

INTERNATIONAL CENTRE FOR DISPUTE RESOLUTION

New gTLD String Confusion Panel

Re: ICDR Case Nos. 50 504 221 13 and 50 504 246 13 (Consolidated)

Web.com Group, Inc., Objector

and

Vistaprint Limited, Applicant

String: <.webs>

Expert Determination

The Parties

The Objector is Web.com Group, Inc., 12808 Gran Bay Parkway, West Jacksonville, Florida 32258 U.S.A., represented by Steven C. Sereboff, Esq., SoCal IP Law Group LLP, 310 North Westlake Boulevard, Suite 120, Westlake Village, California 91362 U.S.A.

The Applicant is Vistaprint Limited, 22 Victoria Street, Canon's Court, Hamilton, Bermuda, BAHAMAS, HM12, represented by Flip Petillion, Advocaat, Crowell & Moring, Rue Joseph Stevens 7, Brussels, 1000, BELGIUM.

The New gTLD Objected To

The new gTLD string applied for and objected to is <.webs>.

Prevailing Party

The Objector has prevailed, and the Objection is sustained.

The New gTLD String Confusion Process

In June 2011, the Internet Corporation for Assigned Names and Numbers ("ICANN") approved the gTLD Applicant Guidebook ("Guidebook"), regarding applications for new generic top level domains ("gTLDs"). Module 3 of the Guidebook, Objection Procedures ("Module 3"), addresses, *inter alia*, dispute resolution procedures when

a third party files an objection to an application. Attachment to Module 3, New gTLD Dispute Resolution Procedure (“Attachment to Module 3”), provides for procedures that “apply to all proceedings administered by each of the dispute resolution service providers (DRSP).”

Article 1(b) of Attachment to Module 3 states: “The new gTLD program includes a dispute resolution procedure, pursuant to which disputes between a person or entity who applies for a new gTLD and a person or entity who objects to that gTLD are resolved in accordance with this New gTLD Dispute Resolution Procedure”

There are four separate grounds on which an objection to an application of a new gTLD may be made.¹ One of these grounds is the string confusion objection, in which “[t]he applied-for gTLD string is confusingly similar to an existing TLD or to another applied-for gTLD string in the same round of applications.”² Article 3(a) of Attachment to Module 3 states that “String Confusion Objections shall be administered by the International Centre for Dispute Resolution.” In accordance with this mandate, on January 10, 2012, the International Centre for Dispute Resolution (“ICDR”) issued its Supplementary Procedures for String Confusion Objections (“ICDR Procedures”).

Procedural History of This Case

The ICDR has informed the Panel of the following history.

The Objector filed this String Confusion Objection, with annexes thereto, on March 13, 2013. Pursuant to Paragraph 3.4.2 of Module 3, and Article 12 of Attachment to Module 3, the ICDR consolidated the two cases, on May 6, 2013. On May 23, 2013, the Applicant/Respondent filed its Response and annexes thereto. On June 28, 2013, the ICDR appointed a panelist for an Expert Determination. On July 19, 2013, the Objector submitted its Objector’s Reply to Applicant’s Response, with annexes thereto. On July 31, 2013, the Applicant submitted a statement objecting to the Objector’s supplemental filing, to which the Objector responded, on August 5, 2013. On August 8, 2013, the appointed panelist acknowledged receipt of the Objector’s Reply to Applicant’s Response and the parties’ respective statements dated July 31, and August 5, 2013, and instructed, “Under Article 17 of [Attachment to Module 3], I hereby authorize Applicant to submit a surreply, not to exceed 5 pages, and any additional annexes, no later than 6 September 2013.” The Applicant filed its Surreply and annexes thereto, on August 29, 2013.

¹ Module 3 ¶ 3.2.1; Attachment to Module 3 art. 2(e).

² Module 3 ¶ 3.2.1. Likewise, Article 2(e)(i) of Attachment to Module 3 provides: “String Confusion Objection’ refers to the objection that the string comprising the potential gTLD is confusingly similar to an existing top-level domain or another string applied for in the same round of applications.”

On October 1, 2013, under Article 2 of the ICDR Procedures, the ICDR removed the initial panelist. On October 14, 2013, the ICDR, under Article 3 of the ICDR Procedures, appointed a replacement panelist. On November 4, 2013, the ICDR removed the second panelist.

