

EXPERT DETERMINATION LEGAL RIGHTS OBJECTION

United States Postal Service v. Charleston Road Registry Inc.
Case No. LRO2013-0045

1. The Parties

The Objector/Complainant (“Objector”) is United States Postal Service of Washington, D.C., United States of America represented by Lewis and Roca LLP, United States.

The Applicant/Respondent (“Respondent”) is Charleston Road Registry Inc. of Mountain View, California, United States represented by Steptoe & Johnson LLP, United States.

2. The applied-for gTLD string

The applied-for gTLD string is <.mail>.

3. Procedural History

The Legal Rights Objection (“LRO”) was filed with the WIPO Arbitration and Mediation Center (the “WIPO Center”) on March 13, 2013 pursuant to the New gTLD Dispute Resolution Procedure (“the Procedure”).

In accordance with Article 9 of the Procedure, the WIPO Center has completed the review of the Objection on March 26, 2013 and has determined that the Objection complies with the requirements of the Procedure and the World Intellectual Property Organization Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections (the “WIPO Rules for New gTLD Dispute Resolution”).

The WIPO Center received a proposal from Objector to consolidate the LRO Objections LRO2013-0043 to LRO2013-0048 on April 25, 2013. Respondent expressed opposition to aspects of Objector’s consolidation proposal. In accordance with Article 12 of Procedure and Paragraph 7(d) of the WIPO Rules for New gTLD Dispute Resolution, the WIPO Center did not make a decision to consolidate the referenced LRO Objections for purposes of Article 12(b) of the Procedure.

In accordance with Article 11(a) of the Procedure, the WIPO Center formally notified Respondent of the Objection, and the proceedings commenced on April 18, 2013. In accordance with Article 11(b) and relevant communication provisions of the Procedure, the Response was timely filed with the WIPO Center on May 17, 2013.

The WIPO Center received an unsolicited supplemental submission from Objector on May 29, 2013, and on May 31, 2013, Respondent transmitted an unsolicited supplemental submission in opposition to Objector's unsolicited submission of May 29, 2013.

The WIPO Center appointed Michael A. Albert as the Panel in this matter on June 14, 2013. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the WIPO Center to ensure compliance with Article 13(c) of the Procedure and Paragraph 9 of WIPO Rules for New gTLD Dispute Resolution.

On July 10, 2013, Objector submitted a request for Oral Argument. This request was denied by the Panel on July 12, 2013.

4. Factual Background

Objector, the United States Postal Service, is the owner of more than 240 registered trademarks involving the word "mail," including U.S. MAIL (the "U.S. MAIL Marks"). Variants within the U.S. MAIL Marks have been in use since 1819. Objector has been the official United States postal system provider continuously since that time. Objector has provided a representative list of trademark registrations in the U.S. MAIL Marks.

Objector provides registrations for a large number of marks within the U.S. MAIL Marks. See Objection Annex 2. The earliest registration provided by Objector is on the Principal Register of the United States Patent and Trademark Office (USPTO) for the word mark EXPRESS MAIL, registration number 2,194,853, registration date October 13, 1998, for "delivery services, namely, delivery of letters and goods by mail." Objector also provides various international registrations of mail-related marks, including registration number 864350 on the International Register of Marks for EXPRESS MAIL, registered January 25, 2005.

Respondent is an American subsidiary of Google Inc., an American corporation focused on the provision of various Internet-related services including email. Respondent applied to register the gTLD <.mail> with the intention of providing mail-related domain names to registrants seeking mail-related domain names for their email services.

5. Parties' Contentions

A. Objector

Objector alleges that the term "mail" has a source-indicative meaning, and is understood by United States consumers and many other worldwide consumers to refer to the United States Postal Service. In support of this contention, Objector provides (1) survey evidence that United States consumers asked for a definition of "mail" responded with terms suggesting the United States Postal Service; and (2) dictionary definitions showing that the primary definition of "mail" refers to "material sent or carried in the postal system" or to "a nation's postal system," and only includes "e-mail" as a secondary or tertiary definition if at all. Objector also notes that it has a statutory monopoly on the delivery of "mail" within the United States. See 39 C.F.R. § 310.2(a).

