

International Centre for Dispute Resolution
New gTLD String Confusion Panel

RE: 50 504 T 00275 13

Charleston Road Registry Inc., OBJECTOR

vs

Sugar Station, LLC, APPLICANT

String: <.tours>

EXPERT DETERMINATION

The Parties:

The Objector is Charleston Road Registry Inc., 1600 Amphitheatre Parkway, Mountain View, California 94043, United States and is represented by Brian J. Winterfeldt, Esq., Steptoe & Johnson LLP, 1330 Connecticut Ave. N.W., Washington, DC 20036. Objector is a wholly owned subsidiary of Google, Inc.

The Applicant is Sugar Station, LLC, 155 108th Avenue, N.E., Suite 510, Bellevue, Washington 98004, United States and is represented by Jonathan Nevett, Donuts, Inc., 6102 Neilwood Dr., Rockville, MD 20852, John M. Genga, Esq. and Don Moody, New gTLD Disputes, 15260 Ventura Blvd. #1810 Sherman Oaks, CA 91403, and Daniel Schindler, Sugar Station, LLC, 10500 NE 8th Street Suite 350 Bellevue, WA 98004.

The New gTLD String Objected To:

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

Prevailing Party:

The Objector has prevailed and the Objection is sustained.

Background:

Module 3 of the ICANN gTLD Applicant Guidebook (“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.”

Section 3.1 of the Guidebook provides: “The independent dispute resolution process is designed to protect certain limited interests and rights. The process provides a path for formal objections during evaluation of the applications. It allows a party with standing to have its objection considered before a panel of qualified experts.”

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

A formal objection initiates a dispute resolution proceeding. In filing an application for a gTLD, the applicant agrees to accept the applicability of the gTLD dispute resolution process. Similarly, an objector accepts the applicability of the gTLD dispute resolution process by filing its objection.

Article 4(b)(i) of the Procedure provides that the applicable Dispute Resolution Service Provider (“DRSP”) Rules are the ICDR Supplementary Procedures for ICANN’s New gTLD Program.

A formal objection can be filed on four enumerated grounds, only one of which is relevant here. Specifically, as expressed in the Guidebook, and the Procedure, one of the grounds expressed is “String Confusion.” Article 2(e)(i) of the Procedure provides: “(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.”

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. Guidebook, Section 3.4.1.

Standing and Other Procedural Matters:

Objectors must satisfy standing requirements to have their objections considered. Standing requirements for objections on the grounds of string confusion require that the Objector be existing TLD operators or TLD applicants in the current round.

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

Any gTLD applicant in the same 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. That is, an

applicant does not have standing to object to another application with which it is already in a contention set.

Here, Objector has applied for the gTLD string <.tour>. Applicant has applied for the gTLD string <.tours>. Accordingly, Objector has standing to file this string confusion objection.

In the case where an existing TLD operator successfully asserts string confusion with an applicant, the application will be rejected.

In the case where a gTLD applicant successfully asserts string confusion with another applicant, the only possible outcome is for both applicants to be placed in a contention set and to be referred to a contention resolution procedure (refer to Module 4, String Contention Procedures). If an objection by one gTLD applicant to another gTLD applicant is unsuccessful, the applicants may both move forward in the process without being considered in contention with one another.

Article 21(d) of the Procedure provides: “The Expert Determination shall be in writing, shall identify the prevailing party and shall state the reasons upon which it is based. The remedies available to an Applicant or an Objector pursuant to any proceeding before a Panel shall be limited to the success or dismissal of an Objection and to the refund by the DRSP to the prevailing party, as determined by the Panel in its Expert Determination, of its advance payment(s) of Costs pursuant to Article 14(e) of this Procedure and any relevant provisions of the applicable DRSP Rules.”

