

International Centre for Dispute Resolution

New gTLD String Confusion Panel

Re: 50 504 T 219 13

AFILIAS LIMITED, OBJECTOR

and

JOHN ISLAND, LLC, APPLICANT

String: <.pets>

EXPERT DETERMINATION

The parties

The Objector is AFILIAS LIMITED, 2 La Touche House, IFSC, Dublin 1, Ireland (hereinafter, the “Objector”), and is represented by David Taylor, Esq., HOGAN LOVELLS (PARIS) LLP, 17 Avenue Matignon, 75008 Paris, France

The Applicant is JOHN ISLAND, LLC, 155 108th Avenue NE, Suite 510, Bellevue, WA 98004 (hereinafter, the “Respondent”), and is represented by THE IP & TECHNOLOGY LEGAL GROUP, P.C., dba New gTLD Disputes, 15260 Ventura Boulevard, Suite 1810, Sherman Oaks, CA 91403, USA

The New gTLD String Objected To

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

Prevailing Party

The Objector has prevailed and the Objection is sustained.

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 is 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

Objector filed a request for determination with ICDR, the Dispute Resolution Service Provider (DRSP) for String Confusion Objections, on March 18, 2013. After an administrative review, on April 4, 2013 ICDR found that the Objection did not comply with Articles 5-8 of the New gTLD Dispute Resolution Procedure and the applicable ICDR Rules, and set a five days deadline to cure. After Objector rectified the deficiencies, the DRSP confirmed compliance on April 11, 2013. Applicant filed its timely response within 30 days of a prompting letter by the DRSP. ICDR confirmed on May 23, 2013, that the response complied with Art. 11 of the New gTLD Dispute Resolution Procedure and the ICDR Rules. ICDR appointed a one person expert panel on June 14, 2013. After proper funding and expert disclosure, which disclosure is ongoing, the DRSP set a deadline of August 15, 2013, for the expert determination of this case.

Basis of Objector’s Standing to Object for String Confusion

The Objector is an applicant for the TLD “.pet” in the current application round. It applied for the “.pet” TLD string on June 13, 2012 (original post; see Annex 2 to Objection). Applicant misstates Article 3.2.2.1 of the gTLD Applicant Guidebook (version 2012-06-04, Module 3) of ICANN: it is not a requirement for standing that two applicants have been put into a contention set. Thus Objector has standing in accordance with Article 3.2.2 of the gTLD Applicant Guidebook (version 2012-06-04, Module 3) of ICANN.

Parties’ Contentions

Objector

After noting that in the *ad hoc* new gTLD program of ICANN there are no precedents, Objector draws parallels with rules mainly regarding trademark law. Given the subject matter’s

global nature, Objector includes law from the EU, US, and other jurisdictions. It sets forth the standard of the Court of Justice of the EU and Article 4(1)(b) of the First Council Directive 89/104/EEC of December 21, 1988 as an approximation. It bases the similarity of the marks on the overall impression given by the marks, bearing in mind their distinctive and dominant components.

Objector lists some trademarks that have been found likely to be confused, such as “troll” and “trolls”, “light” and “lights”, “igoal” and “igoals”, “alien” and “aliens”, all on at least two grounds. It points out that Applicant basically added only an additional letter, “s”, but otherwise submits the same name. An additional letter is in Objector’s view clearly insufficient to make the signs look or sound dissimilar. According to a EU 2012 Decision the consumer generally pays greater attention to the beginning of a mark than to the end.

To bolster Objector’s argument that Applicant’s submission is similar in sound, Objector lists more cases, e.g., ETOOL(S), DIGIT(S), and BEATLE(S), in which the trademarks were found similar. Likewise regarding conceptual similarity, Objector lists cases particularly from English-speaking courts, as the average Internet user should be familiar with the English language. PIRATE(S), NEWPORT(S), LEGO(S) and HUSKY/HUSKIES are examples where the plural form doesn’t change the meaning, but remains very similar. Objector also argues that GENERAL MOTOR could not argue it is singular and thus not confusing with the plural version; see WIPO Arbitration and Mediation Center, *12 Technologies Inc v. Richard Alexander Smith* (Case No. D2001-0164, 4 June 2001).

Applicant

Applicant references another TLD, “.mobile”, applied for by a sister company and objected to by Objector. Applicant alleges that neither this other objection nor the string in question here bears actionable resemblances. Applicant also sees Objector seeking to stifle fair competition and free speech by “misusing the ICANN objection process to place obstacles in the path of those applying for distinct TLD names” (Response p. 2). In the view of Applicant, a successful elimination of “.pets” would contravene the letter and spirit of the new gTLD program which is increased choice and competition in the domain name industry.