Objector argues that because "mail" is understood to refer to a traditionally governmental service, consumers are likely to view <.mail> as a source-indicative gTLD like <.gov> or <.post> (particularly because "mail" and "post" are synonyms), and will assume that the <.mail> gTLD is affiliated with Objector.

Objector alleges that the <.mail> gTLD will create an impermissible likelihood of confusion with its U.S. MAIL Marks. Objector argues that this confusion will cause consumers to incorrectly assume similar levels of privacy and security between Objector's services and any email services available at <.mail> addresses, that

it will allow third parties to register domain names identical or confusingly similar to Objector's U.S. MAIL Marks, and that it will harm Objector's reputation by increasing the risk of fraudulent or criminal activity. Objector argues that the registration of the <.mail> gTLD will interfere with the legitimate exercise of its trademark rights by allowing third-party registration of infringing domain names, promoting fraudulent activity and thereby tarnishing Objector's marks, limiting its own access to domains incorporating the word "mail", and allowing third-party dilution of the U.S. MAIL Marks.

Objector notes that Respondent does have rights in several marks involving the word GMAIL (the "GMAIL Marks") and that consumers may recognize Respondent's affiliation with the GMAIL Marks, but argues that the addition of the "g" and use of <.com> as a TLD suffice to distinguish that usage from the proposed gTLD at issue here. Objector does not object to Respondent's attempt to register the <.gmail> gTLD.

B. Respondent

Respondent argues that an analysis of the similarity between the <.mail> gTLD and Objector's U.S. MAIL Marks must focus on the overall commercial impression rather than merely on the word "mail," which Respondent argues is a generic, commonly-used English word. Respondent notes that Objector has consistently disclaimed the word "mail" in its USPTO trademark registrations and argues that Objector itself uses the word "mail" in a generic sense in its publications.

Respondent asserts that consumers view gTLDs as content indicators related to the generic meaning of the gTLD, rather than source indicators.

Respondent argues that the proposed gTLD is distinct from Objector's marks in appearance, sound, and commercial impression in that Objector's marks have different suffixes and prefixes than the proposed gTLD.

Respondent asserts that consumers do not associate the word "mail," standing alone, with Objector. Respondent argues that dictionary definitions show the word "mail" to mean "the transmission of messages," including email.

Respondent concedes that Objector has trademark registrations acquired and used in good faith, but argues that they do not allow Objector to protect the word "mail" in isolation. Respondent argues that under United States trademark law, words with a generic meaning cannot be appropriated as trademarks on that meaning.

Respondent argues that its intent in applying for the gTLD was the good faith provision of domain names for email services, which cannot directly compete with Objector's postal system. Respondent argues that the use of a generic term in its generic sense cannot interfere with Objector's rights in its mark. Respondent further argues that it has promised to adopt rights protection mechanisms and anti-abuse policies to minimize the risk of infringing or interfering use of its gTLD, and its parent company Google has a history of respecting mark rights and providing mechanisms for their enforcement.

Respondent argues that precedent indicates that gTLDs are not source indicators, and that Respondent was therefore under no obligation to conduct a search for potentially infringed trademarks before attempting to register the gTLD.

Respondent asserts that it has not engaged in a pattern of registering TLDs which are identical or confusingly similar to marks owned by others.

Respondent argues that its own rights in the <.mail> string should be weighed neutrally, given the fact that it is using a generic term in its generic sense.

Respondent argues that the <.mail> gTLD would not create a likelihood of confusion with the U.S. MAIL Marks even if the term "mail" were not generic. In support of this conclusion, Respondent argues that 1) Objector's U.S. MAIL Marks are entitled to a limited scope of protection because Objector disclaimed the

word “mail”; 2) their goods and services are not related; 3) the marks are not similar as viewed in the marketplace; and 4) Respondent is applying for the gTLD in good faith and intends to implement appropriate rights protection mechanisms.

6. Discussion and Findings

A. Preliminary Issue: Identifying the Relevant Legal Rights

Section 3.2.1 of the gTLD Applicant Guidebook (“the Guidebook”) identifies four grounds on which formal objections may be filed to challenge new gTLD applications: (1) string confusion; (2) existing legal rights; (3) limited public interest; and (4) community. The Guidebook identifies two types of existing legal rights objections: (a) infringement of an objector’s legal rights in a trademark; or (b) infringement of an objector’s legal rights in an intergovernmental organization (“IGO”) name.

