентства печати новостей; вещание телевизионное; вещание телевизионное кабельное; доска сообщений электронная [телекоммуникационные службы]; информация по вопросам дистанционной связи; маршрутизации и соединения телекоммуникационные; обеспечение дискусионными формами в Интернете; обеспечение доступа в Интернет [услуги провайдеров]; обеспечение доступа к базам данных; обеспечение телекоммуникационного подключения к Интернету; обеспечение телекоммуникационными каналами, предоставляющими услуги телемагазинов; передача сообщений; передача сообщений и изображений с использованием компьютера; передача срочных объявлений; передача телеграмм; почта электронная; прокат аппаратуры для передачи сообщений; прокат времени доступа к сетям всемирной информационной сети; прокат модемов; прокат оборудования для телекоммуникационной связи; прокат телефонных аппаратов; прокат факсимильных аппаратов; радиовещание; связь волоконно-оптическая; связь радиотелефонная; связь с использованием компьютерных терминалов; связь спутниковая; связь телеграфная; связь телефонная; связь факсимильная; служба пейджинговая [с использованием радио телефонной службы или других средств электронной связи]; телеконференции [Интернет]; услуги абонентской телеграфной службы; услуги по предоставлению телеграфной связи; услуги голосовой почты; услуги по предоставлению телефонной связи.”

On December 13, 2010, Regtime transferred the OPI trademark to Legato.

The Respondent, Public Interest Registry (“PIR”), is a nonprofit corporation, registered in the State of Pennsylvania, the United States of America. It has functioned as the registry operator for the <.org> gTLD since 2003.

On June 13, 2012, the Respondent submitted its Application number 1-910-36696 to ICANN for the <.opr> gTLD, and is the sole applicant for this string. The Respondent has described the literal meaning of the string as “org (организация - organization)”, and has stated the mission/purpose of the <.opr> gTLD in the following terms: “The mission/purpose of the IDN gTLD is to offer the Eastern European language community (Bosnian, Bulgarian, Belarusian, Macedonian, Russian, Serbian, and Ukrainian) a gTLD that is an in-language and localized translation of .ORG, and to promote the mainstream adoption of Internationalized Domain Names (IDNs). PIR wishes to extend its stewardship of .ORG to other language communities, providing a consistent end-user experience across the IDN equivalents. PIR’s deployment of an IDN, as a mainstream and proven registry operator, will serve as an important boost to promote the adoption of IDNs, and will signal to application developers to support IDNs, which in turn leads to a better user experience and usability of IDNs.”

The Respondent’s application describes the benefits of the proposed gTLD as follows: “The Cyrillic IDN gTLD’s area of specialty is in providing registrants a local language domain name for greater inclusiveness of Internet users. A goal of the Cyrillic IDN gTLD is to carry forward the reputation of .ORG as being trustworthy, well-intentioned, valuable information, and reliable. These are the top five brand attributes of .ORG, as indicated in PIR’s annual brand research conducted in 2008-2011. PIR will operate the IDN gTLD registry in the same exemplary manner as it does for .ORG in order to carry forward the environment conducive to such positive brand recognition. The Cyrillic IDN gTLD will advance the goals of competition, differentiation and innovation in a number of ways. Creating a language-unique IDN gTLD for organizations will advance competition among TLDs that currently offer domain service to community organizations. Community organizations use .ORG today, as well as a wide selection of TLDs, ccTLDs, sTLDs. A uniquely identifiable IDN gTLD for organizations will provide the same differentiation that organizations can achieve today with .ORG, but within their own language. This distinction also benefits Internet users who are searching for language specific organizations on the Internet. With each IDN gTLD that is launched, the Internet takes a big step forward in becoming truly global. English might be a popular language in the world, but there are many people who don’t use it, or who use other languages together with it. With IDNs, the Internet will reach many more people, who previously were either completely offline, or who used the Internet only in a limited way. The Cyrillic IDN gTLD will make the Internet more user-friendly for this language community. Internet users will now be able to write a domain name or an URL exactly the way it is supposed to be written - *i.e.* without substituting the special symbols in Latin-based languages, or without transcribing non-Latin languages into English.”

On March 1, 2013, ICANN revealed its string similarity evaluation results. The <.opr> string was not included in ICANN's list of strings that may lead to public confusion. On April 11, 2013, ICANN's Government Advisory Council ("GAC") issued a Communiqué in which it provided advice to the ICANN Board of Directors concerning its objections and concerns with respect to newly-applied for strings. The GAC raised no issue with respect to the Respondent's application for <.opr> gTLD. On or about April 5, 2013, ICANN announced that the Respondent's Application had passed the initial evaluation.

5. Parties' Contentions

A. Complainant

The Objector Regtime submits that it was established in 2000. It became an ICANN-accredited domain name registrar as of March 28, 2007. Regtime is the second Russian ICANN-accredited domain name registrar and the third oldest accredited registrar for .ru country code top level domain (ccTLD). The Objector Legato was also established in 2000. The two Objectors claim that they are under common ownership and control, and that Legato is the intellectual property holding company in their group of companies.

Regtime alleges that, after the transfer of the ОПГ trademark to Legato, it has continued to use the trademark under the control of Legato. According to the Objectors, the ОПГ trademark is registered for, among other things, "telecommunications service subscription for third parties", which allegedly includes and covers registration of domain names and services for ensuring Internet access to online Internet resources in a wide range, including through subscription (the right of usage for a certain period of time) of second level domain names in the <.opr> first level root domain.

