

EXPERT DETERMINATION LEGAL RIGHTS OBJECTION

Right At Home v. Johnson Shareholdings, Inc.

Case No. LRO2013-0030

1. The Parties

Objector is Right At Home of Omaha, Nebraska, United States of America represented by Faegre Baker Daniels LLP, United States.

Respondent/Applicant is Johnson Shareholdings, Inc. of Racine, Wisconsin, United States, represented by Steven M. Levy, United States (the "Respondent").

2. The applied-for gTLD string

The applied-for gTLD string (the "String") is <.rightathome>.

3. Procedural History

The Objection was filed with the WIPO Arbitration and Mediation Center (the "WIPO Center") on March 13, 2013, pursuant to the New gTLD Dispute Resolution Procedure (the "Procedure").

In accordance with Article 9 of the Procedure, the WIPO Center has completed the review of the Objection on March 21, 2013 and has determined that the Objection complies with the requirements of the Procedure and the World Intellectual Property Organization Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections (the "WIPO Rules for New gTLD Dispute Resolution").

In accordance with Article 11(a) of the Procedure, the WIPO Center formally notified Respondent 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 timely filed with the WIPO Center on May 15, 2013.

The WIPO Center appointed Robert A. Badgley 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.

4. Factual Background

Respondent Johnson Shareholdings, Inc. is a wholly-owned subsidiary of S.C. Johnson & Son, Inc. (“SC Johnson”). SC Johnson, which has existed for decades, is a major manufacturer of various consumer household products, in areas including house cleaning, pest control, air care, shoe care, and food storage, with famous brand names such as Windex, Pledge, Glade, Raid, Ziploc, and Kiwi. SC Johnson generates more than USD 9 billion in annual sales, and its products are made, marketed, and sold in many countries.

SC Johnson has used the mark RIGHT@HOME (stylized) to provide housekeeping information in the fields of cleaning, arts and crafts, interior decorating, cooking, landscape gardening, and space management for closets, garages, and crawl spaces. SC Johnson’s first use in commerce for these various fields of informational activity range between 2008 and 2010, and this mark was registered with the United States Patent & Trademark Office on November 2, 2010.

Respondent asserts, and there is no evidence to the contrary in the record of this case, that Objector never objected to SC Johnson’s registration or use of the RIGHT@HOME mark prior to the commencement of this LRO proceeding.

By agreement effective April 1, 2012, SC Johnson licensed use of the RIGHT@HOME mark and other marks to Respondent and authorized Respondent to seek gTLD registrations for various character strings including “rightathome”.

In its application to register the String, Respondent stated:

“The intended future mission and purpose of the .RIGHTATHOME gTLD is to serve as a trusted, hierarchical, and intuitive namespace provided by SC Johnson for SC Johnson’s customers, and Internet users in general. ...

The .RIGHTATHOME gTLD is intended to be one of those .BRAND gTLDs, with the goal of protecting SC Johnson’s online presence and identity; expanding its marketing and promotion efforts; providing a secure channel for Right@Home(TM) content, and offering a platform through which to consolidate many of the intellectual property activities of SC Johnson.”

Respondent also maintains a website at <rightathome.com>, at which site one finds recipes, cooking tips, food storage tips, coupons for SC Johnson’s various products, and so forth.

Objector describes itself as an “international franchise organization” based in the United States and founded in 1995. Objector provides home healthcare services in more than 250 locations on six continents. The home care services offered by Objector include meal preparation, medication reminders, dressing and bathing assistance, cleaning, errands, and the like.

Objector markets its services under the RIGHT AT HOME mark, which is registered in the United States and several other countries. Objector also holds numerous international registrations for stylized marks featuring the words RIGHT AT HOME – IN HOME CARE & ASSISTANCE. Objector first used the mark RIGHT AT HOME to identify and distinguish its services in commerce in 1995.

According to Objector’s president, RIGHT AT HOME is the company’s “only manner of identifying itself to the consuming public, and has been since 1995.” Respondent also operates a website at <rightathome.net>.

Respondent notes that various third parties have registered domain names <rightathome.biz>, <rightathome.us>, <rightathome.mobi>, <rightathome.info>, <rightathome.org>, <rightathome.co.uk>, and <rightathome.de>, and asserts that Objector has never objected to the use of these domain names by such third parties.