The Guidebook sets forth eight non-exclusive factors to consider when evaluating a legal rights objection based on trademark rights. The eight factors analyze various aspects of an objector’s mark or an applicant’s use of and/or rights in the sign corresponding to the gTLD. The eight factors do not refer to any rights belonging to an objector other than its trademark rights.

Objector filed the Objection based on the ground of existing legal rights in its U.S. MAIL Marks, pursuant to Section 3.5.2 of the Guidebook. Objector alleged it owns over 240 trademark registrations for marks that include “mail” and identified 21 exemplary registrations. Because Objector focused its arguments on the U.S. MAIL mark in its brief, the Panel focuses its decision on that mark and treats it as representative of Objector’s marks.

Objector raises two arguments that concern issues not relevant to a Section 3.5.2 challenge. First, Objector contends that the public associates “mail” with the USPS. However, Objector nowhere claims that it possesses trademark rights in the standalone term “mail.” To the contrary, Objector routinely disclaimed “mail” when registering its U.S. MAIL Marks (see *e.g.*, Reg. Nos. 4,031,772; 3,435,895; 3,796,195; 3,898,915; 2,194,853; 2,247,552; 2,295,193; 1,094,739; and App. No. 85867833). Because Objector does not claim to possess trademark rights in the standalone term “mail,” any association by the public between the USPS and the term “mail” is not relevant to evaluating the Objection.

Second, Objector cites as evidence of the alleged association between the USPS and “mail” several dictionary definitions of “mail.” The definitions describe materials carried in “the postal system” or refer to “a nation’s postal system” itself. Rather than demonstrating that Objector has trademark rights in the term “mail,” these definitions suggest that “mail” is simply a generic term for any national postal system, which, in the United States, happens to be Objector. But the fact that Objector has a legal monopoly over delivering mail in the United States does not give Objector a linguistic monopoly over the common noun “mail.” By analogy, although the phrase “President of the United States” refers (at any given time) to a single individual, that individual does not for that reason own trademark rights in the common noun “president.” Likewise, the USPS’s legal monopoly over the delivery of physical mail within the United States does not give it trademark rights in the common noun “mail.”

In sum, Objector’s arguments regarding an association between “mail” and the USPS appear to be an attempt to tacitly claim the standalone term “mail” as one of Objector’s marks. Yet Objector has not argued that it owns such a mark; indeed, it has disclaimed rights in the word “mail.” Because Objector has not asserted trademark rights in “mail,” and because the only rights of Objector that are relevant to a legal rights objection under Section 3.5.2 are trademark rights, Objector’s arguments are inapposite.

B. Analysis of Trademark Rights in Light of the Eight Non-Exclusive Factors

The Guidebook, Section 3.5.2, identifies eight non-exclusive factors that are relevant to evaluating a legal rights objection based on trademark rights. For the following reasons, the Panel finds that these factors favor Respondent.

i. Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound, or meaning, to the objector's existing mark.

The first factor concerns the degree of similarity between the applied-for gTLD string, <.mail>, and the existing marks of Objector, in particular the U.S. MAIL mark. This mark differs from the applied-for gTLD in several substantial respects. For one, the terms begin with different letters, and thus the distinction between the two is particularly noticeable. Visually, the addition of the "U.S." characters increases the length of the string. These characters add two syllables compared to "mail" alone, tripling the syllables and generating different sounds. Most importantly, the addition of "U.S." significantly changes the meaning of the expression, narrowing it to refer only to "mail" affiliated with the United States (or, if compared to marks like MEDIA MAIL or EXPRESS MAIL, to refer only to specific mail services).

The first factor raises the question whether the dot (".") in <.mail> should be considered in assessing the similarity between the <.mail> gTLD and the U.S. MAIL Marks. A previous LRO panel held that the presence of the "." prefix is not sufficient to eliminate the likelihood of confusion between otherwise identical strings of letters. *Express, LLC v. Sea Sunset, LLC*, WIPO Case No. LRO2013-0022. Here, regardless of whether the presence of the "." prefix itself can distinguish the proposed gTLD from Objector's marks, the meaning of "mail" differs significantly across the physical and digital contexts that Objector and Respondent occupy, respectively. Though the primary meaning of "mail" and "U.S. Mail" might both involve a national postal service, ".mail" more likely refers to mail within a digital context, or email. Accordingly, the digital context of the gTLD affects the meaning of the word "mail", and suggests a lower degree of similarity between the U.S. MAIL Marks and the gTLD.

