

**International Centre for Dispute Resolution**

**New gTLD String Confusion Panel**

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Re: 50 504 00273 13

COMMERCIAL CONNECT, LLC, OBJECTOR

and

DOT-SALE, LLC, APPLICANT

String: <.SALE >

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**EXPERT DETERMINATION**

**The Parties:**

The Objector is Commercial Connect, LLC and is represented by Jeffrey S. Smith, 1418 South 3<sup>rd</sup> Street, Louisville, KY 40208 USA.

The Applicant is Dot-Sale, LLC and is represented by Edward A. White, 21700 Oxnard Street, Suite 400, Woodland Hills, CA 91367 USA, and by Daniel Frohling, Loeb & Loeb LLP, 321 North Clark Street, Suite 2300, Chicago, IL 60654 USA and Melanie Howard, Loeb & Loeb LLP, 10100 Santa Monica Blvd., Suite 2200, Los Angeles, CA 90067 USA.

**The New gTLD String Objected To:**

The new gTLD string applied for and objected to is: **.sale**

**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:**

By letter dated March 18, 2013, the International Centre for Dispute Resolution (“ICDR”) acknowledged receipt of the Objection. ICDR subsequently found certain administrative deficiencies in the Objection and gave Objector an opportunity to correct these. By letter dated April 11, 2013, ICDR found the earlier deficiencies rectified, and registered the Objection for processing. By letter dated April 17, 2013, ICDR directed Applicant to file its Response to the Objection. Applicant timely filed its Response to the Objection on or about May 16, 2013. By letter dated May 24, 2013, ICDR acknowledged timely receipt of the Response to the Objection and determined that the Response complied with Article 11 of the *New gTLD Dispute Resolution Procedure* and the applicable Dispute Resolution Service Provider (“DRSP”) Rules. By letter dated June 18, 2013, ICDR appointed the undersigned to serve as the neutral expert (“Expert”) in this matter.

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

Objector is a gTLD applicant for: .shop. Objector has standing to make its Objection pursuant to Module 3 of the ICANN gTLD Applicant Guidebook on the grounds of String Confusion.

### **Factual Background:**

Applicant has applied for the potential .sale gTLD. Objector has applied for the potential .shop gTLD.

### **The Parties’ Contentions:**

**Objector:** Objector contends that the gTLD (“.sale”) filed by Applicant so nearly resembles the “.shop” gTLD that it is probable that confusion will arise in the mind of the average, reasonable internet user because the “.sale” gTLD application is similar either visually, aurally, or has a similar meaning.

**Applicant:** Applicant contends that the Objection has failed to demonstrate the high level of similarity required by applicable ICANN guidance to show probable confusion and to prevail on the Objection. Applicant contends that, in fact, the Objection fails to demonstrate

any similarity between the strings at issue here and, indeed, does not even name the specific string to which the Objection is made or offer any plausible demonstration of why the particular strings in dispute are allegedly likely to deceive or cause confusion. Applicant also contends that “.sale” is not likely to be confused with “.shop” because both terms are generic, and neither is a brand, a distinctive term or even a merely descriptive term. Applicant also contends that the two strings in dispute are not visually, phonetically or aurally similar, that they do not have identical meanings and that they are unlikely to be confused by an average internet user. Finally, Applicant contends that the Objection was submitted for an improper purpose – constraining the choices and options available to internet users – rather than as a legitimate attempt to prevent confusion among such users.

**Discussion and Findings:**

Based on the record presented, I make the following findings concerning this dispute:

Objector has failed to demonstrate it is probable that Applicant’s proposed gTLD “.sale” will cause a likelihood of confusion to arise in the mind of the average, reasonable internet user as specified in the ICANN *gTLD Applicant Guidebook*, Module 3, Section 3.5.1. Objector also failed to demonstrate either that internet users will be unable to distinguish between the gTLD’s “.shop” and “.sale” when using the internet, or that they will be confused into believing that these two gTLD’s are either the same or interchangeable.

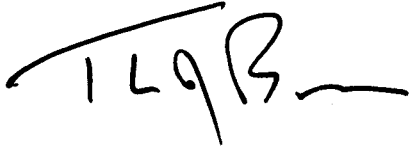
More specifically, the Objection failed to demonstrate that the “.shop” and “.sale” gTLD’s are visually similar, phonetically or aurally similar, or that they have the same meanings. Rather, Applicant demonstrated persuasively that the two terms are both visually and phonetically dissimilar. Objector substantially undercut its own contention that the two gTLD’s have the same meanings by failing to even identify or discuss the “.sale” TLD in its presentation of the Objection. In addition, Objector listed 19 words that allegedly have a similar meaning to .shop, but none of the words listed included “.sale” or any similar variants of that term. As presented, the Objection failed to demonstrate that the two gTLD’s convey confusingly similar meanings or that reasonable internet users are likely to be confused by them.

For these reasons, I find that Objector failed to satisfy the standard required by applicable ICANN guidance to establish a probability of string confusion.

**Determination:**

**Therefore, the Applicant has prevailed and the Objection is dismissed.**

DATED this 15<sup>th</sup> day of August, 2013

A handwritten signature in black ink, appearing to read 'TLQB' followed by a horizontal flourish.

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Thomas J. Brewer

Sole Expert Panelist