

LEGAL RIGHTS OBJECTION

Sina Corporation v. Tencent Holdings Limited
Case No. LRO2013-0040

1. The Parties

The Objector/Complainant (the “Objector”) is Sina Corporation of Beijing, China, represented by Hogan Lovells International LLP, France.

The Applicant/Respondent (the “Applicant”) is Tencent Holdings Limited of Shenzhen, China, represented by CSC Digital Brand Services, Stockholm, Sweden.

2. The Domain Name and Registrar

The applied-for gTLD string (the “String”) is <.微博>.

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 ICANN New gTLD Application Guidebook (the “Guidebook”) and the Dispute Resolution Procedure (the “Procedure”).

In accordance with Article 9 of the Procedure, the WIPO Center completed the review of the Objection on March 26, 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 Applicant of the Objection, and the proceedings commenced on April 17, 2013. In accordance with Article 11(b) and relevant communication provisions of the Procedure, the Response was filed with the WIPO Center on May 16, 2013.

On May 23, 2013, the WIPO Center acknowledged the receipt of the mutual agreement between the Objector and the Applicant to the appointment of a three-member Panel. Both Parties separately submitted to the Center the names of three candidates from the Center’s List of Experts.


The WIPO Center appointed Dr. Hong Xue as the Presiding Panelist and Mr. Matthew Harris and Ms. Susanna H.S. Leong as the Co-Panelists 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. On July 14, 2013, the Objector filed the Additional Submissions and Supplemental Evidence to the WIPO Center. The Panel, after being informed by the WIPO Center, accepted the Objector's additional submissions and granted seven days for the Applicant to respond. On July 18, 2013, the Applicant filed the Response to the Objector's Additional Submissions with an Annex.

4. Factual Background

The Objector, Sina Corporation, as stated in the Objection, is a "Chinese online media company for Chinese communities around the world." On August 14, 2009, the Objector introduced and since then has been operating the micro-blogging services in China. These services had 503 million registered users by the end of 2012 and are provided from a website that uses the domain name <weibo.com>. "Weibo" is the Chinese pinyin transliteration (*i.e.* the transliteration of Chinese characters into the Roman alphabet) of "微博."

The Objector holds Chinese Trademark Registration (No. 7649615) for the mark "微博", registered on December 28, 2010 in Class 35. The Objector has also registered in China a series of the trademarks for "新浪微博" and "  微博" the earliest of which has a registration date of January 21, 2011.

The Objector states that it has dedicated significant resources and investment to advertising its "微博" trademark and its pinyin equivalent. In addition to <weibo.com>, the Objector has registered a number of additional domain names either incorporating "微博" in Chinese characters (under the few extensions where the registration of Internationalized Domain Names is possible) or the term "weibo". The Objector contends that the applied-for new gTLD string <.微博> infringes its existing legal rights.

The Applicant, Tencent Holdings Limited, provides value-added Internet, mobile and telecommunication services and online advertising. There are 990 million users with accounts for the Applicant's instant messenger program, QQ. In April 2010, the Applicant launched "Tencent 微博", which is a micro-blogging site with about 373 million users and "available inside every one of Applicant's major social products". The Applicant has advertised with respect to the "Tencent 微博" brand and the services designated by this trademark. The Applicant has registered in China a series of TENCENT 微博 T.QQ.COM" (and device) trademarks from June 2012. The Applicant also holds a series of trademark registrations for the mark TENCENT WEIBO (and device) in China Taiwan Region, Australia, Europe, Japan, Russian Federation, The Republic of Korea, Singapore and China Hong Kong Special Administrative Region from October 2011. The Applicant contends that its use of the term "微博" predates the opening gTLD application process on January 12, 2012 and has established rights in the term "微博" before applying for the new gTLD string <.微博>. The Applicant has also applied for the <.weibo> gTLD.

The Applicant states that its use of the term "微博" has been *bona fide* and legitimate. "微博" is the descriptive word of micro-blog service, describing functions and characteristics of micro-blog service. The Objector's Chinese Trade mark Registration (No. 7649615) for "微博" that is currently under dispute on the ground that it is "too generic" and is lacking in distinctiveness.

