

**International Centre for Dispute Resolution**  
**New gTLD String Confusion Panel**

---

Re: 50 504 T 00292 13

The Government of Montenegro

OBJECTOR

And

Charleston Road Registry, Inc.

APPLICANT

String: <.MEME >

---

**EXPERT DETERMINATION**

**The Parties**

The Objector is the Government of Montenegro - Rimski Trg 45, Podgorice, Montenegro, 81 000 and is represented by Karen J. Bernstein, Law Offices of Karen J. Bernstein, LLC, 100 Park Avenue, Suite 1600, New York, New York, 10017

The Applicant is Charleston Road Registry, Inc. – 1600 Amphitheatre Parkway, Mountain View, California, 94043 and is represented by Brian Winterfeldt, Katten Muchin Rosenman LLP, 2900 K Street NW, North Tower, Suite 200, Washington D.C. 20007-5118

**The New gTLD String Objected To**

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

## **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 Internet Corporation for Assigned Names and Numbers (ICANN) is responsible for coordination of the Internet's system of identifiers including management of Top-Level Domain Names. A program has been implemented for the introduction of new generic Top-Level Domain Names (“gTLDs”). Applicants may apply for new gTLDs subject to a right of other parties to object.

The Applicant\Respondent Charleston Road Registry, Inc. (“CRR”) applies for registration of the new gTLD “.MEME”.

The objection brought is a String Confusion Objection. The position of the Objector is that the string comprising the potential gTLD is confusingly similar to an existing top-level domain. The Objector argues that the MEME application must be rejected based on string similarity confusion because the new gTLD it will more than probably confuse the average, reasonable Internet user into believing it is the ME string, devastate the market for the ME string, and cause serious economic, operational, and security problems in the domain space.

In accordance with the ICANN protocol for new gTLD applications CRR posted its application on June 13, 2012 for the MEME string. In accordance with the prescribed Dispute Resolution

Procedure, the Government of Montenegro filed its objection dated March 13, 2013. The CRR response to the objection was sent to the Objector and ICANN on May 15, 2013.

The International Centre for Dispute Resolution (ICDR) of the American Arbitration Association is the Dispute Resolution Service Provider under the prescribed ICANN Dispute Resolution Procedure. On June 13, 2013 I was appointed the Expert by the ICDR to decide the Objection.

### **Basis for Objector's Standing to Object based on String Confusion**

The Objector, the Government of Montenegro, was assigned the standard two letter country code .ME in September 2006 by the International Organization for Standardization (the "ISO"). In September 2007, ICANN delegated the .ME string to the Government of Montenegro.

### **Preliminary Objection**

On May 24, 2013 the Government of Montenegro filed an additional submission in support of the Objection. On May 28, 2013 CRR registered an objection to the additional submission on the basis that the prescribed procedures do not permit submissions beyond the Objection and the Response without prior authorization of the Expert. In the preliminary objection CRR notes that Article 17 of the Dispute Resolution Procedure provides that the Expert may decide whether the parties shall submit any written statements in addition to the Objection and the Response. No additional written statements were so requested. CRR accordingly requests that the additional submission dated May 24, 2013 be stricken from the record and not considered.

The ICANN Dispute Resolution Procedure provides a complete code for the resolution of disputes. There is no provision for a Reply in answer to a Response to an Objection. Where matters are raised in a Response that warrant a reply in the view of the Expert then under Article 17 the Expert may request that the parties submit additional written statements. No such request was made in this case. There is nothing in the applicable rules to prohibit a party from requesting an opportunity to file reply submissions but no such application was made. Nevertheless, I will treat the May 24, 2013 letter as an application to file an additional statement.

The Response filed by CRR does raise new issues including the relevance of United States trademark law. The Response however does not in my view necessitate a reply argument. I am able to weigh the relevance of trademark law to the issues arising herein as well as any other new matters raised in the Response. The case is amenable to decision without additional written statements. The additional written submission filed by the Government of Montenegro dated May 24, 2013 will not be considered in deciding this case. There will likewise be no need for CRR to file a reply argument in answer to the May 24, 2013 letter.

## **Parties' Contentions**

### **Position of the Objector the Government of Montenegro**

Montenegro argues that the replication of the letters ME in the .MEME string will bring more than a simple association with the .ME string. Montenegro argues that the MEME string is visually identical to the existing .ME string. As such the MEME string will deceive or cause confusion in the mind of the average reasonable Internet user who will mistake the MEME string with the existing ME string.

