

INTERNATIONAL CENTRE FOR DISPUTE RESOLUTION  
New gTLD String Confusion Panel

Re: 50 504 T00220 13

VERISIGN, INC, Objector

and

NÚCLEO DE INFORMAÇÃO E  
COORDENAÇÃO DO PONTO BR-  
NIC.BR, Applicant

String <.BOM>

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EXPERT DETERMINATION

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**I The Parties**

- (a) The Objector is VeriSign, Inc., a corporation incorporated in Delaware, United States of America, with its principal place of business located at 12061 Bluemont Way, Reston, Virginia, 20190, United States of America, and is represented by:

Thomas Indelicarto  
Verisign, Inc.  
12061 Bluemont Way  
Reston, VA 20190

- (b) The Applicant is Núcleo de Informação e Coordenação do Ponto BR - NIC.br, a not-for-profit association established under Brazilian Law No 9790 of 23/03/1999 about non-profit private organizations and new Brazilian Civil Code of 2002. Applicant's principal place of business address is Av Nacoes Unidas 11541, 7o. Andar, Sao Paulo, Sao Paulo 04578000, Brazil, and is represented by:

Rubens H Kuhl Junior  
Núcleo de Informação e Coordenação do Ponto BR - NIC.br  
Av Nacoes Unidas 11541  
70.Andar  
Sao Paulo - SP 04578000

## **II The New gTLD string objected to:**

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

## **III Prevailing Party**

The Applicant has prevailed and the objection is dismissed.

## **IV 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 object 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(3)(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".

## **V Procedural History of this Case**

- (a) This String Confusion Objection was submitted to the International Centre for Dispute Resolution ("ICDR") for determination in accordance with the New gTLD

Dispute Resolution Procedure ("Procedure"), provided as an Attachment to Module 3 of the gTLD Applicant Guidebook ("Applicant Guidebook") approved by the Internet Corporation for Assigned Names and Numbers ("ICANN") on June 20, 2011, and as updated on June 04, 2012, which incorporates by reference the ICDR's International Rules for proceedings, and the ICDR Supplementary Procedures for String Confusion Objections ("ICDR Supplementary Procedures").

- (b) Following upon the receipt of the Objection, the ICDR satisfied itself that the Response had been received timeously.
- (c) The ICDR thereafter, and by letter dated June 13, 2013, advised the representatives of the parties that Archibald Findlay SC had been appointed as Expert in terms of Article 13 of the Procedure.

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

- (a) The Objector is the existing TLD operator of .com. and submits this objection on the basis that the .BOM string is confusingly similar to the .com TLD. No challenge has been brought by the Applicant.
- (b) As the Objector is an existing TLD operator, the Panel is satisfied that it has the standing to file a string objection (Module 3 of the Applicant Guidebook - paragraphs 3/2/2 and 3/2/2/1).

#### **VII Parties' Contentions**

##### **A Objector:**

1 That the .comTLD has a unique, strong and well-established identity.

The Objector contends that it is beyond dispute that the .com domain has the strongest identity of any TLD worldwide. This is demonstrated by the fact that it was established in 1985 and today has over 100 million registered names and is served by approximately 1000 ICAN accredited registrars and is far larger and better known than any other TLD.

The Internet community regards the label ".com" both as being derived from an abbreviation of the word "company" and as a shorthand form of "commercial".

This, so it is contended, is part of its considerable popularity and growth, with the result that, although it is known as the registry for commercial communication, there are many non-commercial sites and networks who make use thereof.

The Objector, or its predecessor, has served as the operator virtually from inception and the Objector has operated this registry for over 20 years.

It is contended further that the Objector has the best record of a registry in respect of security and stability and that it has also established, and continues to do so, many of the standards and best practices for registry operations. Some hundreds of millions of dollars have been invested to develop and maintain its globally distributed, robust and secure environment, there by no other TLD supported by such an investment.