5. Parties' Contentions

A. The Objector

The Objector raises arguments under each of the eight non-exclusive factors relevant to a determination under the ICANN gTLD Applicant Guidebook (the "Guidebook") and the Procedure. The Objector requests that the applied-for gTLD <.微博> not be delegated to the Applicant.

B. The Applicant

The Applicant's arguments are also based on the eight factors specified in the Guidebook and the Procedure.

The Applicant requests that the Objection be denied. Should the Objection be denied, the Applicant further requests a refund of the paid fees, as far as applicable.

6. Discussion and Findings

The Guidebook provides in the Module 3 the Legal Right Objection, which allows the right holders to object the applied-for gTLD strings that they believe infringe their existing legal rights that are recognized or enforceable under generally accepted and internationally recognized principles of law.

Under the Dispute Resolution Principles (Standards) specified by the Guidebook, Section 3.5.2, a panel presiding over a legal rights objection involving trademark rights 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, or unjustifiably impairs the distinctive character or the reputation of the objector's mark, or otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector's mark.

The Panel has carefully reviewed both Parties' submissions and made the assessment according to the Guidebook's Principles and Standards, particularly taking into consideration the eight non-exclusive factors, provided in the Guidebook, Section 3.5.2.

(1) Summary of the Findings

Before analyzing each factor, the Panel wishes to summarize its discoveries by looking at the facts of the case.


(a) The Objector's Trademark

The Panel finds that the Objector holds the trademark for 微博, which was registered in China on December 28, 2010 (Registration Number 7649615). Under the Chinese Trademark Law, a holder of the registered trademark enjoys the exclusive right to use the mark. Therefore, the Objector's trademark right over 微博 is the legal basis for the Objector to file the Legal Right Objection.

The Applicant contends that the Objector's Chinese Trademark Registration (No. 7649615) for 微博 is currently under dispute "and is subject to possible cancellation proceedings". The Panel reviewed the pertinent evidence presented by the Applicant and finds, on the "Detailed Information of Trademark" (Registration No. 7649615), that the Objector's trademark 微博 is in the process of dispute. But the Applicant did not provide more information on the dispute, such as why the trademark is in dispute and what the current status of the dispute adjudication is. Based on the information available so far, the Panel finds that the Objector's trademark registration for 微博 (Registration No. 7649615) is *prima facie* legitimate and valid until December 27, 2020.

The Applicant contends that the Objector's trademark registration for 微博 (Registration No. 7649615) was "incorrectly registered as it is too generic and is lacking in distinctiveness." However, this is denied by the Objector, who claims that 微博 is the one that is associated in the minds of at least the Chinese public with the Objector. Further, generic or descriptive terms can be registered as trademarks, provided that they have in fact acquired a distinctive character, *i.e.* they are capable of distinguishing the sources of goods or services, as a result of the use made of them. The Objector's trademark 微博 (Registration No. 7649615) is registered in Class 35 on the services of "advertising, online advertising on data communication network, exhibiting goods on communication media for retailing, market analysis, public opinion poll, data retrieval (for others) in computer files, computer database information enrollment, computer database information classification and computer database information systemization." Until the conclusion of this case of Legal Right Objection, the Objector's trademark 微博 (Registration No. 7649615) has not been invalidated or cancelled by the Chinese trademark authorities. The Objector, as the holder of the registered trademark, still enjoys the exclusive right under the Chinese Trademark Law.

The Applicant provided a fair amount of evidence to show that the term “微博” is used to describe the phenomenon of micro-blogging in China and is shared by many micro-blog service providers. According to the Applicant, the term “微博” is often used in a descriptive manner and there are various market players who are using the term “微博”.

However, the Chinese Trademark Office ruled in the Decisions on Opposition against Trademark  微博 (No. 9337632) on May 21, 2013, that the opponent’s claims that “微博” is a generic name of the platform for information sharing and exchanging, and the registration and use of the opposed mark would mislead the public and violate Article 10.1(8) of the Chinese Trademark Law, are not supported by the evidence submitted.

The Chinese trademark authority’s recent rulings reconfirm, to some extent, the distinctive character and registerability of “微博” and shows that the validity of the Objector’s trademark registration for 微博 (Registration No. 7649615) is unlikely to be challenged in the near future.

