

International Centre for Dispute Resolution

New gTLD String Confusion Panel

Re: 50 504 00257 13

Verisign Switzerland SA, OBJECTOR

and

T V Sundram Iyengar & Sons Limited, APPLICANT

String: <.TVS.>

EXPERT DETERMINATION

I The Parties

The Objector in this proceeding is *Verisign Switzerland SA*, a corporation incorporated in Switzerland, with its principal place of business located at 20 Quai Gustave Ador, 1207 Geneva, Switzerland.

The Applicant in this proceeding is *T V SUNDRA MIYENGAR & SONS LIMITED*, a corporation incorporated under the Companies Act of 1956. Applicant's principal place of business address is TVS Building, 7 B West Veli Street, Madurai Tamil Nadu 625001, IN.

II The New gTLD String Objected To is

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

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 ".tv."

IV Prevailing Party:

The Applicant has prevailed and the Objection is dismissed.

V The New gTLD String Confusion Process

Article 1(b) of the *Procedures* states that "The new gTLD program includes a dispute resolution Procedures, 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 Procedures."

As expressed in the Guidebook, and the *Procedures*, 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 *Procedures* mandates that "String Confusion Objections shall be administered by the ICDR."

VI Procedural History of this Case

In accordance with the *Procedures*, Applicant T V Sundram Iyengar & Sons Limited filed its Application for the new gTLD ".TVS"; Objector Verisign Switzerland SA timely filed its Objection based on alleged confusion with its gTLD ".tv". Applicant then timely filed its Response and the dispute based on the category "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 gTLDs in question in accordance with the *Procedures* and the ICDR's *Supplementary Procedures for String Confusion Objections*.¹

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

Under Article 8 of the *Procedures*, 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 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

In its Objection and accompanying affidavits, Objector Verisign claims standing in this proceeding as the existing TLD operator for the .tv TLD. (*Decl. of Joseph Waldron on Behalf of Verisign Switzerland SA ["Waldron Decl."]*) and asserts its objection to Applicant's application on the basis that the latter's proposed gTLD, .TVS string is confusingly similar to the .tv TLD.

¹See *Procedures*, Articles 3 (a), 4 (b) (i), 8, 11 and 13.

B. Legal Standard

1. String Confusion:

According to the *Procedures* "[string confusion exists where a string so nearly resembles another that it is *likely* to deceive or cause confusion." *gTLD Applicant Guidebook* (v. 2012-06-04), Module 3, Section 3.5.1.) As noted by Objector, "[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 3.5.1.² *The Applicant 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 *Procedures* provides that "[t]he Objector bears the burden of proving that its Objection should be sustained in accordance with the applicable standards."³ Accordingly, Objector has the burden of establishing by a preponderance of the evidence that the gTLD applied for by Applicant so nearly resembles Objectors' TLD that it is **likely** to deceive or cause confusion." *gTLD Applicant 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

² As noted further by Objector:

The standards articulated in the ICANN *Dispute Resolution Procedures* reflect and parallel long-established standards governing likelihood of confusion that have developed under U.S. trademark law and trademark law more broadly. See, e.g., Decl. of James T. Walsh on Behalf of Verisign Switzerland SA ("Walsh Deck") Annex 2 1 14. 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; Walsh Decl. 1 14. Similarly, the ICANN standards require a probability of confusion, which reflects trademark law standards. Walsh Decl. f 14. The well-established trademark law tests for determining similarity and likelihood of confusion are persuasive in assessing string confusion.

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.

³ The standards referred to are set forth in Legal Standard above.

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 Expert.)

VIII Factual Background

Objector is the existing TLD operator of .tv a country code top-level domain, which was assigned to the country of Tuvalu, a South Pacific island nation, in 1991. Pursuant to a contract with Tuvalu, Objector, or its affiliated entities have continuously served as the registry operator for the .tv TLD since 1999. (*See* Waldron Decl. f 3.)

Applicant's TVS Brand was created over 100 years ago, is a well known brand, headquartered in India with global revenues of US\$7 Billion in Financial Year 2012-13. Applicant was founded Shri. T V Sundaram Iyengar in 1911 and operates primarily in the automotive field.

IX Parties' Contentions

A. Objector's Contentions Regarding Confusing Similarity

Objector contends that its Objection should be upheld based on (i) similarity (visual and phonetic) between Applicant's proposed gTLD and Objector's TLD, (ii) similarity of meaning (based on context and overall impressions), and (iii) confusion and harm to both users and the Objector based on the similarity between the two TLD strings at issue. Objector claims it will suffer economic harm as well as damage to its brand if users have negative experiences if they erroneously believe the applied-for gTLD is associated with its TLD .tv.

B. Applicant's Response

In its Response, Applicant TVS asserts that there is ample evidence that *no confusion* would exist between .tv and .TVS, stating that "[w]hile TVS does not dispute that there is but one letter difference between TVS and TV, the appearance, sound, connotation and commercial impression are substantially dissimilar." (*See* TVS String Confusion Response, p. 2.)

In arguing its position, Applicant also agrees with Objector and its expert that the multi-factor test set forth in *In re E. I. DuPont DeNemours & Co*, cited in footnote 3 above, is the appropriate framework to analyze whether there is the potential for confusion between the top-level domains (TLDs) TV and TVS in the mind of the average reasonable Internet user.

X Findings

After having carefully reviewed and considered the facts, law, applicable rules, opinions and allegations set forth in the briefs, affidavits and other documents submitted by the parties appearing in this proceeding, I 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 .TVS would be confusingly similar to its TLD .tv. 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

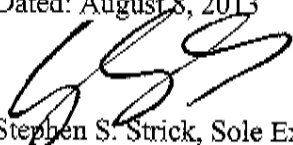
While Objector's expert James T. Walsh found "important similarities between .tvs and .tv in appearance, sound and meaning, finding "significant" that both begin with the letters tv, he notes, and the parties agree that under the *Procedures*, in order for the Objector to prevail, Objector must prove that the co-existence of the two TLDs in question would *probably* result in user confusion.⁴ Given the analysis of the thirteen factors cited by Applicant derived from the DuPont case cited above, I find that Objector has failed to meet its burden of proof regarding the *probability* of such confusion. I note that while the co-existence of the two TLDs that are the subject of this proceeding *may* result in confusion by users, Objector has failed to meet its burden of proof to establish the *likelihood or probability* that users will be confused.

In considering the parties' arguments, I was persuaded, in part, by Applicant's arguments relating to the commercial impression of the TVS TLD, including the proof offered by Applicant as to the longevity of the TVS brand, the limited nature of the gTLD's intended use, the dissimilarity of the goods or services associated respectively with the two strings, i.e. TVS's association with automobile products, the fact that TVS's brand is associated with capital letters (whereas Objector's .tv is in lower case), the fact that TVS is well known and associated with its company's brands, the lengthy market interface and long historical co-existence of TVS and tv without evidence of confusion in the marketplace.

XII Determination

The Applicant has prevailed and the Objection is dismissed.

Dated: August 8, 2013


Stephen S. Strick, Sole Expert Panelist

⁴ I also carefully considered the Affidavit of Objector's Expert, linguist Gail Stygall.