The Objectors further submit that in 2000, only ASCII domain names were available for registration in the Russian Federation. This created difficulties for Internet users in the Russian Federation and other Russian-speaking countries, as their languages utilize the Cyrillic alphabet. Many such Internet users did not understand English and had difficulty operating in a Latin alphabet environment, instead of the Cyrillic one that they were used to. There was no way to register brand names or generic words containing Cyrillic characters as ASCII domain names, which constrained development of the Internet in the Russian Federation. As a result, there was a strong demand in the Russian Federation and other Russian-speaking countries for internationalized domain names ("IDN") utilizing the Cyrillic character set.

The Objectors state that, to capitalize on the demand for fully Cyrillic domain names, Regtime licensed i-dns.net's technology in order to provide a privately offered fully Cyrillic product with both the second level and the top-level sections in Cyrillic, described by the Objectors as the "ОПГ Cyrillic IDN Product". Because Regtime was not an ICANN-accredited registry operator like the Respondent, it could not create a Cyrillic version of an existing TLD, so its product would not be in the ICANN root and would only resolve if the Internet user downloaded a browser plug-in (known as "i-client") that enabled the browser to resolve Regtime's ОПГ Cyrillic product, or the Internet user's ISP applied a patch to its system which would enable the Internet user's browser to resolve Regtime's products.

According to the Objectors, Regtime launched its ОПГ Cyrillic product in March 2001 and issued press releases announcing the availability of its fully Cyrillic products through a number of channels including PRNewswire, Yahoo, and Techweb. On May 22, 2001, Regtime commenced a large public relations campaign to publicize its ОПГ Cyrillic product in partnership with Interfax, the leading Russian International Information Group, which included a press conference with the leading Russian IT journalists and major television stations, as well as television ads on the major Russian National channels. The total expenditure by Regtime for this campaign was approximately USD 60,000. As a result, Regtime's ОПГ Cyrillic product received significant subsequent media attention, including by the BBC.

The Objectors state that Regtime continued to advertise and sell its ОПГ Cyrillic product directly through its Regtime.net and Webname.ru websites and through a large reseller network in all major cities of the Russian Federation. The resellers were actively involved in distributing the i-client plug-ins and patching their own

DNS servers so that Regtime's OPF Cyrillic products would resolve. The reseller agreements required that resellers identify on their websites and in their user agreements with purchasers of Regtime's OPF Cyrillic products that these products were not domain names that operated in the ICANN root, but rather were products created by Regtime and that purchasers needed to download plug-in software for these Cyrillic products to work.

According to the Objectors, Regtime has since 2001 sold its OPF Cyrillic products to approximately 30,000 unique customers, including many prominent clients inside and outside of the Russian Federation. As a result, Regtime's OPF Cyrillic products continued to enjoy significant media coverage including from prominent sources such as PCWeek and Computer World. This coverage publicized Regtime's OPF Cyrillic products and the fact that they were private commercial products offered by Regtime, and that Regtime was the exclusive source of the OPF Cyrillic products. Regtime also developed strategic partnerships to ensure distribution of its plugin software and resolution of its OPF Cyrillic product. Regtime partnered with the largest Internet café chain in the Russian Federation, the Café Max, to ensure that its OPF Cyrillic products resolved on all computers in this chain. Regtime also partnered with numerous ISPs such as Samara Internet who patched their servers to ensure that Regtime's OPF Cyrillic products resolved for all of their customers. As a result of these activities, over 200,000 of Regtime's plug-ins were downloaded.

The Objectors submit that the Respondent has been the registry operator for the <.org> gTLD since January 2003, almost three years after Regtime began selling and marketing its OPF Cyrillic products, and that the Respondent has brought to the market its own Cyrillic IDNs in February 2011, over 10 years after Regtime began selling and marketing its OPF Cyrillic products. Unlike Regtime's fully Cyrillic OPF products, Respondent's Cyrillic IDNs only use the Cyrillic script in the second level of Respondent's ASCII <.org> TLD. According to the Objectors, the Respondent's current IDNs are inferior to Regtime's OPF Cyrillic products in that they require Internet users to switch character sets in order to type in a single IDN domain, and do not fully meet the needs of Russian-speaking Internet users.

B. Respondent

The Respondent describes itself as a public charity dedicated to serving the public interest by strengthening the safety and integrity of the Internet, improving access to technology and expanding into underserved markets.

The Respondent submits that the <.org> gTLD was created in 1984 and is one of the Internet's original top level domains (TLDs), along with <.com>, <.net>, <.gov>, <.edu> and <.mil>. Although it is open and unrestricted, <.org> soon became the domain of choice for organizations dedicated to serving the public interest. From small, local groups to huge, global foundations, a diverse range of noncommercial organizations use <.org> to advance their missions. <.org> was originally operated by Verisign, Inc. ("Verisign"). However, in the spring of 2002, ICANN authorized and issued a Request for Proposals to succeed Verisign as the operator of the <.org> registry. Eleven proposals were received and carefully evaluated, including that of the Internet Society ("ISOC"), who had by then formed the Respondent for the express purpose of operating <.org> in a manner that would serve the needs of global organizations and "facilitate and support the continuing evolution of the Internet as a research, education and communication infrastructure, and to stimulate the involvement of the non-profit community, and others, in the continuing growth and evolution of the Internet".

The Respondent further refers to IANA's "Report on Redlegation of the .org Top-Level Domain", which contains the statement that the Internet Society was formed in 1992 and is a professional membership society with more than 150 organizational and 11,000 individual members in over 182 countries. Thus, the Internet Society is a long-established organization that is particularly knowledgeable about the needs of the organizations for which the <.org> top-level domain was intended. By establishing the Respondent as a subsidiary to serve as the successor operator of <.org>, the Internet Society has created a structure that can operate the <.org> TLD in a manner that will be sensitive to the needs of its intended users while allowing the Respondent to focus on the operation of <.org> by insulating it from the possibly distracting effects of

pursuing the Internet Society's broader mission. The Respondent asserts that it is not and has never been an affiliate of Verisign.