Although the Panel does not rule out the possibility that the mark 微博 could be invalidated by the Chinese trademark authorities for losing its distinctiveness, the proceeding of the Legal Right Objection only resolves the conflicts between existing legal rights and the applied-for gTLD strings.

Given this, the Panel is of the view that this decision can and should, therefore, proceed on the basis of current legal status of the Objector’s mark.

(b) The Applicant’s Rights

The Applicant contends that its micro-blogging services are “marked by the brand 微博 or its pinyin equivalent WEIBO.” However, it is apparent from the Applicant’s submissions that the brand or trademark that the Applicant consistently uses for its services is TENCENT 微博” or TENCENT WEIBO, not “微博” or “weibo” *per se*. Further, the Applicant’s trademark registrations acquired in a number of countries or regions all consist of “Tencent” in combination with “微博” or “weibo”.

Indeed, it is inherent in the Applicant’s claims that the terms “微博” and “weibo” are descriptive of the phenomenon of micro-blogging in China and is shared by many micro-blog service providers, and that the Applicant maintains that the distinguishing feature of its marks is the term “Tencent”, not “微博” or “weibo” alone. Accordingly no trademark rights subsist in “微博” or “weibo” alone for the Applicant.

(c) The Applicant’s Potential Use

The Panel notes that the Applicant may assert that it makes descriptive use or other legitimate use of the Objector’s mark 微博, irrespective of whether “微博” will be conclusively determined to be a generic or descriptive term or not. However, the Panel finds, primarily from the Applicant’s new gTLD Application submitted to ICANN for the string <微博>, that the Applicant’s potential use of the term “微博” as a gTLD unjustifiably impairs the distinctive character of the Objector’s mark 微博 that is currently legitimately registered.

According to the Applicant’s Application, the new gTLD space is planned to be used solely for the Applicant’s micro-blogging site and services.

The Applicant states in its New gTLD Application for <微博>, “Tencent intends to use the <微博> gTLD to allow for more convenient and innovative communication between users of Tencent’s Weibo micro-blogging site”; “Tencent Holdings Limited (Tencent) intends to utilise the new gTLD to allow people to communicate easier through its micro-blogging platform”; “[T]he new <微博> gTLD will promote and strengthen the Tencent Weibo services”; “[T]he <微博> gTLD will simplify how Internet users interact with Tencent’s Weibo services by providing a distinctive domain space”; “Tencent has the ability to create second-level domain names on demand which are relevant to its customer base and services and products. These domain names will be licensed to verified users of Tencent’s Weibo services”; “it is foreseen that communication to

the Internet community of the existence of the proposed new gTLD and encouragement to utilise the trusted site will contribute towards making it a popular home for Tencent's Weibo services.”

In addition, the Applicant states that <.微博> is a restricted gTLD and “registration for the <.微博> gTLD will be in accordance with its stringent registration policy”. The Eligible Registrants must be: “(i) an Affiliate entity of Tencent; or (ii) an organisation explicitly authorised by Tencent; or (iii) a natural person explicitly authorised by Tencent. If the Registrant does not meet one of the above eligibility criteria, there is no entitlement to register a Domain Name under the <.微博> gTLD. If the Registrant ceases to be eligible at any time in the future, the Registry may cancel or suspend the licence to use the Domain Name immediately.”

The Panel notes that, once an application for a new gTLD is approved and delegated by ICANN, the commitments made by the Applicant in the Application will be incorporated into the New gTLD Base Agreement between the Applicant and ICANN and become binding to the Applicant.

In the circumstances, it is legitimate for the Panel to conduct its assessment on the assumption that the String would be used by the Applicant in the manner described in the Application.

In that respect the Panel notes that the Application asserts that <.微博> will be used as “a distinctive domain space” for the Applicant’s services, rather than a generic and open domain space for any users or any micro-blogging services. In other words, notwithstanding its claims about the descriptive nature of the term, the majority of the Panel concludes that the Applicant appears to plan to use the term in a non-descriptive sense for its own services.

Although a new gTLD applicant has the freedom to choose its business model, the Applicant’s plan to use the term “微博” in the String to promote its own brand Tencent and its micro-blogging services in the view of the majority of the Panel will inevitably impair the distinctive character of the Objector’s mark 微博.

