International Centre for Dispute Resolution

New gTLD String Confusion Panel

Re: 50 504 T 00248 13

Commercial Connect LLC, OBJECTOR

and

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

String: <.家電>

EXPERT DETERMINATION

I   The Parties

The Objector in this proceeding is *Commercial Connect, LLC*., located at 1418 South 3rd Street Louisville, Kentucky, United States, 40208.

The Applicant in this proceeding is *Amazon EU S.a.r.l.*, with its principal place of business located at 5 rue Plaetis, Luxembourg, Luxembourg, L-2338.

II   The New gTLD String Objected To is

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

III   Objector's TLD String serving as the basis for its objection is:

Objector's string serving as the basis for its confusion claims is ".SHOP".

IV   Prevailing Party.

The Applicant has prevailed and the Objection is dismissed.

V The New gTLD String Confusion Process

Article 1(b) of the New gTLD Dispute Resolution Procedure (the *"Procedure"*)[1] states that "[t]he 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) of the *Procedure* mandates that "String Confusion Objections shall be administered by the ICDR."

VI Procedural History of this Case

In accordance with the *Procedure*, Applicant filed its Application for the new gTLD referenced above. Objector filed its Objection based on alleged confusion with its gTLD ".SHOP."[1] Applicant then timely filed its Response and the dispute based on the category

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[1] The *Procedure* is an Attachment to Module 3 of the gTLD Applicant Guidebook (the " Guidebook") approved by the Internet Corporation for Assigned Names and Numbers ("ICANN") on June 20, 2011 and as updated on June 4, 2012.

[2] In its Response, Applicant states that the present proceedings deal with the objection against the string identified by the Objector as "xn--fct429k Consumer Electronics."

On April 11, 2013, the ICDR informed Applicant's primary contact for several of its new gTLD applications that it had conducted an administrative review of an objection filed by Mr Jeffrey S. Smith on behalf of Objector (the 'Objection') and that it had noted that "after rectifying deficiencies previously set forth" the Objection "complies with Articles 5-8 of the *New gTLD Dispute Resolution Procedure* and the applicable ICDR (DRSP) Rules" and "shall be registered for processing".

In its Response, Applicant noted that it had not received any formal objection, nor had it received any copy of an objection in compliance with Article 7(b) of the *Procedure*. It argues that not copying the Applicant is a deficiency that cannot be rectified under the Procedure;

In an email of March 18, 2013, the ICDR acknowledged receipt of the Objection by Commercial Connect with reference to Case number 50 504 T 00248 13. There is no reference to the string noted.

On March 29, 2013, Amazon received an 'ONLINE FILING DEMAND FOR ARBITRATION/MEDIATION FORM' that refers to the string 'xn«fct429k' with the English meaning 'Consumer Electronics'. No objection against this string was published in either ICANN's Dispute Announcement, nor in the ICDR's list of filed objections.

By email of April 4, 2013, the ICDR specifically requested the Objector to: indicate the string it objected to;

"String Confusion Objection" was referred to the ICDR, who appointed the undersigned Expert to render a ruling on the issue of String Confusion between the TLDs in question in accordance with the *Procedure* and the ICDR's *Supplementary Procedures for String Confusion Objections*.[2]

VII   Basis for Objector's Standing to Object based on String Confusion

Under Article 8 of the *Procedure*, the Objection filed by the Objector is to contain, *inter alia*, a statement of the Objector's basis for standing, a description of the basis of the Objection, a statement of the ground(s) upon which the Objection is being filed (in this proceeding, String Confusion), and an explanation of the validity of the Objection and why it should be upheld.

A.   Objector's Basis for Standing/Ground for Filing/String Confusion

provide the Application ID for confirmation;
provide "proof or statement" that copies of the objection were sent to Amazon.

