

International Centre for Dispute Resolution

New gTLD String Confusion Panel

Re: 50 504 T 217 13

Universal Postal Union, OBJECTOR

and

Deutsche Post AG, APPLICANT

String: <.epost>

EXPERT DETERMINATION

The parties

The Objector is Universal Postal Union, International Bureau, Weltpoststrasse 4, 3000 Berne 15, Switzerland, represented by Mr. Ricardo Guilherme Filho, its Legal Expert.

The Applicant is Deutsche Post AG, Charles-de Gaulle Strasse 20, 53113 Bonn, Germany and is represented by Mr. Bart Lieben, Attorney-at-Law, Antwerp, Belgium.

The New gTLD String Objected To

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

Prevailing Party

The Applicant has prevailed and the Objection is dismissed.

The New gTLD String Confusion Process

Module 3 of the ICANN gTLD Applicant Guidebook contains Objection Procedures and the New gTLD Dispute Resolution Procedure (“the Procedure”).

Article 1(b) of the Procedure states that “The new gTLD program includes a dispute resolution procedure, pursuant to which disputes between a person or entity who applies for a new gTLD and a person or entity who objects to that gTLD are resolved in accordance with this New gTLD Dispute Resolution Procedure.

As expressed in the Guidebook, and the Procedure, there are four (4) grounds to object to the registration of new gTLDs. One of these grounds expressed String Confusion, as described in DRP Article 2(e)(i): “(i) ‘**String Confusion Objection**’ refers to the objection that the string comprising the potential gTLD is confusingly similar to an existing top-level domain or another string applied for in the same round of applications.”

Article 3(a) states that “String Confusion Objections shall be administered by the International Centre for Dispute Resolution”.

Procedural History of this Case

The Objection was filed with the International Centre for Dispute Resolution (the "ICDR") on March 13, 2013 pursuant to the New gTLD Dispute Resolution Procedure (the "Procedure.") The ICDR formally acknowledged receipt of the Objection by letter dated March 18, 2013.

In accordance with Article 9 of the Procedure, on March 19, 2013, the ICDR completed the review of the Objection and determined that the Objection was deficient, in that Objector failed to furnish proof of service on Applicant. On April 11, 2013, following receipt of additional information from Objector, the ICDR determined 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 17, 2013. On May 23, 2013, the ICDR notified the parties that it would proceed with the appointment of the expert panel.

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 holder of the gTLD string <.post> and therefore has standing to pursue this objection. Section 3.2.2.1, Module 3, New gTLD Guidebook.

Factual Background

A. Facts set out by Objector

Objector is an intergovernmental organization and specialized agency of the United Nations. Objector was founded in 1874 with the intent to establish a single postal territory for the reciprocal exchange of letter-post items and with the purpose of organizing and improving the postal services and of promoting the development of international collaboration in the provision of postal services.

Objector provided in its Constitution that, among other things, it wished to stimulate the lasting development of efficient and accessible postal services, in order to facilitate communication between all of the inhabitants of the globe.

Currently Objector facilitates the development of worldwide postal services by providing an information and communication technology environment which allows postal operators to concentrate on the delivery of postal services to their customers. Objector is dedicated to the concept of a single postal territory, and its member countries work to ensure that all postal customers enjoy the right to universal postal service at affordable prices.

In 2009 ICANN established the <.post> gTLD to be administered by Objector as a sponsored gTLD. Objector intends to use the <.post> gTLD to provide a secure and trusted electronic infrastructure on the Internet to serve the needs of the global postal community.

Since the launch of the original initiative to develop the <.post> project in 2000, Objector and its member countries have invested considerable time and hundreds of thousands of dollars in these efforts.

In its pre-screening assessment, ICANN used a String Similarity Investment Tool to determine the percentage of visual similarity as between two strings using various algorithms. The application of this tool to the strings “.post” and “.epost” resulted in a similarity score of 75%.