As Objector points out, there are various third parties using the marks RIGHT AT HOME or RIGHT@HOME (word or stylized) for various goods or services including pharmaceutical services, home improvement and restoration services, and child-safety products.

According to Objector, it made contact with Respondent prior to commencing this LRO proceeding, but the parties were unable to reach an amicable resolution.

5. Parties' Contentions

A. Complainant/Objector

Objector raises arguments under each of the eight non-exclusive factors relevant to a determination under the Procedure, which are set forth below in the respective discussion of each of those factors. On a larger scale, though, Objector raises a few overarching points. First, Objector asserts that allowance of the String could result in third-party registrations of domain names and "could easily result in the proliferation of domains that infringe the rights of Objector." According to Objector, this prospect will create a "considerable burden of constant vigilance with respect to the gTLD." Also, Objector further stresses that the mark RIGHT AT HOME is its only way of identifying itself to the consuming public.

B. Respondent/Applicant

Respondent also raises points under each of the eight non-exclusive factors, as will be set forth below. In addition, Respondent stresses that its contemplated use of the String is entirely legitimate, and that Respondent and Objector offer goods and services in decidedly different spheres of commercial activity. Respondent also argues that Objector's fear of having to undertake heightened vigilance to police its trademark rights is misplaced, and that vigilance is in any event a burden that any mark owner must willingly shoulder.

6. Discussion and Findings

For the reasons set forth below, the Panel concludes that this Legal Rights Objection is unavailing and should not be sustained.

Objector bears the burden of proof. Procedure, Section 3.5. The prefatory comments to the eight factors to be considered by a Panel under the LRO Procedure state that the Panel:

... 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...

Procedure, Section 3.5.2. The use of the terms "unfair," "unjustifiably," and "impermissible" as modifiers, respectively, of "advantage," "impairs," and "likelihood of confusion" in Section 3.5.2 suggests that there must be something more than mere advantage gained, or mere impairment, or mere likelihood of confusion for an Objection to succeed under the Procedure. It seems, rather, that there must be something untoward – even if not to the level of bad faith – in the conduct or motives of Respondent, or something intolerable in the state of affairs which would obtain if the Respondent were permitted to keep the String in dispute.

The foregoing concepts are not uniformly defined or understood in the international trademark community. Indeed, the word "unfair" in the context of "unfair competition" is a notoriously elusive concept. An excellent and colorful discussion of the quicksilver quality of that term may be found in McCarthy's treatise, wherein it is observed: "The word 'unfair' is no more precise than many other legal terms whose purpose is to give

discretion to a judge, such as ‘reasonable’ or ‘adequate.’” J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition 4th* (Thomson Reuters/West) Section 1:8.

To aid interpretation of this general concept, the Procedure sets forth eight non-exclusive factors which should be considered by the Panel when applying the Section 3.5.2 standards to the facts of this case. These factors may be viewed collectively as analytical proxies for the more general concepts discussed above. The Panel underlines that as these 8 factors are stated to be nonexclusive, it thereby leaves room for the interpretation of this general concept. It also bears noting that the relevant importance of each factor is not fixed in advance of the Panel’s inquiry; rather, depending on the facts and circumstances of each case, some factors may prove more significant than others. Deciding a case under the LRO Procedure is not simply a matter of tallying the factors (e.g., 5-3) and declaring the winner on that basis.

With the foregoing understanding of how the concepts and factors of the LRO Procedure work together, the Panel reaches the following findings and conclusions under the eight factors.

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

The parties essentially agree that the String here is at least similar in all relevant respects to Objector’s RIGHT AT HOME mark. The Panel finds that the word “at” and the symbol “@” are essentially synonymous in Internet parlance and concludes that this factor weighs in favor of Objector.

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

Respondent does not seriously dispute for purposes of this proceeding that Objector’s use of, and rights in, its RIGHT AT HOME mark are *bona fide*. The Panel finds that this factor weighs in favor of Objector.

3. Whether and to what extent there is recognition in the relevant sector of the public of the sign corresponding to the gTLD, as the mark of Objector, of Applicant/Respondent or of a third party.

On the record here, there is little doubt that a relevant sector of the public associates the RIGHT AT HOME mark with Objector’s home care services. The record also supports the conclusion that some sector of the public associates the RIGHT@HOME mark with Respondent’s parent SC Johnson. As noted above, that mark is duly registered and has been used for several years in commerce to provide information regarding various household products and activities. The web pages accessible at SC Johnson’s “www.rightathome.com” site also appear very well developed.

