

Annex 11.



Contact Information Redacted

internet: <http://www.adr.org/ICDR>

May 31, 2013

Via Email

Steven Sereboff, Esq.
SoCal IP Law Group, LLP
Contact Information Redacted

Flip J. Petillion
Crowell & Moring
Contact Information Redacted

Re: 50 504 T 00221 13
Web.com Group, Inc.
vs
Vistaprint Limited

Dear Parties,

The International Centre for Dispute Resolution (ICDR), a division of the American Arbitration Association (AAA), acknowledges timely receipt of the Response to the Objection with respect to the above captioned matter.

We have conducted an administrative review and note that the Response complies with Article 11 of the *New gTDL Dispute Resolution Procedure* and the applicable Dispute Resolution Service Provider (DRSP) Rules.

Therefore, pursuant to Article 13 of the Procedure, the ICDR will proceed with appointing an expert by June 22, 2013.

Sincerely,

/s/

Tom Simotas
ICDR Supervisor
Contact Information Redacted

Annex 12.



Contact Information Redacted

internet: <http://www.adr.org/ICDR>

June 28, 2013

Via Email

Steven Sereboff, Esq.
SoCal IP Law Group, LLP
Contact Information Redacted

Flip J. Petillion
Crowell & Moring
Contact Information Redacted

Re: 50 504 T 00221 13
Web.com Group, Inc.
vs
Vistaprint Limited

Dear Parties,

Pursuant to Article 13 of the New gTLD Dispute Resolution Procedure (“the Rules”), please be advised that the ICDR has appointed Steve Y. Koh, Esq. (“Expert”) to this matter. A copy of the Expert’s resume is attached for your review.

Please note that this matter has been consolidated with case number 50 504 T 00246 13. As such, the Expert’s fee has been negotiated and will total \$9,000.00 for both cases. With that said, the total billing has been split evenly between these two cases.

In accordance with Article 13(c) of the Rules, the Expert shall be impartial and independent of the parties. In that regard the parties are requested to review the Expert’s resume and submit any comments or challenges regarding the appointment by no later than **July 8, 2013**. If a party wishes to challenge the appointment of the Expert, it may submit its comments to the undersigned with a copy to the other side. The Expert shall not be copied on any comments related to the disclosure.

In addition and pursuant to Article 14 of the Rules, the parties may obtain their invoice reflecting the advanced costs required for the proceedings through our Web File system. If you are having issues with obtaining an invoice, please contact me and request a copy. If you have not done so already, please make arrangements to submit payment by **July 8, 2013**.

Sincerely,

/s/

Tom Simotas
ICDR Supervisor
Contact nformation Redacted

Cc: Steve Y. Koh, Esq.

Annex 13.

Janssen, Jan

From: Petillion, Flip
Sent: lundi 12 août 2013 13:41
To: Koh, Steve Y. (Perkins Coie); 'Steve Sereboff'
Cc: Contact information Redacted
Subject: RE: CASE NUMBERS: 50-504-T-000246-13 and 50-504-T-000221-13 - Procedural Order No. 1

Dear Mr Koh,

Thank you for your mail.

We will submit the surreply before the deadline.

Yours sincerely,

Flip Petillion

From: Koh, Steve Y. (Perkins Coie) Contact Information Redacted
Sent: jeudi 8 août 2013 19:28
To: 'Steve Sereboff'; Petillion, Flip
Cc: Contact information Redacted
Subject: CASE NUMBERS: 50-504-T-000246-13 and 50-504-T-000221-13 - Procedural Order No. 1

Dear Counsel,

I am in receipt of Objector's 19 July 2013 supplemental filing, Applicant's 31 July 2013 objection thereto, and Objector's further comment of 5 August 2013. Under Article 17 of the gTLD Dispute Resolution Procedure, I hereby authorize Applicant to submit a surreply, not to exceed 5 pages, and any additional annexes, no later than 6 September 2013.

No further submissions are permitted without prior leave.

Steve Y. Koh

IRS CIRCULAR 230 DISCLOSURE: To ensure compliance with Treasury Department and IRS regulations, we inform you that, unless expressly indicated otherwise, any federal tax advice contained in this communication (including any attachments) is not intended or written by Perkins Coie LLP to be used, and cannot be used by the taxpayer, for the purpose of (i) avoiding penalties that may be imposed on the taxpayer under the Internal Revenue Code or (ii) promoting, marketing or recommending to another party any transaction or matter addressed herein (or any attachments).

NOTICE: This communication may contain privileged or other confidential information. If you have received it in error, please advise the sender by reply email and immediately delete the message and any attachments without copying or disclosing the contents. Thank you.

Annex 14.

From: Tom Simotas Contact Information Redacted
Sent: mercredi 18 septembre 2013 21:32
To: 'Steve Sereboff'; Petillion, Flip
Cc: Contact Information Redacted
Subject: RE: New documents available for cases 50-504-T-000221-13 and 50-504-T-000246-13 [W006-L12531]

Dear Parties,

The Expert is now in receipt of all necessary submissions to complete his determination. After discussing this matter with the Expert, please be advised that a determination will be issued on or about October 4, 2013.

Thank you for your attention to this matter,

Tom Simotas



Tom Simotas
Supervisor

American Arbitration Association
International Centre for Dispute Resolution
Contact Information Redacted

www.icdr.org

T: Contact Information Redacted

F:

The information in this transmittal (including attachments, if any) is privileged and/or confidential and is intended only for the recipient(s) listed above. Any review, use, disclosure, distribution or copying of this transmittal is prohibited except by or on behalf of the intended recipient. If you have received this transmittal in error, please notify me immediately by reply email and destroy all copies of the transmittal. Thank you.

Annex 15.

From: Tom Simotas Contact Information Redacted
Sent: mardi 1 octobre 2013 18:06
To: Petillion, Flip; 'Steve Sereboff'
Cc: 'Koh, Steve Y. (Perkins Coie)'; Tom Simotas
Subject: Cases nos 50 504 T 00221 13 and 50 504 T 00246 13
Importance: High

Dear Parties,

Please be advised that due to a new conflict, the Expert, Steve Koh, currently appointed to these matters, will no longer be able to serve and has been removed.

A new Expert will be appointed shortly.

Thank you,

Tom Simotas



Tom Simotas
Supervisor

American Arbitration Association
International Centre for Dispute Resolution
Contact Information Redacted

www.icdr.org

T: + Contact Information Redacted

F: +

The information in this transmittal (including attachments, if any) is privileged and/or confidential and is intended only for the recipient(s) listed above. Any review, use, disclosure, distribution or copying of this transmittal is prohibited except by or on behalf of the intended recipient. If you have received this transmittal in error, please notify me immediately by reply email and destroy all copies of the transmittal. Thank you.

Annex 16.

From: Tom Simotas Contact Information Redacted
Sent: Monday, October 14, 2013 1:58 PM
To: Steve Sereboff; Contact Information Redacted
Cc: Contact Information Redacted
Subject: RE: Cases 50 504 T 000221 13 and 50 504 T 000246 13

Dear Parties,

Pursuant to Article 13 of the New gTLD Dispute Resolution Procedure ("the Rules"), please be advised that the ICDR has appointed Bruce W. Belding, Esq. ("Expert") to this matter. A copy of the Expert's resume is attached for your review.

In accordance with Article 13(c) of the Rules, the Expert shall be impartial and independent of the parties. In that regard the parties are requested to review the Expert's resume and submit any comments or challenges regarding the appointment by no later than **October 24, 2013**. If a party wishes to challenge the appointment of the Expert, it may submit its comments to the undersigned with a copy to the other side. The Expert shall not be copied on any comments related to the disclosure.

Regards,

Tom Simotas



Tom Simotas
Supervisor

American Arbitration Association
International Centre for Dispute Resolution
Contact Information Redacted

www.icdr.org

Contact Information Redacted

The normal transmission (including attachments, any) is provided and/or condensed and is intended only for the recipient(s) listed above. Any review, use, disclosure, distribution or copying of this transmission is prohibited except by or on behalf of the intended recipient. If you have received this transmission in error, please notify me immediately by reply email and destroy a copy of the transmission. Thank you.

Annex 17.

From: Steve Sereboff Contact Information Redacted
Sent: Thursday, October 24, 2013 2:15 AM
To: Tom Simotas
Cc: Contact Information Redacted
Subject: RE: Cases 50-504-T-000221-13 and 50-504-T-000246-13

Tom,

Opposer hereby challenges the appointment of Bruce W. Belding (the "proposed panelist") in Case nos. 50 504 T 00221 13 and 50 504 T 00246 13.

Opposer desires a prompt decision in this case, and the prompt naming of a new panelist. A new panelist should be chosen carefully to avoid another challenge. Objector suggests that the new panelist should have no prior decisions in a singular-plural string confusion case. The new panelist also should have had no prior dealings with either party, or the representatives for either party.

This challenge is based upon the following independent grounds.

1. The Proposed Panelist Lacks Impartiality and Independence

Opposer believes that there is justifiable doubt about the proposed panelist's ability to be impartial and independent in this case. In particular, having made a decision in a recent case addressing the same core issue, the proposed panelist is biased to make a similar decision in this case. Thus, the proposed panelist is not impartial or independent.

The relevant rule is in the Supplementary Procedures for String Confusion Objections (10 January 2012) (Rules) of the International Centre for Dispute Resolution (ICDR). Article 2 of the Rules states: "1. A party may challenge any Expert whenever circumstances exist that give rise to justifiable doubts as to the Expert's impartiality or independence." Thus, the issue here is whether "justifiable doubts" exist, which is a conservative approach favoring disqualification so as to avoid the appearance of impropriety in the dispute resolution process

Here, there are justifiable doubts that the proposed panelist will be impartial and independent because he will necessarily be biased to make his decision in this case consistent with a very recent prior decision. The prior case was Case No. 50 504 237 13, *Hotel Top-Level-Domain S.a.r.l v. Booking.com B.V.*, available [here](#). In the *Hotel* case, rendered just a few months ago, there was a string confusion objection between the objector's applied-for string "hotel" and the applicant's applied-for string "hotels." The issue was whether the applied-for string "hotels" was likely to be confused with the objector's string "hotel" in the mind of average, reasonable Internet users.

In the *Hotel* case the panelist had to decide whether the plural form of a simple, generic word was likely confusing with the singular form of the same word. In this case, the issue is whether "webs" -- the plural form of a simple, generic word -- is likely to be confused with "web" -- the singular form of the same word -- by ordinary, reasonable Internet users. That is, the proposed panelist is asked to make the same determination in this case that he already made in *Hotel*.

Plural versus singular generic word forms has arisen in a number of other string confusion cases. The decisions in these cases have been inconsistent and strong public criticism of the process has arisen. If an apparently biased panelist is employed in this case, there will necessarily be additional questions about the fairness of the process. This should be avoided.

While it is possible that the proposed panelist could render a decision in this case which conflicts with his *Hotel* decision, he will have a natural bias to be consistent. This natural bias to be consistent means that there are justifiable doubts as to the proposed panelist's impartiality and independence. Accordingly, the proposed panelist should be disqualified from this case.

2. The Proposed Panelist is Disqualified by his Prior Work

The proposed panelist is disqualified here under the New gTLD Dispute Resolution Procedure (Procedure) which prohibits a panelist from acting in a matter relating to a previous matter. In particular, Article 13(e) of the Procedure states:

Unless required by a court of law or authorized in writing by the parties, an Expert shall not act in any capacity whatsoever, in any pending or future proceedings, whether judicial, arbitral or otherwise, relating to the matter referred to expert determination under this Procedure.

The matters that the proposed panelist decided in the *Hotel* case relate to matters in this case. In particular, the same core issue is presented. The issue in this case is whether the singular and plural forms of a generic word are likely to be confused by the ordinary, reasonable Internet user. That was the same issue decided by the proposed panelist in *Hotel*.

Although it could be argued that there are material differences between the *Hotel* case and this one, the proposed panelist's decision in that case strongly suggests that he is insensitive to those differences. In that decision, the proposed panelist wrote: "I find persuasive the degrees of similarity or dissimilarity between the string by use of the String Similarity Assessment Tool" (decision at p. 4). Objector feels strongly that any panelist's reliance on the String Similarity Assessment Tool is inappropriate. In his *Hotel* decision, the proposed panelist also wrote, "I find persuasive . . . that ICANN did not put the applications for .HOTEL and .HOTELS in the same contention set." *Id.* Objector feels even more strongly that any panelist's reliance upon ICANN's selection of contention sets is inappropriate. These issues in *Hotel* – applicability of the String Similarity Assessment Tool and applicability of ICANN's selection of contention sets – relate directly to this case.

The matters decided in *Hotel* relate to this case, and the proposed panelist must be disqualified.

Regards,

/Steven C. Sereboff/
ph + Contact Information Redacted
mobile + Contact Information Redacted
SoCal IP Law Group LLP
www.socalip.com

Contact Information Redacted

Annex 18.

Nelissen, Mariet

From: Petillion, Flip
Sent: mercredi 30 octobre 2013 20:13
To: Tom Simotas
Cc: Contact Information Redacted
Subject: FW: Cases 50-504-T-000221-13 and 50-504-T-000246-13

Dear Mr. Simotas,

Reference is made to the Objector's email of 24 October 2013, in which Objector challenges the appointment of Mr. Bruce W. Belding as Panelist in Case nos. 50 504 T 00221 13 and 50 504 T 00246 13.

According to the Objector, Mr. Bruce W. Belding lacks impartiality and independence and is disqualified by his prior work. The Objector is of the opinion that there are justifiable doubts that the Panelist will be impartial and independent because, according to the Objector, *"he will necessarily be biased to make his decision in this case consistent with a prior case between Hotel Top-Level-Domain S.à.r.l. and Booking.com B.V."*, involving the applied-for strings 'hotel' and 'hotels' (the 'Hotel Case'). In addition, the Objector argues that the present case is related to the previous decision by the Panelist, as the same core issue is presented.

The Applicant considers that the Objector's arguments are unfounded.

There are no reasons giving rise to justifiable doubts that the Panelist will be impartial and independent. The fact that a panelist made an expert determination in a similar case is no ground for disqualification. Each case should be examined on its own merits. The fact that similarities may exist between different cases is linked to the nature and the subject-matter of string confusion objections. This does not prevent an expert to serve as panelist in different string confusion objection cases. It is exactly because of his expertise that a panelist is asked to give his expert determination on these cases.

In this respect, reference can also be made to the IBA Guidelines on Conflicts of Interest in International Arbitration ('IBA Guidelines'). The IBA Guidelines provide guidance on the requirements of impartiality and independence. Under these guidelines, any views expressed by an arbitrator or panelist on similar issues to the issue in dispute do not give rise to justifiable doubts as to the independence or impartiality of the Panelist and do not constitute a reason to challenge him. To the contrary, the IBA Guidelines adopted a Green List that *"contains a non-exhaustive enumeration of specific situations where no appearance of, and no actual, conflict of interest exists from the relevant objective point of view"* (IBA Guidelines, p. 18). This Green List specifies that there is no appearance of, and no actual conflict of interest where an arbitrator (or panelist) *"has previously published a general opinion (such as in a law review article or public lecture) concerning an issue which also arises in the arbitration (but this opinion is not focused on the case that is being arbitrated)"* (IBA Guidelines, p. 24). When an arbitrator *c.q.* panelist has previously served in another arbitration *c.q.* expert determination on a related issue, these can only give rise to justifiable doubts as to his impartiality or independence insofar this issue involved one of the parties or an affiliate of one of the parties (IBA Guidelines, point 3 on p. 18 in conjunction with point 3.1.5 on p. 22). This principle is also translated in Article 13 (e) of the Procedure which prohibits an appointed expert to act in any capacity in any pending or future proceedings relating to the matter referred to expert determination. This prohibition does not prevent an expert to decide on related issues in another matter between different parties.

In the present case, the Applicant is unaware of a related issue in which any of the parties or their affiliates were involved in and on which Mr. Bruce W. Belding served as an arbitrator or panelist. It is of no relevance that Mr. Bruce W. Belding was of the opinion in an unrelated case about a similar issue that:

"Upon my review and consideration of the Objection, Response and attachments to each, the Objector has not sustained its burden of proof. I find insufficient factual and/or evidentiary, and no expert opinion, support for the Objection required to sustain Objector's burden of proof." (Expert Determination in the Hotel Case, p. 3)

Mr. Bruce W. Belding will now have to review and consider a different objection, a different response and different attachments to determine whether or not the Objector has sustained its burden of proof. Mr. Bruce W. Belding can do so in all independence and impartially.

Therefore, the Applicant respectfully requests that Objector's request to disqualify Mr. Bruce W. Belding as Panelist be rejected.

Sincerely yours,

Flip Petillion

Annex 19.

From: Tom Simotas [mailto:Contact nformation Redacted]
Sent: lundi 4 novembre 2013 17:42
To: Petillion, Flip; Contact Informat on Redacted
Cc: Tom Simotas
Subject: RE: Cases 50-504-T-000221-13 and 50-504-T-000246-13
Importance: High

Dear Parties,

After careful review of your comments, please be advised that the objection to the continued service of Mr. Belding has been sustain and the Expert has been removed.

