

**International Centre for Dispute Resolution**  
**New gTLD String Confusion Panel**

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Re: 50 504 T 00232 13

VeriSign, Inc.

OBJECTOR

and

Trixy Manor, LLC.

APPLICANT

String: <.network>

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**EXPERT DETERMINATION**

**The parties**

The Objector is VeriSign, Inc. of 12061 Bluemont Way, Reston, VA 20190, USA and is represented internally by Thomas Indelicarto, Verisign, 12061 Bluemont Way, Reston, VA 20190, USA.

The Applicant is Trixy Manor, LLC of 10500 NE 8th Street, Suite 350, Bellevue, WA, USA 98004 and is represented by John M. Genga and Don C. Moody, The IP& Technology Legal Group, P.C., 15260 Ventura Boulevard, Suite 1810, Sherman Oaks, California 91403 USA.

**The New gTLD String Objected To**

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

**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**

1. On March 13, 2013, pursuant to the Procedure, the Objector filed with the International Centre for Dispute Resolution (“ICDR”) an ICANN gTLD String Confusion Objection that is the subject of this proceeding.
2. On March 18, 2013 the ICDR acknowledged receipt of the Objection and advised the parties that pursuant to Article 9 of the Procedure it would conduct an administrative review of the Objection.
3. On April 3, 2013 the ICDR advised the Objector that it had conducted the administrative review, that the Objection complied with Articles 5-8 of the Procedure and with the ICDR Supplementary Procedures for String Confusion Objections (Rules) (“the applicable ICDR Rules”) and that accordingly the Objection would be registered for processing.
4. On April 17, 2013, the ICDR advised the parties that the Applicant was invited to file a Response to the Objection.
5. On May 17, 2013, the Applicant filed with the ICDR its Response to the Objection which was timely received.
6. On May 23, 2013, the ICDR advised the parties that it had conducted an administrative review of the Response to the Objection and noted that the Response complied with Article 11 of the Procedure and the applicable ICDR Rules.
7. On June 17, 2013 and pursuant to Article 13 of the Procedure, the ICDR appointed The Honourable Neil Anthony Brown QC (“the Expert”) as an Expert in this matter. Prior to accepting appointment, the Expert, pursuant to Article 1 of the applicable ICDR Rules and to ensure compliance with Article 13(c) of the Procedure, declared to the ICDR that there were no circumstances likely to give rise to justifiable doubts as to his impartiality and independence. The Expert has satisfied himself that he was properly appointed.
8. Each party has made its advance payment of Costs pursuant to Article 14 of the Procedure.

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



Section 3.2.2. of Module 3 of the Guidebook provides that objectors must satisfy standing requirements to have their objections considered. Section 3.2.2.1 of that Module provides *inter alia* that in the case of a string confusion objection, “(a)n existing TLD operator may file a string confusion objection to assert string confusion between an applied-for gTLD and the TLD that it currently operates.”

The Objector is the operator of the <.net> TLD and therefore has standing to make the present objection.

### **Factual Background**

1. This is a proceeding to determine whether the proposed generic Top Level Domain (gTLD) <.network> is confusingly similar to the current generic Top Level Domain <.net>. It is brought pursuant to Module 3 of the gTLD Applicant Guidebook (“the Guidebook”) approved on June 20, 2011 and as updated on June 4, 2012 by the Internet Corporation For Assigned Names and Numbers (“ICANN”), the Procedure and the applicable ICDR Rules.
2. The Parties are VeriSign, Inc, a United States company (“Verisign” or “the Objector”) which is the Objector and Trixy Manor, LLC, a United States company (“Trixy Manor” or “the Applicant”) which is the Applicant for the new gTLD <.network> pursuant to Application ID #1-1572-10553 and hence the Respondent in this proceeding.
3. Verisign is the Objector as it operates the current TLD <.net>, one of several existing TLDs. It argues that the string of the proposed TLD <.network> is confusingly similar to the current TLD <.net>. Trixy Manor maintains that the proposed <.network> TLD is not confusingly similar to <.net>.

