

INTERNATIONAL CENTRE FOR DISPUTE RESOLUTION
New gTLD String Confusion Panel

Re: 50 504 T00255 13

VERISIGN SWITZERLAND SA, Objector

and

DISH DBS CORPORATION, Applicant

String ≤DTV≥

EXPERT DETERMINATION

I The Parties

- (a) The Objector is VeriSign Switzerland SA, a corporation incorporated in Switzerland, with its principal place of business located at 20 Quai Gustave Ador, 1207 Geneva, Switzerland, and is represented by:

Thomas Indelicato
Verisign, Inc.
12061 Bluemont Way
Reston, VA 20190

- (b) The Applicant is Dish DBS Corporation, a Colorado corporation, with its principal place of business at 9601 S Meridian Boulevard, Eaglewood, Colorado 80112, and is represented by:

Deborah M Lodge
Patton Bogs LLP
2550 M Street NW
Washington DC 20037

II The New gTLD string objected to:

The new gTLD string applied for and objected to is ≤DTV≥

III Prevailing Party

The Applicant has prevailed and the objection is dismissed.

IV 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 object 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(3)(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".

V Procedural History of this Case

- (a) This String Confusion Objection was submitted to the International Centre for Dispute Resolution ("ICDR") for determination in accordance with the New gTLD Dispute Resolution Procedure ("Procedure"), provided as an Attachment to Module 3 of the gTLD Applicant Guidebook ("Applicant Guidebook") approved by

the Internet Corporation for Assigned Names and Numbers ("ICANN") on June 20, 2011, and as updated on June 04, 2012, which incorporates by reference the ICDR's International Rules for proceedings, and the ICDR Supplementary Procedures for String Confusion Objections ("ICDR Supplementary Procedures").

- (b) The Objection was submitted to the ICDR on March 18, 2013. The Objection was administratively reviewed by the ICDR and found to have complied with Articles 5 to 8 of the Procedures.
- (c) Following upon the receipt of the Objection, the ICDR satisfied itself that the Response had been received timeously and that, pursuant to an administrative review, complied with Article 11 of the Procedures.
- (d) The ICDR thereafter, and by letter dated July 11, 2013, advised the representatives of the parties that Archibald Findlay SC had been appointed as Expert in terms of Article 13 of the Procedure.

VI Basis for Objector's Standing to Object Based on String Confusion

- (a) The Objector is the existing TLD operator of .tv and submits this objection on the basis that the .dtv string is confusingly similar to the .tv TLD. No challenge has been brought by the Applicant to the Objector's standing.
- (b) As the Objector is an existing TLD operator, the Panel is satisfied that it has the standing to file a string objection (Module 3 of the Applicant Guidebook - paragraphs 3/2/2 and 3/2/2/1).

VII Parties' Contentions

A Objector:

1 The .tv TLD has a Unique, Strong & Well-Established Identity

The Objector contends that the .tv top level domain (TLD) is the established home for video on the web, being the preferred domain name for rich media content websites, by reason of the fact that "TV" is the established abbreviation of "television" and that this is fairly popular and valuable by reason thereof.

It is pointed out by the Objector that .tv is a country code top level domain (cc TLD), which was assigned to the country of Tuvalu, a South Pacific island nation, in 1991, and that the Objector is the existing TLD operator thereof pursuant to a contract with that country since 1999.

The Objector points out that in this capacity .tv has been marked as an Internet destination for websites with playable content, in connection with television, video, entertainment and other media services. It is served by approximately 210 registrars and has had the benefit of the Objector's experience for more than twenty years and its know-how in operating a secure and stable registry. It is further contended that no other registry operator has built an infrastructure comparable to that developed by the Objector, nor does any other TLD have the size or provide similar services. This, it is said, is responsible for the unique attributes of the .tv TLD, as well as the superior performance when measured against records of other TLDs.

Thus the Objector submits that Internet users from various walks of life know of the .tv TLD and its unique identity and benefits.

2 Legal Background on the Meaning of Similarity & Confusion

(a) Similarity

The Objector refers to the principle set out in the Applicant Guidebook, namely:

- (i) that string confusion "exists where a string so nearly resembles another that it is likely to deceive or cause confusion";
- (ii) that "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";
- (iii) for there to be a likelihood of confusion "it must be probable, not merely possible, that confusion will arise in the mind of the average, reasonable Internet user".