On November 20, 2013, the ICDR appointed Professor Ilhyung Lee to serve as the Panel, with notice to counsel for both parties. Before the appointment, the Panel stated that it has no disclosure of any circumstances that would likely give rise to justifiable doubts as to the Panel's impartiality or independence, as required by Article 1 of the ICDR Procedures, and to ensure compliance with the Guidebook.³

Basis for Objector's Standing to Object Based on String Confusion

Paragraph 3.2.2 of Module 3 requires that an objector must satisfy the standing requirement in order for its objection to be considered. Regarding standing for a string confusion objection, Paragraph 3.2.2.1 states in relevant part,

Any gTLD applicant in this application round may file a string confusion objection to assert string confusion between an applied-for gTLD and the gTLD for which it has applied, where string confusion between the two applicants has not already been found in the Initial Evaluation. That is, an applicant does not have standing to object to another application with which it is already in a contention set as a result of the Initial Evaluation.

Here, Web.com Group, Inc., the Objector, is an applicant for the gTLD string <.web>. In the Initial Evaluation, ICANN placed the Objector's <.web> gTLD in String Contention Set 222, and the Applicant's <.webs> gTLD in String Contention Set 223.

The Objector has satisfied the standing requirement.

Parties' Contentions

A. The Objector

The Objector asserts principally that it has standing to file this String Confusion Objection, and that it has met its burden of proving that the Applicant's applied-for gTLD <.webs> is likely to result in string confusion, under Paragraph 3.5.1 of Module 3. In summary, the Objector states:

WEB and WEBS are merely the plural and singular forms of the same word. As a result the two strings are virtually indistinguishable in sight, sound and meaning such that there is a strong likelihood that average, reasonable

³ Module 3 ¶ 3.4.4; Attachment to Module 3 art. 13(c).

Internet users would be confused or deceived if the two strings were delegated.⁴

In addition, the Objector:

>states that confusion is “especially acute for non-native English speakers”, who “commonly confuse plural and singular word forms or omit the plural all together”, and also notes that “the vast majority of Internet users are non-native English speakers”;⁵

>relies on the conclusions of an expert with “a doctoral degree in linguistics (morphophonology)”,⁶ who stated that the average reasonable Internet user “may or may not notice the extra ‘s’ on the end. This is particularly true in the context of an Internet gTLD, which will appear to the Internet user at the end of a longer letter string that incorporates at the very least a second-level domain name that is the focus of what the Internet user is searching to find”;⁷

>refers also to its expert’s conclusions:

In my opinion “web” and “webs” fall into a category where there is more likelihood of confusion between them than there might be with other noun/noun + plural morpheme words, given the similarities in orthography, phonology and concept, particularly as these terms are already used interchangeably in some contexts.

For this reason, there is a high likelihood of confusion in the minds of the “average, reasonable Internet user,” who would be viewing these nearly identical letter strings as top-level domain names at the end of longer URL strings that contain material which is more important to and more easily distinguishable for the typical user.⁸

⁴ Objector’s String Confusion Objection at 3 [hereinafter Objection].

⁵ *Id.* at 5 (emphasis in original). In this regard, the Objector relies on its linguistics expert, who reported that less than 14% of the Internet users in the world are from English-speaking countries. Objector’s Reply to Applicant’s Response Annex R1 at 3 [hereinafter Annex R1].

⁶ Annex R1, *supra* note 5, at 1.

⁷ *Id.* at 3.

⁸ *Id.* at 5. The Objector’s linguistics expert also offered a sharp critique of the report submitted by her counterpart on the Applicant’s side, stating, among other things, that the Applicant’s expert is “an expert in French linguistics. . . . The average, reasonable Internet user probably does not speak French.” *Id.* at 4.

>points to “abundant evidence of actual confusion between WEBS and WEB”, including confusion by U.S. law enforcement agencies, the Applicant’s own customers, and the Applicant itself;⁹ and

>refers to numerous court decisions and decisions under the Uniform Domain Name Dispute Resolution Policy that have found confusing similarity between singular and plural forms of the same noun.

B. The Applicant

The Applicant contends principally that the Objector has failed to meet its burden of proving that the Applicant’s applied-for <.webs> is likely to result in string confusion. In addition, the Applicant states, *inter alia*, that:

*the <.webs> and <.web> strings are different, visually, aurally, and in meaning:

Visually, the ‘S’ is a clear differentiator because it is positioned at the end of the short word (which gives it priority in the processing of word recognition) and it has the function to indicate the plural, which is a regular plural.¹⁰

[A]urally, the strings are different. . . . [B]oth ‘webs’ and ‘web’ consist of completely regular patterns and are spelled out exactly as they sound. In other words, all letters are clearly pronounced in both words, which makes the words clearly recognizable and distinct from one another.¹¹

The strings have a different meaning. ‘Web’ refers to the world wide web or to a network or silken structure created by a spider . . . , whereas ‘webs’ has no particular meaning and could be anything. On Wikipedia, ‘webs’ is used for the Applicant’s web hosting services, a radio station and a 2003 sci-fi movie ‘Web’ on the other hand has a clear dictionary meaning¹²

⁹ Objection at 7-8.

¹⁰ Applicant’s Response at 9.