### **Parties’ Contentions**

#### **Objector**

The Objector makes the following contentions.

1. The <.net>TLD has a unique, strong and well-established identity. The letters “.net” are derived from an abbreviation of the word “network” which signifies its originally intended purpose of use by organizations involved in networking technologies. The Objector has operated the <.com> and <.net> registries for over 20 years and has performed successfully in that role. The <.net> TLD is one of the strongest labels in internet usage. The Applicant’s use of “network” as the name of a new TLD would therefore create confusion among internet users.
2. The ICANN standards set out in the Guidebook on when string confusion exists and the meaning of “similar” in the context of “confusingly similar” reflect standards governing the likelihood of confusion under US trademark law and trademark law generally. The ICANN standards also look to the probability of confusion. Confusing similarity may consider more than visual similarity and may be based on any type of similarity.

3. The Objector then makes submissions on visual similarity ; contends that there is a visual similarity between <.net> and <.network>; phonetic similarity; similarity of meaning ; contends that <.net> and <.network> have the same meaning and that <.net> is recognized as an abbreviation of “network” and contends that similarity is based on context and overall impressions.

4. The Objector then turns to the issue of confusion and discusses the general factors used by United States courts in assessing likelihood of confusion, namely strength of the mark/word, degree of care exercised by the user and marketing channels and submits that they militate in favour of a finding of confusing similarity between <.network> and <.net>.

5. The Objector then submits that expert and linguist evidence will demonstrate confusing similarity. The expert evidence will be that the similarity between <.network> and <.net> is material and likely to cause confusion and that the strings <.network> and <.net> are confusingly similar.

6. Under the ICANN standards, <.net> and <.network> are confusingly similar because of their visual similarity, phonetic similarity and similarity of meaning. Moreover, at the Initial Evaluation stage, a similarity score of 43% between <.network> and <.net> was achieved, showing confusing similarity.

7. The Objector then submits that the string confusion contended for will cause harm to internet users as well as the Objector.

8. The Objector tendered affidavits of two expert witnesses, being a lawyer in private practice in trademark matters and an academic linguist and a declaration by a Director of the Objector.

### **Applicant**

The Applicant makes the following contentions.

1. The <.network> string does not bear actionable resemblance to the Objector’s TLD <.net>. There is no “probable” confusion and the Objector has not made out a case to that effect. Rather, Objector seeks to stifle fair competition and free speech by misusing the ICANN objection process to obstruct the path of those applying for distinct TLD names for the benefit of the public.

2. The Objection contravenes both the letter and spirit of the new gTLD program, the goals of which include increased choice, expression and competition in the domain name industry.

3. In creating the string confusion objection, ICANN set an extremely high standard for objectors. It expressly placed the burden squarely on objectors to prove the elements comprising the objection.

4. ICANN’s independent review panel has already performed its initial string similarity review and did not reject the Applicant’s proposed string as being contrary to string similarity prohibitions.



5. The Objector can establish string confusion only by carrying its burden of proving that “a string so nearly resembles another that it is likely to deceive or cause confusion.” To do so, Objector must show that it is “probable, not merely possible that confusion will arise in the mind of the average, reasonable Internet user.” In performing that task, trademark law is of limited value. In any event the Objector has not established the element required.

6. Objector does not even come close to satisfying its substantial burden to prove probable confusion among average, reasonable Internet users.

7. The Objector also runs the <.com> TLD and was happy to apply to run <.co> and it is noteworthy that no confusion has resulted in that area.

8. ICANN’s string similarity panel’s result of 43 % similarity is low compared with other comparisons that were made.

9. The <.net> and <.network> strings differ substantially in sound.

10. Both “network” and “net” have divergent meanings – including, in each case, as words completely unrelated with the objector.