The Objector then contends that the above articulated standards reflect parallel long-established standards governing the likelihood of confusion that have developed under United States trademark law, as well as trademark law viewed more broadly, and that the well-established trademark law tests for determining

similarity and the probability of confusion are now persuasive in assessing string confusion.

It is further contended that, as under trademark law, the principles in the Applicant Guidebook make it clear that the likelihood of confusing similarity requires consideration of more than mere visual similarity, albeit that this is an important consideration, in that confusion based on any type of similarity, including visual, aural or similarity of meaning, may be relied upon by an objector.

(iv) Visual Similarity

It is contended that this is a matter of degree and that a slight spelling variation would not prevent confusion, and that in the present instance this supports the proposition that there is visual similarity between .tv and .dtv.

(v) Phonetic Similarity

In this regard the focus must be upon how the word is pronounced by the public rather than what constitutes a "correct" pronunciation, as a trademark owner cannot control how purchasers would vocalise its mark. In this regard it would follow that there is a likelihood of confusion. Because of the different ways in which the names of TLDs and second level domain names can be pronounced, particularly on the radio and in speech, there is phonetic similarity between .tv and .dtv.

(vi) Similarity of Meaning

It is contended that the mental impact of meaning must be considered, as the use of a designation may convey the same idea, mental reaction or meaning, which can cause confusion.

(vii) Similarity as Evaluated Based on Context & Overall Impressions

In determining whether two marks are confusingly similar, the overall impression created by the context in which they are found must be appraised, with a consideration of the totality of factors that could cause confusion among prospective purchasers. Where initials are used or the number of letters is the same, and there is a significant overlap in letters, this is contended to be generally sufficient to sustain a claim of similarity.

3 Confusion

The Objector refers to the United States trademark law and what are considered the foundational factors to be considered in determining the presence or absence or a likelihood of confusion, and selects the following as being applicable:-

(a) Strength of the Mark/Word

It is contended that in assessing likelihood of confusion, one factor that should be considered is the commercial strength or market place recognition of the existing TLD .tv, particularly because of it being the established variation of the word "television".

(b) Degree of Care Exercised by User

It is contended that the relevant class of users would consist of casual Internet users who are likely to exercise a low degree of care when exposed to or interacting with TLDs and, when this is combined with high visual and aural similarity, the likelihood of confusion will increase.

(c) Marketing Channels

The relevance of this aspect is said to be that confusion is more likely when goods are marketed and used by the same or similar users and that, even if the parties are currently engaged in different channels of trade, marketing methods can and do change as businesses evolve or new business plans may be put into place.

The Applicant expresses a current intention to make the applied-for .dtv TLD restricted and available only to the Applicant and its affiliated entities delivering satellite and other media programmes to customers. The Objector points out that this constitutes an intention to embark upon a marketing campaign which will overlap with that of the Objector, with the danger that the overlapping may increase as the market develops. This, in turn, would significantly increase the likelihood of confusion.

4 Evidence of Likelihood of Confusion - Linguistic Experts

The Objector draws attention to United States trademark law that recognises the use of linguistic experts before courts in order to provide helpful guidance as to how people use a certain term and the "roots" of the terms.

In this regard the Objector relies upon an affidavit by Gail Stygall, a professor of the English language and an adjunct professor of linguistics at the University of Washington, Seattle, whose opinion is that the linguistic similarities of the two strings establish that confusion amongst Internet users will occur if they encounter domain names with these strings. The Objector also relies upon an affidavit by James T Walsh, an active member of the Bar of the District of Columbia, a Trademark Examining Attorney and Lead Attorney dealing with examination and registration of trademarks, the Principal Editor of the trademark Manual of Examination and thereafter Counsel in private practice with regard to trademark law. He also served as a Judge at the Trademark Trial and Appeal Board. He is of the view that the striking similarities in appearance, sound and meaning lead to a strong probability of confusion.

5 Confusing Similarity Between .dtv & .tv

The Objector contends that the applied for TLD .dtv so nearly resembles the well-established TLD .tv in appearance, sound and meaning, that it is likely to deceive or cause confusion in the mind of the average, reasonable Internet user:

- (a) as the strings are virtually similar because they vary only by one letter;
- (b) they are phonetically similar because they have the last two letters resulting in strings that rhyme;
- (c) there is a similarity in meaning because both stand out as the well-known abbreviation for television.

The Objector draws attention to the fact that the initial evaluation carried out by ICANN, which involved comparing existing TLDs with every applied for gTLD string to determine whether the new string is confusingly similar, was simply a visual similarity check and that the closer to 100 in the result means that it is closer visually under the algorithmic scoring process which, in this instance, was 63%.

