

.Brand TLD Designation Application for .HANGOUT

Internet Corporation for Assigned Names and Numbers ("ICANN")
12025 Waterfront Drive, Suite 300
Los Angeles, California 90094
Attention: New gTLD Program Staff

RE: Application for .Brand TLD Designation

Charleston Road Registry Inc. ("Registry Operator"), in connection with the execution of the Registry Agreement for the .HANGOUT TLD (the "Registry Agreement"), hereby applies for the .HANGOUT TLD [REDACTED] to be qualified by ICANN as a .Brand TLD.

Registry Operator confirms and represents to ICANN that the TLD meets most of the criteria for the TLD to be qualified as a .Brand TLD, as described in the .Brand TLD Application Process and Specification 13 attached thereto, and that all supplemental material accompanying this application is accurate and not misleading in any respect. Registry Operator also represents that the trademark registration attached hereto as Exhibit A and the registration policies attached hereto as Exhibit B are complete and accurate copies of the official trademark registration and Registry Operator's registration policies for the TLD, respectively.

Registry Operator also submits detailed information, including particular evidence, attached hereto as Exhibits C-E, supporting the TLD's satisfaction of the .Brand TLD criteria, and where the TLD does not satisfy the .Brand criteria, justification for the TLD to nonetheless be qualified as a .Brand TLD.

- i. **TLD and Trademark Identity.** The HANGOUT TLD string is not identical to the textual elements protected by Hong Kong Trademark Registration for HANGOUTS ([REDACTED]) (the "HANGOUTS mark"), but is indistinguishable to and the legal equivalent of the HANGOUTS mark, and identical to how Internet users often use the HANGOUTS mark. Therefore, ICANN should consider the TLD to be identical to the HANGOUTS mark for purposes of qualifying the TLD as a .Brand.

In Hong Kong, a trademark may consist of "words (including personal names), indications, designs, letters, characters, numerals, figurative elements, colours, sounds, smells, the shape of goods or their packaging and any combination of such signs" without claim to any particular font style, size, or color and thus consist only of textual elements, which in this case is HANGOUTS. See Hong Kong Trade Marks Ordinance [REDACTED]. Thus, the TLD string is only different from the textual elements of the HANGOUTS mark by the omission of one letter "s", and is the singular version of the HANGOUTS mark.

The TLD should nonetheless be considered identical to the HANGOUTS mark because (1) the terms have identical commercial meaning, as demonstrated by consumers' routine interchanging use of HANGOUTS and HANGOUT in connection with the services identified in the submitted trademark registration (see Exhibit F; 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 7:18 (4th ed. 2014) (noting that an abbreviation of a mark is entitled to trademark protection as a mark if in the public mind the abbreviation identifies a company or its services, even if the company itself has not used the abbreviation in a formalistic way as a service mark); (2) Registry Operator intended the HANGOUT TLD string to represent the HANGOUTS mark and will brand websites at domains in the HANGOUT TLD with the HANGOUTS mark, as demonstrated by the TLD's Mission and Registration Policies (see Exhibit B); and (3) because domain names that are singular or plural versions of trademarks should be considered indistinguishable, legal equivalents in appearance, sound, and impression to those trademarks, as held by numerous UDRP Panels and courts that have considered whether trademarks and domains that are singular or plural versions of those trademarks are distinguishable. E.g., Home Retail Group v. Home Retail Group / Rafique Holding, [REDACTED] ("In the Panel's view this extra letter ["s"] does nothing to distinguish the disputed domain name from the Complainant's trade mark and . . . given that it confers an appearance on the disputed domain name of being a plural form of the Complainant's trade mark."); [REDACTED] - [REDACTED] the disputed domain names plural does not sufficiently distinguish them from Complainant's marks."); Fannie May Confections, Inc. v. Domain Contact 2, [REDACTED] to be identical to complainant's FANNIE MAY mark); In re Pix of America, Inc., 225 [REDACTED] (refusing to register NEWPORTS for women's shoes in view of prior registration of NEWPORT, for shirts; "As for the marks except for the pluralization of applicant's mark which is almost totally insignificant in terms of the likelihood of confusion of purchasers, the marks are essentially identical in sound, appearance and commercial impression."); Wilson v. Delauney, [REDACTED] ("It is evident that there is no material difference, in a trademark sense, between the singular and plural forms of the word "Zombie" and they will therefore be regarded here as the same mark.").

