

International Centre for Dispute Resolution
New gTLD String Confusion Panel

Re: 50 504 T 210 13

SportAccord, OBJECTOR

and

Steel Edge, LLC, APPLICANT

String: <.sports>

EXPERT DETERMINATION

The parties

The Objector is SportAccord, Maison du Sport International, 54, av de Rhodanie, 1007 Lausanne, Switzerland, represented by Pierre Germeau.

The Applicant is Steel Edge LLC, represented by The IP & Technology Legal Group, P.C. (dba New gTLD Disputes), United States of America.

The New gTLD String Objected To

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

Prevailing Party

The Objector has prevailed and the Objection is sustained.

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

The Objection was filed with the International Centre for Dispute Resolution (the "ICDR") on March 18, 2013 pursuant to the new gTLD Dispute Resolution Procedure (the "Procedure.")

In accordance with Article 9 of the Procedure, on April 4, 2013, the ICDR completed the review of the Objection and determined that the Objection was deficient in that Objector failed to show proof of service on Applicant. On April 11, 2013, after receipt of a further submission from Objector, the ICDR notified the parties that the Objection now complied with the requirements of the Procedure and with requirements of the International Centre for Dispute Resolution (ICDR) Supplementary Procedures for String Confusion Objections (Rules) (the "ICDR Rules").

In accordance with Article 11(a) of the Procedure and Article 2, 3 of the ICDR Rules, on April 17, 2013, the ICDR formally notified Applicant of the Objection. In accordance with Article 11(b) and relevant communications provisions of the Procedure, the Response was timely filed with the ICDR on May 22, 2013.

The ICDR appointed M. Scott Donahey as the Panel in this matter on June 14, 2013. The Panel finds that it was properly constituted and is in compliance with Article 13 (c) of the Procedure and Article 1, 1 of the ICDR Rules.

Basis for Objector's standing to Object based on String Confusion

Objector is the current applicant for the new gTLD <.sport> and therefore has standing to pursue this objection. Section 3.2.2.1, Module 3, new gTLD Guidebook.

Factual Background

Objector is the applicant for the new gTLD <.sport>. In addition to its String Confusion Objection, Objector has also filed a community-based objection against Applicant, as well as a community based objection against an application for <.sport> made by dot Sport Limited, a wholly owned subsidiary of Famous Four Media Ltd. Objector and dot Sport Limited are currently in a contentions set concerning the <.sport> string.

Applicant is a subsidiary of Donuts Inc., a company that was formed to acquire and operate new generic top-level domains. Donuts Inc. has applied for 307 new gTLDs. Donuts has designed additional safeguards which it intends to use to increase security without restricting initial access. Donuts has invested almost US\$ 57 million in its effort to acquire new gTLDs. A search of the United States Patent and Trademark Office ("USPTO") found that the USPTO has registered 2,054 word marks, each of which has a plural word mark which has also been registered.

Parties' Contentions

Objector

Objector alleges that since "sports" is the plural of "sport," a significant degree of confusion will occur, since a significant degree of confusion would occur between any TLD string that is understood to be the plural of another TLD string.

Objector contends that "Sport" and "sports" are used interchangeably to refer to various types of sport activities. In certain languages, such as German and Italian, there is only one word for "sport" that serves as both the singular and the plural.

Objector argues that in the English language the singular and plural of "sport" are often used interchangeably as nouns. The word "sport" and "sports" in English are used interchangeably as adjectives.

Objector alleges that there is little difference in the pronunciation of “sport” and “sports.” In the French language the words “sport” and “sports” are pronounced exactly the same. Hundreds of millions of Internet users have French as their primary written language.

Objector contends that memorability is a key issue in the use of domain names. The ordinary Internet user will not normally remember whether the gTLD is <.sport> or <.sports>.

In Objector’s view, the <.sports> registry application lacks community-based eligibility.