The fact that the strings vary by one letter only and one incorporates the other is said to be an important similarity in appearance as well as sound, and that the letters common to both have a clear shared meaning to the average Internet user, which is not displaced by the letter "d". The risk is also said to be likely to increase where the relevant class of users, being casual Internet users, will probably exercise a low degree of care when exposed to or interacting with the TLDs.

The Objector relies upon the opinions of James T Walsh, as well as those of Professor Stygall in further support of these contentions. To these considerations must be added the fact of the commercial strength and popularity of the already established .tv which the Objector points out is likely to further establish the likelihood of confusion when combined with the potential overlapping marketing channels which could also alter in the future if the proposed .tv TLD were to become an open TLD.

The Objector concludes this leg of the argument with the contention that every relevant factor points to a likelihood of confusion sufficient to establish the necessary substantial probability thereof.

7 Harm to Users & the Objector from Confusion

The Objector contends that string confusion in these circumstances will harm not only the Internet users but also the Objector, particularly in that the user will not receive what he or she wanted or expected in seeking to sign up for a .com domain but will be misled by the confusion, or the Internet user will suffer confusion by looking for an address that may not exist. The Objector will further suffer economic harm by the diversion away from its registry service of users, as well as negative customer experiences resulting from such confusion. Finally, that confusion may lead to the mistaken belief on the part of the public that there is an affiliation with the sites or an endorsement of the sites, particularly if it caused the public to believe that the Applicant's sites, were they to contain offensive subject matter, were sites of the Objector, thus harming the latter's goodwill.

B Applicant

- 1 The Applicant intends to operate the .dtv TLD as a closed domain restricted in use with the "d" understood as referring to "DISH". It is said that that understanding will be reinforced by the Applicant's advertising and promotion. The Applicant, through its corporate affiliate, DISH NETWORK L.L.C., provides over 14 000 000 satellite tv customers with high quality programming and technology and, as it is a leader in this field as well as that of satellite tv and communications, it envisages using the .tv TLD as a means of promoting its branded DISH services and enhancing consumer loyalty. It points out that its customers are serviced through a network of affiliates.
- 2 It contends that there will be no likelihood of confusion between .tv and the .dtv TLD as the designations are different, the uses will be different and the registrants will be different.

3 "Probable Confusion" is the applicable standard. Whilst the Applicant notes the US trademark law in relation to the applicable standard for "likelihood of confusion" is one applied by those courts with regard to the various factors referred to by the Objector and supported by case law, the Applicant contends that, whilst they are relevant to assessing possible confusion, "probable confusion" is a more stringent standard even than that of "likelihood of confusion".

4 Similarity

(a) Visual Similarity

The Applicant contends that the variation by one letter is important because customers are used to differentiating between various domains, even those TLDs that have some letters in common, as in this instance. The Applicant refers particularly to the fact that:

- (i) existing TLD ".co" uses some of the same letters as ".com";
- (ii) numerous top-level country code domains also have common letters, examples being .ch (Switzerland), .cn (China) and .cc (Cocos Islands); there are also shared letters with .tv, namely those of .tw (Taiwan).

The Applicant relies further on the principle that confusion between marks requires that they be compared in their entirety and must not be predicated on dissection of a mark and comparison of only portions thereof.

It is also important to have regard to the well-accepted principle that consumers tend to focus on the first part of any trademark or service mark.

Moreover, consumers are accustomed to slight variations in acronyms used for television channels in the United States, such as NBC, ABC and CBS. Consumers are readily able to distinguish between them.

(b) Aural Similarity

- (i) The pronunciation of .dtv is not phonetically similar to .tv and the approach of the Objector that they are phonetically similar because they have the same last two letters and sound does not take into account the fact that consumers and Internet users are accustomed to similarities in what it describes as TEE-VEE applications.

- (ii) In particular the Applicant relies upon the views of Professor Thomas J Maronick expressed in his declaration that the pronunciations are not phonetically similar.
- (iii) Professor Maronick is a qualified lawyer, having been admitted to the Bar of the State of Maryland. He is the Professor of Marketing at Towson University College of Business & Economics, the Associate Professor of Marketing at the University of Baltimore School of Business and an instructor of business administration at the Virginia Commonwealth University, Richmond. In addition, he is a former director of the Office of Impact Evaluation of the Federal Trade Commission and, in particular, has been accepted as an expert witness in litigation in respect of trademarks, trade dress and consumer confusion, as well as market surveys.