It is also considered unique among Internet domains in that:

- (a) the Objector does not use any industry standard technologies but a specially-designed purpose-built proprietary system;
- (b) it has over 20 years' experience and know-how in operating a secure and stable registry;
- (c) the .com and .net domains, both operated by the Objector, have led to many developments in the domain names system, as well as the introduction of various services which benefit users and contribute to their security and reliable service.

The performance of the .com registry is such as to be superior when measured against the records of other TLDs and there is no stronger label in Internet usage.

## 2 Legal Background on the Meaning of Similarity & Confusion

### (a) Similarity

The Objector refers to the principle set out in the Applicant Guidebook, namely:

- (i) that string confusion "exists where a string so nearly resembles another that it is likely to deceive or cause confusion";
- (ii) that "similar" means "strings so similar that they create a probability of user confusion if more than one of the strings is delegated into the root zone";

- (iii) for there to be a likelihood of confusion "it must be probable, not merely possible, that confusion will arise in the mind of the average, reasonable Internet user".

The Objector then contends that the above articulated standards reflect parallel long-established standards governing the likelihood of confusion that have developed under United States trademark law, as well as trademark law viewed more broadly, and that the well-established trademark law tests for determining similarity and the likelihood of confusion are now persuasive in assessing string confusion.

It is further contended that, as under trademark law, the principles in the Applicant Guidebook make it clear that the likelihood of confusing similarity requires consideration of more than mere visual similarity, albeit that this is an important consideration, in that confusion based on any type of similarity, including visual, oral or similarity of meaning, may be relied upon by an objector.

- (iv) Visual Similarity

It is contended that this is a matter of degree and that a slight spelling variation would not prevent confusion, and that in the present instance this supports the proposition that there is visual similarity between .com and .bom.

- (v) Phonetic Similarity

In this regard the focus must be upon how the word is pronounced by the public rather than what constitutes a "correct" pronunciation, as a trademark owner cannot control how purchasers would vocalise its mark. In this regard it would follow that there is a likelihood of confusion.

- (vi) Similarity of Meaning

Since it is said that there is no meaning which can be attributed to .bom by English speakers, which would serve to distinguish the letter strings .com and .bom, it must follow that there are no differences in meaning, hence the likelihood of confusion.

- (vii) Similarity as Evaluated Based on Context & Overall Impressions

In determining whether two marks are confusingly similar, the overall impression created by the context in which they are found must be appraised, with a consideration of the totality of factors that could cause confusion among prospective purchasers. Where

initials are used or the number of letters is the same, and there is a significant overlap in letters, this is contended to be generally sufficient to sustain a claim of similarity.

(b) Confusion

The Objector refers to the United States trademark law and what are considered the foundational factors to be considered in determining the presence or absence or a likelihood of confusion, and selects the following as being applicable:-

(i) Strength of the Mark/Word

It is contended that in assessing likelihood of confusion, one factor that should be considered is the commercial strength or market place recognition of the existing TLD.

(ii) Degree of Care Exercised by User

It is contended that the relevant class of users would consist of casual Internet users who are likely to exercise a low degree of care when exposed to or interacting with TLDs and, when this is combined with high visual and aural similarity, the likelihood of confusion will increase.

(iii) Marketing Channels

The Objector points out that the Applicant, in its application, expresses an intention to make the applied for TLD available to the public to promote everything that is good and that registration will be open to all law-abiding citizens or organisations, being the same registrants for .com, leading to overlapping market channels.

(c) Evidence of Likelihood of Confusion - Linguistic Experts

The Objector draws attention to United States trademark law that recognises the use of linguistic experts before courts in order to provide helpful guidance as to how people use a certain term and the "roots" of the term.

In this regard the Objector relies upon a sworn declaration by Gail Stygall, a professor of the English language and an adjunct professor of linguistics at the University of Washington, Seattle, whose opinion is that the linguistic similarities of the two strings establish that confusion amongst Internet users will occur if they encounter domain names with the .bom

string, as well as .com. Professor Stygall also refers to the fact that the two letters are a key apart on the so-called "QWERTY" keyboard, thus increasing the risk of confusion.

