

International Centre for Dispute Resolution

New gTLD String Confusion Panel

Re: 50 504 T00241 13

**COMMERCIAL CONNECT, LLC,
OBJECTOR**

and

**WILD ISLAND, LLC,
APPLICANT**

String: TLD: <.商店>

EXPERT DETERMINATION

The Parties

The Objector is Commercial Connect, LLC, with its principal place of business at 1418 S. 3rd Street, Louisville, KY 40208, USA. It is represented by Jeffrey S. Smith, 1418 S. 3rd Street, Louisville, KY 40208, USA.

The Applicant is Wild Island, LLC. with its principal base of business at 10500 N.E. 8th Street, Suite 350, Bellevue, WA 98004, USA. It is represented by Daniel Schindler, Executive Vice President of Donuts, Inc. and Jonathan Nevett, Executive Vice President of Donuts, Inc.

The New gTLD String Objected To

The new gTLD string applied for and objected to is: <.商店> (.shāng diàn)

Prevailing Party

The Applicant has 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) as follows: “(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”.

Procedural History of this Case

The Objector filed its Objection and the Applicant has responded. Both parties have made written submissions, both in initial support of their positions and in supplementary filings.

Basis for Objector’s Standing to Object based on String Confusion

The Objector has standing based on its being a gTLD applicant. *See* Applicant Guidebook, Module 3 §3.2.2.

Parties’ Contentions

Objector

The Objector asserts that the gTLD filed by Wild Island, LLC “so nearly resembles the .SHOP TLD that it is probable that confusion will arise in the mind of the average, reasonable internet user” because . . . the .商店 (.shāng diàn) gTLD application to which it objects is “similar either visually, aurally, or has a similar meaning.” The Objector offers no specific comments or evidence in support of its contention that “.商店” (.shāng diàn)” is confusingly similar to its gTLD, “.SHOP” other than, in its supplementary submission, to assert that that the two gTLDs are similar in meaning. In particular, the Objector asserts that, under the doctrine of foreign equivalents, “foreign words from common languages are translated into English in order to ascertain similarity with English words,” citing *Palm Bay Imports v. Veuve Cliquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369 (Fed. Cir., 2005) and the two terms, when translated are identical in “sight, sound and meaning.” Additional Submission of Objector, page 4.

The Objector's filing demand also refers to a number of words that it asserts have similar meanings to "shop." "商店 (shāng diàn)" is not among those listed by the Objector in its filing demand.

Applicant

The Applicant contends that the Objector fails to state fully the basis for its standing to object, asserting that the Objector neglects to state that it was not placed into a contention set with the Applicant's 商店 (.shāng diàn) string.

The Applicant also contends that the Objector fails to prove the elements of similarity required to be shown for its Objection to be sustained.

The Applicant points out that "even a cursory glance" would show the Chinese characters (商店 (.shāng diàn)) and .SHOP to be different since one belongs to the East-Asian script family and the other to the European script family. As a result, only a user who is versed in Chinese would recognize the two Chinese characters.

The Applicant also states that strings in different scripts, such as the Chinese and European scripts, in this instance, are so dissimilar that they cannot even be compared through the use of ICANN's String Similarity Assessment Tool because the likelihood of confusion is thought to be zero since they are so visually different. The Applicant also contends that 商店 (.shāng diàn) and .SHOP are not marketed to and/or used by the same or similar users or overlapping marketing channels -- Chinese-speaking market vs. non-Chinese-speaking market -- and therefore confusion between the two terms is not probable.

The Applicant also contends that the Objector fails to prove that SHOP and 商店 (.shāng diàn) are similar in sound, asserting that they differ sharply from each other in sound, one having two syllables and the other being monosyllabic. Also, other sounds make the terms different one from the other.