Even if the Objector cannot enforce its trademark rights against the descriptive use or other legitimate use of the term “微博”, the majority of the Panel are of the view that the Applicant planned use of the new gTLD <.微博> directly conflicts with the Objector’s trademark registration 微博 (Registration No. 7649615). In particular, the Objector’s mark 微博 is registered on the services, *inter alia*, data retrieval (for others) in computer files, computer database information enrollment, computer database information classification and computer database information systemization. The Applicant’s planned running for the new <.微博> name space involves the above-mentioned services.

In the circumstances and on balance, the majority of the Panel concludes that this Legal Rights Objection should be sustained.

(2) Eight Factors

Having summarizing the discoveries, the Panel will go through all eight non-exclusive factors set forth in the Guidebook, Section 3.5.2, to examine the findings and conclusion. The Guidebook does not provide how a panel draws the conclusion from the assessment of the eight factors. It is clear that a panel does not need to find in favor of the objector in all eight factors to support the objection.

(a) Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound, or meaning, to Objector’s existing mark.

The Objector’s registered mark is 微博 and the applied-for gTLD string is <.微博>. Apart from the “dot” before the TLD string that carries no weight for the purpose of comparison, the string is identical with the Objector’s mark.

Hence the Panel finds that this factor weighs in favor of Objector.

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

The Applicant acknowledges that the Objector is using 微博 for its Sina service and has a large market presence with respect to its Sina Weibo service. But the Applicant contends that the Objector's statement that it was the first creator and developer of micro-blogging service in China since 2009 is not true. In this respect it claims it launched the micro-blogging-like website "www.taotao.com" in early 2007 under the name "滔滔微博" (which in pinyin is "taotao weibo"), but that was shut down due to some "operating problems" on January 26, 2010. It contends, that "statements made by the Objector, as to its 'exclusive' rights in the term cannot be considered *bona fide*".

There are a number of problems with the Applicant's contentions. First, although the Applicant refers to a Wikipedia entry to support its claim that it launched "www.taotao.com" in early 2007, there is no evidence before the Panel that the term "微博" was used in connection with the service¹.

Second, even if the question is whether the Objector was entitled to have obtained any trademark rights in this term, that is somewhat different from the question whether the Objector's trademark application or its use of that trade mark was *bona fide*. There would appear to be claimed by the Applicant that the Objector acted in bad faith when seeking to register these trademarks or when subsequently using them.

Accordingly the Panel rejects any claim that the Applicant acquired or has used the trademark registration for the mark 微博 (No. 7649615) on December 28, 2010 in bad faith. The Objector's application for and acquisition of that trade mark was clearly based upon its own use of that term for its services that had been launched in August of the previous year.

Given this, the factor if it is of any real weight at all in this case, weighs in favor of Objector.

(c) 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 Objector, of Applicant or of a third party.

There is clearly a dispute between the Parties as to whether the term "微博" is generic or descriptive of micro-blogging services.

The Objector has provided evidence that the Chinese trademark authorities had concluded on more than one occasion that the Applicant had failed to show that these terms were descriptive of those services. But that is not quite the same thing as saying that the mark is distinctive of those services.

Both Parties made many submissions regarding their market share and the public recognition and reputation of their relevant marks. However, so far as the use of the terms "微博" alone are concerned, the evidence is not conclusive. For example, the Objector has provided survey evidence that the term "微博" was primarily associated with the Objector by 44% of the sampled public in a number of Chinese cities. However, it is unclear whether that amounts to recognition of "微博" as a sign of the Objector or merely reflects that the Objector is the largest provider of micro-blogging services in China.

The Panel therefore finds that on the evidence before it this factor is inconclusive one way or the other.

(d) Applicant's intent in applying for the gTLD, including whether Applicant, at the time of application for the gTLD, had knowledge of Objector's mark, or could not have reasonably been unaware of that mark, and including whether 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.

¹ The Panel notes that the term "微博" or "weibo" does not seem to appear on the records for the "www.taotao.com" website to be found on the "Wayback Machine" Internet Archive.