¹¹ *Id.* at 10.

¹² *Id.*

*“[t]he difference between the .WEBS and .WEB strings is grounded in the character ‘S’ present in the first and not part of the second. In linguistic terms, the character ‘S’ is manifestly distinct”;¹³

*the Objector failed to produce any evidence in support of the argument “that the vast majority of Internet users are non-native English speakers and that non-English speakers commonly confuse plural and singular word forms or omit the plural altogether”, and also asks, “[H]ow can the Objector (without any evidence) know what a non-native English speaker sees and not, or what he distinguishes and she does not?”;¹⁴

*there is no evidence of actual confusion;

*“ICANN’s String Similarity Assessment Tool provides a low similarity rate”, and when comparing <.webs> and <.web>, the “similarity rate is 72%[,] . . . which is much lower than the similarity rate of various TLDs that currently co-exist”;¹⁵

*“neither the String Similarity Panel nor ICANN (who endorses the determinations by the String Similarity Panel) were of the opinion that the .WEBS and .WEB strings are so similar that they would create a probability of user confusion if allowed to coexist in the DNS”;¹⁶

*in addition to the Objector, there are six other applicants for the <.web> gTLD, and none of these applicants has filed a string confusion objection against the Applicant;¹⁷

*given that there are multiple applicants for the Objector’s applied-for gTLD <.web>, while there are no other applicants for <.webs> other than the Applicant, “The Objector has realized that it faces a challenge in obtaining the delegation of the .WEB extension,” and “[t]he Objector’s sole motive in filing the objection is to prevent a potential competitor, who does not have the

¹³ *Id.* at 8.

¹⁴ *Id.* at 11.

¹⁵ *Id.* at 6. The Applicant further states, “The 72% similarity is also much lower than the 88% similarity between the applied-for .ACCOUNTANTS and .ACCOUNTANT or the 84% similarity between the applied-for .COUPONS and .COUPON The applicants for these strings did not file a string confusion objection.” *Id.*

¹⁶ *Id.* at 7.

¹⁷ *Id.* at 3.

intention to create goodwill in the Objector's name, from entering the gTLD market";¹⁸

*"the Objector seeks to use the string confusion objection to limit competition. Such use of the objection proceedings directly conflicts with the purpose of ICANN's new gTLD program";¹⁹

*the Applicant uses the <webs.com> domain name for the Applicant's business of providing "free website creation tools and hosting services", while the Objector uses its <web.com> domain name for "web site development services," the two parties "have co-existed for many years without any problem",²⁰ and "[t]he Objector has never instituted a formal challenge to the WEBS.COM domain name";²¹

*while the Objector and a third party agreed that there was no likelihood of confusion between the Objector's WEB.COM and the third party's WEB.COM, and having "enjoyed long coexistence without any known instances of actual confusion", "it is impossible to understand how the Objector can agree to coexistence between WEB.COM and WEB.COM and yet object to a coexistence between WEB and WEBS";²² and

*"[w]hereas the letter 'S' in 'WEBS.COM' makes 'WEBS.COM' clearly differ from 'WEB.COM', the difference between a 'WEBS' TLD and a 'WEB' TLD is even greater. As a TLD will always come at the end of the domain name syntax, the distinctive letter 'S' will always appear at the end, making this last letter more significant."²³

The Applicant also relies on the findings of an expert, a professor "in linguistics and language teaching methodology",²⁴ who made the following findings:

Exterior letters serve as visual clues for word recognition. The first and last letters of a word have been shown to be more salient than the rest of the

¹⁸ *Id.* at 11.

¹⁹ *Id.* at 4.

²⁰ *Id.* at 2.

²¹ *Id.* at 7.

²² *Id.*

²³ *Id.* at 7-8.

²⁴ *Id.* at 8.

letters and to receive priority in processing. Readers can recognize a word even when its interior letters are scrambled.

....

In the case of 'web' and 'webs', completely regular patterns allow for a one-to-one mapping of spelling to sound. In other words, a word that consists of completely regular patterns is spelled out exactly as it sounds. The sound of the word easily translates into the spelling of the word and *vice versa*. Words consisting of completely regular patterns facilitate word recognition.

....

[T]here is an extremely limited number of words that could be generated by changing only one single letter in 'webs' and 'web'. In other words, 'webs' and 'web' have a limited number of orthographic neighbors. Words with a high number of orthographic neighbors are more difficult to recognize and have an inhibitory effect when reading, as evidence by eye-fixation patterns. Words with fewer orthographic neighbors are more easily recognizable.

....