Objector argues that the co- existence of a <.sports> gTLD alongside a <.sport> gTLD means that the <.sports> gTLD could be used for deceit bordering on fraud, involving SLDs being registered in various degrees of bad faith. Such activities would greatly damage the “Sport community,” the values of sport, and the reputation of sport organizers.

Objector asserts that the existence of both <.sport> and <.sports> gTLDs would force legitimate domain name registrants to perform large-scale defensive registrations in <.sport>.

In Objector’s view, while the community-based .sport gTLD will be operated “in the interest of the Sport community,” the <.sports> gTLD will lack accountability to the “Sport community,” and registrations in the <.sports> gTLD would occur in the absence of “policies designed to safeguard and promote the Interest of the Sport community.”

Objector contends that the .sport/.sports situation is different from other situations such as .eu/.eus, .com/.co, .It/.it, and sport.com/sports.com.

Objector alleges that any registrant in <.sport> would be forced to register in <.sports>. Speculative and abusive registrations would thrive in <.sports>. Having more registrants in <.sports>, the registry would be able to lower pricing; therefore it would encourage more speculation and abuse.

In an unsolicited supplemental submission, Objector cites the decision in the matter of Charleston Road Registry, OBJECTOR and John Island, LLC, APPLICANT, ICDR No. 50 504 00274 13, concerning the application for the new gTLD string <.pets> , which consists of the English plural of the applied for new gTLD string <.pet>. Although not obligated to accept this supplemental submission, the Expert elects to do so.

In the <.pets> Expert Determination, dated August 14, 2013, the Expert determined that, based on the visual similarity between the singular and plural forms, the high algorithmic score given by the panel in preliminary string similarity review (the algorithm produced a “72% similarity”), the high aural similarity, the applied for gTLD string <.pets> was confusingly similar to the applied for gTLD string <.pet> and sustained the objection.

Applicant

Applicant contends that Objector has failed to meet its burden of proof.

Applicant argues that the words “sport” and “sports” both look different and sound different.

Applicant notes that ICANN’s String Similarity Panel, after performing a manual visual similarity check, applied certain algorithms designed to determine visual similarity and found the “sport” and “sports” were not visually similar.

Applicant argues that the singular and plural forms of English nouns commonly co-exist as SLDs in the domain name system, and Applicant gives several examples which incorporate the words “sport” and “sports” in the SLDs of registered domain names and are otherwise identical, and that such domain names have co-existed for a number of years.

Applicant points out that a number of English nouns have been registered as trademarks by the USPTO in both their singular and their plural forms, which singular and plural form marks are often owned by different parties.

Applicant asserts that the pronunciation of “sport” and “sports” as depicted by the International Phonetic Alphabet are markedly different. Response, Annex D. The fact that there may be some similarity in the sound of the words makes little difference in the Internet environment, since it is primarily visual and typographical.

Applicant contends that the meaning of “sport” and “sports” “could differ completely from each other . . .” Applicant argues that “sport” is a singular noun and that “sports” is a plural noun.

Applicant alleges that, even if one accepts that there is some similarity in meaning between “sport” and “sports,” “such similarity alone does not suffice to find likelihood of confusion.”

Applicant contends that even if one could say that “sports” may bring “sport” to mind, this is insufficient to establish probability of confusion. Section 3.5.1, Module 3, new gTLD Guidebook.

Applicant asserts that Objector’s statements as to the effect on “the Sport community and the public at large” are mere speculation and are irrelevant.

In Applicant’s unsolicited supplemental response to Objector’s unsolicited supplemental submission, Applicant cited the Expert Determination in the case of Charleston Road Registry, OBJECTOR and Koko Castle, APPLICANT, ICDR No. 50 504 00233 13, which concerns the application for the new gTLD string <.cars>, which is the plural form of the applied for new gTLD string <.car>. Because the Expert elected to consider the supplemental submission of Objector, the Expert also considers the supplemental response of Applicant.