(c) Similarity of Meaning

- (i) The Applicant contends that both have a similar meaning as applied to the word "television", whereas this does not carry weight inasmuch as the common generic abbreviation for "television" is well-recognised.
- (ii) Relying on Professor Maronick, the Applicant also contends that, whilst consumers are likely to understand that the "tv" TLD refers somehow to television, adding the "d" causes a totally separate impression from the two letters "tv". On the other hand, the designation "dtv" has no inherent meaning.
- (iii) There is no overall similarity between "dtv" and "tv".

(d) Similarity Having Regard to the Overall

- (i) The Applicant contends that the words or marks should be considered as they are encountered in the market place, taking into account normal circumstances surrounding how they are treated.
- (ii) As the Applicant intends that this is to be used solely for internal purposes, to maintain brand loyalty and consumer confidence, there will be no similarity in context, nor will the user or customer for .dtv be the same as potential customers for the .tv domain.

(e) The TLD strings are not similar when measured by ICANN string similarity assessment tool.

- (i) The similarity level in respect of .dtv and .tv is scored at 63% between the two. A comparison of this with other instances supports the notion that there is insufficient to create user confusion between the two.
- (ii) The Applicant contends that the yardstick used in this assessment corresponds with that on reference to Module 4 of the Guidebook, Subsection 4.1, and is therefore effectively the same as that for string confusion objections in this proceeding, having regard to the Guidebook's reference in Subsection 3.5.1 to "probable confusion in the mind of the average, reasonable Internet user".
- (iii) The Applicant also furnishes examples from the list of similarity scores comparing various applied-for strings with common characters which are below 90% but above the 63% scored in respect of .dtv and .itv.

5 Confusion

- (a) The Applicant challenges the approach of the Objector and contends that, bearing in mind the category in which the mark's strength traditionally falls, this will determine whether it is inherently distinctive and entitled to protection and, in particular, that generic terms are not entitled to protection, nor are descriptive terms, unless they have acquired secondary meaning.
- (b) The Applicant contends that "tv and "television" are fundamental generic terms and they belong on the weakest level, cannot be imbued with secondary meaning, or that such secondary meaning can be taken from common parlance or use.
- (c) The Applicant further contends that the generic designation .tv is exceedingly weak and entitled to no protection under the standard and that in contracting to operate this with the Island of Tuvalu it must have been aware that "tv" was a generic designation for "television" since it promotes that domain for use with video and television content.

(d) Degree of Care Likely to be Exercised by User

- (i) The Applicant contends that when accessing either .tv or .dtv domains users are likely to exercise a higher degree of care.
- (ii) By limiting .dtv to DISH affiliates and others within their network or group, there will be an increase in consumer confidence and trust and it will be used to reduce consumer deception or mistake.

(e) Marketing Channels

The Applicant again stresses the fact that .dtv will be a restricted TDL and only open to authorised DISH affiliates as against the .tv TDL which is open to the public, thus not resulting in any overlap in marketing channels.

(f) Evidence of Actual Confusion

The Applicant relies upon the views of Professor Thomas Maronick that there will be no confusion likely between the two and that further support is to be derived from an Internet survey which he conducted and, of the 225 persons who responded, not a single one answered that .dtv was associated with or sponsored by .tv, nor was .tv mentioned by any respondent.

(g) Applicant's Intent in Selecting the Mark

The Applicant again repeats its assertion that its intent is that .dtv will be a restricted TLD for its own use, and that it has no intention of infringing or causing confusion with .tv, its intention being in good faith. It points out that it is a renowned distributor of television programming and has been involved in bringing its products to consumers over thirty years. It is, moreover, a publicly traded company quoted on the NASDAQ exchange and employing over 25 000 people in the U S.

(h) No harm from confusion will result to users or to the Objector

As there is no probability of any confusion, there will consequently, so contends the Applicant, be any harm caused to the Objector, and that suggestions to the contrary by the Objector are not well-founded. Furthermore the restriction of the .dtv TLD would prevent the general public and others not associated with the Applicant from registering domain names. On the contrary the operation of .dtv as a closed domain will be to the benefit of the public interest in all the circumstances.

VIII Discussion & Findings

A Substantive Aspect of the String

Module 3 to the Applicant's Guidebook (version 2012-06-04) sets out the following in paragraphs 3.5 and 3.5.1:-

"3.5 Dispute Resolution Principles (Standards)

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 principles outlined below are subject to evolution based on ongoing consultation with DRSPs, legal experts, and the public.