[A] reader will first decompose the word 'webs' into meaningful units. 'Webs' is composed of two meaningful units, namely 'web' and the plural marker '-s'. 'Web' only has one meaningful unit.²⁵

²⁵ *Id.* at 8-9. The Applicant also responds to the assertion made by the Objector's expert that the Applicant's expert is an expert in *French* linguistics:

The Objector claims that [the Applicant's expert] is a professor of French linguistics and language pedagogy and that he would therefore not be qualified to express an opinion on the meaning of English words such as webs and webs [sic].

While it is correct that [the Applicant's expert] teaches French linguistics, he has been building relevant and profound expertise in various domains of Applied Linguistics for many years. In this respect, he has performed in-depth analysis of various West-European languages, including English. At the same time, he has also built strong expertise in General Linguistics, which gave him a thorough understanding and comprehension of the mechanisms that form the basis of the functioning of the human language. . . .

In contrast, the consultant that was hired by the Objector and who wrote the "criticism" of [the Applicant's linguistics expert's] opinion, has only published very modestly and almost exclusively in conference proceedings, *i.e.*, with high acceptance rates and not systematically with double-blind peer review This, in combination with the fact that, ever since her doctoral thesis (carried out many years ago), she has been active in consultancy rather than in an academic

The Applicant refers to the Expert Determinations issued in string confusion objections involving the applied-for gTLD strings, <.cars>, <.tvs>, and <.hotels>, in which each of the three panels separately concluded that there was no likelihood of string confusion.²⁶

Discussion and Findings

The Panel issues this Expert Determination, under Paragraph 3.4.6 of Module 3.

Before turning to the merits, the Panel pauses to commend counsel for both parties for their zealous representation and comprehensive argument.

The Guidebook governs here. Paragraph 3.5.1 of Module 3 instructs that “[a] DRSP panel hearing a string confusion objection will consider whether the applied-for gTLD string is likely to result in string confusion”, and further guides:

[i] String confusion exists where a string so nearly resembles another that it is likely to deceive or cause confusion. [ii] For a likelihood of confusion to exist, it must be probable, not merely possible that confusion will arise in the mind of the average, reasonable Internet user. Mere association, in the sense that the string brings another string to mind, is insufficient to find a likelihood of confusion.²⁷

The Objector bears the burden of proof.²⁸

environment, . . . probably explains why her opinion does not contain a single reference to scientific literature.

Applicant’s Surreply at 1.

²⁶ Applicant’s Surreply at 4. The Applicant submitted full copies of the three Expert Determinations. *Id.* Annexes 79 (*Charleston Road Registry Inc. v. Koko Castle, LLC*, ICDR Case No. 50 504 233 13 (Aug. 7, 2013) (<.cars>)), 80 (*Verisign Switzerland SA v. T V Sundram Iyengar & Sons Limited*, ICDR Case No. 50 504 257 13 (Aug. 8, 2013) (<.tvs>)), 81 (*HOTEL Top-Level-Domain S.a.r.l v. Booking.com B.V.*, ICDR Case No. 50 504 237 13 (Aug. 8, 2013) (<.hotels>)). The Panel will discuss herein these and other Expert Determinations of interest.

²⁷ Module 3 ¶ 3.5.1. *See* Attachment to Module 3 art. 2(e)(i) (“‘String Confusion Objection’ refers to the objection that the string comprising the potential gTLD is confusingly similar to an existing top-level domain or another string applied for in the same round of applications.”).

²⁸ Module 3 ¶ 3.5; Attachment to Module 3 art. 20(c).

[i] *String confusion exists where a string so nearly resembles another that it is likely to deceive or cause confusion.*

Module 2 of the Guidebook, Evaluation Procedures, explains that the String Similarity Review by the String Similarity Panel during the Initial Evaluation entails a “preliminary comparison” of the applied-for gTLD with other strings, a “visual similarity check”.²⁹ But during the formal string confusion objection stage, the objection “is not limited to visual similarity. Rather, confusion based on any type of similarity (including visual, aural, or similarity of meaning) may be claimed by an objector.”³⁰

The Panel concludes that the <.webs> string so nearly resembles <.web> -- visually, aurally and in meaning -- that it is likely to cause confusion. A contrary conclusion, the Panel is simply unable to reach. The Applicant’s <.webs> is visually identical to the Objector’s <.web>, except for the letter “s” at the end of “.web”. When read aloud, the words in the two strings also sound the same, again with only the phonetic “s” at the end of “web” distinguishing the two. Regarding the meaning of “web”, the Panel is not entirely unsympathetic to the Applicant’s argument that “web” commonly refers to the world wide web, and as such, it is not normally a word where the plural form would be used. Nevertheless, “web” is also used in the context of, for example, a “spider web”, and “webs” is the plural of “web”. Considering all of the indicia of similarity, the Panel determines that the resemblance between <.webs> and <.web> is likely to cause confusion.