In the matter of the string <.cars>, determined on August 7, 2013, the Expert acknowledged that the visual similarity tool assigned a percentage score of 72% in the preliminary examination of visual similarity, the identical algorithmic score to that arrived at in the <.pets> preliminary analysis. However, the Expert in the <.cars> case found that only where there is a confluence of all three types of similarity (visual, aural, and meaning) “that it becomes most probable that [confusion in the mind of the average Internet user] will occur.” Accordingly, the Expert in the <.cars> case dismissed the Objection.

Discussion and Findings

A. Burden of Proof

Objector bears the burden of proof in each case. Section 3.5, Module 3, new gTLD Applicant Guidebook; Procedures, Section 20(c).

B. Standing

“Two types of entities have standing to object:

An existing TLD operator may file a string confusion objection to assert string confusion between an applied-for gTLD and the TLD it currently operates.

Any gTLD applicant in this application round may file a string confusion objection to assert string confusion between an applied-for gTLD and the gTLD for which it has applied, where string confusion between the two applicants has not already been found in the Initial Evaluation.”

Section 3.2.2.1, Module 3, new gTLD Applicant Guidebook.

As an applicant for a new gTLD, the Panel finds that Objector has standing to file a string confusion objection.

C. Test for String Confusion Objection

“A . . . 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.”

Section 3.5.1, Module 3, new gTLD Applicant Guidebook.

D. Findings

It has been argued that there should be a bright line test regarding singular and plural new gTLDs and that ICANN should not permit both singular and plural versions to co-exist as new gTLDs. On April 11, 2013, at the ICANN meeting in Beijing, the Governmental Advisory Committee (GAC), an ICANN interest group consisting of representatives from various national governments, passed a resolution making just such a recommendation to ICANN’s Board of Directors. After considering the GAC recommendations, public comments thereon, and papers of expert commentators, on June 25th the ICANN Board New gTLD Program Committee (NGPC) issued a resolution in response thereto stating that the NGPC saw no need to make any changes to the current new gTLD Applicant Guidebook in order “to address potential consumer confusion specifically resulting from allowing singular and plural versions of the same strings.”

The test for a String Confusion Objection set out in the new gTLD Applicant Guidebook is a relatively simple one, at least in comparison to the tests for a Legal Rights Objection, a Limited Public Interest Objection, or a Community Objection. For string confusion to exist, a “**string**” must “so nearly **resemble**[] another [string] that it is likely to deceive or cause confusion.” The key words are “string” and “resemble:” there must be a “resemblance” between the “string” of the objector and the “string” of the Applicant.

The Webster’s Ninth New Collegiate Dictionary definition of “string” which most closely applies to the present situation, in which the strings consist of sequences of roman alphabet characters, is “a series of things arranged in or as if in a line; a sequence of like items (as bits, characters, or words).” Likewise, the definition of “resemblance” from the same source: “the quality or state of resembling, *esp.*: correspondence in **appearance** or **superficial** qualities.”

The test is primarily a visual one, but it is to be supplemented by comparisons of similarities other than visual. ICANN performs an initial evaluation designated a “String review.” Section 2.2, Module 2, new gTLD Applicant Guidebook. ICANN describes the initial evaluation thusly: “The **visual** similarity check that occurs during initial Evaluation is intended to augment the objection and **dispute resolution process that addresses all types of similarity.**” Section 2.2.1.1, Module 2, new gTLD Applicant guidebook, emphasis added. Thus, while visual similarity is the primary evaluation in a string confusion analysis, the Panel is expected to examine other similarities, which similarities are not enumerated in the requirements.

At the initial evaluation stage, ICANN looks for visual identity between the strings. “In the simple case in which an applied-for gTLD string is identical to an existing TLD or reserved name, the online application system will not allow the application to be submitted.” Section 2.2.1.1.1, Module 2, new gTLD Applicant Guidebook. The String Similarity Panel that performs the initial screening for ICANN applies the following standard:

“**Standard for String Confusion** – String confusion exists where a string so nearly resembles another **visually** that it is likely to deceive or cause confusion. For the 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.”