Parties’ Contentions:

Objector asserts that a high degree of confusing similarity in appearance exists in instances involving the mere addition of the letter “s” and resultant pluralization of a word, citing, e.g., *In re Pix of America, Inc.*, 225 USPQ 691 (TTAB 1985) (finding NEWPORTS for women's shoes held likely to be confused with NEWPORT for outer shirts); *In re Curtice-Burns, Inc.*, 231 USPQ 990 (TTAB 1986) (finding MCKENZIE'S (stylized) for processed frozen fruits and vegetables held likely to be confused with MCKENZIE for canned fruits and vegetables); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (finding MILTRON and MILLTRONICS (stylized) to be highly similar in appearance).

Objector also argues that UDRP panels have found confusing similarity exists between single and plural domain names and trademarks, citing, e.g., *Matel, Inc. v. Magic 8 Ball Factory*, WIPO Case No. D2013-0058 (finding magic8balls.biz confusingly similar to MAGIC 8 BALL because the addition of the letter “s” letter constitutes only a minor variation); *LEGO Juris A/S v. Frederik Soleimani*, WIPO D2012-2133 (“The addition of a simple letter, as here a mere ‘s’ which refers to the plural of LEGO, can exacerbate the confusing similarity and increase the risk of confusion. Here, the Panel finds it clearly creates confusing similarity...”); *Home Retail Group v. Home Retail Group / Rafique Holding*, WIPO D2012-2335 (“In the Panel’s view this extra letter [“s”] does nothing to distinguish the disputed domain name from the Complainant’s trade mark and indeed it may be considered to heighten the potential for confusion, given that it confers an appearance on the disputed domain name of being a plural form of the Complainant’s trade mark.”); *Pet360, Inc. v. Private Registrations Aktien*

Gesellschaft, WIPO D2012-0325 (“The disputed domain name incorporates the Complainant’s registered trademarks PETFOOD DIRECT, PETFOODDIRECT and PETFOODDIRECT.COM, and adds the letter ‘s’ to the phrase ‘petfood’ to change it from the singular to the plural. The addition of this letter does not lessen the inevitable confusion of the disputed domain name with the Complainant’s registered trademarks.”).

Objector further cites NAF decisions, e.g., *Insbury, Inc. v. Genetic Researches Community*, NAF Claim No. FA1209001464188 (“It is well settled that domain names which merely modify a mark from singular to plural (or vice versa) are not distinguishable from, and are deemed confusingly similar to, the mark.”) *Barnesandnoble.com LLC v. Your One Stop Web Shop*, NAF Claim No. FA670171 (finding that the additions of the letter “s” to the disputed BARNESANDNOBLES.INFO and BARNESAND NOBLES.BIZ domain names failed to avoid confusing similarity with the complainant’s BARNES AND NOBLE trademark.); and *Deckers Outdoor Company v. Rongchun Huang and Yuan Chen*, NAF Claim No. FA0902001248979 (finding pluralization of the UGG mark did not avoid confusing similarity).

Applicant responds by contending that the gTLD program’s intent includes the promotion of free expression, citing statements in ICANN’s new gTLD Applicant Guidebook (“AGB”) – e.g., “everyone has the right to freedom of expression,” AGB at 3-21. Applicant argues that its application, along with approximately 1,600 submitted by others to ICANN, will create competition among domain name registries that has not previously existed in a landscape that has had only 22 gTLDs to this point. Applicant asserts that such competition advances the program’s goals, shared by Applicant, to expand consumer choice in the name space.

Applicant also asserts that it has adopted a business model that it believes enhances consumer choice more effectively than it could have achieved with a lesser number of applied-for names. By applying for and scaling up to run a large number of new gTLDs, Applicant achieves economies of scale that allow it to offer domains representing terms and subjects that otherwise could not be brought to the name space economically and, consequently, would not have their own forum.

In response to Objector’s contention that its string and Applicant’s “plural” thereof would confuse reasonable Internet users, Applicant asserts that it investigated singular/plural domain name pairs that currently coexist on the Internet. The search allegedly uncovered 50,886 singular/plural pairs that do not point to the same Internet Protocol (“IP”) address, compared to 1,330 pairs that do. In other words, over 50,000 users registered domain names even when the corresponding singular or plural version of the same name already existed and/or was being actively put to use on the Internet.

