

International Centre for Dispute Resolution
New gTLD String Confusion Panel

Re: 50 504 T 00262 13

VERISIGN SWITZERLAND SA, OBJECTOR

and

ITV SERVICES LIMITED, APPLICANT

TLD String applied for and objected to: <.itv >

EXPERT DETERMINATION

The parties

The Objector is VERISIGN SWITZERLAND SA, and is represented by Thomas Indelicarto, Vice-President, Associate General Counsel, 12061 Bluemont Way; Reston, VA 20190. Verisign alleges that it is the existing TLD operator of .tv, pursuant to a 1991 assignment of the country code top-level domain (ccTLD) by the country of Tuvalu, a South Pacific nation.

The Applicant is ITV SERVICES LIMITED and is represented by Lorna Gradden, The London Television Centre Upper Groun SE 1 9LT United Kingdom; Anoushka Sandry and Paul Stevens with Olswang LLP; 90 High Holborn London WC1V6XX United Kingdom; and, Brian Beckham, Valideus Ltd., 2nd Floor, 28-30 Little Russell Street WC1A2HN, United Kingdom London. The Applicant alleges that it is a broadcast network made up of ITV – the largest commercial channel in the United Kingdom – and the digital channels ITV2, ITV3, ITV4 and CITV.

The New gTLD String Objected To

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

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” (“ICDR”).

Procedural History of this Case:

On March 13, 2013, Objector Verisign Switzerland SA (“Verisign”) submitted its String Confusion Objection, together with the supporting declarations under penalty of perjury of Gail Stygall, Expert Linguist; James T. Walsh, Expert (Legal); and Joseph Waldron, Director of Product Management for .tv and other Verisign products.

On May 17, 2013, Applicant/Respondent ITV Services Limited (“ITV”) submitted its Response to String Confusion Objection, with Annexes Nos. 1 to 8, and the supporting Witness Statement of Helen Jane Tautz, with Exhibits HT-1 through HT-7.

The undersigned’s appointment as Expert was confirmed by the ICDR on July 5, 2013.

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

Verisign asserts standing as the existing TLD operator of .tv, pursuant to an assignment of the country code top-level domain (ccTLD) by the country of Tuvalu.

Parties’ Contentions

Objector Verisign contends as follows:

1. The .tv TLD has a unique and well-established identity as the home for video on the Web, and has been marketed by Verisign as an Internet destination for websites with playable content, in connection with television, video, entertainment, and other media services and is served by approximately 219 registrars with over 20 years of experience.
2. The ICANN standards reflect and parallel long-established standards governing likelihood of confusion that have developed under U.S. trademark law and trademark law more broadly, referring to the trademark law concept of “likelihood of confusion”. In trademark law, visual similarity is generally “not a binary factor but is a matter of degree”. Also, WIPO standards reflect a recognition that inclusion of a subsidiary word to the dominant feature of a mark does not serve to obviate confusion, especially where the first language of an internet user is not the same as that of the domain name. Also, even if two words are generally distinguishable visually to the eye, the two words may sound the same to the ear. Under trademark law, the use of a designation which causes confusion because it conveys the same idea, or stimulates the same mental reaction, or has the same meaning is enjoined on the same basis as where the similarity goes to the eye or the ear.
3. Applying the foregoing principles, there is a visual similarity, a phonetic similarity, and a similarity of meaning between .tv and .itv.
4. In judging similarity, context needs to be considered, such as the general impression created by a mark under trademark law, citing a U.S. trademark case finding CSC to be confusingly similar to CCC because initials, by their very nature, are a shortened version to be comprehended by a glance.
5. General factors used by U.S. courts in assessing likelihood of confusion include: 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. Applying those factors to the present case, the .tv TLD is popular and valuable because it is the established abbreviation of the word "television". The relevant class of users consists of casual internet users who are likely to exercise a low degree of care when exposed to TLD's, increasing the likelihood of confusion. Both Verisign and ITV are currently engaged in different channels of trade, and ITV's application for .itv expresses its current intention to provide a platform for the delivery of secure digital material and to make the applied-for TLD available for use only by ITV personnel/employees and ITV customers, but that could change in the future. Also, ITV expressly states its intention to use the TLD in marketing, advertising and in communicating with consumers—which overlaps with Verisign's customers' use of .tv for video and televisivisualon content on the Internet, significantly increasing the risk of confusion.