Applicant argues that the other side equates two different terms (“.pet” and “.pets”). Applicant also contends that the legal standard is unsatisfied; similarity judgments for trademarks rely on different criteria than those using the new gTLD string similarity standard. “Pets” is, according to Applicant, either itself a generic term, or merely describes domain names or websites that present information concerning pets. Applicant holds that trademark law does not protect generic terms and serves no source-identifying function. Trademark law often treats simple modifiers as part of generic non-protectable names. Applicant refers to the initial evaluation performed by the independent review panel ICANN, and reminds the panel that “.pets” passed it.

Applicant alleges that Objector does not show sufficient similarity to make confusion probable. Applicant has produced a table for other words under ICANN’s string similarity

assessment tool such as “pets” and “sept”, or “google” and “goggle”. This table shows score results of 75% and higher, thus above the 72% that “pet” and “pets” scored. Respondent lists further co-existing websites with singular and plural forms, e.g., “pet.com” and “pets.com”, or “prettypet.com” and “prettypets.com”.

Applicant bases its opinion that the sound of “pet” and “pets” is different on the fact that they end in two different consonants, “t” and “s”. Applicant points to differences in the pronunciation of “pet” and “pets” which it asserts are “substantial.” It refers to divergence in meaning with dictionary examples. Applicant also mentions that TLDs have long been used interchangeably on the “left” and “right” sides of the “dot” as second-level extensions, referencing some country strings. Applicant wants to give “modern Internet users” more credit than Objector.

Applicant emphasizes that the degree of similarity has not reached a “loss of confidence in the DNS” (domain name system) required under ICANN Guidance. According to Respondent, the many pet related domain strings show that they can co-exist. Applicant argues that Objector has failed to demonstrate other “confusion” factors.

Discussion and Findings

Merits of the Objection

The parties agree that “pet” is a dictionary term, and “pets” is the plural of “pet”. Objector references the similarity standard of the Court of Justice of the EU and Article 4(1)(b) of the First Council Directive 89/104/EEC of December 21, 1988 (overall impression). The ICANN similarity standard for TLD string confusion is differently defined. Trademark law, including in *re E.I. du Pont de Nemours & Co*, may be cited analogously. The two strings may be compared in terms of visual, aural and conceptual similarities.

The likelihood of visual similarity seems high, as “pet” is included in “pets”, it differs only in one more letter, and the first three letters are identical, which is the portion that users most focus on. Even Applicant assumes in its analysis “some similarity”. Applicant only believes that “such similarity alone does not suffice to find likelihood of confusion” (Applicant’s Brief, p. 12).

The SWORD algorithm score between the two strings in question here, 72%, is high. Applicant discusses three lists of comparisons in an attempt to disprove the high similarity between “pet” and “pets”. Different terms like “carpets” and “precast” also score in the 70s percentage range. Particularly unhelpful to Applicant are “prettypet.com” and “prettypets.com”, etc. as they concern second level domain names which are a truly different animal (pun unintended).

In terms of aural similarity, other than the “s”, they have the same pronunciation. Applicant’s argument that the sound of “pet” and “pets” is very different on the basis that they end in two different consonants is not convincing.

The “pluralization” of a word does not significantly change its meaning. Words with the same meaning, albeit distinct in number are easy to confuse; their signs are conceptually very similar, if not identical. In general, two grammatical versions of a word do not change their meaning nor heighten their distinguishability. Applicant’s assertion that TLDs have long co-existed interchangeably on the “left” and “right” sides of the “dot” mixes top level with second level domains and is irrelevant here. Although Applicant has labeled Objector’s arguments as “irrelevant” and “incorrect”, Applicant has not provided supporting evidence for its claims.

Objector’s use of examples from various jurisdictions has demonstrated with overwhelming evidence that the plural “s” does not avoid confusing similarity. Neither Applicant’s witness declaration (Declaration of Jonathon Nevett, Executive Vice President of Donuts Inc., dated May 17, 2013, Applicant’s Annex C) nor other evidence effectively rebuts Objector’s evidence. Applicant’s witness declaration states, *inter alia*, that “Donuts” has applied for 307 new gTLDs through subsidiaries and invested \$57 million, had staff investigate existing singular/plural domain name pairs, and that 2,054 out of 351,812 of active registered trademarks have plural matches (see Nevett Declaration p. 6 and 7).

In its June 24, 2013 Resolution, ICANN’s New gTLD Program Committee (NGPC) addressed confusion issues, including singular and plural new gTLDs. The Resolution expressly stated, “ICANN did not provide any instructions to the [String Similarity] panel outside of the criteria specified in the Applicant Guidebook, including any prejudgment of whether singular or plural versions of strings should be considered visually similar.”

The two strings are so close that confusion will occur. The danger of confusion is not only possible, it is probable. Thus, the two strings “.pet” and “.pets” shall be placed in a contention set together.

Determination

“(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.”

The applied for gTLD “.pets” is confusingly similar to the applied for top-level domain “.pet”. It is probable that confusion will arise in the mind of the average, reasonable Internet user.

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

San Francisco, October 20, 2013

Urs Laeuchli, Esq.

Sole Expert Panelist