Montenegro further argues that inclusion of the two letter ME country designation in the meme string violates the prohibition against applications for strings that are country or territory based.

Montenegro also relies upon the ICANN evaluation tool for string similarity, an algorithm called the String Similarity Assessment Tool ("SWORD"). This algorithm is intended to provide an approximation of similarity between names. Montenegro argues that ICAAN discourages string similarities above 30% and notes that the similarity between the letters ME and the letters MEME results in a 50% similarity score using SWORD.

Citing the Generic Names Supporting Organization warning against similarity of names likely to cause confusion Montenegro argues that registrars will be reluctant to accept the ME string for fear that they will be faced with unforeseen customer service issues such as explaining why a website with a ME string is somehow displaying a website with a .MEME string. This would cause harm not only to Montenegro but to the entire domain industry they say.

A concern is also expressed regarding the potential for Google, the parent company of CRR, to manipulate its algorithm to increase search rankings in favor of the .MEME string over the .ME string. The potential for confusion might also cause an Internet user intending to send an email to the registrant of a .ME domain to type the letters M and E twice by accident. Montenegro argues that an Internet user could fall victim to fraud and that approval of the .MEME string could upset the security of the Internet. An example is given of a phishing scheme that could be devised to send an email with a second level .MEME domain name to an unsuspecting Internet user who mistakenly believes that the email is an official message from their subscribed social media source with a .ME string. This might cause the unwitting Internet user to provide usernames, passwords and secure information such as Social Security numbers and birth dates. The Internet users would believe that they were communicating with an authorized entity when in actuality it was a scam.

In conclusion Montenegro argues that approval of the .MEME string application will cause substantial confusion and erode the goodwill that Montenegro has built up with its .ME string. There is a danger that CRR will be permitted to reap the benefit of the hard work and dedication invested by the government of Montenegro in its .ME string over the years.

## **Position of the Applicant Charleston Road Registry, Inc.**

In the Response to the Objection, CRR argues that there is no probability of confusion between the two strings because the terms are different in appearance, sound and meaning. Sophisticated Internet users and consumers would not likely be confused. CRR argues that approval of the .MEME string would not cause economic harm to the government of Montenegro.

The original application for the proposed gTLD sought approval of the string to provide the marketplace with direct association with the term “meme” which connotes the echoing of a cultural idea as coined by Richard Dawkins in his book *The Selfish Gene*. The mission of the proposed gTLD was to provide a dedicated domain space for registrants to enact second-level domains related to viral phenomena, ideas, images, and videos. This was said to be of benefit to consumers, businesses and organizations wanting to offer information, products and services related to known memes. New registrants could differentiate their content by signifying that their content is related to a particular meme.

CRR argues that it is not probable that confusion will arise in the mind of the average, reasonable Internet user. There would be no expectation in the mind of that user that the .ME string and the .MEME string under the control of a single trade source. Reference is made to trademark jurisprudence in the United States which permits minor changes to short marks and that such a difference would negate any confusing similarity. The difference of even one letter can change the commercial impression engendered by a mark.

CRR argues further that objections in respect of generic TLD’s were never intended by ICANN to serve as a general veto for incumbents at the top level. For that reason it must be probable that confusion will arise. On the proper test, reasonable Internet users must expect that use of the two different strings would suggest common control from a single trade source thus causing confusion.

The word “meme” is said to be visually distinct from the word “me”. In assessing the visual similarities references is made to ICANN’s string confusion standards which are said to be borrowed from trademark law. As such, words should not be split into component parts in the submission of CRR. The impression conveyed by a term as a whole is said not to be conveyed by the individual parts, in this case, the word “me” repeated.

In respect of string similarity based on the SWORD algorithm, CRR argues that the ICANN String Similarity Panel charged with assessing the probability of confusion determined that the algorithmic score of 50% would not cause confusion.

CRR also relies upon United States trademark law to argue that minor differences in weak trademarks can negate confusing similarity. The use by the Government of Montenegro of the string ME is said to be generic and lacking in any trademark strength. Even if the .ME string had value as a mark the addition of another M and E would create a distinct visual impression especially when an entirely new word would be created. CRR cites United States judicial decisions in trademark cases where, for example, no confusing similarity was found between the names Poly Pro and Poly Flow. Small differences are said to create a different overall

commercial impression. Trademark precedents are relied upon to establish that generic indicators like Inc., Co. and Ltd. or even .com do not qualify for trademark protection. Accordingly an objector may not claim trademark protection. By extension, the generic .ME designation would not in the minds of average reasonable Internet users suggest priority rights or any degree of recognition.