6. The similarity review conducted by the String Similarity Panel in its Initial Evaluation prior to approving ITV's gTLD application for further processing (using an algorithm) indicated a visual similarity score of 63% between .tv and .itv.
7. According to the Declaration of James T. Walsh, former Administrative trademark judge at the Trademark Trial and Appeal Board of the USPTO, the difference between .itv and .tv varies by only one letter difference between these letters is "virtually imperceptible"; the two could easily be confused by a casual Internet user; as both use the letters "tv" the addition if the letter "I" does not detract from the shared meaning associated with television; and, the commercial strength and popularity of the established .tv TLD, combined with the potential overlapping marketing channels of .tv and .itv further establish the likelihood of confusion.
8. Verisign will suffer economic harm when users are diverted away from its registry services who may be confused by reaching an address that does not exist, or an unintended website.

Applicant ITV contends as follows:

1. ITV contends that Verisign does not have standing in that the .tv ccTLD is the country code top-level domain assigned to the country of Tuvalu and that there is no evidence that the government of Tuvalu has consented to or supports the Objection.
2. No evidence has been presented to support Verisign's claim that .tv is "the established home for video on the Web" and "the preferred domain name for rich media content websites". ITV disputes this assertion.
3. No evidence has been presented to support Verisign's claims that "no other registry operator has built an infrastructure comparable to that developed by Verisign, nor has any other TLD have the size nor provide the services of Verisign's TLD's" and that "Internet users, from surfers to domain name registrants and registrars, know of the .tv TLD and its unique identity and benefits". ITV disputes this assertion.
4. Verisign's website indicates that in response to a poll asking "Where do you watch the most online Video", the results were 64% for YouTube, 14% for Facebook, 14% for Vimeo, 0% for Hulu, and 7% for Other. Of those identified above, only Hulu has a .tv domain, and only then to redirect to hulu.com.
5. Verisign cannot claim monopoly rights to "TV" because it admits that it is an established internationally recognized abbreviation of the word television. Internet users will readily understand "TV" (as an e a ccTLD) to mean "television" and will look for other identifiers and context to determine the source or origin of a domain which includes "TV".

6. The ITV trademark and brand are both well-known and well-established in the United Kingdom and internationally, as supported by the witness statement of Helen Tautz at Annex 2 to ITV's Response. The ITV family of channels attracts the largest audience of any UK broadcaster other than the BBC, with a 22.3% Share of Viewing, and the largest share of the UK television advertising market at 45.8%.
7. U.S. case law cited by Verisign in support of its objection is not binding upon this tribunal and should not influence this determination.
8. The Walsh Decl. submitted by Verisign confuses the test for similarity in respect of domain names with that for trademarks. Walsh fails to address the fact that Internet users are familiar with the common practice that identical (or virtually identical) domains can be registered by unconnected third parties, with the only difference often being the gTLD or ccTLD (e.g. yellowpages.co.uk; yellowpages.com.au; yellowpages.ca).
9. ITV disputes the assertion in the Walsh Decl. that "the one letter difference between the letter strings . . . is virtually imperceptible" (in both appearance and sound).
10. Visually, .itv and .tv look different because of the addition of the letter "I" at the start of the GTLD. Trade mark practice dictates that the dominant element of a trademark is the initial element/syllable/character. The "i" in .itv is such a distinguishing initial element.
11. ccTLDs consist of 2 letters. Typically, gTLD's consist of at least 3. Internet users will be aware of that and will be able to distinguish between .tv and .itv.
12. .tv is one of seventeen ccTLDs which begin with "t" consisting of 2 letters; there is no exclusivity for 2 letter strings beginning with "i" or "t". .tv has coexisted with these ccTLDs for numerous years.
13. There are 11 ccTLDs which are phonetically similar to .tv (.bv, .cv, .lv, .mv, .tc, .td, .tp, .tt, .ve and .vi) The visual and phonetic similarities of these ccTLDs to .tv is closer than any phonetic similarity between .tv and .itv, and yet .tv coexists with these aa ccTLDs.
14. In a trademark sense, "tv" is generic, or at least entirely descriptive.
15. The opinion of linguist Stygall that "a user encountering .itv for the first time is still likely to associate the .itv with .tv" because "the presence of tv in the TLD simply overwhelms other possible interpretations" is irrelevant because mere association is not the test.
16. The .tv ccTLD is not intended to refer to "Internet TV" but rather to Tuvalu. .tv is not a "mark" but a ccTLD which cannot function as a trademark.
17. .itv will only be operated as a closed registry. Only ITV's websites will be hosted at any .itv domain for the benefit of ITV's customer, shareholders and employees. There will be no opportunity for internet Users (other than ITV) registering a .itv domain. As stated in ITV's application, "the ITV registry will be stringently controlled and used only by authorized ITV personnel."
18. ITV would suffer extensive economic harm if .itv is not registered because ITV has enjoyed a 26% increase in Online, Pay and Interactive revenue.