On January 25, 2003, Verisign transferred all of the then existing 2.6 million <.org> domain names to the Respondent. Currently, there are approximately 10.1 million registered <.org> domain names.

The Respondent contends that it has used a stylized version of .ORG as a trademark in commerce since January of 2003 – some four and one-half years prior to the effective date of the OPF trademark. Presently the Respondent has three U.S. trademarks that contain “.ORG” and are used as its logos. Unlike the OPF trademark, the class of services to which the Respondent's trademark is registered includes domain name registry services, namely, coordinating the registration of domain names for identification of users and Internet protocol addresses on the Internet; providing an on-line computer database in the field of domain name registration information, and domain name monitoring services.

6. Discussion and Findings

The Response is valid and should be upheld for the following reasons:

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 OPF trademark; and

(ii) does not unjustifiably impair the distinctive character or the reputation of the Objector's OPF trademark; and

(iii) does not otherwise create an impermissible likelihood of confusion between the applied-for gTLD and the Objector's OPF trademark.

The Panel's detailed findings are described below.

The Objectors' rights in the OPF trademark

Due to the fact that the present Objection is based on trademark rights, the first issue that the Panel has to discuss and make a determination on is the nature and scope of the Objectors' rights in the OPF trademark.

Under Article 2(e)(ii) of the Procedure, an existing legal rights objection is based on the contention that the string comprising the potential new gTLD infringes the existing legal rights of the objector that are recognized or enforceable under generally accepted and internationally recognized principles of law. Under Section 3.2.2.2 of Module 3 of the ICANN's gTLD Applicant Guidebook, “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”.

The OPF trademark is registered for the territory of the Russian Federation, so it is governed by the laws of this jurisdiction. Under Article 1477(1) of the Civil Code of the Russian Federation¹, “An exclusive right

¹ An unofficial translation of Part IV of the Russian Civil Code is provided on the official website of the Russian Federal Service for Intellectual Property (ROSPATENT)¹ at <http://www.rupto.ru/rupto/portal/883567fd-fbd2-11e0-e807-8e000200001f?lang=en>. As specified there, “The English translation of the Part IV of the Civil Code of the Russian Federation, prepared by the specialists of Rospatent, is an unofficial one intended to inform the international community, in particular, multilateral organizations, foreign IP offices, and also professionals dealing with the issues of protection and enforcement of IP rights both in the country and abroad”.

certified by a trademark certificate (Article 1481) shall be recognized to a trademark, *i.e.*, to a sign capable of individualizing of goods of legal entities or individual entrepreneurs". Under Article 1480 of the same Code, "Official registration of a trademark shall be effected by the federal executive authority for intellectual property in the State Register of Trademarks and Service Marks of the Russian Federation (State Register of Trademarks) by the procedure provided by Articles 1503 and 1505 of the present Code". Article 1481 of the same Code specifies that "A trademark certificate shall be issued for a trademark registered in the State Register of Trademarks". Under Article 1490(1) of the Civil Code of the Russian Federation, "A contract for the alienation of the exclusive right to a trademark, a license contract, and also other contracts by means of which disposition of the exclusive right to a trademark is exercised shall be made in a written form and are subject to official registration by the federal executive authority for intellectual property".

Thus, the Objectors bear the burden of proof that they have trademark rights in the OPF trademark that support the Objection, and this burden of proof may be met through the submission of official documents for the registration of the trademark or for the registration of other exclusive rights in the same trademark, issued by the competent authorities of the Russian Federation.

The Objectors have provided information that the owner of the OPF trademark at the time of filing of the Objection is the Objector Legato. The trademark rights of Legato are supported by the evidence submitted with the Objection. The Objector Regtime alleges that it uses the OPF trademark under the control of Legato, and does not provide written evidence that it has ownership rights in the same trademark. The official certificate for registration of the OPF trademark, submitted by the Objectors, does not certify any rights of Regtime in the same trademark, be it as a licensee or otherwise. The Objectors have not submitted any other written evidence which establishes any right of the Objector Regtime in the OPF trademark. The allegation that Regtime uses the OPF trademark under the control of Legato is not supported by any written evidence either, and neither do the Objectors allege the existence of a written agreement between them in this regard. In the absence of such evidence, the Panel is not satisfied on the present record that the co-objector Regtime has trademark rights in the OPF trademark.

The Objectors and the Respondent are in disagreement as to the scope of services for which the OPF trademark is registered. According to the Objectors, one of these services is "telecommunications service subscription for third parties" in International Class 35, which the Objectors allege covers registration of domain names and services for insuring Internet access to online Internet resources in a wide range, including through subscription (the right of usage for a certain period of time) of second level domain names in the OPF first level root domain. In support of their statement, the Objectors have submitted a clarifying letter from Glint Agency, LLC, which identifies this service with Basic No. 350094.

The Panel notes that the letter from Glint Agency, LLC, also refers to one of the services in International class 38, for which the OPF trademark is registered as well – the service "providing telecommunications connections to a global computer network". Objectors have not referred to this service in the Objection, but the Panel will discuss its relevance as well, as it is indeed one of the services for which the OPF trademark is registered.

