

**Reconsideration Request  
DERCars, LLC**

**Annex A**

*Charleston Road Registry Inc. v. Koko Castle, LLC,*  
ICDR Case No. 50 504 233 13 (7 Aug. 2013)

**International Centre for Dispute Resolution**

**New gTLD String Confusion Panel**

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Re: 50 504 00233 13

Charleston Road Registry, OBJECTOR

and

Koko Castle, APPLICANT

String: < .cars >

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**EXPERT DETERMINATION**

**The parties**

The Objector is Charleston Road Registry, Inc. a corporation incorporated in the state of Delaware, USA with principal place of business in Mountain View, California, USA, represented by Brian Winterfeldt, Esq. who prepared this Objection while at the law firm of Steptoe & Johnson, Washington, D.C. He is now with the law firm Katten Muchin Rosenman LLP in Washington, D.C.

The Applicant is Koko Castle, LLC, a limited liability corporation incorporated in the state of Delaware, USA with principal place of business Bellevue, state of Washington, represented by John M. Genga, Esq. and Don C. Moody, Esq. of the IP & Technology Legal Group, P.C. in Sherman Oaks, California, USA.

**The New gTLD String Objected To**

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

**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” or “DRP”).

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**

The Objection was filed online and in the form of a hard copy Objection with the ICDR on March 13, 2013.

On March 18, 2013 the ICDR sent a letter to the Objector, with copy to the Applicant and/or its representative in this proceeding, acknowledging receipt of its Objection to the gTLD string which Applicant applied for. On April 3, 2013 the ICDR sent the Objector an initial “Proceed” letter stating that the Objection complied with Articles 5 – 8 of the New gTLD DRP and ICDR Rules. On April 17, 2013 the ICDR sent a letter to the Applicant requesting a Response within 30 days. The Applicant submitted its Response in a timely manner.

On June 5, 2013, the ICDR sent a letter to the Applicant stating that there was an administrative deficiency in the Response in terms of its non-compliance with the requirements set forth in Article 11 of the New gTLD DRP and the ICDR Rules. Specifically, the ICDR found non-compliance because the Response was not sent to the proper representative of the Objector. The ICDR therefore requested the Applicant to provide proof or a statement within five days that copies of the Response were sent to the proper representative of the Objector.

On June 11, 2013 the ICDR sent the parties a second “Proceed letter”, noting Applicant’s compliance with its June 5 request and authorizing the continuation of the process following the ICDR’s administrative verification as described above.

The ICDR appointed Paul E. Mason as the Expert Panelist in this matter on July 26, 2013. The Panel finds that it was properly constituted under Article 13(b)(1) of the New gTLD DRP. The Panel has made a statement of acceptance and declaration of impartiality and independence as required by Article 13(c) of the New gTLD DRP and Article 1 of the ICDR Rules.

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

Pursuant to Paragraph 3.2.2.1 of the ICANN Guidebook, two types of entities have standing to object:

- An existing TLD operator may file a string confusion objection to assert string confusion between an applied-for gTLD and the TLD that it currently operates.
- Any gTLD applicant in this application round may file a string confusion objection to assert string confusion between an applied-for gTLD and the gTLD for which it has applied, where string confusion between the two applicants has not already been found in the Initial Evaluation. That is, an applicant does not have standing to object to another application with which it is already in a contention set as a result of the Initial Evaluation.

Charleston Road Registry has applied for the gTLD <.CAR> in the same application round as the Applicant and therefore has standing to object to Applicant’s application for the new gTLD <.CARS>.

## **Factual Background**

The Objector Charleston Road Registry (“CRR”) is an American company wholly owned by Google, Inc. CRR was established to provide internet registry services. According to page 3 of the Objection, “CRR aspires to create unique web spaces where users can learn about products, services and information in a targeted manner and in ways never before seen on the Internet. Its business objective is to manage Google’s gTLD portfolio and Google’s registry operator business.”

The Applicant is Koko Castle, Inc., a subsidiary of Donuts, Inc. which in turn was “founded by long-standing industry executives with experience in registry and registrar operations and industry regulation” and “has applied for more than 300 TLDs...”, as stated on page 3 of the Objection, quoting the website <http://www.donuts.co> and Applicant’s application for <CARS> as posed by ICANN on June 13, 2012. These statements were not contested by the Applicant in its Response to the Objection.

From these statements it appears that both parties have considerable experience with internet registrations.

The Objector CRR filed an application for a new gTLD <CAR> while the Applicant filed an application for a new gTLD <CARS>

## **Parties’ Contentions**

### **Objector**

CRR relies heavily on the type of name similarity analysis used in UDRP cases (trademark holders vs. internet domain name registrants) and makes the following arguments:

- Legions of UDRP decisions have held that addition of the plural letter “s” does not change the meaning of the base word and so renders the singular and plural confusingly similar to each other. U.S. trademark cases and commentators such as Thomas McCarthy are also cited to support this point.

- The strings are also phonetically similar which is also recognized by UDRP panels ruling on so-called “typosquatting” cases.

- In previous gTLD application rounds in 2000, public comments submitted with respect to NameSpace Inc.’s and the MDMA’s applications for singular and plural versions of the same TLD complained that some of these were confusingly similar to each other.

- Finally, CRR refers to alleged difficulty of distinguishing plural from singular for some non-English speakers, especially Koreans.

### **Applicant**

Applicant Koko Castle points to a heavy burden on the Objector to show why a new gTLD application should *not* be granted, because there is a presumption generally in favor of granting new gTLDs. Its primary arguments are the following:

- CRR’s trademark-related arguments are irrelevant because the word “car” is generic and thus incapable of receiving any trademark protection.

- The U.S. trademark law test for confusion also includes other factors besides similarity between terms in dispute. Were these other elements also to be considered, then the Objector should have filed a “legal rights objection” which is a different ground for objection under a different regime than this one.

- ICANN's initial string similarity review tests did not place other singular and plural gTLD applications, such as <.game> and <.games>, in common contention sets.

- ICANN's third-party expert panel found that <.car> and <.cars> were not visually similar to each other. The visual similarity test is much narrower, such as the paradigm <.COM> versus <.COM> using the letter "O" versus the number "zero" in the TLD, or <.unicorn> versus <.unicom> where that panel did place these in the same contention sets.

- As the ICANN initial string similarity review test panel did not find string confusion in this case, the Applicant has the right to an evidentiary presumption in favor of ICANN approval of its application.

- The Objector cannot prove that "Cars" and "Car" are so similar in appearance as to result in likelihood of internet user confusion. To support this contention, Applicant states that the initial ICANN string visual similarity assessment tool yielded a result of only 72% between "car" and "cars". To buttress its case further, Applicant provided a table of so-called "false positives" which are much more different from each other than "car" vs. "cars", where the ICANN string similarity assessment tool yielded much higher scores in the range of 86% ("PRINCES" vs. "PRINCESS") - 94% ("GOOGLE" vs. "GOGGLE").

- "Peaceful Coexistence" for second level domain names: Similar and plural words are used differently more often than not in existing TLDs (e.g. car.com and cars.com). Some 50,886 singular/plural string pairs currently exist which do not point to the same IP address, compared to 1,330 pairs which do.

- Compilations from Alexa Internet show that plural websites function as online businesses independently of their singular name counterparts.

- Singular and plural versions as TLDs are easier to distinguish at the top level than they would be at the second level: <hot.car> vs. <hot.cars> are easier to distinguish than <hotcar.com> vs. <hotcars.com>.

- Objector does not prove an aural similarity between "car" and "cars", as the latter ends with "s" which is distinguishable in pronunciation.

- The terms "car" and "cars" may not have similar meanings because the word "car" has different meanings in French (because), Croatian (emperor), or Serbian (geographic indicator).

- Studies cited by the Objector regarding difficulty of Korean and Francophone speakers to distinguish English singular vs. plural words are not valid because the methodology was not adequately elaborated.

- Even assuming some similarity between "car" and "cars", this does not automatically suffice to find likelihood of confusion. Other applicants have applied for synonyms in gTLDs, such as "<.auto" and "<.autos>".

- Earlier ICANN public comments cited by Objector regarding string confusion in NameSpace's and MDMA's gTLD applications with singular vs. plural names were most likely caused by factors other than singular vs. plural confusion.

- Objector's use of the term "confusingly similar" is inappropriate here because under U.S. trademark law, there is one test for likelihood of confusion and another test for similarity. In contrast, the ICANN "string confusion objection standard *only* takes into account the similarity of the two strings (whereas [*sic*] visual, aural, or in meaning"), citing ICANN Guidebook § 2.2.1.1.3.

## **Discussion and Findings**

Under Paragraph 3.5 of the ICANN Guidebook - "Dispute Resolution Principles (Standards)", the Objector bears the burden of proof in each case.

Paragraph 3.5.1 of the ICANN Guidebook provides the applicable standard on which to rule on these cases:

“3.5.1. String Confusion Objection

A DRSP panel hearing a string confusion objection will consider whether the applied-for gTLD string is likely to result in string confusion. String confusion exists where a string so nearly resembles another that it is likely to deceive or cause confusion. 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.”

The quantum of proof necessary to sustain a string confusion objection is therefore established at the level of probability, not mere possibility.

**A. Identical or Confusingly Similar Strings**

First, the Panel must establish the legal and factual standards to determine whether the strings are identical or confusingly similar to each other.

The UDRP and U.S. trademark cases can be helpful but not determinative. UDRP cases involve rights of trademark holders and also contain obligatory elements of bad faith by domain name registrant respondents. None of these aspects are present in New gTLD String Confusion cases. Trademark law standards do not entirely fit here either, because the Objector’s string <.CAR> is generic and hence ineligible for trademark protection.

The legal standards for burden and quantum of proof have been set forth by ICANN in its Applicant Guidebook, Module 3, Paragraph 3.5 as quoted above.

Applicant has asserted that its application is entitled to an evidentiary presumption of acceptability because it passed through the initial ICANN visual similarity tool tests. This Panel does not accept this argument because the Objection process is an independent review process. However, this Objection process can take into consideration the results of the earlier ICANN visual similarity tool tests.

There is a factual standard involving exactly what is meant by “similarity” found in the ICANN Applicant Guidebook, Module 2, Paragraph 2.2.1.1.3:

“An application that passes the [initial visual] String Similarity review is still subject to objection by an existing TLD operator or by another gTLD applicant in the current application round. That process requires that a string confusion objection be filed by an objector having the standing to make such an objection. **Such category of objection is not limited to visual similarity. Rather, confusion based on any type of similarity (including visual, aural, or similarity of meaning) may be claimed by an objector...**” [emphasis added]

Therefore, it is possible under this provision for a party to launch an objection to a newly-applied for gTLD based on any of these three types of similarity – visual, aural, or in meaning – between the string applied for by Objector and the string applied for by Applicant. Having said that, it does not logically follow that any one of these grounds of similarity *alone* would *automatically* result in having such an objection granted. For example, “.car” and “.automobile” have the same meaning in English. An objection to a <.car> string based on similarity of meaning alone with an <.automobile> string would not show a real probability that confusion between the two terms would arise in the mind of the average internet user, since these strings look and sound entirely different. It is when there is a confluence of all three types of similarity (visual, aural, meaning) that it becomes most probable that such confusion will occur.

On the question of visual similarity, Applicant has presented adequate evidence to show that “CAR” and “CARS” do not have a high probability of being confused visually. This is partly because the ICANN visual similarity tool test assigned a similarity score of only 72%, in comparison with other string pairs with more distinct meanings having much higher similarity scores. It is true that the ICANN visual similarity standards appear quite narrow, but it is not the role this Panel to substitute for ICANN’s expert technical findings. There also does appear to be visual

“peaceful coexistence” at the secondary domain name level between singular and plural names. Applicant has presented evidence that singular and plural websites have existed together commercially without much internet user confusion between them.

Applicant’s other point is also plausible - that differences in singular and plural word forms are more distinctive and identifiable at the top level of a domain name as we have here, as compared to the secondary level.

On the question of aural similarity, neither party presented convincing evidence. The Objector refers to UDRP “typosquatting” cases to show aural and visual similarity between singular and plural words used when registering a domain name similar to an existing protected trade or service mark. However, the typosquatting cases all contain the key element of bad faith. The UDRP respondents register and use a slight plural variation of a complainant’s mark in order to *intentionally* divert internet traffic away from the complainant to the benefit of the domain name registrant – a form of online trademark piracy. These factors are simply not present in New gTLD String Confusion cases such as this one. No bad faith is alleged and neither string application enjoys prior legal protection as an existing valid trademark would. With the burden of proof of probability, not mere possibility, of aural similarity between the two strings on the Objector, this Panel finds this burden not met.

On the question of similarity in meaning between “car” and “cars”, there is no question that they have the same meaning in English (automotive related products and services), especially in an internet gTLD context – unless a user is reading the string in English but thinking in French, Serbo-Croatian, or Korean (although Serbo-Croatian and Korean use their own alphabets, not the Roman alphabet).

**B. Probability, not mere possibility, that confusion will arise in the mind of the average reasonable internet user**

It is almost certain that confusion would arise in the mind of the average internet user with respect to the meanings of the two strings. However, this is not the only determining factor here. Objector has not met its heavy burden of proving that there is a probability, not just a possibility, of aural and/or visual similarity between the strings <CAR> and <CARS>, as opposed to mere association between them.

**Determination**

For the foregoing reasons, in accordance with Article 21 of the New gTLD DRP and the ICDR Rules, the Panel orders that the Objection be dismissed.

by: Paul E. Mason



Date: August 7, 2013

**Reconsideration Request  
DERCars, LLC**

**Annex B**

*Charleston Road Registry Inc. v. DERCars, LLC,*  
ICDR Case No. 50 504 234 13 (27 Aug. 2013)



**INTERNATIONAL CENTRE FOR DISPUTE RESOLUTION**

**New gTLD String Confusion Panel**

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**Re: 50 504 T 234 13**

**CHARLESTON ROAD REGISTRY INC., OBJECTOR**

**and**

**DERCars, LLC, APPLICANT**

**String: <.CARS >**

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**EXPERT DETERMINATION**

**The Parties**

The Objector is Charleston Road Registry Inc., 1600 Amphitheater Parkway, Mountain View, CA 94043, email: [tas-contact12@google.com](mailto:tas-contact12@google.com). It is a newly formed American corporation which is a subsidiary of Google Inc. The Objector is represented by Brian Winterfeldt , Katten Muchin Rosenman LLP, 2900 K Street NW, North Tower, Suite 200, Washington , DC 20007-5118, [brian.winterfeldt@kattenlaw.com](mailto:brian.winterfeldt@kattenlaw.com).

The Applicant is DERCars, LLC, 150 Granby Street, Norfolk VA 23510, email: [gfridelltld@dominionenterprises.com](mailto:gfridelltld@dominionenterprises.com). It is a newly formed subsidiary of Dominion Enterprises and is incorporated under the laws of the Commonwealth of Virginia. The Applicant is represented by David Weslow, WILEY REIN LLP, 1776 K Street, NW, Washington, DC 20006, email: [dweslow@wileyrein.com](mailto:dweslow@wileyrein.com).

### **The New gTLD String In Issue**

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

### **The Prevailing Party**

The Objector has prevailed and the Objection is sustained.

### **The New gTLD String Confusion Process**

The Internet Corporation for Assigned Names and Numbers (“ICANN”) prepared a gTLD Applicant Guidebook (the “Guidebook” or “Applicant Guidebook”) for use in the New gTLD Program for the creation and delegation of new generic top level domains (“gTLD”). Module 3 of the Applicant Guidebook contains Objection Procedures which set out grounds on which objections may be made in respect of applications for a new gTLD. Attachment to Module 3 is another document entitled the New gTLD Dispute Resolution Procedure also dated 2012-06-04 which sets out the mechanisms and procedures for a timely and efficient resolution of objections to applied for new gTLDs. Article 1(b) of the Procedure states:

“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 (the Procedure)”.

As expressed in the Guidebook and the Procedure, there are four (4) grounds of objection to an application for registration of a new gTLD. The first of these grounds is referred to and defined in the Procedure as a String Confusion Objection. Article 3(a) of the Procedure mandates that “String Confusion Objections shall be administered by the International Centre for Dispute Resolution [the ‘ICDR’]”. The other three types or

grounds of objection are referred to other dispute organizations for administration and determination pursuant to different procedures. In accordance with the mandate in Article 3(a) of the Procedure, the ICDR developed its Supplementary Procedures for String Confusion Objections dated 10 January 2012 (the “ICDR Rules” or “Rules”) which also govern this expert determination, though subject to the Procedure in the event of a discrepancy between the two.

In accordance with the Procedure and the ICDR Rules, the ICDR has received and administered the Objection of Charleston and the Response of DERCars in this particular String Confusion Objection and has duly appointed the Expert herein to make this Expert Determination as required under the Procedure and ICDR Rules.

The Guidebook, Module 3, defines the ground of a String Confusion Objection at Article 3.2.1 as follows:

**“String Confusion Objection** – 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”.

The applicable dispute resolution principles and standards are also addressed in the Guidebook, Module 3, in Articles 3.5 and 3.5.1 which for ease of reference are reproduced in full as follows:

*3.5 Dispute Resolution Principles  
(Standards)*

Each panel will use appropriate general principles (standards) to evaluate the merits of each objection. The principles for adjudication on each type of objection are specified in the paragraphs that follow. The panel may also refer to other relevant rules of international law in connection with the standards.

The objector bears the burden of proof in each case. The principles outlined below are subject to evolution based on ongoing consultation with DRSPs, legal experts,

and the public.

### *3.5.1 String Confusion Objection*

A DRSP panel hearing a string confusion objection will consider whether the applied-for gTLD string is likely to result in string confusion. *String confusion exists where a string so nearly resembles another that it is likely to deceive or cause confusion. 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.*[emphasis added].

A String Confusion Objection is also described in Article 2(e)(i) of the Procedure and parrots the language of the Guidebook, Module 3, 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.”**

It is noteworthy that the Guidebook, Module 3 and the Procedure make no comment on and provide no guidance with respect to the issue raised in this Objection as to whether the singular and plural forms of a generic word or term in pending applications may or may not be permissible gTLDs or may or may not provide a legitimate ground for objection in the context of the String Confusion Objection.

It is within this framework established by ICANN and the ICDR that the String Confusion Objection in this case is to be determined.

### **Procedural History of this Case**

As noted above, the Applicant DERCars applied for the gTLD <.CARS>, which application was delivered to ICANN and originally posted on 13 June 2012 as Application ID 1-909-45636 (see Objection, Annex 3). The purpose and mission of this new gTLD was also stated in its application at paragraph 18.1 as follows:

“DERCars, LLC (“DERCars”), a wholly owned subsidiary of Dominion Enterprises (“Dominion”), has filed this application for a .CARS gTLD with the intention of bringing to market a trusted, hierarchical, and intuitive namespace for consumers that will contain listings of motor vehicles for sale, as well as a repository of goods and services related to cars”.

The Applicant then described in greater detail the proposed purpose, benefits and services for meeting the business needs of its parent, Dominion Enterprises, a Virginia general partnership, and its clients, and thereafter, in a subsequent stage of development, of non-clients.

The Objector Charleston has itself applied for the new gTLD <.CAR> by way of application also originally posted on 13 June 2012, bearing Application ID 1-1683-84431 (see Objection, Annex 2). The stated purpose or mission of the proposed gTLD <.CAR> was described, in part, in the paragraph 18.a of the Objectors application as follows:

“The mission of this gTLD, .car, is to provide a dedicated domain space in which registrants can enact second-level domains that offer content related to cars, including the sale, purchase, rental, financing, servicing, repair, insurance and/or management of cars, as well as automobile industry-related information, such as new product development and trends(e.g. alternative fuel sources).”

It was also stated that this gTLD would also meet the business needs of Charleston and its parent Google Inc. to help make information universally accessible by extending the utility of the DNS while enhancing the performance, security and stability of the Internet for users worldwide.

On March 13, 2013, Charleston, by its counsel, delivered the String Confusion Objection Form to the ICDR in accordance with the Guidebook and the Procedures objecting to the application for the gTLD string <.CARS> which had been filed by DERCars. This Objection included a 10 page written submission, with 5 Annexes

thereto. Following an administrative review by the ICDR, the Objection was registered for processing as confirmed by letter dated April 3, 2013 from the ICDR to Counsel for the Objector and to the Applicant DERCars.

On May 23, 2013, DERCars, by its counsel, delivered to the ICDR its Response to the Objection dated May 15, 2013 consisting of an 18 page written submission, together with 5 Annexes, including legal authorities, totaling 397 pages.

By letter dated May 23, 2013 to counsel for both parties, the ICDR confirmed receipt of the Response to the Objection and that the Response complied with Article 11 of the Procedure.

Thereafter, by letter dated June 13, 2013, the ICDR confirmed to counsel for the parties that John A.M. Judge had been appointed pursuant to Article 13 of the Procedure as the Expert to determine the Objection and requested challenges, if any, by June 18, 2013, together with payment of the requisite advance on costs by June 24, 2013. There being no challenges to his appointment, Mr. John A.M. Judge was appointed as the Expert.

Following payment of the required advances in respect of costs, Mr. Judge was instructed on June 27 to proceed with the substantive review materials as filed and with the determination of the Objection.