Discussion and Findings

This Determination assumes that Verisign has standing to make a string confusion objection by virtue of it being an operator of the .tv domain by assignment from the owner, the country of Tuvalu.

The applicable standard for determining whether string confusion exists is set forth in Rule 3.5.1 of the Applicant Guidebook, which states that “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.”

Applying the above standard to the present case, Verisign has failed to establish that there is a probability that confusion will arise in the mind of the average, reasonable internet user with respect to the .tv ccTLD and the .itv gTLD.

First and foremost, the two domains are clearly distinguishable visually because .tv has only two letters (commonly associated with country code TLD’s) and .itv has three letters. It is quite likely that the average, reasonable internet user will be able to distinguish between a two-letter TLD and a three-letter TLD and therefore will not be confused, even though he or she might associate .itv with television and therefore possibly as well with the domain .tv. As indicated in Rule 3.5.1 a mere association is not enough to support a finding of a likelihood of string confusion. The undersigned is simply unable to accept the statement in the Walsh Declaration relied on by Verisign that the one letter difference between .itv and .tv is “virtually imperceptible”. As argued by ITV, it is reasonable to assume that internet users will readily understand “TV” (as an expression, not as a ccTLD) to mean “television” and will look to other identifiers and context to determine the source or origin of a domain which includes the letters “tv”.

Second, the Stygall declaration relied on by Verisign finds that a “user encountering .itv for the first time is .. likely to associate the .itv with .tv.” and “the addition of the i might simply be a category or type of tv”. [Emphasis added]. It then goes on to conclude that “these linguistic similarities suggest that it is probable, not merely possible, that Internet users who encounter domain names with .itv are likely to be confused.” [Emphasis added]. But as already indicated, a mere association is not the test. Nor does Ms. Stygall opine that confusion is probable, as required by Rule 3.5.1 --- only that the association with a type of .tv “suggests” that confusion is probable. A mere association that merely suggests a probability of confusion does not meet the Rule 3.5.1 standard.

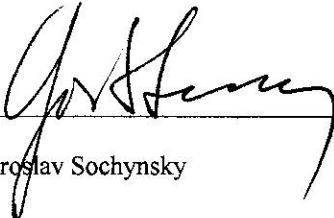
Third, to the extent an internet user may now or in the future be using voice control to access the Internet, .itv and .tv are also aurally sufficiently distinguishable so as to avoid the probability of confusion in the average, reasonable internet user. The two sound differently to the human ear, and the mere association with television that may be brought to mind is again not enough to meet the test. As before, the undersigned does not accept Declarant Walsh’s statement that the one letter difference between the two causes them to be aurally “virtually imperceptible”.

While not of itself dispositive, the fact that ITV has represented in its application that “the ITV registry will be stringently controlled and used only by authorized ITV personnel.” lends further weight to its position that it is not probable that the average, reasonable internet user will be confused between .itv and .tv.

Determination

The Applicant has prevailed and the Objection is dismissed.

Dated: August 9, 2013



Yaroslav Sochynsky

Sole Expert Panelist