The Applicant was clearly aware of Objector's micro-blogging service at the time of applying for the gTLD String. But the Applicant contends that what it clearly knows is "微博/ weibo" refers to a general term representing the micro-blog service rather than the Objector itself."

Further, it is highly implausible that the Applicant did not actually know of the Objector's registered trademarks, including its mark for 微博 alone at the time of application for the gTLD, given the Parties have been in the disputes in relation to the Chinese registrations of those marks.

However, the Applicant contends that "微博/weibo" refers to a general term representing the micro-blog service rather than the Objector itself and it also appears to have been operating its own micro-blogging services using a name that incorporates that term for almost two years before applying for the gTLD string.

The Objector raises the point that although the Applicant has other brands that are more significant to it than TENCENT WEIBO, it is only "微博" and "weibo" that have been applied for as gTLDs. The inference it appears to be asking the Panel to draw from this is that the Applicant has chosen those terms because they are being used by the Objector.

However, the Panel is of the view that it is not persuaded by the Objector's claims that the gTLDs have been applied for in bad faith.

Accordingly, this is a factor which if anything weighs in favor of the Applicant.

(e) Whether and to what extent Applicant 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 Objector of its mark rights.

The Panel sees three key elements from this factor. First, whether the Applicant has provided the service *bona fide* before the application for gTLD? The answer is yes. The Applicant has been operating its micro-blogging services under the brand of "Tencent 微博/Weibo" since April 2010. As stated by the Applicant, "Tencent 微博" has been coexisting with "Sina 微博" in the market for years. The Applicant, therefore, has made a *bona fide* provision of information services by using its sign "Tencent 微博/Weibo".

Second, whether the Applicant has been using the "sign corresponding to the gTLD" in provision of the services? The answer is no. The Applicant's mark is actually TENCENT 微博, which is not "corresponding" to the gTLD string. The Applicant has not been using the term "微博" alone as its brand for the provision of services.

Third, whether the Applicant's provision of service interferes with the Objector's right? The Panel finds that the Applicant's provision of service by using the mark TENCENT 微博 does not interfere with the Objector's right as far as the term "微博" is merely used descriptively, however the Applicant's purported use of 微博 as a brand for its services in the gTLD space would be interfering to the Objector's right.

Accordingly, this is not a factor that may simply be deemed in favor of either Party.

(f) Whether 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 Applicant is consistent with such acquisition or use.

For the purpose of assessment of this factor, the Panel splits this factor into three parts, *i.e.* "the sign corresponding to the gTLD", "acquisition and use of the right in the sign *bona fide*", and "purported use consistent with the acquisition or use."

As presented before, the Applicant has registered in China a series of TENCENT 微博 T.QQ.COM (and

device) trademarks from June 2012, and also holds a series of trademark registrations for the mark TENCENT WEIBO (and device) in a number of countries and regions from October 2011. Although these registered trademarks were acquired and have been used *bona fide*, they are not corresponding to the gTLD string applied by the Applicant.

There is no evidence showing that the Applicant has any mark or intellectual property rights in “微博” alone. Based on the gTLD application, the Applicant, however, plans to use gTLD <微博> as a brand name for its own services, which purported use of “微博” is not consistent with the trademark rights that it has acquired.

Given the complexity of this factor, the Panel finds that it is oversimplified to weigh this factor in favor of either Party.

(g) Whether and to what extent 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 Applicant is consistent therewith and *bona fide*.

This factor, once assessed, is not very different from factor (f), except that the Applicant is not commonly known as “微博” alone.

Like factor (f), the Panel finds that it is oversimplified to weigh this factor in favor of either Party.

(h) Whether Applicant’s intended use of the gTLD would create a likelihood of confusion with Objector’s mark as to the source, sponsorship, affiliation, or endorsement of the gTLD.

The Panel notes that the Objector's trademark registration for 微博 (No. 7649615) covers a broad scope of services, e.g. from advertising to database management. It is clear that the Applicant's planned provision of the services through the new gTLD space does involve the database update, classification or other management, therefore fall in the scope of the Objector's trademark registration. Accordingly, the Applicant's intended use of the gTLD <微博> as the brand for its micro-blogging and other services falls in the scope of the Objector's trademark registration for 微博 (No. 7649615) and could create a likelihood of confusion with the Objector's mark as to the source, sponsorship, affiliation, or endorsement of the gTLD < 微博>.

