

## International Centre for Dispute Resolution

### New gTLD String Confusion Panel

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Re: Consolidated Objections to String: <.mobile>

Afilias Technologies Limited, OBJECTOR

ICDR Case No. 50 504 T 225 13

Amazon EU S.à.r.l., APPLICANT

ICDR Case No. 50 504 T 227 13

Pixie North, LLC, APPLICANT

ICDR Case No. 50 504 T 235 13

Dish DBS Corporation, APPLICANT

String: <.mobile>

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### **EXPERT DETERMINATION**

#### **The parties**

The Objector is Afilias Technologies Limited, formerly known as “mTLD Top Level Domain, Ltd.”, 2 La Touche House, Ifsc, Dublin 1, Ireland (hereinafter “Objector”). Objector is the sponsor of the specialized top-level domain <.mobi>, pursuant to a contract with ICANN. Objector’s representative in these proceedings is Scott Hemphill, Afilias Technologies Limited, 2 La Touche House, Ifsc, Dublin 1, Ireland.

The Applicants are:

1. Amazon EU S.à.r.l., is represented in these proceedings by Douglas M. Isenberg, Esq., The GigaLaw Firm, 5555 Glenridge Connector, Suite 200, Atlanta Georgia 30342 United States of America.
2. Pixie North, LLC, is a wholly owned subsidiary of Donuts, Inc., and its representative in these proceedings is John M. Genga, Don C. Moody, The IP & Technology Legal Group, P.C. (dba New gTLD Disputes), 15260 Ventura Boulevard, Suite 1810, Sherman Oaks, California 91403, United States of America.
3. Dish DBS Corporation, a United States of America corporation, and its representative in these proceedings is Christopher W. Adams, Deborah M. Lodge, Patton Boggs LLP, 2550 M. Street, NW, Washington, DC 20037, United States of America.

#### **The New gTLD String Objected To**

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

## **Prevailing Party**

The Applicants have prevailed and the Objection is dismissed.

## **The New gTLD String Confusion Process**

Module 3 of the ICANN gTLD Applicant Guidebook contains Objection Procedures and the New gTLD Dispute Resolution Procedure (“the Procedure”).

Article 1(b) of the Procedure states that “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.

As expressed in the Guidebook, and the Procedure, there are four (4) grounds to object to the registration of new gTLDs. One of these grounds expressed String Confusion, as described in DRP Article 2(e)(i): “(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.”

Article 3(a) states that “String Confusion Objections shall be administered by the International Centre for Dispute Resolution”.

Article 12, entitled “Consolidation of Objections” provides in pertinent part in relation to string confusion objections:

- (a) The [International Centre for Dispute Resolution (“ICDR”)] is encouraged, whenever possible and practicable . . . to consolidate objections, for example, when more than one Objector has filed an Objection to the same gTLD on the same grounds. The [ICDR] shall endeavor to decide upon consolidation prior to issuing its notice pursuant to Article 11(a) and, where appropriate, shall inform the parties of the consolidation in that notice.
- (b) If the [ICDR] itself has not decided to consolidate two or more objections, any Applicant or Objector may propose the consolidation of Objections within seven (7) days of the notice given by the [ICDR] pursuant to Article 11(a). If, following such a proposal, the [ICDR] decides to consolidate certain Objections, which decision must be made within 14 days of the notice given by the [ICDR] pursuant to Article 11(a), the deadline for the Applicant’s Response in the consolidated proceeding shall be thirty (30) days from the Applicant’s receipt of the [ICDR’s] notice of consolidation.
- (c) In deciding whether to consolidate Objections the [ICDR] shall weigh the benefits (in terms of time, cost, consistency of decisions, etc.) that may result from the consolidation against the possible prejudice or inconvenience that the consolidation may cause. The [ICDR’s] determination on consolidation shall be final and not subject to appeal.

## **Procedural History of this Case**

The Objections were filed with the International Centre for Dispute Resolution (the “ICDR”) on March 13, 2013 pursuant to the New gTLD Dispute Resolution Procedure (the “Procedure.”)

In accordance with Article 9 of the Procedure, on April 4, 2013, the ICDR completed the review of the Objections and determined that the Objections were deficient. On April 11, 2013, after receipt of a further submission from Objector, the ICDR notified the parties that the Objections now complied with the requirements of the Procedure and with requirements of the International Centre for Dispute Resolution (ICDR) Supplementary Procedures for String Confusion Objections (Rules) (the “ICDR Rules”).