For all of the reasons discussed above, the HANGOUT TLD should be considered identical to the HANGOUTS mark.

- a. **Trademark Clearinghouse Entry.** Registry Operator's Affiliate Google Inc. ("Google") owns and recorded the HANGOUTS mark including proof of use with the Trademark Clearinghouse, and such proof of use was verified by the Trademark Clearinghouse. A copy of the [REDACTED] [REDACTED] issued by the Trademark Clearinghouse for the HANGOUTS mark is attached hereto as Exhibit C.

- b. **Trademark Ownership.** As detailed in its new gTLD application for the .HANGOUT TLD, the statements and representations of which were expressly warranted as true and accurate by Registry Operator by submitting its application under the Top-Level Domain Application Terms and Conditions, Registry Operator is a wholly-owned subsidiary of Google. Under the Registry Agreement, "Affiliate" means a person or entity that, directly or indirectly, through one or more intermediaries, or in combination with one or more other persons or entities, controls, is controlled by, or is under common control with, the person or entity specified, and (ii) "control" (including the terms "controlled by" and "under common control with") means the possession, directly or indirectly, of the power to direct or cause the direction of the management or policies of a person or entity, whether through the ownership of securities, as trustee or executor, by serving as an employee or a member of a board of directors or equivalent governing body, by contract, by credit arrangement or otherwise. As the owner of all shares of Registry Operator, Google has the power to directly control the Registry Operator. Google is thus an Affiliate of Registry Operator, and is the owner of the Hong Kong trademark registration for the HANGOUTS mark.
- c. **Registration Timing.** The trademark application for the HANGOUTS mark was filed on November 27, 2012, and the registration formally issued on August 30, 2013. See Exhibit A. Although the trademark registration for the HANGOUTS mark registered after the Registry Operator submitted its new gTLD application for the .HANGOUT TLD, the TLD should nonetheless be qualified as a .Brand TLD because, as affirmed in its new gTLD application for the TLD, Registry Operator did not pursue a trademark registration of HANGOUTS for the purpose of reserving the .HANGOUT TLD or to qualify as a .Brand. Indeed, Registry Operator's Affiliate Google continuously used the HANGOUTS mark for bona fide services since at least as early as June 28, 2011, well before ICANN opened its new gTLD application window on January 12, 2012 and the Registry Operator submitted its TLD registry application, as well as way before the .Brand category of TLDs was recognized by ICANN. Rather, the trademark application for HANGOUTS was filed shortly after the new brand was more widely distributed in 2012 under a normal trademark application filing strategy of protecting a new business's nascent trademark rights.

Moreover, not only are Google's HANGOUTS services bona fide and not "token use" of a mark made to support a trademark and/or .Brand application, they have been heavily advertised, routinely covered by the press, and extremely popular, with millions of online chats having been held using the HANGOUTS service since its first use. Such promotion and use of the HANGOUTS mark, including its singular form HANGOUT, has firmly ingrained these marks into the minds of Internet users as service identifiers for Google's legitimate online chat services. As affirmed in its registration policies, Google will not allow third parties to register domain

names in the TLD unless they are affiliates of or trademark licensees, and Google will control the DNS records of each domain name in the TLD, which further demonstrates the bona fide intent of the mark and its corresponding TLD. See Exhibit B. Accordingly, Internet users will see .HANGOUT and immediately know that it will be used for Google's online services. Evidence showing Google's June 28, 2011 use of the mark for the services identified in the submitted trademark registration is attached hereto as Exhibit E.

With no evidence suggesting any other intent in applying for the supporting registration, the timing of its registration corresponds with the startup of Google's bona fide HANGOUTS services and corresponding trademark protection strategy, and thus should support the .HANGOUT TLD's qualification as a .Brand TLD.