### 3 Confusing Similarity Between .bom & .com

The Objector contends that the applied for TLD .bom so nearly resembles the well-established .com TLD in appearance, sound and meaning, that it is likely to deceive or cause confusion in the mind of the average, reasonable Internet user:

- (a) as the strings are virtually similar because they vary only by one letter;
- (b) they are phonetically similar because they have the last two letters resulting in strings that rhyme;
- (c) there is no difference in meaning because .bom possesses no meaning in English, obvious or otherwise, which would distinguish it from .com.

The Objector draws attention to the fact that the initial evaluation carried out by ICANN, which involved comparing existing TLDs with every applied for gTLD string to determine whether the new string is confusingly similar, was simply a visual similarity check and that the closer to 100 in the result means that it is closer visually under the algorithmic scoring process which, in this instance, was 63%.

The fact that the strings vary by one letter only and end with the same two letters is said to be an important similarity in appearance as well as sound, and that the two different letters with which they commence are too subtle a distinction to avoid confusion, particularly as they are so close to each other on a keyboard.

As there is no strong TLD in Internet usage than .com, it is said to be probable that the average Internet user, so conditioned to hearing and seeing the .com TLD, would mistake .bom with .com, or .com with .bom, in navigating the Internet.

The Objector concludes this leg of the argument with the contention that every relevant factor points to a likelihood of confusion sufficient to establish the necessary substantial probability thereof.

4 Harm to Users & the Objector from Confusion

The Objector contends that string confusion in these circumstances will harm not only the Internet users but also the Objector, particularly in that the user will not receive what he or she wanted or expected in seeking to sign up for a .com domain but will be misled by the confusion, or the Internet user will suffer confusion by looking for an address that may not exist. The Objector will further suffer economic harm by the diversion away from its registry service of users, as well as negative customer experiences resulting from such confusion. Finally, that confusion may lead to the mistaken belief on the part of the public that there is an affiliation with the sites or an endorsement of the sites, particularly if it caused the public to believe that the Applicant's sites, were they to contain offensive subject matter, were sites of the Objector, thus harming the latter's goodwill.

B Applicant:

- 1 That the Applicant is responsible for the operation of the cc TLD  $\leq$ .br $\geq$ , as well as the co-ordination and integration of all Internet service initiatives in Brazil.

The Applicant points out that this requires it to exercise certain rights and obligations, including the registration and maintenance of  $\leq$ .br $\geq$  domain names, handling and responding to computer security incidents, and projects that support and improve the network infrastructure in Brazil. It also produces and publishes indicators, statistics and strategic information on the development of the Brazilian Internet, promotes studies and recommends procedures, rules and technical operational standards which will improve the network, and provides technical and operational support.

- 2 The potential use of the applied for gTLD  $\leq$ .bom $\geq$  would not take unfair advantage of the distinctive character or reputation of the Objector's TLD  $\leq$ .com $\geq$  unjustifiably, or otherwise create a likelihood of confusion between the two.

3 Similarity

(a) Visual Similarity

The Applicant contends that variation between the two of one letter is not enough to establish a visual similarity between .com and .bom. The Applicant refers particularly to the fact that:



- (i) .com already co-exists with a number of cc TLDs and several examples are then given, including .com.br, it being said that there are currently in operation on the Internet 133 occurrences of .com [country code] where the country code is the ISO3166 code for each country;
- (ii) the Objector did not object to applications for the new gTLD.mom, nor .bet, which also vary by only one letter from .com and .net respectively;
- (iii) a further example being NIC,BO, the operator of which cc TLD ≤.bo.≥ from Bolivia did not object to .bom, although both TLDs vary by only one letter;
- (iv) there are several instances in the registry of trademarks in the United States, where trademarks vary by only one letter, and examples such as BBC, NBC and ABC v BBC are cited, among others;
- (v) similarly in referring to the trademark registry in Brazil, the Applicant draws attention to co-existing trademarks that differ by one letter, being, among others, GNTvTNT and GNTvNGT;
- (vi) it is pointed out also that some of the owners of the above-cited trademarks have applied for new TLDs, such as American Broadcasting Companies Inc applied for .abc, while British Broadcasting Corporation applied for .bbc;
- (vii) that .bom passed the string similarity review as provided in the ICANN's gTLD;
- (viii) that, even though the ICANN similarity assessment established a 63% similarity score between the two TLDs, this score is unlikely to generate confusion as only three pairs of Latin-script strings were declared by ICANN as confusingly similar, all of which had indices ranging from 94% to 99%;
- (ix) .mom, when compared with .com, and .bet when compared with .net, also achieved a rating of 63%;
- (x) a further list published by ICANN and referred to showed that there were several TLDs referred to by ICANN as likely to cause confusion but that their ratings were higher than 63%;

- (xi) that this evidence supports the notion that it is a normal and frequent occurrence in the domain name world that TLDs may vary by only one letter;
- (xii) that accordingly string confusion in this regard would not fall within the ambit of being likely to deceive or cause confusion at the level of a probability and not a possibility and that, as pointed out also in the Applicant's Guidebook, mere association in the sense that the string brings another string to mind would be insufficient to find a likelihood of confusion.

(b) Phonetic Similarity

- (i) The Applicant contends at the outset that the Objector has failed to identify where the phonetic similarity can be identified and merely relies on general principles of United States trademark case law in this regard.
- (ii) In referring to the affidavit of Professor Stygall, the Applicant points out that there is said to be oral similarity only as to the "o" sound in both words, which is also insufficient.
- (iii) The Applicant relies upon a technical and scientific study from a phonetic expert, Mr Mauricio Raymundo de Cunto, confirming the lack of phonetic similarity between .com and .bom, and that the study conducted by him demonstrates that phonetically and acoustically there is no room for confusion.

(c) Similarity of Meaning

- (i) The Applicant contends that it does not follow that there is a similarity of meaning if .bom does not have a meaning in English.
- (ii) The Applicant, however, refers to the fact that the word "bom" is a Portuguese word meaning "good", derived from the Latin word "bonis".
- (iii) That in any event the word "bom" can be found in two Internet on-line dictionaries - the Urban Dictionary and the Internet Slang - stating the "bom" is an English slang word meaning "bro", "dude", "friend", amongst others.
- (iv) Accordingly these meanings differ markedly from .com being short for commercial, as does the Portuguese meaning.

- (v) Consequently there is no room for a complaint that there is a likelihood of confusion arising from meaning similarity.

**B** Evaluation of Similarity Based on Context & Overall Impressions

- (a) Fundamentally, the Applicant contends that the Objector failed to demonstrate that this was so, nor did it provide sufficient evidence to support the contention that there was a probability of confusion.
- (b) Apart from citing case law, the Objector did not show probability of Internet user confusion as against the Applicant's many instances cited of TLDs and trademarks that co-exist and have characteristics that overlap.
- (c) The Objector, accordingly, has failed, so the Applicant contends, to show more than an intention to avoid competition and limit consumer choice.

**C** Linguistic Expert

- (a) The Applicant relies on an opinion from Ms Erica de Freitas, who is a linguistic expert employed by the Faculty of Philosophy, Languages & Literature, & Human Sciences, at the University of Sao Paulo, Brazil.
- (b) The Applicant contends that the opinion of this expert refutes all arguments put forward by the Objector's expert.
- (c) In particular, apart from disagreeing as to the weight to be attached to the two words where only the first letter differs, Ms de Freitas joins issue as to the proximity on the "QWERTY" keyboard and points out that different fingers would normally be used to type different groups of letters, and that the group where "b" is located is not the same as that of the letter "c".

**D** Harm to Users & the Objector from Confusion

The Applicant disputes the contention of harm on the basis that, by reason of the Objector having failed to demonstrate a likelihood of confusion, it would obviously follow that the fears expressed as to harm ensuing, were the two TLDs to co-exist on the Internet, are not well founded.