"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."

These provisions must also be read in conjunction with that portion of Module 2 to the Applicant's Guidebook (version 2012-06-04) which states the following relative to an application that passes the string similarity review:-

"2.2.1.1.3 Outcomes of the String Similarity Review

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."

B Appropriate General Principles (Standards)

Having regard to the test expressed in paragraph 3.5.1 above of Module 3 to the Applicant's Guidebook, the definition of String Confusion which is said to exist when a string "so nearly resembles another that it is likely to deceive or cause confusion" is clearly an adoption virtually verbatim of the general principles applicable in trademark law.

That this is the adoption of an international principle of trademark law is supported by reference to the GATT Agreement on Trade-Related Aspects of Intellectual Property Rights - Section 2 Trademarks - Article 16-1 - which provides:

"The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion."

The Panel also considers that it is helpful in cases such as these to look to decisions of the European Court, particularly as that body deals with international disputes (i.e. member States), and has accordingly not limited itself to the law of a particular country, and can be viewed as having global application. In this regard the Panel would refer to *Lloyd Schushfabrik Meyer & Co GmbH v Klijsen Handel BV* 1999 All ER (EC) 587 and 1999 ECR I-3819, particularly paragraph 25 of the judgment, wherein it is stated:

"In addition, the global appreciation of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 5(1)(b) of the Directive '..... there exists a likelihood of confusion on the part of the public' shows that the perception of marks in the mind of the average consumer of the category of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a

whole and does not proceed to analyse its various details (see, to that effect, SABEL, paragraph 23)."

Moreover the yardstick now laid down of that of the mind of the average reasonable Internet user also bears comparison with what was said in the above case at paragraph 26:

"For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96 *Gut Springenheide & Tusky* [1998] ECR I-4657, paragraph 31)."

The Panel accepts that it is important to have regard to the overall view, as pointed out in the passages quoted above, which entitle the Panel to consider that this view supports the approach that where one of the factors, such as aural similarity may be decisive (such as *Lloyd Schushfabrik Meyer & Co GmbH supra* paragraph 28), the Panel must not overlook the fact that, if no one factor can be said to be decisive, it must take into account all factors relevant to the circumstances (*Sabel BB v Puma AG* 1998 RPC 199, 1998 ETMR 1 (1997); *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1998] ECR I-5507 paragraph 16). In so doing, and where appropriate, the Panel may have to evaluate the importance to be attached to each of those different factors or elements (*Lloyd Schushfabrik Meyer & Co GmbH supra* paragraph 27).

Whilst the Panel has sought to determine an appropriate formulation of the relevant international principles with particular regard to the decisions of the European Court, this does not mean that the Panel has either overlooked or not taken into account certain of the contentions, particularly of the Objector, where there might be a difference in emphasis, in that the Objector relied on United States case law which bears a striking similarity to the principles viewed on a more general basis. Indeed, and apart from the fact that the Objector selected what it contends to be appropriate relevant factors from the general factors used by the United States Federal Courts (and there does not appear to be any challenge to this approach by the Applicant in its Response, having regard to the defences raised), the Panel is aware of the fact that the European Courts speak of visual, aural or conceptual similarity (*Lloyd Schushfabrik Meyer & Co GmbH supra*), whereas the Objector contends that similarity must be viewed as being four factors, namely visual, phonetic, similarity of meaning and evaluation based on context and overall impressions. Whether this is somewhat wider than that suggested in the European Court cases, or is encompassed by what is there said to be conceptual

similarly, is not a matter which requires a different or limited approach. The Panel is of the view that the fact that the Objector and, in its Response the Applicant, have chosen to deal with these four factors as being relevant is appropriate, and they will be viewed accordingly.

When dealing with confusion, both parties draw attention to the general factors used by the U S Federal Courts in assessing likelihood of confusion as including (1) similarity of the marks, (2) strength of the mark, (3) type of goods and the degree of care likely to be exercised by the purchaser, (4) marketing channels used, (5) evidence of actual confusion, (6) defendant's intent in selecting the mark, and (7) likelihood of expansion of the product lines. Both rely upon American authorities, notably *Polaroid Corp Polarad Elecs Corp* 287 F.2d 492, 495 (2d Cir 1961), *cert denied*, 368 U S 820 (1961).