The Respondent maintains that the services for which the OPF trademark is registered do not include the registration of domain names as a registry service. The Respondent submits that neither Glint Agency, LLC's letter, nor its website provide authoritative support for the allegations of the Objectors in relation to the scope of protection of the OPF trademark. The Federal Service for Intellectual Property (*a.k.a.* "Rospatent") under the Ministry of Economic Development of the Russian Federation is responsible for controlling and supervising legal protection of intellectual property within the Russian Federation, including trademarks.

The service translated by the Objectors in English as "telecommunications service subscription for third parties", is described in the original Russian version of the registration certificate for the OPF trademark as "абонирование телекоммуникационных услуг для третьих лиц". The Panel has reviewed the 9th edition of the Nice Classification (which entered into force on January 1, 2007 and was valid for the territory of the Russian Federation when the OPF trademark was applied for and registered), as available in both English and Russian languages on the official website of the Russian Federal Institute of Industrial Property

(Rospatent).² In this version of the Nice Classification, the service “абонирование телекоммуникационных услуг для третьих лиц” with Basic No. 350094, is equivalent to “arranging subscriptions to telecommunication services for others”. This is confirmed by the legal opinion of Glint Agency, LLC, submitted by the Objectors as Annex 3 to the Objection, where the service is referred to with the same Basic number and is translated in English with the same words. Taking this into account, the Panel finds that the proper English translation of the service “абонирование телекоммуникационных услуг для третьих лиц”, for which the ОПГ trademark is registered, is “arranging subscriptions to telecommunication services for others”.

The Respondent has applied to act as the registry operator for <.opr> gTLD. The role of a domain name registry is defined in the ICANN's Glossary³ in the following terms: “The ‘Registry’ is the authoritative, master database of all domain names registered in each Top Level Domain. The registry operator keeps the master database and also generates the ‘zone file’ which allows computers to route Internet traffic to and from top-level domains anywhere in the world. Internet users don't interact directly with the registry operator; users can register names in TLDs including .biz, .com, .info, .net, .name, .org by using an ICANN-Accredited Registrar.”

The comparison between the service “arranging subscriptions to telecommunication services for others” and the above description of the role of the domain name registry shows that they are dissimilar. The inclusion of the word “arranging” in the service “arranging subscriptions to telecommunication services for others” shows that this is the service provided by an intermediary or an agent whose task is to connect the providers and the consumers of telecommunication services and to facilitate the subscription to these services, while the provider of the domain names registry service itself maintains the database of registered domain names.

As to the service “providing telecommunications connections to a global computer network”, referred to in the clarifying letter by Glint Agency, LLC, the Panel notes that the original Russian description of this service, included in the registration certificate for the ОПГ trademark is “обеспечение телекоммуникационного подключения к Интернету”. The English equivalent of this service, listed with Basic No. 380037 in the version of the Nice Classification available at the official website of Rospatent is “providing telecommunications connections to a global computer network”. This is a telecommunication service where the provider offers technical means for the access of its customers to the Internet and the two-way transmission of information through a cable, mobile or wireless connection to the Internet. It is also different from the services of a registry operator.

The Panel further notes that the 9th edition of the Nice Classification explicitly mentions the service “registration of domain names [legal services]”, to be included in International Class 45, and not in International Classes 35 or 38.

In the end the Panel finds that this case does not turn on this question. Merely for the purpose of the further analysis of the case, the Panel will deem any trademark protection from which the Objectors may benefit to encompass domain-related services.

Is the registration and operation of the <.opr> gTLD an activity that infringes the trademark rights of the Objectors in the ОПГ trademark?

The Objectors allege that by virtue of the ОПГ trademark, under Russian law only the trademark registration owner has the right to provide domain name registration services and other similar services in connection with the ОПГ trademark. The Objectors maintain that the Respondent cannot operate the <.opr> gTLD without infringing the ОПГ trademark. According to the Objectors, the applied-for gTLD is identical to the

² As described on its official website at “http://www1.fips.ru/wps/wcm/connect/content_en/en/about_fips/”, the Russian Federal Institute of Industrial Property (FIPS) is a nonprofit research organization in a form of a federal government budgetary institution. The Nice Classification is available on the same website at “http://www1.fips.ru/wps/portal/IPC/MKTU9_RTf/”.

³ Publicly available at “<http://www.icann.org/en/about/learning/glossary>”.

OPF trademark. The only difference between them is the dot, which is purely functional in nature. WIPO Uniform Domain Name Dispute Resolution Policy (UDRP) Panels have consistently found that the presence or absence of dots in a domain name is typically irrelevant to the consideration of confusing similarity between a trademark and a domain name. The Objectors submit that it is unlikely that ICANN intended that only trademarks beginning with a “.” would be considered identical to an applied-for string. Even if the “.” is considered part of the applied-for string, the applied-for string is still similar to the OPF trademark, in that both consist of the Cyrillic letters OPF and the “.” at the beginning of the applied-for string is the only difference. Accordingly, the OPF trademark and the applied-for string are virtually identical in appearance, sound and meaning, in the sense that “OPF” has no meaning in Russian, other than the source origin meaning which has developed for Regtime’s services due to the Objectors’ efforts over the last 11 years. The Objectors also allege that the operation of the <.opr> gTLD is included in the scope of protection of the OPF trademark, because it covers the registration of domain names.

According to the Objectors, the Applicant’s intended use of the <.opr> gTLD would create a likelihood of confusion with the Objector’s OPF trademark as to the source, sponsorship, affiliation, or endorsement of the gTLD. Regtime has been the exclusive provider of its OPF Cyrillic products which incorporate the OPF trademark for over 11 years. In this period, all fully Cyrillic OPF products were purchased from Regtime. According to the Objectors, if the Respondent were allowed to operate the <.opr> gTLD, and offer fully Cyrillic domain names ending in “.opr”, this would create a likelihood of confusion with the Objectors’ OPF trademark as to source, sponsorship, affiliation or endorsement of the gTLD, because it would be likely that domain name registrants would be confused as to whether they were purchasing the Objector’s OPF Cyrillic product or a second level domain in the Respondent’s <.opr> gTLD, especially if both were offered by the same reseller or registrar.