On 3 July 2013, counsel for the Objector, in response to a request from Mr. Judge, delivered by email copies of the legal cases and authorities relied upon by the Objector in support of its Objection.

**Basis for Objector's Standing to Object Based on String Confusion**

It is accepted by the Applicant DERCars that Charleston has standing to bring this proceeding. Charleston is a gTLD applicant for <.CAR> in the same round of

applications as DERCars for <.CARS> and therefore has standing in accordance with Article 3.2.2 of the Guidebook to bring this Objection.

### **Parties' Contentions**

#### **The Objector Charleston:**

In support of its Objection that the gTLD string <.CARS> so nearly resembles <.CAR> that it is likely to deceive or cause confusion in the mind of an average reasonable Internet user, Charleston relies on United States judicial authorities, mainly in trademark cases, and arbitration panel decisions under the Uniform Domain Name Dispute Resolution Policy ("UDRP") administered by the World Intellectual Property Organization ("WIPO") and National Arbitration Forum ("NAF") as being persuasive for this novel objection procedure. In particular, Charleston submits and relies upon the following factors to support a finding of confusion.

**The Strings are virtually identical in appearance.** It is submitted that the words .CAR and .CARS are identical but for the mere addition of the letter "s" which results in the pluralization of the root word. The Objector cites numerous trade-mark cases as well as WIPO and NAF decisions under the UDRP to support its position that there is confusing similarity between the singular and plural of domain names and marks. (see *Nabisco, Inc. v Warner Lambert Co.*, 220 F.3d 43, 46, (2d Cir. 2000); *In Re Pix of America, Inc.* 225 USPQ 691(TTAB1985); *In Re Curtice-Burns, Inc.*, 231 USPQ 990 (TTAB); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB) 1983; *Mattel Inc. v Magic 8 Ball Factory*, WIPO Case No D2013-0058; *Lego Juris A/S v. Frederik Soleimani*, WIPO D 2012-2133; *Barnesandnoble.com LLC v Your One Stop Web Shop*, NAF Claim No. NFA 670171, amongst others). Using ICANN's String Similarity

Assessment Tool to compare .CAR versus .CARS, it is submitted by Charleston that these two strings share a 72% visual similarity. Therefore, it is said that it is probable, not merely possible that reasonable internet users and consumers will be confused when viewing .CAR versus .CARS.

**The Strings are virtually identical in phonetic sound.** It is further submitted that the word “CARS”, pronounced “kahrs”, is essentially and phonetically equivalent to the word “CAR”, pronounced “kahr”. They are both one syllable with the same primary accent on the initial “CA”, pronounced “kah”. It is submitted that the pluralization by the addition of the letter “s” results in a high degree of confusing similarity in sound. It is also submitted that similarity of sound is particularly important when goods are of a type frequently purchased by verbal order, such as automobiles and auto parts and related services advertised over various media and purchased over the Internet.

**The Strings are virtually identical in meaning.** Charleston submits that the commercial meaning of the disputed terms is also a material factor and here there is no material difference between the .CAR and .CARS gTLDs. Both the Applicant and the Objector intend to use their respective gTLDs for the same or similar content which is automobile related content. The commercial meaning remains the same whether the singular or the plural word is used. Again the Objector references numerous trade-mark and domain name cases to support its submission that the commercial meaning of the terms remain confusingly similar where the letter “s” is added to pluralize a word. For example, in *Blue Bell Creameries L.P. v Private Whois/ Telecom Tech Corp.*, WIPO Case No. D2011-0316, the singular “Creamery” was used in the domain name while the



plural was used in the trademarks and the Tribunal there concluded that “the two would be indistinguishable in the recall of the average Internet user”.

**The Strings so resemble each other that they are likely to deceive or cause confusion.** By reason of the fact that the two strings are nearly identical in appearance, phonetic pronunciation and commercial meaning, it is submitted that the .CARS gTLD is therefore likely to deceive or cause confusion in the minds of the average reasonable Internet user.

**Additional Considerations.** Finally, the Objector raises two other factors which it says support a finding of likely confusion regarding the .CAR and .CARS gTLDs. First, it points to an ICANN practice in prior gTLD applications not to allow certain applications by Name.Space Inc. for both singular and plural names such as .FILM and .FILMS. None of these applications by Name.Space Inc. were allowed save one, .MUSEUM. Secondly, it is submitted that certain non-English speaking users, such as Koreans and French, will be particularly susceptible to the confusion created by the addition of “s” in the .CARS TLD. In languages such as Korean and French, it is said that the plural ending is largely “irrelevant”, thereby suggesting an increased likelihood of confusion if both .CAR and .CARS TLDs are delegated.

**The Applicant DERCars:**

DERCars disputes the Objection of Charleston as lacking merit due to the absence of any specific arguments under the law as to why the .CARS gTLD string is likely to result in confusion and also the reliance by Charleston solely on the pluralization of the word to suggest that confusion can be automatically assumed. DERCars asserts that

such an assumption is ill-founded and at odds with global norms for assessing consumer confusion and also at odds with the new reality that there will be in fact new gTLDs in both the singular and plural forms of words. The Applicant notes that a number of pending new gTLDs are proceeding in both singular and plural forms and are not subject to string confusion objections, such as .Auto and .Autos, .Photo and .Photos and Google's own application for .NEW versus many other applications for .NEWS.

The Applicant rightly notes that the burden of proof is on Charleston to establish string confusion on a balance of probabilities under Article 3.5.1 of the Guidebook, and specifically that the string <.CARS> so nearly resembles <.CAR> that it is likely to deceive or to cause confusion. DERCars characterizes the core of Charleston's argument as being that the plural form of a word is automatically confusing with the singular form. Such an argument is said to fail to meet the required test for three basic reasons which are fully developed in its Response. To a considerable extent these reasons overlap and can be summarized as follows.

**Confusion is not automatic and cannot be assumed when comparing the singular and the plural forms.** Such an assumption, the Applicant submits, is contrary to the confusion analysis applied by Courts, by UDRP Panels in respect of domain names and by ICANN's own String Similarity Panel and Board of Directors. DERCars notes that Charleston's reliance on the three factors of "sight, sound and meaning" is selective and incomplete as a reference to the nine factors used by courts, usually in a trademark context, for the confusion analysis. When the proper factors are taken into account, including context, it is clear, according to DERCars, that similar, even identical, marks may not create confusion. The UDRP cases relied upon by Charleston, such as *Mattel*

*Inc. v. Magic 8 Ball Factory*, WIPO Case D2013-0058 and *Barnesandnoble.com LLC v Your One Stop Web Shop* NAF. Claim No. FA 670171, are clearly distinguishable as they involved famous registered trademarks. Here, completely generic terms are being compared. It is submitted that consumers are much more cautious and discerning with respect to generic terms.

The Applicant also noted that ICANN's expert String Similarity Panel did *not* include both singular and plural forms of the same applied for string in the same contention set, indicating that the plural form alone did not create a possibility of user confusion. It also asserted that at the April 2013 meeting in Beijing between the ICANN Board and the Government Advisory Committee ("GAC"), ICANN confirmed that it did not believe that the singular and plural forms created "visual confusion". DER Cars also noted that certain singular and plural versions of strings were, in fact, proceeding without objections being filed, noting Charleston's own application for .NEW while seven other applications for .NEWS were pending. These particular arguments will be reviewed in more detail in the analysis.

Finally, in raising the specter of an estoppel, DERCars noted that Charleston itself has applied for other visually and phonetically similar strings such as .DOT, .DOC and .DOGS as well as .LLC and .LLP which would of necessity fail if Charleston's argument were accepted.

**Consumers are not likely to confuse the domains .CAR and .CARS when applying accepted tenets for likelihood of confusion analysis, particularly in the proper context.** Under this heading, DERCars consolidates a number of disparate and in part inconsistent submissions. First, it emphasizes that a new gTLD cannot be considered in

isolation but only in context with the entire name, the second level domain name. Indeed, based on trademark cases involving domain names, it is said that the top level domains are not source indicators alone as it is the second level domain on which the consumer will focus (relying on *Nissan Motor Co. v. Nissan Computer Corp*, 204 F.R.D. 460, 466-467 in which the court there noted that “any permutations one may derive from adding a top-level domain to the second level domain ‘Nissan’ are indistinguishable as a matter of law”. The generic strings .CAR and .CARS cannot act as source identifiers. Indeed it is submitted that whether a term is “strong” or “weak” is significant for the confusion analysis, as consumers are less likely to confuse weak terms. Descriptive or commonly used terms would be weak, it being suggested that the word “car” clearly falls into this category. Given the generic terms in issue, they are “weak” and therefore are more readily or easily distinguished by discerning consumers.

In terms of a broader context, it is submitted by the Applicant that broader marketing channels and marketplace conditions should be considered, in particular the distinguishable service offerings of Charleston and DERCars and their parent companies. Even identical marks can co-exist without a likelihood of consumer confusion where they may be associated with differentiated and distinct products and services (Response at p. 9-10), which is the case when comparing the services of the parent corporations, Google and Dominion. It is noted, for example, identical terms already co-exist in [www.cars.com](http://www.cars.com), [www.cars.co](http://www.cars.co), [www.car.com](http://www.car.com), [www.car.co](http://www.car.co) and [www.car.ca](http://www.car.ca), all without confusion. These illustrate, it is submitted, that the presumption of confusion with singular and plural forms is therefore untenable.

However, it would appear that in these instances the top level domain differentiates these strings, a result inconsistent with the comments of the court in the Nissan case. In

any event, it is further noted by the Applicant (Response at p. 13) that even if a gTld is viewed as a source identifier, consumers in fact focus on the first portion of a delegated name. Therefore, if there is any confusion at the second level domain name, it is submitted that such confusion should be dealt with in the UDRP process and that any such confusion at the second level should not be attributed to the top-level domain. (Response at p. 13).

**The Likelihood of Confusion is Even Less Probable When Considering How “Average, Reasonable Internet Users” Interact Online.** Based on a number of court decisions, it is argued that consumers no longer form expectations based on domain names alone, but rather from the Internet websites in their entirety. Reliance is placed on various court decisions in which some U.S. courts have held that “consumers don’t form any firm expectations about the sponsorship of a website until they’ve seen the landing page – if then” (*Toyota Motor Sales, U.S.A. Inc. v Tabari*, 610 F.3d 1171 at 1179 (9<sup>th</sup> Cir.2010)) or that similar domain names may cause a “diversion, not a likelihood of confusion”. For example, it is argued that if a consumer accidentally typed AUCTION.CARS instead of AUCTION.CAR, they would more than likely realize the error upon reaching the landing page. Therefore, rather than presume confusion at the top level domain, any confusion should be determined on a case by case basis, based on how the second level domain is actually used with the issue to be determined in the UDRP process.

**Response to “Additional Considerations” Relied Upon by Charleston: No *Per Se* Rule for Pluralizations.** Firstly, in response to specific arguments made by Charleston that prior applicant rounds for certain gTLDs gave rise to some precedent to the effect

that the pluralization of a word gave rise to objectionable confusion, the Applicant reviewed the materials and submitted that there simply was no precedent created by certain specific name applications. Secondly, in response to the Charleston submission regarding the difficulties created for non-English speaking users by plural terms, the Applicant disputed the evidence relied upon by Charleston and more importantly disputed as erroneous the conclusions which Charleston drew with respect to the impact of plural terms on the recognition of gTLDs. Of interest was the Applicant's submission that the number of non-English websites exceeds the number of English websites and that it is in fact unclear if non-English speaking users would even encounter the .CAR and .CARS gTLDs and in what context.

DERCars therefore concluded that it was not likely and certainly not probable that there would be confusion in the mind of the average, reasonable Internet user.

#### **ISSUE FOR DETERMINATION**

The issue for expert determination in this matter can be simply stated as follows:

Does the gTLD <.CARS> so nearly resemble <.CAR> that in the mind of the average reasonable Internet user, is it likely on a balance of probabilities to deceive or to cause confusion, or in other words is <.CARS> confusingly similar to <.CAR>?

Subsumed in this statement of the issue is the broader policy issue raised by these two applied for gTLDs and which permeates the submissions of both parties as to whether the pluralization of a generic term is likely to deceive or to cause confusion. This will be addressed in this expert determination for the specific question raised by this

Objection to the applied-for string, but this expert determination is not intended as a broader policy discussion or determination of this particular issue which is properly for consideration and determination by the ICANN Board.

## **DISCUSSION, ANALYSIS AND FINDINGS**

**Introduction and Elements to be Established.** The issue for determination as stated above raises four elements for consideration and comment, though in this case two are not in dispute. First is whether the string <.CARS> “so nearly resembles” <.CAR>. There is, and can be, no serious issue on this element. Indeed, the Applicant has, in part, argued that even if they were identical, the use of identical terms can be differentiated. It is plain and obvious on a considered review that the two strings in issue do in fact closely or “nearly resemble” each other. As for objective evidence, the ICANN String Similarity Assessment Tool comparative analysis of car vs. cars at Annex 4 of the Objection Submission generated a rating of 72%, which provides objective evidence that on a balance of probabilities the two strings “nearly resemble” one another. The second element is simply the burden of proof which is also not in dispute. Both parties agree, rightly, that the burden is on the Objector to prove the confusion elements on a balance of probabilities as is expressly required under Articles 3.5 and 3.5.5 of the Guidebook. No further discussion or comment is required on the articulation of the requisite standard, though the application of this standard will be discussed in the context of the remaining confusion elements. Third is the element on the standard of assessment of confusion, being the “the mind of the average, reasonable Internet user”. Both parties have made short submissions on this element which warrant brief review and comment. The fourth and disputed element for consideration and determination is whether the

resemblance in the strings “is likely to deceive or cause confusion”. It is this element which has attracted the core arguments from both parties and likewise will be the principal focus of the analysis in this determination.

**Position of the ICANN Board and String Similarity Panel.** Before embarking on the analysis of the disputed element, it is appropriate to address a specific argument relied upon by Applicant at page 7 of its submission that ICANN and its String Similarity Panel have recognized and implicitly approved the coexistence of the plural\singular versions of the same root word. In particular the Applicant has quoted representatives of the ICANN Board at the Joint Meeting of the GAC and ICANN Board in April 2013 in Beijing to suggest approval of the singular and plural roots. A review of that meeting and its aftermath indicates that no inference of such an approval can or should be made which would affect the independent analysis and determination to be made in respect of the Objection in this case under the Guidebook, Procedure and the ICDR SCO Rules

The Applicant has accurately noted that at the April 9, 2013 Joint Meeting of the GAC and the ICANN Board, the issue of plural forms of words was raised by a GAC member for discussion. The ICANN representatives noted at the meeting at 16:45 -18:00 on April 9, at pages 18-19 of the transcript, that the independent panel had looked at these strings and did not believe there was confusion. It was stated that the ICANN Board would not second guess the panel. However, the GAC was not satisfied with that position and shortly thereafter, by Communique dated 11 April 2013, gave advice to ICANN, as it was entitled to do, on a variety of issues relating to the New gTLD Program, including the belief by GAC that the singular and plural forms could lead to potential consumer confusion and that the ICANN Board should reconsider its decision



to allow this. Thereafter, ICANN accepted that advice on June 4, 2013 and, after receiving public comment on a variety of issues, embarked upon a reconsideration including the specific issue of singular\plural versions of the same string. The process is summarized in the Approved Resolution\Meeting of the New gTLD Program Committee of ICANN dated 25 June 2013, (see Item 2 d. of the Main Agenda at page 13 of 21 of the Minutes available online at [www.icann.org/en/groups/board/documents/resolutions-new-gtld-25jun13-en.htm](http://www.icann.org/en/groups/board/documents/resolutions-new-gtld-25jun13-en.htm). This reconsideration took place while the application process was already well underway with over 1900 applications being filed and indeed after the closure of the period for the filing of objections on 13 March 2013 in respect of those pending applications. It was noted in the June 25 Minutes that ICANN did not provide any instructions to the String Similarity Panel apart from the criteria specified in the Guidebook. It was noted that there were a total of 26 singular/plural applied-for English language strings, which pairings attracted a total of 21 string similarity objections filed against them. The Objection filed by Charleston in this matter is one of them. As was noted in the June 25 Minutes referenced above, the Applicant Guidebook, the Procedure and the ICDR SCO Rules are a complete set of procedures for the consideration of potential confusion issues in the string analysis. Therefore, the assessment of the String Similarity Panel is not determinative. The Guidebook and the Procedure do not suggest that the Panel opinion is even persuasive in any respect. Instead the Objection procedure provides for an independent expert determination. After a full and considered review of the GAC request for a review of the singular\plural issue and the pros and cons described in the public comments, the ICANN Board New gTLD Program Committee determined and resolved on June 25, 2013 that no changes should be made to the existing mechanisms

in the Applicant Guidebook specifically “to address potential consumer confusion resulting from allowing singular and plural versions of the same string”. This ICANN Committee noted that the principles of preventing user confusion and avoiding loss of confidence in the Domain Name System were built into the standards and procedures to address the string analysis. Those procedures include the objection procedure applicable to the Objection in this matter which the ICANN Committee noted was available to all applicants who had standing to file objections to another application. Since the application process was well under way and maintaining this status quo under the Guidebook and existing Procedure would not have any impact on the existing program governed by that Guidebook, the ICANN Committee followed the prudent course of making no change whatsoever the applicable standards and of offering no other comment. Any comment, after the fact, would have undermined the process already underway.

No conclusions or inferences can or should be drawn, one way or the other, from the fact that the String Similarity Panels appear to have allowed singular and plural versions to proceed, albeit with no specific or defined policy on this issue being established in the Applicant Guidebook or otherwise by the ICANN Board. Nor should any conclusions or inferences, one way or the other, be drawn from the fact that the GAC, out of a concern about confusion with singular\plural terms, requested reconsideration from the ICANN Board. After that reconsideration, no changes were made by the ICANN Board by way of a new policy statement or amendments to the Guidebook. The clear rationale was to not disrupt the current process or to change the rules mid-stream but rather to let the existing procedures in the Guidebook for the new gTLD applications unfold in the normal course. Of course, these procedures include the string confusion objection

procedure, as described above, which govern this Objection. Therefore, there can be no presumption or inference that all singular and plural strings are likely to cause confusion and by the same token, no presumption or inference that all singular and plural strings are permissible and are not likely to cause confusion.

The Guidebook does not contemplate any presumptions to be applied, one way or the other on the confusion issue. Nor is any particular deference or weight to be given under the Guidebook to the results of the String Similarity Panel, which is not required to give any reasons. The confusion procedure provided in the Guidebook is therefore being applied in this Objection, without any change arising from the reconsideration noted above since April 2013. It is for this reason that this Expert found it unnecessary to invite the parties to make any further submissions in connection with this reconsideration arising from the GAC request in April 2013 for advice from ICANN. The existence of that reconsideration process is therefore noted, but that process since April 2013 has had no direct bearing on the analysis or end result of this Expert Determination of the Objection in this matter.

**The Average Reasonable Internet User.** The standard for determining the existence of string confusion is the “mind of the average, reasonable Internet user”. This term is not defined in the Applicant Guidebook, the Dispute Resolution Procedure or the ICDR SCO Rules. Indeed it is a term that is not even discussed. As a result, there is no guidance whatsoever in this ICANN string objection procedure to assist in determining the scope of that standard.

However, the use of this term, an average reasonable Internet user, is clearly intended as an adaptation of the legal construct or fiction of the “reasonable man” or the “reasonable

person” developed in national common law legal systems, such as England and the United States of America, to assist in defining the existence and scope of legal rights and obligations and, consequently liability, by determining the appropriate conduct expected of a typical member of a community in situations which may have an impact on or may harm others or their property. It is normally associated with the development of the principles of negligence and certain offences in criminal law. It is said to represent a common objective standard rather than an individualized subjective standard. The reasonable person is normally not regarded as the “average” person. Instead the concept represents a composite of a particular community’s judgment as to how a member of that community should act or respond in particular circumstances. It is intended to establish a minimum level of conduct or behavior and to avoid legal distinctions for individual liability solely by reason of the individual differences in the ability of people to perceive the impact of their conduct on others and to inadvertently cause harm. It is a community standard for the particular community and the circumstances in issue in a domestic or national law context.

The “average, reasonable Internet user” is therefore also a construct or a fiction established by the ICANN board in the Guidebook and Procedure to set a minimum standard for testing and determining the likelihood of an applied-for gTLD to deceive or to cause confusion. This term is analogous conceptually to the “reasonable person” standard recognized under certain domestic or national legal regimes. However, the community within which this standard is to apply is different from any local, domestic or even national legal standard. The community for a reasonable Internet user is, by virtue of the nature of the Internet, ubiquitous and global in nature, encompassing users in developed, developing and underdeveloped countries, English speaking and non-

English speaking countries and users. The population and scope of Internet users is far reaching and varied, and therefore more challenging to assess for the purpose of articulating the content of a standard for an “average, reasonable Internet user”. Furthermore, as internet usage continues to dramatically expand, users will continue to range from first time novices through to occasional and regular users and ultimately to experienced knowledgeable users and arguably skilled IT professionals. In some countries internet penetration has achieved high percentage levels of the population while in other countries the level is significantly less, even modest, which may also reflect variations in the sophistication of the users. The average, reasonable user establishes a standard higher than that of the novice. However the combination of words “average” with “reasonable” moderates the standard, and indicates that the standard will most certainly also fall short of a standard set by experienced, frequent users at the other end of the spectrum. The parties have not submitted any evidence to breathe some life into the “average, reasonable Internet user” in order to clarify the standard of expected conduct. Therefore the comments herein must remain general and will be limited to the submissions of the parties and also to the context in which the specific string confusion Objection is made in this case.