### **Discussion and Findings**

1. **Burden of proof.** The first matter to be considered is which party bears the burden of proof. In this matter the burden of proof is on the Objector. That would be so as a matter of general principle even without any specific provision in the ICANN requirements governing this proceeding; the proceeding concerns an attempt by the Objector to dislodge the Applicant/ Respondent from its prospective entitlements and rights under the application for a new gTLD pursuant to the new TLD arrangements and the burden of making out a case for doing so must rest on the party who wishes to achieve it.

2. But even apart from general principles, the relevant provision in the ICANN Guidebook makes it clear beyond doubt that the burden of proof is on the Objector. That conclusion is drawn from Section 3.5 of Module 3 in the Guidebook, which provides, among other things, that “The objector bears the burden of proof in each case”. The onus is therefore on the Objector to prove its case.

3. The same proposition is stated again in the section of the Guidebook devoted to procedures, namely the Attachment to Module 3. That procedure provides as follows:

#### **Article 20. Standards**

(a) For each category of Objection identified in Article 2(e), the Panel shall apply the standards that have been defined by ICANN.

(b) In addition, the Panel may refer to and base its findings upon the statements and documents submitted and any rules or principles that it determines to be applicable.

(c) The Objector bears the burden of proving that its Objection should be sustained in accordance with the applicable standards.”

4. But the question instantly arises: if the burden of proof is on the Objector, what does the Objector have to prove? The answer to that question is contained in the provisions in the Guidebook relating to certain standards that must be applied in these proceedings. That requirement comes about because, first, Article 20 of the Procedure requires the Panel to apply the standards defined by ICANN. Secondly, Section 3.5 of Module 3 of the Guidebook provides for “Dispute Resolution Principles (Standards)” and Section 3.5.1 of the Module contains the standards to be applied in cases of String Confusion Objections. Those standards are as follows:

#### **“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.”

5. Thus, in the present case, to comply with the standards, Verisign must prove that the proposed <.network> TLD is likely to result in string confusion with an existing TLD, in the present case the existing TLD <.net> and within the meaning articulated in the standard. In particular, the standard requires the Objector to prove that string confusion is “likely to result.” This does not weaken the burden on an Objector, but strengthens it.

6. The provisions of the Guidebook just referred to and dealing with standards then give an indication of when it is likely that string confusion has arisen. Module 3, Section 3.5.1 provides that:

“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.”

7. Thus, a mere possibility of string confusion is not enough and the time-honored criterion of “probably” must be satisfied; moreover, the probability of confusion must have arisen in the mind of the average, reasonable Internet user.

8. The notion of probability is not confined to Section 3.5.1 of Module 3. It has previously been invoked in the definition of “similar” which appears on two occasions in the Guidebook. The first occasion is in Module 1, Section 1.1.2.10 where it is said:

“In 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.” (Module 1, Section 1.1.2.10).

The second occasion is in Section 2.2.1.1 of Module 2 of the Guidebook where the same definition appears:

“In 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.”



9. But the test of whether it is probable that confusion will arise in the mind of the average, reasonable Internet user must be applied judicially and it is not enough to conclude that someone, somewhere will probably be confused by the string. The test is made more specific than that by requiring that the probable confusion must be in the mind of “the average, reasonable internet user.” The task of the Expert in the present proceeding, is therefore to place himself in the position of the average, reasonable internet user and to assess whether such a person would probably be confused by the proposed string.

10. Then, in this analysis of principles, the question arises: what is string confusion? To that question the answer is given, as has been noted, in Section 3.5.1 of Module 3, namely that “(s)tring Confusion exists where a string so nearly resembles another that it is likely to deceive or cause confusion.”

11. Finally, the standards add another cautionary rule in interpreting the Module and in assisting Experts to decide whether in a given case, a likelihood of confusion has been established. This is achieved by reminding the Expert that just because an object reminds one of something else, does not mean that the observer is confused between the two. It does this by providing: “Mere association, in the sense that the string brings another string to mind, is insufficient to find a likelihood of confusion.” Logically, that is a correct statement and a timely reminder, as is well illustrated by the observation of the court in *In re Ferrero*, 479 F.2d 1395, 1397 (CCPA 1973) that:

“Seeing a yellow traffic light immediately ‘calls to mind’ the green that has gone and the red that is to come, or vice versa; that does *not* mean that confusion is being caused. As we are conditioned, it means exactly the opposite.”