The Respondent submits that the registration and use of the <.opr> gTLD does not infringe the Objectors’ rights in the OPF trademark, because the scope of this trademark does not extend to domain name registry services. With the exception of the dot, <.opr> is identical in appearance to the OPF trademark, but it is not identical in meaning. The Respondent has applied for the right to use <.opr> as a pointer to the globally used and accepted root system administered by ICANN and to manage the authoritative database of all future <.opr> top-level domain names. The Respondent further points out that “opr” is an abbreviation that stands for “организация” or “organization” in English.

Under Article 1484(3) of the Civil Code of the Russian Federation, “No one has the right to use, without the permission of the rightholder, signs similar to his trademark with respect to the goods for the individualization of which the trademark has been registered or similar goods if such use would result in a likelihood of confusion”. Under Article 1477 (2) of the same Code, “The provisions of the present Code related to trademarks shall be applied correspondingly to service marks, *i.e.*, to signs capable of individualizing work performed or services rendered by legal entities or individual entrepreneurs”. Taking these provisions into account, the Panel is of the opinion that the criteria used in Article 1484(3) of the Civil Code should be applied here in order to reach a conclusion whether the operation of the <.opr> gTLD would infringe the OPF trademark.

The Panel will first consider whether the <.opr> gTLD is *per se* identical or similar to the OPF trademark. The OPF trademark is a word trademark and consists only of the element “opr”, written with Cyrillic letters. The <.opr> gTLD contains a dot and the word element “opr”, written in Cyrillic letters. In the Panel’s view, the difference between the gTLD and the trademark, which consists of the inclusion of the dot in the gTLD is not of such significance so as to render the gTLD and the trademark dissimilar. Rather, it is more likely that Internet users will regard them as similar.

The next issue to consider is whether the services for which the <.opr> gTLD is intended to be used are identical or similar to the services for which the OPF trademark is registered. The gTLD is intended to be used for the operation of a domain name registry for the <.opr> gTLD.

The final issue to determine here is whether the use of the gTLD will result in a likelihood of confusion with the ОПГ trademark. Under the above cited Article 1484(3) of the Civil Code of the Russian Federation, the likelihood of confusion is a qualifying requirement that is assessed if the signs are identical or similar and are used for identical or similar goods or services. If the services in relation to which the <.opr> gTLD is used are not identical or similar to the ОПГ trademark, there can be no likelihood of confusion.

In order to reach a conclusion in these matters, the Panel now finds it useful to address the eight factors referred to under Section 3.5.2 of the Guidebook.

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

As discussed above, the Panel finds that the <.opr> gTLD is very similar in appearance and phonetic sound to the ОПГ trademark, the only difference between them being the addition of the dot in the gTLD.

Additionally, the <.opr> gTLD is also very similar to the <.org> gTLD, as "opr" is the Cyrillic transliteration of "org". An exact transliteration of a sign in another script is very similar to the sign because they are phonetically identical and have an appearance of mutual exchangeability to users who use both scripts.

It is well known that the <.org> gTLD is one of the most popular gTLDs. Being widely regarded as an abbreviated form of "organization", it has been continuously used for many years by millions of users globally for the registration and use of domain names in connection to different organizations, including associations, charities, environmental groups, religious institutions, schools, and cultural institutions.

As shown from the evidence provided by the Objectors themselves (see Annex 6 to the Objection), Regtime has advertised the launch of its ОПГ Cyrillic product with the following statement:

"Registration of domains in zones .ком .нет .opr in Russian starts on May 22, 2001.

On May 22, 2001 RegTime.net company starts registration and delegation of Russian names in the Internet in zones .ком .нет and .opr.

This revolutionary technology uses the International Domain Names System, developed by i-DNS.net International, supporting multilingual internet addresses in more than 59 different languages. This innovation makes it possible for Internet users to register their addresses in the form of words using the Russian alphabet, ending with combinations .ком – for companies, .нет – for Internet providers, .opr – for organizations."

The last sentence of this statement shows that Regtime has advertised its ОПГ Cyrillic product as directed to organizations, which coincides with the use of the <.org> gTLD, rather than distinguishing the two. The two strings being equivalents in different alphabets, such advertising should have actually contributed Internet users using the Cyrillic alphabet to regard Regtime's product and <.org> as mutually interchangeable in meaning as well as in appearance and sound. This conclusion is also supported by the press material from the BBC Russian Service in Annex 8 to the Objection, which states: Extensions ".ком", ".нет" and ".opr" correspond to the English ".com" - "commercial", ".net" – "network" and ".org" - "organisation" (in Russian "коммерческий", "сеть" и "организация"). The suffix ".ком" can be attributed to a commercial company, ".нет" – to an Internet provider, ".opr" – to a community organization.

At the same time, there is no evidence in the case file in the form of consumer surveys that show that consumers recognize a trademark of the Objectors in the <.opr> gTLD, rather than a Cyrillic transliteration of <.org>.

Taking all the above into account, the Panel is of the opinion that the ОПГ trademark, to the extent it may be deemed to cover domain name registry services, would have been descriptive and non-distinctive for such services. As such, it forms a rather weak basis to support the present Objection.