We will be appointing a new Expert shortly.

Thank you,

Tom Simotas



Tom Simotas
Supervisor

American Arbitration Association
International Centre for Dispute Resolution
Contact Information Redacted

www.icdr.org

T:+1 212 484 4077

F:+1 212 246 7274

The information in this transmittal (including attachments, if any) is privileged and/or confidential and is intended only for the recipient(s) listed above. Any review, use, disclosure, distribution or copying of this transmittal is prohibited except by or on behalf of the intended recipient. If you have received this transmittal in error, please notify me immediately by reply email and destroy all copies of the transmittal. Thank you.

Annex 20.

Janssen, Jan

From: Petillion, Flip
Sent: mardi 5 novembre 2013 18:32
To: Tom Simotas; SSereboff@socalip.com
Subject: RE: Cases 50-504-T-000221-13 and 50-504-T-000246-13

Dear Mr. Simotas,

It is surprising to read that the Center has sustained the challenge of Mr. Belding as an Expert.

The Applicant considers that there are no apparent reasons to disqualify Mr. Belding as an Expert in this matter. This is explained in more detail in our response to the Objector's challenge of Mr. Belding. It seems to the Applicant that the facts invoked by the Objector were no reason to challenge or disqualify Mr. Belding, which is why the Center did not refrain from appointing Mr. Belding in the first place.

If the reasons stated by the Objector are a sufficient ground to challenge an expert, the Applicant wonders how the Center will ever be able to appoint an expert, as experts, by definition, have expert opinions about issues that are similar to the one that is at stake in the current proceedings. As previously explained by the Applicant, this is no reason to challenge an expert.

The Applicant is also wondering how the expert who was appointed prior to Mr. Belding could resign from his mission, because of a conflict that had arisen during proceedings which are specifically designed with the goal of resolving disputes rapidly. If there was no conflict when accepting his mission, how could a conflict have subsequently arisen?

In view of the fact that there are no reasons to challenge Mr. Belding as an Expert and in view of the delays that have already occurred in relation to the present proceedings, the Applicant is of the opinion that Mr. Belding should be allowed to complete his mission and render an expert determination.

Therefore, we respectfully request the Center to reconsider its decision to sustain the challenge to the continued service of Mr. Belding.

Sincerely yours,

Flip Petillion

From: Tom Simotas [mailto:[Contact Informat on Redacted](#)]
Sent: lundi 4 novembre 2013 17:42
To: Petillion, Flip; SSereboff@socalip.com
Cc: Tom Simotas

Annex 21.

From: Tom Simotas [mailto:SimotasAt@adr.org]
Sent: vendredi 8 novembre 2013 22:35
To: Petillion, Flip; Contact Informat on Redacted
Cc: Tom Simotas
Subject: RE: Cases 50-504-T-000221-13 and 50-504-T-000246-13
Importance: High

Dear Counsel,

This will acknowledge receipt of Mr. Petillion's request to reconsider our decision to remove Mr. Belding as the Expert.

After careful review and consideration of the Applicant's comments, the ICDR will stand by its decision to remove Bruce Belding and will appoint a new Expert shortly.

Thank you,

Tom Simotas



Tom Simotas
Supervisor

American Arbitration Association
International Centre for Dispute Resolution
Contact Information Redacted

www.icdr.org

T: Contact Information Redacted

F:

The information in this transmittal (including attachments, if any) is privileged and/or confidential and is intended only for the recipient(s) listed above. Any review, use, disclosure, distribution or copying of this transmittal is prohibited except by or on behalf of the intended recipient. If you have received this transmittal in error, please notify me immediately by reply email and destroy all copies of the transmittal. Thank you.

Annex 22.



Contact Information Redacted

internet: <http://www.adr.org/ICDR>

November 20, 2013

Via Email

Steven Sereboff, Esq.
SoCal IP Law Group, LLP
Contact Information Redacted

Flip J. Petillion
Crowell & Moring
Contact Information Redacted

Re: 50 504 T 00221 13
Web.com Group, Inc.
vs
Vistaprint Limited

Dear Parties,

Pursuant to Article 13 of the New gTLD Dispute Resolution Procedure (“the Rules”), please be advised that the ICDR has appointed Prof. Ilhyung Lee (“Expert”) to this matter. A copy of the Expert’s resume is attached for your review.

In accordance with Article 13(c) of the Rules, the Expert shall be impartial and independent of the parties. In that regard the parties are requested to review the Expert’s resume and submit any comments or challenges regarding the appointment by no later than **December 2, 2013**. If a party wishes to challenge the appointment of the Expert, it may submit its comments to the undersigned with a copy to the other side. The Expert shall not be copied on any comments related to the disclosure.

Sincerely,

/s/

Tom Simotas
ICDR Supervisor
Contact Information Redacted

Cc: Prof. Ilhyung Lee

Annex 23.

Janssen, Jan

From: Petillion, Flip
Sent: mercredi 31 juillet 2013 16:54
To: Steve Koh Contact Information Redacted
Cc: Contact nformation Redacted; Steve Sereboff; Contact nformation Redacted; David Barron; 'Victoria Clifford'; Janssen, Jan
Subject: CASE NUMBERS: 50-504-T-000246-13 and 50-504-T-000221-13

Dear Panelist,

Reference is made to the Objector's unsolicited supplementary filing of 19 July 2013 in the consolidated cases 50-504-T-000221-13 and 50-504-T-000246-13. It is said to contain a reply brief and 25 annexes of additional evidence.

According to the new gTLD Dispute Resolution Procedure (hereinafter, the 'Procedure'), it is not up to the parties to decide upon the submission of additional written statements in addition to the Objection and the Response filed with the Dispute Resolution Service Provider. Article 17 of the Procedure provides that only the Panel may decide whether the parties shall submit any written statements in addition to the Objection and the Response.

The goal of the proceedings is to resolve disputes rapidly and at reasonable cost. This goal is specifically referred to in relation to the procedures for the production of documents. Article 18 provides that in order to achieve the goal of resolving disputes over new gTLDs rapidly and at reasonable cost, procedures for the production of documents shall be limited. In exceptional cases, the Panel may require a party to provide additional evidence.

As a result, the filing of additional submissions and evidence can only be granted in exceptional circumstances and only if the Panel so requires. In previous decisions dealing with a legal rights objection, Panels have decided not to accept additional filings or evidence, based on the fact that:

- there were no exceptional circumstances,
- evidence was untimely submitted without explaining why it was not provided with the objection,
- the process is intended "to achieve the goal of resolving disputes rapidly and at reasonable cost", and that
- there were no reasons to accept reply evidence in a procedure that does not contemplate a reply

(See WIPO Case No. LRO2013-0044 and WIPO Case No. LRO2013-0046).

The Applicant considers that there are no exceptional circumstances in the case at hand that would justify the provision of additional evidence or the submission of additional written statements. The unsolicited additional submission does not contain statements or arguments that could not have been foreseen in the original objection.

The necessity to examine the additional written submission and evidence would create unreasonable additional costs for the Applicant. The Applicant considers that the procedural ramifications of the admission of the Objector's unsolicited filing and additional evidence would violate the express goal of the Procedure "of resolving disputes rapidly and at reasonable cost".

However, if the Panel has considered the additional submission of the Objector or wishes to examine it, the Applicant respectfully requests that it be given the opportunity to respond so that, in accordance with Article 4(e) of the Procedure, the parties are treated with equality, and the Applicant is given a reasonable opportunity to present their position. Should the Panel wish to invite the Applicant to submit an additional statement or evidence, the Applicant requests to be granted sufficient time to prepare a response, taking into account that the Objector has submitted its unsolicited additional submission 2 months following the filing of the Response by the Applicant.

Thank you for your attention to this matter.

Sincerely yours,

Flip Petillion

Annex 24.

INTERNATIONAL CENTRE FOR DISPUTE RESOLUTION

New gTLD String Confusion Panel

Re: ICDR Case Nos. 50 504 221 13 and 50 504 246 13 (Consolidated)

Web.com Group, Inc., Objector

and

Vistaprint Limited, Applicant

String: <.webs>

Expert Determination

The Parties

The Objector is Web.com Group, Inc., **Contact Information Redacted**
Contact Information Redacted, represented by Steven C. Sereboff, Esq., SoCal IP Law Group
LLP, **Contact Information Redacted**
Contact Information Redacted

The Applicant is Vistaprint Limited, **Contact Information Redacted**
Contact Information Redacted represented by Flip Petillion, Advocaat, Crowell &
Moring, **Contact Information Redacted**

The New gTLD Objected To

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

Prevailing Party

The Objector has prevailed, and the Objection is sustained.

The New gTLD String Confusion Process

In June 2011, the Internet Corporation for Assigned Names and Numbers ("ICANN") approved the gTLD Applicant Guidebook ("Guidebook"), regarding applications for new generic top level domains ("gTLDs"). Module 3 of the Guidebook, Objection Procedures ("Module 3"), addresses, *inter alia*, dispute resolution procedures when

a third party files an objection to an application. Attachment to Module 3, New gTLD Dispute Resolution Procedure (“Attachment to Module 3”), provides for procedures that “apply to all proceedings administered by each of the dispute resolution service providers (DRSP).”

Article 1(b) of Attachment to Module 3 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”

There are four separate grounds on which an objection to an application of a new gTLD may be made.¹ One of these grounds is the string confusion objection, in which “[t]he applied-for gTLD string is confusingly similar to an existing TLD or to another applied-for gTLD string in the same round of applications.”² Article 3(a) of Attachment to Module 3 states that “String Confusion Objections shall be administered by the International Centre for Dispute Resolution.” In accordance with this mandate, on January 10, 2012, the International Centre for Dispute Resolution (“ICDR”) issued its Supplementary Procedures for String Confusion Objections (“ICDR Procedures”).

Procedural History of This Case

The ICDR has informed the Panel of the following history.

The Objector filed this String Confusion Objection, with annexes thereto, on March 13, 2013. Pursuant to Paragraph 3.4.2 of Module 3, and Article 12 of Attachment to Module 3, the ICDR consolidated the two cases, on May 6, 2013. On May 23, 2013, the Applicant/Respondent filed its Response and annexes thereto. On June 28, 2013, the ICDR appointed a panelist for an Expert Determination. On July 19, 2013, the Objector submitted its Objector’s Reply to Applicant’s Response, with annexes thereto. On July 31, 2013, the Applicant submitted a statement objecting to the Objector’s supplemental filing, to which the Objector responded, on August 5, 2013. On August 8, 2013, the appointed panelist acknowledged receipt of the Objector’s Reply to Applicant’s Response and the parties’ respective statements dated July 31, and August 5, 2013, and instructed, “Under Article 17 of [Attachment to Module 3], I hereby authorize Applicant to submit a surreply, not to exceed 5 pages, and any additional annexes, no later than 6 September 2013.” The Applicant filed its Surreply and annexes thereto, on August 29, 2013.

¹ Module 3 ¶ 3.2.1; Attachment to Module 3 art. 2(e).

² Module 3 ¶ 3.2.1. Likewise, Article 2(e)(i) of Attachment to Module 3 provides: “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.”

On October 1, 2013, under Article 2 of the ICDR Procedures, the ICDR removed the initial panelist. On October 14, 2013, the ICDR, under Article 3 of the ICDR Procedures, appointed a replacement panelist. On November 4, 2013, the ICDR removed the second panelist.

On November 20, 2013, the ICDR appointed Professor Ilhyung Lee to serve as the Panel, with notice to counsel for both parties. Before the appointment, the Panel stated that it has no disclosure of any circumstances that would likely give rise to justifiable doubts as to the Panel's impartiality or independence, as required by Article 1 of the ICDR Procedures, and to ensure compliance with the Guidebook.³

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

Paragraph 3.2.2 of Module 3 requires that an objector must satisfy the standing requirement in order for its objection to be considered. Regarding standing for a string confusion objection, Paragraph 3.2.2.1 states in relevant part,

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.

Here, Web.com Group, Inc., the Objector, is an applicant for the gTLD string <.web>. In the Initial Evaluation, ICANN placed the Objector's <.web> gTLD in String Contention Set 222, and the Applicant's <.webs> gTLD in String Contention Set 223.

The Objector has satisfied the standing requirement.

Parties' Contentions

A. The Objector

The Objector asserts principally that it has standing to file this String Confusion Objection, and that it has met its burden of proving that the Applicant's applied-for gTLD <.webs> is likely to result in string confusion, under Paragraph 3.5.1 of Module 3. In summary, the Objector states:

WEB and WEBS are merely the plural and singular forms of the same word. As a result the two strings are virtually indistinguishable in sight, sound and meaning such that there is a strong likelihood that average, reasonable

³ Module 3 ¶ 3.4.4; Attachment to Module 3 art. 13(c).

Internet users would be confused or deceived if the two strings were delegated.⁴

In addition, the Objector:

>states that confusion is “especially acute for non-native English speakers”, who “commonly confuse plural and singular word forms or omit the plural all together”, and also notes that “the vast majority of Internet users are non-native English speakers”;⁵

>relies on the conclusions of an expert with “a doctoral degree in linguistics (morphophonology)”,⁶ who stated that the average reasonable Internet user “may or may not notice the extra ‘s’ on the end. This is particularly true in the context of an Internet gTLD, which will appear to the Internet user at the end of a longer letter string that incorporates at the very least a second-level domain name that is the focus of what the Internet user is searching to find”;⁷

>refers also to its expert’s conclusions:

In my opinion “web” and “webs” fall into a category where there is more likelihood of confusion between them than there might be with other noun/noun + plural morpheme words, given the similarities in orthography, phonology and concept, particularly as these terms are already used interchangeably in some contexts.

For this reason, there is a high likelihood of confusion in the minds of the “average, reasonable Internet user,” who would be viewing these nearly identical letter strings as top-level domain names at the end of longer URL strings that contain material which is more important to and more easily distinguishable for the typical user.⁸

⁴ Objector’s String Confusion Objection at 3 [hereinafter Objection].

⁵ *Id.* at 5 (emphasis in original). In this regard, the Objector relies on its linguistics expert, who reported that less than 14% of the Internet users in the world are from English-speaking countries. Objector’s Reply to Applicant’s Response Annex R1 at 3 [hereinafter Annex R1].

⁶ Annex R1, *supra* note 5, at 1.

⁷ *Id.* at 3.

⁸ *Id.* at 5. The Objector’s linguistics expert also offered a sharp critique of the report submitted by her counterpart on the Applicant’s side, stating, among other things, that the Applicant’s expert is “an expert in French linguistics. . . . The average, reasonable Internet user probably does not speak French.” *Id.* at 4.

>points to “abundant evidence of actual confusion between WEBS and WEB”, including confusion by U.S. law enforcement agencies, the Applicant’s own customers, and the Applicant itself;⁹ and

>refers to numerous court decisions and decisions under the Uniform Domain Name Dispute Resolution Policy that have found confusing similarity between singular and plural forms of the same noun.

B. The Applicant

The Applicant contends principally that the Objector has failed to meet its burden of proving that the Applicant’s applied-for <.webs> is likely to result in string confusion. In addition, the Applicant states, *inter alia*, that:

*the <.webs> and <.web> strings are different, visually, aurally, and in meaning:

Visually, the ‘S’ is a clear differentiator because it is positioned at the end of the short word (which gives it priority in the processing of word recognition) and it has the function to indicate the plural, which is a regular plural.¹⁰

[A]urally, the strings are different. . . . [B]oth ‘webs’ and ‘web’ consist of completely regular patterns and are spelled out exactly as they sound. In other words, all letters are clearly pronounced in both words, which makes the words clearly recognizable and distinct from one another.¹¹

The strings have a different meaning. ‘Web’ refers to the world wide web or to a network or silken structure created by a spider . . . , whereas ‘webs’ has no particular meaning and could be anything. On Wikipedia, ‘webs’ is used for the Applicant’s web hosting services, a radio station and a 2003 sci-fi movie ‘Web’ on the other hand has a clear dictionary meaning¹²

⁹ Objection at 7-8.

¹⁰ Applicant’s Response at 9.

¹¹ *Id.* at 10.