In accordance with Article 11(a) of the Procedure and Article 2, 3 of the ICDR Rules, on April 17, 2013, the ICDR formally notified Applicants of the Objection. In accordance with Article 11(b) and relevant communications provisions of the Procedure, the Responses were timely filed with the ICDR.



On April 24, 2013, Applicant Dish DBS Corporation filed a request that the three cases involving string confusion objections to the string <.mobile> be consolidated. Without objection, the ICDR granted the request for consolidation.

The ICDR appointed M. Scott Donahey as the Expert in this matter on September 18, 2013. The Expert finds that it was properly constituted and is in compliance with Article 13 (c) of the Procedure and Article 1, 1 of the ICDR Rules.

## **Factual Background**

### **Objector**

On July 10, 2005, Objector entered into a contract with ICANN pursuant to which Objector became the sponsor of the <.mobi> TLD. In Appendix S to the contract between Objector and ICANN, a definition of the sTLD community was set out. The stakeholders in the community were to include consumers who used or accessed Internet services “while connected over mobile or wireless,” businesses that provided use or access to the Internet “over mobile or wireless,” and “mobile technology, mobile media, mobile services and mobile entertainment stakeholder consortia.” The agreement between ICANN and Objector contained the following provision:

“ICANN and [Objector] acknowledge that a criterion included in the application process in which the .mobi TLD was selected and in the previous TLD application expansion round, was that a new TLD be ‘clearly differentiated from existing TLD’s.’ ICANN, when undertaking to effect the delegation of new TLDs, shall take into consideration Internet community input received, including any objections interested third parties may have under policy considerations or applicable law or otherwise, regarding the creation of new TLD strings.”

Dictionary.com includes the following definition for the adjective “mobile:” “pertaining to or noting a cell phone, usually one with computing ability or a portable wireless computing device used while held in the hand, as in mobile tablet; mobile PDA; mobile app” and includes the following definition for the noun “mobile:” “mobile phone.”

The first four letters in <.mobile> are identical to the letters that make up <.mobi> . <.mobile> differs from <.mobi> only by the addition of two Roman characters “l” and “e.”

“mobi” is an acronym for “mobile,” as shown by various online dictionaries and acronym finders cited by Objector.

According to the Urban Dictionary, “mobi” is a slang term in the UK meaning “mobile phone.”

Many companies in many companies have adopted names that include “mobi” in telecommunications, antennas, wireless, and even accounting.

The large International Conference on Mobile Computing and Networking is referred to as “MobiCom”.

### **Applicants**

Objector’s own Annex 3 shows that the most common pronunciation for “mobile” in American English is not moh - BEEL, as Objector asserts, but rather MOH – buhl.

Objector’s TLD is only four letters long, having only 67% of the number of characters in the domain name <.mobile>.

Many strings examined by the ICANN preliminary visual confusion test having a higher percentage of common characters than do the TLDs of the Objector and the Applicants.

Objector’s TLD string is pronounced “Moh – bee” while Objector’s Annex 3 shows that the most common American English pronunciation is “MOH – buhl.”



Objector's web site shows that registration of domain names in the <.mobi> TLD is "designed to let consumers know that a site works on a mobile phone (Applicant Amazon's Annex D) and that registrations are open to "[a]ny individual or organization." *Id.*

While Objector claims that its trademark registrations supports that its <.mobi> TLD is related to mobile wireless and mobile devices and technologies, many of its trademark registrations are unrelated to such a claim, such as one for a "web browsing guide" and for "providing information to domain name registrars relating to the registration of domain names," another for "publishing, including publishing of electronic and on-line publications" and for "creating, maintaining and hosting the websites of others," a third for printed publications and data processing services, a fourth for "computer services, namely providing search engines for obtaining data on the Internet, registering and tracking addresses on the Internet," and a fifth for "computer software" and IP address management services, namely enabling persons to reserve and use IP addresses and to search. Access, add, modify or delete information relating to IP addresses. Objection, Annex 10.

Objector has operated the <.mobi> TLD since 2006, yet it is used by less than .01% of all web sites.

## **Parties' Contentions**

### **Objector**

Objector contends that online dictionaries support the Objection in that they define the noun "mobile" as "mobile phone" and the adjective "mobile" as "pertaining to or noting a cell phone."

Objector argues that trademark law and cases decided thereunder.

Objector notes that the two TLDs are similar in that <.mobile> has only two additional letters appended to "mobi."

Objector asserts that "mobi" is pronounced "moh – bee," and that "mobile" is pronounced "moh – beel," which is the most common pronunciation in the United States and in other widely spoken languages, such as French. Thus, the two TLDs are aurally similar.

