

International Centre for Dispute Resolution
New gTLD String Confusion Panel

Re: 50 504 T00304 13

SX REGISTRY SA BV,
OBJECTOR

and

INTERNET MARKETING SOLUTIONS, LIMITED,
APPLICANT

String: TLD: <.SEX >

EXPERT DETERMINATION

The parties

The Objector is .SX Registry S.X B.V., with its principal place of business at Cruise Terminal Building, Suite No. 1, Pointe Blanche, Sint Maarten. It is represented by Jean-Christophe Vignes, 29 rue de Mogador, Paris 75009, France.

The Applicant is Internet Marketing Solutions, Limited, a company established in the British Version Islands with its principal base of business at Trident Chambers, Wickhams Cay, Post Office Box 146, Road Town, Tortola. It is represented by Jeff Gilroy, Director, and David Taylor, Hogan Lovells, LLP, 17 Avenue Matignon, 75008 Paris, France

The New gTLD String Objected To

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

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, is described in the Procedure 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

The objection was filed on March 13, 2013 and the Applicant/Respondent has, in addition to its application, responded to the objections of the Objector.

Both parties have accompanied their presentations with exhibits.

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

The Objector is an existing TLD operator and has filed a string confusion objection to assert string confusion between the TLD that it currently operates, .SX, and an applied-for TLD, .SEX. See Applicant Guidebook §3.2.2.1.

Parties’ Contentions

Objector

The Objector contends that .SEX is confusingly similar to its TLD, .SX, in both the “technical” and “legal” sense. With respect to the technical sense, the Objector refers to the Levenshtein Distance

between “SX” and “SEX” under which there is only one character (“E”) that has to be deleted to produce “SX.” The Objector also refers to the “commonly used sound algorithm “Soundex,” which, it says “would establish extremely high similarity between ‘SX’ and ‘SEX’ since the vowels are ignored.” The Objector also refers to the ICAAN algorithm, the String Similarity Assessment Tool, which, according to Objector’s Exhibit 6, shows that .SX and .SEX have a 57% similarity.

Objector also refers to the public perception of .SX and .SEX, contending that confusion already exists in the minds of average, reasonable internet users, referring to “anecdotal evidence” that it says shows that .SX “has already been associated with “Sex” and “Sexy” in the media and on the internet.

The Objector also refers to the detrimental effect on the Sint Maarten citizens of allowing .SEX to coexist with .SX. This last point is, however, not within the mandate of this DRSP Panel, which is limited to considering “whether the applied-for gTLD string is likely to result in string confusion.” Applicant Guidebook, §3.5.1.

Applicant

The Applicant addresses the Objector’s string confusion objection in terms of visual or aural similarity and similarity of meaning.

The Applicant contends that the 57% similarity shown by the ICAAN String Similarity Assessment Tool algorithm is “relatively low” and is on a level of similarity that exists between other existing strings and/or applied-for strings, citing as an example the comparison done by the String Similarity Assessment Tool algorithm of .SEX and .SE, the latter being the Sweden country code top-level domain. The Applicant/ points out that, although the test shows that the level of similarity between the .SEX and .SE TLDs is 64%, higher than the 57% level, the Swedish .SE registry has not objected to .SEX as confusing.

The Applicant says that “visually the terms ‘SEX’ and ‘SX’ are different in their structure, features and overall impression” and points out that the difference between the two terms was highlighted

in a ruling by the European Union Office of Harmonization for the Internal Market (“OHIM”), which registers community trademarks in the European Union, in a Ruling on Opposition involving the comparison of the signs “SXTV” and “SEXTV.” (Decision of February 2, 2007, No. B 795 288) The Applicant points to other trademark rulings in which there were found to be significant visual differences in short marks such as “FBI” and “FEBI” and “TCA” and “TECA.”

With respect to the aural comparison of .SEX and .SX, the Applicant contends that .SEX would be most likely pronounced as a single word, where as .SX would invariably have each of its letters pronounced separately. The Applicant refers to decisions of various trademark offices in which there were findings that consumers recognized additional vowels, such as E or I, and pronounced the mark containing such a vowel as a word rather than as initials.

With respect to the conceptual or meaning comparison of .SX with .SEX, the Applicant contends that the public is capable of grasping immediately that “at least one of the signs,” referring to .SEX, has a “clear and specific meaning.” The Applicant states, “whilst certain words can have very distinct meanings, the word SEX is one that has a primary and universally recognized meaning so as to prevent doubts about what the word SEX refers to. In light of this, it is highly unlikely that the average internet user would ever come to believe that SEX has any link to the country code for Sint Maarten.” The Applicant further states that, since the .SX domain has as its purpose the identification of a geographical territory, it seems wholly inappropriate and an attempt at misusing a gTLD for the Objector to “claim some sort of exclusivity or right in relation to the adult entertainment industry.” Accordingly, the Applicant states that “it is abundantly clear that it is far from probable” there will arise in the mind of the average, reasonable internet user any confusion between the two terms SX and SEX because they have “wholly different meanings, leaving no room for confusion.”