¹² *Id.*

*“[t]he difference between the .WEBS and .WEB strings is grounded in the character ‘S’ present in the first and not part of the second. In linguistic terms, the character ‘S’ is manifestly distinct”;¹³

*the Objector failed to produce any evidence in support of the argument “that the vast majority of Internet users are non-native English speakers and that non-English speakers commonly confuse plural and singular word forms or omit the plural altogether”, and also asks, “[H]ow can the Objector (without any evidence) know what a non-native English speaker sees and not, or what he distinguishes and she does not?”;¹⁴

*there is no evidence of actual confusion;

*“ICANN’s String Similarity Assessment Tool provides a low similarity rate”, and when comparing <.webs> and <.web>, the “similarity rate is 72%[,] . . . which is much lower than the similarity rate of various TLDs that currently co-exist”;¹⁵

*“neither the String Similarity Panel nor ICANN (who endorses the determinations by the String Similarity Panel) were of the opinion that the .WEBS and .WEB strings are so similar that they would create a probability of user confusion if allowed to coexist in the DNS”;¹⁶

*in addition to the Objector, there are six other applicants for the <.web> gTLD, and none of these applicants has filed a string confusion objection against the Applicant;¹⁷

*given that there are multiple applicants for the Objector’s applied-for gTLD <.web>, while there are no other applicants for <.webs> other than the Applicant, “The Objector has realized that it faces a challenge in obtaining the delegation of the .WEB extension,” and “[t]he Objector’s sole motive in filing the objection is to prevent a potential competitor, who does not have the

¹³ *Id.* at 8.

¹⁴ *Id.* at 11.

¹⁵ *Id.* at 6. The Applicant further states, “The 72% similarity is also much lower than the 88% similarity between the applied-for .ACCOUNTANTS and .ACCOUNTANT or the 84% similarity between the applied-for .COUPONS and .COUPON The applicants for these strings did not file a string confusion objection.” *Id.*

¹⁶ *Id.* at 7.

¹⁷ *Id.* at 3.

intention to create goodwill in the Objector's name, from entering the gTLD market";¹⁸

*"the Objector seeks to use the string confusion objection to limit competition. Such use of the objection proceedings directly conflicts with the purpose of ICANN's new gTLD program";¹⁹

*the Applicant uses the <webs.com> domain name for the Applicant's business of providing "free website creation tools and hosting services", while the Objector uses its <web.com> domain name for "web site development services," the two parties "have co-existed for many years without any problem",²⁰ and "[t]he Objector has never instituted a formal challenge to the WEBS.COM domain name";²¹

*while the Objector and a third party agreed that there was no likelihood of confusion between the Objector's WEB.COM and the third party's WEB.COM, and having "enjoyed long coexistence without any known instances of actual confusion", "it is impossible to understand how the Objector can agree to coexistence between WEB.COM and WEB.COM and yet object to a coexistence between WEB and WEBS";²² and

*"[w]hereas the letter 'S' in 'WEBS.COM' makes 'WEBS.COM' clearly differ from 'WEB.COM', the difference between a 'WEBS' TLD and a 'WEB' TLD is even greater. As a TLD will always come at the end of the domain name syntax, the distinctive letter 'S' will always appear at the end, making this last letter more significant."²³

The Applicant also relies on the findings of an expert, a professor "in linguistics and language teaching methodology",²⁴ who made the following findings:

Exterior letters serve as visual clues for word recognition. The first and last letters of a word have been shown to be more salient than the rest of the

¹⁸ *Id.* at 11.

¹⁹ *Id.* at 4.

²⁰ *Id.* at 2.

²¹ *Id.* at 7.

²² *Id.*

²³ *Id.* at 7-8.

²⁴ *Id.* at 8.

letters and to receive priority in processing. Readers can recognize a word even when its interior letters are scrambled.

....

In the case of 'web' and 'webs', completely regular patterns allow for a one-to-one mapping of spelling to sound. In other words, a word that consists of completely regular patterns is spelled out exactly as it sounds. The sound of the word easily translates into the spelling of the word and *vice versa*. Words consisting of completely regular patterns facilitate word recognition.

....

[T]here is an extremely limited number of words that could be generated by changing only one single letter in 'webs' and 'web'. In other words, 'webs' and 'web' have a limited number of orthographic neighbors. Words with a high number of orthographic neighbors are more difficult to recognize and have an inhibitory effect when reading, as evidence by eye-fixation patterns. Words with fewer orthographic neighbors are more easily recognizable.

....

[A] reader will first decompose the word 'webs' into meaningful units. 'Webs' is composed of two meaningful units, namely 'web' and the plural marker '-s'. 'Web' only has one meaningful unit.²⁵

²⁵ *Id.* at 8-9. The Applicant also responds to the assertion made by the Objector's expert that the Applicant's expert is an expert in *French* linguistics:

The Objector claims that [the Applicant's expert] is a professor of French linguistics and language pedagogy and that he would therefore not be qualified to express an opinion on the meaning of English words such as webs and webs [sic].

While it is correct that [the Applicant's expert] teaches French linguistics, he has been building relevant and profound expertise in various domains of Applied Linguistics for many years. In this respect, he has performed in-depth analysis of various West-European languages, including English. At the same time, he has also built strong expertise in General Linguistics, which gave him a thorough understanding and comprehension of the mechanisms that form the basis of the functioning of the human language. . . .

In contrast, the consultant that was hired by the Objector and who wrote the "criticism" of [the Applicant's linguistics expert's] opinion, has only published very modestly and almost exclusively in conference proceedings, *i.e.*, with high acceptance rates and not systematically with double-blind peer review This, in combination with the fact that, ever since her doctoral thesis (carried out many years ago), she has been active in consultancy rather than in an academic

The Applicant refers to the Expert Determinations issued in string confusion objections involving the applied-for gTLD strings, <.cars>, <.tvs>, and <.hotels>, in which each of the three panels separately concluded that there was no likelihood of string confusion.²⁶

Discussion and Findings

The Panel issues this Expert Determination, under Paragraph 3.4.6 of Module 3.

Before turning to the merits, the Panel pauses to commend counsel for both parties for their zealous representation and comprehensive argument.

The Guidebook governs here. Paragraph 3.5.1 of Module 3 instructs that “[a] DRSP panel hearing a string confusion objection will consider whether the applied-for gTLD string is likely to result in string confusion”, and further guides:

[i] String confusion exists where a string so nearly resembles another that it is likely to deceive or cause confusion. [ii] 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.²⁷

The Objector bears the burden of proof.²⁸

environment, . . . probably explains why her opinion does not contain a single reference to scientific literature.

Applicant’s Surreply at 1.

²⁶ Applicant’s Surreply at 4. The Applicant submitted full copies of the three Expert Determinations. *Id.* Annexes 79 (*Charleston Road Registry Inc. v. Koko Castle, LLC*, ICDR Case No. 50 504 233 13 (Aug. 7, 2013) (<.cars>)), 80 (*Verisign Switzerland SA v. T V Sundram Iyengar & Sons Limited*, ICDR Case No. 50 504 257 13 (Aug. 8, 2013) (<.tvs>)), 81 (*HOTEL Top-Level-Domain S.a.r.l v. Booking.com B.V.*, ICDR Case No. 50 504 237 13 (Aug. 8, 2013) (<.hotels>)). The Panel will discuss herein these and other Expert Determinations of interest.

²⁷ Module 3 ¶ 3.5.1. *See* Attachment to Module 3 art. 2(e)(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.”).

²⁸ Module 3 ¶ 3.5; Attachment to Module 3 art. 20(c).

[i] *String confusion exists where a string so nearly resembles another that it is likely to deceive or cause confusion.*

Module 2 of the Guidebook, Evaluation Procedures, explains that the String Similarity Review by the String Similarity Panel during the Initial Evaluation entails a “preliminary comparison” of the applied-for gTLD with other strings, a “visual similarity check”.²⁹ But during the formal string confusion objection stage, the 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.”³⁰

The Panel concludes that the <.webs> string so nearly resembles <.web> -- visually, aurally and in meaning -- that it is likely to cause confusion. A contrary conclusion, the Panel is simply unable to reach. The Applicant’s <.webs> is visually identical to the Objector’s <.web>, except for the letter “s” at the end of “.web”. When read aloud, the words in the two strings also sound the same, again with only the phonetic “s” at the end of “web” distinguishing the two. Regarding the meaning of “web”, the Panel is not entirely unsympathetic to the Applicant’s argument that “web” commonly refers to the world wide web, and as such, it is not normally a word where the plural form would be used. Nevertheless, “web” is also used in the context of, for example, a “spider web”, and “webs” is the plural of “web”. Considering all of the indicia of similarity, the Panel determines that the resemblance between <.webs> and <.web> is likely to cause confusion.

The nature of the difference between the two strings is significant. In the Panel’s view, the addition of “s” to the end of “.web” resulting in another string would lead to confusion, whereas the addition of a different letter to the end of another three-letter noun may not. For example, there is a distinction between “web” and “webs”, on the one hand, and “tub” and “tuba”, on the other.

[ii] *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 Guidebook requires that in order for the string confusion objection to be sustained, the likelihood of confusion between the two gTLDs must be (a) probable,

²⁹ Module 2 ¶ 2.2.1.1.

³⁰ Module 2 ¶ 2.2.1.1.3. Paragraph 2.2.1.1 elaborates on the nature of the similarity review at the Initial Evaluation in relation to the review during the string confusion objection phase: “The visual similarity check that occurs during Initial Evaluation is intended to augment the objection and dispute resolution process (see Module 3, Dispute Resolution Procedures) that addresses all types of similarity.”

not merely possible (b) in the mind of the average, reasonable Internet user. The Guidebook does not define “average, reasonable Internet user”. It appears to be ICANN’s intention to allow individual panelists to determine the likely perceptions of such Internet user. Nor does the Guidebook elaborate on the distinction between probability and possibility of confusion, other than the text relied on by the Applicant (and all applicants in string confusion objections) that “[m]ere association, in the sense that the string brings another string to mind, is insufficient”.³¹

The Panel concludes that given the similarity of <.webs> and <.web> as discussed above, it is probable, and not merely possible, that confusion will arise in the mind of the average, reasonable Internet user. This is not a case of “mere association”. A more apt example of mere association between two strings would be the hypothetical gTLD <.twoweb>, which would likely “bring to mind” another hypothetical gTLD <.oneweb>. In contrast, the presence of <.webs> in the same net that also includes <.web>, and vice versa, requires Internet users actively to differentiate between the two.

In reaching its decision, the Panel has the benefit of reviewing the ten previously issued Expert Determinations (as of this date) stemming from string confusion objections involving precisely the same situation seen in this Objection, i.e., where the gTLD objected to is the plural form of the objector’s gTLD, indicated by the addition of the letter “s” to the end of the objector’s string.³² All of these determinations are publicly available on the ICDR Internet site.³³ The determinations resolved objections to the following seven applied-for gTLDs: <.cars> (three separate decisions³⁴), <.games>,³⁵ <.hotels>,³⁶ <.pets> (two separate

³¹ Module 3 ¶ 3.5.1.

³² Not included in this list are the decisions involving <.hoteles> and <.hoteis>, in which the party that applied for <.hotel> filed separate string confusion objections.

³³ International Centre for Dispute Resolution, *ICANN New gTLD Program: ICDR Dispute Resolution Process - String Confusion Objections*, at <http://images.go.adr.org/Web/AmericanArbitrationAssociation/%7Bdf3f46b6-4c35-4bd1-a428-7c70d7db53b%7D_ICANN_DRP_StringConfusion_Objections.pdf>.

³⁴ *Charleston Road Registry Inc. v. Koko Castle, LLC*, ICDR Case No. 50 504 233 13 (Aug. 7, 2013) (Panelist Paul E. Mason); *Charleston Road Registry Inc. v. DERCars, LLC*, ICDR Case No. 50 504 234 13 (Aug. 27, 2013) (Panelist John A.M. Judge); *Charleston Road Registry Inc. v. Uniregistry, Corp.*, ICDR Case No. 50 504 238 13 (Oct. 10, 2013) (Panelist Hon. Neil Anthony Brown QC).

³⁵ *Charleston Road Registry Inc. v. Foggy Beach, LLC*, ICDR Case No. 50 504 243 13 (Sep. 19, 2013) (Panelist Earl A. Cherniak, Q.C.).

decisions³⁷), <.sports>,³⁸ <.tours>,³⁹ and <.tvs>.⁴⁰ These decisions are not binding on the Panel, but are of interest, in that they may offer persuasive reasoning and analysis.

Decisions in accord

The Panel's determination herein finding similarity and probable confusion between the Applicant's <.webs> and the Objector's <.web> is consistent with the result in six of the reported "plural form" Expert Determinations, those involving: <.cars> (but just one of the three cases⁴¹), <.games>,⁴² <.pets> (both cases⁴³), <.sports>,⁴⁴ and <.tours>.⁴⁵ In each of these decisions, the panelist determined that the applicant's plural form string was confusingly similar, visually, aurally, and in meaning, to the objector's string in singular form, and that confusion was probable.

Contrary decisions

The Panel acknowledges that there are determinations involving the plural form of the objector's string, in which the panelist decided that the objector did not meet its burden of proving likelihood of string confusion, and thus dismissed the objection.

³⁶ *HOTEL Top-Level-Domain S.a.r.l v. Booking.com B.V.*, ICDR Case No. 50 504 237 13 (Aug. 8, 2013) (Panelist Bruce W. Belding).

³⁷ *Charleston Road Registry Inc. v. John Island, LLC*, ICDR Case No. 50 504 274 13 (Aug. 14, 2013) (Panelist Richard W. Page) [hereinafter *John Island, LLC*]; *Afilias Limited v. John Island, LLC*, ICDR Case No. 50 504 219 13 (Oct. 20, 2013) (Panelist Urs Laeuchli) [hereinafter *Afilias Limited*].

³⁸ *SportAccord v. Steel Edge LLC*, ICDR Case No. 50 504 210 13 (Aug. 20, 2013) (Panelist M. Scott Donahey).

³⁹ *Charleston Road Registry Inc. v. Sugar Station, LLC*, ICDR Case No. 50 504 275 13 (Aug. 16, 2013) (Panelist Robert M. Nau).

⁴⁰ *Verisign Switzerland SA v. T V Sundram Iyengar & Sons Limited*, ICDR Case No. 50 504 257 13 (Aug. 8, 2013) (Panelist Stephen S. Strick).

⁴¹ *DERCars, LLC*. As to the other two cases, see *infra* note 48.

⁴² *Foggy Beach, LLC*.

⁴³ *John Island, LLC; Afilias Limited*.

⁴⁴ *SportAccord*.

⁴⁵ *Sugar Station, LLC*.

These four cases involve (1) <.tvs>,⁴⁶ (2) <.hotels>,⁴⁷ and the other two decisions involving (3) and (4) <.cars>.⁴⁸ As indicated above, the Applicant relies on three of these determinations.⁴⁹ The Panel offers the following observations in regard to these decisions.

(1) *Verisign Switzerland SA v. T V Sundram Iyengar & Sons Limited*, ICDR Case No. 50 504 257 13 (Aug. 8, 2013) (<.tvs>).

In the determination involving the <.tvs> gTLD, the panelist relied on “the analysis of the thirteen factors . . . derived from [*Application of E.I. DuPont DeNemours & Co.* 50]”.⁵¹ In *DuPont DeNemours*, a U.S. court looked to the multiple factors to assess the likelihood of confusion between the applicant’s trademark “RALLY” for “a combination polishing, glazing and cleaning agent for use on automobiles”, and the previously registered “RALLY” for “an all-purpose detergent.”⁵² Initially, the Panel questions whether the factors to be considered when “testing for likelihood of confusion under Sec. 2(d)”⁵³ of the Lanham Act should be the test for determining

⁴⁶ *Verisign Switzerland SA*.

⁴⁷ *HOTEL Top-Level-Domain S.a.r.l.*

⁴⁸ *Koko Castle, LLC; Uniregistry, Corp.* To state it explicitly, there are three string confusion objection cases, all filed by Charleston Road Registry Inc. (which had applied for the <.car> gTLD), challenging the application of <.cars> by three separate parties. Panelists Paul E. Mason and The Honourable Neil Anthony Brown QC separately determined that the respective applicant’s <.cars> was not confusing with the objector’s <.car>, while Panelist John A.M. Judge reached the opposite conclusion, *DERCars, LLC*. Thus, conflicting determinations resulted in the objections to the very same gTLD. As to this circumstance, Panelist Brown QC observed:

[I]t is difficult for the Expert to decide how ICANN might deal with the potential conflicts . . . , 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

Uniregistry, Corp. at 7.

⁴⁹ See *supra* text accompanying note 26.

⁵⁰ 476 F.2d 1357 (C.C.P.A. 1973).

⁵¹ *Verisign Switzerland SA* at 5.

⁵² 476 F.2d at 1359.

⁵³ *Id.* at 1361. The thirteen factors are:

likelihood of confusion between two gTLD strings -- <.webs> and <.web>.⁵⁴ Moreover, assuming, but only *arguendo*, that the *DuPont DeNemours* factors are pertinent in assessing string confusion, some of the factors do not weigh in the Applicant's favor. In the <.tvs> determination, the panel noted as a matter of factual background that the applicant's "TVS Brand was created over 100 years ago, [and] is a well known brand, . . . with global revenues of US\$7 Billion in Financial Year 2012-13."⁵⁵ This, as well as other descriptions of the string objected to in *Verisign Switzerland SA*, is simply inapt in the present case.