Applicant stated in its application for the New gTLD <.epost> that the idea underlying Applicant’s E-POSTBRIEF product is to provide “confidential, binding and reliable communication (i.e. secure electronic communication, as well as trusted transactions” via the Internet. Applicant’s intention is to “combine various services and products all dealing with trusted transactions and secure electronic communications – such as payment and/or identification services. It is envisioned that [<.epost>] will serve as the umbrella domain for all of these services and products.”

Applicant further states in its application that it intends “to provide for an international platform in order to expand its current services provided under EPOST.de on a global level.”

In its initial application for the <.post> gTLD, Objector stated: “Our conclusion is that the only secure and stable way to operate a universal electronic postal service, [sic] that would fulfill the expectations of the world’s citizens and governments, could only be achieved under a sponsored GLD.” “Using a sponsored TLD, [Objector] wishes to extend this territory by extending its services onto a global electronic postal network – establishing up to 650,000 Post Offices on the Internet which will enable users in all parts of the world to access their local postal outlets via the DNS, for services related to local postal functions.”

B. Facts set out by Applicant

The <.post> sponsored gTLD is intended to be a platform whereby postal operators around the world can register postal related domain names. ICANN’s “registry monthly activity report” shows that as of January 2013, no registrars have been accredited and no domain names have been registered in <.post>.

Applicant has products which were initially intended to be a hybrid platform for conversion between electronic communications and paper communications. In the first two years the platform produced approximately 100 million hybrid communications, and by the year 2000 Applicant’s platform had produced approximately one billion such hybrid communications. Applicant has a platform for fully secure email service, using advanced digital signatures.

The current services provided by Applicant under the E-POST brand are as follows: 1) E-POSTBRIEF – a hybrid communications tool, which for non-registered users, converts email communications to paper communications and delivers the communications by mail; 2) E-POSTIDENT – an identification tool for Internet services that requires its users to be of a certain age and is a secure means of authentication; 3) E-POSTZAHLUNG – a secure system for payment over the Internet; 4) E-POSTSAFE – a secure storage and filing system for data; 5) E-POSTSCAN – a system for the digitization of paper documents.

Applicant has trademarks in Germany for EPOST that date back to 1998 and in the European Community that date back to 2005. Complaint, Annex 2.

In its application for the <.epost> gTLD, Applicant states that its intent is to take paper communications into the electronic environment and to provide a secure and safe Internet environment for communications. In the initial stages, only Applicant would be able to register domain names in the <.epost> New .gTLD. To the extent that Applicant should choose to allow third parties to register domain names in the <.epost> gTLD, only Applicant would be able to render Internet-related services under each and every domain name so registered. sTLD domain name registrants will be unable to control the content of any web site made available under the <.epost> gTLD.

In its visual String Similarity Review Panel proceedings, ICANN did not find that there was visual confusion between <.post> and <.epost>.

Parties' Contentions

Objector

Objector contends that the proposed New gTLD <.epost> is intended for the offering of postal services which may ultimately prove similar to those offered with the <.post> gTLD. Therefore, in addition to the visual similarity between <.post> and > <.epost>, the average reasonable Internet user is likely to be confused as to the source of the services offered. The result of ICANN's preliminary application of the String Similarity Assessment Tool showed that an algorithmic comparison between the two gTLDs showed that there was a 75% likelihood of visual similarity between the two.

Moreover, Applicant's stated plans for use of the proposed New gTLD shows a strong similarity to the stated plans for use of the sponsored gTLD submitted by Objector to ICANN in March, 2004.

The sponsored gTLD agreement that ICANN entered into with Objector on December 11, 2009, contained the following provision as the only provision in the final section of Appendix S, which section was entitled "Part VII – Additional Provisions:"

"ICANN and [Objector] acknowledge that a criterion included in the application process in which the .POST sTLD [sic] was selected, and in the previous TLD application expansion round, was that a new TLD be clearly differentiated from existing TLDs."

.post Sponsored TLD Agreement between ICANN and Objector, Appendix S, Part VII (Objection, Annex 6).