Reference is again made to United States trademark jurisprudence to support the proposition that the two strings differ in phonetic sounds and are therefore unlikely to be mistaken in verbal marketplace communications. CRR points out that the words “meme” and “me” do not appear on the list of false cognates, a listing of the 250 most often confused words.

CRR argues that the word meme is increasingly recognized in today’s culture. Journal articles describing the best memes of the last 15 years and websites devoted to the concept of memes and trending in the use of memes suggests that there is a valid purpose to the use of the term meme in the proposed new gTLD.

In answer to the Objector’s position that Internet users may be victimized by scams taking advantage of similarities between the two strings in question, CRR argues that according to studies of online consumers, Internet users are sophisticated purchasers. It is said that reasonable, prudent consumers should be able to readily distinguish between the .MEME and .ME gTLD’s. Such consumers should not be assumed to exercise a low degree of care in this respect or to not recognize that typing ME twice was inadvertent.

In answer to the Objector’s position that the Applicant is attempting to circumvent prohibitions against strings for country codes, CRR argues that there is no such intent and that the term “meme” is a generic word found in the dictionary.

CRR denies any suggestion that its parent Google could or would manipulate algorithms to increase search rankings to favor the term “meme” over the term “me”.

In respect of claims by the Government of Montenegro that economic harm and user confusion would result, CRR argues that no likelihood of confusion or cognizable harm has been established. Similarly CRR disputes the suggestion that domain name registrars would have difficulty with string confusion in this case.

In conclusion CRR argues that the Government of Montenegro has failed to meet the high burden to establish string confusion given the many significant differences between the two generic words, their appearance, sound and meaning.

## **Discussion and Findings**

The test for deciding a string confusion objection is whether or not the new gTLD is confusingly similar to an existing top-level domain name. The party filing an objection must establish on a

balance of probabilities that an average, reasonable Internet user will be confused by the similarity in the proposed and existing domain names.

In deciding this case I am not assisted in any measurable way by references to United States trademark jurisprudence. This is not a case in which I am asked to consider the difference for example between Col. Sanders and Col. Saunders. There is relevance however to whether or not a party is attempting to ride on the coattails of another party that already has a designation for a top level domain name and for which it has invested time and money in promoting the domain name.

I have no reason to suspect that the Applicant is attempting to capitalize on the .ME string. The Applicant has a legitimate business purpose for promoting the .MEME string. There is no ostensible reason for the Applicant to try to take advantage of the existing .ME string.

I find that there is no probability of confusion in the mind of the average, reasonable Internet user in distinguishing between the .ME and .MEME strings. I do not accept the Applicant's position that the average reasonable Internet user should be considered to be a sophisticated user though I do accept that the average Internet consumer is sophisticated enough to distinguish between .ME and .MEME in making an on-line purchase.

I am satisfied that any inadvertent duplication of the .ME string by an Internet user typing the letters ME twice would immediately be recognized as a mistake. I am also satisfied that there is a significant difference between the two strings and that the term "meme" has a recognized meaning.

I am not satisfied that use of the .MEME string will deceive or cause confusion in the mind of the average, reasonable Internet user. I am also not convinced that inclusion of the two letter ME country designation for Montenegro in the MEME string violates the prohibition against applications for strings that are country or territory based.

Application of the String Similarity Assessment Tool (SWORD) is not determinative of the issue in the case at hand. There may be a degree of similarity in that the .ME string and .MEME string use the same letters but there is little objective similarity between the terms ME and MEME.

While I have no basis upon which to conclude that Google, the parent of CRR, will not favor the term "meme" in search algorithms neither do I have any reason to suspect Google of bad faith or to suspect that CRR is acting in any way in bad faith in applying for the .MEME string.

There will always be a danger of fraudulent phishing schemes that seek to take advantage of any similarity between the .ME and .MEME strings but I am confident that the average, reasonable Internet user is alive to very frequent attempts to perpetrate fraud on the Internet and will be vigilant to ensure that they are not taken in.

The Government of Montenegro has made significant investments in the .ME string. There is no reason to believe that those investments will be jeopardized by acceptance of the application herein for the .MEME string. The average reasonable Internet user will recognize that a two

letter string is often a country or territorial designation and that the .ME string is logically associated with Montenegro.

**Determination**

For these reasons the Applicant has prevailed and the Objection is dismissed.

Dated: August 9, 2013

A handwritten signature in black ink, appearing to read 'Murray Lorne Smith', with a stylized flourish at the end.

Murray Lorne Smith

Sole Expert Panelist