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i. e. "impulse" vs. careful, sophisticated purchasing.
- (5) The fame of the prior mark (sales, advertising, length of use).
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
- (10) The market interface between applicant and the owner of a prior mark:
 - (a) a mere "consent" to register or use.
 - (b) agreement provisions designed to preclude confusion, i. e. limitations on continued use of the marks by each party.
 - (c) assignment of mark, application, registration and good will of the related business.
 - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
- (12) The extent of potential confusion, i. e., whether *de minimis* or substantial.
- (13) Any other established fact probative of the effect of use.

Id.

⁵⁴ Two panelists have commented on the applicability of trademark law decisions on string confusion objections: "Trademark law standards do not entirely fit here . . ., because the Objector's string <.CAR> is generic and hence ineligible for trademark protection", *Koko Castle, LLC* at 5 (Panelist Mason); "for purposes of this St[r]ing Confusion Objection, the decisions . . . of American trademark law involved different standards and will not be applied", *John Island, LLC* at 10 (Panelist Page).

⁵⁵ *Verisign Switzerland SA* at 4.

(2) *HOTEL Top-Level-Domain S.a.r.l v. Booking.com B.V.*, ICDR Case No. 50 504 237 13 (Aug. 8, 2013) (<.hotels>).

In the string confusion objection involving the <.hotels> gTLD, the panelist stated that “it [is] undisputed that the words ‘hotel’ and ‘hotels’ are similar, with only the addition of an ‘s’ differentiating them visually”.⁵⁶ He nevertheless concluded that the strings are “sufficiently visually and aurally different for string confusion purposes.”⁵⁷ The panelist explained: “I find persuasive [i] the degrees of similarity or dissimilarity between the strings by use of the String Similarity Assessment Tool . . ., [ii] that ICANN did not put the applications for .HOTEL and .HOTELS in the same contention set . . ., and [iii] the analysis and conclusions of the independent expert retained by Applicant.”⁵⁸

First, ICANN’s String Similarity Assessment Tool, while relevant in the Panel’s consideration, is not determinative in resolving a string confusion objection.⁵⁹ Second, regarding the relevance of ICANN not placing two applied-for strings in the same contention set, as one panelist in a previous string confusion objection noted, an applicant’s gTLD application is not entitled to “an evidentiary presumption of acceptability because it passed through the initial ICANN visual similarity tool tests.”⁶⁰ Rather, “the Objection process is an independent review process.”⁶¹ Third, this Panel has considered, and found not persuasive, the opinions of the Applicant’s linguistics expert urging dissimilarity between <.webs> and <.web>.

⁵⁶ *HOTEL Top-Level-Domain S.a.r.l* at 3.

⁵⁷ *Id.* at 4.

⁵⁸ *Id.*

⁵⁹ See *DERCars, LLC* at 29.

⁶⁰ *Koko Castle, LLC* at 5 (Panelist Mason).

⁶¹ *Id.* In this regard, Module 2 provides:

An application for a string that is found too similar to another applied-for gTLD string will be placed in a contention set.

An application that passes the 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. . . .

Module 2 ¶ 2.2.1.1.3.

As previously noted, in a string confusion objection against the <.cars> gTLD, Panelist John A.M. Judge determined that confusion was probable and sustained the objection.⁶² But in two other objections brought by the same objector against the very same <.cars> string, both panelists separately determined that there was *no* likelihood of confusion.

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

In the first of the two, Panelist Mason stated that regarding visual similarity, there was “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.”⁶³ But Panelist Judge, faced with the same 72% algorithmic score, determined that the score “supports the finding that the burden of proving likely confusion on a balance of probabilities has been met.”⁶⁴ Likewise, in two other string confusion objections that also involved a 72% score (for <.pets> and <.pet>), Panelists Richard W. Page and Urs Laeuchli separately characterized the score as “high”.⁶⁵ Panelists Judge, Page and Laeuchli all found likelihood of string confusion, and sustained the objection. The 72% figure is the same algorithmic score seen in the present Objection.

In *Koko Castle, LLC*, the panelist wrote, “There . . . 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.”⁶⁶ In this vein, the Applicant here argues that the Applicant’s <webs.com> domain name has co-existed with the Objector’s <web.com>. Yet the Panel questions whether this consideration, alone or in combination with others, is relevant in this determination.

Ultimately, Panelist Mason concluded that “[the] 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

⁶² *DERCars, LLC*. See *supra* note 48.

⁶³ *Koko Castle, LLC* at 5 (emphasis added).

⁶⁴ *DERCars, LLC* at 29.

⁶⁵ *John Island, LLC* at 10 (Panelist Page); *Afilias Limited* at 4 (Panelist Laeuchli).

⁶⁶ *Koko Castle, LLC* at 5-6.

association between them.”⁶⁷ Regardless of whether ICANN intended the burden on string confusion objectors to be heavy or otherwise, this Panel reaches a different conclusion regarding probable confusion for the strings <.webs> and <.web>.

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

In the second determination involving <.cars> in which the string confusion objection was dismissed, the panelist ultimately concluded that “the string <.cars> is not confusingly similar to the string <.car>.”⁶⁸ Given that the panelist’s task was “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”,⁶⁹ he wrote, “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.”⁷⁰ Specifically,

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.⁷¹

The panelist also noted that Internet users of today are

very well aware that, on the internet, small differences in spelling and meaning are significant and that they mean different things 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 misle[]d or deceived. There will therefore, in the opinion of the Expert, be no

⁶⁷ *Id.* at 6 (emphasis added).

⁶⁸ *Uniregistry, Corp.* at 10 (¶¶ 14, 17) (in original).

⁶⁹ *Id.* at 9 (¶ 9).

⁷⁰ *Id.* at 10 (¶ 15).

⁷¹ *Id.* at 11 (¶ 19(a)).

probability of user confusion if the two strings are delegated into the root zone.⁷²

The Panel is unable to concur with the above descriptions, and perceptions, of Internet users generally. As an aside, it is a fair question to ask, if the above quoted text amounts to the rule, whether, as a practical matter, any string confusion objection could prevail under the Guidebook. In all events, the Panel determines that the Applicant's <.webs> string so nearly resembles the Objector's <.web> in a number of respects that it is probable that confusion will arise in the human mind of the average, reasonable Internet user.

The Panel has considered the Applicant's many arguments, including those emphasizing: the absence of previous litigation between the parties, the Objector's alleged motives in filing this Objection, the absence of objections by other applicants for the <.web> gTLD, and the alleged anti-competitive effect. Under the governing Guidebook and the applicable principles, these arguments carry little weight.⁷³

Per the Guidebook, "The Objector bears the burden of proving that its Objection should be sustained in accordance with the applicable standards."⁷⁴ The Objector has met this burden.

Determination

The Objector has prevailed, and the String Confusion Objection is sustained.

January 24, 2014



Ilhyung Lee

Sole Expert Panelist

⁷² *Id.* at 10 (¶ 15). The panelist acknowledged that "[i]t is of course possible that some internet user will be confused by the two strings", but added that such possibility "will, at most, exist only in very few cases". *Id.* at 11 (¶ 19(a)). "[I]t is not enough to conclude that someone, somewhere will probably be confused by the string." *Id.* at 9 (¶ 9).

⁷³ See *HOTEL Top-Level-Domain S.a.r.l* at 4 ("The parties' arguments and contentions regarding alleged business motives and/or attempts to limit competition, alleged detriments that could arise if [the challenged gTLD] is approved, . . . are deemed irrelevant to the task of the expert panel.").

⁷⁴ Attachment to Module 3 art. 20(c).

Annex 25.

Reconsideration Request Form

Version of 11 April 2013

ICANN's Board Governance Committee is responsible for receiving requests for reconsideration from any person or entity that has been materially affected by any ICANN staff action or inaction if such affected person or entity believes the action contradicts established ICANN policies, or by actions or inactions of the Board that such affected person or entity believes has been taken without consideration of material information. Note: This is a brief summary of the relevant Bylaws provisions. For more information about ICANN's reconsideration process, please visit <http://www.icann.org/en/general/bylaws.htm#IV> and <http://www.icann.org/en/committees/board-governance/>.

This form is provided to assist a requester in submitting a Reconsideration Request, and identifies all required information needed for a complete Reconsideration Request. This template includes terms and conditions that shall be signed prior to submission of the Reconsideration Request.

Requesters may submit all facts necessary to demonstrate why the action/inaction should be reconsidered. However, argument shall be limited to 25 pages, double-spaced and in 12 point font.

For all fields in this template calling for a narrative discussion, the text field will wrap and will not be limited.

Please submit completed form to reconsideration@icann.org.

1. Requester Information

Name: Vistaprint Limited

Address: Contact Information Redacted

Email:

Phone Number (optional):

C/o:

Name: Flip Petillion, Crowell & Moring LLP

Address: Contact Information Redacted

Email:

Phone Number (optional): Contact information Redacted

(Note: ICANN will post the Requester's name on the Reconsideration Request page at <http://www.icann.org/en/committees/board-governance/requests-for->

[reconsideration-en.htm](#). Requestors address, email and phone number will be removed from the posting.)

2. Request for Reconsideration of (check one only):

Board action/inaction

Staff action/inaction

3. Description of specific action you are seeking to have reconsidered.

(Provide as much detail as available, such as date of Board meeting, reference to Board resolution, etc. You may provide documents. All documentation provided will be made part of the public record.)

Vistaprint Limited (hereinafter "Requester") seeks reconsideration of various actions and inactions of ICANN's staff related to the Expert Determination of the New gTLD String Confusion Objection regarding the strings .WEB (Application ID 1-1009-97005) and .WEBS (Application ID 1-1033-22687 and 1-1033-73917) by the International Centre for Dispute Resolution in the consolidated Cases No. 50 504 T 00221 13 and 50 504 T 00246 13, dated January 24, 2014 (hereinafter, the 'Decision'). The Decision is attached as **Annex 1**. This decision fails to follow ICANN process for determining string confusion in many aspects.

4. Date of action/inaction:

(Note: If Board action, this is usually the first date that the Board posted its resolution and rationale for the resolution or for inaction, the date the Board considered an item at a meeting.)

January 24, 2014

5. On what date did you become aware of the action or that action would not be taken?

(Provide the date you learned of the action/that action would not be taken. If more than fifteen days has passed from when the action was taken or not taken to when you learned of the action or inaction, please provide discussion of the gap of time.)

January 27, 2014. The Decision was rendered on January 24, 2014, but was communicated by the ICDR on January 27, 2014.

6. Describe how you believe you are materially affected by the action or inaction:

The Requester is the sole applicant for the .WEBS gTLD. The Requester applied for both a standard application and a community-based application.

The finding in the Decision that .WEBS and .WEB are confusingly similar will impact the Requester because ICANN has made it clear in the Applicant Guidebook that it *“will not approve applications for proposed gTLD strings that are identical or that would result in user confusion, called contending strings”* (Applicant Guidebook, Module 4-2). ICANN refers to a group of applications for contending strings as a contention set. The Decision places .WEBS in a non-exact match contention set with .WEB against the objector and 6 other applicants for .WEB who did not file a string confusion objection. The Requester could invoke the community priority of its community-based .WEBS application to resolve the contention, created by the Decision. If this community priority is accepted by the community priority evaluation panel, the other applied-for strings that are in contention with the Applicant’s community-based .WEBS application will be eliminated. If the community priority is not accepted, the .WEBS application will remain in contention with the .WEB application as a result of the Decision and the contention set can only be resolved through negotiation or auction between the Requester and the 7 applicants for .WEB.

While the Requester is confident that it fulfills the criteria for community priority, the Decision still impacts the Requester as it will need to submit a deposit amount for the community priority evaluation. In addition, the Decision deprives the Requester of the choice to operate either a standard gTLD or a community-based gTLD, which comes

with additional obligations in the daily operation of the gTLD.

7. Describe how others may be adversely affected by the action or inaction, if you believe that this is a concern.

Various third parties are adversely affected by the Decision:

Other applicants for .WEB will be put in a contention set with .WEBS, meaning that Internet users will not be able to benefit from services under a .WEB if the .WEBS gTLD is delegated, or *vice versa* in the unlikely event that the community priority of the Requester's application is not accepted and Requester does not succeed in the auction.

As made clear by ICANN regarding the standard for objections, “[t]here is a presumption generally in favor of granting new gTLDs to applicants who can satisfy the requirements for obtaining a gTLD – and, hence, a corresponding burden upon a party that objects to the gTLD to show why that gTLD should not be granted to the applicant” (New gTLD Draft Applicant Guidebook Version 3 – Public Comments Summary and Analysis, p. 67, available at <http://archive.icann.org/en/topics/new-gtlds/summary-analysis-agv3-15feb10-en.pdf>). The string similarity process was not intended to “hobble competition or reserve a broad set of string for a first mover” [sic]. As a result, the similarity test is a high bar, not to limit legitimate competition. (See New gTLD Draft Applicant Guidebook-Version 2: Analysis of Public Comment, p. 149, available at <http://archive.icann.org/en/topics/new-gtlds/agv2-analysis-public-comments-31may09-en.pdf>).

In the case at hand, accepting the Decision would unjustifiably (*infra*) limit choice for Internet users and limit legitimate competition. This is not in the interest of the Internet user.

Internet users are adversely affected as there may be less competition at TLD level.

8. Detail of Board or Staff Action – Required Information

Staff Action: If your request is in regards to a staff action or inaction, please provide a detailed explanation of the facts as you understand they were provided to staff prior to the action/inaction presented to the staff and the reasons why the staff's action or inaction was inconsistent with established ICANN policy(ies). Please identify the policy(ies) with which the action/inaction was inconsistent. The policies that are eligible to serve as the basis for a Request for Reconsideration are those that are approved by the ICANN Board (after input from the community) that impact the community in some way. When reviewing staff action, the outcomes of prior Requests for Reconsideration challenging the same or substantially similar action/inaction as inconsistent with established ICANN policy(ies) shall be of precedential value.

Board action: If your request is in regards to a Board action or inaction, please provide a detailed explanation of the material information not considered by the Board. If that information was not presented to the Board, provide the reasons why you did not submit the material information to the Board before it acted or failed to act. "Material information" means facts that are material to the decision.

If your request is in regards to a Board action or inaction that you believe is based upon inaccurate, false, or misleading materials presented to the Board and those materials formed the basis for the Board action or inaction being challenged, provide a detailed explanation as to whether an opportunity existed to correct the material considered by the Board. If there was an opportunity to do so, provide the reasons that you did not provide submit corrections to the Board before it acted or failed to act.⁴

Reconsideration requests are not meant for those who believe that the Board made the wrong decision when considering the information available. There has to be identification of material information that was in existence of the time of the decision and that was not considered by the Board in order to state a reconsideration request. Similarly, new information – information that was not yet in existence at the time of the Board decision – is also not a proper ground for reconsideration. Please keep this guidance in mind when submitting requests.

Provide the Required Detailed Explanation here:

Although the String Similarity Review was performed by a third party, ICANN has determined that the Reconsideration process can properly be invoked for challenges of the third party's decisions where it can be stated that either the vendor failed to follow its process in reaching the decision, or that ICANN staff failed to follow its process in accepting that decision (Recommendation of the Board Governance

Committee (BGC) Reconsideration Request 13-5, August 1, 2013, page 4).

The new gTLD program included 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 the so-called New gTLD Dispute Resolution Procedure (Article 1(b), New gTLD Dispute Resolution Procedure (hereinafter, the 'Procedure'). Pursuant to Article 1(c) of the Procedure, Dispute resolution proceedings shall be administered by a Dispute Resolution Service Provider (DRSP) in accordance with the Procedure and the applicable DRSP Rules. In accordance with Article 20(a) the Panel appointed by the DRSP had to apply the standards that have been defined by ICANN.

In the present case, both the DRSP and the Panel have derogated from the Procedure and the Panel has failed to apply the standard defined by ICANN in reaching his Decision (*infra*). As a result, the policy for dealing with disputes has not been followed. Accepting the Decision as an expert determination and advice would thus be contrary to ICANN's policy, as ICANN would accept an expert determination that was not made in accordance with ICANN's policy.

Requester reminds that ICANN shall not 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 (Article II(3), ICANN Bylaws). Requester also reminds that ICANN should always apply its policies neutrally and objectively, with integrity and fairness. The Decision is unfair, not neutral and accepting it creates disparate treatment without justified cause. Also for this reason, ICANN should not accept the Decision.

9. What are you asking ICANN to do now?

(Describe the specific steps you are asking ICANN to take. For example, should the action be reversed, cancelled or modified? If modified, how should it be modified?)

The Requester asks ICANN to reject the advice set forth in the Decision, and instruct a panel to make an expert determination that applies the standards defined by ICANN. Should ICANN consider that there is a need to derogate from the Procedure in order to comply with the process defined in the Applicant Guidebook, ICANN's Bylaws and Articles of Incorporation, the Requester asks to make the necessary derogations allowing for a non-discriminatory application of ICANN's standards, policies and procedures.

10. Please state specifically the grounds under which you have the standing and the right to assert this Request for Reconsideration, and the grounds or justifications that support your request.