Objector describes this provision as constituting "a clear acknowledgment and commitment to ensure that any new TLD (such as the requested epost TLD) be 'clearly differentiated' from existing TLDs like the existing .post TLD. This provision not only reflected the original intent of both Parties to avoid string confusion disputes in future gTLD rounds as far as the .post TLD [sic] was concerned but also recognized the considerable investments made by [Objector] during the application process for the .post TLD and the further development and implementation steps undertaken by [Objector] member countries for the .post project"

Objector also attaches statements from postal authorities in Poland and Italy in support of Objector's contentions in this proceeding that the proposed <.epost> gTLD will cause confusion in the mind of the "average, reasonable consumer." Objection, Annex 7.

Applicant

Applicant argues that ICANN's String Similarity Assessment tool has been subject to strong criticism from various parties. Response, Annexes 3-7.

Applicant contends that the likelihood of confusion test normally applied in trademark law is inapplicable to the string confusion examination. The test that should be applied is the "sight, sound or meaning" test.

Since ICANN's expert String Similarity panel found no visual string similarity between <.epost> and <.post>, Applicant argues that neither should the Panel.

Applicant contends that since it is unlikely that an Internet user "would erroneously or intuitively include the prefix "E" when hearing the word post," than the proposed <.epost> gTLD could not be found to be confusingly similar to the <.post> gTLD.

Applicant argues that Applicant does not see how an Internet user can be confused between, on the one hand, an applied-for gTLD (<.epost> and, on the other hand, an existing gTLD that officially does not have any or only a few sTLDs registered in the existing gTLD, such as is the case with <.post>.

In discussing the possibility of audible similarity, Applicant contends that it is very unlikely that an average Internet user would be confused between the pronunciation of <.epost>, which contains two syllables, and <.post>, which contains only one.

As to confusion in meaning, Applicant argues that “post” is a common generic word denoting the physical delivery of written messages, while “epost” does not exist in common language. At the same time, Applicant asserts that the prefix “e” has become commonly recognized as a designation of goods or services sold or delivered electronically. Applicant asserts that there is a clear distinction between the terms “mail” and “email,” and the term “email” has been imported into non-English languages, while the term “mail” has not. To the same effect “business” or “commerce” compared with “ebusiness” or “ecommerce,” “book” compared with “ebook,” “file” compared with “efile,” etc. The letter “e” has become a prefix indicating “electronic” or “over the Internet,” and is used to differentiate a service provided electronically from those provided in a tangible, physical way.

Applicant asserts that Objector’s <.post> domain is virtually unknown to today’s Internet users and has only a handful of active registered SLDs two years following its launch.

Applicant argues that Objector is using the existing gTLD <.post> as a traditional registry of domain names, whose registrants are free to use the domain names so registered as they see fit. Objector does not attempt to control the activities, the content, the service, nor any goods or products made available by those registrants. In contrast, Applicant contends, the source of the goods and or services made available on the web sites to which the SLDs registered under <.epost> will resolve will be provided only by Applicant, controlled by Applicant, and branded by Applicant.

Applicant asserts that there will be no competition between the goods and services offered under <.post> and those offered under <.epost>. Objector intends to and is operating its gTLD as a traditional registry, whereas Applicant intends only to directly provide goods and services under its proposed New gTLD, maintaining complete control over the web sites to which SLDs registered in <.epost> will resolve, and intends to provide all services and to maintain total control of all web sites to which registered SLDs resolve.

Applicant accuses Objector of attempting to monopolize the generic word “post.” Applicant contends that the real motive behind the Objection is an attempt to protect the investment that Objector has made in the existing gTLD <.post>.

Applicant sees no relevance in the public comments made by the Italian and Polish postal authorities, nor to the GAC Early Warning related to potential governmental objections, as there is no reference to <.epost> in the GAC communication.

As to the agreement reached between Objector and ICANN, Applicant emphasizes that it is not a party to that agreement and believes that ICANN’s String Similarity Panel ruling is an indication that ICANN has decided according to its policy provisions that no similarity exists.

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 the holder of an existing gTLD, the Panel finds that Objector has standing to file a string confusion objection. In its Response, Applicant has admitted 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

The test for a String Confusion Objection is a relatively simple one 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

However, 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.