Section 2.2.1.1.2, Module 2, new gTLD Applicant Guidebook, emphasis added.

This language is identical to that in Section 3.5 Dispute Resolution Principles (Standards), Section 3.5.1 String Confusion Objection, with the sole exception of the absence of the word “visually” in the Dispute Resolution Standard. Thus, it is clear that in the dispute resolution arena, a Panel should consider resemblances other than mere visual resemblances in determining whether a likelihood of confusion exists. ICANN could not be clearer on this point:

“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.”

Section 2.2.1.1.3, Module 2, new gTLD Applicant Guidebook

The Expert in the present case is unable to adopt the Expert’s view in the <.pets> case, since it is difficult to imagine many monosyllabic words, at least in the English language, whose plural and singular versions would not be similar visually and aurally. This Expert believes that such similarities, without more, would not necessarily cause confusion in the mind of the reasonable Internet user. However, neither could this Expert say that a confluence of the factors of visual, aural and linguistic similarities would be sufficient in and of themselves, without more, to establish such confusion in the mind of the reasonable Internet user. As pointed out in the guidebook, these are only three examples of the similarities which an Expert might consider in making her Determination.

Having said that, this Expert believes that it would not be proper for a String Confusion Panel to engage in an analysis based on a legal rights objection, a limited public interest objection or a community objection. Those arenas have been reserved to other panels. Objector’s references to “the Sport community” and how it might be damaged or affected by the presence of the two proposed gTLDs are in the nature of Community objections, and are not appropriate for consideration by a String Confusion Panel.

Objector’s many references to possible fraud, deceit, cybersquatting or other type of abuse through the use of the gTLD proposed by Applicant are in the nature of legal rights objections, are mere speculation, and are unworthy of any consideration by an Expert in a string confusion analysis. What this Expert must determine is whether there are such similarities between the two gTLD strings that it is likely to deceive or cause confusion in the mind of the average, reasonable Internet user. This must involve a weighing and consideration of all relevant facts and circumstances.

In the present case, there are a number of similarities between the proposed new gTLDs at issue. It is true that the two are visually different, as the gTLD proposed by Applicant has added a final “s” to the word “sport” that is absent from the gTLD proposed by Objector. Yet that is the only visual difference. The proposed gTLDs are visually similar. If that were the only similarity, the Panel would find that Objector had failed to prove that Applicant’s string so nearly resembles Objector’s string that it is likely to deceive or cause confusion in the mind of the average, reasonable Internet user. But that is not the only similarity.

It is true that the words in English are not pronounced exactly the same. But they do sound similar. But these facts alone are in this Expert’s mind are insufficient to establish the likelihood of confusion in the average, reasonable Internet user. However, there is more. The words in “sport” and “sports” are pronounced exactly the same in French, and for many people around the globe French is their primary written or spoken language.

The word “sport” is not only a singular noun referring to one of many sports practiced around the world, but it is also a collective noun referring to all of the practices and pass times that we have elected to call “sports.” Thus, the phrase, “the wide world of sport” is identical to the phrase, “the wide world of sports.” And as an adjective the two words are synonymous and mean “of, relating to, or suitable for sports, *esp* styled in a manner suitable for casual or informal wear.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster, Inc., Springfield, Massachusetts, United States of America (1983), at 1141. Hence, “sport wear” or “sportswear,” and “sport coat” or “sports coat.”

The convergence of all these similarities, the fact that the words look very similar, that the words sound very similar in English and sound the same in French, and that the words can be used interchangeably as nouns in English to indicate the panorama of sporting activities, and that the words are interchangeable when used as adjectives in English, all lead the Expert to conclude that it is probable that confusion will arise in the mind of the average, reasonable Internet user.

Determination

The Objector has prevailed and the Objection is sustained.



M. Scott Donahey

Sole Expert Panelist

August 20, 2013