12. Putting all of these criteria together clarifies the task of the Expert and shows the obligations of an Objector in these proceedings. Those obligations are that the Objector:

- (a) must prove its case;
- (b) must do so on the balance of probabilities and must therefore show that string confusion will probably occur; noting that
- (c) it is not enough to show that string confusion is a possibility; and
- (d) what the Objector has to prove is that string confusion is likely to result; and
- (e) it must prove that the string confusion is likely to arise in the mind of an average, reasonable Internet user;
- (f) the state of string confusion that must exist for the Objector to succeed is where “a string so nearly resembles another that it is likely to deceive or cause confusion”;
- (g) finally, that task will not be assisted by showing that the string brings another string to mind.

13. The starting point in this inquiry consists of the terms of the objection itself.

The Objection is:

**“String Confusion Objection** – The applied-for gTLD string is confusingly similar to an existing TLD or to another applied for gTLD string in the same round of applications.”



As has been noted, “similar” has in effect been defined in two provision in the Guidebook, Module 1, Section 1.1.2.10 and Module 2, Section 2.2.1.1, namely : “In 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.”

14. The applied for string is <.network>. The existing TLD is <.net>. The question is therefore whether the string <.network> is confusingly similar to the string <.net>. The Determination of this Expert is that the string <.network> is not confusingly similar to the string <.net>. That is so for the following reasons.

15. There are essentially two questions which, to some extent overlap, but they are nevertheless two questions. The first question that arises is whether the two strings are similar, as defined in the Guidebook. The second question is whether, if the two strings are similar, are they confusingly so? As to the first question, is true that each string consists of a word that contains the same three letters, “n”, “e” and “t”; all three of those letters appear at the beginning of each of the two strings; and they appear in the same order in each case. However, what is most dominant when the two are compared is that each of the words “network” and “net” stands in its own right and has an understandable and workable meaning of its own. It is that fact that persuades the Expert that the two words are not similar. They have the common features mentioned above, but undoubtedly those who drafted the Guidebook meant that to determine similarity, the entire words should be compared. When the Expert compares the entirety of the two words, he reaches the conclusion that they are not similar. Moreover, it is equally clearly ICANN’s intention that in interpreting whether the three common letters appearing in each word makes the two strings similar, the Expert should use the definition that has been mandated in the Guidebook and repeated. The question is therefore whether the two strings are so similar that they create the probability of user confusion. The Expert’s view on that question is that they are not similar, as they will not probably give rise to user confusion. Users will recognize that one of the strings can stand on its own as a separate word and that the other can do likewise and that that difference means that they should regard the two strings as entirely different, as they are. Internet users are now very well aware that, on the internet, even small differences in spelling and meaning are significant and that they mean different things, will lead to different destinations such as websites and email destinations and will carry consequences, such as whether communications are genuine and arrive at their correct destinations. Internet users have become increasingly aware of such differences and are now mature and sophisticated enough to realize it when they are being presented with such differences; indeed, internet users are so astute to such matters that they now look for them to ensure as best they can that they are not being mislead or deceived. There will therefore, in the opinion of the Expert, be no probability of user confusion if the two strings are delegated into the root zone.

16. The Expert also points out that although the meanings of two words may in part overlap, that does not mean that they are similar. In determining similarity, it is the dominant features of words and the substance of their meanings that must be compared. When that is done in the case of the two words at issue here, it is seen that the dominant features of the two words are that they can and do stand as different words, with their own meanings and uses and that, although there may be some overlap, each of them has some meanings that are not possessed by the other. The Expert therefore finds that the two strings are not similar.



17. But even if they are similar, are they confusingly similar? This, by far, is the more significant question. The Expert finds that <.network> is not confusingly similar to <.net>. In particular, the Expert finds that the Objector has not discharged its burden and its Objection therefore fails.