The nature of the difference between the two strings is significant. In the Panel’s view, the addition of “s” to the end of “.web” resulting in another string would lead to confusion, whereas the addition of a different letter to the end of another three-letter noun may not. For example, there is a distinction between “web” and “webs”, on the one hand, and “tub” and “tuba”, on the other.

[ii] *For a likelihood of confusion to exist, it must be probable, not merely possible that confusion will arise in the mind of the average, reasonable Internet user. Mere association, in the sense that the string brings another string to mind, is insufficient to find a likelihood of confusion.*

The Guidebook requires that in order for the string confusion objection to be sustained, the likelihood of confusion between the two gTLDs must be (a) probable,

²⁹ Module 2 ¶ 2.2.1.1.

³⁰ Module 2 ¶ 2.2.1.1.3. Paragraph 2.2.1.1 elaborates on the nature of the similarity review at the Initial Evaluation in relation to the review during the string confusion objection phase: “The visual similarity check that occurs during Initial Evaluation is intended to augment the objection and dispute resolution process (see Module 3, Dispute Resolution Procedures) that addresses all types of similarity.”

not merely possible (b) in the mind of the average, reasonable Internet user. The Guidebook does not define “average, reasonable Internet user”. It appears to be ICANN’s intention to allow individual panelists to determine the likely perceptions of such Internet user. Nor does the Guidebook elaborate on the distinction between probability and possibility of confusion, other than the text relied on by the Applicant (and all applicants in string confusion objections) that “[m]ere association, in the sense that the string brings another string to mind, is insufficient”.³¹

The Panel concludes that given the similarity of <.webs> and <.web> as discussed above, it is probable, and not merely possible, that confusion will arise in the mind of the average, reasonable Internet user. This is not a case of “mere association”. A more apt example of mere association between two strings would be the hypothetical gTLD <.twoweb>, which would likely “bring to mind” another hypothetical gTLD <.oneweb>. In contrast, the presence of <.webs> in the same net that also includes <.web>, and vice versa, requires Internet users actively to differentiate between the two.

In reaching its decision, the Panel has the benefit of reviewing the ten previously issued Expert Determinations (as of this date) stemming from string confusion objections involving precisely the same situation seen in this Objection, i.e., where the gTLD objected to is the plural form of the objector’s gTLD, indicated by the addition of the letter “s” to the end of the objector’s string.³² All of these determinations are publicly available on the ICDR Internet site.³³ The determinations resolved objections to the following seven applied-for gTLDs: <.cars> (three separate decisions³⁴), <.games>,³⁵ <.hotels>,³⁶ <.pets> (two separate

³¹ Module 3 ¶ 3.5.1.

³² Not included in this list are the decisions involving <.hoteles> and <.hoteis>, in which the party that applied for <.hotel> filed separate string confusion objections.

³³ International Centre for Dispute Resolution, *ICANN New gTLD Program: ICDR Dispute Resolution Process - String Confusion Objections*, at <http://images.go.adr.org/Web/AmericanArbitrationAssociation/%7Bdf3f46b6-4c35-4bd1-a428-7c70d7dbe53b%7D_ICANN_DRP_StringConfusion_Objections.pdf>.

³⁴ *Charleston Road Registry Inc. v. Koko Castle, LLC*, ICDR Case No. 50 504 233 13 (Aug. 7, 2013) (Panelist Paul E. Mason); *Charleston Road Registry Inc. v. DERCars, LLC*, ICDR Case No. 50 504 234 13 (Aug. 27, 2013) (Panelist John A.M. Judge); *Charleston Road Registry Inc. v. Uniregistry, Corp.*, ICDR Case No. 50 504 238 13 (Oct. 10, 2013) (Panelist Hon. Neil Anthony Brown QC).

³⁵ *Charleston Road Registry Inc. v. Foggy Beach, LLC*, ICDR Case No. 50 504 243 13 (Sep. 19, 2013) (Panelist Earl A. Cherniak, Q.C.).

decisions³⁷), <.sports>,³⁸ <.tours>,³⁹ and <.tvs>.⁴⁰ These decisions are not binding on the Panel, but are of interest, in that they may offer persuasive reasoning and analysis.

Decisions in accord

The Panel's determination herein finding similarity and probable confusion between the Applicant's <.webs> and the Objector's <.web> is consistent with the result in six of the reported "plural form" Expert Determinations, those involving: <.cars> (but just one of the three cases⁴¹), <.games>,⁴² <.pets> (both cases⁴³), <.sports>,⁴⁴ and <.tours>.⁴⁵ In each of these decisions, the panelist determined that the applicant's plural form string was confusingly similar, visually, aurally, and in meaning, to the objector's string in singular form, and that confusion was probable.

Contrary decisions

The Panel acknowledges that there are determinations involving the plural form of the objector's string, in which the panelist decided that the objector did not meet its burden of proving likelihood of string confusion, and thus dismissed the objection.