Hence the Panel finds that this factor on the evidence before it weighs in favor of Objector.

Through assessing all eight factors under Section 3.5.2 of the Guidebook, the Panel rules for the Objector.

7. Decision

For the foregoing reasons, the Objection is upheld.

[signed]

Hong Xue
Presiding Panelist
Date: August 28, 2013

[signed]

Susanna H.S. Leong
Panelist
Date: August 28, 2013

Dissenting Opinion

It is with some hesitation that I have formed the view that it is necessary to submit a formal dissent in these proceedings. It is a “formal” dissent because the outcome in this case may be right, but I do not think the case can be decided for the Objector as matters currently stand. It is “with hesitation” because my dissent depends upon the way in which certain Chinese characters are understood by Chinese readers and also in part upon issues of Chinese law and procedure, in respect of which both of my fellow panelists are likely to be in a better position to comment.

Nevertheless, the difficulty I face is that at the heart of this case there appears to be a fundamental dispute between the Parties as to the extent to which the terms “weibo” and “微博” are descriptive or generic in the Chinese language in relation to micro-blogging services. The Objector emphatically says that it is not and refers to decisions of the Chinese trade mark authorities that appear to support its position. In contrast, the Applicant says that it is descriptive and also claims that it has used the term in its generic sense for some time.

My understanding of my fellow panelists’ position is that they say this case can be decided in the Objector’s favour without having to form a view on who is right on this issue of whether these terms are generic. Their position appears to be that the Objector has at least one *prima facie* valid trade mark in China for the term “微博”, that it is in China that the Applicant has conducted most of its business in the past and that it is to the Chinese market (albeit as part of a slightly larger Chinese speaking market) that the Applicant intends to direct its services under the <微博> gTLD. Given this (if my understanding of the argument is correct) the use of the gTLD will infringe and/or unduly impinge on that mark.

Although I agree that the perception of the term by those who read Chinese is most important, I am not so sure that this case can be decided on this basis. Section 3.5.2 of the Guidebook *inter alia* states that:

“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 unjustifiably impairs the distinctive character or the reputation of the objector’s mark ... , or otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector’s mark “

I think it is reasonable to say that it is internationally recognised principle of trade mark law that generally the use of a term which has a descriptive meaning in a manner that is consistent with its descriptive meaning should not infringe a trademark for that term. That use is unlikely to take unfair advantage of, or unjustifiably impair any distinctive character of, or create impermissible likelihood of confusion with a trademark. That is because in such circumstances the mark is unlikely to have any distinctive character in respect of that activity and/or the law considers any advantage gained, impairment caused or confusion incurred, as neither unfair, nor unjustified nor impermissible.

Therefore, if “weibo” and “微博” are descriptive of micro-blogging and the Applicant intends to use if for micro-blogging services, then it will be difficult for the Objector to succeed in these proceedings.

I am un-persuaded by the argument that it is not necessary to decide the question of whether “weibo” and “微博” are descriptive of micro-blogging because the Objector has a mark that extends to, for example, “computer database information systemization” and that the Applicant’s provision of micro-blogging services will involve such database activities. Even if that is factually correct, such database activity is secondary and incidental to the provision of the central service that the Applicant intends to offer. Further, it is an argument that the Objector does not appear to have advanced in these proceedings.

Similarly, I am un-persuaded that the fact that the Applicant has asserted in its Application for the gTLD that the new gTLD will provide a “distinctive domain space”, is particularly significant. The Applicant in reading the decision in this case may now regret that particular choice of words. However, there is to my mind a danger of reading too much into those words. It does not necessarily follow from the fact that the Applicant may wish to promote this gTLD as a “distinctive domain space” that it accepts that the term “微博” is inherently already distinctive, or that it will become “distinctive” save in the limited sense than it is a gTLD that the Applicant hopes will be remembered and used by registrants in preference to other gTLDs that may be or become available.

I broadly agree with my fellow panelists in their assessment of the factors that we are mandated to consider by Section 3.5.2 of the Guidebook. Nevertheless, they are simply factors that may or may not assist in the context of a particular case and the weight and regard that is to be given to each factor will depend on the specific facts. No part of that analysis persuades that it is wrong to conclude that the Objector’s case stands or falls on the issue of whether the terms “weibo” and “微博” are inherently descriptive.