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

The Objectors submit that their acquisition and use of rights in the OPF trademark has been *bona fide*, as Regtime has sold thousands of OPF Cyrillic products for over 12 years, and the OPF trademark covers registration of domain names and services for ensuring Internet access to online Internet resources in a wide range, including through subscription (the right of usage for a certain period of time) of second level domain names.

According to the Respondent, the Objectors' acquisition and use of rights in a trademark in furtherance of an unauthorized alternative system outside the globally accepted Internet root system administered by ICANN is not *bona fide* because it misleads the public into believing that connection to an unauthorized alternative root system is comparable to connection to the unique system of identifiers administered by ICANN. Objectors provide a technological means that misleads the sector of the public constituting its customers into believing that connection to an unauthorized alternate system is compatible with connection to the ICANN administered global Internet. The Objectors could have likewise submitted an application to ICANN for <.opr>, but chose not to do so.

The Panel notes that, as discussed above, the OPF trademark does not include domain name registry services in its scope of protection. At the same time, the Objectors claim the opposite in the present proceeding, and Regtime has advertised its OPF Cyrillic product as a top level domain name without distinguishing it from the gTLDs approved by ICANN, as evident from Annex 9 to the Objection.

As discussed under item 1 above, it is well known that <.org> has long established itself as one of the most popular and widely used gTLDs around the world. With the introduction of its Cyrillic products to the public in 2001, Regtime announced that its OPF product is directed at organizations. Regtime has thus introduced to the public a Cyrillic equivalent of <.org>, which has become popular and attractive to the users through the efforts of others. The Objectors admit in the Objection that Regtime's Cyrillic products are not domain names, and Regtime began acting as an ICANN-accredited registrar only in 2007, so by that time it could not have had any contribution to the popularity of the <.org> gTLD on the Russian market.

Taking the above into account, the Panel is inclined to accept that the conduct of the Objectors actually shows an attempt to secure for themselves exclusive rights in relation to domain name registry services to the Cyrillic transliteration of the <.org> gTLD, the popularity of which domain has been established by others without the contribution of Regtime. In the Panel's view, such an attempt is not legitimate.

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 [respondent] or of a third party.

The Objectors submit that the relevant sector of the public recognizes the sign corresponding to the gTLD as the trademark of the Objectors, and that Regtime has enjoyed significant media coverage, which identified Regtime as the exclusive source of the OPF Cyrillic product. Many of Regtime's OPF Cyrillic products were purchased through resellers who were obligated to disclose to purchasers that the products were provided by Regtime.

The Respondent states that where a claim is based upon allegations of trademark infringement, the burden of proving a likelihood of confusion lies with the proponent of such claim, even when the claim is based upon an incontestable trademark registration. The relevant inquiry in ascertaining whether there is a likelihood of public confusion is whether a consumer using the product or service represented by the mark associates the mark with the source of a different product or service. Any analysis of whether the relevant sector of the public recognizes a given trademark as representing a given source demands an analysis of the type of goods and services offered under the trademark. If the goods are totally unrelated, there can be no infringement because confusion is unlikely. According to the Respondent, the Objectors are in the business of sublicensing software technology that permits entry into a private unauthorized alternate root zone

system. Their customers interact in a software market-for-exchange that has nothing to do with domain name registry services.

The Objectors do not engage in registry services, even in an alternate Internet root. Rather, the Objectors appear to distribute software products through resellers for operation in an alternate root. The scope of the OPF trademark does not extend to domain name registry services.

As discussed under item 1 above, the Objectors have not submitted evidence that the OPF trademark has become popular among consumers in relation to domain-related services and that consumers recognize this trademark in the <.opr> gTLD. The Panel also finds that the Objectors' advertising of their own products has not contributed for said products differentiation from the <.org> gTLD. Given the widespread use of the <.org> gTLD around the world for many years, it can be accepted to be known to and popular among most Internet users. Therefore, the Panel is not convinced that the average consumer using the Cyrillic alphabet would recognize the OPF trademark in the <.opr> gTLD. Rather, it is much more likely that consumers would understand it as the Cyrillic transliteration of the <.org> gTLD.

4. Applicant's [respondent's] intent in applying for the gTLD, including whether the applicant [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 applicant [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 Objectors allege that the Respondent had bad-faith intent in applying for the <.opr> gTLD, and that the Respondent had knowledge of the OPF trademark at the time of its application for the gTLD. The Objectors submit that the Respondent should not be allowed to usurp their nationally-protected rights and destroy the results of their extensive efforts over the last 11 years.

The Respondent rejects the allegations of the Objectors of bad-faith intent in the application for the <.opr> gTLD. It submits that it has filed its application for <.opr> gTLD, with the express intent to extend its stewardship of <.org> gTLD to the Cyrillic language community name and promote the mainstream adoption of IDNs. At the time the Respondent applied for the <.opr> gTLD (and until it received service of the Objection), the Respondent was not aware of the OPF trademark. The subject matter category of goods and services to which the OPF trademark belongs does not expressly include domain name registry services. The Objectors' submission of a letter from Dr. Shahram Soboutipour, a former PIR Advisory Council member, does not support their assertion that the Respondent has acted in bad faith in applying for <.opr>. Mr. Soboutipour's letter states only that he was "personally aware" of IDN "private party products", such as those sold by the Objectors, and "believes some others on the Board were also aware" of such products. The Respondent submits that nothing in Mr. Soboutipour's letter can fairly be read to support the Objectors' accusation that the Respondent has acted in bad faith by applying for the <.opr> gTLD.