³⁶ *HOTEL Top-Level-Domain S.a.r.l v. Booking.com B.V.*, ICDR Case No. 50 504 237 13 (Aug. 8, 2013) (Panelist Bruce W. Belding).

³⁷ *Charleston Road Registry Inc. v. John Island, LLC*, ICDR Case No. 50 504 274 13 (Aug. 14, 2013) (Panelist Richard W. Page) [hereinafter *John Island, LLC*]; *Afilias Limited v. John Island, LLC*, ICDR Case No. 50 504 219 13 (Oct. 20, 2013) (Panelist Urs Laeuchli) [hereinafter *Afilias Limited*].

³⁸ *SportAccord v. Steel Edge LLC*, ICDR Case No. 50 504 210 13 (Aug. 20, 2013) (Panelist M. Scott Donahey).

³⁹ *Charleston Road Registry Inc. v. Sugar Station, LLC*, ICDR Case No. 50 504 275 13 (Aug. 16, 2013) (Panelist Robert M. Nau).

⁴⁰ *Verisign Switzerland SA v. T V Sundram Iyengar & Sons Limited*, ICDR Case No. 50 504 257 13 (Aug. 8, 2013) (Panelist Stephen S. Strick).

⁴¹ *DERCars, LLC*. As to the other two cases, see *infra* note 48.

⁴² *Foggy Beach, LLC*.

⁴³ *John Island, LLC; Afilias Limited*.

⁴⁴ *SportAccord*.

⁴⁵ *Sugar Station, LLC*.

These four cases involve (1) <.tvs>,⁴⁶ (2) <.hotels>,⁴⁷ and the other two decisions involving (3) and (4) <.cars>.⁴⁸ As indicated above, the Applicant relies on three of these determinations.⁴⁹ The Panel offers the following observations in regard to these decisions.

(1) *Verisign Switzerland SA v. T V Sundram Iyengar & Sons Limited*, ICDR Case No. 50 504 257 13 (Aug. 8, 2013) (<.tvs>).

In the determination involving the <.tvs> gTLD, the panelist relied on “the analysis of the thirteen factors . . . derived from [*Application of E.I. DuPont DeNemours & Co.* 50]”.⁵¹ In *DuPont DeNemours*, a U.S. court looked to the multiple factors to assess the likelihood of confusion between the applicant’s trademark “RALLY” for “a combination polishing, glazing and cleaning agent for use on automobiles”, and the previously registered “RALLY” for “an all-purpose detergent.”⁵² Initially, the Panel questions whether the factors to be considered when “testing for likelihood of confusion under Sec. 2(d)”⁵³ of the Lanham Act should be the test for determining

⁴⁶ *Verisign Switzerland SA*.

⁴⁷ *HOTEL Top-Level-Domain S.a.r.l.*

⁴⁸ *Koko Castle, LLC; Uniregistry, Corp.* To state it explicitly, there are three string confusion objection cases, all filed by Charleston Road Registry Inc. (which had applied for the <.car> gTLD), challenging the application of <.cars> by three separate parties. Panelists Paul E. Mason and The Honourable Neil Anthony Brown QC separately determined that the respective applicant’s <.cars> was not confusing with the objector’s <.car>, while Panelist John A.M. Judge reached the opposite conclusion, *DERCars, LLC*. Thus, conflicting determinations resulted in the objections to the very same gTLD. As to this circumstance, Panelist Brown QC observed:

[I]t is difficult for the Expert to decide how ICANN might deal with the potential conflicts . . . , but the process is ICANN’s, it has control over the entirety of the process, it seems to have contemplated that some such problem may arise during the process and it is ICANN’s role to manage the remainder of the process. Indeed, the parties are bound by ICANN’s process[;] they have agreed to it by virtue of taking part in it

Uniregistry, Corp. at 7.

⁴⁹ See *supra* text accompanying note 26.

⁵⁰ 476 F.2d 1357 (C.C.P.A. 1973).

⁵¹ *Verisign Switzerland SA* at 5.

⁵² 476 F.2d at 1359.

⁵³ *Id.* at 1361. The thirteen factors are:

likelihood of confusion between two gTLD strings -- <.webs> and <.web>.⁵⁴ Moreover, assuming, but only *arguendo*, that the *DuPont DeNemours* factors are pertinent in assessing string confusion, some of the factors do not weigh in the Applicant's favor. In the <.tvs> determination, the panel noted as a matter of factual background that the applicant's "TVS Brand was created over 100 years ago, [and] is a well known brand, . . . with global revenues of US\$7 Billion in Financial Year 2012-13."⁵⁵ This, as well as other descriptions of the string objected to in *Verisign Switzerland SA*, is simply inapt in the present case.