18. We have already seen from the Guidebook and the standards that must be applied that the Objector must show:

- (a) that the new gTLD <.network> is likely to result in string confusion;
- (b) that the confusion must arise in the mind of the average, reasonable internet user ; that
- (c) string confusion will be said to have arisen where a string so nearly resembles another that it is likely to deceive or cause confusion; bearing in mind that mere association, in the sense that the string brings another string to mind, is insufficient to find a likelihood of confusion.

19. Taking each of these requirements in turn and applying the standards specified in Section 3.5.1 of Module 3:

- (a) In the opinion of the Expert, the proposed new gTLD is not likely to result in string confusion. It is of course possible that some internet user will be confused by the two strings. That does not mean that it is likely and the Expert is of the opinion that it is not likely. Indeed, in the present case, the degree of possibility of confusion arising could well be described as “remote” and far from likely. It must also be borne in mind that the Guidebook admonishes against finding that there is a mere possibility and then drawing from that finding the conclusion that a possibility makes something likely or probable, as it clearly does not. The applied for gTLD <.network> will not give rise to string confusion with the <.net> TLD. That is so because the reader and the user will appreciate the fact that the two words that constitute the strings, “network” and “net”, are separate words, with distinct meanings, with each of them being capable of being given their own function and that there is no reason why they should be understood as regarded as being used, in the internet context, in anything other than those distinct meanings.
- (b) Moreover, it must be remembered that when the standard provides that the Objection can succeed only when the new TLD is “likely to result in string confusion”, it means “string confusion” as defined. Section 3.5.1 defines string confusion as such a state of resemblance between the two strings “that it is likely to deceive or cause confusion.” The opinion of the Expert is that the resemblance between the two strings in question and which exists only in the presence of the first three letters of the word “network” will not deceive or cause confusion among users. That is so because internet users will appreciate that the words are different, that they have their own meanings, that they are being used as separate TLDs which by necessity must be different and they will also draw on their own experiences of using the internet. That experience tells them that differences in spelling, let alone differences in spelling that constitute different words, have immense consequences when it comes to website addresses, domain names, email addresses, passwords and elsewhere and that a change of one letter, a change in punctuation or even in the case in which a word is typed will mean the difference between using the internet successfully or not. Because of that experience and because of the times when they have been frustrated in the use of the internet,



users are now permanently on the look out for such differences and will be particularly astute to take notice of them, especially when the differences in spelling go beyond the mere addition or subtraction of a single letter or two and go into the realm of entirely different words, as is the case here. There is therefore an air of unreality in the argument that internet users are so beguiled by a current TLD that will think a proposed new TLD with resemblances of the sort in the present case to the existing TLD, is the same as or associated with it or that they will be deceived or confused between the one and the other.

- (c) The Expert also holds that it is unlikely that string confusion will result in the present case in the mind of the average, reasonable internet user. Indeed, the average, reasonable internet user is less likely to be confused in the way claimed by the Objector than other candidates, because he or she is astute to the basic workings of the internet and knows in particular that even small spelling differences in words often have great significance; they also know that there are separate words with different meanings in use on the internet and that “net” and “network” are two such separate words. Thus the objection does not give average, reasonable internet users the credit that they deserve, as it should not be assumed that if they see the two words “net” and “network”, they will not appreciate immediately that they are separate words with their own meanings and uses. It is also one of the characteristics of average, reasonable internet users that they are now, probably more than ever, on their guard and likely to be curious about similarities in spelling and what they signify. The average, reasonable internet user knows, for instance, that there is a difference between <.com> and <.co> and between <.com> and <.com.au>. Many internet users who have registered a domain name have had to make a choice about the top level domain in which they register their domain name and are thus aware of differences between the various top level domains and what they signify and are unlikely to be confused between two domains that have a slight resemblance in the spelling. Moreover, the average, reasonable internet user is by definition familiar with the internet; the suggestion that internet users cannot tell one TLD from another, even if the spelling is somewhat similar, sells their knowledge short and is unjustified. Accordingly, no confusion will arise in the present case in the mind of the average, reasonable internet user between <.network> and <.net>.
- (d) The string <.network> does not so nearly resemble another that it is likely to deceive or cause confusion. As has been noted above, the resemblance between the two strings is slight, consisting as it does of three letters; each string is a separate word and readily recognized as such; each word has a meaning sufficiently different from the other word to give it a unique character; and even when the “net” is separated from “network”, a separate word, namely “work”, remains. All of these factors support the notion that average, reasonable internet users will appreciate the difference between the two TLDs and accordingly, they will not be deceived or confused. The two words are so distinct that the average, reasonable internet user will not be deceived into believing that they are the same. Nor, for the same reason, would the average, reasonable internet user be confused