- d. **Continuous Trademark Use.** Registry Operator's Affiliate Google has continuously used the HANGOUTS mark in connection with all of the services identified in the submitted trademark registration since at least as early as June 28, 2011, and intends to maintain such use through the Term of the Registry Agreement. Specimens showing Google's use of the mark for the services identified in the submitted trademark registration are attached hereto as Exhibit D.
 - e. **No Punctuation.** The HANGOUTS and HANGOUT marks do not begin with a period or dot. See Exhibits A, D.
 - f. **Trademark Unrelated To Registry Services.** Registry Operator's Affiliate Google has continuously used the HANGOUTS mark in connection with all of the services identified in the submitted trademark registration since at least as early as June 28, 2011, and intends to maintain such use through the Term of the Registry Agreement. See Exhibits A, D. The services identified in the submitted trademark registration and supporting specimens do not reference the provision of any TLD Registry Service, as defined in Section 2.1 of Specification 6 of the Registry Agreement.
- ii. **Registrants and DNS Record Control.** As detailed in its Registration Policies (See Exhibit B), only Registry Operator, its Affiliates or Trademark Licensees are eligible to be registrants of domain names in the TLD and control the DNS records associated with domain names at any level in the TLD.
 - iii. **Non-Generic String.** The applied-for TLD HANGOUT is not a Generic String TLD as defined in Specification 11 of the Registry Agreement. As defined in Section 3(c) of Specification 11 of the Registry Agreement, "Generic String" means 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. "Hangout(s)" is not a general class of goods or services, but is a specific brand

of goods or services offered by Google. At the Hong Kong Intellectual Property Department, Trademark Examiners substantively analyze trademark applications to determine if they are unregistrable for being generic in relation to the applied-for goods and services. [REDACTED]

(a). Registry Operator's Affiliate Google holds a presumptively valid Hong Kong trademark registration [REDACTED] for the HANGOUTS mark, meaning that it is the opinion of the Hong Kong Intellectual Property Department that the word HANGOUTS is not generic, and that it distinguishes a specific brand of services from the services of others. Indeed, no trademark office or court has held that Google's HANGOUTS mark is generic for the services identified in its registration.

- iv. **Registration Certificate.** Registry Operator has provided ICANN with an accurate and complete copy of a Hong Kong trademark registration ([REDACTED]) for the HANGOUTS mark. See Exhibit A.

For all of the reasons stated above, ICANN should qualify the .HANGOUT TLD as a .Brand TLD.

Registry Operator agrees that if Registry Operator makes any changes to its registration policies for the TLD (whether before or after this application has been approved) that may disqualify the TLD as a .Brand TLD, it will promptly provide ICANN with a complete and accurate copy of the revised registration policies. In addition, if Registry Operator fails to maintain the trademark registration underlying its .Brand TLD application, it shall promptly notify ICANN of such failure. Registry Operator also agrees to maintain the criteria required to qualify as a .Brand TLD and to immediately notify ICANN of any changes in circumstances that could alter the statements made, and supporting materials provide with, this application.

Registry Operator acknowledges and agrees that this letter is binding on Registry Operator and, if any of the foregoing representations and agreements becomes untrue or not complied with, it shall be deemed a breach of the Registry Agreement by Registry Operator, and ICANN may assert its rights under the Registry Agreement, including by determining that the TLD no longer qualifies as a .Brand TLD pursuant to the terms of Specification 13.

Questions about this request should be directed to Sarah Falvey.

Submitted by: [REDACTED]

Position: [REDACTED]

Dated: [REDACTED]

[REDACTED]

[REDACTED] g [REDACTED]

Exhibit A

Trademark Registration



商標註冊證明書
《商標條例》(第 559 章)
CERTIFICATE OF REGISTRATION OF TRADE MARK
Trade Marks Ordinance (Chapter 559)

茲證明下述商標之詳情於今日記入註冊紀錄冊:

I hereby certify that the Trade Mark with the following particulars has been entered in the register today:

商標編號:
Trade Mark No.:



商標:
Mark:

HANGOUTS

商標種類:
Mark Type:

Ordinary

商標描述:
Mark Description:

N/A

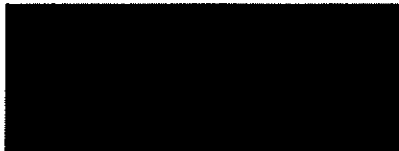
一系列商標:
Series Mark:

No

擁有人姓名/名稱、
地址:
Owner(s)' Name,
Address:



擁有人的送達地址:
Owner(s)' Address for
Service:



類別及貨品/服務說明:
Class(es) & Specification(s):

Class 9

(A) Downloadable software for publishing and sharing digital media and information via global computer and communication network; (B) computer software; computer software development tools; electronic and on-line manuals.

