

International Centre for Dispute Resolution

New gTLD String Confusion Panel

Re: 50 504 T00242 13

COMMERCIAL CONNECT, LLC,

and

SHOP YOUR WAY, INC,

String: TLD: <.shopyourway>

EXPERT DETERMINATION

The parties

The Objector is Commercial Connect, LLC, with its principal place of business at 1418 S. 3rd Street, Louisville, KY 40208, USA and is represented by Jeffrey S. Smith, 1418 S. 3rd Street, Louisville, KY 40208, USA

The Applicant is Shop Your Way, Inc. with its principal base of business at 3333 Beverly Road, Hoffman Estates, Illinois 60179 and is represented by Gretchen Olive, 3333 Beverly Road, Hoffman Estates, Illinois 60179

The New gTLD String Objected To

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

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) as follows: “**(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

Objector has filed a String Similarity Objection.

The Applicant has, in addition to its application, responded to the objections to the Objector.

Both parties have accompanied their presentations with exhibits.

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

The Objector has made an application for .SHOP as a top level domain name and states that it has “made it completely through the approval process” and is “still considered active” but has not “received delegation” for the gTLD .SHOP. *See* Applicant Guidebook, §3.2.2.1.

Parties’ Contentions

Objector

The Objector contends that the .SHOPYOURWAY so nearly resembles the .SHOP string that it is likely to deceive or cause confusion. The Objector does not specifically address the ways in which it contends that .SHOPYOURWAY is likely to cause confusion.

Applicant

Applicant, .SHOPYOURWAY contends that there is a lack of likelihood that the “average, reasonable internet user” would be deceived or confused if both strings should be awarded and delegated by ICANN. Applicant asserts that .SHOPYOURWAY is distinctive and distinguished from the generic term “shop” visually and aurally. Also, Applicant further contends that .SHOPYOURWAY is not similar because is “clearly established in the market and in the mind of internet users as a brand, trademark and membership program associated with Sears Holding Corporation and its affiliated entities.”

Discussion and Findings

The Panel is mandated by Module 3 of the Applicant Guidebook, §3.5.1, to consider whether the applied-for gTLD string is likely to result in string confusion in the mind of the “average, reasonable internet user.” The likelihood of confusion must be probable, not merely possible. The Objector bears the burden of proving that its Objection should be sustained in accordance with the standards. (Attachment to Module 3, New gTLD Dispute Resolution Procedure, Article 20(c)) and Applicant Guidebook §3.5. Thus, the Panel considers whether .SHOPYOURWAY is visually and aurally similar to .SHOP in a way that makes it probable that there is a likelihood of confusion. The Panel finds that, both visually and aurally, the only similarity between the two names is the word “shop” and that .SHOPYOURWAY, containing, as it does, two additional words containing two additional syllables, is not likely to cause confusion between the two names as a visual or aural matter.

With respect to the meaning of the two terms, the Applicant focuses, with respect to the perception of .SHOPYOURWAY, on the extent to which “shop your way” has been a successful customer loyalty program of Sears Holding Company, with a membership “numbering in excess of 8 digits worldwide.” The Applicant asserts that “shop your way” is strongly associated in the minds of users as identifying Applicant’s services and makes an impression that is distinct from the generic term “shop” applied for by Objector.

The Panel is unable to determine the extent to which “shop your way” is so widespread that it has an effect on the mind of the average, reasonable internet user. In any event, the Panel does not consider it necessary that it do so because it regards the name “shopyourway” as having, on its face, a connotation of a sort of individualized shopping experience that is different from the perception that an internet user is likely to have from the word “.SHOP.”

The Panel finds that the Objector has failed to carry its burden of proof that it is probable -- not merely possible -- that confusion will arise as a result of there being two generic top level domains in existence and operation. The Objector has presented no particular reasons as to the alleged confusion that it asserts will exist between .SHOPYOURWAY and .SHOP. Indeed, it makes no specific mention of .SHOPYOURWAY in its Objection.

Determination

Accordingly, the panel rules that the Applicant has prevailed and the Objection is dismissed.

October 1, 2013



Lawrence W. Newman

Sole Expert Panelist