between the two words. Again, that eventuality would be so rare that it could not be described as likely or probable.

- (e) For reasons of completeness, the Panel also finds on the balance of probabilities and in the present context, that the string <.network> does not bring the string <.net> to mind, but that if it did, it is by virtue of the express words of the standard insufficient to find a likelihood of confusion.

20. The Panel will now deal with a number of other arguments that have been raised during the proceeding, as the parties' submissions have been very detailed and also to provide an opportunity to elaborate, where appropriate, on the arguments already advanced. They are as follows.

1. The Objector has provided a quantity of valuable information concerning the identity of the <.net> domain, its history, the derivation of <.net>, the valuable service provided by Verisign as the registry for the <.net> TLD virtually from its beginning, its high standard of performance and its establishment of many of the standards and best practices for registry operations, with the result that internet users know of the <.net> TLD and its unique identity and benefits and that it is one of the strongest labels in internet usage. That information has been valuable in obtaining an understanding of the <.net> TLD and the success achieved by the Objector and it should be accepted as such.

However, it is at the point where the Objector draws its conclusion from this valuable information that the Expert parts company with the Objector's submission. The Objector submits that because of the success of <.net>, the proposed use of "network" as the name of a new TLD "would create confusion among Internet users". Presumably this is said to be so because the <.net> TLD has become so strong that another TLD with any similarity, such as <.network> is said to be because of its first three letters, must induce internet users to conclude that it must actually be <.net> or generate confusion as to whether it is or not. However, that conclusion does not follow. Reaching the conclusion contended for by the Objector ignores the far more dominant considerations that both "net" and "network" are separate words, with separate meanings that can and do stand by themselves and it overlooks the fact that internet users are sufficiently sophisticated and selective that they understand that differences between words and their spelling are significant; indeed, using the criterion of "the mind of the average, reasonable internet user" which ICANN mandates us to do, the conclusion must be that the mind of the average, reasonable internet user is astute enough to discriminate between two words such as "net" and "network" with different meanings.

Indeed, it is possible that the evidence of the Objector militates against the conclusion it seeks to draw; in other words, the <.net> brand of TLD may now be so strong and so embedded in the minds of internet users after almost 30 years of efficient service delivery by the Objector, that any difference, no matter how slight, will be seen as something new and different and, in the context of the new regime of top level domains, the sign of a new and different TLD.

Moreover, ICANN's promotion of the new regime of TLDs has been so prominent and effective that average, reasonable internet users must by now be very aware that there are to be new TLDs and are probably on the lookout for them and the differences in spelling that may accompany them. They are therefore less likely to be confused than might be thought.

2. The Objector has submitted that the standards set out in the Guidebook on when string confusion exists and the meaning of "similar", reflect standards governing likelihood of confusion under US trademark law and trademark law generally; that the ICANN standards also look to the probability of confusion; and that confusing similarity must consider more than visual similarity and may be based on any type of similarity.

The Objector's submission in this regard is that the test of similarity issues in this proceeding is "essentially the same test for similarity applied under US trademark law". The Expert's response to this submission is that an examination of trademark law is no doubt useful and informative, but it must always be remembered that ICANN has gone out of its way to articulate its own principles and the tests that it wants to see applied in this new venture and both parties are bound by those principles and tests in this proceeding. When the ICANN principles are clear, as they are, it seems to the Expert that they should be followed and be treated as ICANN no doubt intended that they should be treated, namely as the principle guidelines to be used in resolving issues such as the one presently under consideration.