(Include in this discussion how the action or inaction complained of has resulted in material harm and adverse impact. To demonstrate material harm and adverse impact, the requester must be able to demonstrate well-known requirements: there must be a loss or injury suffered (financial or non-financial) that is a directly and causally connected to the Board or staff action or inaction that is the basis of the Request for Reconsideration. The requestor must be able to set out the loss or injury and the direct nature of that harm in specific and particular details. The relief requested from the BGC must be capable of reversing the harm alleged by the requester. Injury or harm caused by third parties as a result of acting in line with the Board's decision is not a sufficient ground for reconsideration. Similarly, injury or harm that is only of a sufficient magnitude because it was exacerbated by the actions of a third party is also not a sufficient ground for reconsideration.)

The Panel was not appointed in accordance with the Procedure, which led to unjustified disparate treatment

- The Appointment Procedure, developed by ICANN

Pursuant to Article 13 (a) of the Procedure, the DRSP shall select and appoint the Panel of Expert(s) within thirty (30) days after receiving the Response. All Experts acting under the Procedure shall be impartial and independent of the parties. The

applicable DRSP Rules stipulate the manner by which each Expert shall “*confirm and **maintain their impartiality and independence***” (Article 13(c) of the Procedure, emphasis added).

The procedures for challenging and replacing an Expert are stipulated in the applicable DRSP Rules (Article 13(d) of the Procedure).

The applicable DRSP Rules of the ICDR stipulate that a party “*may challenge any Expert whenever circumstances exist that give rise to justifiable doubts as to the Expert’s impartiality or independence. Upon receipt of such a challenge, the DRSP shall notify the other parties of the challenge. [...] Upon review of the challenge the DRSP in its sole discretion shall make the decision on the challenge and advise the parties of its decision. The challenged Expert may also withdraw from office upon notice of the challenge*” (Article 2 ICDR Supplementary Procedures for String Confusion Objections).

Pursuant to Article 21 of the Procedure, the DRSP and the Panel shall make reasonable efforts to ensure that the Expert Determination is rendered within 45 days of the constitution of the Panel. In specific circumstances such as consolidated cases and in consultation with the DRSP, if significant additional documentation is requested by the Panel, a brief extension may be allowed.

- The appointment of a Panel by the ICDR in the case at hand is contrary to the Procedure, developed by ICANN

The belated appointment of the first expert, followed by unjustified extensions

In the case at hand, the Response was received by the ICDR on May 23, 2013 (**Annex 2**). In accordance with Article 13(a) of the Procedure, the Panel had to be appointed by June 22, 2013. On May 31, 2013, the ICDR confirmed its commitment to appoint the expert by that date (**Annex 3**). It nevertheless took the ICDR until June 28, 2013 to appoint Steve Y. Koh, Esq. as Panel (**Annex 4**).

Mr. Koh wrongly accepted additional submissions of the parties (*infra*) and agreed with the ICDR on a substantial extension of the deadline to issue the Expert Determination. On September 18, 2013 (*i.e.* 82 days after the appointment of Mr. Koh as Panel) and although the additional submissions that were authorized by Mr. Koh cannot be considered significant additional documentation – the additional submission that the Requester was authorized to make had to be limited to 5 pages (**Annex 5**) – the ICDR informed the parties that the expert determination was going to be issued on or about October 4, 2013 (*i.e.* 98 days after the appointment of Mr. Koh as Panel) (**Annex 6**).

This can in no way be considered a brief extension of the 45-day deadline to render the determination, as it more than doubles the timeframe to render the decision. The consolidation of the cases cannot serve as an excuse for the disproportionate extension, as the cases are between the same parties and the arguments that were raised are identical.

The failure of the first Panel to maintain its impartiality and independence

On October 1, 2013, the ICDR informed the parties that “*due to a **new conflict**, the Expert, Steve Koh [...] [was not going to] be able to serve [any] longer*” (**Annex 7**, emphasis added).

However, once appointed, each expert had to maintain his impartiality and independence in accordance with Article 13(c) of the Procedure. The fact that a new conflict arose shows that Mr. Koh failed to maintain his impartiality and independence and thus violated the Procedure.

The unjustified acceptance of the challenge of the second Panel

On October 14, 2013, the ICDR informed the parties that it had appointed Bruce W. Belding, Esq. as the new Panel (**Annex 8**). On October 24, 2013, the Objector challenged the appointment of this Panel (**Annex 9**).

However, there were no grounds to challenge this Panel, as there were no reasons giving rise to justifiable doubts that the Panel was going to be impartial and independent (**Annex 10**). The Requester therefore requested to deny the challenge by the Objector on October 30, 2013 (**Annex 10**). Despite the fact that there was no objective reason to challenge the Panel and despite the fact that the ICDR was inescapably aware of the grounds invoked by the Objector when proceeding with the appointment of a new Panel¹, the ICDR accepted the Objector's challenge on November 4, 2013 (**Annex 11**). On November 5, 2013, the Requester requested the ICDR to reconsider its decision to sustain the challenge to the continued service of Mr. Belding (**Annex 12**). On November 8, 2013, the ICDR denied this request and indicated that it was going to appoint a new Panel shortly (**Annex 13**).

The unfounded acceptance of the challenge of the Panel and the denial of the request to reconsider this decision are further violations of the Procedure by the

¹ The Objector invoked the fact that Mr. Belding had served as a Panel in an unrelated string confusion objection with the ICDR. As the ICDR administered this unrelated case, it was necessarily aware of this fact when appointing Mr. Belding as a Panel in the case between the Objector and the Requester.

ICDR.

The failure by the third Panel, which should not have been appointed, to render a timely determination

On November 20, 2013, the ICDR appointed Prof. Ilhyung Lee as Panel (**Annex 14**). In accordance with Article 21 of the Procedure, his determination should have been rendered by January 4, 2014. However, it took this Panel until January 24, 2014 to render the Decision.

The overall failure of the ICDR to achieve the goal of resolving disputes rapidly

The case history above shows that, from the date that the Panel had to be ultimately appointed, it took no less than 216 (!) days for a Panel to render a decision that should have been rendered in maximum 45 days.

It is patently clear from the above that the ICDR did not achieve the goal of resolving disputes rapidly and that it has not taken reasonable efforts to ensure that the decision was rendered within 45 days of the constitution of the Panel:

- it first appointed a Panel 6 days after the date on which the Panel had to be appointed in accordance with Article 13(a) of the Procedure;
- 82 days after this Panel's appointment, and without a valid reason for an extension, the ICDR informed the parties that it had authorized the Panel to render his decision 98 days following the constitution of the Panel;
- it then allowed the Panel to have a new conflict, despite the express requirement that all appointed Experts had to maintain their impartiality and

independence;

- it further on accepted an unjustified challenge of a newly appointed Panel;
- and
- it finally allowed a third Panel to release a determination 65 days after its appointment, without any reason for this delay and without informing the parties of it.

- The discrimination resulting from the flawed appointment of a Panel by the ICDR

The many delays encountered in the appointment procedure and in the handling of the proceedings by the appointed Panels resulted in unjustified disparate treatment between the Requester and other applicants. Indeed, until the final resolution of the string confusion objection, the Requester is not allowed to proceed with the delegation of the .WEBS gTLD. In view of the many violations of ICANN's policy and process by the ICDR and the Panel(s) (*supra* and *infra*), the Requester is still awaiting a final resolution in this case. A timely and correct determination by a timely appointed Panel would have allowed the Requester to proceed in the application phase and to start operations under its .WEBS gTLD sooner. However, while other new gTLDs were already active, the Requester was still blocked by the protracted string confusion objection proceedings. This disparate treatment is without justification. In the unlikely event that the Decision is not reversed and the community priority of the Requester's .WEBS application is not accepted, the Requester may even find itself in an auction against applicants who have been able to make profits through the launch of new gTLDs.

In addition, the delays in the proceedings also allowed for the final Panel to examine

expert determinations in other cases. This would not have been possible if the Expert Determination in the instant case was timely. Although each string confusion objection must be decided on its own merits, the third appointed Panel in the instant case went to great lengths to discuss previous expert determinations instead of focusing on the merits of the case. Previous expert determinations clearly confused the Panel who mingled the cases involving the 'car' and 'cars' strings with a case involving the 'hotel' and 'hotels' strings (**Annex 1**, p. 16). Again, this would not have been possible if the Expert Determination was timely. As a result, it is clear that the untimely decision has led to disparate treatment without justification.

The unjustified and unreasoned acceptance of additional submissions

On 19 July 2013 (*i.e.* 58 days after the receipt of the Requester's response), the Objector submitted an unsolicited supplementary filing to the first Panel. The filing was said to contain a reply brief and 25 annexes of additional evidence. The original objection only contained 4 annexes. On 31 July 2013, the Requester objected to the acceptance of this unsolicited supplementary filing (**Annex 15**). In accordance with Article 17 of the Procedure, only the Panel may decide whether the parties shall submit any written statements in addition to the Objection and the Response. Pursuant to Article 18 of the Procedure, additional evidence may only be submitted in exceptional cases. Although there were no exceptional circumstances and although the necessity for the Requester created unreasonable additional costs for the Requester, the first Panel disregarded the procedural ramifications of the admission of the Objector's unsolicited filing and additional evidence in violation of the express goal of the Procedure "of resolving disputes rapidly and at reasonable

costs". On August 8, 2013 the first Panel accepted the Objector's supplemental filing containing 25 annexes. The first Panel provided no justification. Instead, the first Panel authorized the Requester to submit a surreply, not to exceed 5 pages within 29 days (**Annex 5**). This time and page limit are in sheer contrast with the 58 day period taken by the Objector to submit a 6-page reply and no less than 25 additional annexes.

The Requester considers that the equality of arms was not guaranteed by this decision by the first Panel.

As mentioned above, on October 1, 2013, the ICDR informed the Requester that the first Panel was removed "*due to a **new** conflict*" (**Annex 7**, emphasis added). The Requester is wondering whether this conflict arose before or after the unjustified acceptance of the additional submissions. In any event, it is the Panel that may require a party to provide additional evidence (Article 18 of the Procedure). When a Panel needs to be replaced, decisions by a previous Panel cease to exist. This is particularly true when the independence and impartiality of that previous Panel was not warranted.

The third appointed Panel did not request any party to provide additional evidence. However, it follows from the Decision that this Panel accepted the unsolicited additional submission by the Objector and the Requester's surreply that was requested by the first Panel. Instead of making an independent assessment whether or not to require additional submissions and evidence, the third Panel simply accepted the additional submissions, relying on the decision by the first Panel, who already had proven not to be independent and impartial.

As a result, no independent and impartial decision was made on the acceptance of

additional submissions, and hence, the Decision was not based on an independent and impartial assessment. Also for this reason, ICANN's policy and process was not followed.

In addition, and as will be demonstrated below, the unjustified acceptance of additional submissions and evidence has implications in relation to the burden of proof.

The incorrect application of the burden of proof

The third Panel correctly stated that the Objector bears the burden of proof. However, this Panel failed to correctly apply the burden of proof rule.

First, the Panel incorrectly accepted the Objector's additional submission, based on an assessment that was not independent and impartial. It is unclear whether the Objector would have met the burden of proof according to the Panel without the acceptance of this additional submission.

Second, the Panel does not give an analysis showing that the Objector had met the burden of proof. The Panel simply makes the following statement at the beginning of its discussion and findings:

The Panel concludes that the <.webs> string so nearly resembles <.web> -- visually, aurally and in meaning -- that it is likely to cause confusion. A contrary conclusion, the Panel is simply unable to reach. The Applicant's <.webs> is visually identical to (Annex 1, p. 10)

It is unclear how the Panel came to this conclusion, let alone that this conclusion was based on the Objector's evidence and arguments. The Panel merely makes this statement and then starts discussing the Requester's arguments. It should have

been the other way around. The Panel should have looked into the Objector's evidence and arguments and then have analyzed them in view of the Requester's evidence and counterarguments.

In the instant case, the Panel rather puts forward his personal view without discussing the Objector's submissions and concludes that .WEB and .WEBS are confusingly similar. This raises strong concerns about the independence and impartiality of the Panel, who simply accepts the Objector's assertion without any analysis.

The incorrect application of the standard, defined by ICANN

- The standard, defined by ICANN

According to ICANN's policy, panels appointed by the DRSP have the obligation to apply the standards that have been defined by ICANN. For a string confusion objection, the standard to be applied by the panel as defined by ICANN is defined in Section 3.5.1 of the Applicant Guidebook:

"A DRSP panel hearing a string confusion case 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 the 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."

ICANN has made it clear that this is a high standard, not intended to hobble competition or reserve a broad set of string for a first mover:

"[T]he standard indicates that confusion must be probable, not merely possible, in order for this sort of harm to arise. Consumers also benefit from competition. For new gTLDs, the similarity test is a high bar, as indicated by the wording of the standard. A TLD string that is a dictionary word will not automatically exclude all synonyms of that word (and most TLD strings today are not dictionary words and have no real synonyms).

Therefore, while the objection and dispute resolution process is intended to address all types of similarity, the process is not intended to hobble competition or reserve a broad set of string for a first mover." (New gTLD Draft Applicant Guidebook-Version 2: Analysis of Public Comment, p. 149, available at <http://archive.icann.org/en/topics/new-gtlds/agv2-analysis-public-comments-31may09-en.pdf>)

This high standard was explicitly confirmed by the NGPC in the rationale to NGPC Resolution 2013.06.25.NG07 stating that 'similar' in the Applicant Guidebook 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. During the policy development and implementation design phases of the New gTLD Program, aural and conceptual string similarities were considered. These types of similarity were discussed at length, yet ultimately not agreed to be used as a basis for the analysis of the string similarity panels' consideration because on balance, this could have unanticipated results in limiting the expansion of the DNS as well as the reach and utility of the Internet." (Rationale for NGPC

Resolution 2013.06.25.NG07)

In addition, the NGPC reflected on the positive and negative impacts of existing string similarity and observed that there are thousands of examples of similar strings that exist within the DNS at the second level that are not operated by the same registrant. This similarity does not automatically lead to confusion:

“The NGPC reflected on existing string similarity in the DNS and considered the positive and negative impacts. The NGPC observed that numerous examples of similar strings, including singulars and plurals exist within the DNS at the second level. Many of these are not registered to or operated by the same registrant. There are thousands of examples [...]” (Rationale for NGPC Resolution 2013.06.25.NG07).

It is clear from the above that the confusing similarity standard is a very high standard and that the average, reasonable Internet user is used to the existence of many similar strings in the DNS. It is in accordance with this high standard that panels had to rule on confusing similarity between two strings.

- The application of a different standard in the decision

A different standard than the one defined by ICANN was applied in the Decision putting .WEB and .WEBS in a contention set. The third Panel considered that ICANN did not define the ‘average, reasonable Internet user’ and that it could therefore make its individual determination of the likely perceptions of such Internet user:

not merely possible (b) in the mind of the average, reasonable Internet user. The Guidebook does not define “average, reasonable Internet user”. It appears to be ICANN’s intention to allow individual panelists to determine the likely perceptions of such Internet user. Nor does the Guidebook elaborate on the distinction between probability and possibility of confusion, other than the text relied on by the Applicant (and all applicants in string confusion objections) that “[m]ere association, in the sense that the string brings another string to mind, is insufficient”.³¹

(Annex 1, p. 11)

Nothing could be further from the truth. It never was ICANN’s intention to allow individual panelists to determine the likely perceptions of the average, reasonable Internet user. In a string confusion objection, it is the task of the Objector to prove that the average, reasonable Internet user was likely to be confused and for the Panel to analyze this evidence.

By its own admission, and as argued by the Requester, the Objector considered that the average, reasonable Internet user that may be interested in the Objector’s services is sophisticated enough to understand the difference between the much more similar WEB.COM and WEBCOM. The Objector made this statement when it entered into a coexistence agreement with a third party, Verio, regarding the use of Verio’s WEBCOM sign and the Objector’s WEB.COM trademark:

A. The Objector considers much more similar signs not confusingly similar

Web.com has narrowed the scope of its enforceable trademark rights by entering into a Supplemental Consent to Registration with Verio. The Objector and Verio have agreed that there was no likely confusion between WEB.COM on the one hand, and WEBCOM on the other hand (**Attachment 59**).

When entering into the Supplemental Consent, the Objector was of the opinion that "customers understand that you have to use the correct Internet address because a different Internet address will resolve to a different website" and that there is no likelihood of confusion because "[t]he consuming public is sophisticated enough" (**Attachment 59**). The Objector also indicated that the parties have enjoyed long coexistence without any known instances of actual confusion.

Therefore, it is impossible to understand how the Objector can agree to coexistence between WEB.COM and WEBCOM and yet object to a coexistence between WEB and WEBS. Indeed:

- The letter 'S' is much more distinctive than the symbol '.';
- The dot is placed in the middle of the WEB.COM sign, making it much more likely to be overlooked than the last letter of a word, which (together with the first letter) has been shown to be more significant than the rest of the letters (*infra*);
- The Applicant and the Objector have also enjoyed long coexistence without any known instances of actual trademark relevant confusion.

