

International Centre for Dispute Resolution

New gTLD String Confusion Panel

Re: 50 504 T 170 13

Starting Dot, S.A.S., OBJECTOR

and

United TLD Holdco, Ltd., APPLICANT

String: <.immobilien>

EXPERT DETERMINATION

The parties

The Objector is Sporting Dot, S.A.S., 3 B, blvd de la Saussaye, 92200 Neuilly-sur Seine and is represented by Mr. Godefroy Jordan, its CEO and Chairman, and by Nathalie Dreyfus, its legal representative.

The Applicant is United TLD Holdco Ltd., Uglan House, South Church Street, George Town, Caiman Islands and is represented by Greenburg Traurig, LLP, United States of America.

The New gTLD String Objected To

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

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): “(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 Objection was filed with the International Centre for Dispute Resolution (the “ICDR”) on March 5, 2013 pursuant to the New gTLD Dispute Resolution Procedure (the “Procedure.”)

In accordance with Article 9 of the Procedure, on March 19, 2013, the ICDR completed the review of the Objection and determined that the Objection 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 Applicant of the Objection. In accordance with Article 11(b) and relevant communications provisions of the Procedure, the Response was timely filed with the ICDR on May 17, 2013. On May 23, 2013, the ICDR notified the parties that it would proceed with the appointment of the expert panel.

The ICDR appointed M. Scott Donahey as the Panel in this matter on June 14, 2013. The Panel 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.

On June 17, 2013, without requesting permission of the panel, Objector filed “Supplemental submissions to the Applicant’s Response to String Confusion Objection for [*immobilien*].” On June 18, 2013, Applicant objected to the supplemental submissions, and requested that if such submissions were accepted that Applicant be given thirty days in which to file a Supplemental Response.

In this particular case, the Panel determines pursuant to Article 17(a) of the Procedure that in the interest of fairness, it will accept and consider the supplemental submissions. In the interest of the expedition of the determination of the Objection, the Panel determines that it will deny Applicant’s request to file a Supplemental Response.

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

Objector is the current applicant for the New gTLD <.immo> and therefore has standing to pursue this objection. Section 3.2.2.1, Module 3, New gTLD Guidebook.

Factual Background

Objector has applied for five new gTLDs, all of which are industry related Top Level Domains, with the gTLD extension in each case intended to act as a label for a particular industry.

The term, “immo,” is a short hand form for the words indicating “real estate” in at least four languages, including German. Real estate brokers and property managers in Austria, France, Belgium, Germany, Italy, Luxembourg, and Switzerland are associated in the “Conseil Europeen des Professions Immobilières” or CEPI, which is translated into the English Language as “European Council of Real Estate Professionals.” The Managing Director of the CEPI association, in a letter dated 25 February 2013, supports Objector’s Objection to the proposed New gTLD <.immobilien>. Objection, Annex 1. CEPI supports the proposed gTLD <.immo> as “the most logic [sic] way to set up a dedicated TLD for real estate in Europe . . .” The letter states that “the co-existence of two different TLDs related to real estate and with the same meaning will i) create confusion in the European real estate market, ii) infringe CEPI’s objective to facilitate cross-border transactions inside the European Union, iii) undermine CEPI and European Commission common objective promote [sic] the realization of the internal market, which require uniform label of recognition for both property buyers and professionals, like the .IMMO TLD [sic].” The overall membership of CEPI has been estimated to be in excess of 200,000 corporations, representing 600,000 real estate professionals.

The Collins German-English Dictionary translates “eine immobilie” to mean “a property” and “immobilien” to mean “real estate” or “property.” “Immo” is the abbreviated form of “immobilien.” There is no semantic difference between “immo” and “immobilien.”

In its supplemental submissions, Objector cites the 1988 EU Trademark Directive and judicial decisions concerning European trademark law. Objector asserts that DOT IMMO is a registered European trademark held by Objector.

Parties’ Contentions

Objector

Objector contends that the proposed New gTLD <.immobilien> is intended for open registration and that such registration would mislead Internet users that the SLD registrants in <.immobilien> are part of the regulated profession of real estate and that this is likely to damage the reputation of regulated real estate agents. Objector describes these contentions as “public interest issues.”

Objector contends that its application for the proposed New gTLD <.immo> “is a community based application with the support of almost all professional organizations and real estate regulatory bodies for the applicable languages.”