## VIII Discussion & Findings

### A Substantive Aspect of the String

Module 3 to the Applicant's Guidebook (version 2012-06-04) sets out the following in paragraphs 3.5 and 3.5.1:-

#### "3.5 Dispute Resolution Principles (Standards)

Each panel will use appropriate general principles (standards) to evaluate the merits of each objection. The principles for adjudication on each type of objection are specified in the paragraphs that follow. The panel may also refer to other relevant rules of international law in connection with the standards.

The objector bears the burden of proof in each case.

The principles outlined below are subject to evolution based on ongoing consultation with DRSPs, legal experts, and the public.

#### 3.5.1 String Confusion Objection

A DRSP 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."

These provisions must also be read in conjunction with that portion of Module 2 to the Applicant's Guidebook (version 2012-06-04) which states the following relative to an application that passes the string similarity review:-

#### "2.2.1.1.3 Outcomes of the String Similarity Review

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."

B Appropriate General Principles (Standards)

Having regard to the test expressed in paragraph 3.5.1 above of Module 3 to the Applicant's Guidebook, the definition of String Confusion which is said to exist when a string "so nearly resembles another that it is likely to deceive or cause confusion" is clearly an adoption virtually verbatim of the general principles applicable in trademark law.

That this is the adoption of an international principle of trademark law is supported by reference to the GATT Agreement on Trade-Related Aspects of Intellectual Property Rights - Section 2 Trademarks - Article 16-1 - which provides:

"The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion."

The Panel also considers that it is helpful in cases such as these to look to decisions of the European Court, particularly as that body deals with international disputes (i.e. member States), as well as, in certain instances, possible trademark infringements in circumstances where the mark is in a language different to that used by the alleged infringer. In this regard the Panel would refer to *Lloyd Schushfabrik Meyer & Co GmbH v Klijsen Handel BV* 1999 All ER (EC) 587 and 1999 ECR 1-3819, particularly paragraph 25 of the judgment, wherein it is stated:

"In addition, the global appreciation of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 5(1)(b) of the Directive '..... there exists a likelihood of confusion on the part of the public .....' shows that the perception of marks in the mind of the average consumer of the category of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, to that effect, *SABEL*, paragraph 23)."

Moreover the yardstick now laid down of that of the mind of the average reasonable Internet user also bears comparison with what was said in the above case at paragraph 26:

"For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96 *Gut Springenheide & Tusky* [1998] ECR I-4657, paragraph 31)."

The Panel accepts that it is important to have regard to the overall view, as pointed out in the passages quoted above, which entitle the Panel to consider that this view supports the approach that where one of the factors, such as aural similarity may be decisive (such as *Lloyd Schushfabrik Meyer & Co GmbH supra* paragraph 28), the Panel must not overlook the fact that, if no one factor can be said to be decisive, it must take into account all factors relevant to the circumstances (*Sabel BB v Puma AG* 1998 RPC 199, 1998 ETMR 1 (1997); *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1998] ECR I-5507 paragraph 16). In so doing, and where appropriate, the Panel may have to evaluate the importance to be attached to each of those different factors or elements (*Lloyd Schushfabrik Meyer & Co GmbH supra* paragraph 27).

Whilst the Panel has sought to determine an appropriate formulation of the relevant international principles with particular regard to the decisions of the European Court, this does not mean that the Panel has either overlooked or not taken into account certain of the contentions, particularly of the Objector, where there might be a difference in emphasis, in that the Objector relied on United States case law which bears a striking similarity to the principles viewed on a more general basis. Indeed, and apart from the fact that the Objector selected what it contends to be appropriate relevant factors from the general factors used by the United States Federal Courts (and there does not appear to be any challenge to this approach by the Applicant in its Response), the Panel is aware of the fact that the European Courts speak of visual, aural or conceptual similarity (*Lloyd Schushfabrik Meyer & Co GmbH supra*), whereas the Objector contends that similarity must be viewed as being four factors, namely visual, phonetic, similarity of meaning and evaluation based on context and overall impressions. Whether this is somewhat wider than that suggested in the European Court cases, or is encompassed by what is there said to be conceptual similarity, is not a matter which requires a different or limited approach. The Panel is of the view that the fact that the Objector and, in its Response the Applicant, have chosen to deal with these four factors as being relevant is appropriate, and they will be viewed accordingly.