(Annex 2)

The Panel failed to respond to this argument (and many other arguments including Requester's arguments on the absence of (any evidence of) actual confusion and about the differences in the mission and purpose of the .WEBS and .WEB gTLDs clearly differentiating both gTLD strings)). In relation to the determination of the average, reasonable Internet user, the Panel simply stated that it was unable to concur with descriptions and perceptions of Internet users that were accepted by other experts and panels:

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

In the second determination involving <.cars> in which the string confusion objection was dismissed, the panelist ultimately concluded that “the string <.cars> is not confusingly similar to the string <.car>.”⁶⁸ Given that the panelist’s task was “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”,⁶⁹ he wrote, “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.”⁷⁰ Specifically,

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.⁷¹

The panelist also noted that Internet users of today are

very well aware that, on the internet, small differences in spelling and meaning are significant and that they mean different things 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 misle[]d 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.⁷²

The Panel is unable to concur with the above descriptions, and perceptions, of Internet users generally. As an aside, it is a fair question to ask, if the above quoted text amounts to the rule, whether, as a practical matter, any string confusion objection could prevail under the Guidebook. In all events, the Panel determines that the Applicant’s <.webs> string so nearly resembles the Objector’s <.web> in a number of respects that it is probable that confusion will arise in the human mind of the average, reasonable Internet user.

(Annex 1, pp. 17-18)

Although the Panel stated that it was unable to concur with the description of the average, reasonable Internet user by other panels, the Panel failed to provide a

description of the average, reasonable Internet user. The Panel did not enter into a discussion on the burden of proof in this respect. It merely stated that it reached a different conclusion than other panels, but provides no basis for this conclusion:

In *Koko Castle, LLC*, the panelist wrote, "There . . . 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."⁶⁶ In this vein, the Applicant here argues that the Applicant's <webs.com> domain name has co-existed with the Objector's <web.com>. Yet the Panel questions whether this consideration, alone or in combination with others, is relevant in this determination.

Ultimately, Panelist Mason concluded that "[the] 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."⁶⁷ Regardless of whether ICANN intended the burden on string confusion objectors to be heavy or otherwise, this Panel reaches a different conclusion regarding probable confusion for the strings <.webs> and <.web>.

(Annex 1, pp. 16-17)

In addition, it is stunning to read that the Panel questions whether the co-existence between the Requester's <webs.com> and the Objector's <web.com> for many years without (any evidence of) actual confusion is relevant for his determination. When explaining the string confusion standard in the Rationale for NGPC Resolution 2013.06.25.NG07, ICANN has clearly made reference to the existence of similar strings in the DNS today at the second level. The absence of actual confusion between the existing <webs.com> and <web.com>, as well as between the more similar <web.com> and <webcom> is the closest real-life evidence that the average, reasonable Internet user is not confused between .WEBS and .WEB.

The fact that the Panel questioned the relevance of this evidence *c.q.* did not even

consider this evidence, is further evidence of the fact that the Panel failed to apply the burden of proof and the standards imposed by ICANN.

The cursory nature of the Decision and the arbitrary and selective discussion of the parties' arguments by the Panel show the lack of either the Panel's independence and impartiality or the Panel's appropriate qualifications.

The former is contrary to Article 13 of the Procedure; the latter is contrary to the Applicant Guidebook, Module 3-16, which requires that a panel (ruling on a string confusion or other objection) must consist of "*appropriately qualified experts appointed to each proceeding by the designated DRSP*".

Conclusion

ICANN's established policy was violated in many respects as 1) the DRSP failed to make a timely appointment of an appropriately qualified, independent and impartial expert, 2) the DRSP and the Panel failed to render a timely expert determination, and 3) the Panel failed to make a correct application of the burden of proof rule and the policies and standards developed by ICANN.

11. Are you bringing this Reconsideration Request on behalf of multiple persons or entities? (Check one)

Yes

No

11a. If yes, is the causal connection between the circumstances of the Reconsideration Request and the harm the same for all of the complaining parties? Explain.

Do you have any documents you want to provide to ICANN?

If you do, please attach those documents to the email forwarding this request. Note that all documents provided, including this Request, will be publicly posted at <http://www.icann.org/en/committees/board-governance/requests-for-reconsideration-en.htm>.

1. Expert Determination in the matter before the ICDR with case numbers 50 504 T 00221 13 and 50 504 T 00246 13
2. Response to the Objection, as filed on May 22, 2013
3. Communication by the ICDR of May 31, 2013
4. Communication by the ICDR of June 28, 2013
5. Communication by Mr. Koh of August 8, 2013
6. Communication by the ICDR of September 18, 2013
7. Communication by the ICDR of October 1, 2013
8. Communication by the ICDR of October 14, 2013
9. Communication by the Objector of October 24, 2013
10. Communication by the Requester of October 30, 2013
11. Communication of the ICDR of November 4, 2013
12. Communication by the Requester of November 5, 2013
13. Communication by the ICDR of On November 8, 2013
14. Communication by the ICDR of November 20, 2013
15. Communication by the Requester of On 31 July 2013

Terms and Conditions for Submission of Reconsideration Requests

The Board Governance Committee has the ability to consolidate the consideration of Reconsideration Requests if the issues stated within are sufficiently similar.

The Board Governance Committee may dismiss Reconsideration Requests that are querulous or vexatious.

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.

The BGC may take a decision on reconsideration of requests relating to staff action/inaction without reference to the full ICANN Board. Whether recommendations will issue to the ICANN Board is within the discretion of the BGC.

The ICANN Board of Director's decision on the BGC's reconsideration recommendation is final and not subject to a reconsideration request.

Flip Petition

Signature

February 6, 2014

Date

Annex 26.

DETERMINATION OF THE BOARD GOVERNANCE COMMITTEE (BGC)

RECONSIDERATION REQUEST 14-5

27 FEBRUARY 2014

The Requester (Vistaprint Limited) seeks reconsideration of the Expert Determination upholding Web.com Group, Inc.'s string confusion objections to the Requester's applications for .WEBS.

I. Brief Summary.

The Requester submitted two applications for .WEBS – one as a standard application and one as a community application. The Web.com Group, Inc. applied for .WEB. Web.com Group, Inc. filed two string confusion objections to the Requester's applications, and both Objections were upheld. The Requester claims that the ICDR failed to follow applicable ICDR procedures governing the appointment and conduct of experts. Specifically, the Requester claims that the ICDR violated applicable ICDR procedures concerning: (i) the timely appointment of an expert panel; (ii) the acceptance of additional written submissions ; (iii) the timely issuance of an expert determination; (iv) an expert's duty to remain impartial and independent; and (v) challenges to experts. The Requester also claims that the actions of the Panel were inconsistent with ICANN policies, which influenced the Panel's decision to uphold the Objections. Specifically, the Requester claims that the Panel violated applicable ICANN policies concerning: (i) the Objector's burden of proof; and (ii) the standards governing the evaluation of a string confusion objection.

The Requester asks ICANN to reject the Expert Determination and instruct a new panel to issue an expert determination that applies the standards defined by ICANN. In the event ICANN concludes that the ICDR and the "new" Panel adhered to and correctly applied ICDR

and ICANN processes and policies concerning string confusion objections, the Requester asks that ICANN derogate from its procedure because accepting the Expert Determination would purportedly result in discriminatory application of ICANN's standards, policies and procedures.

With respect to each claim asserted by the Requester concerning the ICDR's alleged violations of applicable ICDR procedures concerning experts, there is no evidence that the ICDR deviated from the standards set forth in the Applicant Guidebook, the New gTLD Dispute Resolution Procedure, or the ICDR's Supplementary Procedures for String Confusion Objections (Rules). The Requester has likewise failed to demonstrate that the Panel applied the wrong standard in contravention of established policy or procedure. Therefore, the BGC¹ concludes that Request 14-5 be denied.

II. Facts.

A. Background Facts.

Vistaprint Limited (the "Requester") applied for .WEBS.²

Web.com Group, Inc. (the "Objector") applied for .WEB. Six other applicants also applied for .WEB.

On 13 March 2013, the Objector filed two string confusion objections (the "Objection")³ with the ICDR⁴ to the Requester's applications. The Objector asserted that "the applied-for gTLD string is confusingly similar to an existing TLD or to another applied-for gTLD string in the same round of applications." (Applicant Guidebook ("Guidebook"), § 3.2.1; Procedure, Art.

¹ Board Governance Committee.

² Six other applicants also applied for .WEB.

³ Because the Objections were consolidated and the Expert Panel issued just one Determination, this Recommendation may reference "Objection" and "Determination" in the singular or the plural; any singular references shall apply to both objections.

⁴ International Centre for Dispute Resolution.

2(e).) The Objector was the only .WEB applicant to file a string confusion objection to the .WEBS applications.

On 6 May 2013, the ICDR consolidated Case No. 50 504 T 00221 13 and Case No. 50 504 T 00246 13. (Request, Section 3, Pg. 2.)

On 23 May 2013, the Requester responded to the Objections.

On 28 June 2013, the ICC appointed Mr. Steve Y. Koh, Esq. as the expert to consider the Objections (the “First Expert”).

On 19 July 2013, the Objector submitted a supplemental written statement replying to the Requester’s response.

On 31 July 2013, the Requester objected to the Objector’s supplemental filing, to which the Objector responded on 5 August 2013.

On 8 August 2013, the Panel acknowledged receipt of the Objector’s supplemental written statement and the parties’ respective statements dated 31 July 2013 and 5 August 2013, and granted the Requester leave to submit a sur-reply no later than 6 September 2013.

The Requester filed its sur-reply on 29 August 2013.

On 1 October 2013, the ICDR removed the First Expert due to a new conflict that arose.

On 14 October 2013, the ICDR appointed Bruce W. Belding, Esq. as the new expert (the “Second Expert”).

On 24 October 2013, the Objector challenged the appointment of the Second Expert, to which the Requester responded on 30 October 2013.

On 4 November 2013, the ICDR removed the Second Expert in response to the Objector’s challenge.

On 20 November 2013, the ICDR appointed Professor Ilhyung Lee to serve as the expert (“Expert” or “Panel”) to consider the Objector’s Objection (the “Third Expert”). No party objected to this Expert.

On 24 January 2014, the Panel issued an Expert Determination in favor of the Objector and deemed the Objector the prevailing party. (Determination, Pg. 18.)

On 27 January 2014, the ICDR notified the parties of the Expert Determination.

On 6 February 2014, the Requester filed Request 14-5.

B. The Requester’s Claims.

The Requester claims that the ICDR failed to adhere to the following:

- Article 13(a) of the New gTLD Dispute Resolution Procedure (“Procedure”), in particular the standards for the timely appointment of an Expert Panel;
- Article 17 of the Procedure, in particular the standards governing the submission of additional written statements;
- Article 21 of the Procedure, in particular the standards for the timely issuance of an Expert Determination;
- Article 13(c) of the Procedure, in particular the standards governing an expert’s duty to maintain his or her impartiality and independence; and
- Article 2 of the ICDR’s Supplementary Procedures for String Confusion Objections (Rules), in particular the standards governing challenges to experts.

The Requester claims that the Panel’s decision to uphold the Objection violates the following:

- Section 3.5 of the Guidebook and Article 20(c) of the Procedure, which together place the burden on the objector to prove “that its Objection should be sustained in accordance with applicable standards”; and
- Section 3.5.1 of the Guidebook, in particular the standards governing the evaluation of a string confusion objection.

(Request, Section 10, Pgs. 7-23.) Specifically, the Requester makes the following claims:

1. The ICDR first appointed an expert six days after the date on which an expert had to be appointed in accordance with Article 13(a) of the Procedure;
2. The Expert Panel improperly accepted and considered unsolicited supplementary filings in violation of Article 17 of the Procedure;
3. The ICDR informed the parties that the First Expert would render his determination on 4 October 2013, which the Requester claims would have been untimely under Article 21 of the Procedure;
4. The removal of the First Expert “due to a new conflict” demonstrates that the First Expert failed to maintain his impartiality and independence in accordance with Article 13(c) of the Procedure;
5. The ICDR improperly accepted the Objector’s challenge to the Second Expert and improperly denied the Requester’s request to reconsider its decision;
6. The Expert Panel that ultimately considered the Objection failed to render a determination in a timely manner under Article 21 of the Procedure;
7. The Expert improperly concluded that the Objector had met the burden of proof without sufficiently analyzing or articulating the basis for this conclusion; and
8. The Expert Panel incorrectly applied the standards governing string confusion objections by failing to define the “average, reasonable Internet user.”

(*Id.*)

C. Relief Requested.

The Requester asks ICANN to reject the Expert Determination and instruct a new panel to issue an expert determination that applies the standards defined by ICANN. In the event ICANN concludes that the ICDR and the Panel adhered to and correctly applied ICDR and ICANN processes and policies concerning string confusion objections, the Requester asks that ICANN derogate from its procedure because accepting the Expert Determination would purportedly result in discriminatory application of ICANN’s standards, policies and procedures.

(Request, Section 9, Pg. 7.)

III. Issues.

In view of the claims set forth in Request 14-5, the issues for reconsideration are:

- A. Whether the ICDR violated its processes or procedures governing the appointment and conduct of the experts, including whether:
1. The ICDR's appointment of the First Expert was untimely;
 2. The Expert Panel improperly accepted and considered unsolicited supplementary filings;
 3. The ICDR violated established procedure when it informed the parties that an expert determination would be issued on 4 October 2013;
 4. The First Expert failed to maintain his impartiality and independence;
 5. The ICDR improperly accepted the Objector's challenge to the Second Expert; and
 6. The Expert Determination was untimely;

and

- B. Whether the Expert Panel applied the wrong standards in contravention of established policies or processes, including whether:
1. The Expert Panel improperly concluded that the Objector had met its burden of proof without sufficient analysis; and
 2. Whether the Expert Panel improperly failed to define the "average, reasonable Internet user" for purposes of evaluating the string confusion objection.

IV. The Relevant Standards for Evaluating Reconsideration Requests and String Confusion Objections.

ICANN's Bylaws provide for reconsideration of a Board or staff action or inaction in accordance with specified criteria.⁵ (Bylaws, Art. IV, § 2.) Dismissal of a request for

⁵ 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

reconsideration of staff action or inaction is appropriate if the BGC concludes, or if the Board or the NGPC⁶ agrees to the extent that the BGC deems that further consideration is necessary, that the requesting party failed to satisfy the reconsideration criteria set forth in the Bylaws.⁷

In the context of the New gTLD Program, the reconsideration process does not call for the BGC to perform a substantive review of expert determinations. Accordingly, the BGC is not to evaluate the Panel's substantive conclusion that the Requester's applications for .WEBS are confusingly similar to the Requester's application for .WEB. Rather, the BGC's review is limited to whether the Panel violated any established policy or process in reaching that Determination.

The standards for evaluating string confusion objections are set forth in Section 3.5.1 of the Applicant Guidebook (the "Guidebook"). Pursuant to Section 3.5.1 of the Guidebook, the expert panel hearing a string confusion objection will "consider whether the applied-for gTLD string is likely to result in string confusion." The Guidebook provides:

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.

(continued...)

- (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.

⁶ New gTLD Program Committee.

⁷ ICANN has previously determined that the reconsideration process can properly be invoked for challenges to expert determinations rendered by panels formed by third party dispute resolution service providers, such as the ICDR, where it can be stated that the Panel failed to follow the established policies or processes in reaching the expert determination, or that staff failed to follow its policies or processes in accepting that determination. *See* <http://www.icann.org/en/groups/board/governance/reconsideration/recommendation-booking-01aug13-en.doc>, BGC Recommendation on Reconsideration Request 13-5.

(Guidebook, § 3.5.1.).

Also relevant to the Requester's claims are the ICDR's Supplementary Procedures for String Confusion Objections ("Rules"). The Rules relevant to the Requester's claims are discussed below.

V. Analysis and Rationale.

A. The Requester Failed To Demonstrate That The ICDR Violated Its Processes Or Procedures Governing The Appointment And Conduct Of Experts.

The Requester claims that the ICDR failed to follow applicable ICDR procedures concerning: (i) the timely appointment of an expert panel; (ii) the acceptance of additional written submissions; (iii) the timely issuance of an expert determination; (iv) an expert's duty to remain impartial and independent; and (v) challenges to experts. As discussed in detail below, the Requester provided no support for its contention that the ICDR incorrectly applied any ICDR process or procedure.

1. The ICDR's Purported Failure To Appoint The First Expert In A Timely Manner Does Not Support Reconsideration.

The Requester claims that the ICDR's appointment of the First Expert was untimely. Specifically, the Requester claims that its response was submitted on May 23, 2013, such that the expert "had to be appointed by June 22, 2013." (Request, Section 10, Pg. 9.) Because it "took the ICDR until June 28, 2013 to appoint Steve Y. Koh, Esq.," the Requester contends that the expert's appointment was in violation of Article 13(a) of the Procedure, which provides: "The DRSP shall select and appoint the Panel of Expert(s) within thirty (30) days after receiving the Response." (Procedure, Art. 13(a).)

