

# LIFESTYLE DOMAIN HOLDINGS, INC.

## **.Brand Specification TLD Designation Application For .FOOD**

July 28, 2016

Internet Corporation for Assigned Names and Numbers (“ICANN”)  
12025 Waterfront Drive, Suite 300  
Los Angeles, California 90094

Attention: New gTLD Program Staff

### **PURPOSE OF THIS LETTER**





The purpose of this letter is to provide a response to the public comments made regarding our application as a Specification 13 registry and provide further support for the rationale and basis for how we meet the criteria of a Specification 13 registry.

### **ABOUT SCRIPPS NETWORKS AND LIFESTYLE DOMAIN HOLDINGS, INC.**

Scripps Networks Interactive, Inc. is a publicly-traded global media and entertainment company, and it is the parent entity of its solely-owned subsidiary Lifestyle Domain Holdings, Inc., the registry operator for .FOOD (collectively “Scripps”). Scripps is one of the world’s leading developers of lifestyle-oriented content for many media platforms, including television, digital, mobile and publishing. Scripps’ portfolio includes some of the most popular and famous media brands in the world, including Food Network, Food., Cooking Channel, HGTV, Travel Channel, and DIY Network. Scripps has applied for numerous gTLDs related to its brands, including its famous FOOD brand.

In addition to the fact that Scripps’ famous Food Network television service was branded simply as “FOOD” on-air for a decade and continues to be branded as such in digital video content and in print and electronic television guides, Scripps owns and operates a highly successful recipe sharing and meal planning service available on web and mobile platforms called “FOOD” which has averaged over 25 million unique visitors over the past 12 months (see Annex 1). The brand “FOOD” is one in which Scripps has invested hundreds of millions of dollars, and as a result of this substantial investment and the resulting fame and goodwill, the trademark “FOOD” is one of Scripps’ most valuable assets.

To protect its rights in the FOOD trademark, Scripps, through its subsidiary Television Food Network, G.P., has secured the following trademark registrations on the Principal Register of the United States Patent and Trademark Office:

Trademark	USPTO Reg. #	Goods/Services	Date of First Use / Reg'n Date
FOOD	4049665	IC 041. G & S: Entertainment services, namely, an on-going audio and visual program distributed over television, satellite, wireless, audio and video media, fiber optics, cable, and a global computer network in the fields of cooking and culinary arts, health, fitness, and nutrition	FIRST USE: Jan. 2003  REG. DATE: Nov. 2011
	3658542	IC 038. G & S: Cable television broadcasting services.	FIRST USE: Jan. 2003  REG. DATE: July 2009
	3658543	IC 041. G & S: Entertainment services in the nature of ongoing television programs in the field of cooking and culinary arts, health, fitness and nutrition; production and distribution of television programs.	FIRST USE: Jan. 2003  REG. DATE: July 2009
	3658544	IC 043. G & S: Providing information via a global computer information network in the fields of cooking and culinary arts.	FIRST USE: Jan. 2003  REG. DATE: July 2009
	4921137	IC 043. G & S: Providing information online in the fields of cooking and culinary arts.	FIRST USE: Feb. 2015  REG. DATE: March 2016

In all of these registrations, the United States Patent and Trademark Office, upon review, specifically accepted that the term FOOD was **not generic** as to Scripps's goods and services, but to the contrary, that the term had acquired distinctiveness and trademark significance as a result of Scripps's substantial use, investment and promotion. In many cases, these trademarks have been determined to be incontestable, further reinforcing that it is not a generic term as used.

## **SPECIFICATION 13 REQUIREMENTS AND BASIS FOR APPLICATION**

Scripps applied for .FOOD during the 2012 ICANN application window with the intention that it be operated as an exclusive access registry to further support its proprietary FOOD brand. <https://gtldresult.icann.org/application-result/applicationstatus/applicationdetails/466>. Two other applicants also applied for .FOOD, placing it in a contention set. In the 2013 Beijing Communiqué <https://www.icann.org/en/system/files/correspondence/gac-to-board-18apr13-en.pdf>, the GAC flagged .FOOD as one of many TLDs under Category 2 advice that caused concern for them regarding exclusive access to a generic term. In that communiqué, the GAC did not recognize that, as is well-recognized in global trademark law, common terms can and do constitute legitimate trademarks. Scripps maintained then, as it does now, that its use of FOOD is not as a generic term but—as has been recognized and validated by the United States government—is instead a legally protected, proprietary trademark for the specific goods and services of Scripps. Scripps provided public statements to this effect when requested by ICANN in response to the Communiqué. <http://newgtlds.icann.org/en/applicants/gac-advice/cat2-safeguards>.

After winning the .FOOD TLD contention set through a private proceeding, Scripps applied for Specification 13 status in accordance with the requirements set out by the New gTLD Program Committee (“NGPC”). NGPC specifically stated that those criteria reflected “months of negotiations on many key issues raised by the community.” As is set forth below, Scripps squarely meets all of the stated criteria for a .Brand TLD.

Section 5.1 of the NGPC guidelines require an applicant to meet the following criteria to establish eligibility for Specification 13 status:

1. The TLD string must be identical to the textual elements protectable under applicable law, of a registered trademark valid under applicable law, which registered trademark.

**SCRIPPS HAS A TRADEMARK FOR “FOOD” WHICH IS AN EXACT MATCH TO THE TLD STRING .FOOD.**

2. The trademark must be registered with the Trademark Clearinghouse, if such mark meets the eligibility requirements to be registered with the Trademark Clearinghouse.