The seven points are in fact a summary of the following passage to be found in the judgment of the court in the *Polaroid* case at 495:-

"Where the products are different, the prior owner's chance of success is a function of many variables: the strength of his mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of defendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers. Even this extensive catalogue does not exhaust the possibilities - the court may have to take still other variables into account."

Although the factors are described somewhat differently in the judgment, there is still latitude, even if certain of the enumerated factors are not expressly mentioned, since the court expressed the reservation that its own catalogue did not exclude other variables which may have to be taken into account. As indicated earlier by the Panel, the general factors may have been approached differently by the parties but, since they have chosen to deal with this aspect of the matter on that basis and as being relevant, the Panel feels it appropriate to view them accordingly.

Bearing the above considerations in mind, the Panel turns to the specific complaints raised.

(a) Visual Similarity

What is required to be established by the Objector, who bears the onus, is that the spelling variation would probably give rise to confusing similarity. Obviously the circumstances must be considered and in this regard the Panel finds that the contentions advanced by the Applicant, which are

summarised above, dealing with the fact that the variation by one letter is important, even though certain of the letters may coincide, and bearing in mind that there are existing TLDs which share some of the same letters and numerous top-level country code domains as well, this establishes that many domains that differ by one letter co-exist in various registries. To this must be added the fact that, as pointed out by the Applicant, consumers in the United States are able to distinguish slight variations in acronyms used for television channels. The Objector, on the other hand, contends that the issue is a matter of degree and that a slight spelling variation would not prevent confusion as in this instance. Against that, however, the Applicant raises the proposition that marks are acquired in trademark law to be compared in their entirety and not predicated on dissection thereof, as well as the fact that there is authority supporting the principle that consumers tend to focus on the first part of any trademark or service mark.

Having considered these contentions, the Panel concludes that there is insufficient to warrant a finding that visual similarity can be said to be present when comparing .tv and .dtv.

(b) Aural or Phonetic Similarity

While it may be correct as contended by the Objector that the focus should be on the pronunciation of the word by the public, particularly on radio and in speech, which would support the existence of a phonetic similarity between the two, the Applicant draws attention to the fact that Professor Maronick demonstrates that the pronunciations are not phonetically similar. The Applicant emphasises the view of Professor Maronick that the Applicant's string is pronounced " DOT DEE TEE VEE", whereas the Objector's is "DOT TEE VEE".

Against that, Professor Stygall, on behalf of the Objector, contends that, based upon her experience, the linguistic similarities suggest that it is probable that Internet users who encounter these domain names are likely to be confused. James T Walsh also find important similarities in sound.

Here the Panel is faced with conflicting views by respective experts. There is nothing to suggest that any expert is not an appropriately qualified expert in the field and that each has expressed an opinion. The Panel is not satisfied that there are reasons expressed by Professor Stygall in support of her opinion, and also by James T Walsh, which refute the views of Professor Maronick. The Panel is also aware that, when dealing with expert evidence, experts very often differ and, even though one may be considered to be an expert whose views are supported by the majority in the field, there can still be a respectable minority to which the other expert

belongs. In the absence of sufficient reasoning in favour of one view and negating or weakening the logic and reasoning of the other, the Panel is left in the situation that it cannot prefer one above the other. That being so, it is faced with the difficulty that the onus, being on the Objector, it cannot find that the onus has been discharged.

(c) Similarity of Meaning

The thrust of the contention of the Objector is that the mental impact of meaning must be considered in circumstances where the TLD may convey the same idea, mental reaction or meaning, thus causing confusion.

Against that, the Applicant contends that, to the extent that both have a similar meaning as applied to the word "television", this would not carry weight since the common generic abbreviation for "television" is well recognised and that, as opined by Professor Maronick, once the letter "d" is added, this creates a separate impression from the two letters "tv", with the result that the designation "dtv" has no inherent meaning.

Without the benefit of further evidence or reasons to support the contention relating to the mental impact of the meaning, nor other circumstances before the Panel which suggest that the approach of Professor Maronick should be rejected, the Panel finds that, on the evidence before it, there is insufficient to warrant the inference that the Objector has discharged the onus in this regard.

(d) Similarity Based on Context & Overall Impressions

The contentions of the Objector are, in principle, based upon the application of general and legal principles, which overlap with what has already been considered above in regard to similarity.

Whilst the Applicant agrees that the words or marks should be considered as they are encountered in the market place, taking into account normal surrounding circumstances, it counters on the basis that the intention is to use the TLD .dtv as a closed domain with the consequence of there being no similarity in content nor the same pool of users or customers as in the case of the TLD .tv.