In the present case, the Panel finds that while on a superficial level the proposed New gTLD <.epost> might be considered visually similar to the gTLD <.post>, since the two gTLDs differ only in respect to the initial letter “e,” and since algorithms designed to focus only on “visual similarity” found the two gTLDs to be “75% similar,” the average, reasonable Internet user would perceive a significant difference: the average, reasonable Internet user would see the same difference that he or she would notice between <.mail> and <.email>. These are two different things in the mind of the average, reasonable Internet user. The first is the traditional mail system, often referred to by the average, reasonable Internet user as “snail mail.” The second is electronic mail, the messages over the Internet that are transmitted instantaneously. The average, reasonable Internet user seeing the two gTLDs side by side, would not see a similarity, but rather a sharp contrast, a contrast that perhaps the String Comparison Similarity Tool might miss.

As to auditory similarity, the Panel is of the opinion that the average, reasonable Internet user, when asked to pronounce the two gTLDs at issue, would pronounce <.post> as the one syllable word that it represents and would pronounce <.epost> as a two syllable word, with the first syllable consisting of the pronunciation of the letter “e.” The Panel does not find this to be auditorily similar.

Nor does the Panel find that the two gTLDs have the same meaning. The word “post” suggests the traditional postal service, the one that citizens in nations around the world have come to depend on: “Neither snow nor rain nor heat nor gloom of night stays these couriers from the swift completion of their appointed rounds,” the famous inscription in a New York United States Post Office that is actually a rough translation from ancient Greek describing the Greek courier service of long ago. And it is true that postal services around the world have long served the needs of providing reliable communication, no matter the physical risks and hardships faced by generations of postal carriers. And there will be a great need for their continuing service in the foreseeable future.

But a new means of communication has developed, and in time it promises to be the primary form of communication, at least until it is supplanted by another form that is now difficult for us to foresee or to comprehend. The word “epost” suggests the current new means of communication, electronic communication via the Internet, a communication which we now regard as instantaneous, but which one day may also be rendered “slow as a snail.” The word “epost” suggests “email,” a communication that moves through cyberspace, rather than through the physical world.

But what of the fact that Objector and Applicant are in competition, for they are, despite Applicant’s protestations to the contrary, since both intend to be involved in the electronic messaging services. Is this likely to create confusion in the mind of the average, reasonable Internet user? The Panel believes that the test for confusing similarity was not designed to stifle competition. “ICANN is dedicated . . . to promoting competition . . .” Section 1.1.2.3, Module 1, New gTLD Applicant Guidebook . It is to be expected that eventually there will be many gTLDs that are in competition in various areas of service, products or information. That is true whether the owner of the gTLD is using the gTLD as a traditional registry, providing registrations to any who wish to register an SLD, or whether the owner of the new gTLD wishes to use the gTLD solely for its own provisions of services, brands, products or information. The fact that two gTLDs are competitive in a certain industry or area of information is not a concern,

unless the average, reasonable Internet user might be confused as to the source of the service or information provided. That is not the case here.

Finally, as to Objector's argument that in its Sponsored TLD Agreement with ICANN, ICANN effectively promised that ICANN would allow in the future only new gTLDs that were clearly differentiated from <.post>, such an argument must fail. First, the Panel does not read the language in Part VII of the Sponsored TLD Agreement with ICANN to deal at all with future TLDs. The language, which is quoted, *supra*, at page 4, deals with "the previous TLD expansion round" and the "criterion included in the application process in which the .POST sTLD was selected." The language is retrospective, rather than prospective.

But more importantly, the .post Sponsored TLD Agreement was an agreement between ICANN and Objector. It does not bind third parties. If Objector feels that ICANN has somehow breached a prospective promise, than Objector is free to pursue a remedy through the provisions of Section 5.1 of the .post Sponsored TLD Agreement which provides for the "Resolutions of Disputes." However, that is not a matter within the purview of this panel.

Determination

The Applicant has prevailed and the Objection is dismissed.



M. Scott Donahey

Sole Expert Panelist

July 15, 2013