**SCRIPPS’S FOOD TRADEMARK IS REGISTERED IN THE TRADEMARK CLEARINGHOUSE AS EVIDENCED BY THE SMD FILES ATTACHED TO SCRIPPS’S SPECIFICATION 13 APPLICATION.**

3. The trademark must be owned and used by the Registry Operator or its Affiliate in the ordinary course of Registry Operator’s or its Affiliates’ business in connection with the offering of the goods and/or services claimed in the trademark registration.

**SCRIPPS'S FOOD TRADEMARK IS USED BY SCRIPPS IN CONNECTION WITH THE GOODS AND SERVICES CLAIMED IN ITS TRADEMARK REGISTRATION.**

4. The trademark was issued to Registry Operator or its Affiliate prior to the filing of its TLD registry application with ICANN.

**SCRIPPS'S FOOD TRADEMARK WAS FIRST USED IN 2003, AND THE FOOD TRADEMARK REGISTRATION WAS ISSUED IN 2011, PRIOR TO THE FILING OF SCRIPPS'S APPLICATION FOR THE .FOOD TLD IN 2012.**

5. The trademark is used throughout the Term continuously in the ordinary course of business of Registry Operator in connection with the offering of the goods and/or services identified in the trademark registration;

**SCRIPPS'S FOOD TRADEMARK HAS CONTINUOUSLY BEEN USED CONSISTENT WITH THE RECITATION OF SERVICES.**

6. The trademark does not begin with a dot.

**SCRIPPS'S REGISTERED FOOD TRADEMARK DOES NOT BEGIN WITH A DOT.**

7. The trademark is used by Registry Operator in the conduct of one or more of its businesses that are unrelated to the provision of TLD Registry Services.

**SCRIPPS'S FOOD TRADEMARK IS NOT USED FOR TLD REGISTRY SERVICES BUT RATHER FOR TELEVISION ENTERTAINMENT SERVICES SET FORTH IN SCRIPPS'S FOOD TRADEMARK REGISTRATION.**

8. Only Registry Operator, its Affiliates, or Trademark Licensees register domain names and control the DNS records associated with domain names at any level in the TLD

**SCRIPPS WILL CONTROL THE DOMAIN NAMES IN ACCORDANCE WITH THIS REQUIREMENT AND AS EVIDENCED BY THE POLICIES ATTACHED TO ITS SPECIFICATION 13 APPLICATION.**

9. Registry Operator has provided ICANN with an accurate and complete copy of such trademark registration.

**SCRIPPS PROVIDED A COPY OF ITS FOOD REGISTRATIONS IN ITS SPECIFICATION 13 APPLICATION, AND THEY ARE INCLUDED HERE FOR REFERENCE.**

Scripps clearly meets all of the above stated criteria for .BRAND TLD status under Specification 13, and no challenges to Scripps's eligibility under these criteria have been asserted in any of the public comments. Should ICANN require further support or evidence relating to the above criteria, however, please let us know and we will gladly produce additional documentation or evidence as needed.

The final requirement set forth in the Specification 13 agreement is that the TLD is not a “Generic String as defined in Specification 11.”

**.FOOD IS NOT A GENERIC STRING AS SET FORTH IN SPECIFICATION 11**

Specification 11 3(d) defines the term Generic String as: “a string consisting of a word or term that denominates or describes a general class of goods, services, groups, organizations or things, *as opposed to distinguishing a specific brand of goods, services, groups, organizations or things from those of others.*”

Under the above-stated definition, a generic term serves only to describe a general class of goods, services, or things, rather than acting as a brand indicator of source. By this definition, Scripps’ FOOD brand cannot be considered generic because it serves as a strong brand indicator of source for Scripps’s entertainment and related services, as evidenced by its trademark registrations with the United States Patent and Trademark Office.

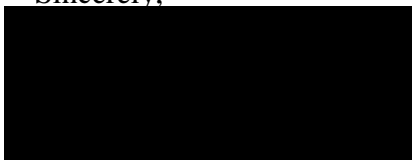
In all of Scripps’s trademark registrations for the mark FOOD, the United States Patent and Trademark Office specifically accepted that the term “FOOD” is **not generic** for Scripps’s stated goods and services, but to the contrary that the term is merely descriptive and proven to be protectable as a trademark by virtue of Scripps’s acquired distinctiveness through long and widespread use, promotion and public recognition.

The principle of acquired distinctiveness is well-settled in trademark law and jurisprudence globally. In this case, the United States Patent and Trademark Office--an official government agency and leading trademark authority—has made a legal determination that the term FOOD is **not generic** but instead serves as a specific brand for Scripps’s goods and services. The question of genericness has therefore already been reviewed, evaluated, and determined by an agency expert in such matters and imbued with the legal authority to determine them. As such, Scripps’s registered FOOD trademark constitutes a valid legal basis upon which to grant its application for Specification 13 status, as all required criteria for such status have been met.

As stated above, Scripps’s .FOOD TLD meets all of the stated criteria for Specification 13 .BRAND status. No public interest can be served by ICANN unilaterally disallowing an application for such status when all of the criteria developed by the community clearly have been met.

Accordingly, I respectfully request that Scripps’s application for Specification 13 .BRAND TLD status in .FOOD be granted.

Sincerely,



Executive Vice President & Chief Legal Officer

# Annex One

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