In any event, the ICANN principles themselves make it clear that string confusion is intended to be based on "any type of similarity (including visual, aural, or similarity of meaning)..." and that an objector may rely on any or all of such criteria. The Objector in the present case, relies on the following:

(a) **visual similarity.** The Objector argues that "it is clear that there is a visual similarity between .net and .network (*infra*).” The Objector's submission seeks to expand on that submission by pointing out that the alleged visual similarity is "because .network and .net have the same first three letters." To that extent, the two words have some, if a partial resemblance, and this seems to be stating the obvious, but it is a minor resemblance confined as it is to three letters and overlooks the far more significant fact that the dominant feature of the word "network" is that it is a recognized word with a clearly



understood and frequently used meaning. Moreover, as has already been noted, after “removing” the first three letters, the word “work” remains and it also is a separate and complete word, further militating against confusion. In any event, the resemblance cannot possibly satisfy the test very clearly set out in Module 1, Section 1.1.2.10 and Module 2, Section 2.2.1.1 of the Guidebook that “similar” in the present context 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.” In the opinion of the Expert, there is no such probability, for the reason that the common letters are confined to three letters and the whole of the word “network” is widely understood to be a word in its own right with a broad, active and current use. Even a casual reading of the newspapers reveals daily and frequent uses of the word in reference to networks of friends and business associates, radio or television networks and movies such as “Network”. Moreover, any conference goer knows that one of the blandishments held out for attending a conference is that it provides great opportunity to “network”, using the word as a verb. There is therefore no similarity of the sort that the Guidebook clearly specifies.

(b) **phonetic similarity.** The Expert is uncertain as to whether the Objector is arguing that the two words are phonetically similar, but if it is, there is no substance to that submission. The two words are pronounced as they are, namely as different words, the one consisting of one syllable and the other of two syllables.

(c) **similarity of meaning.** The Objector argues that “... <.net> and <.network> have the same meaning.” That is not so. They have different meanings. The dictionary and our own experience and knowledge tells us that “net” means an item of equipment, as in “tennis net” and other objects coming within that genre, in addition to the wide use of the word as a verb as in “to net a fish”. In modern times, it has also taken on, when the context justifies it, the meaning of the internet in the sense that the internet user is said to be “on the net” or “using the net”. “Network”, as a noun, means an array of connecting points as in a television network or a network of contacts or transport facilities and, as the verb “to network”, it means the type of function engaged in by people seeking contact with each other.

The Objector’s main submission under this heading and probably its principle submission, is that “Indeed, “.net” is recognized as an abbreviation of “network.”” The word “net” when used as a TLD may well have been derived from “network”, but it is simply not true that today the principal or dominant meaning of the word is as an abbreviation of “network”. One of its uses is clearly associated with the internet and some people would regard “net” as an abbreviation of “internet”, especially when it is used in the expression “the net.” Others, probably most people, would simply give the word its dictionary or common meaning and others would regard “net” as one of the more prestigious top level domains as in the context of <.net>. But at best, any similarity between the meaning of the two words “net” and

“network” is peripheral and limited especially when they also have their own separate meanings.

Again, it must be remembered that for present purposes we have to conceive of the two words as strings to be used as Top Level Domains, and the rule as set out in the Guidebook is that the only strings to be regarded as similar are “strings so similar that they create a probability of user confusion if more than one of the strings is delegated into the root zone.” The common use of three letters in each string is well short of the “probability of user confusion” that the ICANN principles require.