In addition, Objector argues that the string ".email" would be distinctive enough to "avoid confusion with Objector's registered marks" involving the word "mail." Given this argument that the addition of the prefix "e" to "mail" creates an obvious distinction, it is difficult to see how the addition of the prefix "U.S." or "Express" to "mail" does not create a similarly obvious distinction.

This factor weighs in favor of Respondent.

ii. Whether the objector's acquisition and use of rights in the mark has been *bona fide*.

Both parties appear to agree that Objector has acquired and used in good faith its rights in the U.S. MAIL Marks. This factor is not decisive when the dispute centers on the scope and potential generic nature of an objector's mark, however. See *Express, LLC v. Sea Sunset, LLC*, WIPO Case No. LRO2013-0022 (rejecting objection despite finding of *bona fide* acquisition and use of rights by Objector).

Though it has relatively slight weight, this factor favors Objector.

iii. Whether and to what extent there is recognition in the relevant sector of the public of the sign corresponding to the gTLD, as the mark of the objector, of the applicant or of a third party.

The third factor involves the level of public recognition of the sign corresponding to the gTLD – here, "mail" or ".mail" – as the mark of Objector. Objector argues that the word "mail" has source-indicative meaning to consumers. As noted above, however, dictionary definitions suggest that the association between "mail" and the USPS is a reflection of Objector's legal monopoly on the delivery of mail. Because Objector is by law the only postal service in the United States, the public's association of "mail" and the postal service may simply indicate the descriptive nature of "mail." Objector has not provided evidence that would overcome this

ambiguity, *i.e.*, whether the association exists because “mail” functions as an indication of source or rather because Objector is the only game in town.

Even assuming that Objector’s evidence showed strong source-indicative meaning, it is far from clear that such source-indicative meaning would constitute a “mark” under United States trademark law,¹ or that it would indicate public recognition of the word as a “mark.” Under United States trademark law, generic words are not protectable as trademarks, even with a showing of source-indicative meaning, unless they have also lost their generic meaning. See, *e.g.*, *Blinded Veterans Ass’n v. Blinded American Veterans Foundation*, 872 F.2d 1035, 1039 (D.C. Cir. 1989) (“Because a generic term denotes the thing itself, it cannot be appropriated by one party from the public domain; it therefore is not afforded trademark protection *even if it becomes associated with only one source.*”) (emphasis added); see also *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812 (2d Cir. N.Y. 1999) (finding no trademark protection “as long as the term retains some generic meaning.”); *Am. Online, Inc. v. AT&T Corp.*, 243 F.3d 812, 822, (4th Cir. Va. 2001) (“[T]he repeated use of ordinary words functioning within the heartland of their ordinary meaning...cannot give AOL a proprietary right over those words, even if an association develops between the words and AOL.”).

Objector’s dictionary definitions suggest that “mail” retains a generic meaning, referring to “a nation’s postal system” and to “e-mail” in addition to U.S. consumers’ potential association of the term with Objector’s services. Objector further argues that “mail” and “post” are synonyms, and that “post” usually refers to hard-copy correspondence carried by entities other than Objector. While Objector’s consistent disclaimers of the word “mail” in its trademark applications are not dispositive, they provide additional evidence that the word “mail,” in isolation, is too generic to be protected. Objector’s legal monopoly as a mail carrier within the United States does not appear to have granted it a linguistic monopoly on use of the word “mail.”

At most, a competitor who uses a generic word with source-indicative meaning to describe its product may be forbidden to pass its product off as the original product. See *Blinded Veterans Ass’n*, 872 F.2d at 1038 (“[A] subsequent competitor cannot be prevented from using the generic term to denote itself or its product, but it may be enjoined from passing itself or its product off as the first organization or its product.”). However, Objector has not demonstrated that consumers who interact with email addresses involving the <.mail> string would believe that Objector regulates or owns the gTLD. Indeed, as discussed above, the difference in meaning of the word “mail” in the digital and physical contexts gives the “.” prefix special relevance for this Objection. In particular, Objector provides no evidence that the relevant sector of the public recognizes “mail” as source-indicative in the context of Internet-related “mail” services. Accordingly, “passing off” is not a factor here.