Bearing the above considerations in mind, the Panel turns to the specific complaints raised.

(a) Visual Similarity

What is required to be established by the Objector, who bears the onus, is that the slight spelling variation will probably give rise to confusing similarity. The fact that on the authorities cited a slight spelling variation will not prevent a finding being arrived at does not of itself mean that a slight spelling variation will, on the probabilities, give rise to confusing similarity. Obviously the circumstances must be considered and in this regard the Panel finds that the contentions advanced by the Applicant, which are summarised above, dealing with the fact that the TDL.com already co-exists with a number of ccTDLs, are that an examination of trademark registrations, even in the United States, shows that many trademarks that differ by one letter co-exist in the registry and that there are in fact similar co-existing trademarks in the trademark registry in Brazil.

The fact that the Objector did not object to other similar strings cited by the Applicant is not a factor which should tell against the Objector, in the view of the Panel, as each case depends on its own particular facts and circumstances, nor on the evidence available would such conduct constitute a waiver on the part of the Objector such as to give rise to an inference against it without knowledge of the circumstances which led to the non-objection and whether or not they were sufficiently relevant to the enquiry in the present case.

The further arguments by the Objector based on WIPO authority that inclusion of a subsidiary word to the dominant feature of market issue does not serve to obviate confusion does not arise in this instance, in the view of the Panel, inasmuch as that principle applies where it is established that either the whole mark or what is clearly the dominant feature thereof has been adopted and merely supplemented. The Panel is not satisfied that it could be said that the letters "om" constitute the dominant feature of the mark in this instance.

The Panel therefore concludes that there is insufficient to warrant a finding that visual similarity exists between .com and .bom.

(b) Phonetic Similarity

While it may be correct, as contended by the Objector, that the focus must be on how the word is pronounced by the public rather than what is considered to be a correct pronunciation, there is no evidence before the Panel suggesting that the public pronounce the two words in such a

manner as to give rise to sufficient phonetic similarity warranting the inference of confusion. Indeed, as is pointed out by the Objector, it may not be possible for a trademark owner to control how purchasers will vocalise the mark, which also does not assist the Objector in discharging the onus in this regard.

The Objector relies on the affidavit of Professor Stygall, who contends that the two words differ by only one sound, being the initial ".c" and ".b", coupled with aural similarity in the "o" sound in both words. Against that, the Applicant relies upon the study conducted by its expert, Mr Mauricio Raymundo de Cunto, confirming the lack of phonetic similarity between .com and .bom, and that a study conducted by him demonstrates that there is no room for such confusion.

Here the Panel is faced with conflicting views by respective experts. There is nothing to suggest that either expert is not an appropriately qualified expert in the field and each has expressed an opinion. The Panel is not satisfied that there are reasons expressed, certainly by Professor Stygall in support of her opinion, which refute the views of Mr de Cunto.

The Panel is also aware that when dealing with expert evidence, experts very often differ, and, even though one may be considered to be an expert whose views are supported by the majority in the field, there can still be a respectable minority to which the other expert belongs. In the absence of sufficient reasoning in favour of one view and negating or weakening the logic and reasoning of the other, the Panel is left in the situation that it cannot prefer one above the other. That being so, it is faced again with the difficulty that, the onus being on the Objector, it cannot find that that onus has been discharged.