The Applicant has referenced some trademark cases in its submission to raise or elevate the standard of conduct for an average reasonable Internet user. The Applicant suggests in its submission at page 14 that “(c)onsumers no longer form expectations about web sites from domain names alone” based on American trademark infringement cases like *Toyota Motor Sales U.S. A. Inc. v Tabari*, 610 F.3d. 1171 (9<sup>th</sup> Cir. 2010). Based on such authorities, it is submitted that expectations are established only after seeing the landing page or first online page of a website. As a result, it is suggested that the similar domain

names may create only a diversion, but not a likelihood of confusion as any error would be recognized upon arrival at the landing page and then corrected by a reasonable internet user. There are a number of difficulties with this analysis. First, the diversion-confusion distinction is wholly unsatisfactory as these are not mutually exclusive concepts. A diversion is an action which re-directs the mind or attention away from an intended course. While a diversion can be clearly and intentionally demarcated so as not to confuse, it may not be. A diversion may also exist simply because of confusion and uncertainty created in the first instance. This may occur where two domain names closely resemble one another. The distinction also assumes that the landing pages to which a user is directed will reveal the true ownership, origin or sponsorship of the particular websites and will readily clarify the initial confusion\diversion. It may not. More importantly, this distinction and the supporting analysis, if accepted, would essentially preclude any finding of string confusion in relation to two generic words, or the singular and plural versions of a word, as new gTLDs under the New gTLD Program. The proposed approach dictates considering a particular domain name only in the context of an existing website and its landing page.

That is of course impossible in this string objection procedure generally and in this particular Objection as the determination is not being made in the context of a particular or existing website at all. The gTLD subject to this Objection procedure is simply proposed, and is presently not in use with any particular domain name or website.

The facts of the *Toyota* case are clearly distinguishable. In the *Toyota* case, relied upon heavily by the Applicant, the US Federal Court of Appeals, sitting in California, was satisfied that experienced online consumers would form firm expectations of the origin

or sponsorship of a site only after going to the website landing page. The Court's assessment in *Toyota* was made in the context of an existing website for the defendant broker who assisted purchasers in buying a genuine Toyota product and the court found that, after some modification, the website did not suggest sponsorship with Toyota.

That is not this case. There are no websites and no domain names to compare. We have the proposed for gTLDs and, at most, there are tentative business plans of the Applicant and the Objector as to how they would organize each of their businesses as registrars in their intended markets if successful in obtaining their applied-for gTLD.

In creating the New gTLD Program, ICANN itself was concerned about the issue of string confusion in generic domains and created the string objection procedures governing this Objection specifically to ensure a mechanism was in place during the delegation process to avoid likely confusion as between applied for top level domains, independent of any association with a specific existing website. Accepting the Applicant's submission and deferring to a user's ability to resolve an initial diversion or confusion upon reaching the landing page of a non-existent website would constitute an abdication of the responsibility to make the expert determination required under the Guidebook and Procedure as part of the application process for potential registrars of the new gTLDs.

For the purposes of applying the standard of an average reasonable Internet user in this string confusion analysis, it is also important to recognize that a user is not simply one who is accessing the Internet to go to websites or to search for information over the Internet, perhaps with a commercial interest in mind. Equally important, an Internet user is also a person or entity who applies to register a domain name for use with a

website and email address. With respect to the applied-for gTLDs in issue in this Objection, the first internet users of these potential gTLDs in the marketplace will be persons or entities who seek to register a second level domain with the top level generic domains in issue. It is therefore appropriate to consider how an average reasonable potential registrant for a domain name, as an Internet user, may view the two domains in issue. Such a user may or may not be a consumer in the traditional sense. Indeed it is likely that many registrants for these gTLDs will be commercial businesses seeking to obtain a domain for use in connection with an existing business and/or a website to provide online access to their business in the normal course. That appears to be the primary focus of the Applicant's business plan.

Therefore, it is accepted that the standard of the "average, reasonable Internet user" is an objective one, independent of the personal differences or idiosyncracies of individual users. That user will include a person seeking to register a second level domain in conjunction with the proposed-for gTLDs. Therefore, the objective standard is to be considered in relation to the applied for gTLDs and the potential domain names using those top level domains, without the benefit of observing or assessing any particular website potentially associated with any particular domain name.

**Likelihood to Deceive or to Cause Confusion.** This is the key issue for determination in respect of the Objection to the applied-for gTLD <CARS>. Before addressing the specific arguments raised by the parties, it is appropriate to briefly identify the underlying policies for the New gTLD Program as referenced in the gTLD Applicant Guidebook, including Module 3, which underpin and inform the string confusion test set out in that Guidebook. ICANN's core objectives include the maintenance of stability



and security of the domain name system. In the New gTLD Program, ICANN's objectives are to increase competition and choice in the domain name space, and to enhance innovation through new gTLDs, while lowering registration cost and abuse. (Applicant Guidebook, Preamble; ICANN 2012 Annual Report, at p. 7-10; ICANN New Generic Top Level Domains, About the Program at <http://newgtlds.icann.org/en/about/program>). In the development of the program procedures, a balance was sought between increasing competition and avoiding gTLDs which were likely to deceive or to cause confusion in the new strings to be applied for and ultimately delegated. The string confusion objection procedure was applicable to words which were generic, not distinctive, in contrast to traditional trademarks, and the legal rights and protections for those marks. The Applicant Guidebook in Module 3 also created a separate and independent objection procedure for the protection of existing legal rights, principally trademarks, in relation to the new applied-for gTLDs. Therefore, the string confusion test was not intended to be limited by or confined to traditional trademark rights and concepts which would otherwise support an independent legal rights objection as specifically defined in the Applicant Guidebook, Module 3. This new string confusion objection procedure was not aimed at protecting existing rights but rather but more broadly intended to ensure that increased competition and choice would be encouraged while maintaining a stable domain name system and avoiding or minimizing registration abuse.

Therefore, the meaning of "confusion" in this string objection procedure cannot be completely synonymous with the confusion analysis in the trademark context. The string confusion objection involves the comparison of two generic applied-for gTLDs which have not been used in connection with an existing business or product. By

contrast, valid trademarks must meet the distinctiveness requirements necessary under applicable trademark laws for use in connection with goods or services. The Applicant has itself recognized the limitations in applying the trademark cases at pages 6-7 of its Response. Therefore, the American trademark cases, relied upon extensively by both parties are of some persuasive assistance in certain aspects of the confusion analysis, but they cannot provide the entire framework necessary for the assessment of confusion in relation to generic, non-distinctive terms for the purposes of this determination.

The Guidebook, in establishing the string confusion objection and procedure, did not provide any definition of the term “confusion”, other than to specify in Article 3.5.1 of the Procedures in Module 3, that “mere association, in the sense that the string brings another string to mind, is insufficient ....” Therefore, before addressing the arguments of the parties and some of the authorities relied upon, it is useful to consider the plain and ordinary meaning of the English word “confusion”. The Oxford Dictionary (online version) defines “confusion” as: “1. uncertainty about what is happening, intended or required; 2. the state of being bewildered or unclear in one’s mind about something”. The Merriam-Webster Dictionary (online version) defines “confusion” as: “1. an act or instance of confusing; and, 2. the quality or state of being confused.” The Merriam-Webster Dictionary further defines “confuse”, inter alia, as: “1. to make indistinct, to blur; 2. to mix indiscriminately; to fail to differentiate from an often similar or related other”. These general definitions of the plain and ordinary meaning of the term “confusion” assist in posing more specific questions for this objections procedure for the gTLD <.CARS>. Is there a lack of clarity or uncertainty over what is intended, or more specifically is there a failure to differentiate as between <.CARS> and <.CAR>?

Is the uncertainty, lack of clarity or failure to differentiate more than a “mere association in the sense that one brings the other to mind”?

In answering these questions in light of the applicable standard of the “average reasonable Internet user” for the confusion test, one should first consider the perspective of a user who applies to register a domain name and thereafter the perspective of an online user who may seek to access that domain. If both the <.CAR> and the <.CARS> gTLDs are available, what would be in the mind of a user applying for a particular domain name, whether an existing mark or another generic term at the second level in conjunction with one or both of these gTLDs? How would an average reasonable applicant for a name react to, or what would that person think of the two gTLDs? The Objector gives examples of potential names such as SEDAN.CAR and SEDAN.CARS, or SHOP.CAR and SHOP.CARS, or AUCTION.CAR and AUCTION.CARS. It must also be recognized that many existing businesses will seek to use their names in connection with these new gTLDs such as GM.CAR and GM.CARS, or FORD.CAR and FORD.CARS. An individual with a business somehow related to automobile industry may simply seek to use that individual’s name, for example, ANYNAME.CAR or ANYNAME.CARS. Faced with these two gTLDs, any potential registrant, as an average reasonable Internet user, would feel compelled to register under both <.CAR> and <.CARS>. Any domain name registrant, knowing that both gTLDs were available, would be very concerned about registering under one alone and leaving the other for someone else to be able to register the same second level name. The reason is very simple in that they would want to avoid the prospect of either outright deception or likely confusion if they did not otherwise register under both gTLDs.

In my view, it is plain and obvious to and it would be in the mind of a potential name registrant, as an average reasonable Internet user, that the use of both <.CAR> and <.CARS> as gTLDs in connection with the same second level name would likely cause confusion. Indeed, they would conclude in their mind that confusion was highly probable, not just a conclusion on a balance of probabilities. Therefore, that user would feel compelled to register under both and thereby control the names under both gTLDs. If a domain registration was made under only one gTLD, say for example ANYNAME.CARS, there would be a real and legitimate concern that someone else may register the other, in this example ANYNAME.CAR, and cause confusion or worse, deception. A potential name registrant would make that assessment based on the overall impression of the domain name alone, being the second level name in combination with each of the gTLDs in issue, without any consideration of the content of websites yet to be online. It would be plain and obvious to the average and reasonable registrant, as an Internet user, that other Internet users, whether consumer or commercial users, would very likely be confused that the two domains names were associated with or sponsored by the same person.

In my view it is also plain and obvious that an average and reasonable internet user accessing the internet for information for various purposes, including online commerce, is also likely to be confused by the availability and use of the two gTLDs <.CAR> and <.CARS> in connection with the same second level name. To be clear, the user would form that conclusion on a balance of probabilities. That conclusion is based on the overall impression created by the two separate domain registrations under the two gTLDs. This test of the "overall impression" of factors to be perceived by the purchaser is also endorsed in the trademark cases relied upon by both parties (see *Nabisco v.*

*Lambert Company* 220 F.3d 43 at 46,47; *Dan Robbins & Associates v Questor Corporation*, 599 F.2d 1009 at 1013, found at page 145 of Annex 4 of the Applicant's Response). However, it is also appropriate to identify the specific findings and reasons which justify this overall impression.

As submitted by the Objector, the two strings applied for, <.CARS> and <.CAR>, are virtually identical in appearance, in phonetic sound and in meaning. The combination of all three elements makes the prospect of confusion compelling, not just likely on a balance of probabilities. The only difference is the pluralization of the singular term by the addition of one letter "s".

As for appearance, the undisputed evidence is that ICANN's String Similarity Assessment Tool indicated a 72% visual similarity. While this is not determinative, it supports the finding that the burden of proving likely confusion on a balance of probabilities has been met. The weight of the American court decisions in trademark cases and the WIPO and NAF domain name cases as cited by the Objector are also persuasive and supportive of the finding of likely confusion which is not dispelled by the mere addition of the letter "s" to pluralize. The plural form is simply not a sufficient differentiator to avoid confusion. Indeed in a number of decisions, it is suggested that the use of a plural form of the singular may even serve to heighten or exacerbate the potential for confusion (see *Lego Juris A\G v Frederick Soleimani*, WIPO Case D2012-2133, at section 6.A., number 7 in the Objector's Authorities; *Insubuy Inc. v. Genetic Researches Community*, NAF, Claim FA 1209000114644188; *Home Retail Group v Home Retail Group\Rafique Holding*, WIPO Case D2012-2335, at section 6.A). Other cases note that use of the plural certainly does not lessen the inevitable confusion with

the singular (*Barnesandnoble.com LLC v Your One Stop Web Shop*, NAF Claim FA670171 at page 6; and, *PET 360, Inc. v. Private Registrations Aktien Gesellschaft*, WIPO Case No. D2012-0325, at Section 6A.). I agree with those comments on the impact of the plural form.

Phonetically, the term CAR is essentially equivalent to CARS and vice versa. Each is one syllable with the same stress pattern in pronunciation, the primary accent being on the initial “kah” sound in each word. The similarity of sound is significant as users relate to and remember on the basis of the sound of words and the likelihood of confusion is increased where the sound is essentially the same.

Finally, the ordinary meaning of the two words is essentially the same as they both refer to a vehicle and would both encompass automobile related content. There is no material difference in the plain and ordinary meaning of the terms simply by the addition of the letter “s” to the term “CAR” to create the plural. The trademark and UDRP decisions cited by Objector are also persuasive in this regard.

It is the combination of these three virtually identical factors of appearance, sound and meaning which make the likelihood of confusion compelling, not just probable, in suggesting a common source or origin. It is these three factors in combination which support the overall impression and which controls the determination of likely confusion with respect to the gTLD in issue. If any one or more of these three factors indicated a material difference, then the balancing of these three factors would be materially altered and the result may well be different. For example, <.CARS> and <.AUTOS> have essentially the same meaning but the visual and phonetic differences in these two gTLDs make any confusion unlikely.

The Respondent has raised a number of arguments and it is appropriate to briefly address those and to clarify why those submissions are not persuasive and cannot prevail.

i. It is argued that there will be other singular and plural forms of gTLDs based on the existing applications for which no objection has been made. These other gTLDs are listed at page 2 of the Response. However, those applications are not before this Panel for expert determination and they are not the subject of submissions on this Objection. Those other applications may well cause confusion or be likely to cause confusion. They may not. The fact that applicants for those domains, for their own specific reasons, have not filed objections does not provide any precedent one way or the other in this Objection. The mere fact that those applications remain in play is not a persuasive or cogent reason to allow the two applied for gTLDs in issue in this Objection to proceed separately, if, as I find to be the case, there is a likelihood of causing confusion by doing so.

ii. The Applicant asserts that the Objector, or its parent Google, has applied for a gTLD .NEW, but has not objected to seven other pending applications for .NEWS. Furthermore, the Objection in this matter would, if submitted by the Applicant, undermine other Google gTLD applications such as .DOT, .DOC, and .DOG, which are purportedly premised on errors. These are raised as an estoppel argument to suggest that the Objector should be estopped in making its arguments in this Objection proceeding and that its position is therefore untenable. This argument is not persuasive and is not accepted. As for the applications for .NEW and .NEWS, these illustrate that the mere addition of an “s” to a root word may in fact create a different word with a

different meaning and is not simply a plural of the root word which causes confusion. With respect to the other applications for .DOT, DOC, and DOG, they are sufficient differences amongst them in terms of visual, phonetic and meaning criteria that they are unlike the proposed gTLDs for .CAR and .CARS. In any event, if all of these gTlds were subjected to full argument and submissions, those other applications may or may not be proper. However, they are not in issue in this Expert Determination and they carry little or no weight for the determination to be made in this Objection.

iii. It is said that the Objector relied on only three factors from the trademark cases (appearance, phonetics, and meaning) and ignored the other six factors normally applied in the American trademark cases for determining confusion, thereby leading to the erroneous presumption of a likelihood of confusion between the singular and plural forms of a string. This submission is not persuasive. After a careful review of the cases submitted by both parties, it is clear that the other factors referenced by the Applicant are specific to the trademark context, relating to the distinctiveness of a mark, its relative “strength” or “weakness” in connection with actual usage in relation to specific goods or services in specific markets. Those additional factors are well suited to and are uniquely applied in the trademark context for assessing confusion with a trademark. However, those additional tests or factors are of little assistance in assessing the likelihood of confusion as between two proposed generic terms as gTLDS for future use in connection with a complete domain name and a future website by unknown domain name registrants.

iv. The Applicant asserts that String Similarity Panel of ICANN has already determined that the plural of a singular form does not alone generate or cause confusion.



As discussed earlier, that submission is not accepted. The String Similarity Panel made no express endorsement or policy statement regarding singular\plural gTLDs. In any event an assessment by that Panel for any particular application or set of applications was subject to the String Objection Procedure established under the Guidebook and now followed to date with respect to the applied-for gTLD <.CARS> and the Objection in respect of that application. That String Objection Procedure was reviewed by ICANN and remains in place without change. The String Objection Panel has completed its mandate, a mandate which is different from this Expert Determination. The practices of that Panel cannot usurp the mandate on this Expert Determination to provide an independent assessment of a String Confusion Objection on the basis of the submissions from the affected parties in an adversarial context in accordance with applicable Guidebook and Rules.

v. The Applicant asserts that similar, even identical, marks may not create confusion when looked at in their entirety and in the proper context. That is certainly true with respect to trademarks where the two identical marks may be used in connection with different products or services, in different markets and geographic areas. By analogy, it is argued that the Objector and Applicant have different business plans and distinguishable service offerings. However, those tentative business models and plans do not differentiate the potential usage of the two gTLDs in issue nor do they neutralize or clarify the confusion created in the mind of the average, reasonable Internet user who is likely unaware of the nuanced differences in their business plans and models which are in any event still preliminary and under development. For the task of assessing confusion in the two applied for gTLDs, the appropriate context is the combination with a second level name and the prospect that the exact same second level

name will be used with both. If one Internet user registers a name, say SEDAN.CAR, and another Internet user registers the same second level name as SEDAN.CARS, albeit with a different registrar having a different business model, there remains a compelling likelihood of confusion. The differences in the registrars cannot dispel that likelihood of confusion for the average reasonable Internet user who is in all likelihood oblivious to the different registrars and their models.

vi. It is asserted that, according to the trademark and domain name cases, the top level domain is not a source indicator and the focus must instead be on the second level name. Therefore, it is submitted that any confusion at the second level should not be attributed to the top level but should be left to the UDRP process for resolution. It is true that courts and UDRP Panels have focused on the second level in the names and not the differences in the top levels among the existing top level domains such as .com, .biz or .net. to assess confusion in a trademark or domain name dispute. However, this submission is a double-edged sword for the purposes of the String Confusion Objection procedure for at least two reasons. First, where the exact same second level name is used in both <.CAR> and <.CARS> by different registrants, there is no differentiation at the second level. When the same second level name is combined with each of the applied for gTLDs, it is only the top level which arguably may provide the differentiation. However, as found above, the gTLD <.CARS> is essentially the same visually, phonetically and in meaning as <.CAR> and will clearly cause confusion by suggesting a common source or origin. If, as is suggested, current users are unlikely to focus on the top level as a basis for differentiation, then they are unlikely to appreciate the very subtle and immaterial distinction at the top level merely through the addition of the letter "s" in one of those names. Since no current top level domains provide for both

a singular and plural form of the same root term, current users are simply not attuned to appreciating such a fine distinction. Confusion is the likely result. Second, the quotes from trademark cases to the effect that the top level name is essentially “invisible” when assessing confusion are inapt and inapplicable on their facts for the task at hand in this String Confusion Objection procedure for new gTLDs. While the courts and panels in the trademark cases look at the second level of a domain name where the trademark in issue is actually used or referenced in order to assess the likelihood of confusion, the String Confusion Objection procedure directs the analysis to the top level and thereby to the prospect of confusion in the combination of the names at the top and second levels. It is also inappropriate to suggest that any resulting confusion for specific name registrations should be addressed only in the UDRP process and that the root of the problem, the two confusing gTLDs should be allowed to proceed separately at this time. To do so would establish a name registration framework which would inevitably invite and lead to name registration abuse, a result which ICANN seeks to avoid in its mission with the New gTLD Program. Such a framework would also add extra expense for user registrants and also undermine the ICANN objective of reducing costs by facilitating fair competition. The increased costs may arise in one of two ways if the two proposed gTLDs proceed. First, a user may feel compelled to incur the expense of registering under both gTLDs to avoid confusion. Second, if a user registers under only one of the two applied-for gTLDs (assuming both are granted), the door is left open for another user to register the same second level name under the other gTLD and the prospect of disputes and legal costs arising as a result is very real. The cases produced by both parties amply illustrate that confusing registrations can and are used to promote improper activities including identity theft, phishing for personal information,

deployment of viruses, and online fraud etc. Allowing both of the proposed gTLDs to proceed independently to delegation will encourage copycat registrations as between the two gTLDs and lead to ongoing costly legal disputes arising from the confusion which will only serve to undermine the stability of domain name system. There is no obvious or pressing justification which has been put forward for allowing both <.CAR> and <.CARS> to proceed. Instead of requiring future registrants to deal with the likely confusion in future UDRP proceedings, the confusion can be readily averted at this time, while still encouraging legitimate competition in the same name space for automobile related names. There are many other such names which can be used, some of which are subject to other gTLD applications, without allowing two virtually identical names as gTLDs which are likely to cause confusion or worse for the average, reasonable Internet user.