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i. e. "impulse" vs. careful, sophisticated purchasing.
- (5) The fame of the prior mark (sales, advertising, length of use).
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
- (10) The market interface between applicant and the owner of a prior mark:
 - (a) a mere "consent" to register or use.
 - (b) agreement provisions designed to preclude confusion, i. e. limitations on continued use of the marks by each party.
 - (c) assignment of mark, application, registration and good will of the related business.
 - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
- (12) The extent of potential confusion, i. e., whether *de minimis* or substantial.
- (13) Any other established fact probative of the effect of use.

Id.

⁵⁴ Two panelists have commented on the applicability of trademark law decisions on string confusion objections: "Trademark law standards do not entirely fit here . . ., because the Objector's string <.CAR> is generic and hence ineligible for trademark protection", *Koko Castle, LLC* at 5 (Panelist Mason); "for purposes of this St[r]ing Confusion Objection, the decisions . . . of American trademark law involved different standards and will not be applied", *John Island, LLC* at 10 (Panelist Page).

⁵⁵ *Verisign Switzerland SA* at 4.

(2) *HOTEL Top-Level-Domain S.a.r.l v. Booking.com B.V.*, ICDR Case No. 50 504 237 13 (Aug. 8, 2013) (<.hotels>).

In the string confusion objection involving the <.hotels> gTLD, the panelist stated that “it [is] undisputed that the words ‘hotel’ and ‘hotels’ are similar, with only the addition of an ‘s’ differentiating them visually”.⁵⁶ He nevertheless concluded that the strings are “sufficiently visually and aurally different for string confusion purposes.”⁵⁷ The panelist explained: “I find persuasive [i] the degrees of similarity or dissimilarity between the strings by use of the String Similarity Assessment Tool . . ., [ii] that ICANN did not put the applications for .HOTEL and .HOTELS in the same contention set . . ., and [iii] the analysis and conclusions of the independent expert retained by Applicant.”⁵⁸

First, ICANN’s String Similarity Assessment Tool, while relevant in the Panel’s consideration, is not determinative in resolving a string confusion objection.⁵⁹ Second, regarding the relevance of ICANN not placing two applied-for strings in the same contention set, as one panelist in a previous string confusion objection noted, an applicant’s gTLD application is not entitled to “an evidentiary presumption of acceptability because it passed through the initial ICANN visual similarity tool tests.”⁶⁰ Rather, “the Objection process is an independent review process.”⁶¹ Third, this Panel has considered, and found not persuasive, the opinions of the Applicant’s linguistics expert urging dissimilarity between <.webs> and <.web>.

⁵⁶ *HOTEL Top-Level-Domain S.a.r.l* at 3.

⁵⁷ *Id.* at 4.

⁵⁸ *Id.*

⁵⁹ See *DERCars, LLC* at 29.

⁶⁰ *Koko Castle, LLC* at 5 (Panelist Mason).

⁶¹ *Id.* In this regard, Module 2 provides:

An application for a string that is found too similar to another applied-for gTLD string will be placed in a contention set.

An application that passes the String Similarity review is still subject to objection by an existing TLD operator or by another gTLD applicant in the current application round. That process requires that a string confusion objection be filed by an objector having the standing to make such an objection. Such category of objection is not limited to visual similarity. Rather, confusion based on any type of similarity (including visual, aural, or similarity of meaning) may be claimed by an objector. . . .

Module 2 ¶ 2.2.1.1.3.

As previously noted, in a string confusion objection against the <.cars> gTLD, Panelist John A.M. Judge determined that confusion was probable and sustained the objection.⁶² But in two other objections brought by the same objector against the very same <.cars> string, both panelists separately determined that there was *no* likelihood of confusion.

(3) *Charleston Road Registry Inc. v. Koko Castle, LLC*, ICDR Case No. 50 504 233 13 (Aug. 7, 2013) (<.cars>).

In the first of the two, Panelist Mason stated that regarding visual similarity, there was “adequate evidence to show that ‘CAR’ and ‘CARS’ do not have a high probability of being confused visually. This is partly because the ICANN visual similarity tool test assigned a similarity score of only 72%, in comparison with other string pairs with more distinct meanings having much higher similarity scores.”⁶³ But Panelist Judge, faced with the same 72% algorithmic score, determined that the score “supports the finding that the burden of proving likely confusion on a balance of probabilities has been met.”⁶⁴ Likewise, in two other string confusion objections that also involved a 72% score (for <.pets> and <.pet>), Panelists Richard W. Page and Urs Laeuchli separately characterized the score as “high”.⁶⁵ Panelists Judge, Page and Laeuchli all found likelihood of string confusion, and sustained the objection. The 72% figure is the same algorithmic score seen in the present Objection.