Furthermore, Objector’s evidence of source-indicative meaning is limited to the United States. Respondent has presented evidence that postal services around the world use the word “mail” to refer to any hard-copy correspondence shipped through a postal service, as well as evidence of extensive registration of mail-related trademarks by parties other than Objector. Objector’s own evidence thus suggests that the relevant sector of the public for email-related services using the <.mail> string includes individuals outside the United States who use the word “mail” to describe various services and forms of correspondence. This broad use of “mail” to describe various postal systems around the world suggests that public recognition of “mail” as a source indicator within the United States may simply reflect Objector’s legal monopoly on mail delivery within the United States, rather than public recognition of the word as Objector’s mark.

Finally, Factor 3 raises a procedural issue. Objector did not produce evidence that the <.mail> gTLD was publicly recognized as a mark of Objector’s. Respondent noted this in its Response. Objector then filed supplemental papers that included survey evidence allegedly showing an association between “mail” and Objector. Objector offers no justification for the delay. Objector’s untimely submission deprives Respondent of the opportunity to respond. The Panel therefore does not rest its decision on any evidence in Objector’s

¹ Because both parties are located within the United States, the application of United States trademark principles is appropriate.

supplemental filing. But even if the Panel were to consider the supplemental submission it would not change the Panel's conclusions. As with much of Objector's other evidence, the survey does not adequately distinguish between descriptive and source-indicative uses of the gTLD <.mail>. Separately, Objector's survey appears to rely on a potentially questionable method of coding responses. For example, all references to hard-copy mail appear to have been counted as unambiguous source-indicative references to Objector. See, e.g., Supplemental Filing at 51, 95 (Response 100013, "Letters," coded as "Clear USPS mention[] and nothing else"). This over-inclusive treatment is not sensitive to descriptive uses of "mail."

This factor favors Respondent.

iv. Applicant's intent in applying for the gTLD, including whether the applicant, at the time of application for the gTLD, had knowledge of the objector's mark, or could not have reasonably been unaware of that mark, and including whether the applicant has engaged in a pattern of conduct whereby it applied for or operates TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others.

Respondent argues that the registration of a gTLD creates no obligation to search for trademarks, because gTLDs have no source-indicative significance as a matter of settled authority. In the context of an LRO, however, Respondent's reliance on this precedent is misplaced. While gTLD strings have not historically indicated source, the registration of new gTLD strings has created new opportunities for the use of gTLDs as trademarked source indicators. See, e.g., *Defender Security Company v. Charleston Road Registry Inc.*, WIPO Case No. LRO2013-0032 ("[I]t is possible that new gTLDs with more general dictionary meaning may appropriately form part of any assessment of the legal status in trademark terms of such domain or registrations made therein."); see also *Right At Home v. Johnson Shareholdings, Inc.*, WIPO Case No. LRO2013-0030 ("The .RIGHTATHOME gTLD is intended to be one of those .BRAND gTLDs, with the goal of protecting SC Johnson's online presence and identity.").

Given the extensive worldwide history of Objector's use of the U.S. MAIL Marks, the Panel finds that Respondent was or ought to have been aware of Objector's rights in those marks. In a case involving a good-faith dispute over the scope of the rights of an objector in a commonly used word, however, knowledge of the mark does not appear to carry significant weight. See, e.g., *Express, LLC v. Sea Sunset, LLC*, WIPO Case No. LRO2013-0022 (rejecting objection despite Respondent's knowledge of mark). Objector does not argue that Respondent applied for the <.mail> gTLD in bad faith, or for other TLDs confusingly similar to the marks of others, or that it has any history of registering domain names that are confusingly similar to the marks of others. Accordingly, while Respondent cannot seriously be assumed to have been ignorant of the U.S. Postal Service and its trademarked functions, such knowledge does not *ipso facto* indicate any malevolent intent when choosing a common term such as "mail" as a gTLD, nor has Objector produced any evidence of such ill intent (whether in this case or in any past history of Respondent's registrations).