Class 38

(A) Telecommunications services, namely, electronic transmission of data and digital messaging via global computer and

communication networks; providing online forums, chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; digital multimedia broadcasting services over the Internet, namely posting, displaying, and electronically transmitting data in the fields of general interest; (B) digital multimedia broadcasting services over the Internet, namely posting, displaying, and electronically transmitting audio and video; providing access to computer databases in the fields of general interest; communication and telecommunication services; provision of communications facilities for interchange of electronic data; provision of communication and telecommunication facilities for interactive discussion and communication.

Class 41

(A) Entertainment services, namely, providing temporary use of non-downloadable interactive multiplayer and single player games played via global computer and communication networks; (B) entertainment services.

Class 42

(A) Providing temporary use of on-line non-downloadable software for publishing and sharing digital media and information via global computer and communication networks; Providing temporary use of on-line non-downloadable software development tools; Providing temporary use of on-line non-downloadable software for use as an application programming interface (API); Providing a web hosting platform for others for organizing and conducting meetings, social events and interactive text, audio, and video discussions; Providing an on-line network environment that features technology that enables users to share data; (B) computer services; on-line computer services; computer software services; computer software technical support services; updating and maintenance of computer software; advisory and consultancy services relating to all the aforesaid services.

卸棄: Disclaimer:	N/A
限制: Limitation:	N/A
條件: Condition:	N/A
其他: Others:	N/A

註冊日期: 27.11.2012
Date of Registration:

聲稱具有優先權的日期:
Dates of Priority Claimed:

優先權申請編號:
Priority Application No.:

優先權申請的
國家、地區、地方:
Country, territory, area of
Priority Applications:

FRANCE (for goods and services listed in (A))

日期: 2013年8月30日
Date: 30 August, 2013

註:
Note:

1. 註冊由上述註冊日期起計為期 10 年，在該期間屆滿時，可再每次續期 10 年。
Registration is for a period of 10 years beginning on the date of registration. At the end of that period, it may be renewed successively for further periods of 10 years.
2. 本證明書不可用於法律程序，或用以取得外地註冊。
This certificate is not for use in legal proceedings or for obtaining registration abroad.
3. 本商標的擁有權如有改變，或擁有人的姓名/名稱及/或地址/送達地址改變，必須立刻向商標註冊處處長申請更改註冊。
Upon any change of ownership of this trade mark, or change of name and/or address /address for service of the registered owner, application should AT ONCE be made to the Registrar of Trade Marks to register the change.

Exhibit B

.Hangout TLD Registration Policies

Mission

The mission of the proposed gTLD is to strengthen the brand relationship between Google's Hangouts services and select Hangouts users and to simplify the Hangouts user experience by hosting select Hangouts content. Second-level domains in the proposed gTLD, .hangout, will automatically be delegated to Google's DNS servers, which will in turn provide authoritative DNS responses pointing the user's web browsers to Hangouts. This mission will enhance consumer choice by providing new availability in the second-level domain space for select users on Hangouts, creating new layers of organization on the Internet, improving the Hangouts user experience, and signaling that only select Hangouts content is available in the domain.

In addition, the .Hangout gTLD will clearly be differentiated from other gTLDs due to its purposefully limited scope. This differentiation includes:

- (1) A clear indicator that second-level domains within the gTLD offer a particular, targeted content; and
- (2) because the gTLD will be associated with a branded offering, Internet users will immediately be able to rely on the quality of the product.

Registration Policies

Registry Operator believes that the .Hangout gTLD will best add value to the gTLD space by remaining completely closed for use by Google. Second-level domain names within the proposed gTLD are intended for registration by Registry Operator, its affiliates and their trademark licensees.

Google's existing business and marketing decision-making channels will define policies and manage decisions, in accordance with the technical specifications in Registry Operator's agreement with ICANN, regarding the reservation, activation, allocation, registration and DNS Records of all domain names within the TLD. Once a name considered for reservation, activation, and/or registration has been reviewed and deemed in compliance with internal rules and procedures, the name will be approved by authorized employees of Google and submitted for reservation, activation, and/or registration through an ICANN-accredited registrar in accordance with the Registry Agreement. The registration and use of domain names in the gTLD will also be shaped by Registry Operator's:

- (1) Abuse prevention policy (available at <http://www.google.com/registry/policies/domainabuse/>); and

(2) Privacy policy (available at <http://www.google.com/registry/privacy.html>).

If multiple parties affiliated with the Registry Operator express an interest in registering the same domain name, the designated personnel will make the decision regarding which party's registration and use of the domain name is a higher business priority.