First, the Requester has failed to provide any evidence that it contemporaneously challenged the timeliness of the ICDR's appointment of the First Expert. Had the Requester

submitted a challenge or other objection to the ICDR when the First Expert was appointed, the ICDR could have addressed that challenge in an appropriate fashion. A Reconsideration Request is not the appropriate mechanism to raise the issue for the first time.

Furthermore, and more importantly, the Requester has not shown, because it cannot show, that it was “materially” and “adversely” affected by the purported brief delay in appointing the First Expert. Absent evidence that the Requester has been materially and adversely affected by the brief delay, reconsideration is not appropriate. (Bylaws, Art. IV, §2.2.)

2. The First Expert Did Not Incorrectly Accept Additional Submissions.

On 19 July 2013, the Objector submitted a supplementary filing to the First Expert. The Requester claims that the First Expert’s acceptance of this supplementary filing violated Article 17 of the Procedure. The Requester’s claim must be rejected.

As the Requester points out, Article 17 of the Procedure provides that:

The Panel may decide whether the parties shall submit any written statements in addition to the Objection and the Response, and it shall fix time limits for such submissions.

(Procedure, Art. 17(a) (emphasis added).) It is thus entirely within the expert’s discretion to determine whether to accept additional written statements. Here, in exercising that discretion, the First Expert deemed it appropriate to accept the Objector’s supplemental filing. It is not the BGC’s role to second-guess any expert panel in this regard. Moreover, the First Expert allowed the Requester to respond to the Objector’s supplemental filing, which the Requester did on 29 August 2013. (Request, Section 10, Pg. 13-14; Determination, Pg. 2.)⁸

⁸ Citing Article 18 of the Procedure, the Requester claims that “there were no exceptional circumstances” warranting the acceptance of the Objector’s supplementary filings and that the expert’s acceptance of the Objector’s filing “created unreasonable additional costs for the Requester.” (Request, Section 10, Pg. 13.) Article 18 of the Procedure does not apply here. Article 18 states that “[i]n exceptional cases, the Panel

The Requester also contends that the Expert who ultimately issued the Determination in the instant proceeding (the Third Expert) should have made “an independent assessment whether or not to require additional submissions and evidence.” (Request, Section 10, Pg. 14.) In support, the Requester states only that “[w]hen a Panel needs to be replaced, decisions by a previous Panel cease to exist.” (*Id.*) There is no support for the Requester’s summary conclusion. Indeed, the Requester fails to cite any provision in the Guidebook, the Procedure, the Rules or elsewhere that somehow voids a decision of a previous panel concerning the submission of additional materials.

3. The ICDR’s Purported Representation That An Expert Determination Would Be Issued By 4 October 2013 Does Not Support Reconsideration.

The Requester claims that “[o]n September 18, 2013 (*i.e.* 82 days after the appointment of Mr. Koh as Panel) ... the ICDR informed the parties that the expert determination was going to be issued on or about October 4, 2013 (*i.e.* 98 days after the appointment of Mr. Koh as Panel).” (Request, Section 10, Pg. 9.) The Requester contends that this would have resulted in the issuance of an untimely Expert Determination because Article 21(a) of the Procedure provides that “[t]he DSRP and the Panel shall make reasonable efforts to ensure that the Expert Determination is rendered within forty-five (45) days of the constitution of the Panel.” The Requester’s claims do not support reconsideration.

First, the Requester presents only a hypothetical alleged violation of one provision of the Procedure. On 1 October 2013, *before* the expert determination was purportedly to be issued,

(continued...)

may require a party to provide additional evidence.” (Procedure, Art. 18.) Here, no party was “required” to provide any additional evidence. The parties submitted supplementary filings on their own volition and it was within the expert’s discretion to accept the additional materials. (*See* Procedure, Art. 17(a).)

the ICDR removed the First Expert. The action (or inaction) that Requester seeks to challenge (i.e. the failure to timely issue an Expert Determination) never occurred. The BGC therefore cannot evaluate whether the First Expert rendered an untimely determination in violation the Procedure because he was removed before an Expert Determination could be issued. As such, no established policy or process was violated.

Second, the 45-day timeline set out in the Procedure cited by the Requester applies to the Expert's submission of the Expert Determination "in draft form to the DRSP's scrutiny as to form before it is signed." (Procedure, Art. 21(a)-(b).) Moreover, pursuant to Article 21(a) of the Procedure, the ICDR and the Expert are to exercise "*reasonable efforts*" to issue a determination within forty-five (45) days of the constitution of the Panel. (Procedure, Art. 21(a) (emphasis added).) The Requester has not presented any evidence that the DRSP or the Expert failed to make such "reasonable efforts." On the contrary, as the Requester acknowledges, the First Expert was considering consolidated cases, and "additional submissions that were authorized by Mr. Koh" were submitted, including the Objector's reply brief with twenty-five (25) annexes of additional evidence and the Requester's sur-reply. (Request, Section 10, Pg. 9.) The Requester has not presented any evidence demonstrating that the First Expert did anything other than consider these supplementary materials and make reasonable efforts to issue its determination in a timely fashion.

4. The Removal Of The First Expert Does Not Support Reconsideration.

On 1 October 2013, the ICDR informed the parties that "due to a new conflict, the Expert, Steve Koh ... will no longer be able to serve and has been removed." (Request, Section 10, Pg. 9.) The Requester concludes that this "shows that Mr. Koh failed to maintain his impartiality and independence and thus violated [Article 13(c) of] the Procedure. (Request, Section 10, Pg. 10.) The Requester's claim is unsupported.

Article 13(c) of the Procedure states that “[a]ll Experts acting under this Procedure shall be impartial and independent of the parties.” (Procedure, Art. 13(c).) Section 3.4.4. of the Guidebook provides that the ICDR will “follow its adopted procedures for requiring such independence, including procedures for challenging and replacing an expert for lack of independence.” (Guidebook, Section 3.4.4.)

The Requester provides no evidence demonstrating that the First Expert failed to follow the applicable ICDR procedures for independence and impartiality. The only evidence the Requester cites in support of its argument that Mr. Koh failed to maintain his independence during the proceeding is the ICDR’s statement that it had decided to remove Mr. Koh “due to a new conflict.” (Request, Section 10, Pgs. 9-10.) The ICDR did not provide any further information as to the nature of the conflict. Conflicts can take many forms, such as scheduling or personal conflicts unrelated to the proceedings. There is no evidence that the conflict that inflicted Mr. Koh was related to the instant proceedings or otherwise impacted Mr. Koh’s ability to remain impartial and independent.

Furthermore, the Requester neither claims to have been, nor presents any evidence of being, materially and adversely affected by Mr. Koh’s removal. Indeed, had the Requester successfully challenged Mr. Koh for lack of independence at the time he was removed, the remedy under the applicable ICDR procedures would have been the removal of Mr. Koh, which was the result here.

5. The ICDR’s Acceptance Of The Objector’s Challenge To The Second Expert Does Not Support Reconsideration.

On 14 October 2013, the ICDR informed the parties that it had appointed Bruce W. Belding, Esq. as the new expert (Second Expert) to consider the Objection. On 24 October 2013, the Objector timely challenged the appointment of Mr. Belding. On 4 November 2013, the

ICDR accepted the Objector's challenge and indicated its intention to appoint a new (or Third) Expert. On 5 November 2013, the Requester asked the ICDR to reconsider its decision to accept the challenge to the continued service of the Second Expert. On 8 November 2013, the ICDR denied the Requester's request. The Requester claims that the ICDR's acceptance of the Objector's challenge to the Second Expert and the denial of the Requester's request to reconsider this decision constitute a violation of the Procedure. The Requester's claims do not support reconsideration.

The Requester does not state which provision of the Procedure was purportedly violated. The procedure governing challenges to experts is set forth in Article 2 of the ICDR's Supplementary Procedures for String Confusion Objections (Rules). Article 2, Section 3 states as follows:

Upon review of the challenge the DRSP *in its sole discretion* shall make the decision on the challenge and advise the parties of its decision.

(Rules, Art. 2(3).)

While the Requester may disagree with the ICDR's decision to accept the Objector's challenge to the Second Expert, that decision was in the "sole discretion" of the ICDR. (*Id.*) It is not the BGC's role to second guess the ICDR's discretion in this regard.

6. The Panel's Expert Determination Was Not Untimely.

On 20 November 2013, the ICDR appointed Professor Ilhyung Lee as the Third Expert. The Requester claims that, pursuant to Article 21 of the Procedure, the Expert Determination therefore "should have been rendered by January 4, 2014," which was forty-five (45) days after the Panel was constituted. (Request, Section 10, Pg. 11; *see also* Procedure, Art. 21.) Because "it took this Panel until January 24, 2014 to render the Decision," the Requester contends that the Expert Determination was untimely. The Requester's claims do not support reconsideration.

Article 21 provides in pertinent part as follows:

The DRSP and the Panel shall make reasonable efforts to ensure that the Expert Determination is rendered within forty-five (45) days of the constitution of the Panel. In specific circumstances such as consolidated cases and in consultation with the DRSP, if significant additional documentation is requested by the Panel, a brief extension may be allowed.

The Panel shall submit its Expert Determination in draft form to the DRSP's scrutiny as to form before it is signed, unless such scrutiny is specifically excluded by the applicable DRSP rules.... The signed Expert Declaration shall be communicated to the DRSP, which in turn will communicate that Expert Determination to the Parties and ICANN.

(Procedure, Art. 21(a)-(b).)

Thus, according to the Procedure, the Expert must exercise reasonable efforts to ensure that it submits the Expert Determination “in draft form to the DRSP’s scrutiny as to form before it is signed” within forty-five (45) days of the Panel being constituted. (*Id.*) There is no evidence that the Expert failed to comply with this Procedure. When the ICDR communicated to the parties and to ICANN the signed Expert Determination on 27 January 2014, this was done in accordance with Article 21(b) of the Procedure. (*See* Procedure, Art. 21(b) (“The signed Expert Determination shall be communicated to the DRSP, which in turn will communicate that Expert Determination to the Parties and ICANN.”)). At bottom, because the Requester presented no evidence that the Expert failed to submit its Determination in draft form to the DRSP’s scrutiny as to form before it was signed within the forty-five (45) day timeframe, the Requester’s claims fail.

B. The Requester Failed To Demonstrate That The Panel Applied The Wrong Standards In Contravention Of Established Policy or Process.

The Requester contends that the Panel failed to correctly apply the Procedure and failed to follow the Guidebook’s substantive objection standards for evaluating whether the applied-for

gTLD string is likely to result in string confusion. As discussed in detail below, there is no support for the Requester's contention that the Panel incorrectly applied any ICANN standard in contravention of established policy or process.

1. The Panel Did Not Incorrectly Apply The Burden Of Proof Requirement.

The Requester claims that the Third Expert contravened ICANN process by “fail[ing] to correctly apply the burden of proof rule.” (Request, Section 10, Pg. 15.) In support, the Requester contends that “the Panel does not give an analysis showing that the Objector had met the burden of proof” and that “[i]t is unclear how the Panel came to [the] conclusion [that the .WEBS string would result in string confusion].” (*Id.*)

The relevant standard for evaluating a String Confusion Objection is set out in Section 3.5.1 of the 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.

(Guidebook, § 3.5.1.) As the Third Expert correctly notes, “during the formal string confusion objection stage, the 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.” (Determination, Pg. 10.)

Contrary to the Requester's contention, the Third Expert extensively detailed the support for its conclusion that the .WEBS string so nearly resembles .WEB – visually, aurally and in

meaning – that it is likely to cause confusion. Specifically, the Expert based its conclusion on the following:

- “The Applicant’s <webs> is visually identical to the Objector’s <web>, except for the letter ‘s’ at the end of ‘.web’”;
- “When read aloud, the words in the two strings also sound the same, again with only the phonetic ‘s’ at the end of ‘web’ distinguishing the two”;
- “Regarding the meaning of ‘web’, the Panel is not entirely unsympathetic to the Applicant’s argument that ‘web’ commonly refers to the world wide web, and as such, it is not normally a word where the plural form would be used. Nevertheless, ‘web’ is also used in the context of, for example, a ‘spider web’, and ‘webs’ is the plural of ‘web’.”

(Determination, Pg. 10.) The Expert considered all of the foregoing “indicia of similarity” and “determine[d] that the resemblance between <.webs> and <.web> is likely to cause confusion.”

(*Id.*) There is no support for the Requester’s claim that “the Panel does not given an analysis showing that the Objector had met the burden of proof.” (Request, Section 10, Pg. 15.) To the contrary, the Expert carefully considered the issues relevant to determining the existence of string confusion. Reconsideration is not warranted on the grounds posited by the Requester.⁹

2. The Panel Did Not Incorrectly Apply The Standards Governing String Confusion Objections.

The Requester claims that the Third Expert violated ICANN processes by incorrectly applying the standards governing string confusion objections. (Request, Section 10, Pgs. 18-23.)

⁹ The Requester also claims that “[i]t is unclear whether the Objector would have met the burden of proof according to the Panel without the acceptance of [the] additional submission.” (Request, Section 10, Pg. 15.) As set forth above, the acceptance of additional written submissions by both parties did not contravene ICANN process or policy. The acceptance of the supplementary filings therefore does not impact the BGC’s conclusion concerning the application of the burden of proof.

Specifically, the Requester contends that the Expert “failed to provide a description of the average, reasonable Internet user.” (Request, Section 10, Pgs. 21-22.) In support, the Requester relies on the following Expert statement:

The Guidebook does not define “average, reasonable Internet user”. It appears to be ICANN’s intention to allow individual panelists to determine the likely perceptions of such Internet user.

(Request, Section 10, Pgs. 18-19.) The Requester contends that “[n]othing could be further from the truth. It was never ICANN’s intention to allow individual panelists to determine the likely perceptions of the average, reasonable Internet user.” (Request, Section 10, Pg. 19.)

The standards governing string confusion objections are set forth in Section 3.5.1 of the Guidebook:

For the 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.

(Guidebook, § 3.5.1.) The Requester does not cite, because it cannot cite, any provision in the Guidebook or otherwise that requires the Expert to “provide a description of the average, reasonable Internet user” in the Expert Determination. (Request, Section 10, Pgs. 21-22.) Absent an articulation of what process the Requester claims was violated in this regard, reconsideration is not appropriate.

Moreover, as the Requester recognizes, the Third Expert considered and rejected the descriptions and perceptions of Internet users as articulated by other panels. (Determination, Pgs. 17-18; Request, Section 10, Pgs. 21-22.) The Requester has not identified any provision in the Guidebook or otherwise that this Determination purportedly contravenes. The Requester’s disagreement as to whether the standards should have resulted in a finding in favor of Requester’s application does not mean that the panel violated any policy or process in reaching the decision.

The Requester also claims that the Panel “failed to apply the burden of proof and the standards imposed by ICANN” because the Expert “questions whether the co-existence between the Requester’s <webs.com> and the Objector’s <web.com> for many years without (any evidence of) actual confusion is relevant to his determination.” (Request, Section 10, Pgs. 22-23.)

As set forth in Section 3.5.1 of the Guidebook:

A DRSP panel hearing a string confusion case objection will consider whether *the applied-for gTLD string* is likely to result in string confusion.

(Guidebook, § 3.5.1 (emphasis added).) The relevant consideration for the Expert is therefore whether the applied-for gTLD string is likely to result in string confusion. The issue is not, as the Requester urges, whether there will be confusion between second level domain names.

(Request, Section 10, Pgs. 22-23.) The Requester does not cite any provision of the Guidebook, the Procedure, or the Rules that have been contravened in this regard.

At bottom, it appears that the Requester simply disagrees with the Expert Determination and it is not the role of the BGC to evaluate the Expert’s substantive determination.¹⁰

VI. Decision

Based on the foregoing, the BGC concludes that the Requester has not stated proper grounds for reconsideration, and therefore denies Vistaprint Limited’s Reconsideration Request.

As there is no indication that the ICDR or the Expert violated any policy or process in reaching the Determination, this Request should not proceed. If the Requester believes that it has

¹⁰ The Requester concludes with the following claim: “The cursory nature of the Decision and the arbitrary and selective discussion of the parties’ arguments by the Panel show the lack of either the Panel’s independence and impartiality or the Panel’s appropriate qualifications.” (Request, Section 10, Pg. 23.) The Requester’s assertion is not accompanied by any discussion or further explanation for how ICANN processes were purportedly violated. The Requester’s summary conclusions are without merit and insufficient to warrant reconsideration. Furthermore, the Requester’s claim that the Determination was “cursory” and only contained “selective discussion of the parties’ arguments” is unsupported. The Determination was eighteen pages long and contained more than six pages of discussion of the parties’ arguments and evidence.

somehow been treated unfairly in the process, the Requester is free to ask the Ombudsman to review this matter.