The Respondent has submitted evidence that it has administered the <.org> registry since 2003. As a result of this use, the Respondent has become known as the provider of domain name registry services for this gTLD. In its application for the delegation of the <.opr> gTLD, the Respondent has clearly explained its intent to offer it to Internet users as a Cyrillic transliteration of <.org> gTLD.

In light of the above and in the absence of evidence to the contrary, the Panel is of the opinion that the Respondent had a *bona fide* intent in applying for the <.opr> gTLD.

5. Whether and to what extent the applicant [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.

The Objectors submit that the Respondent has not used OPF and has not made demonstrable preparations to use OPF 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 Objectors of their rights in the OPF trademark. If the Respondent is granted the <.opr> gTLD and it begins providing services under it, it is not clear what would happen to owners of Regtime's OPF Cyrillic products. If a domain name is registered in the <.opr> gTLD that is identical to an OPF Cyrillic product of Regtime, it is not certain which of them would resolve and resolve consistently. The Objectors submit that Regtime has had to stop selling new OPF Cyrillic products as of the day ICANN announced that the Respondent had applied for the <.opr> gTLD for fear that Regtime would not be able to provide the proposed services if the Respondent's application were to be approved.

The Respondent submits that its application was the culmination of a sustained and focused effort to better understand and serve the Cyrillic community. In 2008, the Respondent conducted focus group meetings in Moscow to understand the needs of the community and the receptiveness to IDNs. In 2011, it launched a Cyrillic second-level domain name using the <.org> gTLD. Together with its contracted registry backend service provider, the Respondent has devoted countless resources to develop the relevant IDN tables, ensure operational readiness, and prescribe effective and efficient policies and procedures aimed at ensuring that <.opr> will operate in the same exemplary manner that <.org> does today.

The Respondent further refers to the allegation of the Objectors that they had to stop selling new OPF Cyrillic products because they feared they would not be able to provide their services if an authorized <.opr> gTLD is established. According to the Respondent, the Objectors' assertion that they were forced to stop selling their products as of the date ICANN announced that the Respondent had applied for <.opr> "for fear that it will not be able to provide promised services, if Applicant's application is approved" is irrelevant. The cessation of business based upon the fear of the occurrence of some future event is not fairly attributable to anyone other than the Objectors. The Respondent submits that the Objectors have submitted no evidence that their software products, which operate in an alternative root, "may not resolve consistently" if ICANN approves and delegates the <.opr> gTLD.

The Panel is of the opinion that the Respondent has made demonstrable preparations to use the sign corresponding to the gTLD in connection with a *bona fide* offering of goods or services in a way that does not interfere with the exercise by the Objectors of their trademark rights. The application for this gTLD includes the payment of a significant evaluation fee to ICANN and requires the availability of significant technical, operational and financial resources. The Respondent has applied for this gTLD as a Cyrillic transliteration of <.opr> gTLD, and as found under item 4 above, it has made its application in good faith.

Whether the operation of the <.opr> gTLD would actually interfere with the operation by the Objector Regtime of its services is a technical issue that is beyond the scope of the present proceeding and for which the Objectors have submitted no evidence. Nevertheless, given that Regtime has adopted a business model that is alleged to deviate from the standards and policies of ICANN for a uniform root and has chosen not to apply for the <.opr> gTLD itself, the Panel does not find that the operation by the Respondent of the <.opr> gTLD in compliance with the standards of ICANN could represent an activity that could be regarded as illegitimate *vis-a-vis* Regtime. It should also be noted in this regard that the Respondent has offered to alleviate the concerns of Objectors and their customers, and has offered to make available to the users of Regtime's OPF Cyrillic products identical registrations in the new <.opr> gTLD for the first year at no charge to the registrar of the domain names, subject to applicable ICANN requirements.

6. Whether the applicant [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 applicant [respondent] is consistent with such acquisition or use.

According to the Objectors, the Respondent has no trademark or other intellectual property rights in OPF, and has not used OPF as a trademark.

The Respondent accepts that it does not hold a OPF trademark, and refers to the fact that it has used a stylized version of .ORG in commerce since January 2003, and that it is the holder of three U.S. trademarks,

which contain “.org,” and their scope of protection specifically includes domain name registry services. Under 15 U.S.C. § 1057(b), these certificates are *prima facie* evidence of the validity of the registered marks, their registration, the Respondent’s ownership of these marks and its exclusive right to use them in commerce in connection with the goods and services for which they are registered.

The Respondent has provided evidence that it is the owner of the following trademarks containing “.org”:

- the combined trademark “.org” with reg. No. 3,044,328, registered for the territory of the United States of America on January 17, 2006 for the following services in International Class 42: “domain name registry services, namely, coordinating the registration of domain names for identification of users and internet protocol addresses on the Internet; providing an online computer database in the field of domain name registration information, and domain name monitoring services.” This trademark was first used in commerce on January 3, 2003;

- the combined trademark “.org >> advance your mission” with reg. No.3,471,789, registered for the territory of the United States of America on July 22, 2008 for the following services in International Class 45: “domain name registry services, namely, coordinating the registration of domain names for identification of users and internet protocol addresses on the Internet; providing an online computer database in the field of domain name registration information, and domain name monitoring services.” This trademark was first used in commerce on January 17, 2008; and

- the combined trademark “.org>” with reg. No. 3,471,790, registered for the territory of the United States of America on July 22, 2008 for the following services in International Class 45: “domain name registry services, namely, coordinating the registration of domain names for identification of users and internet protocol addresses on the Internet; providing an online computer database in the field of domain name registration information, and domain name monitoring services.” This trademark was first used in commerce on January 17, 2008.

Therefore, the Panel finds that the Respondent has trademark rights for domain name registry services in the sign .ORG that, as discussed under item 1 above, is similar to the <.opr> gTLD.

