International Centre for Dispute Resolution

New gTLD String Confusion Panel

Re: 50 504 T 00263 13

Commercial Connect. LLC, OBJECTOR

and

Amazon EU S.a.r.l., APPLICANT

String: <.STORE>

EXPERT DETERMINATION

The Parties

The Objector is Commercial Connect, LLC, 1418 South 3rd Street, Louisville, Kentucky, United States 40208 and is represented by Jeffrey S. Smith, 1418 South 3rd Street, Louisville, Kentucky, United States 40208

The Applicant is Amazon EU S.a.c.l., 5 Rue Plaetis, Luxembourg, Luxembourg L-2338 and is represented by Flip Petillion, Crowell & Moring, Rue Joseph Stevens 7, Brussels, Belgium, 1000.

The New gTLD String Objected To

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

This is Objector's description of the string. The string actually applied-for is in the Japanese language and "STORE" does not appear in the applied-for string. "Store" is the meaning of the Japanese word in the string applied-for. In this Expert Determination, the word ".STORE" is used to refer to the objected to string.

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 ("Guidebook") contains Objection Procedures and the New gTLD Dispute Resolution Procedure ("Procedure").

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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".

I.　　Introduction and Procedural History of this Case

The Applicant has applied to the ICANN for a new gTLD String herein notionally referred to as ".STORE". In this same round of TLD applications, Objector has applied to the ICANN for a new gTLD String ".SHOP".

Objector has filed a String Confusion Objection for resolution under the Procedure.

Applicant has filed a Response to the String Confusion Objection.

On April 11, 2013, the ICDR informed Applicant that deficiencies in the Objection had been rectified and that the Objection complies with Articles 5 – 8 of the Procedure and the ICDR Rules and the Objection would be registered for processing. Applicant claims it did not receive notification of the Objection or a copy of the Objection as required by Article 7(b) of the Procedure. Applicant further claims that, subsequently, it received from the Objector a Dispute Resolution Objection with blank unfilled spaces where the string applicant and relevant string would otherwise appear. On April 19, 2013, Applicant informed the ICDR that it had not received an objection on time and that it did not know if an objection was filed on time with the ICDR. For these reasons, Applicant requested the ICDR to disregard and dismiss the Objection. On May 3, 2013, the ICDR informed Applicant that the matter would proceed to an Expert for determination and that the matters of notification and timely filing may be raised as part of the Response which Applicant has done.

The issue in dispute between Applicant and Objector is whether .STORE so resembles .SHOP that it is likely to cause confusion in the mind of the average, reasonable internet user.

The remedy sought by Objector is described in the Objection, as "the avenues ... (of recourse) ...prescribed by ICANN."

In accordance with the Procedure, the evidence and submissions of the parties are contained in the Application, the String Confusion Objection, the Response and all

accompanying documents submitted electronically by the parties. This is an "all documents" proceeding. There was no oral hearing. The proceedings are governed by the Procedure and the ICDR Rules.

Appointment of John F. Curran, Q.C. as the sole Expert Panel member was made by the ICDR on June 18, 2013.

II.   **Basis for Objector's Standing to Object based on String Confusion**

The Objector's basis for standing is the following statement contained in the Objection:

> *"My name is Jeffrey S. Smith, President of Commercial Connect, LLC. We are a current gTLD applicant for the shop (dot Shop)TLD as well as the only remaining approved and active applicant for .shop in the 2000 round. I have standing to object pursuant to Module 3 Section3.2.2 on the grounds of String Confusion."*

Objector is a gTLD applicant in the current round and has standing.

III.   **Factual Background**

A.   Objector - The Objector was established in 2000 for the specific purpose to bring the .shop TLD to the internet. The Objector has applied for multiple TLDs including .SHOP in the current round.

B.   Applicant - The Applicant is among the world's largest online booksellers and a well known internet retailer. The Applicant offers a wide range of goods and services at its website which have been registered in over 180 countries worldwide.

IV.   **Parties' Contentions**

A.   Objector's Contention - The Objector contends that:

- The .STORE string so nearly resembles the .SHOP string that it is probable that confusion will arise in the mind of the average, reasonable internet user because the .STORE string is similar either visually, aurally, or has a similar meaning.