The Applicant has provided evidence which shows that to some extent the terms “weibo” and “微博” have been used descriptively. However, the Objector has put in plenty of evidence that the terms “weibo” and “微博” are associated with the Objector. Some of the evidence is inconclusive. An example of this is the survey evidence relied upon by the Objector. But some of this evidence undoubtedly supports the Objector’s case. For example, there is material which suggests the terms “weibo” and “微博” are generally considered as synonyms for the Objector.

Particularly powerful is the finding of the Chinese trade mark registry in trade mark objection proceedings in relation to Trademark No. 9337632. The Objector claims that this decision:

“directly and unequivocally negates and contradicts the Respondent’s incorrect and unsupported claim that the term ‘微博’ is ‘generic’ or ‘descriptive’”

Unfortunately, this decision does not incorporate any detailed reasoning and the relevant statement in that decision is as follows:

“The opponent’s claims that ‘微博’ is a generic name of the platform for information sharing and exchanging, and the registration and use of the opposed mark would mislead the public and violate Article 10.1(8) of the Trademark Law of PRC are not supported by the evidence submitted”

This statement perhaps does not go quite so far as the Objector contends. A statement that someone has not provided sufficient evidence that a term is generic is not quite the same as a statement that the term is non-generic or distinctive. It is, therefore, not possible for me to form a concluded view on the significance of these statements without knowing in fuller detail what was said to the Chinese trademark registry, what assumptions the Chinese trademark registry made as to distinctiveness and who bore what burdens of proof.²

There are other issues that may well be relevant to the issue of distinctiveness. One is the exact origins of the term “微博”. Who coined this terms first and how they were then deployed in the field of micro-blogging might well be of significance.

As is already recorded in a footnote to the substantive decision in this case, the terms “微博” or “weibo” do not seem to appear on the records for the “www.taotoa.com” website to be found on the “Wayback Machine” Internet Archive, notwithstanding the claim by the Respondent that it first offered a “滔滔微博” service in early 2007. This may be a point of some importance.

² Another reason for exercising caution here is that according to the Applicant the United States Patent and Trade Mark Office appears to have reached an opposite conclusion in respect of US trade mark applications 85264899, 85264957, 85296605 and 85320366, although those decisions appear to be subject to appeal.

Further, it is common knowledge that written Chinese is fundamentally different from phonetic systems like English. In English a word is usually made up of letters that usually indicate as to how the word is pronounced. Chinese is instead made up of individual characters that may have their own independent meanings in isolation. A Chinese word can therefore be made up of characters that may have a "literal" translation which may or may not be allusive to the word as a whole.

Further, according to Wikipedia "weibo" / "微博" are abbreviated forms of the terms "wei boke"/ "微博客" and "weixing boke" / "微型博客". This may or may not be relevant to the issue of the distinctiveness of these terms.

None of these issues are addressed in the submissions before the Panel.

There is also the fact that although the terms "weibo" and "微博" are already being used by Applicant as part of a larger term (for example, "Tencent 微博"), it would appear that no legal proceedings have been brought by the Objector against the Applicant in relation to that use. There may well be very good reasons, whether of law, procedure or commercial practicality as to why this is the case. Nevertheless, it is something that calls out for an explanation.

It does not follow from this that the Objection should be dismissed on the basis that it is the Objector that bears the burden of proof in these proceedings. Given the Chinese trademark registry decision, I am of the view that a more appropriate approach would have been to have put these points to the Parties for further comment in a procedural order. However, the majority of the Panel in this case do not consider this to be necessary.

No criticism is intended on my part of the decision of my fellow panelists not to make such an order. Given the approach that the majority appear to have adopted, any further submissions filed by the Parties in this case would be unlikely to have impacted on its final outcome, it would have further postponed the final decision and it would have imposed unnecessary additional costs on the Parties. However, in the absence of such an Order and without the benefit of the Parties' submission on these points, I am unable to join the majority of the Panel in this case.

[signed]

Matthew Harris

Panelist (Dissenting)

Date: August 28, 2013