The Objector did not respond to the above requests by the ICDR, or at least failed to copy Amazon in its answer to the ICDR;

Applicant states that it has not received the following documents from the Objector:

a 'Dispute Resolution Objection' with blank unfilled spaces where the string applicant and relevant string would otherwise appear;
a TLD Application for .mall, .shop, and .svc submitted by Commercial Connect (October 11, 2000).

On April 19, 2013 the Applicant informed the ICDR that it had neither been informed of, nor received any information that allowed it to conclude that any previously set forth deficiencies in the Objection had been rectified timely. The Applicant requested the ICDR to disregard and dismiss the Objection.

Applicant states that it reiterated this request on April 24, 2013.

On April 25, 2013, the ICDR responded that the Objection related to the application for SHOP. Later that day, the ICDR informed the Applicant that the reference of the string was incorrect, that it was reviewing the objections once again and would follow up with a clarification.

On May 2, 2013, the ICDR clarified that the Objection related to the string (applicant number 1-1318-54339). The ICDR also informed the Applicant that any issues regarding the validity of an Objection may be raised in an Applicant's Response, which remained due by May 17, 2013. Applicant argues that the Objection should be dismissed for reasons of due process because Objector failed to copy the Applicant in accordance with Articles 6(b) and 7(b) of the *Procedure* which state that the DRSP, the Panel, the Applicant, and the Objector **shall** provide copies to one another of all correspondence regarding the proceedings and that a copy of the Objection **must** be sent to the Applicant. Applicant argues that not copying the Applicant is a deficiency that cannot be rectified under the Procedure.

Applicant also asserts that the Objector did not clearly indicate which application it objected to and it was not until May 2, 2013 that it was informed which gTLD string was the subject of these proceedings.

Based on the foregoing, Applicant in its Response requested that the Panel dismiss the Commercial Connect's Objection.

[2] *See Procedure*, Articles 3 (a), 4 (b) (i), 8, 11 and 13.

In its Objection and accompanying affidavits, Objector claims standing in this proceeding as the existing TLD operator for the ".SHOP" TLD. and asserts its objection to Applicant's application on the basis that the latter's proposed gTLD, string is confusingly similar to the .家電 gTLD.

B.   Legal Standard

1.   String Confusion:

According to the *Procedure*, "[s]tring confusion exists where a string so nearly resembles another that it is *likely* to deceive or cause confusion." *Guidebook* (v. 2012-06-04), Module 3, Section 3.5.1.) *The Guidebook states that*, "[i]n this *Applicant Guidebook*, '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." *Id*. Module 1, Section 1.1.2.10. "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." *Id*. Module 3, Section 3.5.1.[3] *The Guidebook* also states that mere association, in the sense that string brings another string to mind, is insufficient to find a likelihood of confusion.

2.   Burden of Proof

Article 20 (c) of the *Procedure* provides that "[t]he Objector bears the burden of proving that its Objection should be sustained in accordance with the applicable standards."[4] Accordingly, Objector has the burden of establishing by a preponderance of the evidence that the

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[3] The standards articulated in the ICANN *Dispute Resolution Procedure'* reflect and parallel long-established standards governing likelihood of confusion that have developed under U.S. trademark law and trademark law more broadly. Indeed, the ICANN standards expressly refer to the trademark law concept of "likelihood of confusion." See gTLD Applicant Guidebook, Module 3, Section 3.5.1. Similarly, the ICANN standards require a probability of confusion, which reflects trademark law standards.

As under trademark law, the Applicant Guidebook makes it clear that the likelihood of confusing similarity must consider more than mere visual similarity, although visual similarity is an important consideration. The Applicant Guidebook expressly states that with regard to objections based on string confusion, "[s]uch 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." gTLD Applicant Guidebook, Module 2, Section 2.2.1,1.3 (emphasis added).

This is essentially the same test for similarity applied under U.S. trademark law. See, e.g., *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 351 (9th Cir. 1979), abrogated on other grounds by *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003). As explained below, similar standards also are applied under the Uniform Domain Name Dispute Resolution Policy ("UDRP") adopted by ICANN.