This factor is neutral.

v. Whether and to what extent the applicant has used, or has made demonstrable preparations to use, the sign corresponding to the gTLD in connection with a *bona fide* offering of goods or services or a *bona fide* provision of information in a way that does not interfere with the legitimate exercise by the objector of its mark rights.

Objector acknowledges that Respondent intends to use the <.mail> TLD to offer email-related services, and does not dispute Respondent's technical ability to operate a registry or Respondent's implementation of standard protocols to prevent infringing registrations. Objector's two arguments that such use would interfere with its use of the U.S. MAIL Marks are not persuasive.

Objector first argues that the potential registration of domain names identical or confusingly similar to its registered trademarks would constitute interference, either directly or through dilution or tarnishment. The argument that potentially confusing third-party registrations interfere with the legitimate exercise of trademark

rights has been rejected by previous LRO panels in the circumstances asserted to those panels. See *Right At Home v. Johnson Shareholdings, Inc.*, WIPO Case No. LRO2013-0030 (dismissing such harms as “speculative” and noting that “Objector would have legal recourse” against the third parties if such domain names were registered); see also *Express, LLC v. Sea Sunset, LLC*, WIPO Case No. LRO2013-0022 (“Respondent’s intended use of the <.express> gTLD may heighten risk that third parties will seek to register domain names that are likely to create a likelihood of confusion. The prospective presence of such risk is not a sufficient basis to deny Respondent the ability to secure the <.express> gTLD.”).

Objector also argues that Respondent’s <.mail> gTLD would limit Objector’s theoretical access to domains and email addresses containing the word “mail.” Objector does not challenge Respondent’s statement (which this Panel credits and expressly relies upon) that Respondent will implement standard trademark protection procedures, allowing it to reclaim any domain names confusingly similar to Objector’s trademarks. The inability to register all possible mail-related domains at will, regardless of their similarity to Objector’s trademarks, does not constitute an interference with Objector’s trademark rights.

This factor therefore favors Respondent.

vi. Whether the applicant has marks or other intellectual property rights in the sign corresponding to the gTLD, and, if so, whether any acquisition of such a right in the sign, and use of the sign, has been *bona fide*, and whether the purported or likely use of the gTLD by the applicant is consistent with such acquisition or use.

Objector acknowledges that Respondent owns several marks containing the term “mail,” the GMAIL Marks, and does not dispute that the acquisition of these rights has been *bona fide*. The Panel notes that both Objector and Respondent own registered trademarks consisting of “mail” and a prefix or suffix. If, as Objector implies, it has rights relevant to the string <.mail>, Respondent would also have such rights. Respondent, however, argues that its use of part of Objector’s mark involves a generic word used descriptively, giving this factor little weight.

Though it has only slight weight, this factor favors Respondent..

vii. Whether and to what extent the applicant has been commonly known by the sign corresponding to the gTLD, and if so, whether any purported or likely use of the gTLD by the applicant is consistent therewith and *bona fide*.

As discussed above, this factor has little weight, given Respondent’s argument that it is using a generic word descriptively. However, Objector concedes that Internet users may recognize the GMAIL Marks as associated with Respondent.

This factor is neutral.

viii. Whether the applicant’s intended use of the gTLD would create a likelihood of confusion with the objector’s mark as to the source, sponsorship, affiliation, or endorsement of the gTLD.

This factor raises two questions. First, the parties dispute whether consumers are likely to view the <.mail> gTLD as an indication of source or sponsorship at all. Second, if consumers are likely to view the <.mail> gTLD as an indication of source or sponsorship, this factor asks whether Respondent’s intended use of the gTLD would cause a likelihood of confusion between the gTLD and Objector’s mark. This Panel finds that the <.mail> gTLD may be viewed as a source indicator, but that it is unlikely to create a likelihood of confusion with Objector’s U.S. MAIL Marks.

