

3.2.2.2

Legal Rights Objection

Any 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~~ abused by the applied-for gTLD must be included in the filing.

An intergovernmental organization (IGO) is eligible to file a legal rights objection if it meets the criteria for registration of a .INT domain name¹:

- b) An international treaty between or among national governments must have established the organization; and
- b) The organization that is established must be widely considered to have independent international legal personality and must be the subject of and governed by international law.

The specialized agencies of the UN and the organizations having observer status at the UN General Assembly are also recognized as meeting the criteria.

3.5.2

Legal Rights Objection

In interpreting and giving meaning to GNSO Recommendation 3 ("Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law"), a DRSP panel of experts presiding over a legal rights objection will determine whether the potential use of the applied-for gTLD by the applicant takes unfair advantage of the distinctive character or the reputation of the objector's registered or unregistered trademark or service mark ("mark") or IGO name or acronym (as identified in the treaty establishing the organization), ~~or~~ unjustifiably impairs the distinctive character or the reputation of the objector's mark or IGO name or acronym, ~~or~~ otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector's mark or IGO name or acronym, or was filed for the purpose of triggering an private auction proceeding designed to obtain a payment from the objector.

In the case where the objection is based on trademark rights, the panel will consider the following non-exclusive factors:

- 1. Whether the applied-for gTLD is identical, ~~or~~ similar, or a translation or transliteration of (including in appearance, phonetic sound, or meaning), to the objector's existing mark.
- 2. Whether the objector's acquisition and use of rights in the mark has been bona fide.
- 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, including but not limited niche market fame, of the applicant or of a third party.
- 4. Applicant's intent in applying for the gTLD, including whether a. the applicant, at in advance of the time of application for the gTLD, ~~had knowledge of the~~ conducted a trademark search for trademarks corresponding to the applied-for string; b. if the objection is based on common law rights, whether or not the applicant objector's mark, ~~or could not have reasonably been~~ knew or should have known ~~unaware of that~~ the objector's mark; c. and including whether the applicant has engaged in a pattern of conduct whereby it applied for or operates TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others; d. whether or not the applicant has engaged in past "private auctions" designed to raise funds from competing applications; or e. whether or not the applicant, or any entity, officer, or board member of the applicant, has been named in more than five UDRP complaints in the last three years as a Respondent in which the Respondent was the losing party.
- 5. In the event that the string does not correspond to a famous trademark owned by the objector, wWhether and to what extent the applicant has used, or has made demonstrable preparations to use, the sign corresponding to the gTLD in connection with a bona fide offering of unrelated goods or services.

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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.

6. Whether the applicant has marks or other intellectual property rights in the sign corresponding to the gTLD, and, if so, whether any acquisition of such a right in the sign, and use of the sign, has been bona fide, and whether the purported or likely use of the gTLD by the applicant is ~~consistent with~~ strictly corresponds to such acquisition or use the applicant's marks or other intellectual property rights. Failure of the applicant to include registration and use restrictions prohibiting registration and use of the string in conjunction with the goods and services covered by the Objector's trademarks shall be conclusive evidence that applicant does not have defenses under this paragraph.
7. ~~Whether and to what extent the applicant has been commonly known by the sign corresponding to the gTLD, and if so, whether any purported or likely use of the gTLD by the applicant is consistent therewith and bona fide. Deleted: this can be gamed with mere corporate filings – the issue is trademarks, not company names.~~
8. Whether the applicant's intended use of the gTLD would create a likelihood of confusion with the objector's mark as to the source, sponsorship, affiliation, or endorsement of the gTLD. Failure of the applicant to include registration and use restrictions prohibiting registration and use of the string in conjunction with the goods and services covered by the Objector's trademarks shall be conclusive evidence that applicant's intended use of the gTLD will create a likelihood of confusion with the objector's mark as to the source, sponsorship, affiliation, or endorsement of the gTLD.

In the case where a legal rights objection has been filed by an IGO, the panel will consider the following non-exclusive factors:

1. Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound or meaning, to the name or acronym of the objecting IGO;
2. Historical coexistence of the IGO and the applicant's use of a similar name or acronym. Factors considered may include:
 - a. Level of global recognition of both entities;
 - b. Length of time the entities have been in existence;
 - c. Public historical evidence of their existence, which may include whether the objecting IGO has communicated its name or abbreviation under Article 6ter of the Paris Convention for the Protection of Industrial Property.
3. Whether and to what extent the applicant has used, or has made demonstrable preparations to use, the sign corresponding to the TLD 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 of the objecting IGO's name or acronym;
4. Whether and to what extent the applicant has been commonly known by the sign corresponding to the applied-for gTLD, and if so, whether any purported or likely use of the gTLD by the applicant is consistent therewith and bona fide; and
5. Whether the applicant's intended use of the applied-for gTLD would create a likelihood of confusion with the objecting IGO's name or acronym as to the source, sponsorship, affiliation, or endorsement of the TLD.