Objector also points out that certain third parties have made use of the RIGHT AT HOME or RIGHT@HOME marks in the fields of pharmaceuticals, home remodeling, and child-safety products. Respondent asserts that such third-party use actually undercuts Objector’s argument. The Panel agrees. It seems common ground in this proceeding that a variety of companies have used RIGHT AT HOME or RIGHT@HOME to identify and distinguish goods or services in a variety of fields, and seem to have coexisted in their endeavors. Objector has not, as far as this record reveals, objected to SC Johnson’s use of RIGHT@HOME, or SC Johnson’s operation of a website at “www.rightathome.com”, or the third-party uses of RIGHT AT HOME and RIGHT@HOME marks.

The Panel finds that this factor favors Respondent.

4. Applicant’s/Respondent’s intent in applying for the gTLD, including whether Applicant/Respondent, 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/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 Panel first observes that, while the Parties did not specifically address the question whether Respondent was actually aware of Objector's mark at the time it applied for the gTLD, it seems fair to infer that Respondent, or at least its parent SC Johnson, had such knowledge. SC Johnson is a major corporation with a wide variety of successful brands, and corresponding trademarks. It is difficult to imagine Respondent or its parent being unaware of Objector's mark. In any event, Respondent does not specifically deny that it had knowledge of Objector's RIGHT AT HOME mark at the time it applied for the String.

Objector also asserts that Respondent should be charged with constructive knowledge of the RIGHT AT HOME mark, by virtue of the mark's registration. The Panel need not decide whether constructive knowledge, by itself, may be a decisive consideration under this factor of the LRO Procedure. Rather, the Panel concludes on a balance of probabilities that Respondent was probably aware of Objector's mark. Such knowledge, however, does not end the inquiry under this factor.

With respect to any pattern of conduct whereby Respondent has applied for or used other TLDs which are confusingly similar to the marks of others, there is no allegation or evidence presented in this record that Respondent has done any such thing.

Finally, with respect to the overarching concern of this factor, viz., Respondent's intent in applying for the String, the Panel concludes that Respondent's intent was *bona fide*. Respondent's stated explanation in its application boils down to its "goal of protecting SC Johnson's online presence and identity; expanding its marketing and promotion efforts; providing a secure channel for Right@Home(TM) content, and offering a platform through which to consolidate many of the intellectual property activities of SC Johnson." This explanation seems quite plausible for a major marketer of numerous household consumer goods, and it appears consistent with the marketing activities which have been undertaken at the "www.rightathome.com" website operated by SC Johnson.

In sum, the Panel finds nothing untoward in Respondent's intent here. This factor favors Respondent.

5. Whether and to what extent 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 Objector of its mark rights.

Much of what was said above in connection with the fourth factor is equally applicable here. Respondent's parent has been using RIGHT@HOME as a mark and at a website for several years for legitimate purposes.

Under this head, Objector asserts that "Applicant/Respondent's intent to open the gTLD to third party registrations will likely result in the proliferation of domains within that gTLD that infringe upon the rights of Objector." By way of example, Objector notes that "a third party could register <ILoveMyMother.rightathome> or <healthcare.rightathome>."

Respondent replies that it "has used its RIGHT@HOME mark since 2009 on [sic] connection with a *bona fide* business and Objector's fears are unsupported." Respondent also states that Objector has presented no evidence that its trademark rights have been infringed by the peaceful coexistence of the parties' respective marks. The lack of any evidence of past abuse, Respondent argues, is suggestive that such abuse is unlikely to occur in the future.

The Panel agrees with Respondent that Objector's professed fears are largely speculative. In any event, Objector would have legal recourse if some party registered, for instance, <healthcare.rightathome> as a domain name and used it to host a website offering home care services in competition with Objector.

This factor weighs in favor of Respondent.

6. Whether 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 Applicant/Respondent is consistent with such acquisition or use.

Again, it has already been found that Respondent's parent SC Johnson has made use of RIGHT@HOME for several years in connection with legitimate commercial activities.

Objector's main argument under this head is that SC Johnson, and not Respondent itself, owns the RIGHT@HOME mark. Respondent, however, has presented sufficient evidence in the record to establish that it is a wholly-owned subsidiary of SC Johnson and is licensed to use the RIGHT@HOME mark (and is also authorized to apply for the String in dispute here). The Panel finds it curious that, according to Objector, the Parties had communicated prior to the commencement of this LRO proceeding and yet they apparently did not clarify the relationship between SC Johnson and Respondent *vis-à-vis* the RIGHT@HOME mark.