In *Koko Castle, LLC*, the panelist wrote, “There . . . does appear to be visual ‘peaceful coexistence’ at the secondary domain name level between singular and plural names. Applicant has presented evidence that singular and plural websites have existed together commercially without much internet user confusion between them.”⁶⁶ In this vein, the Applicant here argues that the Applicant’s <webs.com> domain name has co-existed with the Objector’s <web.com>. Yet the Panel questions whether this consideration, alone or in combination with others, is relevant in this determination.

Ultimately, Panelist Mason concluded that “[the] Objector has not met its heavy burden of proving that there is a probability, not just a possibility, of aural and/or visual similarity between the strings <.CAR> and <.CARS>, as opposed to mere

⁶² *DERCars, LLC*. See *supra* note 48.

⁶³ *Koko Castle, LLC* at 5 (emphasis added).

⁶⁴ *DERCars, LLC* at 29.

⁶⁵ *John Island, LLC* at 10 (Panelist Page); *Afilias Limited* at 4 (Panelist Laeuchli).

⁶⁶ *Koko Castle, LLC* at 5-6.

association between them.”⁶⁷ Regardless of whether ICANN intended the burden on string confusion objectors to be heavy or otherwise, this Panel reaches a different conclusion regarding probable confusion for the strings <.webs> and <.web>.

(4) *Charleston Road Registry Inc. v. Uniregistry, Corp.*, ICDR Case No. 50 504 238 13 (Oct. 10, 2013) (<.cars>).

In the second determination involving <.cars> in which the string confusion objection was dismissed, the panelist ultimately concluded that “the string <.cars> is not confusingly similar to the string <.car>.”⁶⁸ Given that the panelist’s task was “to place itself in the position of the average, reasonable internet user and to assess whether such a person would probably be confused by the proposed string”,⁶⁹ he wrote, “Users will recognize that one of the strings is singular and one of them is plural and that that difference means that they should regard the two strings as different, as they are.”⁷⁰ Specifically,

the reader and the user will appreciate the fact that the two words that constitute the strings, “cars” and “car”, are separate words, with distinct meanings, with each of them being capable of being given their own function, namely that the former invokes cars in general and as a group, while the latter clearly invokes the concept of a single entity and that there is no reason why they should be understood as regarded as being used, in the internet context, in anything other than those distinct meanings.⁷¹

The panelist also noted that Internet users of today are

very well aware that, on the internet, small differences in spelling and meaning are significant and that they mean different things Internet users have become increasingly aware of such differences and are now mature and sophisticated enough to realize it, when they are being presented with such differences; indeed, internet users are so astute to such matters that they now look for them to ensure as best they can that they are not being misle[]d or deceived. There will therefore, in the opinion of the Expert, be no

⁶⁷ *Id.* at 6 (emphasis added).

⁶⁸ *Uniregistry, Corp.* at 10 (¶¶ 14, 17) (in original).

⁶⁹ *Id.* at 9 (¶ 9).

⁷⁰ *Id.* at 10 (¶ 15).

⁷¹ *Id.* at 11 (¶ 19(a)).

probability of user confusion if the two strings are delegated into the root zone.⁷²

The Panel is unable to concur with the above descriptions, and perceptions, of Internet users generally. As an aside, it is a fair question to ask, if the above quoted text amounts to the rule, whether, as a practical matter, any string confusion objection could prevail under the Guidebook. In all events, the Panel determines that the Applicant's <.webs> string so nearly resembles the Objector's <.web> in a number of respects that it is probable that confusion will arise in the human mind of the average, reasonable Internet user.

The Panel has considered the Applicant's many arguments, including those emphasizing: the absence of previous litigation between the parties, the Objector's alleged motives in filing this Objection, the absence of objections by other applicants for the <.web> gTLD, and the alleged anti-competitive effect. Under the governing Guidebook and the applicable principles, these arguments carry little weight.⁷³

Per the Guidebook, "The Objector bears the burden of proving that its Objection should be sustained in accordance with the applicable standards."⁷⁴ The Objector has met this burden.

Determination

The Objector has prevailed, and the String Confusion Objection is sustained.

January 24, 2014



Ilhyung Lee

Sole Expert Panelist

⁷² *Id.* at 10 (¶ 15). The panelist acknowledged that "[i]t is of course possible that some internet user will be confused by the two strings", but added that such possibility "will, at most, exist only in very few cases". *Id.* at 11 (¶ 19(a)). "[I]t is not enough to conclude that someone, somewhere will probably be confused by the string." *Id.* at 9 (¶ 9).

⁷³ See *HOTEL Top-Level-Domain S.a.r.l* at 4 ("The parties' arguments and contentions regarding alleged business motives and/or attempts to limit competition, alleged detriments that could arise if [the challenged gTLD] is approved, . . . are deemed irrelevant to the task of the expert panel.").

⁷⁴ Attachment to Module 3 art. 20(c).