B.   Applicant's Contentions - The Applicant contends that:

- Objector failed to provide Applicant with a copy of the Objection and failed to properly identify the applicant or correctly describe the objected to string; and

- There is no overall similarity between the .STORE and .SHOP strings. They are:

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- ○   visually different;
- ○   aurally different; and
- ○   they have different meanings.

V.   **Discussion and Findings**

The present proceedings deal with the objection against the string identified by Objector as "—IDN for STORE". Applicant asserts that the ICDR identified the objected string as "STORE". However, the Applicant did not file an application for .STORE, but it did for a Japanese word printed in Japanese characters that translates into and means 'store'.

A.   Applicant contends that the failure of Objector to comply with Articles 5 to 8 of the Procedure should result in dismissal of the Objection. None of the Articles stipulate what the consequences are of non-compliance. Applicant does not cite any authority that dismissal is a proper remedy for non-compliance. Article 21 (d) of the Procedure limits remedies to determining the success or dismissal of an Objection. Ordinarily, that determination will depend on whether Objector has met the burden of proof that string confusion exists and is probable. Non-compliance with Articles 5 -8 would be factors to be considered in that determination.

B.   Visual, Aural, Meaning and Other Similarites/Differences: .STORE and .SHOP

Objector contends that .STORE so nearly resembles .SHOP that it is probable that confusion will arise in the mind of the average, reasonable internet user because .STORE is similar either visually, aurally, or has a similar meaning. But Objector provides no evidence or proof for this contention. In contrast, Applicant argues that the two strings are not confusingly similar. Applicant's evidence is that neither ICANN nor its String Similarity Panel found the two strings confusing. ICANN's String Similarity Assessment Tool, which provides an open, objective and predictable mechanism for assessing the degree of _visual_ similarity between TLD strings, was used to compare .STORE and .SHOP. When comparing .STORE with .SHOP, the similarity rate is 0%.

No Visual Similarity - Objector describes Applicant's applied-for string. not by the applied-for Japanese word, handwritten or printed in Japanese characters, but by .STORE, which is the English meaning of the Japanese word applied-for. Why Objector did so is unclear. It may be that the keyboard used by Objector had no Japanese letters, characters or symbols. That clearly is the reason why the Japanese script does not appear in this Expert Determination. Clearly, when the applied-for Japanese version (as distinct from its English meaning, "store") is compared with .SHOP, there is no visual similarity between the two applied-for strings. This view is confirmed by the results of the String Similarity Assessment Tool which considers both strings to be 0% similar.

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No Aural Similarity - Applicant acknowledges in its Response that "one can hear that the (Japanese) word sounds more or less as 'store'." The sound of the word 'store' is not comparable to the word 'shop'. While the first letter in 'store' is the same as in the word 'shop', the sound of the first letter is pronounced differently in both words. The letter 'o' which appears in both words is also pronounced differently in 'store' and in 'shop'. The other letters in both words also generate different sounds which makes both words clearly distinguishable.

Different Meanings – As verbs, 'store' and 'shop' have different and unrelated meanings. As nouns, they are different as well. 'Shop' connotes an establishment where specific goods or a specific sort of goods are sold; whereas 'store' connotes an establishment where more diverse goods are sold.

C. Standard of Expert Panel Review and Burden of Proof for String Confusion - In considering whether the ".STORE" string is likely to result in string confusion, the Guidebook sets forth the guiding principles, or standards, that each dispute resolution panel will apply in reaching its expert determination. In the case of a String Confusion dispute, Article 3.5 (Dispute Resolution Principles (Standards) of the Guidebook states that:

> *"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 appropriate principles (standards) referred to in Article 3.5 of the Guidebook for String Confusion Objections is set forth in Section 3.5.1 of the Guidebook as follows:

> *"...[an Expert Panel] ... 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."*

This standard is sometimes referred to hereinafter as the "Probability Standard".

In addition to Article 3.5 of the Guidebook, Article 20(c) of the Procedure places on Objector the burden of proving that its Objection should be sustained in accordance with the applicable standards. In other words, in this case, Objector must affirmatively prove that the ".STORE" string "so nearly resembles" the ".SHOP" string "that it is likely to deceive or cause confusion", and that such confusion is

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"probable, not merely possible." As noted in Article 3.5.1 of the Guidebook "mere association, in the sense that the string brings another string to mind, is insufficient to find a likelihood of confusion."