While the foregoing review of the Applicant's submissions is not exhaustive, it sets out sufficient reasons for my conclusion that the position of the Applicant must be rejected and that the applied-for gTLD <.CARS> is likely on a balance of probabilities to cause confusion with the applied-for gTLD <.CAR> in the mind of the average reasonable Internet user. Therefore both of these gTLDs should be placed in the same contention set in accordance with the Guidebook and Procedure.

Both parties made some additional submissions on the impact of the singular and plural gTLDs on non-English speakers which warrant a brief comment. In coming to this Expert Determination on this Objection, I have not relied upon the submission of the Objector that additional difficulties will be created for non-English speaking Internet users by the addition or subtraction of an "s" for a gTLD such as those in issue in this

Objection. The studies adduced by the Objector do suggest that the differentiation between the singular and plural terms can be very different, even non-existent in other languages such as French, Korean, Chinese and Japanese (see Swan and Smith, *Learner English*, Cambridge University Press, 2001, at pages 66, 304, 318 and 335). Those whose mother tongue is one of these other languages and who then learn English as a second language may continue to have difficulty with singular\plural distinctions when speaking and understanding English (see for example Lightbrown and Spada, *Effects on Second Language Learning in Focus-On-Form Corrective Feedback in Communicative Language Teaching*, Authority # 28 from Objector authorities, at pages 438-439). These studies suggest that the use of singular and plural gTLDs can be particularly problematic for non-English speaking Internet users or for those whose second language is English. This issue could further compound the likelihood of confusion which already exists for Internet users whose first language is English. However, only limited studies and no other evidence was adduced on this issue. The record before me is incomplete and inadequate to draw any clear conclusions on the applicable standard. This may be a potentially significant issue for a broader policy debate on the use of singular and plural terms as gTLDs. However, I have not relied on this submission in coming to my conclusion and determination. I am satisfied on a balance of probabilities that the use of the gTLDs of <.CARS> and <.CAR> will create a likelihood of confusion in the mind of an average reasonable Internet user whose first language is English. If and when ICANN conducts a policy review of the use of singular and plural gTLDs, this language issue and its impact on domain names may be deserving of closer scrutiny.

Finally, the Applicant has raised an argument about the motivation of the Objector Charleston and its parent company, Google Inc., which also merits comment. The

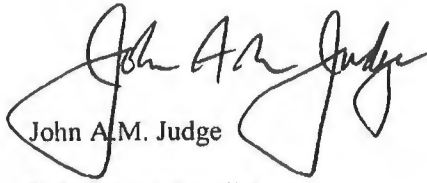
Applicant has submitted that Charleston\Google is motivated not by a desire to prevent consumer confusion but rather by a desire to force other applicants into a contention set auction where Google would enjoy a significant advantage due to its vast resources. Therefore it is submitted that the Objection should be dismissed and the application of DERCars should proceed. Based on the criteria governing this String Objection Procedure as mandated in the Guidebook, this argument is completely irrelevant. It is not within the purview of this Expert Determination to comment upon the motivation of any party, save perhaps if there was cogent evidence of bad faith on the part of a party which is clearly not the case here. As it is entitled to do, ICANN has set up the auction process to resolve competing applications which are in a contention set. Some of the stated objectives of ICANN with the New gTLD Program are to encourage competition for domain name registration, expand consumer choice and reduce the cost of registration. The auction process was a chosen vehicle to achieve these goals in relation to contention sets of competing gTLDs. The extent to which a large company with significant financial resources may conceivably dominate the auction process is a policy issue for ICANN to consider or reconsider in order to achieve its objectives of increased competition and reduced costs. This is not a matter on which any opinion can or should be expressed in this Expert Determination. Therefore this particular submission of the Applicant has been completely discounted and disregarded in the determination of this String Confusion Objection.

**Determination**

Therefore, The Objector has prevailed and the Objection is sustained.

This Expert Determination is made in Toronto.

Dated: August 27, 2013

A handwritten signature in black ink, appearing to read "John A.M. Judge". The signature is stylized with large, sweeping loops and is positioned above the printed name.

John A.M. Judge

Sole Expert Panelist

**Reconsideration Request  
DERCars, LLC**

**Annex C**

*Charleston Road Registry Inc. v. Uniregistry, Corp.*,  
ICDR Case No. 50 504 238 13  
(10 Oct. 2013)



**International Centre for Dispute Resolution**

**New gTLD String Confusion Panel**

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Re: 50 504 T 00238 13

**Charleston Road Registry Inc.**

OBJECTOR

and

**Uniregistry, Corp.**

APPLICANT

String: <.cars >

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**EXPERT DETERMINATION**

**The parties**

The Objector is Charleston Road Registry Inc., of 1600 Amphitheatre Parkway, Mountain View, California 94043, USA, represented by Brian J Winterfeldt, Katten Munchin Rosenman LLP; 2900 K Street NW, North Tower, Suite 200, Washington, DC 20007-5118

The Applicant is Uniregistry, Corp., 3-110 Governors Square, 361 GT Grand Cayman, KY1-1108, KY, represented by John Berryhill, 204 E Chester Pike, First Floor, Suite 4, Ridley Park, PA, 19078.

**The New gTLD String Objected To**

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

**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 the Procedure 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**

1. On March 13, 2013, pursuant to the Procedure, the Objector filed with the International Centre for Dispute Resolution (“ICDR”) an ICANN gTLD String Confusion Objection that is the subject of this proceeding.
2. On March 18, 2013 the ICDR acknowledged receipt of the Objection and advised the parties that pursuant Article 9 of the Procedure it would conduct an administrative review of the Objection .
3. On April 3, 2013 the ICDR advised the Objector that it had conducted the administrative review and that the Objection complied with Articles 5-8 of the Procedure and with the ICDR Supplementary Procedures for String Confusion Objections (Rules) (“ the applicable ICDR Rules”) and that accordingly the Objection would be registered for processing.
4. On April 17, 2013, the ICDR advised the parties that the Applicant was invited to file a Response to the Objection.
5. On May 17, 2013 the Applicant filed its Response to the Objection.
6. On May 31, 2013, the ICDR advised the parties that it had conducted an administrative review of the Response to the Objection and noted that the Response complied with Article 11 of the new gTLD Dispute Resolution Procedure and with the applicable ICDR Rules.
7. On June 17, 2013 and pursuant to Article 13 of the Procedure, the ICDR appointed The Honourable Neil Anthony Brown QC as an Expert in this matter (“the Expert”). Prior to accepting appointment, the Expert, pursuant to Article 1 of the applicable ICDR Rules and to ensure compliance with Article 13(c) of the Procedure, declared to the ICDR that there were no circumstances likely to give rise to justifiable doubts as to his impartiality and independence. The Expert has satisfied himself that he was properly appointed.
8. Each party has made its advance payment of Costs pursuant to Article 14 of the Procedure.

9. On September 5, 2013 the Objector and the Applicant by their authorized representatives submitted to ICDR a Joint Request under Article 16 (d) of the Procedure for a suspension of the proceeding until the sooner of (a) further notice from the parties or (b) thirty (30) days as provided under Article 16(d). On October 8, 2013, the Objector notified the ICDR that it wished the proceeding to proceed to a panel determination. The Expert will therefore proceed with its determination.

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

Section 3.2.2. of Module 3 of the Guidebook provides that objectors must satisfy standing requirements to have their objections considered. Section 3.2.2.1 of that Module provides *inter alia* that in the case of a string confusion objection, "(a)ny gTLD applicant in this application round may file a string confusion objection to assert string confusion between an applied-for gTLD and the gTLD for which it has applied, where string confusion between the two applicants has not already been found in the Initial Evaluation. That is, an applicant does not have standing to object to another application with which it is already in a contention set as a result of the Initial Evaluation."

The Objector is an applicant in the current round of applications for the gTLD <.car> and string confusion between the Objector and the Applicant has not been found in the Initial Evaluation. The Objector therefore has standing to make the present objection.

#### **Factual Background**

1. This is a proceeding to determine whether the proposed generic Top Level Domain <.cars> is confusingly similar to the applied for generic Top Level Domain (gTLD) <.car>. It is brought pursuant to Module 3 of the gTLD Applicant Guidebook ("the Guidebook") approved on June 20, 2011 and as updated on June 4, 2012 by the Internet Corporation For Assigned Names and Numbers ("ICANN"), the Procedure and the applicable ICDR Rules.
2. The Parties are Charleston Road Registry Inc., a United States company ("Charleston Road" or "the Objector") which is the Objector and Uniregistry, Corp. , a United States company ("Uniregistry" or "the Applicant") which is the Applicant for the new gTLD <.cars> and hence the Respondent in this proceeding.
3. Charleston Road is the Objector as it is the applicant in the current round of applications for the proposed gTLD <.car>. It argues that the string of the proposed <.cars> TLD applied for by Uniregistry is confusingly similar to the string of the applied for TLD <.car>. Uniregistry maintains that the string of the proposed <.cars> TLD is not confusingly similar to the string <.car>.

#### **Parties' Contentions**

##### **Objector**

The Objector makes the following contentions.

1. This Objection is based on string confusion as defined.
2. The Objector has standing because it is an Applicant for the <.car> string. On 26 February 2013 ICANN published its list of contention sets and the Objector's <.car> application was not placed in a contention set with the Applicant'/Respondent's <.cars> string.
3. The Objection is valid and should be upheld as it is likely that impermissible confusion will result if both the <.car> and the <.cars> gTLDs are delegated.
4. The Objector is owned by Google Inc., the prominent provider of internet services and a company that wishes to extend the utility of the domain name system.
5. The Applicant/Respondent claims that it seeks to utilize in the internet's "best top-level domain alternatives."
6. The Panel's function is to consider if the applied for gTLD is likely to result in string confusion in the meaning set out in the Guidebook, Section 3.5.1. On the analysis here presented, <.cars> so nearly resembles <.car> that it is likely to deceive or cause confusion in the mind of the average, reasonable internet user.
7. The strings are virtually identical in appearance, as they are identical apart from the additional "s" making a plural and that is enough to establish confusing similarity by itself.
8. A high degree of confusing similarity in appearance comes from the mere addition of an "s" and pluralization and many UDRP panels have found confusing similarity between singular and plural domain names and trademarks. In fact there is nothing to differentiate the two TLDs other than pluralization.
9. There is a 72% visibility between the two strings on the ICANN similarity assessment algorithms.
10. "(T)here are no material differences in their appearance such that there is a likelihood of confusion (*sic*)".
11. The confusion will be probable and not merely possible.
12. Consumers and internet users will glance at email addresses and confuse the two TLDs which will lead to spoofing and phishing. They will also be confused with advertisements.
13. The two strings are virtually identical in phonetic sound and this shows confusing similarity by itself. Phonetic sound has been regarded as an important consideration in UDRP cases. This is particularly significant when goods and services are advertised orally.
14. The two strings are virtually identical in meaning, a situation exacerbated in the case of singular and plural spellings and where, as in the present case, the proposed uses of the two TLDs are the same. Commercial meaning has been accepted as a determinant in cases of

confusing similarity under the UDRP. It is probable and not merely possible that internet users and consumers will glance at email addresses and confuse the two TLDs.

15. In previous rounds of applications for new gTLDs, confusing similarity arising from the singular and plural issue has been regarded as a relevant consideration.

16. The addition or deletion of the plural “s” poses difficulties in human recollection and also for non-English speakers.

17. Thus, practical concerns as well as legal and factual precedent, weigh in favour of a finding of likely confusion to the average internet user if <.car> and <.cars> are delegated.

18. The Objection should be upheld and both TLDs be placed in a contention set.

### **Applicant**

The Applicant makes the following contentions.

1. Claimant has not discharged its burden of producing relevant evidence of the alleged confusing similarity; see gTLD Applicant Guidebook Module 3, Section 3.5.
2. The standard of proof on the Objector is higher than under trademark law and has not been met by the Objector.
3. Neither the <.car> TLD nor the <.cars> TLD is a trademark.
4. A generic TLD is incapable of serving as a trademark. Neither of the two TLDs is a trademark and both are generic words with no distinctiveness.
5. It is the ICANN Guidebook that determines the applicable rules: 3.5.1.
6. The Complainant’s various conclusions, premised on situations involving highly distinctive marks, are thus built upon having skipped the necessary preliminary step of first determining the degree of distinctiveness in the things to be compared.
7. The differences between <.car> and <.cars> are at least as great as those among existing TLDs, e.g. <.ca>. There are also country codes that differ from each other by a single letter. These abundant “single letter” similarities are an accepted feature of the Internet name system. These two TLDs are generic words and small differences between generic words are accepted as part of the domain name system; as with <lawyers.com> and <lawyer .com> and also with <car.com and <cars.com>.
8. The two TLDs are not trademarks but generic words.
9. Internet users are sophisticated enough to select the TLD in which they want to register their domain name. ICANN has clearly decided that singular and plural pairs are not confusingly similar. This is particularly so where the decision to register a domain name will be by a sophisticated person in the industry.

10. The cases cited by the Objector are cases where there was a distinctive mark, but in the present case there is less distinctiveness as it concerns 2 generic words.

11. There is no evidence of actual confusion.

12. It is widely known that singular and plural words are different and that they mean different things. ICANN understood that fact. That is because if determined now, there will be inconsistent results and no one will know what is singular and what is plural. In reality people will adapt to the new gTLDs and recognize the differences between one and the other.

13. Accordingly the Objector has not made out the confusing similarity ground.

14. If competition is the touchstone of the new regime as ICANN says it is, we should not eliminate choice from competing entities which would happen in the case of generic words if the Objector succeeds.

## **Discussion and Findings**

### **Preliminary Issue: Request for Notice of New Authority**

In the course of the Expert's deliberations, the Applicant filed and served a notice entitled Request for Notice of New Authority. The purpose of that notice was to draw to the Expert's attention two authorities decided after the Response of the Applicant had been filed with the ICDR. The first of those two decisions is *Charleston Road Registry Inc. v. Koko Castle, LLC*, ICDR Proceeding 50 504 233 13 - .CAR/.CARS. In that matter, the Expert held that the new gTLD string applied for and objected to, namely <.cars>, was not confusingly similar to the gTLD <.car> applied for in the same application round by the Objector, who is also the Objector in the instant proceeding. The second decision is *Hotel Top-Level-Domain S.a.r.l.v. Booking.com B.V.* ICDR Proceeding 50 504 237 133 .HOTEL/.HOTELS. In that matter, the Expert held that the new gTLD string applied for and objected to, namely <.hotels>, was not confusingly similar to the gTLD <.hotel> applied for in the same application round by the Objector. The use to which the Applicant invited the Expert to make of these decisions was that if a decision were made in the instant proceeding that was different from the decision in *Charleston Road Registry Inc. v. Koko Castle, LLC*, (*supra*), untoward practical consequences would flow. It was submitted that those consequences were that there would be "two contention sets – (a) one set for .CARS applications only, and (b) one set for a mix of .CAR and .CARS applications. The result of the ICANN auction in that circumstance could produce the paradoxical result of two prevailing .CARS TLD applications from the ICANN contention auctions in those two sets, and there is no provision in the ICANN TLD process to address that circumstance. Conflicting results from string contention panels would further bring the consistency and legitimacy of the policy into question." The second decision was presumably relied on as a similar fact situation. The implication of the submission was therefore that the Expert should not make a determination different from that in *Charleston Road Registry Inc. v. Koko Castle, LLC*, (*supra*).

The Objector replied to this submission by contending that the Expert should issue an independent determination based on the particular merits of the string confusion objection i.e. that the Expert should not simply determine the matter by following the decision in *Charleston Road Registry Inc. v. Koko Castle, LLC*, (*supra*). The first reason advanced for that submission was that the ICDR had already issued "independent, yet technically conflicting results among string

contentions regarding singular and plural versions of strings in *Charleston Road Registry Inc. v. John Island, LLC*, ICDR PROCEEDING 50-504-00274-13; .PET / .PETS.” The second reason advanced was that the Applicant Guidebook and the President of the ICANN Generic Domains Division “already acknowledge that separately filed objections necessitate independent, yet potentially inconsistent determinations.”

The Expert rejects the Request for Notice of New Authority, declines to dispose of the instant proceeding by automatically following the determination in *Charleston Road Registry Inc. v. Koko Castle, LLC*, (*supra*) and will proceed to make an independent determination on the merits in the instant string confusion objection. The reasons for that decision are substantially the above two reasons advanced by the Objector in its reply, with which the Expert agrees. In elaboration, it is difficult for the Expert to decide how ICANN might deal with the potential conflicts that the Applicant contends will arise, but the process is ICANN’s, it has control over the entirety of the process, it seems to have contemplated that some such problem may arise during the process and it is ICANN’s role to manage the remainder of the process. Indeed, the parties are bound by ICANN’s process, they have agreed to it by virtue of taking part in it and it would be inappropriate for the Expert to intervene by not making the independent determination that the Applicant Guidebook requires and which the Expert has agreed to give. In addition, the Objector has followed the process that entitles it to an independent decision and it would be a denial of its rights, without justification, in effect to abandon that process and not make an independent determination. The Expert will therefore proceed to deal with the proceeding in the usual manner on its merits.

### **Substantive Issues**

1. **Burden of proof.** The first matter to be considered is which party bears the burden of proof. In this matter the burden of proof is on the Objector. That would be so as a matter of general principle even without any specific provision in the ICANN documents governing this proceeding; the proceeding concerns an attempt by the Objector to dislodge the Applicant/ Respondent from its prospective entitlements and rights under the application for a new gTLD under the new TLD arrangements and the burden of making out a case for doing so must rest on the party who wishes to achieve it.

2. But even apart from general principles, the relevant provision in the ICANN Guidebook makes it clear beyond doubt that the burden of proof is on the Objector. That conclusion is drawn from Section 3.5 of Module 3 in the Guidebook, which provides, among other things, that “The objector bears the burden of proof in each case”. The onus is therefore on the Objector to prove its case.

3. The same proposition is stated again in the section of the Guidebook devoted to procedures, namely the Attachment to Module 3. That procedure provides as follows:

#### **Article 20. Standards**

(a) For each category of Objection identified in Article 2(e), the Panel shall apply the standards that have been defined by ICANN.

(b) In addition, the Panel may refer to and base its findings upon the statements and documents submitted and any rules or principles that it determines to be applicable.

(c) The Objector bears the burden of proving that its Objection should be sustained in accordance with the applicable standards.”

4. But the question instantly arises: if the burden of proof is on the Objector, what does the Objector have to prove? The answer to that question is contained in the provisions in the Guidebook relating to certain standards that must be applied in these proceedings. That requirement comes about because, first, Article 20 of the Procedure requires the Panel to apply the standards defined by ICANN. Secondly, Section 3.5 of Module 3 of the Guidebook provides for certain “Dispute Resolution Principles (Standards)” and Section 3.5.1 of the Module contains the standards to be applied in cases of String Confusion Objections. Those standards are as follows:

#### **“3.5.1 String Confusion Objection**

A DRSP panel hearing a string confusion objection will consider whether the applied-for gTLD string is likely to result in string confusion. String confusion exists where a string so nearly resembles another that it is likely to deceive or cause confusion. 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.”

5. Thus, in the present case, to comply with the standards, Charleston Road must prove that the applied for <.cars> TLD is likely to result in string confusion with the gTLD for which it has applied, namely <.car> and within the meaning articulated in the standard. In particular, the standard requires the Objector to prove that string confusion is “likely to result.” This does not weaken the burden on an Objector, but strengthens it.

6. The provisions of the Guidebook just referred to and dealing with standards then gives an indication of when it is likely that a string confusion has arisen. Module 3, Section 3.5.1 provides that:

“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.”

7. Thus, a mere possibility of string confusion is not enough and the time-honored criterion of “probably” must be satisfied; moreover, the probability of confusion must have arisen in the mind of the average, reasonable Internet user.

8. The notion of probability is not confined to Section 3.5.1 of Module 3. It has previously been invoked in the definition of “similar” which appears on two occasions in the Guidebook. The first occasion is in Module 1, Section 1.1.2.10 where it is said:

“In this Applicant Guidebook, ‘similar’ means strings so similar that they create a probability of user confusion if more than one of the strings is delegated into the root zone.” (Module 1, Section 1.1.2.10).

The second occasion is in Module 2, Section 2.2.1.1 where the same definition appears:



"In this Applicant Guidebook, 'similar' means strings so similar that they create a probability of user confusion if more than one of the strings is delegated into the root zone."

9. But the test of whether it is probable that confusion will arise in the mind of the average, reasonable Internet user must be applied judicially and it is not enough to conclude that someone, somewhere will probably be confused by the string. The test is made more specific than that by requiring that the probable confusion must be in the mind of "the average, reasonable internet user." The task of the Expert in the present proceeding is therefore to place itself in the position of the average, reasonable internet user and to assess whether such a person would probably be confused by the proposed string.

10. Then, in this analysis of principles, the question arises: what is string confusion? To that question the answer is given, as has been noted, in Section 3.5.1 of Module 3, namely that "(s)tring Confusion exists where a string so nearly resembles another that it is likely to deceive or cause confusion."