(c) Similarity of Meaning

The contention of the Objector is fundamentally that, since .bom does not have a meaning in the English language which would serve to distinguish it from .com, there is no difference in meaning. Against that, however, the Applicant points out that the word "bom" has acquired a meaning in modern English, admittedly slang, and secondly that it indeed has a meaning in Portuguese and is in fact referred to by Professor Stygall as a "Portuguese word" in her affidavit.

Since there is no onus on the Applicant, the Panel has difficulty with the notion that there would in these circumstances be an onus on the Applicant to show that the word "bom" had a meaning to English speakers which would serve to distinguish the letter strings .com and .bom, and in the absence thereof it would follow that there would be no difference in meaning.



Although the Applicant has put forward considerable evidence to show that Portuguese is certainly a language which is not only the national language of some countries but also is spoken by a large number of people in the world, the Panel does not find it necessary, in the absence of further evidence, to decide whether similarity of meaning is limited only to the English language in having regard to Internet users, or whether it is permissible to look to meanings in other languages, as in this instance, where it is contended that the Applicant aims mainly at attracting Portuguese-speaking persons, although not limiting itself thereto.

The Panel finds that on the evidence, particularly that put up by the Applicant, there is insufficient to warrant the inference that the Objector has discharged the onus in this regard.

(d) Similarity Based on Context & Overall Impressions

While it is open to the Objector to deal with this factor on the basis that it has, namely largely having regard to the application of general and legal principles, the Panel finds force in the counter advanced by the Applicant that it has not provided sufficient evidence to support the contention that the context and overall impressions would give rise to a probability of confusion. Certainly the Objector has referred to case law as to the fact that the general impression created by marks should be looked at, taking into account all factors that potential purchasers would likely perceive and remember, and applying this principle to the average reasonable Internet user.

Although the Panel is not persuaded that the Objector has discharged the onus in regard, it does not find, as is suggested by the Applicant, that there is a basis necessarily to show an intention on its part to avoid competition and limit consumer choice.

(e) Confusion

Relying on United States case law, the Applicant has selected various categories which it contends are relevant in the present enquiry.

(i) Strength of Mark/Word

It is not disputed by the Applicant that, as is contended by the Objector, .com is, on all the evidence put up by the Objector, a string which is one of, if not the strongest, commercial string of existing TLDs in the market place.

Although this is not challenged, nor answered specifically, it seems to the Panel that, while it can be a factor in the overall, it would not

in the present instance, be the only or decisive factor, but would be one of the factors when taken in combination with others, sufficient collectively to warrant the appropriate inference.

(ii) Degree of Care Exercised by User

The thrust of the Objector's argument is that it considers there to be a likelihood that confusion will arise by reason of the fact that the relevant class of users in this instance would be casual Internet users likely to exercise a low degree of care when exposed to interacting with TLDs, thus increasing the likelihood of confusion. Again this is understandably speculative but there is nothing to show that such a concern is warranted.

Bearing in mind that the test is the average reasonable Internet user, that limits by definition the class, and certainly does not suggest that the test postulated of being a casual Internet user likely to exercise a low degree of care would be appropriate in the absence of any evidence to show that the latter represents the level of the average reasonable Internet user. The concept of a reasonable man is one well known to most systems of law and, when applied to a particular group or class of persons, as in this case Internet users, imports a sufficient knowledge and ability as well as discernment to be able to distinguish strings such as .com and .bom, given, as the Panel has already found, that it cannot be combined with high visual and aural similarity such as to increase the likelihood of any confusion.

(iii) Marketing Channels

Again, this ground is advanced on a speculative basis, save that the Applicant's application expresses an intention to make the applied-for TLD available to the public to promote everything that is good, thus a very wide spectrum, which is said to be the same as registrants for .com. That of itself does not necessarily give rise to confusion, whether or not it leads to overlapping marketing channels which are not of such a nature as to significantly increase the likelihood of confusion, as is suggested.

The Panel is of the view that the average reasonable Internet user, when using the Internet to obtain information or guidance as to appropriate websites or products, would be sufficiently aware of the difference in the strings .com and .bom.