The Applicant also contends that the terms 商店 (.shāng diàn) and SHOP are so different in meaning that there is a low likelihood of internet user confusion. The Applicant asserts that 商店 (.shāng diàn) means a commercial shop or a store, whereas "shop" can have other meanings, such as school laboratory equipped for industrial arts education, the art and science of working with tools and machinery and to examine goods and services with intent to buy. According to the Applicant, the term 商店 (.shāng diàn) does not have the meanings that "shop" has -- hunting for ideas, a new home or an enjoyable place to spend an evening. Moreover, the Applicant asserts, even if there is association between the terms in the sense of one string bringing to mind another, such an association does not suffice to establish probability

Of confusion, referring to the Applicant Guidebook, §3.5.1. The Applicant concludes that the Objection fails to show the high level of similarity need to meet the heavy burden that confusion between the two terms is probable among average, reasonable internet users.

With respect to the Objector's invocation of the doctrine of foreign equivalents, the Applicant asserts, in its Response to the Objector's Additional Submission, that the doctrine relates to trademark infringement and not to the less complex issues of string confusion in this case and that, moreover, as the court stated in *The Palm Bay Imports* case cited by the Objector, the doctrine "should be applied only when the ordinary American purchaser would stop and translate [the word] into its English equivalent." *Palm Bay Imports v. Veuve Cliquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377 (Fed. Cir., 2005), the Applicant points out that only a small segment of the 1.2 billion native Chinese speakers in the world would understand English well enough to "know about the various ways the English term "shop" is employed. The Applicant's Response to the Objector's Additional Submission, pages 6 and 7.

Discussion and Findings

The Applicant asserts that the Objector has no standing, under Dispute Resolution Procedure (Version 2011-09-19) Module 3, §3.2.2.1 because it was not placed into a contention set with the Applicant. But it is only where a gTLD applicant successfully asserts confusion with another applicant that both applicants are placed in a contention set and referred to a contention resolution procedure. Therefore, in the present case, according to §3.2.2.1, "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 a string confusion between the two applicants has not already been found in the initial Evaluation." Furthermore, the Applicant's contention that the Objector has failed to state the basis for its having standing to object must be rejected because the Objector stated in its Objection that it has standing under §3.2.2 and that it is a current gTLD applicant for the .SHOP TLD. Accordingly, the Applicant's argument that the Objector has no standing is rejected.

With respect to the merits of the Objection, the Panel examines the two words in question from the points of view of any visual similarity, aural similarity or similarity in meaning.

With respect to visual similarity, there is little question but that the two words are not at all visually similar. One is in Chinese characters and the other in European script. The Applicant offers many other reasons that there is no visual similarity, whereas the Objector offers no specific support for its contention that the two terms in question are visually similar. Accordingly, the Panel, applying the standard of examining the two words from the point of view of the average, reasonable internet user,

concludes that it is not probable that such a user would find there to be confusion between the two terms from a visual point of view.

With respect to any aural similarity between the terms, the Panel finds little or no likelihood that confusion would exist between the sounds of the two words.

With respect to meaning, the Panel takes into consideration the likelihood that the two terms will be used in two separate markets -- the Chinese-speaking market and the non-Chinese-speaking market. In support of its assertion by the Applicant that .商店 (.shāng diàn) and SHOP “differ completely from each other in meaning,” The Applicant presents evidence that the two terms have “significantly different meanings.” For example, SHOP can be used as a verb to relate to activities not associated with making purchases, whereas 商店 (.shāng diàn) is defined by the Applicant as meaning only a “commercial shop” or “store.” As the Applicant points out, mere association, in the sense that one string brings to mind another string, is insufficient for a finding of likelihood of confusion, as the Applicant Guidebook §3.5.1 states. Moreover, the Objector has the burden of proving that it is “probable, not merely possible that confusion will arise in the mind of the average, reasonable internet user” between the two terms. §3.5.1. Here, not only are the two terms visually and aurally distinct and different, but, regardless of there being overlapping in meaning between the terms, the strong likelihood that the terms will be used in different markets adds additional support to the conclusion that there is no likelihood of confusion between .SHOP and .商店 (.shāng diàn).

Consequently, the Panel determines that the Objector has failed to carry its burden of persuasion that it is probable that confusion will arise in the mind of the average, reasonable internet user between the two terms.

Determination

Therefore, the Applicant has prevailed and the Objection is dismissed.

Dated: November 7, 2013



Lawrence W. Newman, Expert

Sole Expert Panelist