Applicant also searched online records of the United States Patent and Trademark Office (“USPTO”) for separate registrations of the singular and plural versions of the same word marks. Applicant’s search reportedly uncovered 2,054 out of 351,812 unique word marks that have plural matches. Applicant contends that, in those cases, the USPTO did not find the singular/plural sets sufficiently similar to cause confusion or to deny registration.

Applicant asserts that Objector seeks to stifle fair competition in the new gTLD program by misusing the ICANN objection process to obstruct the path of those applying for distinct TLD names, and that the Objection contravenes both the letter and spirit of the new gTLD program, the goals of which include increased choice and competition in the domain name industry.

Discussion and Findings:

Here, the issue is whether the string <.tours> comprising the potential gTLD is confusingly similar to <.tour>.

The Applicant asserts that the plural version of the English word “tour” is not confusingly similar to the singular version of the word. The Objector asserts that the plural is confusingly similar to the singular.

As noted above, the Objector cites various authorities holding that the plural version of a word has been found to infringe upon the trademark of the singular version, on the grounds that they are confusingly similar.

The Applicant asserts that the plural version of a word is readily distinguishable from the singular by the use of the letter “s”, and consequently the likelihood of confusion is merely possible, and not probable.

The issue here is whether the root of a word in a string should be accorded protection from usage of variations of the root word, including plural versions. For example, there are several variations of the root word “tour” in the English language, including the plural “tours,” the participle “touring” and the past tense of the verb “toured.”

As noted above, the applicable standard of review is the following: “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.”

Generally speaking, “confusion” may include jumbled or disorganized thought. A person who is confused may have difficulty solving problems or tasks, especially those known to have been previously easy for the person, or the inability to recognize familiar objects or locations, and uncertainty about what is happening, intended, or required. Confusion may include the state of being unclear in one’s mind about something, or the mistaking of one person or thing for another, including the inability to differentiate between similar words. In the context of internet searches, confusion can arise if the user is unable to differentiate between top level domain names, and becomes unable to access information using a logical, organized thought process. A confused internet user will be unable to find his or her way around the domain in a definite or familiar manner.

Here, the concurrent use of “tours”, the plural version of the root word “tour”, in a gTLD string will result in probable confusion by the average, reasonable Internet user, because the two strings have virtually the same sound, meaning, look and feel. The average Internet user would

not be able to differentiate between the two strings, and in the absence of some other external information (such as an index or guidebook) would have to guess which of the two strings contains the information the user is looking to view.

The adopters of the applicable standard of review for string confusion hypothetically could have allowed an unlimited number of top level domain names using the same root, and simply differentiate them by numbers, e.g., <.tour1>, <.tour2>, <.tour3>, etc., or other modifiers, including pluralization or other similar variations of a root word. While that might allow for increased competition, as argued by Applicant, it would only lead to a greater level of confusion and uncertainty among average, reasonable internet users. Accordingly, the Applicant's argument that the concurrent use of a root word and its plural version in a string increases competition is not persuasive in this context, and is rejected.

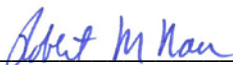
Similarly, the existence of numerous concurrent trademarks and/or domain names based on the same root word should not be determinative of the outcome in this case. Similar trademarks can be granted in difference classes of use. Here, the purpose of the gTLD is to create a top level domain with a name that informs internet users as to the general scope and subject matter of the domain. This is a different purpose and accordingly calls for a different standard from what is used in reviewing trademark applications, or in the allocation of standard internet domain names.

Accordingly, the Applicant's arguments do not appear to be consistent with the applicable standard of review, the apparent purpose or goal of implementing gTLD's, or the purpose or goal in allowing a string confusion objection.

Determination:

Therefore, the Objector has prevailed and the Objection is sustained.

DATED: August 16, 2013



ROBERT M. NAU,
Sole Expert Panelist