

INTERNATIONAL CENTRE FOR DISPUTE RESOLUTION

NEW gTLD String Confusion Panel

Re: 50 504 T 00216 13

VERISIGN, INC., Objector

and

ELECTRONIC MEDIA NETWORK
LIMITED, Applicant

<String: .MNET>

EXPERT DETERMINATION

The Parties

The Objector is VeriSign, Inc. (“VeriSign” or “Objector”) and is represented by Thomas C. Indelicarto, Vice President and Associate General Counsel of VeriSign.

The Applicant is Electronic Media Network Limited (“M-Net” or “Applicant”) and is represented by Deborah M. Lodge of Patton Boggs LLP.

The New gTLD Objected To

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

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 (“Guidebook”) contains Objection Procedures and the New gTLD Dispute Resolution Procedures (“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

M-Net filed its New gTLD Application for string .mnet. VeriSign timely filed and served its String Confusion Objection dated March 13, 2013 (“Objection”). M-Net thereafter filed and served its Response to String Confusion Objection (“Response”). The undersigned was appointed as Expert. (ICDR letter to the parties and their representatives, September 11, 2013) Thereafter the undersigned completed a Notice of Appointment with Supplement thereto, both dated October 24, 2013, which the ICDR sent to the parties requesting any comments by no later than November 4, 2013. (ICDR Email, Oct. 28, 2013) No comments or objections were received.

Basis for Objector’s Standing to Object Based on String Confusion

VeriSign is the existing TLD operator of .net.

Parties’ Contentions

VeriSign contends that .net and .mnet are confusingly similar. It asserts that its .net domain is very strong, unique, well-established and easily and readily recognizable. It contends that the coexistence of .net and .mnet would satisfy the requirement that likelihood of confusion would be probable, and not merely possible, in the minds of average, reasonable Internet users. It contends that they are visually and aurally similar and have similar meanings. VeriSign argues that its commercial strength and marketplace recognition are critical factors, and that the relevant class of users is casual Internet users likely to exercise a low degree of care hence increasing the likelihood of confusion between the two strings. It acknowledges that M-Net’s current intention is to make .mnet a restricted top level domain name, but urges that it is possible M-Net’s business model would change in the future (“potential overlapping marketing channels”) and thus increase the likelihood of confusion. It contends that the declarations of its two experts further support the alleged confusing similarity of the two domain names. VeriSign concludes that the

important similarities in appearance, sound, and meaning establish the probability of confusion.

M-Net contends that in its existing and target market, South and Sub-Sahara Africa, its brand, MNET, is famous, strong and among the most prominent brands in South Africa. It states that .mnet will be a restricted, branded and exclusively controlled domain (“solely as part of its own eco-system”), contrasted to VeriSign’s .net which is an open domain with registration open to anyone. It asserts that consumers in its primary market will immediately associate .mnet with M-Net and its MNET brand and that no confusion will be created or exist. M-Net asserts that VeriSign’s .net TLD is not a significant TLD in South Africa. It contends that the context in which the branded .mnet TLD will be used and the fame and recognition of its MNET brand are key reasons why there is no danger of confusing similarity. It asserts that consumers, and Internet users, in South Africa are very used to, and very adept in, differentiating between various domains, including those with some common letters, and would be likely to exercise a high degree of care in searching for a domain. It also contends that .mnet is not aurally similar to .net due to the common use of “dot” in pronouncing domain names. As to VeriSign’s concern that M-Net may change its business model, M-Net contends and states that “it has no intention of opening this domain up for registration by the public. . . Changing to an ‘open TLD’ model would be fundamentally inconsistent with our business and our intent to reinforce the MNET brand through the .mnet TLD.” M-Net requests that VeriSign’s Objection be dismissed.

Discussion and Findings

Having reviewed and considered the Objection, the Response, and the Declarations of James T. Walsh, Gail Stygall, Joseph Waldron, Patricia van Rooyen and Arthur Goldstruck, the following discussion and findings explain and support my determination.

Based on the parties’ submissions, I find that consumers in M-Net’s primary existing and target market area, South and Sub-Sahara Africa, are not likely to be misled or confused by the coexistence of the .net and .mnet domain names, due largely to the fame and widespread recognition of the MNET brand and VeriSign’s limited presence and market share in that market area, and since .mnet will be a brand-related, restricted domain, contrasted to VeriSign’s .net, an “open” and not branded domain. The extremely high recognition factor, and likely association of .mnet with MNET, in my judgment, render potential confusion very unlikely.

The submissions establish to my satisfaction that the anticipated consumers in South Africa are not casual users who are likely to exercise a low degree of care, but, rather, they are accustomed to differentiating between numerous various domain names including those sharing letters in their designations. While it is true that the two TLD strings share three letters, net, and one string could, by some user, bring the other to mind, “[m]ere association, in the sense that the string brings another

string to mind, is insufficient to find a likelihood of confusion. ("Guidebook, Sec. 3.5.1) I find no likelihood of visual confusion. VeriSign's assertion of aural similarity is also rejected, primarily since "... consumers [typically] include the 'dot' when they pronounce domain names. The .net TLD is not pronounced merely as 'net' – it is pronounced 'Dot Net.' In South Africa, '.mnet' would be pronounced as 'Dot Em' Net' (with the 'em' sound stressed)." (Response, p. 7)

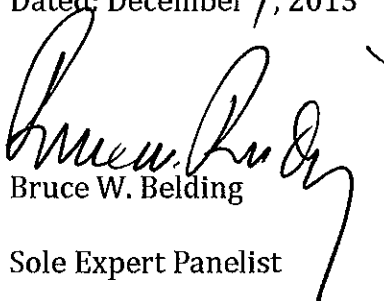
In the appropriate context, i.e., as they are encountered in the marketplace, I find no similarity in context or use. There will be no overlap of marketing channels due to the differences between the two domains arising from their admitted differing registrations (open v. branded and restricted) and requirements. M-Net "has no intention of opening this domain up for registration by the public. It is critical to M-Net's TLD application and to its business that the .mnet domain be a branded, closed TLD (Id., p. 11)

VeriSign has not sustained its burden of proof as required by Section 3.5 of the Guidebook and Article 20(c) of the Procedure to establish likelihood of deception or confusion, or that it is "probable, not merely possible that confusion will arise in the mind of the average, reasonable Internet user." (Guidebook, Sec. 3.5.1)

Determination

The Applicant has prevailed, and the Objection is dismissed.

Dated: December 4, 2013



Bruce W. Belding

Sole Expert Panelist