With the Probability Standard (Article 3.5.1 of the Guidebook) in mind, the task of the Expert is to determine whether Objector has proved that the .STORE string is likely to be confusing and such confusion is probable.
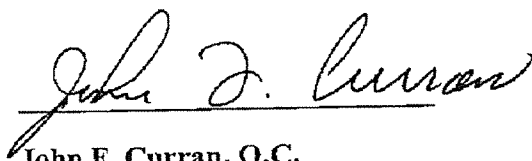
In making its case, Objector has failed to support its single contention (Section IV.A. above) with any evidence whatsoever of visual, aural, meaning or any other similarities such that it is probable confusion will arise between .STORE and .SHOP. In contrast, Applicant has made a persuasive and convincing case that confusion between .STORE and .SHOP is not probable. I accept Applicant's evidence and arguments that the Japanese word (meaning 'store') and .SHOP are clearly different. I find that it is not probable that Applicant's applied-for gTLD Japanese language string (meaning 'store' in Japanese) is likely to result in string confusion

Article 21(d) of the Procedure provides that the remedies available to an Applicant or an Objector pursuant to any proceeding before a Panel shall be limited to the success or dismissal of an objection and to the refund by the ICDR to the prevailing party of Costs pursuant to Article 14(e) of the Procedure and any relevant provisions of the applicable ICDR Rules.

VI.   Determination

The Applicant has prevailed and the Objection is dismissed.

August 26, 2013

John F. Curran, Q.C.

Sole Expert Panelist

International Centre for Dispute Resolution
New gTLD String Confusion Panel

Re: 50 504 T 00263 13
Commercial Connect. LLC, OBJECTOR
and
Amazon EU S.a.r.l., APPLICANT

Procedural Order No. 1

Objector's Request: "We would like to request permission from the mediator to submit additional information in this case relating to the ICANN's design of the dispute mechanism for the new gTLDS. We are hoping that is may assist the mediator in understanding the foundation and technical issues everyone is facing and what tests should be applied to determine string similarity and/or confusion."

Applicant's Respnse: "The Applicant believes that it is not useful for the Objector to submit additional information "relating to the ICANN's design of the dispute mechanism for the new gTLDS".

Rather, the Applicant is of the view that it may trust that the Panel is aware of the applicable rules related to this procedure and will contact the parties if their views or additional information would become required. Therefore, the Applicant is of the opinion that the requested permission should not be granted."

Expert Panel's View: Standard of Expert Panel Review and Burden of Proof for String Confusion - In considering whether the ".STORE" string is likely to result in string confusion, the Guidebook sets forth the guiding principles, or standards, that each dispute resolution panel will apply in reaching its expert determination. In the case of a String Confusion dispute, Article 3.5 (Dispute Resolution Principles (Standards) of the Guidebook states that:

> "*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.*"

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> "*...[an Expert Panel] ... 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.*"
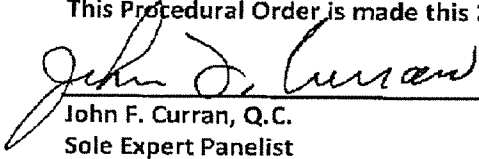
In addition to Article 3.5 of the Guidebook, Article 20(c) of the Procedure places on Objector the burden of proving that its Objection should be sustained in accordance with the applicable standards. In other words, in this case, Objector must affirmatively prove that the ".STORE" string "so nearly resembles" the ".SHOP" string "that it is likely to deceive or cause

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confusion", and that such confusion is "probable, not merely possible." As noted in Article 3.5.1 of the Guidebook "mere association, in the sense that the string brings another string to mind, is insufficient to find a likelihood of confusion."

Accordingly, in the Expert Panel's view, the applicable rules related to the determination of this case are abundantly clear as set forth above and no additional information from either party relating to the ICann's design of the dispute mechanism is required. The Objector's request is denied.

This Procedural Order is made this 26th day of August, 2013.

John F. Curran, Q.C.
Sole Expert Panelist