The Panel finds that the <.opr> gTLD is likely to be regarded as the Cyrillic transliteration of the <.org> gTLD. The <.org> gTLD has been operated in good faith by the Respondent since 2003. In light of this, the Panel is of the opinion that the offer by the Respondent to the public of the <.opr> gTLD would be consistent with the Respondent’s offering of services under the <.org> gTLD.

7. Whether and to what extent the applicant [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 applicant [respondent] is consistent therewith and *bona fide*.

The Objectors submit that the Respondent has not been commonly known by ОПГ, and no purported or likely use of the <.opr> gTLD by the Respondent can be *bona fide*. The Respondent has never offered fully Cyrillic IDNs. The Objectors further state that the Respondent will likely argue that it is commonly known as “.org” by virtue of its long history as registry operator for the <.org> gTLD and because <.opr > is simply the Cyrillic transliteration of <.org> as it states in its application for the <.opr> gTLD. However, according to the Objectors, <.org> is not the same as ОПГ. <.org> is an ASCII TLD which is commonly thought to stand for “organization”. <.opr> is completely different, as it is in Cyrillic as opposed to Latin, and because “ОПГ” has no meaning in Russian and is not commonly thought to stand for anything other than the Objectors’ services. There is no evidence that any Internet user would assume that a <.opr> Cyrillic IDN is the same as a <.org> gTLD or is even operated by the same registry operator. If <.opr> is a transliteration of <.org>, it would fail the String Confusion Evaluation criteria as set forth in Section 2 of the Guidebook. ICANN has published its string similarity review on February 24, 2013, and <.org> and <.opr> were found not to be in contention, so the two are not equivalents of each other.

The Respondent contends that it uses its .ORG trademark as its primary company logo. From the time it began operating the <.org> gTLD registry in 2003 to the present, the Respondent has successfully used its trademarks, including those containing “.ORG” for the purpose of identifying the <.org> gTLD as a trusted Internet platform. The Respondent’s acquisition of a Cyrillic <.org> gTLD in the ICANN root is fully consistent with its past and intended future use. The Objectors’ argument that “ОПГ has no meaning in Russian” is incorrect. The Cyrillic letters “ОПГ” are the first three letters of the Russian word “организация”, which means “organization”. The Objectors’ argument that ICANN’s contention set results, which revealed that <.opr> was not in contention with any other applied-for gTLD is wrong as well, as a string contention occurs when there are “two or more applicants” for an identical or similar string.

The Panel takes into account that <.org> gTLD has been operated in good faith by the Respondent since 2003 and that the Respondent has used its “.ORG” trademark for domain name registry services since 2003. In view of this, the Panel is of the opinion that the Respondent has become commonly known as a service provider for the <.org> gTLD and has rights and legitimate interests in respect of it. The Panel finds that “.org” is a sign that is very similar to and corresponds to “.opr”, as the only difference between them is that they are written in different alphabets and the latter is likely to be regarded as the Cyrillic transliteration of <.org>, as more fully discussed above. Contrary to the Objectors’ allegation that <.opr> is not the same as <.org>, as “opr” has no meaning in Russian, the Panel agrees with the Respondent that “opr” is a shortened form of “организация” or “organization” in English, and this has been confirmed by the evidence submitted by the Objectors in Annexes 6 and 8 to the Objection.

In view of the above, the Panel is satisfied that the Respondent has been commonly known by a sign corresponding to the <.opr> gTLD, and that the purported or likely use of the <.opr> gTLD is consistent therewith and *bona fide*.

8. Whether the applicant’s [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.

According to the Objectors, the Respondent’s intended use of the <.opr> gTLD would create a likelihood of confusion with the ОПГ trademark as to the source, sponsorship, affiliation, or endorsement of the gTLD, because it would be likely that domain name registrants would be confused as to whether they were purchasing Regtime’s ОПГ Cyrillic product or a second level domain in the Respondent’s <.opr> gTLD, especially if both were offered by the same reseller or registrar. The Objectors also allege that the use of the <.opr> gTLD would create confusion in the marketplace with regard to all existing users of the Objectors’ ОПГ Cyrillic product, as it would be possible that two separate entities could register the same Cyrillic string as Objector’s ОПГ Cyrillic product and a second level domain in the Respondent’s <.opr> gTLD. If that were to happen, it would not be clear whether Objector’s ОПГ Cyrillic product or the identical second level domain name in the Respondent’s <.opr> gTLD would resolve, which could create further confusion and harm the thousands of consumers who have already purchased Regtime’s ОПГ Cyrillic product.

According to the Respondent, the *raison d’être* for trademark protection is to avoid public confusion by accurately identifying the source of the goods or services offered in connection with the mark. The purpose of trademarks has remained constant and limited - identification of the manufacturer or sponsor of a good or the provider of a service. The Respondent further submits that, since <.opr> does not convey source information, approval of the Respondent’s application and delegation of the <.opr> gTLD would not create a likelihood of confusion by suggesting that the Objectors are the source, sponsors, affiliates, or otherwise endorse the gTLD.

As discussed under item 1 above, even if domain name registry services had been within the scope of protection of the trademark, the Panel is of the opinion that the trademark would have been descriptive and non-distinctive in relation to them. Moreover, consumers are more likely to understand the Objectors’ ОПГ trademark as the Cyrillic transliteration of the <.org> gTLD, an understanding for which the Objectors may need to bear the consequences.

7. Decision

For the above reasons, the Objection is rejected.

[signed]

Assen Alexiev
Sole Panel Expert
Date: August 23, 2013