To confuse consumers as to source or sponsorship, the <.mail> gTLD must presumably be viewed by consumers as an indicator of source or sponsorship. Neither Respondent nor Objector presents compelling evidence on this point. Respondent’s argument that gTLDs are not seen as source indicators as a matter of

law is not applicable in the LRO context, as discussed above. On the other hand, Objector's argument that consumers view <.gov> as a source indicator and will therefore view <.mail> similarly is also inapplicable. As Objector itself explains, <.gov> is regulated and is "known by the public to be regulated." Objector presents no evidence that public impression of <.gov> as a source indicator arises from its association with an "essential government function" rather than from the fact that the <.gov> domain is, in reality, a source indicator. From the evidence presented, it is not possible to determine whether the public will view <.mail> as an indicator of source or sponsorship at all.

Even if consumers view the <.mail> gTLD as a source indicator, however, Objector has not shown a likelihood of confusion between the intended use of the <.mail> string and Objector's marks. As discussed above, Objector does not have trademark rights in the word "mail," which retains generic meaning as a term relating to any postal system and any system of email. Under United States trademark law, very little weight is given in the analysis of confusing similarity to generic terms used in their generic sense. See, e.g., *Banff, Ltd. v. Federated Dep't Stores, Inc.*, 841 F.2d 486, 491 (2d Cir. N.Y. 1988) ("The long-standing view that the *nongeneric components* of a mark must be compared in the context of the overall composite mark... remains the rule in this Circuit.") (emphasis added); *American Cyanamid Corp. v. Connaught Laboratories, Inc.*, 800 F.2d 306, 308 (2d Cir. N.Y. 1986) ("[A] trademark infringement finding thus cannot be based on the use of a generic or descriptive term."); cf. *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 21 (1st Cir. Mass. 2008) ("[T]rademark law ... is not intended to prevent confusion between two similar, generic marks, or, relatedly, between marks when one mark has acquired a 'de facto secondary meaning' through its exclusive use of a generic term that causes customers to associate the term with that specific source.") (internal citations omitted).

Consistent with United States law, previous LRO decisions have held that the use of a common English word generically or descriptively weighs against—or entirely rules out—a finding of a likelihood of confusion. See, e.g., *I-REGISTRY Ltd v. Vipspace Enterprises LLC*, WIPO Case No. LRO2013-0014 ("Respondent's intended use of the gTLD will lead to the gTLD being seen first and foremost as a descriptive term describing the purpose and characteristics of the domain... The Panel does not believe that confusion with the Objector's mark is likely."); *DotTunes Limited v. Amazon EU S.a.r.l.*, WIPO Case No. LRO2013-0065 ("Given the generic nature of the sign and the limited use of the Objector's mark, the Panel finds that there is little or no likelihood of confusion."); *Defender Security Company v. Charleston Road Registry Inc.*, WIPO Case No. LRO2013-0032 ("Respondent's intended use of the new gTLD <.home> would not create a likelihood of confusion... since Respondent intends to use the sign corresponding to the New gTLD in its generic sense.").

Finally, as discussed above, the context in which Respondent intends to use the mark makes confusion as to source even less likely. A consumer viewing the string <.mail> in the context of a domain name registration or an email address is presumably even more likely to think of the electronic ("email") meaning, rather than the postal meaning, of the term "mail," and thus not to associate it with Objector's services.

This factor weighs in favor of Respondent.

7. Decision

Of the Guidebook's eight factors for evaluating trademark rights, five favor Respondent (including one slightly), one favors Objector (but only slightly) and two are neutral. While the test is not a numerical one, it is instructive that Objector finds little to no support in any of the eight factors. For the foregoing reasons, the Panel finds that Respondent's <.mail> gTLD application uses a generic term in its generic sense, and is not confusingly similar to Objector's U.S. MAIL Marks in the context in which it will be viewed in the marketplace. Given these findings, the Panel finds that the potential use of the applied-for gTLD by Respondent does not:

- (i) take unfair advantage of the distinctive character or the reputation of Objector's U.S. MAIL Marks, or

- (ii) unjustifiably impair the distinctive character or the reputation of Objector's U.S. MAIL Marks, or
- (iii) otherwise create an impermissible likelihood of confusion between the <.mail> gTLD and Objector's U.S. MAIL Marks.

For the above reasons, the Panel rejects the Objection.

[signed]

Michael Albert
Sole Panel Expert
Date: July 25, 2013