Discussion and Findings

The Panel addresses the question as to whether the applied-for gTLD string is “confusingly similar to an existing TLD or to another applied for gTLD string in the same round of applications.” (Applicant Guidebook (§3.2.1) The Panel is directed by the Applicant Guidebook to “consider whether the applied-for gTLD string is likely to result in string confusion, [which] exists where a string so nearly resembles another that it is likely to deceive or cause confusion.” The Guidebook continues: “For a likelihood of confusion to exist, it must be probable, not merely possible, that confusion will arise in the mind of the average, reasonable internet user. Mere association, in the sense that the string brings another string to mind, is insufficient to find a likelihood of confusion.” Applicant Guidebook, §3.5.1.

The Attachment to Module 3 (New gTLD Dispute Resolution Procedure), states, in Article 20(c), that the Objector bears the burden of proving that its Objection should be sustained in accordance with the applicable standards.” *See also*, Applicant Guidebook, §3.5.

Article 21(d) of the new gTLD Dispute Resolution Procedure provides in part, “the Expert Determination shall be in writing, shall identify the prevailing party and shall state the reasons upon which it is based.”

The Panel, applying these standards and instructions, considers whether the Objector has successfully borne the burden of proving that its Objection should be sustained that a string confusion exists between .SX and .SEX in that they so nearly resemble one another that there is likely to be deception or confusion. In doing so, the Panel considers it appropriate for its analysis of whether string confusion exists to analyze the similarity from the point of view of the two terms in question -- visual and aural similarity and similarity of meaning.

Visual Similarity

The Objector asserts that there is a closeness between SX and .SEX, as shown in the Levenshein distance since only the “E” needs to be deleted from SEX to find SX. The Objector fails, however, to

follow up these assertions with reasons that these similarities cause confusion “in the mind of the average, reasonable internet user.” (Applicant Guidebook, §3.5.1) On the other hand, the Panel finds persuasive the Applicant’s argument that the “average, reasonable internet user” will discern a visual difference between .SX and .SEX because the latter term is, in fact, a word and the former term is two initials. This kind of single letter difference has not, as the Applicant points out (its brief, page 4 and Annex 8 thereto), in a number of existing gTLDs and ccTLDs with only a vowel difference, given rise to confusion. These include, for example, .com and .co and .edu and .eu.

Accordingly, the Panel finds that, with respect to visual similarity, the Objector has failed to carry its burden of establishing that it is not merely possible but probable that confusion will exist in the mind of the average, reasonable internet user. There may well be some internet users who will think that the .SX domain relates to sex and visit sites using that TLD, but the probability that such might occur has not been established.

Aural Similarity

The Objector contends that there is a confusing phonetic similarity between the two terms, referring to a finding by Soundex, “one of the most commonly used sound algorithms,” that established an extremely high similarity between SX and SEX “since the vowels are ignored,” but fails to support this contention with the requisite reasons that the average, reasonable internet user would be confused by the way in which the two terms are pronounced.

On the other hand, the Panel finds persuasive the argument of the Applicant that the addition of the vowel “e” to the letters “s” and “x” makes that term a word that will be pronounced in the way in which the English word is pronounced, whereas the term .SX will likely be pronounced as two separate letters and not necessarily as “sex.” Although there may be a possibility that the two terms will be pronounced in a similar way, the Objector has failed to carry its burden of persuasion that there is a probability that there will be such similarity of pronunciation.

Similarity of Meaning

The Objector points out that .SX is “a reputable Domain Name Registry” and further asserts that .SX is widely used in the internet community -- although the Applicant suggests that the .SX registrations referred to by Volkswagen, Air France and Microsoft are “simply defensive registrations.” Response to the String Confusion Objection Against .SEX, paragraph 4.4 (page 9). In any event, the Objector’s arguments concerning the importance of the .SX to Sint Maarten do not address the issues of confusion that are to be dealt with in this dispute.

The Panel finds that the word “sex” has a clear meaning and that, as the Applicant points out, it is highly unlikely that the average, reasonable internet user would believe that .SEX has any connection with the country code for Sint Maarten. There does exist, however, the possibility that the term .SX could have, for some internet users, the possible connotation of “sex” and therefore give rise to expectations of adult entertainment associations with websites that have such a top level domain name. It is more likely than not, however, that the average internet user will regard the letters “SX” as having no clear meaning or many possible meanings, not one of which is manifestly evident. *See*, for example, www.allacronyms.com/sx, where there are 18 definitions for “sx” including symptoms, surgery, space experiments and Sundays excepted.

Accordingly, the Panel finds that the Objector has failed to satisfy its burden of establishing the probability of confusion with respect to the similarity of meaning between .SX and .SEX.

Determination

The Panel therefore determines that the Applicant has prevailed and the Objection is dismissed.

September 17, 2013



Lawrence W. Newman, Sole Expert Panelist