In the absence of any further evidence favoring the Objector and countering that of the Applicant in this regard, the Panel is not persuaded that the Objector has discharged the onus on this issue.

(e) TLD Strings Not Similar When Measured by ICANN String Similarity Assessment Tool

Although this ground is dealt with by the Objector in the course of its argument under the chapter entitled "Confusing Similarity Between .dtv and .tv, the Applicant chose to deal with it specifically as a sub-heading under "Similarity". In the circumstances the Panel has had regard to the contentions of both parties, those of the Objector being that, in the course of the assessment by ICANN, this is an initial evaluation involving the comparing of existing TLDs with every applied-for gTLD string for the purpose of determining whether the new string is confusingly similar to an existing one.

As pointed out by the Objector, the similarity review is conducted by an independent expert and is simply a visual check, in part based upon an algorithmic score applying the ICANN string similarity assessment tool. It is this that led to the determination that the similarity score between .tv and .dtv is 63% which the Objector contends reflects clear similarity, albeit that this is based on visual similarity, being only one aspect of the similarity issue.

Against that, the Applicant draws attention to the fact that the list of similarity scores comparing various applied-for strings with common characters reflects that those below 90% appear to be sufficiently dissimilar that the applications can proceed.

As there is no expert or other evidence in support of either contention as to whether or not a 63% score falls to be classified as a rating within a range likely to deceive or cause confusion, the fact that is contended by the Objector that the higher the rating the greater the likelihood of such being the case, does not satisfy the Panel that the mere rating alone suffices.

However, as this review is, on the understanding of the Panel, a full re-hearing, it would be not only unfair to the Objector but also wrong to require it to assume an onus of having to show that the preliminary findings should stand, unless it is shown that they are wrong or unsupported. The circumstance that the gTLD .dtv passed through the initial testing should not be held against the Objector, since it was not involved in the process, nor would the independent panel carrying out such a review been aware of the specific objections now raised by it.

The Panel therefore does not see that it can attribute weight thereto since the Objector was not a party thereto, nor heard in the course of the review.

6 Confusion

(a) Strength of the Mark

- (i) It is not disputed by the Applicant that, as is contended by the Objector, .tv is an established domain having commercial strength and market place recognition, particularly because of it being perceived as the established variation of the word "television".
- (ii) However, the Applicant contends that the category in which the domain falls and by which its strength traditionally is measured, is such that this will determine whether it is inherently distinctive and entitled to protection on the ground. The Applicant then points out that it falls within a category (whether it is the weakest or not is not established by the evidence but is such by reason of the fact that "tv" and "television" are fundamental generic terms) whereby .tv cannot be imbued with a secondary meaning or that can be derived from common parlance or use.
- (iii) In the absence of any specific evidence from the Applicant countering that of the Objector as to the strength of the domain in the market place because of the nature of its position and its trade, the Panel makes no finding that the mark has not attained a position in the market which may warrant what is said by the Objector.
- (iv) However, the second argument of the Applicant that it is a generic term and not such as to acquire strength by reason of possible secondary meaning, is supported by authority cited by the Applicant. In support of this contention the Applicant relies upon 1-2 Gilson on Trademarks, paragraph 2.09, that generic names cannot achieve secondary meaning. The Panel understands that the general principle, which can also be found in paragraph B(ii) of Article 6 Quinquies of the Convention of Paris for the Protection of Industrial Property entered into on March 20, 1883, up-dated from time to time and adopted by most countries of the world, including the United States of America, demonstrates that this principle is of general and international application. The Panel's understanding is that, if a trademark consists of a word which has become generally recognised by the public as the only practicable name or description of any article or substance or service, and has commonly been used by other traders for such an article or substance, that word ceases to be distinctive and becomes generic. Thus the Panel finds that both the abbreviation "tv" and the word "television" are indeed generic, having become descriptive of the article (i.e. a television meaning a receiving set)

as well as the service (i.e. the provision or broadcasting of television as one of the forms of media) and thus cease to have the necessary distinctiveness as would have qualified for registration or even recognition as a trademark.