(iv) Linguistic Experts

Professor Stygall is also put forward as an expert qualified to deal not only with phonetics but how the word is used, and she contends that the user of the QWERTY keyboard is such that the letters "b" and "c" are only one key apart, therefore the likelihood of error in typing is increased. Against that the Applicant tenders the opinion from Ms Erica da Freitas, a linguistic expert, who not only disagrees on the weight to be attached to the two words where only the first letter differs, but also points out that different fingers would normally be used to type different groups of letters, and that the group containing the letter "b" is one different to that containing the letter "c".

In this regard, the Panel finds itself in the same position as earlier and, for the reasons already expressed, cannot prefer the evidence of one expert against that of the other, thus resulting in the Objector not discharging the onus upon it in this regard.

(f) Confusing Similarity Between .com & .bom

After summarising the propositions already made, the Objector adds the contention that, prior to any new gTLD application being approved for further processing, ICANN performed an initial evaluation which involved comparing existing TLDs with every applied-for gTLD string for the purpose, in order to determine whether it was confusingly similar. That review was conducted by an independent panel and was a visual similarity check based on an algorithmic score which, in this instance, amounted to 63% similarity. This is contended by the Objector to be an important factor, albeit one aspect when added to the others.

Whilst the Applicant did not specifically address this contention in answer to this paragraph, it has, when responding to the Objector's arguments as to visual similarity, dealt with it in that context. In that regard it drew attention to the fact that, even though there was a 63% similarity score between the two TLDs, it would be unlikely to generate confusion as only three pairs of Latin-script strings were declared by ICANN as confusingly similar, all of which had indices ranging from 94% to 99%. Moreover, having regard to the further list published by ICANN and referred to, it showed that, while there were several TLDs considered as likely to cause confusion, their ratings were higher than 63%.

As there is no expert or other evidence to refute that of the Applicant or show that the rating is within a range likely to deceive or cause confusion, the fact that it is contended by the Objector that the higher the rating the

greater likelihood of such being the case, the Panel is not satisfied that the mere rating alone suffices.

The Applicant also advances the argument that the Objector did not object to what it considers to be appropriate comparisons between new gTLDs and existing TLDs, and that the present .bom and .com passed through the preliminary investigations without being considered confusingly similar. The Panel, however, does not consider that the failure to object, on the one hand, gives rise to some type of waiver or conduct on the part of the Objector which counts against it, nor does the Panel consider that it can hold against the Objector the fact that the gTLD .bom passed through the initial testing, since the Objector was not involved therein nor would the independent panel carrying out such a review have been aware of the specific objections now raised by the Objector.

Moreover as this review is, on the understanding of the Panel, a full rehearing, it would be not only unfair to the Objector but also be wrong to require it to assume on onus of having to show that the preliminary findings should stand, unless it is shown that they are wrong or unsupportable.

The Panel therefore does not see that it can attribute weight thereto since the Objector was not a party thereto, nor heard, in the course of the review.

Since the Panel has already made findings on the specifics raised in this argument and dealt with the initial argument, it remains unpersuaded that the Objector has, even if all factors are taken together and evaluated collectively, together with those specifically advanced on the issue of confusion, discharged the onus on it, for the reasons already expressed and which fall to be taken into account when considering context and overall impressions.

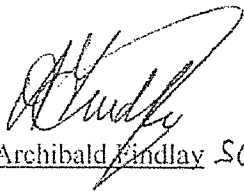
(g) Harm to Users & the Objector From Confusion

Obviously, if the Objector had succeeded in establishing that there was a probability of such confusion, harm would probably follow, but, as the Panel finds that the Objector has failed to demonstrate a likelihood of confusion, the issue of harm in the circumstances falls away, since it would have arisen only had the Objector succeeded.

**IX Determination**

The Panel accordingly finds that the Applicant has prevailed and the objection is dismissed.

Dated: August 12, 2013

A handwritten signature in black ink, appearing to read "A. Findlay", written over a horizontal line.

Archibald Findlay SC

Sole Expert Panelist