3. On the question of confusion, the Objector has raised a number of issues and made submissions on them together with references to decided cases. The Panel has given consideration to all of those matters. In it is not necessary to deal with them in detail here except for one matter which seems to be pivotal to this inquiry and in particular to the way that ICANN has directed the inquiry to be made. The Objector submits that the likely “purchaser”, meaning presumably the likely user of the internet, will consist of “casual Internet users, likely to exercise a low degree of care when exposed to or interacting with TLDs, increasing the likelihood of confusion. For example, users will likely be exposed to new TLDs through television, Internet, and radio advertisements. The low degree of care associated with such casual interactions, combined with high visual and aural similarity, will increase the likelihood of confusion between strings such as .net and .network.”

No evidence or reason was given by the Objector as to why potential users of the new TLDs will be “casual” users and the Panel does not accept that categorization; apart from anything else, the vast expansion of the internet to encompass a high proportion of business and social communication shows that the Internet and those interested in new TLDs are just as likely to be frequent and regular internet users rather than casual ones.

Moreover, it seems to give potential users of the internet less credit than is justified or accurate and a proposition unlikely to be supported by the facts, to say that users are “likely to exercise a low degree of care.” For reasons given several times, potential users are likely to exercise a reasonable and probably a high degree of care in making their choices concerning the internet, including any choice they make about a TLD for their domain name.

The Objector’s conclusion is that a low degree of care, combined with “high visual and aural similarity will increase the likelihood of confusion between strings such as .net and .network.” In the opinion of the Panel a more accurate assessment of the present situation would be that users will exercise a reasonable degree of care in distinguishing between all TLDs.

It should also be noted that the ICANN requirements mandate that it is not “casual internet users” who are the touchstone of whether there is confusion or



not, but “the average, reasonable Internet user.” Whether casual internet users have “a low degree of care” when exposed to TLDs as argued, may be a matter of opinion, but it is not the opinion of the Expert, whose opinion is that in modern times, the average, reasonable internet user shows a high degree of care in discriminating between available choices on the internet and would have no difficulty at all in discriminating between any two TLDs and in particular between <.net> and <.network>, where they know that new TLDs are, subject to passing ICANN’s procedures, on the way. Secondly, there is not a “high visual and aural similarity” in the present case, but, if anything a low similarity.

4. Expert witnesses and the initial evaluation. The Objector also relies on evidence submitted to the Panel from Professor Stygall, and Mr. Walsh. Professor Stygall gave evidence on the linguistic similarities between <.network> and <.net>, that they are confusingly similar and that they would have that effect on “internet users”. Mr. Walsh gave evidence of his extensive experience in the law, including various positions with the United States Patent and Trademark Office (“USPTO”) and including Administrative Trademark Judge at the Trademark Trial and Appeal Board of USPTO. Mr. Walsh gave evidence to the effect that the two TLDs at issue are confusingly similar and in support of the Objector’s contentions. The Expert has considered all of that evidence and taken it into account in its deliberations. The Objector also relied on a Declaration from Mr. Waldron, the Director, Product Management, of Verisign, relating to Verisign’s history and considerable achievements as the operator of the <.com> and <.net> TLDs and related matters. The Expert has also considered that evidence and taken it into account in its deliberations. The Objector also made submissions with respect to the initial evaluation by ICANN. The expert evidence is, of course valuable and it put forward the witnesses’ perspective on the areas of inquiry in this case. It does not, however, relieve the Panel from the eventual obligation of assessing for itself the probability of confusion between the two TLDs, assessed as the ICANN requirements make it plain that the Panel must do, namely to make its own decision on whether string confusion is likely to arise in the mind of the average, reasonable Internet user. That is ultimately and essentially a task for the Panel. Nor do the matters deposed to by Mr. Waldron or the initial evaluation of ICANN relieve the Panel from its obligation to make that determination in keeping with the ICANN specifications.

21. For all of the foregoing reasons, the Objector has not discharged its burden in this proceeding.

### **Determination**

The Determination of the Expert is that the applied for generic Top Level Domain <.network> is not confusingly similar to the existing generic Top Level Domain <.net>.

Therefore, the Applicant has prevailed and the Objection is dismissed

Dated: September 5, 2013



The Honourable Neil Anthony Brown QC

Sole Expert Panelist