In its supplemental submissions, Objector contends that in order to determine whether there is string confusion, it is necessary to take into account “visual, phonetic, and conceptual similarities between the signs,” and that one must “determine if a gTLD is ‘confusingly similar’ to existing trademarks” Objector contends that <.immo> and <.immobilien> are visually similar, because the beginnings of the strings are similar, and European courts deciding trademark cases have found that “the beginnings of the signs are of the most importance, since consumers normally focus their attention on the first part of words.” For the same reasons, the two proposed New gTLDs are phonetically similar. Also, the two proposed New gTLDs are conceptually similar, since “immo” is simply shorthand for “immobilien.”

Applicant

Applicant cites Module 3, Section 3.5.1, New gTLD Applicant Guidebook, for the proposition that string confusion should only be found where the string objected to “so nearly resembles another that it is likely to deceive or cause confusion , and that “it must be probable, not merely possible, that confusion will arise in the mind of the average reasonable Internet user.” *Id.* “Mere association in the sense that the string brings another string to mind is insufficient to find a likelihood of confusion. *Id.*

Applicant contends that the two strings are neither visually similar, nor phonetically similar. Applicant also contends that <.immo> and <.immobilien> are not confusingly similar strings, even though they admittedly have the same meaning, citing trademark case decisions on the subject of confusing similarity.

Applicant contends that it is not probable that confusion will arise in the mind of the average reasonable Internet user.

Applicant also contends that the USPTO forbids registration of a gTLD as a trademark and that courts have routinely found that trademark rights exist only as to the SLD and do not extend to the gTLD.

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.

As an applicant for a New gTLD, the Panel finds that 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

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.” 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.”

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 Panel 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, a Panel 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 Panel 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 panels.

In the present case, Objector’s concerns are really not string confusion concerns; rather they are in the nature of community objections, limited public interest objections, and/or legal rights objections, none of which Objector has raised pursuant to the Dispute Resolution Principles set out in Section 3.5, Module 3, New gTLD Applicant Guidebook. *See* gTLD Objections Filing Dispute Announcement at <http://newgtlds.icann.org/en/program-status/odr/filings>. Objector is concerned with how the real estate community might be affected by the approval of Applicant’s New gTLD application, whether there are “public interest issues” with Applicant’s New gTLD application, and whether the applied for New gTLD might create confusion in the mind of a consumer in the trademark sense. But Objector did not file a Community Objection. Nor did Objector file a Legal Rights Objection. Nor did Objector file a Limited Public Interest Objection. Objector only filed a String Confusion Objection.

In determining a String Confusion Objection, a Panel should first compare the visual elements (the “strings”) of the proposed New gTLDs. In comparing <.immo> to <.immobilien>. The Panel determines that it is not probable that in the mind of the average, reasonable Internet user that there would be a likelihood of confusion.

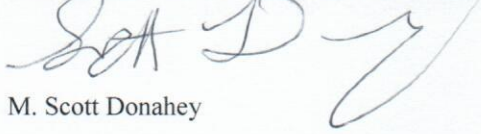
In considering the phonetics of the proposed gTLD strings at issue, the Panel is of the opinion that it is not probable that in the mind of the average, reasonable Internet user that there would be a likelihood of confusion between the sound of “immo” and the sound of “immobilien.” The fact that the two strings mean roughly the same thing would not in the present case give rise to confusion in the mind of the average, reasonable internet user, since one string consists of four characters and the other string consists of ten characters. A reasonable Internet user could not be confused that by entering the gTLD suffix <.immobilien> he would arrive at a site that had the suffix <.immo>.

The fact that the two strings have essentially the same meaning is insufficient in and of itself to create a likelihood of confusion. To determine otherwise would be to permit only one word out of a number of synonymous terms to serve as a gTLD.

In short, there is simply no reason that the two strings <.immo> and <.immobilien> could not co-exist as gTLDs on the Internet, offering Internet users alternative ways to register “real estate” related names. One of ICANN’s key responsibilities is to introduce and promote competition in the registration of domain names, and not to create new monopolies for registrars. *See, e.g.*, <http://newgtlds.icann.org/en/about/program>. This purpose should always inform the panel’s analysis of confusing similarities.

Determination

The Applicant has prevailed and the Objection is dismissed.

A handwritten signature in black ink, appearing to read "M. Scott Donahey". The signature is stylized and cursive, with a large, sweeping flourish at the end.

M. Scott Donahey

Sole Expert Panelist

August 21, 2013