In any event, it is clear that this factor favors Respondent.

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

While it is clear that SC Johnson owns several famous trademarks for its various household products, the record is rather threadbare on the issue whether SC Johnson or Respondent is "commonly known" by the mark RIGHT@HOME. Respondent appears to argue that its *bona fide* actual use of that mark in connection with goods and services means that it has become commonly known by that mark. This argument is not persuasive, particularly since the LRO Procedure includes *separate* factors for Respondent's *bona fides* and the "commonly known" factor. This confirms that the factors should not be conflated. Respondent's evidence on the latter factor is too thin.

The Panel concludes on the record here that this factor weighs in favor of Objector, though this factor does not appear to be as significant as others in the context of this dispute. As should be apparent by this point, the *bona fide* use by Respondent's parent of the RIGHT@HOME mark in a commercial field different from Objector's is the paramount consideration emerging from this analysis.

8. Whether Applicant's/Respondent'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.

Objector's main point under this head is to repeat that "Respondent's intention to allow third parties to register domains within the gTLD is fraught with potential for abuse given the identity between the gTLD and [Objector's] Mark." Objector also repeats that the Mark RIGHT AT HOME "is the only manner in which [Objector] identifies itself to a worldwide consuming public."

The Panel observes that, while Objector undeniably holds rights in the word mark RIGHT AT HOME, it also owns and uses the stylized mark which features the words "RIGHT AT HOME – IN HOME CARE & ASSISTANCE." That mark on its face helps to distinguish Objector's services from those offered by others who use RIGHT AT HOME or some similar mark for different goods and services. Thus, it may not be entirely accurate for Objector to claim that RIGHT AT HOME is its sole means of reaching the relevant public. Respondent urges the Panel to employ the multifaceted test for "likelihood of confusion" set forth in the case *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). Briefly stated, the *DuPont* test calls for the consideration of 13 factors, identified in shorthand terms as follows: (1) appearance, sound, connotation, and commercial impression; (2) the goods or services; (3) the trade channels used; (4) circumstances of the sales; (5) fame of the prior mark; (6) similar marks in use; (7) actual confusion; (8) concurrent use of the competing marks; (9) variety of goods; (10) market interface; (11) right to exclude others; (12) potential confusion; (13) any other fact. The *DuPont* factors are not necessarily given equal weight.

Despite Respondent's invitation, the Panel need not conduct a full-blown *DuPont* test to the facts in the instant case, especially since certain of the considerations set forth in the *DuPont* test have already been touched upon by the Panel. Some considerations emerging from a *DuPont* analysis may be briefly mentioned. The fourth factor, for instance, considers whether consumers are likely to be casual and unsophisticated (and hence likely to be confused) or careful and sophisticated. In this connection, it is not readily apparent that people seeking Objector's home healthcare and related services, either for themselves or for a loved one, are apt to be impulse buyers easily misled by another party using RIGHT AT HOME (or RIGHT@HOME) as a mark in connection with unrelated goods and services.

Similarly, as respects *DuPont* factor (2), the Panel concludes that there is little or no overlap between the home healthcare and related services offered by Objector and the various forms of information and related goods (e.g., food storage tips and Ziploc bags) offered and to be offered by Respondent.

With respect to *DuPont* factor (5), Objector has presented no evidence supporting a conclusion in the context of the present proceeding that its RIGHT AT HOME mark is famous.

With respect to *DuPont* factors (7) and (8), the Panel notes that no evidence of actual confusion has been presented in this record, and this lack of evidence is underscored by several years of concurrent use of the marks RIGHT AT HOME and RIGHT@HOME by the parties.

Most of the other *DuPont* factors either have already been addressed, at least obliquely, or do not figure as particularly significant in the context of this case.

In short, to the extent the *DuPont* test adds anything to the analysis set forth earlier, the test largely favors Respondent.

The Panel concludes that this eighth factor under Section 3.5.2 of the Procedure weighs in favor of Respondent.

7. Decision

For the foregoing reasons, the Panel rejects the Objection.

[signed]

Robert A. Badgley
Sole Panel Expert
Date: July 3, 2013