11. Finally, the standards add another cautionary rule in interpreting the Module and in assisting Experts to decide whether in a given case, a likelihood of confusion has been established. This is achieved by reminding the Expert that just because an object reminds one of something else, does not mean that the observer is confused between the two. It does this by providing: "Mere association, in the sense that the string brings another string to mind, is insufficient to find a likelihood of confusion." Logically, that is a correct statement and a timely reminder, as is well illustrated by the observation of the court in *In re Ferrero*, 479 F.2d 1395, 1397 (CCPA 1973) that:

"Seeing a yellow traffic light immediately 'calls to mind' the green that has gone and the red that is to come, or vice versa; that does *not* mean that confusion is being caused. As we are conditioned, it means exactly the opposite."

12. Putting all of these criteria together clarifies the task of the Expert and shows the obligations of an Objector in these proceedings. Those obligations are that the Objector:

- (a) must prove its case;
- (b) must do so on the balance of probabilities and must therefore show that string confusion will probably occur; noting that
- (c) it is not enough to show that string confusion is a possibility; and
- (d) what the Objector has to prove is that string confusion is likely to result; and
- (e) it must prove that the string confusion is likely to arise in the mind of an average, reasonable Internet user;
- (f) the state of string confusion that must exist for the Objector to succeed is where "a string so nearly resembles another that it is likely to deceive or cause confusion";
- (g) finally, that task will not be assisted by showing that the string brings another string to mind.

13. The starting point in this inquiry consists of the terms of the objection itself.

The Objection is:

***“String Confusion Objection*** – 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.”

As has been noted, “similar” has in effect been defined in two provision in the Guidebook ,Module 1, Section 1.1.2.10 and Module 2, Section 2.2.1.1, namely : “In this Applicant Guidebook, ‘similar’ means strings so similar that they create a probability of user confusion if more than one of the strings is delegated into the root zone.”

14. The applied for string is <.cars>. The TLD applied for by the Objector is <.car>. The question is therefore whether the string <.cars> is confusingly similar to the string <.car>. The Determination of this Expert is that the string <.cars> is not confusingly similar to the string <.car>. That is so for the following reasons.

15. There are essentially two questions which, to some extent overlap, but they are nevertheless two questions. The first question that arises is whether the two strings are similar, as defined in the Guidebook. The second question is whether, if the two strings are similar, are they confusingly so? As to the first question, the two strings clearly have a common feature, namely the word “car”. But it is equally clearly ICANN’s intention that in interpreting whether that fact makes the two strings similar, the Expert should use the definition that has been mandated in the Guidebook and repeated. The question is therefore whether the two strings are so similar that they create the probability of user confusion. The Expert’s view on that question is that they are not similar, as they will not probably give rise to user confusion. Users will recognize that one of the strings is singular and one of them is plural and that that difference means that they should regard the two strings as different, as they are. Internet users are now very well aware that, on the internet, small differences in spelling and meaning are significant and that they mean different things, will lead to different destinations such as websites and email destinations and will carry consequences, such as whether communications are genuine and reach their correct destinations. Internet users have become increasingly aware of such differences and are now mature and sophisticated enough to realize it, when they are being presented with such differences; indeed, internet users are so astute to such matters that they now look for them to ensure as best they can that they are not being mislead or deceived. There will therefore, in the opinion of the Expert, be no probability of user confusion if the two strings are delegated into the root zone.

17. The second question is whether, if the two strings are similar, are they confusingly similar? This is by far the more significant question. The Expert finds that the string <.cars> is not confusingly similar to the string <.car>. In particular, the opinion of the Expert is that the Objector has not discharged its burden and its Objection therefore fails.

18. We have already seen from the Guidebook and the standards that must be applied that the Objector must show:

- (a) that the new gTLD <.cars> is likely to result in string confusion;
- (b) that the confusion must arise in the mind of the average, reasonable internet user ; that
- (c) string confusion will be said to have arisen where a string so nearly resembles another that it is likely to deceive or cause confusion; bearing in mind that mere association, in the sense that the string brings another string to mind, is insufficient to find a likelihood of confusion.

19. Taking each of these requirements in turn and applying the standards specified in Section 3.5.1 of Module 3:

- (a) In the opinion of the Expert, the proposed new gTLD is not likely to result in string confusion. It is of course possible that some internet user will be confused by the two strings. That does not mean that it is likely and the Expert is of the opinion that it is not likely. It must be borne in mind that the Guidebook admonishes against finding that there is a mere possibility and then drawing from that finding the conclusion that a possibility makes something likely or probable, as it clearly does not. The possibility identified will, at most, exist only in very few cases and the applied for gTLD <.cars> will not give rise to string confusion with the <.car> TLD. That is so because the reader and the user will appreciate the fact that the two words that constitute the strings, "cars" and "car", are separate words, with distinct meanings, with each of them being capable of being given their own function, namely that the former invokes cars in general and as a group, while the latter clearly invokes the concept of a single entity and that there is no reason why they should be understood as regarded as being used, in the internet context, in anything other than those distinct meanings.
- (b) Moreover, it must be remembered that when the standard provides that the Objection can succeed only when the new TLD is "likely to result in string confusion" it means "string confusion" as defined. Section 3.5.1 defines string confusion as such a state of resemblance between the two strings "that it is likely to deceive or cause confusion." The opinion of the Expert is that the resemblance between the two strings in question will not deceive or cause confusion among users. That is so because internet users will appreciate that the words are different, that they have their own meanings, that they are being used as separate TLDs which by necessity must be different and they will also draw on their own experiences of using the internet. That experience tells them that differences in spelling, let alone differences in spelling that constitute different words, have immense consequences when it comes to website addresses, domain names, email addresses, passwords and elsewhere and that a change of one letter, a change in punctuation or even in the case in which a word is typed will mean the difference between using the internet successfully or not. Because of that experience and because of the times when they have been frustrated in the use of the internet, users are now permanently on the look out for such differences and will be particularly astute to take notice of them. There is therefore an air of unreality in the argument that internet users will think that two proposed new TLDs with resemblances in spelling, but where one of them relates to a singular concept and the other relates to a plural concept, are actually the same as or associated with each other or that there is some connection such that they will be deceived or confused between the one and the other.
- (c) The Expert also holds that it is unlikely that string confusion will result in the present case in the mind of the average, reasonable internet user. Indeed, the average, reasonable internet user is less likely to be confused in the way claimed by the Objector than other candidates, because he or she is astute to the basic workings of the internet and knows in particular that even small spelling

differences in words often have great significance. Thus the objection does not give average, reasonable internet users the credit that they deserve, as it should not be assumed that if they see the two words, one singular and one plural, they will not appreciate immediately that they are separate words with their own meanings and uses. It is also one of the characteristics of average, reasonable internet users that they are now, probably more than ever, on their guard and likely to be curious about similarities in spelling and what they signify. Many average, reasonable internet users who have registered a domain name have also had to make a choice about the top level domain in which they register their domain name and are thus aware of differences between the various top level domains and what they signify and are unlikely to be confused between two domains that have respectively a singular and a plural connotation. Moreover, the average, reasonable internet user is by definition familiar with the internet and the suggestion that internet users cannot tell one TLD from another, even if the spelling is similar, sells their knowledge short and is unjustified. Accordingly, no confusion will arise in the present case in the mind of the average, reasonable internet user between <.cars> and <.car>.

- (d) The string <.cars> does not so nearly resemble another that it is likely to deceive or cause confusion. As has been noted above, each string is a separate word and readily recognized as such; each word has a meaning sufficiently different from the other word to give it a unique character. All of these factors support the notion that average, reasonable internet users will appreciate the difference between the two TLDs and accordingly, they will not be deceived or confused.
- (e) For reasons of completeness, the Expert also finds on the balance of probabilities and in the present context, that the string <.cars> does not bring the string <.car> to mind, but that if it did, it is by virtue of the express words of the standard insufficient to find a likelihood of confusion.

20. The Panel will now deal with a number of other arguments that have been raised during the proceeding, to provide an opportunity to elaborate, where appropriate, on the arguments already advanced. They are as follows.

1. The Objector has argued that the two strings are nearly identical visually and orthographically by virtue of the pluralization created by the additional letter "s". It then argues that <.cars> is therefore likely to result in string confusion. That is of course the issue that must be resolved by the Expert. In support, the Objector cites judicial decisions and decisions by UDRP panels. Naturally the Expert gives respect to those decisions, but they are not binding on the Expert who is tasked with performing a unique function that was not before those who decided the cases referred to. The Expert's function is clearly intended to be performed within the context of the decision of ICANN to expand the internet by issuing new gTLDs and within the specific rules on the burden and standard of proof to be applied. For example, the Objector submits that "internet users and consumers", apparently in general, will be confused, whereas ICANN has specified that the question is whether the "average, reasonable internet user" will be confused. It is also wrong, in the opinion of the Expert to approach the task by assuming that internet users will only "glance" at email addresses, as the Objector submits. The Expert has already

noted that the average, reasonable internet user today does far more than glance at email addresses and web addresses, especially if he or she is about to send private communications or money over the internet; most internet users know from hard experience that a mere glance is more likely than not to result in using a wrong email address or website with sometimes serious consequences. These days, with concern about internet security and in the coming era of new gTLDs the average reasonable internet user is very likely to be careful about the precise spelling of email and web addresses and they know that small differences, especially in a generic context, are likely to have immense significance.

Indeed, that very point has been made in judicial and UDRP decisions, as has been noted by the Applicant, in cases such as *Entrepreneur Media, Inc. v. Smith*, 279 F. 3d 1135, 1147 (9th Cir., 2002) concerned with the difference between ENTREPRENEUR and ENTREPRENEUR PR ( “[i]n the Internet context, consumers are aware that domain names for different Web sites are quite often similar, because of the need for language economy, and that very small differences matter (;)” and between the singular “Tire Discounter” and the plural “Tire Discounters”, a finding of no confusing similarity: *Tire Discounters, Inc. v. TireDiscounter.com*, NAF Claim Number: FA0604000679485 (“[b]ecause the mark is merely descriptive, small differences matter.”)

Moreover, ICANN’s promotion of the new regime of TLDs has been so prominent and effective that average, reasonable internet users must by now be very aware that there are to be new TLDs and are probably on the lookout for them and the differences in spelling that may accompany them. They are therefore less likely to be confused than might be thought.

2. The Objector has also argued that the two strings are virtually identical in terms of phonetic sound and that consumers, hearing them will be confused. Some consumers may be confused and the ICANN structure contemplates this, which is probably the reason it has built in a standard of proof that will enable new gTLDs to be delegated in appropriate cases but avoid unacceptable degrees of confusion. But it is difficult to imagine widespread confusion coming from hearing the words “car” and “cars” pronounced and the opinion of the Expert is that any such confusion will not be probable or likely.

3. The Objector argues likewise that the two words have virtually identical meanings and that the two TLDs will be used for the same or similar purposes. The Expert is unable to say what uses the disputed TLDs will be put to with any certainty and cannot use a speculative matter like that to determine the outcome of the present Objection.

4. Likewise the submissions of the Objector on the difficulties some people, especially non-English speaking people, have in remembering if they had a singular or plural password and the unique features of some foreign languages are interesting but far too speculative to contribute to the decision that the Expert has to make. This is, again, due to the fact that there are specific rules on the burden and standard of proof that are applicable here and the Expert feels obliged to confine itself to those criteria. This is not a limitation at all, as the ICANN rules provide a workable regime within which the Expert can reach a decision in this matter.

21. For all of the foregoing reasons, the Objector has not discharged its burden in this proceeding.

**Determination**

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

October 10, 2013.

A handwritten signature in black ink, appearing to read 'Neil Anthony Brown', with a long horizontal flourish extending to the right.

The Honourable Neil Anthony Brown QC

Sole Expert Panelist

**Reconsideration Request  
DERCars, LLC**

**Annex D**

Recommendation of the Board Governance  
Committee, Reconsideration Request 13-9, at 10-11  
(10 Oct. 13)

**RECOMMENDATION OF THE BOARD GOVERNANCE COMMITTEE (BGC)**

**RECONSIDERATION REQUEST 13-9**

**10 OCTOBER 2013**

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On 4 September 2013, Amazon EU S.a.r.l. (“Amazon”) submitted a reconsideration request (“Request”). The Request asked the Board to reconsider the 21 August 2013 Expert Determination from a dispute resolution Panel established by the International Centre for Dispute Resolution (“ICDR”) sustaining Commercial Connect LLC’s (“Commercial Connect”) objection to Amazon’s new gTLD application for the Japanese translation of “online shopping” (“Amazon’s Applied-for String”) as being confusingly similar to Commercial Connect’s application for .SHOP (“Commercial Connect’s Applied-for String”).

**I. Relevant Bylaws**

Article IV, Section 2.2 of ICANN’s Bylaws states in relevant part that any entity may submit a request for reconsideration or review of an ICANN action or inaction to the extent that it has been adversely affected by:

(a) one or more staff actions or inactions that contradict established ICANN policy(ies); or

(b) one or more actions or inactions of the ICANN Board that have been taken or refused to be taken without consideration of material information, except where the party submitting the request could have submitted, but did not submit, the information for the Board's consideration at the time of action or refusal to act; or

(c) one or more actions or inactions of the ICANN Board that are taken as a result of the Board's reliance on false or inaccurate material information.

Dismissal of a request for reconsideration is appropriate if the Board Governance Committee (“BGC”) recommends, and in this case the New gTLD Program Committee (“NGPC”) agrees, that the requesting party does not have standing because the party failed to



satisfy the criteria set forth in the Bylaws. These standing requirements are intended to protect the reconsideration process from abuse and to ensure that it is not used as a mechanism simply to challenge an action with which someone disagrees. The reconsideration process is for situations where the staff acted in contravention of established policies (when the Request is based on staff action or inaction).

The Request was received on 4 September 2013, which makes it timely under the Bylaws. Bylaws, Art. IV, § 2.5.

## **II. Background**

### **A. The New gTLD Objection Procedure**

The New gTLD Program includes an objection procedure pursuant to which objections to applications for new gTLDs are submitted to an independent dispute resolution service provider (“DRSP”). The objection procedures are set out in Module 3 of the Applicant Guidebook (“Guidebook”) (<http://newgtlds.icann.org/en/applicants/agb/objection-procedures-04jun12-en.pdf>) and the New gTLD Dispute Resolution Procedure (the “Procedure”) attached thereto.

As detailed in the Request, Commercial Connect filed a string confusion objection with the ICDR asserting that an “applied-for string is confusingly similar to an existing TLD or to another applied-for gTLD string in the same round of applications.” (Guidebook, Section 3.3.2.1; Procedure, Art. 2(e).)<sup>1</sup>

To initiate a dispute resolution proceeding, an objection must comply with the procedures set out in Articles 5-8 of the Procedure. This includes the requirement that objections be filed with the appropriate DRSP with copies to the gTLD applicant against which the objection is

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<sup>1</sup> Where a new gTLD applicant successfully asserts string confusion with another applicant, the two strings are placed in a “contention set” to be resolved per the String Contention Procedures in Module 4 of the Applicant Guidebook. (Guidebook, Section 3.2.2.1.)

being raised. (Procedure, Art. 7 (b).) Before an objection is registered for processing, the DRSP conducts an administrative review to verify compliance with Articles 5-8 of the Procedure and the applicable DRSP Rules, and informs the objector, the applicant and ICANN of the result of its administrative review. (Procedure, Art. 9(a).)

A Panel of appropriately qualified expert(s) appointed by the designated DRSP will consider an objection that has been registered for processing and for which a response has been submitted. (Guidebook, Section 3.4.4.) Each Panel will determine whether the objector has standing to object and will use appropriate general principles/standards to evaluate the merits of each objection. The Panel must apply the standards that have been defined in Section 3.5 of the Applicant Guidebook for each type of objection. (Guidebook, Section 3.5; Procedure, Art. 20.)

The Panel's final determination will include a summary of the dispute and findings, identify the prevailing party, and provide the reasoning upon which the expert determination is based. (Guidebook, Section 3.4.6; Procedure, Art. 21.) The findings of the Panel will be considered an expert determination and advice that ICANN will accept within the dispute resolution process. (Guidebook, Section 3.4.6.)

**B. Commercial Connect's Objection to Amazon's Applied-for String**

Amazon is an applicant for the Japanese translation of "online shopping." Commercial Connect objected to Amazon's Applied-for String, asserting that it was confusingly similar to Commercial Connect's Applied-for String ("Commercial Connect's Objection"); Amazon filed a response. The ICDR's appointed Panelist (the "Panel") rendered an "Expert Determination" on 21 August 2013. The Panel determined that Commercial Connect had standing to object as an applicant for .SHOP, and rejected claims by Amazon that Commercial Connect did not properly serve its objection on Amazon. (Expert Determination, Pg. 3.) Based on the evidence and the parties' submissions, the Panel sustained Commercial Connect's Objection on the grounds that

Commercial Connect's Applied-for String is confusingly similar to Amazon's Applied-for String (Expert Determination, Pgs. 4-5.)

Although Commercial Connect's Objection was determined by a third-party DRSP, ICANN has determined that the Reconsideration process can properly be invoked for challenges of the third-party DRSP's decisions where it can be stated that either the DRSP failed to follow the established policies or processes in reaching the decision, or that ICANN staff failed to follow its policies or processes in accepting that decision. See BGC Recommendation on Reconsideration Request 13-5 at <http://www.icann.org/en/groups/board/governance/reconsideration/recommendation-booking-01aug13-en.doc>.

### **III. Analysis of Amazon's Request for Reconsideration**

Amazon seeks reconsideration of the Panel's decision sustaining Commercial Connect's Objection. More specifically, Amazon requests that ICANN disregard the Panel's Expert Determination, and either instruct a new Panel to review Commercial Connect's string confusion objection with the standards set forth in the Applicant Guidebook or make the necessary accommodations to allow for a "non-discriminatory application of ICANN standards, policies and procedures." (Request, Section 9.)

#### **A. The ICDR and the Panel's Acceptance of Commercial Connect's Objection Does Not Demonstrate A Process Violation**

In its Request, Amazon contends that the ICDR and the Panel failed to follow the established process for registering and/or accepting Commercial Connect's Objection. Specifically, Amazon claims that Commercial Connect failed to provide Amazon with a copy of the objection as required by Article 7(b) of the Procedure, and that this failure is a deficiency that cannot be rectified under the Procedure. (Request, Pgs. 8-10; Annex 4 to Request (19 April 2013

Letter from Amazon to the ICDR.) Pursuant to Article 9(d) of the Procedure, which provides for dismissal of objections that do not comply with Articles 5-8 of the Procedure and where deficiencies have not been cured in the specified timeframe, Amazon contends that the ICDR should have dismissed Commercial Connect's Objection and closed the proceedings. (Request, Pg. 10; Annex 4 to Request (19 April 2013 Letter from Amazon to the ICDR); Annex 5 to Request (24 April 2013 Letter from Amazon to the ICDR).)

The Procedure makes clear that the ICDR was required to perform an administrative review of Commercial Connect's Objection, and to inform the objector, applicant, and ICANN of the results of its administrative review. (Procedure, Art. 9(a).) The available record shows that the ICDR complied with its obligations in this regard.

Amazon claims it received an email from the ICDR acknowledging receipt of Commercial Connect's Objection on 18 March 2013 – though, according to Amazon, that email did not specifically identify the string that was the subject of Commercial Connect's Objection. (Request, Pg. 9.) Soon thereafter, on 4 April 2013, Amazon states that it also received an email from the ICDR requesting that Commercial Connect provide “proof or statement” that copies of the objection were sent to Amazon. (Request, Pg. 9.)

Contrary to Amazon's assertions, failure to provide an applicant with a copy of the objection as required by Article 7(b) is a deficiency that can be cured under the Procedure. Article 9(c) provides that if the DRSP finds that the objection does not comply with Articles 5-8 of the Procedure, the DRSP “shall have the discretion to request that any administrative deficiencies in the Objection be corrected within 5 days.” (Procedure, Art. 9(c).) Accordingly, the ICDR's 4 April 2013 email, requesting Commercial Connect to cure the stated deficiency,

was consistent with the process established in the Procedure for the administrative review of objections.

According to the Request, subsequent to the ICDR's 4 April 2013 correspondence to Commercial Connect requesting it to provide proof of service of the objection on Amazon, Amazon claims it received the following documents from Commercial Connect:

- (i) A copy of Commercial Connect's application for .SHOP;
- (ii) A "online filing demand for arbitration/mediation form" that refers to Amazon's Applied-for String;
- (iii) A "dispute resolution objection" with blank unfilled spaces where the string applicant and relevant string would otherwise appear;
- (iv) a copy of Commercial Connect's 11 October 2000 applications for .MALL, .SHOP, and .SVC; and
- (v) A copy of a 5 April 2013 correspondence to the ICDR in which Commercial Connect certifies that copies of the complaint and attachments were sent via email to all respondents and to ICANN.

(Request, Pgs. 9-10.) From the above, although particular entries may have been left blank, it appears that Amazon did in fact receive a copy of the objection. Based on the 5 April 2013 correspondence from Commercial Connect certifying that copies were provided to Amazon, ICDR concluded that Commercial Connect corrected the deficiency within one day of being notified, well within the five-day period allowed under the Procedure.