[4] The standards referred to are set forth in *Legal Standard* above.

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gTLD applied for by Applicant so nearly resembles Objectors' TLD that it is **likely** to deceive or cause confusion." *Guidebook* (v. 2012-06-04), Module 3, Section 3.5. Objector bears the burden of proving that the strings are so similar that they create a **probability** of user confusion if more than one of the strings is delegated into the root zone." *Id.* Module 1, Section 1.1.2.10. "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*." *Id.* Module 3. (Emphasis added by Designated Expert.)

VIII   Factual Background

Objector participated in in ICANN's 2000 proof of concept round, but the .SHOP gTLD was not assigned to it and Objector has now filed a new unsponsored TLD application for .SHOP. (*See Response* 2:1B.) From 2004 to present Objector claims to have been active in obtaining supporters for its .SHOP gTLD which it asserts is "intended to provide a safe and secure eCommerce experience which meets and exceeds what is offered currently. To date there are in excess of 15,000 members which represent over $650 trillion is annual revenues that support our application for .shop." (*See, Objector Commercial Connect's Objection.*)

Applicant is "among the world's largest online booksellers and a well known Internet retailer" offering "a wide range of goods and services at its 'www.amazon.com' website under its AMAZON and AMAZON-formative marks, which have been registered in over 180 countries worldwide." (*See Applicant Amazon's Response* 2:1A.)

IX   Parties' Contentions

1.   Objector's Contentions Regarding Confusing Similarity

Objector contends that its Objection should be upheld since Applicant's applied for gTLD "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 IDN for Consumer Electronics gTLD application is similar either visually, aurally, or has a similar meaning." (*Objection.*)

2.   Applicant's Response

As noted above, Applicant requests that the Objection be dismissed based on due process grounds (see, fn. 2). Substantively, in its Response, Applicant asserts, that "there is no risk of confusion in the mind of the average reasonable Internet user, nor is such risk probable, given the dissimilarity of meaning, sound and visual appearance Accordingly, there is no likelihood of confusion between the strings" in question. (*See* Applicant *Amazon's Response*, p. 10.)

X   Findings

After having carefully reviewed and considered the facts, law, applicable rules, and the allegations set forth in the documents submitted by the parties appearing in this proceeding;

find that Objector has failed to meet its burden of proof to establish by a preponderance of the evidence that Applicant's use of the gLTD ".家電" would be confusingly similar to Objector's .SHOP gTLD. Consequently, as noted above, Applicant is declared the prevailing party in this proceeding, the Objection is dismissed and Applicant/ shall be refunded its deposit for this matter made to the ICDR.

XI   Discussion and Reasons for Determination

The parties agree that under the *Procedure*, in order for the Objector to prevail, Objector must prove that the co-existence of the two TLDs in question would *probably* result in user confusion.[5]

I find that the visual, phonetic (aural) and conceptual differences between the two TLDs in question are sufficiently great to conclude that the public would *most probably* not be confused or deceived by the existence of the two TLDs in the marketplace. Consequently, I find that Objector has failed to meet its burden of proof regarding the *probability* of such confusion. (Emphasis added.)
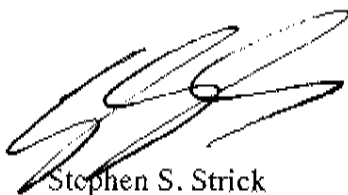
In considering the parties' arguments, I was persuaded, in part, by Applicant's arguments relating to the overall impression of its applied for TLD, including the proof offered by Applicant as to the dissimilarity of sound, visual impression and meaning between its gTLD and the gTLD .SHOP. (*See* Amazon's *String Confusion Response*.)

Given the foregoing finding and the ruling in Applicant's favor the issues of due process put forward by Applicant are not reached and no opinion is expressed with respect to such issues.

XII   Determination

The Applicant has prevailed and the Objection is dismissed.

Dated: August 30, 2013

Stephen S. Strick

Sole Expert Panelist