- (v) The Panel is also aware of the fact that the TLD .tv had a primary designation which was that of a top-level country code domain name of the Island of Tuvalu, cuts against the notion that it can be viewed as having sufficient strength to warrant an inference favourable to the Objector.
- (vi) In so deciding, the Panel is aware of the fact that by general principle trademark law aims at the protection of trademarks in respect of various classes of goods and items or services which are designated, and not generally, save and except for those instances where there may be a class for which the mark is not registered but relating to goods allied to or in some way linked with the class for which the mark is registered, with the result that dilution can occur. There is nothing to suggest on the evidence that this limitation would or would not apply, nor is there any authority which has been placed before the Panel to suggest that such a rule would operate to restrict top-level country domains when considered in the light of general top-level domains, whether commercial or otherwise. Thus the Panel does not make a finding in this regard, more especially as the term "top level domain" in the definition of "String Confusion Objection" (in DRP Article 2(3)(i)) does not suggest such a limitation.

(b) Degree of Care Exercised by User

- (i) The Objector contends that the relevant class of users would consist of casual Internet users likely to exercise a low degree of care, whereas the Applicant contends that by limiting the .dtv TLD to its affiliates and others within its network or group, this is not a concern which will arise.
- (ii) The Panel considers that, on the basis of such limitation, there will be little or no overlap between those who are likely to make use of either TLD. Thus, concerns as to the degree of care would not be a factor which it can find should weigh, particularly as, of necessity, without there being any evidence, the respective contentions as to the degree of care must necessarily be speculative.

(c) Marketing Channels

- (i) As a matter of general principle, the Panel accepts the contention by the Objector that where goods are marketed and used by the same or similar users, even if the parties are engaged in different channels of trade, marketing methods can and do change, depending on circumstances.
- (ii) In the present instance, however, the Panel feels that it must view the matter in the light of the evidence before it. That evidence is that the intention of the Applicant, as has been referred to above, that the .dtv will be a closed domain with restricted access to those authorised affiliates of the Applicant and customers and not one open to the public. The Panel accepts that on that premise there will not be any overlap so as to give rise to the concerns expressed by the Objector and having regard to the general principle, inasmuch as there is no evidence that the position is likely to change in the foreseeable future. The fears of the Objector that, as the business of the Applicant develops there will be a danger of overlapping because the market will develop similarly, are also speculative since there is nothing to suggest a change of intention or evidence that the nature of the business activity contemplated by the Applicant is such as would give rise to such a likelihood in the future.
- (iii) In the circumstances the Panel is unpersuaded that, even in circumstances where the average reasonable Internet user when using the Internet may have occasion to visit the site of the Applicant when searching for products which are catered for by those registered with the Objector, that fear is not substantiated, particularly as such user would find that all those using the .dtv TLD are either the Applicant or its affiliates or those linked to it.

(d) Confusing Similarity Between .tv and .dtv

- (i) Apart from relying upon general submissions based on earlier argument, the Objector raises the question as to the initial evaluation carried out by ICANN which the Panel has already dealt with as a separate factor. To the extent that the Objector relies upon the opinions of James T Walsh, as well as those of Professor Stygall, in support of the contention which has been made, the Panel finds itself in the same position as earlier. Again, notwithstanding a consideration of their views conjointly, the Panel is not persuaded, for the reasons already expressed, that it can

necessarily prefer their evidence against that of Professor Maronick. In particular, his evidence as to the survey carried out is put up as part of the evidential matter, and is evidence which suggests that there would be no confusion between the two and that it is significant that none of the 225 persons who responded mentioned that .dtv was associated with or sponsored by .tv, nor was the latter mentioned by any of them at all.

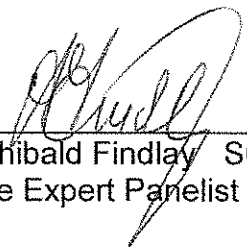
- (ii) In the circumstances the Panel does not see that it can derive any additional evidential weight from what is put up under this head and which can be added to the findings already made to change its views. It accordingly remains unpersuaded that the Objector, even if all the factors are taken together and evaluated collectively, together with those specifically advanced on the issue of confusion, has discharged the onus on it for the reasons already expressed and those which fall to be taken into account when considering the context and overall impressions.

(e) Harm to Users & the Objector from Confusion

Obviously, if the Objector had succeeded in establishing that there was a probability of such confusion, harm would probably follow, but, as the Panel finds that the Objector has failed to demonstrate a likelihood of confusion, the issue of harm in the circumstances falls away, since it would have arisen only had the Objector succeeded.

IX Determination

The Panel accordingly finds that the Applicant has prevailed and the objection is dismissed.



Archibald Findlay SC
Sole Expert Panelist

Dated: September 11, 2013.