In its 11 April 2013 correspondence to the parties, the ICDR indicates that Commercial Connect's Objection would be registered for processing. The ICDR states that it conducted a further administrative review and noted that Commercial Connect's Objection, "after rectifying deficiencies previously set forth, now complies with Articles 5-8" of the Procedure. (Request, Pg. 8; Annex 3 to the Request (11 April 2013 Letter from the ICDR).) The ICDR thereafter sent a letter on 17 April 2013 providing Amazon with notification of its thirty-day period to file a

response to Commercial Connect's Objection. (See Annex 5 to Request (24 April 2013 Letter from Amazon to the ICDR.)) Based on the above, Amazon lacks support for the claim that it did not receive notification that an objection had been filed against it and that Amazon was required to respond in order to avoid default.

Moreover, notwithstanding Amazon's own acknowledgment that it received a copy of the "dispute resolution objection" (albeit with certain entries left blank), the ICDR invited Amazon to raise the alleged procedural defects in Amazon's response to Commercial Connect's Objection. (Annex 6 to Request (3 May 2013 Email from ICDR to Amazon).) The Panel, having received and considered Amazon's claims of procedural deficiencies, rejected Amazon's claims indicating there was no actual prejudice to Amazon. The Panel noted:

[I]t appears that Applicant received actual notice of the Objection, and has been accorded a full and fair opportunity to be heard on its application. Applicant also has not shown that it was prejudiced by any alleged defects in the filing of the Objection. (Expert Determination, Pg. 3.)

In view of the above, the ICDR's acceptance of Commercial Connect's Objection for decision does not demonstrate a policy or process violation, and Amazon has not demonstrated otherwise.

**B. Amazon's Claim That The Panel Applied The Wrong Standard Is Unsupported And Is Not A Basis For Reconsideration.**

A separate ground of Amazon's Request is its contention that the Panel applied the wrong standard in evaluating Commercial Connect's Objection. Specifically, Amazon claims that the Panel applied a standard that considered "the use of essentially the same word in two different languages [as] sufficient to cause string confusion among the average, reasonable Internet user," and claims that such a standard would eliminate the need to evaluate translations of words on a case-by-case basis. (Response, Pg. 13.) Amazon further asserts that even if translations of essentially the same word were sufficient to cause string confusion, an English translation of

Amazon's Applied-for String is not the same as Commercial Connect's Applied-for String, and they have different meanings. (Request, Pg. 13.) Amazon relies on another ICDR Panel's determination, finding that Top Level Domain Holdings Limited's ("TLDH") application for the Chinese translation of "shop" ("TLDH's Applied-for String) is not confusingly similar to Commercial Connect's application for .SHOP,<sup>2</sup> as evidence that the Panel applied the wrong standard. (Request, Pg. 14; Annex 2 to Request.) Amazon concludes that "in the impossible event" that ICANN accepts the Panel's determination, the acceptance would "create inequitable and disparate treatment without justified cause" in violation of Article II, Section 3, of ICANN's Bylaws. (Request, Pg. 7)

In the context of the New gTLD Program, the Reconsideration process does not call for the BGC to perform a substantive review of DRSP Panel decisions; Reconsideration is for the consideration of process- or policy-related complaints. The Reconsideration process will not be used in this instance to evaluate the Panel's substantive conclusion that Commercial Connect's Applied-for String and Amazon's Applied-for String are confusingly similar. Rather, any review will be limited to whether the Panel violated any established policy or process, which Amazon claims was done by the Panel not applying the correct standard in reaching its determination.

The Panel referenced and correctly stated the applicable standard more than once in its evaluation of Commercial Connect's objection.<sup>3</sup> (Expert Determination,

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<sup>2</sup> *Commercial Connect, LLC v. Top Level Domain Holdings Ltd.*, Case No. 50 504 T 00258 13, available at [http://images.go.adr.org/Web/AmericanArbitrationAssociation/%7B772b1de3-e337-4643-b310-f87daa172a2e%7D\\_50\\_504\\_T\\_00258\\_13\\_determination.pdf](http://images.go.adr.org/Web/AmericanArbitrationAssociation/%7B772b1de3-e337-4643-b310-f87daa172a2e%7D_50_504_T_00258_13_determination.pdf) (hereinafter "TLDH Expert Determination".)

<sup>3</sup> In what appears to be a typographical error, at one point, the Panel incorrectly cites to Section 3.4.1 of the Applicant Guidebook instead of Section 3.5.1, but the Panel nonetheless correctly quotes from the applicable standard.

Pgs. 2, 4.) The relevant standard for evaluating a string confusion objection is set out in Section 3.5.1 of the Applicant Guidebook:

A DRSP Panel hearing a string confusion objection will consider whether the applied-for gTLD string is likely to result in string confusion. String confusion exists where a string so nearly resembles another that it likely to deceive or cause confusion. 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.

The Applicant Guidebook also makes clear that a string confusion objection is not limited to visual similarity, but rather, may be based on any type of similarity, including aural similarity or similarity in meaning. (Guidebook, Section 2.2.1.1.3.)

Based on the parties' contentions, it appears that the Panel concentrated on the meanings of the two strings. The Panel determined that there were three distinct, but related issues that needed to be examined in assessing Commercial Connect's Objection:

- (i) Whether the root of the word in a string should be accorded protection from usage of variations of the root word, including participles (*e.g.*, several variations for the root word "shop" in the English language)?
- (ii) Whether the addition of the word "online" before the word "shopping" makes the two strings distinct as to avoid string confusion?
- (iii) Whether the use of Japanese characters and languages for the same word avoids the possibility of confusion?

(Expert Determination, Pg. 4.)

In evaluating these three issues, the Panel found that the concurrent use of "shopping", the participle of the root word "shop," in a string will result in probable confusion by the average, reasonable Internet user, because the two strings have virtually the same sound, meaning, look



and feel.<sup>4</sup> (Expert Determination, Pgs. 4-5.) The Panel likewise found that the addition of the word “online” before “shopping” does not add sufficient uniqueness to the string because the meaning of the strings arises from the use of the root word “shop” and not the modifier “online.” (Expert Determination, Pg. 5.) The Panel was also not persuaded that simply using a foreign language or foreign characters avoided the possibility of confusion. The Panel determined that many Internet users speak more than one language, including English, and that the use of essentially the same word in two different languages is sufficient to cause string confusion among the average, reasonable Internet user. (Expert Determination, Pg. 5.)

The Panel’s focus on the meanings of the strings is consistent with the standard for evaluating string confusion objections. A likelihood of confusion can be established with any type of similarity, including similarity of meaning. (Guidebook, Section 2.2.1.1.3.) To challenge this proposition, Amazon relies on the analysis of the public comment to version 2 of the Applicant Guidebook. (Request, Pg. 11.) Amazon asserts that the public comment makes clear that the standard for establishing string confusion is a “high standard, not intended to hobble competition.” (Request, Pg. 11.) In response to these public comments, which included the suggestion that string confusion objections not be allowed for cases of similar meaning, ICANN specifically addressed and clarified the proper scope of objections:

The new gTLD implementation follows the GNSO recommendation that implies that string confusion should be tested in all ways: visual, meaning and aural confusion. After all, if harm to consumers would result due to the introduction of

---

<sup>4</sup> Amazon claims that the word “shopping” is not used and does not appear in either of the strings at issue, and therefore, the Panel improperly compared Amazon’s Applied-for String with the “shopping” string. (Request, Pg. 14-15.) Amazon’s argument lacks credibility in that Amazon’s proposed string is the Japanese translation for “online shopping”; thus, “shopping” is contained within the challenged string. Further, the Panel is permitted under the Procedure to “refer to and base its findings upon the statements and documents submitted and any rules or principles that it determines to be applicable.” (Procedure, Art. 20(b).)

two TLDs into the root zone because they sounded but did not look alike, then both TLDs should not be delegated.

(New gTLD Draft Applicant Guidebook-Version 2: Analysis of Public Comment, Pg. 149 *available at* <https://archive.icann.org/.../agv2-analysis-public-comments-31may09-en.pdf>.) Any claim by Amazon that the Panel must limit itself to a standard of aural or visual similarity is not supported by available documentation, and does not support a finding that the Panel violated any established policy or procedure.

Moreover, the Panel did not automatically conclude that there was a likelihood of confusion between Commercial Connect's Applied-for String and Amazon's Applied-for String as Amazon contends. To the contrary, it appears that the Panel conducted a detailed and comprehensive analysis of the issues before reaching its determination.

Amazon further relies on another ICDR Panel's determination, finding that TLDH's Applied-for String is not confusingly similar to Commercial Connect's Applied-for String, as evidence that the Panel applied the wrong standard.<sup>5</sup> (Request, Pg. 14.) The fact that these two ICDR Panels evaluated potentially similar objections yet came to different conclusions does not mean that one Panel applied the wrong standard. On a procedural level, each expert Panel generally rests its determination on the materials presented to it by the parties to that particular objection, and the objector bears the burden of proof. Two Panels confronting nearly identical issues could rightfully reach different determinations, based on the strength of the materials

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<sup>5</sup> On 5 September 2013, Commercial Connect separately sought reconsideration of ICANN staff's acceptance of the TLDH Expert Determination. (Request 13-10, available at [http://www.icann.org/en/groups/board/governance/reconsideration/request-commercial-connect-.](http://www.icann.org/en/groups/board/governance/reconsideration/request-commercial-connect-)) Request 13-10 is based primarily on a claim that the Panel dismissing Commercial Connect's objection to TLDH's Applied-for String and the Panel sustaining Commercial Connect's objection to Amazon's Applied-for String inconsistently applied the standard for evaluating string confusion objections. For the same reasons as stated herein, Commercial Connect's claims are unsupported and do not support Reconsideration.

presented. While Commercial Connect was the objector in both proceedings cited by Amazon, the objections were rebutted by different applicants. Thus, the Panels reached different determinations at least in part because the materials submitted by each applicant (Amazon and TLDH) in defense of its proposed string were different.

For instance, in dismissing Commercial Connect's objection to TLDH's Applied-for String, the Panel determined that Commercial Connect failed to meet its burden of proof that the two strings (Commercial Connect's Applied-for String and TLDH's Applied-for String) would cause probable confusion in the mind of the average, reasonable Internet user. (TLDH Expert Determination, Pg. 7.) The Panel, on the other hand, in sustaining Commercial Connect's objection, found that Amazon's arguments:

[d]o not appear to be consistent with the applicable standard of review, the apparent purpose or goal of implementing gTLDs, or the purpose or goal in allowing a string confusion objection.

(Amazon Expert Determination, Pg. 5.) Overall, the Panel found that Amazon's arguments were "not persuasive." (Expert Determination, Pg. 5.)

Moreover, according to the TLDH Expert Determination, TLDH asserted that Commercial Connect's Applied-for String and TLDH's Applied-for String are aimed at distinct markets. TLDH claimed that Commercial Connect's Applied-for String will be marketed to "the global ecosystem of e-commerce" with a "strict verification process where Commercial Connect researches the identity of that applicant and [the] business." (TLDH Expert Determination, Pg. 5.) In contrast, TLDH's Applied-for String is directed to "Chinese-language vendors" and requires no such pre-verification. TLDH noted that these markets may overlap to some extent, but one is "global and restricted," while the other is "language-specific and open." (TLDH Expert Determination, Pg. 5.)

The Panel, dismissing Commercial Connect's objection to TLDH's Applied-for String, found that the similarity in meaning between the two strings is apparent only to individuals who read and understand both Chinese and English. Relying on the intended markets for the strings, the Panel determined:

While there is some potential for overlap between these two markets, they are largely distinct. Therefore, there is little likelihood that a bilingual user would be deceived or confused.

(TLDH Expert Determination, Pg. 7.) The Panel therefore dismissed Commercial Connect's objection not because it concluded that translations of essentially the same word are insufficient to cause string confusion – as Amazon suggests – but because TLDH presented convincing evidence that there was little likelihood of confusion between Commercial Connect's Applied-for String and TLDH's Applied-for String.

Further, the standard guiding the Panels involves some degree of subjectivity. While Amazon may disagree with the Panel's finding, Reconsideration is not available as a mechanism to re-try the substantive determination of the Panel. Amazon's claims that the Panel applied the wrong standard are unsupported and therefore, do not support Reconsideration.

#### **IV. Recommendation and Conclusion**

Based on the foregoing, the BGC concludes that Amazon has not stated proper grounds for reconsideration, and we therefore recommend that Amazon's Request be denied without further consideration.

As there is no indication that either the ICDR or the Panel violated any policy or process in accepting and sustaining Commercial Connect's Objection, this Request should not proceed. If Amazon thinks that it has somehow been treated unfairly in the process, and the Board (through the NGPC) adopts this Recommendation, Amazon is free to ask the Ombudsman to review this matter.

Though there are no grounds for reconsideration presented in this matter, following additional discussion of the matter the BGC recommended that staff provide a report to the NGPC, for delivery in 30 days, setting out options for dealing with the situation raised within this Request, namely the differing outcomes of the String Confusion Objection Dispute Resolution process in similar disputes involving Amazon's Applied-for String and TLDH's Applied-for String. In addition, the BGC suggested that the strings not proceed to contracting prior to staff's report being produced and considered by the NGPC.

**Reconsideration Request  
DERCars, LLC**

**Annex E**

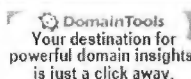
Domain Incite, *Interview: Attalah On New gTLD  
Objection Losers* (Aug. 16, 2013)



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First collision block-lists out now. How painful will they be for new gTLDs?

Donuts and Uniregistry sign more new gTLD contracts

It's official: Verisign has balls of steel

dotShabaka Diary — Day 20, Positive signs?

Ralph Lauren can't have .polo, panel rules

.shopping ruled confusingly similar to .shop

Name collision block-lists to be published this week

dotShabaka Diary — Day 19

## Interview: Atallah on new gTLD objection losers

Kevin Murphy, August 16, 2013, 11:20:59 (UTC), Domain Policy

### Filing a lawsuit against a competitor won't stop ICANN rejecting your new gTLD application.

That's according to Akram Atallah, president of ICANN's Generic Domains Division, who spoke to DI yesterday about possible outcomes from new gTLD objection rulings.

He also said that applicants that believe they've been wronged by the objection process may have ways to appeal the decisions and addressed what happens if objection panels make conflicting decisions.

### Lawsuits won't stay ICANN's hand

In light of the lawsuit by Del Monte International GmbH against Del Monte Corp, as reported by Domain Name Wire yesterday, I asked Atallah if ICANN would put applications on hold pending the outcome of legal action.

The GmbH lost a Legal Rights Objection filed by the Corp, which is the older company and owner of the "Del Monte" trademark pretty much everywhere, meaning the GmbH's bid, under ICANN rules, must fail.

Atallah said lawsuits should not impact ICANN's processes.

"For us it's final," Atallah said. "If they have to go outside and take legal action then the outcome of the legal action will be enforceable by law and we will have to abide by it. But from our perspective the [objection panel's] decision is final."

### There might be ways to appeal

In some cases when an applicant loses an objection — such as a String Confusion Objection filed by an existing TLD or an LRO filed by a trademark owner — the only step left is for it to withdraw its application and receive whatever refund remains.

There have been no such withdrawals so far.

I asked Atallah whether there were any ways to appeal a decision that would lead to rejection.

"The Applicant Guidebook is very clear," he said. "When an applicant loses an objection, basically their application will not proceed any further. We would like to see them withdraw their application and therefore finish the issue."

"Of course, as with anything ICANN, they have some other avenues for asking for reconsidering the decision," he added. "Basically, going to the Ombudsman, filing a Reconsideration Request, or even lobbying the board or something."

I wondered whether the Reconsideration process would apply to decisions made by third parties such as arbitration panels, and Atallah admitted that the Guidebook was "murky" on this point.

"There are two mentions in the Guidebook of this, I think," he said. "One mentions that it [the panel's decision] is final — the application stops — the other mentions that it is advice to staff."

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Reconsideration is not an appeals process: ICANN delivers another blow to Amazon's gTLD hopes

ITU says numeric .tel domains "may be confusing"

dotShabaka Diary — Day 18, More TMCH uncertainty

DotGreen calls it quits w/ith "impossible" gTLD auction looming

More Extended Evaluation passes this week

Donuts' first gTLD sunrise slated for October 29

Third Bulgarian new gTLDs conference planned

Domain Name Association opens membership

That seems to be a reference to the Guidebook at 3.4.6, which states:

The findings of the panel will be considered an expert determination and advice that ICANN will accept within the dispute resolution process.

This paragraph suggests that ICANN staff have to accept the objection panel's decision. That would make it an ICANN decision to reject the application, which can be challenged under Reconsideration.

Of course, the Reconsideration process has yet to see ICANN change its mind on any matter of substance. My feeling is that to prevail you'd at a minimum have to present the board with new information not available at the time the original decision was made.

#### What if different panelists reach opposite conclusions?

While the International Centre for Dispute Resolution has not yet published its panels' decisions in String Confusion Objection cases, a few have leaked out.

(UPDATE: This turns out not to be correct. The decisions have been published, but the only way to find them is via obscured links in a PDF file buried on the ICDR web site. Way to be transparent, ICDR.)

I've read four, enough to see that panelists are taking diverse and sometimes opposing views in their decision-making.

For instance, a panelist in *.car v .cars* (pdf) decided that it was inappropriate to consider trademark law in his decision, while the panelist in *.tv v .tvs* (pdf) apparently gave trademark law a lot of weight.

How the applicants intend to use their strings — for example, one may be a single-registrant space, the other open — seems to be factoring into panelists' thinking, which could lead to divergent opinions.

Even though Google's *.car* was ruled not confusingly similar to Donuts' *.cars*, it seems very possible that another panelist could reach the opposite conclusion — in one of Google's other two *.cars* objections — based on trademark law and proposed usage of the gTLD.

If that were to happen, would only one *.cars* application find itself in the *.car* contention set? Would the two contention sets be linked? Would all three *.cars* applications wind up competing with *.car*, even if two of them prevailed against Google at the ICDR?

It doesn't sound like ICANN has figured out a way to resolve this potential problem yet.

"I agree with you that it's an issue to actually allow two panels to review the same thing, but that's how the objection process was designed in the Guidebook and we'd just have to figure out a way to handle exceptions," Atallah said.

"If we do get a case where we have a situation where a singular and a plural string — or any two strings actually — are found to be similar, the best outcome might be to go back to the GNSO or to the community and get their read on that," he said. "That might be what the board might request us to do."

"There are lots of different ways to figure out a solution to the problem, it just depends on how big the problem will be and if it points to an unclear policy or an unclear implementation," he said.

But Atallah was clear that if one singular string is ruled confusing to the plural version of the same string, that panel's decision would not cause all plurals and singulars to go into contention.

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Leila:  
Greetings! Very helpful advice in this particular post! It's the little changes that produce the biggest changes. Than...  
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Miss Jay:  
I'm from this tiny island and I assure you it only costs \$400 to install this w/ifi disk and thats including labour. It's...  
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Drew bert:  
This block list concept is absurd! Here's the english translations of some of the domains that will be unable to be r...  
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Avtal:  
I agree with your assessment that this exercise is pointless and futile. A typical example of a blocked second-level...  
[read more](#)

Michael Marcovici:  
In fact this can be performed with almost any domain that was in use earlier, in fact we once connected 2000 of our doma...  
[read more](#)

Collabo:  
Wow , good catch Kevin. This is definitely a security risk and could easily be taken advantage of. It's a very easy tas...  
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Amadeu Abril | Abril:  
Kevin, Allow me two quick precisions and one comment from CORE's side: \* blocking all those Latin-script eneric...  
[read more](#)

Rubens Kuhl:



"If a panel decides there is similarity between two strings and another panel said there is not, it will be for that string in particular, it would not be in general, it would not affect anything else," he said.

ICANN, despite Governmental Advisory Committee advice to the contrary, decided in late June that singular and plural gTLDs can coexist under the new regime.

Most of the reliability issues Verisign claims can happen with new gTLDs, like people dying, are not tied to internal ce... read more

Jonathan Zuck: Kevin, I guess I'm a little confused. Are you actually equating the external resolution of an established internal url,... read more

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COMMENTS (3)

**Andrew Allemann**

August 16, 2013 at 3:06 pm

So prescient in light of your next story about .pet and .pets

Reply

**Kevin Murphy**

August 16, 2013 at 3:23 pm

I prefer "preincient".

Reply

**Andrew Allemann**

August 16, 2013 at 3:31 pm

nice 😊

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**Reconsideration Request  
DERCars, LLC**

**Annex F**

Letter from Jonathan Robinson, Chair, ICANN  
GNSO Council, to Dr. Steve Crocker, Chair, ICANN  
Board and Mr. Cherine Chalaby, Chair, ICANN  
Board NGPC (18 Sept. 2013)



18 September 2013

Dr Steve Crocker, Chair, ICANN Board  
Mr Cherine Chalaby, Chair, ICANN Board NGPC

Dear Steve, Dear Cherine,

**GNSO Council policy concerns relating to string similarity in new gTLD applications**

At the direction of the GNSO Council, I am writing to you to highlight issues relating to the string similarity review work within the new gTLD programme, especially in so far as these concerns relate to the application of existing policy.