Objector contends that there are "conceptual similarities" between the two TLDs. Objector asserts that .mobile means "something 'pertaining to or noting a cell phone,' and that "the word MOBI will be understood by Internet users as an abbreviation of MOBILE and a reference to mobile technology and devices."

Objector argues that "MOBI" is an acronym which has the meaning of "mobile."

Objector contends that the vast majority of "important trade marks (sic)" incorporating "mobi" are registered in class 9 of products and class 38 of services, which both refer to mobile phones.

### **Applicants**

Applicants contend that Objector's Annex 3 shows that the most common pronunciation of "mobile" is "moh – buhl," and that therefore there is no confusion in the pronunciation of the two TLDs.

Applicants argue that a TLD "can have multiple meanings," and that therefore their meanings are not fundamentally important to a determination of their similarity under the Guidebook.

Applicants note that ICANN's String Similarity Panel, after performing a manual visual similarity check, applied certain algorithms designed to determine visual similarity and found that "mobi" and "mobile" were not visually similar.

Applicants assert that Objector's TLD contains 50% more characters than that of Applicants and therefore there cannot be similarity between the two TLDs. Even domain names with a higher percentage of similar characters were not put into contention sets by ICANN experts' preliminary review.



Applicants point out that Objector's TLD <.mobi> is pronounced differently from Applicants' <.mobile> TLD. Applicants contend that "mobi" is pronounced "Moh – Bee," while "mobile" is most commonly pronounced "moh-buhl" in American English. Thus, there can be no aural confusion.

Applicants assert that as ICANN's String Similarity Panel did find confusion probable in its preliminary algorithmic examination, the Expert should find that there is an evidentiary presumption in favor of Applicants.

Applicants contend that Objector's argument that references its contract with ICANN regarding the sponsored TLD <.mobi> is irrelevant, as this is not a contract case and ICANN is not a party to this proceeding.

Applicants allege that Objector is attempting to close an entire segment of the domain name space to generic terms and that consumers would suffer if the objection is sustained.

Applicant contends that even if one could say that "sports" may bring "sport" to mind, this is insufficient to establish probability of confusion. Section 3.5.1, Module 3, New gTLD Guidebook.

Applicant asserts that Objector's statements as to the effect on "the Sport community and the public at large" are mere speculation and are irrelevant.

## **Discussion and Findings**

### **A. Burden of Proof**

Objector bears the burden of proof in each case. Section 3.5, Module 3, New gTLD Applicant Guidebook; Procedures, Section 20(c).

### **B. Standing**

"Two types of entities have standing to object:

An existing TLD operator may file a string confusion objection to assert string confusion between an applied-for gTLD and the TLD it currently operates.

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."

Section 3.2.2.1, Module 3, New gTLD Applicant Guidebook.

Applicants do not contest Objector's standing to object. The Expert finds that as the existing operator of a sponsored TLD, the Objector has standing to file a string confusion objection.

### **C. Test for String Confusion Objection**

"A . . . panel hearing a string confusion objection will consider whether the applied-for gTLD string is likely to result in string confusion. String confusion exists where a string so nearly resembles another that it is likely to deceive or cause confusion. 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."

Section 3.5.1, Module 3, New gTLD Applicant Guidebook.



#### D. Findings

On the surface, the test for a String Confusion Objection is a relatively simple one in comparison to the tests for a Legal Rights Objection, a Limited Public Interest Objection, or a Community Objection. For string confusion to exist, a “**string**” must “so nearly **resemble**[ ] another [string] that it is likely to deceive or cause confusion.” Emphasis added. The key words are “string” and “resemble:” there must be a “resemblance” between the “string” of the objector and the “string” of the Applicant.

The Webster’s Ninth New Collegiate Dictionary definition of “string” which most closely applies to the present situation, in which the strings consist of sequences of roman alphabet characters, is “a series of things arranged in or as if in a line; a sequence of like items (as bits, characters, or words).” Likewise, the definition of “resemblance” from the same source: “the quality or state of resembling, *esp*: correspondence in **appearance** or **superficial** qualities.” Emphasis added.

The test is primarily a visual one, but it is to be supplemented by comparisons of similarities other than visual. ICANN performs an initial evaluation designated a “String review.” Section 2.2, Module 2, New gTLD Applicant Guidebook. ICANN describes the initial evaluation thusly: “The **visual** similarity check that occurs during initial Evaluation is intended to augment the objection and **dispute resolution process that addresses all types of similarity.**” Section 2.2.1.1, Module 2, New gTLD Applicant guidebook, emphasis added. Thus, while visual similarity is the primary evaluation in a string confusion analysis, the Expert is expected to examine other similarities, which similarities are not enumerated in the requirements.