In this context, the Council would like to draw your attention to the existing ICANN GNSO Final Report on the introduction of new generic top-level domains as approved by the GNSO in September 2007.

[http://gns0.icann.org/en/issues/new-gtlds/pdp-dec05-fr-parta-08aug07.htm#\\_Toc43798015](http://gns0.icann.org/en/issues/new-gtlds/pdp-dec05-fr-parta-08aug07.htm#_Toc43798015)

In particular, we would like to draw your attention to the following policy recommendations:

**Recommendation 1:** ICANN must implement a process that allows the introduction of new top-level domains. The evaluation and selection procedure for new gTLD registries should respect the principles of fairness, transparency and non-discrimination. All applicants for a new gTLD registry should therefore be evaluated against transparent and predictable criteria, fully available to the applicants prior to the initiation of the process. Normally, therefore, no subsequent additional selection criteria should be used in the selection process.

**Recommendation 2:** Strings must not be confusingly similar to an existing top-level domain or a Reserved Name.

**Recommendation 9:** There must be a clear and pre-published application process using objective and measurable criteria.

The Council is aware of and has discussed the inconsistencies in the current output of the string similarity review process such that, when tested against the above recommendations, the output is apparently not consistent with the above policy recommendations of the GNSO.

Example inconsistencies of output which have given rise to the concern include; different outcomes (in favour of the applicant or the objector) in the case of identical strings (.cam & .com, cam & .com), different outcomes in the case of plurals (.sport & .sports, .hotel & .hotels) and different outcomes in the case of strings where there is only one letter different (.com & .ecom, .post and .epost).

At this point, the Council wishes to draw your attention to and highlight the apparent inconsistencies with existing policy. We intend to pick up this issue and look into the matter in more detail in the near future and will welcome any updates from you in the interim.

Should you require further clarification or input, please revert to me in my capacity as Chair of the GNSO Council.

Yours sincerely,

Jonathan Robinson  
Chair, ICANN GNSO Council

**Reconsideration Request  
DERCars, LLC**

**Annex G**

Recommendation of the Board Governance  
Committee, Reconsideration Request 13-7, at 4  
(25 Sept. 2013)

**RECOMMENDATION OF THE BOARD GOVERNANCE COMMITTEE (BGC)**

**RECONSIDERATION REQUEST 13-7**

**25 SEPTEMBER 2013**

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On 23 August 2013, Dish DBS Corporation (“Dish”) submitted a reconsideration request (“Request”). The Request asked the Board to reconsider the 29 July 2013 Expert Determination from a dispute resolution panel established by the Arbitration and Mediation Center of the World Intellectual Property Organization (“WIPO”) regarding The DirecTV Group, Inc.’s (“DirecTV”) objection to the application for .DIRECT. Specifically, the Request seeks reconsideration of the Panel’s determination sustaining DirecTV’s objection to Dish’s application for .DIRECT.

**I. Relevant Bylaws**

Article IV, Section 2.2 of ICANN’s Bylaws states in relevant part that any entity may submit a request for reconsideration or review of an ICANN action or inaction to the extent that it has been adversely affected by:

- (a) one or more staff actions or inactions that contradict established ICANN policy(ies); or
- (b) one or more actions or inactions of the ICANN Board that have been taken or refused to be taken without consideration of material information, except where the party submitting the request could have submitted, but did not submit, the information for the Board's consideration at the time of action or refusal to act; or
- (c) one or more actions or inactions of the ICANN Board that are taken as a result of the Board's reliance on false or inaccurate material information.

To properly initiate a request for reconsideration, the requesting party must review and follow the Reconsideration Request Form posted on the ICANN website

(<http://www.icann.org/en/groups/board/governance/reconsideration/request-form-11apr13->

en.doc). The requesting party must also acknowledge and agree to the terms and conditions set forth in the form when filing.

Dismissal of a request for reconsideration is appropriate if the Board Governance Committee (“BGC”) recommends, and in this case the New gTLD Program Committee agrees, that the requesting party does not have standing because the party failed to satisfy the criteria set forth in the Bylaws. These standing requirements are intended to protect the reconsideration process from abuse and to ensure that it is not used as a mechanism simply to challenge an action with which someone disagrees. The reconsideration process is for situations where the staff acted in contravention of established policies (when the Request is based on staff action or inaction).

Dish was notified of the 29 July 2013 Expert Determination on 8 August 2013. The Request was received on 23 August 2013, which makes it timely under the Bylaws. Bylaws, Art. IV, § 2.5.

## **II. Background**

### **A. The New gTLD Objection Procedure**

The New gTLD Program includes an objection procedure pursuant to which objections to applications for new gTLDs are submitted to an independent dispute resolution service provider (“DRSP”). The objection procedures are set out in Module 3 of the Applicant Guidebook (<http://newgtlds.icann.org/en/applicants/agb/objection-procedures-04jun12-en.pdf>) and the New gTLD Dispute Resolution Procedure (the “Procedure”) attached thereto.

There are four (4) grounds upon which an objection to a new gTLD application may be filed:

- (i) “String Confusion Objection” – the applied-for string is confusingly similar to an existing TLD or to another applied-for gTLD string in the same round of applications.

(ii) “Legal Rights Objection” – the applied-for gTLD string infringes the existing legal rights of the objector.

(iii) “Limited Public Interest Objection” – the applied for gTLD string is contrary to generally accepted legal norms of morality and public order that are recognized under principles of international law.

(iv) “Community Objection” – there is substantial opposition to the gTLD application from a significant portion of the community to which the gTLD string may be explicitly or implicitly targeted.

(Applicant Guidebook, Section 3.3.2.1; Procedure, Art. 2(e).)

As part of the dispute resolution proceedings, properly stated objections for which a response has been submitted will be considered by a panel of appropriately qualified expert(s) appointed by the designated DRSP. (Applicant Guidebook, Section 3.4.4.)

Each panel will determine whether the objector has standing to object and will use appropriate general principles/standards to evaluate the merits of each objection. The panel must apply the standards that have been defined in Section 3.5 of the Applicant Guidebook for each type of objection. The panel may also refer to and base its findings upon the statements and documents submitted and any rules or principles that it determines to be applicable. The objector bears the burden of proof in each case. (Applicant Guidebook, Section 3.5; Procedure, Art. 20.)

The panel’s final determination will include a summary of the dispute and findings, identify the prevailing party, and provide the reasoning upon which the expert determination is based. (Applicant Guidebook, Section 3.4.6.; Procedure, Art. 21.) The findings of the panel will be considered an expert determination and advice that ICANN will accept within the dispute resolution process. (Applicant Guidebook, Section 3.4.6.)



**B. DirecTV's Objection to Dish's Application for .DIRECT**

Dish is an applicant for the .DIRECT string. DirecTV timely filed a legal rights objection (the "Objection"), and Dish timely filed a response (the "Response"). DirecTV was permitted to file a reply brief (the "Reply"), and Dish was permitted to file a rejoinder (the "Rejoinder"). WIPO's appointed panelists (the "Panel") rendered their expert determination on 29 July 2013 ("Expert Determination"), and the parties were notified of the determination on 8 August 2013.

The Panel determined that DirecTV had standing to object as a rights holder in the "DirecTV" mark and other marks containing the term "direct." Applying the standards that have been defined in Section 3.5.2 of the Applicant Guidebook for a legal rights objection ("LRO"), the Panel sustained DirecTV's objection on the grounds that Dish likely chose the .DIRECT string for the sole purpose of disrupting the business of DirecTV. (Expert Determination, Page 4.)

Although the LRO was determined by a third-party DRSP, ICANN has determined that the Reconsideration process can properly be invoked for challenges of the third-party DRSP's decisions where it can be stated that either the DRSP failed to follow the established policies or processes in reaching the decision, or that ICANN staff failed to follow its policies or processes in accepting that decision. See BGC Recommendation on Reconsideration Request 13.5 at <http://www.icann.org/en/groups/board/governance/reconsideration/recommendation-booking->

### III. Analysis of Dish's Request for Reconsideration<sup>1</sup>

Dish seeks reconsideration of the decision to sustain DirecTV's objection to Dish's application for the .DIRECT new gTLD. More specifically, Dish requests that ICANN disregard the Panel's Expert Determination and requests that the decision be reviewed by a new expert panel. Dish also requests that ICANN provide applicants of "inconsistent or erroneous DRSP panel determinations with an avenue of redress that is consistent with ICANN's mandate to act with fairness." In the event that ICANN will not immediately reverse the decision, Dish requests that it be provided an opportunity to respond to the BGC, before the BGC makes a final recommendation. (Request, Section 9.) Dish also requests a hearing. (Request, Page 11.)<sup>2</sup>

#### A. The Panel's Alleged Influence by Media Accounts Does Not Demonstrate A Process Violation

Dish's Request is based primarily on a claim that the Panel, in reaching its conclusion that Dish's application for .DIRECT was not a "bona fide application," failed to accord proper weight to the declaration of Dish's Senior Vice President of Product Management, Vivek Khemka ("Khemka Declaration"), and instead, was improperly influenced by Dish advertisements that were not part of the record. (Request, Section 10.) To support this assertion, Dish claims that other LRO Expert Determinations have applied a "very high burden for trademark-based objections" and have found that an applicant's business model does not

---

<sup>1</sup> A letter from DirecTV's counsel, requesting that Dish's Request be denied, was received on 6 September 2013 (<http://www.icann.org/en/groups/board/governance/reconsideration/davis-to-bgc-06sep13-en.pdf>). DirecTV's letter has been reviewed and given appropriate consideration in connection with this Recommendation.

<sup>2</sup> Hearings are not required in the Reconsideration Process, however requestors may request a hearing. The BGC retains the absolute discretion to determine whether a hearing is appropriate, and to call people before it for a hearing. See Reconsideration Request Form at <http://www.icann.org/en/groups/board/governance/reconsideration/request-form-11apr13-en.doc>.

automatically translate into a finding of bad intent. (Request, Section 10, Page 8.) Dish contends that the Khemka declaration along with Dish's responses in its application for the .DIRECT string "clearly show on the record that Dish filed a bona fide application" for the string, and that a "more objective review of other information outside the record" would have clearly shown that Dish has used the term "direct" in connection with Dish productions and services since at least December 1998. (Request, Section 10, Page 9.) Dish further asserts that there is nothing in the record showing that Dish engaged in a pattern of conduct from which any type of bad faith can be inferred, there is nothing in the record to support a finding of confusion, and Dish will be injured if the Expert Determination is permitted to stand. (Request, Section 10, Page 9-10.)

The relevant standard for evaluating a LRO is set out in Section 3.5.2 of the Applicant Guidebook:

[A] DRSP panel of experts presiding over a legal rights objection will determine whether the potential use of the applied-for gTLD by the applicant takes unfair advantage of the distinctive character or the reputation of the objector's registered or unregistered trademark or service mark ("mark") or IGO name or acronym ... or unjustifiably impairs the distinctive character or the reputation of the objector's mark or IGO name or acronym, or otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector's mark or IGO name or acronym.

The Applicant Guidebook sets forth eight non-exclusive factors that a panel will need to consider in cases where the objection is based on trademark rights. (Applicant Guidebook, Section 3.5.2.) The Procedure also makes clear that, in addition to applying the standards that have been defined by ICANN, the panel "may refer to and base its findings upon the statements and documents submitted and any rules or principles that it determines to be applicable."

(Procedure, Art. 20(b).) Contrary to Dish’s contention, there is no provision in the Procedures that restricts a panel’s ability to refer to or rely upon media accounts.<sup>3</sup>

Moreover, Dish misstates the alleged influence of media accounts on the Panel in rendering its determination. The Panel noted:

That these two parties are direct competitors can scarcely be doubted. Indeed, the Panel notes that as it has been deliberating over this case, [Dish] is running a series of television advertisements squarely at [DirecTV] and its satellite television offerings.

(Expert Determination, Pages 4-5.) These statements show that the Panel referenced the advertisements to illustrate the fact that Dish and DirecTV are direct competitors in the satellite television industry. Dish does not dispute the fact that the two are competitors, and both parties acknowledge that they provide satellite television services. (Expert Determination, Pages 2-3.) Thus, even if the Panel’s reference to television advertisements was somehow improper, there does not appear to be any prejudice to Dish. The BGC also notes that the “media accounts” at issue here are advertisements produced by the parties to the objection proceedings, and not statements of journalists, so Dish’s opposition to the decision because of these “media accounts” seems misplaced in any event.

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<sup>3</sup> Dish relies on the wrong section (Section 2.4.3) of the Applicant Guidebook in its attempt to establish the alleged breach of ICANN policy and procedure. (Request, Section 8.) Module 2 of the Applicant Guidebook describes the evaluation procedures and criteria used to determine whether applied-for gTLDs are approved for delegation. The Module explains that all applicants will undergo an Initial Evaluation, which includes various reviews (as part of the string review and applicant review) by third-party panelists appointed by ICANN. (Applicant Guidebook, Section 2.2 & 2.4.) Section 2.4.3 of the Applicant Guidebook provides the code of conduct for panelists used at the Initial Evaluation – not objection – stage of the evaluation process. Section 2.4.3, and its statement against panelists being influenced through media accounts, does not govern the code of conduct for panelists used in the dispute resolution procedure set out in Module 3 of the Applicant Guidebook.

As required by the Applicant Guidebook, the Panel applied the eight non-exclusive factors to Dish's LRO and determined that each factor was in favor of DirecTV: (i) .DIRECT is similar to the DirecTV mark; (ii) DirecTV's acquisition and use of rights in its various Direct-formative marks is bona fide; (iii) the public recognizes "direct" as a mark of DirecTV, noting that Dish, a purveyor of satellite television services, is seeking to use the dominant part of the family of marks owned and used by its chief competitor in the satellite television business; (iv) Dish is well aware of DirecTV's DirecTV and Direct-formative marks and applied for the .DIRECT string in order to gain market share over a competitor; (v) Dish has not used the term "direct" as a trademark or service mark; (vi) Dish has no marks or other intellectual property rights that correspond to the word "direct"; (vii) Dish is not commonly known by the word "direct"; and (viii) consumer confusion would likely result if Dish were allowed to keep and use the .DIRECT string. (Expert Determination, Pages 5-8.)

In evaluating the fourth factor – Dish's intent in applying for the .DIRECT string – the Panel concluded "based on the record before it" that Dish applied for the .DIRECT string as "part of an ongoing battle for market share." (Expert Determination, Page 7.) The Panel indicated that Dish's application essentially admitted as much and found that Dish's admission in its application was more reliable than the statements in the Khemka Declaration disavowing Dish's brand-centered motivation in applying for .DIRECT. (Expert Determination, Page 7.) It is within the Panel's purview to weigh the evidence in front of it in making its Expert Determination.

Ultimately, Dish has not been able to identify any policy or process that the Panel did not follow. Rather, the Request challenges the Panel's substantive determination. In the context of the New gTLD Program, Reconsideration is not a mechanism for direct, de novo appeal of panel

decisions with which the requester disagrees, and seeking such relief is, in fact, in contravention of the established processes within ICANN. See BGC Recommendation on Reconsideration Request 13.5 at <http://www.icann.org/en/groups/board/governance/reconsideration/recommendation-booking->.

For the reasons stated above, Dish's claim that the Panel failed to accord proper weight to the Khemka Declaration, and was instead, improperly influenced by Dish advertisements that were not part of the record, do not demonstrate policy or process violations. Similarly, Dish's references to standards applied by other DRSP panels and Dish's general claims that the evidence supports a different outcome, are not enough for Reconsideration. Reconsideration is not available as a mechanism to re-try the decisions of the DRSP panels.

**B. ICANN's Purported Breach from "Automatic Acceptance" of DRSP Decisions Does Not Support Reconsideration**

In its Request, Dish contends that ICANN's automatic acceptance of DRSP panel decisions, including those that are "erroneous or inconsistent," is contrary to ICANN's mandate to act transparently and fairly. (Request, Section 8, Page 4.) To support this assertion, Dish relies on the following:

(a) Paragraph 7 of the "Summary of ICANN Generic Names Supporting Organisation's (GNSO's) Final Report on the Introduction of New Generic Top-Level Domains (gTLDs) and Related Activity" (prepared for the GNSO's 29 October 2007 New gTLD Workshop in Los Angeles, available at <http://losangeles2007.icann.org/files/losangeles/gnso-newgtlds-workshop-29oct07.pdf>). Paragraph 7 is entitled "Fairness of Process" and refers to the GNSO's recommendation that ICANN implement an evaluation and selection process that respects the principles of fairness, transparency and non-discrimination. The GNSO further provides that "all applicants should be evaluated against transparent and predictable criteria, fully available before initiation of the process."

(b) ICANN's Articles of Incorporation (<http://www.icann.org/en/about/governance/articles>), which requires ICANN to act "through open and transparent processes."

(c) ICANN's Bylaws (<http://www.icann.org/en/about/governance/bylaws>). Dish references ICANN's obligation to "operate to the maximum extent feasible in an open and transparent manner and consistent with procedures designed to ensure fairness" (Art. III, § 1), to "mak[e] decisions by applying documented polices neutrally and objectively, with integrity and fairness (Art. 1, § 2.8), and "not to apply its standards, policies, procedures, or practices inequitably or single out any particular party for disparate treatment unless justified by substantial and reasonable cause, such as the promotion of effective competition (Art. II, § 3).

Dish is not suggesting here that the dispute resolution procedures set out in Module 3 of the Applicant Guidebook, or the attached Procedure, were not followed. To the contrary, Dish is asserting that if the procedures are followed – *i.e.*, ICANN accepts the findings of the Panel pursuant to Section 3.4.6 of the Applicant Guidebook – ICANN will in some way be in violation of its mandate to act transparently and fairly. Dish's conclusions in these respects are not accurate and do not support Reconsideration.

ICANN's decision to proceed with the New gTLD Program followed many years of discussion, debate and deliberation with the Internet community, including end users, business groups and governments. ICANN's work to implement the New gTLD Program – including the creation of an application and evaluation process for new gTLDs that is aligned with the policy recommendations and provides a clear roadmap for applicants to reach delegation – is reflected in the drafts of the applicant guidebook that were released for public comment, and in the explanatory papers giving insight into the rationale behind some of the conclusions reached on specific topics. Meaningful input from participants around the globe led to numerous and significant revisions of each draft version of the applicant guidebook, resulting in the Applicant Guidebook that is used in the current application round.

The current Applicant Guidebook is publicly posted on an ICANN website dedicated to the New gTLD Program. See <http://newgtlds.icann.org/en/applicants/agb>. The standards for evaluating the merits of a legal rights objection are provided in the Applicant Guidebook, and by filing an application for a new gTLD, each applicant agrees to accept the applicability of the gTLD dispute resolution process. (Applicant Guidebook, Section 3.5.2 & Section 3.3.2; Procedure, Art. 1(d).) Applicants are evaluated against transparent and predictable criteria, and the procedures are designed to ensure fairness.

Dish's attempt to claim here that the procedures set forth in the Applicant Guidebook, which followed years of inclusive policy development and implementation planning, are inconsistent with ICANN's Articles of Incorporation and Bylaws (or the recommendations of the GNSO) is not supported and must be rejected. The Applicant Guidebook sets out the standards used to evaluate and resolve objections. The Expert Determination shows that the Panel followed the evaluation standards. ICANN's acceptance of that Expert Determination as advice to ICANN is also in accordance with the established process. (Applicant Guidebook, Section 3.4.6.) Dish's disagreement as to whether the standards should have resulted in a finding in favor of DirecTV's objection does not mean that ICANN (or the Panel) violated any policy or process in reaching the decision (nor does it support a conclusion that the decision was actually wrong).

Dish further contends that DRSP panels are taking "diverse and sometimes opposing views in their decision-making." (Request, Section 8, Page 5.) Dish claims that ICANN's failure to provide a mechanism for redress for erroneous and inconsistent DRSP panel decisions is contrary to ICANN's mandate to act with fairness, and prevents Dish (and other applicants) from challenging erroneous and inconsistent decisions in a "non-arbitrary and non-



discriminatory fashion.” (Request, Section 8, Page 5.) For the same reasons as stated above, ICANN’s purported inaction in implementing certain quality controls does not demonstrate a violation of any ICANN policy or process.

While parties to a dispute resolution proceeding may not always be satisfied with the determinations of the DRSP panels – and there may be divergence in the conclusions reached between the various panels – the Reconsideration process is not intended to reexamine the established dispute resolution process. Dish’s belief that the objection and dispute resolution procedures should be changed does not constitute a policy or process violation that supports reconsideration.

#### **IV. Recommendation and Conclusion**

Based on the foregoing, the BGC concludes that Dish has not stated proper grounds for reconsideration and we therefore recommend that Dish’s Request be denied without further consideration. Based on the information available, Dish’s request for the provision of additional information as well as the request for a hearing both have the potential to put before the BGC additional information that only challenges the substantive ruling of the DRSP, as the record before the BGC makes clear that no policy or process has been identified that the Panel or ICANN failed to follow. As a result, Dish’s request for an opportunity to respond to the BGC, as well as the request for a hearing, do not have the potential to bring before the BGC additional material information that is relevant to the evaluation of this Request and we therefore recommend they be denied.

As there is no indication that either the Panel or ICANN violated any policy or process in reaching or accepting the determination sustaining DirecTV’s objection, this Request should not proceed. If Dish thinks that it has somehow been treated unfairly in the process, and the Board

(through the New gTLD Program Committee) adopts this Recommendation, Dish is free to ask the Ombudsman to review this matter.

LAI-3199726v1

**Reconsideration Request  
DERCars, LLC**

**Annex H**

Recommendation of the Board Governance  
Committee, Reconsideration Request 13-10, at 11  
(10 Oct. 2013)

**RECOMMENDATION OF THE BOARD GOVERNANCE COMMITTEE (BGC)**

**RECONSIDERATION REQUEST 13-10**

**10 OCTOBER 2013**

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On 5 September 2013, Commercial Connect, LLC (“Commercial Connect”) submitted a reconsideration request (“Request”). The Request asked the Board to reconsider ICANN staff’s acceptance of what Commercial Connect argues to be two inconsistent expert determinations from dispute resolution panels appointed by the International Centre for Dispute Resolution (“ICDR”). Specifically, the Request challenges the staff’s acceptance of the 8 August 2013 Expert Determination dismissing Commercial Connect LLC’s objection to Top Level Domain Holdings Limited’s (“TLDH”) new gTLD application for the Chinese translation of “shop” (“TLDH’s Applied-for String”) in light of the 21 August 2013 Expert Determination sustaining Commercial Connect’s objection to Amazon EU S.a.r.l.’s (“Amazon”) new gTLD application for the Japanese translation of “online shopping” (“Amazon’s Applied-for String”).

**I. Relevant Bylaws**

Article IV, Section 2.2 of ICANN’s Bylaws states in relevant part that any entity may submit a request for reconsideration or review of an ICANN action or inaction to the extent that it has been adversely affected by:

- (a) one or more staff actions or inactions that contradict established ICANN policy(ies); or
- (b) one or more actions or inactions of the ICANN Board that have been taken or refused to be taken without consideration of material information, except where the party submitting the request could have submitted, but did not submit, the information for the Board’s consideration at the time of action or refusal to act; or
- (c) one or more actions or inactions of the ICANN Board that are taken as a result of the Board’s reliance on false or inaccurate material information.

Dismissal of a request for reconsideration is appropriate if the Board Governance Committee (“BGC”) recommends, and in this case the New gTLD Program Committee (“NGPC”) agrees, that the requesting party does not have standing because the party failed to satisfy the criteria set forth in the Bylaws. These standing requirements are intended to protect the reconsideration process from abuse and to ensure that it is not used as a mechanism simply to challenge an action with which someone disagrees. The reconsideration process is for situations where the staff acted in contravention of established policies (when the Request is based on staff action or inaction).

For reconsideration requests that challenge staff actions, requests must be submitted to the BGC within fifteen days after the date on which the party submitting the request became aware of, or reasonably should have become aware of, the challenged staff action. Bylaws, Art. IV, § 2.5.

The Request was received on 5 September 2013. Commercial Connect asserts that it did not become aware of the challenged staff action (the staff’s acceptance of two seemingly inconsistent expert determinations) until after the second expert determination was rendered on 21 August 2013. Because the Request was received within fifteen days of the second expert determination, Commercial Connect’s Request is deemed timely under the Bylaws.

## II. Background

### A. The New gTLD Objection Procedure

The New gTLD Program includes an objection procedure pursuant to which objections to applications for new gTLDs are submitted to an independent dispute resolution service provider (“DRSP”). The objection procedures are set out in Module 3 of the Applicant Guidebook (<http://newgtlds.icann.org/en/applicants/agb/objection-procedures-04jun12-en.pdf>) and the New gTLD Dispute Resolution Procedure (the “Procedure”) attached thereto.

As detailed in the Request, Commercial Connect filed two string confusion objections with the ICDR asserting that two applied-for strings are “confusingly similar to an existing TLD or to another applied-for gTLD string in the same round of applications.” (Guidebook, Section 3.3.2.1; Procedure, Art. 2(e).)<sup>1</sup>

A panel of appropriately qualified expert(s) appointed by the ICDR is required to consider an objection that has been registered for processing and for which a response has been submitted. (Guidebook, Section 3.4.4.) Each panel will determine whether the objector has standing to object and will use appropriate general principles/standards to evaluate the merits of each objection. The panel must apply the standards that have been defined in Section 3.5 of the Applicant Guidebook for each type of objection. (Guidebook, Section 3.5; Procedure, Art. 20.)

The panel’s final determination will include a summary of the dispute and findings, identify the prevailing party, and provide the reasoning upon which the expert determination is based. (Guidebook, Section 3.4.6.; Procedure, Art. 21.) The findings of the panel will be

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<sup>1</sup> With string confusion objections, where a new gTLD applicant successfully asserts string confusion with another applicant, the two applied-for strings will be placed in a “contention set” and be referred to the String Contention Procedures in Module 4 of the Applicant Guidebook. (Guidebook, Section 3.2.2.1.)

considered an expert determination and advice that ICANN will accept within the dispute resolution process. (Guidebook, Section 3.4.6.)

**B. Commercial Connect's Objections to TLDH's Applied-for String and Amazon's Applied-for String**

Commercial Connect is an applicant for the .SHOP string ("Commercial Connect's Applied-for String"). Commercial Connect objected to both TLDH's Applied-for String and Amazon's Applied-for String, asserting that both strings were confusingly similar to Commercial Connect's Applied-for String; TLDH and Amazon each filed responses in separate proceedings.

For Commercial Connect's objection to TLDH's Applied-for String, the ICDR's appointed panelist rendered an expert determination on 8 August 2013 ("TLDH Expert Determination"). Based on the evidence and the parties' submissions, the TLDH Panel dismissed Commercial Connect's objection on the grounds that the two-applied for strings are not confusingly similar to the average, reasonable Internet user under the standard set forth in the Procedure and the Applicant Guidebook. (TLDH Expert Determination, Pg. 7.)

Separately, for Commercial Connect's objection to Amazon's Applied-for String, a different panelist appointed by the ICDR rendered an expert determination on 21 August 2013 ("Amazon Expert Determination"). That Panelist ("Amazon Panel") determined that Commercial Connect had standing to object as an applicant for the .SHOP string. (Amazon Expert Determination, Pg. 3.) Based on the evidence and the parties' submissions, the Amazon Panel sustained Commercial Connect's objection on the grounds that the two-applied for strings are confusingly similar. (Amazon Expert Determination, Pgs. 4-5.)

Although Commercial Connect's objections were determined by a third-party DRSP, ICANN has determined that the Reconsideration process can properly be invoked for challenges of the third-party DRSP's decisions where it can be stated that either the DRSP failed to follow

the established policies or processes in reaching the decision, or that ICANN staff failed to follow its policies or processes in accepting that decision. See BGC Recommendation on Reconsideration Request 13-5 at <http://www.icann.org/en/groups/board/governance/reconsideration/recommendation-booking-01aug13-en.doc>.

### **III. Analysis of Commercial Connect’s Request for Reconsideration**

Commercial Connect seeks reconsideration of the staff’s acceptance of the purportedly inconsistent TLDH Expert Determination and the Amazon Expert Determination. More specifically, Commercial Connect requests that ICANN “issue clear and well-defined guidance” to the expert panels and “ensure that the Panels comply with the guidelines” (especially for string similarity objections involving Internationalized Domain Names with foreign characters). Once ICANN establishes “well-defined guidance,” Commercial Connect requests that staff return to the expert panels any determinations that do not comply with the guidance, and Commercial Connect contends that the TLDH Expert Determination should be returned because it is inconsistent with the standards set forth in the Applicant Guidebook and the Amazon Expert Determination. (Request, Section 9.)

#### **A. The Purported Inconsistencies Between Expert Determinations Do Not Demonstrate A Process Violation**

Commercial Connect’s Request is based primarily on a claim that the TLDH Panel and the Amazon Panel inconsistently applied the standard for evaluating string confusion objections.<sup>2</sup>

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<sup>2</sup> On 4 September 2013, Amazon separately sought reconsideration of the Amazon Expert Determination. (Request 13-9, available at <http://www.icann.org/en/groups/board/governance/reconsideration/request-commercial-connect-05sep13-en.pdf>.) Amazon’s reconsideration request is based in part on Amazon’s contention that the Amazon Panel applied the wrong standard in evaluating Commercial Connect’s objection. Amazon relies on the TLDH Expert Determination as evidence that the Amazon



To support this assertion, Commercial Connect relies on Section 2.2.1.1.3 of the Applicant Guidebook, which states that a string confusion objection may be based on any type of similarity, including visual, aural or similarity of meaning. (Request, Pg. 4.) Although both panels concentrated on the meanings of the applied-for strings (determining there was no visual or aural similarities between the objected-to strings and Commercial Connect’s application for .SHOP), Commercial Connect concludes that the two panels, applying the same standard, rendered inconsistent determinations “as to whether a Roman root and a gTLD string of foreign characters having the same meaning should be placed in the same contention set.” (Request, Pg. 5.) To support this conclusion, Commercial Connect contends that the TLDH Panel determined that “the guidelines do not permit confusion to be based on meaning alone” when evaluating an application for Internationalized Domain Names with foreign characters, while the Amazon Panel determined the “use of essentially the same word in two different languages is sufficient to cause string confusion.” (Request, Pg. 5.)

The fact that these two panels, evaluating similar objections, came to different conclusions does not mean that the panels inconsistently applied the standard for evaluating string confusion objections, nor does it establish a policy or process violation to support Reconsideration. On a procedural level, each expert panel generally rests its determination on the materials presented to it by the parties to that particular objection, and the objector bears the burden of proof. Two panels confronting nearly identical issues could rightfully reach different determinations, based on the strength of the materials presented. While Commercial Connect

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(continued...)

Panel applied the wrong standard. For the same reasons as stated herein, Amazon’s claims are unsupported and do not support Reconsideration.

was the objector in each of these determinations, each objection was rebutted by a different applicant. Thus, the panels reached different decisions at least in part because the materials submitted by each applicant (TLDH and Amazon) in defense of its proposed string were different, and not because one panel violated any established policy or process in reaching its determination.

For instance, in dismissing Commercial Connect's objection, the TLDH Panel determined that Commercial Connect failed to meet its burden of proof that the two strings (Commercial Connect's Applied-for String and TLDH's Applied-for String) would cause probable confusion in the mind of the average, reasonable Internet user. (TLDH Expert Determination, Pg. 7.) The Amazon Panel, on the other hand, in sustaining Commercial Connect's objection, found that Amazon's arguments:

[d]o not appear to be consistent with the applicable standard of review, the apparent purpose or goal of implementing gTLDs, or the purpose or goal in allowing a string confusion objection.

(Amazon Expert Determination, Pg. 5.) Overall, the Amazon Panel found that Amazon's arguments were "not persuasive." (Expert Determination, Pg. 5.)

Moreover, according to the TLDH Expert Determination, TLDH asserted that Commercial Connect's Applied-for String and TLDH's Applied-for String are aimed at distinct markets, as evidenced by the descriptions in the two applications. TLDH claimed that Commercial Connect's Applied-for String will be marketed to "the global ecosystem of e-commerce" with a "strict verification process where Commercial Connect researches the identity of that applicant and [the] business." (TLDH Expert Determination, Pg. 5.) In contrast, TLDH's Applied-for String is directed to "Chinese-language vendors" and requires no such pre-verification. TLDH noted that these markets may overlap to some extent, but one is "global and

restricted,” while the other is “language-specific and open.” (TLDH Expert Determination, Pg. 5.)

The TLDH Panel found that the similarity in meaning between the two strings is apparent only to individuals who read and understand both Chinese and English. Relying on the intended markets for the strings, the TLDH Panel determined:

While there is some potential for overlap between these two markets, they are largely distinct. Therefore, there is little likelihood that a bilingual user would be deceived or confused.

(TLDH Expert Determination, Pg. 7.) The TLDH Panel therefore dismissed Commercial Connect’s objection not because it concluded that translations of essentially the same word are insufficient to cause string confusion – as Commercial Connect contends – but because TLDH presented convincing evidence that there was little likelihood of confusion between Commercial Connect’s Applied-for String and TLDH’s Applied-for String.

Ultimately, Commercial Connect has not been able to establish an actual policy or process that either panel failed to follow. The Request instead challenges the substantive determinations of the panels rather than the processes by which the panels reached their determinations. While Commercial Connect may disagree with the TLDH Panel’s findings, Reconsideration is not available as a mechanism to re-try the substantive determination of the TLDH Panel. Commercial Connect’s claims that the panels inconsistently applied the standards set out in the Applicant Guidebook are unsupported and do not support Reconsideration.

**B. ICANN’s Alleged Failure To Provide Guidance To The Panels Does Not Support Reconsideration**

In its Request, Commercial Connect contends that its participation in the dispute resolution process was predicated on its reliance that DRSP-appointed panels would comply with the clear and well-defined guidance provided by ICANN and that ICANN would only accept

determinations that complied with ICANN's guidance. Commercial Connect claims that ICANN's "failure to provide and ensure compliance with clear and well defined guidance has resulted in inconsistent results in identical fact patterns." (Request, Pg. 6.)

Commercial Connect does not contend that the dispute resolution procedures set out in Module 3 of the Applicant Guidebook, or the attached Procedures, were not followed. Instead, it appears that Commercial Connect is challenging an alleged inaction – *i.e.*, ICANN's purported failure to act to provide "clear and well-defined guidance" to dispute resolution panels and failure to "ensure compliance" with that guidance. (Request, Pg. 6.) But Commercial Connect does not identify any established policy or process that required ICANN to take action above the action it has already taken in implementing the New gTLD Program.

ICANN's decision to proceed with the New gTLD Program followed many years of discussion, debate and deliberation with the Internet community, including end users, business groups and governments. ICANN's work to implement the New gTLD Program – including the creation of an application and evaluation process for new gTLDs that is aligned with the policy recommendations and provides a clear roadmap for applicants to reach delegation – is reflected in the drafts of the applicant guidebook that were released for public comment, and in the explanatory papers giving insight into the rationale behind some of the conclusions reached on specific topics. Meaningful community input from participants around the globe has led to numerous and significant revisions of each the draft version of the applicant guidebook, resulting in the Applicant Guidebook that is used in the current application round.

The current Applicant Guidebook is publicly posted on an ICANN website dedicated to the New gTLD Program. See <http://newgtlds.icann.org/en/applicants/agb>. The standards for evaluating the merits of a string confusion objection are provided in the Applicant Guidebook,

and by filing an application for a new gTLD, each applicant agrees to accept the applicability of the gTLD dispute resolution process. (Guidebook, Section 3.5.1 & Section 3.3.2; Procedure, Art. 1(d).) Applicants are evaluated against transparent and predictable criteria, and the procedures are designed to ensure fairness.

Commercial Connect's disagreement as to whether the standards should have resulted in the TLDH Panel dismissing Commercial Connect's objection does not mean that ICANN violated any policy or process in accepting the decision (nor does it support a conclusion that either panel's decision was wrong). The Applicant Guidebook sets out the standards used to evaluate and resolve objections. The TLDH Expert Determination and the Amazon Expert Determination reflect that the panels followed the evaluation standards. As explained above, Commercial Connect has not been able to establish any policy or process that either panel failed to follow. ICANN's acceptance of the determinations as advice to ICANN is also in accordance with the established process. (Guidebook, Section 3.4.6.) Commercial Connect's attempt to claim here that the procedures set forth in the Applicant Guidebook for evaluating string confusion objections, which followed years of inclusive policy development and implementation planning, are somehow deficient because of allegedly inconsistent expert determinations is therefore not supported and should be rejected.

#### **IV. Recommendation and Conclusion**

Based on the foregoing, the BGC concludes that Commercial Connect has not stated proper grounds for reconsideration, and we therefore recommend that Commercial Connect's Request be denied without further consideration.

As there is no indication that the TLDH Panel violated any policy or process in dismissing Commercial Connect's objection, and there is similarly no indication that ICANN acted inconsistent with any established policy or procedure, this Request should not proceed. If

Commercial Connect thinks that it has somehow been treated unfairly in the process, and the Board (through the New gTLD Program Committee) adopts this Recommendation, Commercial Connect is free to ask the Ombudsman to review this matter.

Though there are no grounds for reconsideration presented in this matter, following additional discussion of the matter the BGC recommended that staff provide a report to the NGPC, for delivery in 30 days, setting out options for dealing with the situation raised within this Request, namely the differing outcomes of the String Confusion Objection Dispute Resolution process in similar disputes involving Amazon's Applied-for String and TLDH's Applied-for String. In addition, the BGC suggested that the strings not proceed to contracting prior to staff's report being produced and considered by the NGPC.

**Reconsideration Request  
DERCars, LLC**

**Annex I**

Table of Arguments in .CARS Expert Determinations

**Table of Arguments in .CARS Expert Determinations**

	<b>.CARS I Koko Castle, LLC</b>	<b>.CARS II DERCars, LLC</b>	<b>.CARS III Uniregistry, Corp.</b>
<b>Objector's Argument</b>			
.CAR and .CARS strings are virtually identical in appearance	<b>Y</b> (ED at 3)	<b>Y</b> (ED at 7-8)	<b>Y</b> (ED at 4)
UDRP case precedent finding confusing similarity between singular and plural forms	<b>Y</b> (ED at 3)	<b>Y</b> (ED at 7)	<b>Y</b> (ED at 4)
SWORD analysis of visual similarity	<b>Y</b> (ED at 5)	<b>Y</b> (ED at 7-8)	<b>Y</b> (ED at 4)
Confusion in e-mail addresses and announcements	<b>N</b> *	<b>Y</b> **	<b>Y</b> (ED at 4)
Phonetic similarity between .CAR and .CARS	<b>Y</b> (ED at 3)	<b>Y</b> (ED at 8)	<b>Y</b> (ED at 4)
.CAR and .CARS strings are virtually identical in meaning	<b>Y</b> (ED at 6)	<b>Y</b> (ED at 8)	<b>Y</b> (ED at 4-5)
Public comments in 2000 gTLD round regarding confusion between singular and plural versions of same string	<b>Y</b> (ED at 3)	<b>Y</b> (ED at 9)	<b>Y</b> (ED at 5)
Difficulty of distinguishing between singular and plural form for non-English speakers	<b>Y</b> (ED at 3)	<b>Y</b> (ED at 9)	<b>Y</b> (ED at 5)
<b>Applicant's Argument</b>			
An objector bears a heavy burden to show why a new gTLD application should not be granted	<b>Y</b> (ED at 3)	<b>Y</b> (ED at 10)	<b>Y</b> (ED at 5)
Generic terms such as .CAR are incapable of receiving trademark protection	<b>Y</b> (ED at 3)	<b>Y</b> (ED at 10-12)	<b>Y</b> (ED at 5)
U.S. trademark law considers other factors beyond similarity of the terms themselves	<b>Y</b> (ED at 3)	<b>Y</b> (ED at 10)	<b>N</b>
Services offered will help users distinguish between similar strings	<b>Y</b> (ED at 3)	<b>Y</b> (ED at 33-34)	<b>N</b>
Consumers are more cautious and discerning with respect to generic terms	<b>N</b>	<b>Y</b> (ED at 11)	<b>N</b>
Proposed strings must be considered in context	<b>N</b>	<b>Y</b> (ED at 11-12)	<b>N</b>
ICANN string similarity review did not place singular/plurals in common contention sets	<b>Y</b> (ED at 4)	<b>Y</b> (ED at 11)	<b>N</b>



	<b>.CARS I Koko Castle, LLC</b>	<b>.CARS II DERCars, LLC</b>	<b>.CARS III Uniregistry, Corp.</b>
ICANN expert panel found no visual similarity between .CAR and .CARS	Y (ED at 4)	Y ***	N
72% string similarity does not establish likelihood of confusion	Y (ED at 4)	N	N
Singular/plural pairs exist in second level domain names	Y (ED at 4)	Y (ED at 12)	Y (ED at 5)
Easier to distinguish singular/plural TLDs than second level domains	Y (ED at 4)	Y (ED at 13)	N
Presence of “s” negates aural similarity	Y (ED at 4)	N	N
Plurals have different meanings	N	N	Y (ED at 6)
Car and Cars have different meanings in other languages	Y (ED at 4)	N	N
Methodology of foreign language confusion study invalid or not persuasive	Y (ED at 4)	Y (ED at 14)	N
Similarity will not result in confusion, as evidenced by .AUTO and .AUTOS	Y (ED at 4)	Y (ED at 10)	N
ICANN public comments cited by objector are distinguishable	Y (ED at 4)	Y (ED at 13-14)	N
Average, reasonable users do not form expectations based on domain names alone, lessening any likelihood of confusion	N	Y (ED at 13)	Y (ED at 6)
Interest in competition should support presumption of choice	N	N	Y (ED at 6)

ED = Expert Determination

\* Although this argument is not referenced in the .CARS I expert determination, it likely was raised in the objection (which is not publicly available), based on the other similarities in Charleston Road’s objections.

\*\* Although this argument was raised in the objection, it is not referenced in the .CARS II Expert Determination.

\*\* Although this argument was raised in the applicant’s response, it is not referenced in the .CARS II Expert Determination.