At the initial evaluation stage, ICANN looks for visual identity between the strings. “In the simple case in which an applied-for gTLD string is identical to an existing TLD or reserved name, the online application system will not allow the application to be submitted.” Section 2.2.1.1.1, Module 2, New gTLD Applicant Guidebook. The String Similarity Panel that performs the initial screening for ICANN applies the following standard:

“**Standard for String Confusion** – String confusion exists where a string so nearly resembles another **visually** that it is likely to deceive or cause confusion. For the 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.”

Section 2.2.1.1.2, Module 2, New gTLD Applicant Guidebook, emphasis added.

This language is identical to that in Section 3.5 Dispute Resolution Principles (Standards), Section 3.5.1 String Confusion Objection, with the sole exception of the absence of the word “visually” in the Dispute Resolution Standard. Thus, it is clear that in the dispute resolution arena, an Expert should consider resemblances other than mere visual resemblances in determining whether a likelihood of confusion exists. ICANN could not be clearer on this point:

“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.”

Section 2.2.1.1.3, Module 2, New gTLD Applicant Guidebook

However, it would not be proper for a String Confusion Expert to engage in an analysis based on a legal rights objection, a limited public interest objection or a community objection. Those arenas have been reserved to other Experts. Objector’s references to “the Internet community” and how it might be damaged or affected by the presence of the two proposed gTLDs are in the nature of Community objections, and are not appropriate for consideration by a String Confusion Expert. Likewise, Objector’s reliance on trademark cases is misplaced. Trademark law considers many factors other than likelihood of confusion by consumers. Trademark law is applicable to legal rights objections, but not to string confusion. What this Expert must determine is whether there



are such similarities between the two gTLDs that it is likely to deceive or cause confusion in the mind of the average, reasonable Internet user.

In the present case, there are a few similarities between the TLDs at issue. It is true that the two are visually different, as the gTLD proposed by Applicants has a final “le” that is absent from the TLD sponsored by Objector. While the two TLDs may be said to be somewhat visually similar, they are not similar enough for the Expert to find that Applicant’s string so nearly resembles Objector’s string that it is likely to deceive or cause confusion in the mind of the average, reasonable Internet user.

How is one to compare the two aurally? Objector’s TLD is not a word in any language of which this Expert is aware. It is merely a string of Roman characters. How is it to be “pronounced,” if it is to be pronounced at all? Both Objector and Applicants seem to agree that the pronunciation of “mobi” is “MOH – bee.” But it could just as easily be pronounced “em – oh – bee – aye” or “moh – bye” or even “mob – aye.” Moreover, Applicants’ string could be seen to be a word in different languages, pronounced in different ways. If it were an English word, in American English it is generally pronounced “moh – buhl” whose primary meaning is “movable or capable of being moved.” See Objection, Annex 3. In Italian, it is pronounced “MOH – bee – lay” and indicates furniture. In Spanish, it would not be a dictionary word, but if pronounced as if it were a Spanish word, it would be pronounced “moh – BEE – lay.”

Objector contends that “mobi” is an abbreviation or an “acronym” for the words “mobile phone” or “mobile technology,” and at page 8 of the Objection, Objector lists links to various web sites for the proposition that “the websites . . . concur on the fact that the acronym “MOBI” is defined as meaning “MOBILE.” However on the Abbreviations web site to which Objector has provided a link, the site lists four meanings for “MOBI,” none of which are “mobile:” Mobius Management Systems, Inc.; Mothers Overcoming Breastfeeding Issues; Mobile’s Outstanding Business and Industry; and Microgravity Observations of Bubble Interactions. [www.abbreviations.com/MOBI](http://www.abbreviations.com/MOBI). And when one clicks on the link to [www.acronymfinder.com/MOBI.html](http://www.acronymfinder.com/MOBI.html), “mobile” is only one of six listed possibilities, the first of which is Man Overboard Indicator.

In summary, Objector has failed to meet its burden of proof to show that it is probable that the average, reasonable Internet user will be confused if the strings <.mobi> and <.mobile> co-exist on the Internet. To the extent that Objector feels that ICANN may have breached its agreement with Objector, that is a matter to be taken up with ICANN, and is not a matter of String Confusion contention. This Expert notes that there is a dispute resolution provision in Objector’s sponsorship contract.

**Determination**

The Applicants have prevailed and the Objection is dismissed.

October 21, 2013



M. Scott Donahey

Sole Expert Panelist