In accordance with Article IV, Section 2.15 of the Bylaws, the BGC's determination on Request 14-5 shall be final and does not require Board (or NGPC) consideration. The Bylaws provide that the BGC is authorized to make a final determination for all Reconsideration Requests brought regarding staff action or inaction and that the BGC's determination on such matters is final. (Bylaws, Art. IV, § 2.15.) As discussed above, Request 14-5 seeks reconsideration of a staff action or inaction. After consideration of this Request, the BGC concludes that this determination is final and that no further consideration by the Board is warranted.

Annex 27.

Nelissen, Mariet

From: Petillion, Flip
Sent: lundi 17 mars 2014 15:41
To: Independent Review
Subject: CEP Vistaprint Limited
Attachments: 3286937_14 03 17 Letter to ICANN re CEP-c.PDF

Dear Sirs,

Please see the attached letter.

Yours sincerely,

Flip Petillion

Flip Petillion

Partner

Direct: **Contact Information Redacted**

Crowell & Moring LLP | www.crowell.com

Contact Information Redacted

KBO/BCE 0543.459.326

[Firm Bio](#) - [LinkedIn](#)

Our ref. : fpe/mne/109171.0000004
Your ref. :

Flip Petillion
Attorney-at-law
Contact nformation Redacted

17 March 2013

To the attention of:

Mr. Steve Crocker
Chair, ICANN Board;

Mr. Bruce Tonkin
Chair, Board Governance Committee;

Mr. Cherine Chalaby
Chair, New gTLD Program Committee; and

Mr. Fadi Chehade,
President and CEO, ICANN

12025 Waterfront Drive, Suite 300
Los Angeles, CA 90094-2536
USA

By regular mail, fax +1 310 823 8649 and by e-mail: independentreview@icann.org

Re: Cooperative engagement process

Dear Sirs,

I write you on behalf of Vistaprint Limited (Vistaprint) having its seat at ^{Contact Informat on Redacted}
^{Contact Information Redacted} Reference is made to the meeting of the
Board Governance Committee of 27 February 2014 of which the meeting minutes have been
published on 13 March 2014. In this meeting, the Board Governance Committee made a
determination rejecting the Vistaprint's Reconsideration Request 14-5.

Vistaprint is of the opinion that the Board Governance Committee's rejection of
Reconsideration Request 14-2 is in violation of various provisions of ICANN's Bylaws and
Articles of Incorporation. In particular, Vistaprint considers this is in violation of Articles I,
II(3), III and IV of the ICANN Bylaws as well as Article 4 of ICANN's Articles of
Incorporation. In addition, Vistaprint considers that ICANN has acted in violation of Articles
3, 7 and 9 of ICANN's Affirmation of Commitment.

In view of the above, Vistaprint has given me the instruction to file a request for a cooperative engagement process on their behalf. Vistaprint is committed to cooperate with ICANN in good faith in finding a solution to the issue and has instructed me to act as Vistaprint's point of contact for the resolution of the issue.

The present letter serves as written notice to ICANN invoking the cooperative engagement process. ICANN is requested to confirm the suspension of the deadline for the Vistaprint to file a request for Independent Review for the duration of the cooperative engagement process, meaning that Vistaprint shall have 26 days to file a request for Independent Review, following notice by ICANN that the cooperative engagement process has ended.

I will send my complete contact details to you in a separate email, under the condition that you keep this information confidential.

Yours sincerely,



Flip Petillion
Crowell & Moring LLP
Contact Information Redacted

Annex 28.



Resources

▶ [About ICANN](#)

▶ [Board](#)

▶ [Accountability & Transparency](#)

▶ [Governance](#)

▶ [Groups](#)

▶ [Contractual Compliance](#)

▶ [Registrars](#)

▶ [Registries](#)

▶ [ccTLDs](#)

▶ [Internationalized Domain Names](#)

▶ [TLD Acceptance](#)

▶ [Policy](#)

▶ [Public Comment](#)

▶ [Contact](#)

▶ [Help](#)

Board Governance Committee (BGC) Meeting Minutes

27 Feb 2014

BGC Attendees: Chris Disspain, Olga Madruga-Forti, [Ray Plizak](#), Mike Silber, and Bruce Tonkin – Chair

Other Board Member Attendees: Steve Crocker

Executive and Staff Attendees: Megan Bishop (Board Support Coordinator), Michelle Bright (Board Support Manager), John Jeffrey (General Counsel and Secretary), Elizabeth Le (Senior Counsel), and Amy Stathos (Deputy General Counsel)

Apologies: Cherine Chalaby and [Ram Mohan](#)

The following is a summary of discussion, actions taken, and actions identified:

1. [Minutes](#) – The BGC approved the minutes from the meeting on 5 February 2014.
2. [Reconsideration Request 14-3](#) – Ram Mohan abstained from participation of this matter noting conflicts. Staff briefed the BGC regarding Corn Lake, LLC's Request seeking reconsideration of the Expert Determination upholding the Independent Objector's community objection to Corn Lake's application for .CHARITY. Corn Lake claims that the Expert Panel failed to adhere to and apply ICANN processes and policies concerning the requirements for identifying a clearly delineated community and for showing the likelihood of material detriment as set forth in Sections 3.5 and 3.5.4 of the Applicant Guidebook. After discussion and consideration of the Request, the BGC concluded that the Requester has not stated proper grounds for reconsideration because there is no evidence that the Panel violated any policy or process in reaching the Panel's determination. The BGC determined that Corn Lake failed to demonstrate that the Panel applied the wrong standard in evaluating the Independent Objector's Objection. The Bylaws authorize the BGC to make a final determination on Reconsideration Requests brought regarding staff action or inaction; the BGC still has the discretion, but is not required, to recommend the matter to the Board for consideration. Accordingly, the BGC concluded that its determination on Request 14-3 is final; no consideration by the NGPC is warranted.
3. [Reconsideration Request 14-5](#) - Ram Mohan abstained from participation of this matter noting conflicts. Staff briefed the BGC regarding Vistaprint Limited's ("Vistaprint") Request seeking reconsideration of the Expert Determination upholding Web.com Group, Inc.'s string confusion objections to the Requester's applications for .WEBS. Vistaprint claims that the ICDR failed to follow applicable ICDR procedures governing the appointment and conduct of experts by violating applicable ICDR procedures concerning: (i) the timely appointment of an expert panel; (ii) the acceptance of additional written submissions; (iii) the timely issuance of an expert determination; (iv) an expert's duty to remain impartial and independent; and (v) challenges to experts. Vistaprint also claims that the actions of the Expert Panel violated applicable [ICANN](#) policies concerning: (i) the Objector's burden of proof; and (ii) the standards governing the evaluation of a string confusion objection. After discussion and consideration of the Request, the BGC concluded that with respect to Requester's claims concerning the ICDR's alleged violations of applicable ICDR procedures concerning experts, there is no evidence that the ICDR deviated from the standards set forth in the Applicant Guidebook, the New gTLD Dispute Resolution Procedure, or the ICDR's Supplementary Procedures for String Confusion Objections (Rules). The BGC further determined that the Requester failed to demonstrate that the Panel applied the wrong standard in contravention of established policy or procedure. The Bylaws authorize the BGC to make a final determination on Reconsideration Requests brought regarding staff action

or inaction; the BGC still has the discretion, but is not required, to recommend the matter to the Board for consideration. Accordingly, the BGC concluded that its determination on Request 14-5 is final; no consideration by the NGPC is warranted.

4. AOB

- [Practice and Guideline on Invitations to Events and Receiving Gifts by Board Members](#) – The BGC discussed the proposed practice and guidelines on invitations to events and gifts. The BGC members discussed various considerations that should be factored into the proposed guidelines. The BGC agreed to consider the proposed guidelines at its meeting in Singapore.
 - [Action](#) – Staff to draft proposed guidelines for further consideration by the BGC.
- [Compensation for Board Liaisons](#) – Staff briefed the BGC on various issues surrounding the potential for providing compensation to Board Liaisons. The BGC asked staff to prepare a recommendation for consideration at the Singapore BGC meeting.
 - [Action](#) – Staff to prepare a proposed BGC recommendation to the Board regarding compensation for Board Liaisons for consideration at the Singapore BGC meeting.

Published 13 March 2014

[You Tube](#)

[Twitter](#)

[LinkedIn](#)

[Flickr](#)

[Facebook](#)

[RSS Feeds](#)

[Community Wiki](#)

ICANN Blog

Who We Are

[Get Started](#)

[Learning](#)

[Participate](#)

[Board](#)

[CEO](#)

[Staff](#)

[Careers](#)

[Newsletter](#)

Contact Us

[Security Team](#)

[PGP Keys](#)

[Certificate Authority](#)

[Registry Liaison](#)

[AOC Review](#)

[Organizational Reviews](#)

[Request a Speaker](#)

[For Journalists](#)

Accountability & Transparency

[Governance](#)

[Agreements](#)

[Accountability Mechanisms](#)

[Independent Review Process](#)

[Request for Reconsideration](#)

[Ombudsman](#)

[AOC Review](#)

[Annual Report](#)

[Financials](#)

[Document Disclosure](#)

[Planning](#)

[Correspondence](#)

[Dashboard](#)

[RFPs](#)

[Litigation](#)

Help

[Dispute Resolution](#)

[Domain Name](#)

[Dispute Resolution](#)

[Name Collision](#)

[Registrar Problems](#)

[Whois](#)

© 2014 Internet Corporation For Assigned Names and Numbers.

[Privacy Policy](#)

[Cookie Policy](#)

Annex 29.

NewgTLDs

What will be the next big thing? You name it!

location
arsache
community
LANGUAGE
TLD[ICANN Home](#) • [New gTLDs Home](#)**String Similarity Assessment Tool**

This algorithm is intended to provide an approximation of similarity between a candidate generic top-level domain (gTLD) and existing TLDs and reserved names. It also allows a similarity comparison between any two strings. The algorithm compares uppercase and lowercase versions of strings. Any string yielding a similarity level of 30% or above is cited. Dots ('.') should not be included in the test strings; they are not eliminated, but cause distortions in calculation of similarity scores.

[View the Terms of Use](#)**Assess candidate string** : Compare a candidate to existing TLDs and reserved names.

Candidate top-level domain :

Assess two strings : Compare two strings to each other.

First string :

Second string :

 String similarity assessment tool - Terms of use**STRING SIMILARITY ASSESSMENT TOOL – TERMS OF USE**

BY USING OR ACCESSING THE INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS' ("ICANN") STRING SIMILARITY ASSESSMENT TOOL ("SSAT SOFTWARE"), YOU AGREE TO BE BOUND BY AND COMPLY WITH THESE TERMS OF USE.

IF YOU DO NOT AGREE TO THESE TERMS OF USE, DO NOT PROCEED ANY FURTHER – PLEASE DISCONTINUE AND DO NOT PROCEED TO USE THE SSAT SOFTWARE.

INFORMATIONAL USE ONLY

USE OF SSAT SOFTWARE IS FOR GENERAL INFORMATIONAL PURPOSES ONLY AND NOT INTENDED TO REPLACE HUMAN EVALUATION OF SIMILARITY BETWEEN TOP LEVEL DOMAIN (TLD) STRINGS. ANY OUTPUT OR RESULTS FROM THE SSAT SOFTWARE SHOULD NOT BE RELIED UPON, IMPLIED OR INFERRED TO INDICATE, CORRELATE TO OR DETERMINE THE SUCCESS OR FAILURE OF ANY ACTUAL FINAL EVALUATION OF A TLD STRING APPLICATION UNDER ICANN'S NEW GTLD PROGRAM.

DISCLAIMER; LIMITATION OF LIABILITY & INDEMNITY

USE OF SSAT SOFTWARE IS PROVIDED ON AN "AS IS" AND "AS AVAILABLE" BASIS. TO THE FULLEST EXTENT PERMITTED BY LAW, ICANN, ITS OFFICERS, DIRECTORS, EMPLOYEES, LICENSORS AND AGENTS DISCLAIM ALL WARRANTIES, EXPRESS OR IMPLIED, IN CONNECTION WITH THE SSAT SOFTWARE AND ITS USE. ICANN MAKES NO WARRANTIES OR REPRESENTATIONS ABOUT THE FITNESS FOR USE, NON-INFRINGEMENT, AVAILABILITY OR RELIABILITY OF SSAT SOFTWARE OR THAT IT IS ERROR-FREE.

IN NO EVENT SHALL ICANN, ITS OFFICERS, DIRECTORS, EMPLOYEES, LICENSORS OR AGENTS, BE LIABLE FOR ANY DIRECT, INDIRECT, INCIDENTAL, SPECIAL, PUNITIVE, OR CONSEQUENTIAL DAMAGES WHATSOEVER RESULTING FROM ANY (I) ERRORS, MISTAKES, OR INACCURACIES IN THE SSAT SOFTWARE, (II) INJURY OR DAMAGE, OF ANY NATURE WHATSOEVER, RESULTING FROM ACCESS TO AND USE OF THE SSAT SOFTWARE, (III) INTERRUPTION OR CESSATION OF TRANSMISSION TO OR FROM THE SSAT SOFTWARE, (IV) BUGS, VIRUSES, TROJAN HORSES, OR THE LIKE, WHICH MAY BE TRANSMITTED TO OR THROUGH THE SSAT SOFTWARE BY ANY THIRD PARTY, (V) DENIAL OF SERVICE OR ANY MALICIOUS SECURITY EXPLOIT INVOLVING THE SSAT SOFTWARE, (VI) LOSS OR DAMAGE OF ANY KIND INCURRED AS A RESULT OF ANY USE, COMPROMISE, OR LOSS OF DATA TRANSMITTED, OR OTHERWISE MADE AVAILABLE VIA THE SSAT SOFTWARE, AND/OR (VII) RELIANCE ON THE RESULTS OR OUTPUT OF THE SSAT SOFTWARE, WHETHER BASED ON WARRANTY, CONTRACT, TORT, OR ANY OTHER LEGAL THEORY, AND WHETHER OR NOT APPLICANT OR USER HAS BEEN ADVISED OF THE POSSIBILITY OF SUCH DAMAGES. THE FOREGOING LIMITATION OF LIABILITY SHALL APPLY TO THE FULLEST EXTENT PERMITTED BY LAW IN ANY APPLICABLE JURISDICTION.

YOU SHALL INDEMNIFY AND HOLD HARMLESS ICANN, ITS OFFICERS, DIRECTORS, EMPLOYEES, LICENSORS OR AGENTS FROM AND AGAINST ANY DIRECT, INDIRECT, INCIDENTAL, SPECIAL, PUNITIVE, OR CONSEQUENTIAL DAMAGES WHATSOEVER RESULTING FROM THIRD PARTY CLAIMS ARISING IN CONNECTION WITH YOUR BREACH OF THESE TERMS OF USE.

Any non-English translation of these Terms of Use that ICANN may make available are for convenience only. In the event of any inconsistency between the translated version and the English version, the English version of these Terms of Use will prevail.

 About this tool

The Applicant Guidebook states that "Strings must not be confusingly similar to an existing top-level domain or a Reserved Name." This string similarity tool, developed by SWORD, is intended to provide an open, objective, and predictable mechanism for assessing the degree of visual similarity between TLD strings. The algorithm uses proprietary software to perform a series of mathematical calculations to assess the visual similarity between strings based upon the following parameters:

- length of the strings;
- number of similar letters within sequences of two or more letters;
- number of similar letters not in sequence;
- number of dissimilar letters;

- length of common prefixes and suffixes if greater than one.

Additionally, the tool uses an image recognition program (a pixel-by-pixel comparison) designed to assess the visual similarity between two characters (e.g., the capital letter "O" and a zero "0" have a high visual similarity score). This scoring feature is a component of the algorithm's results. This version of the algorithm supports the most common characters in Arabic, Chinese, Cyrillic, Devanagari, Greek, Japanese, Korean and Latin. It also can compare cross-script strings that belong to the same family of scripts. For example, Chinese and Japanese belong to the East-Asian script family and could be compared. Similarly, Latin and Greek belong to the European script family and could be compared. This tool will not compare scripts from different families as they are believed to be so visually different that the likelihood of confusion is thought to be zero. This version of the algorithm does not include validation of candidate strings for compliance with IDNA protocols. The algorithm computes a visual similarity score – it is not meant to consider phonetic similarity. For example, "fish", "phish", and "fiche" sound alike, but are visually distinct and unlikely to be confused.

About SWORD

SWORD is a specialist international IT services and products company offering consultancy and integration services. As well-known specialist in the area of verbal search algorithms, SWORD has its proprietary search algorithm deployed in more than 30 patent and trademark offices throughout the world.

Information about SWORD is available at www.sword-group.com

Annex 30.

NewgTLDs

What will be the next big thing? You name it!

location
arsache
community
LANGUAGE
TLD[ICANN Home](#) • [New gTLDs Home](#)**String Similarity Assessment Tool**

This algorithm is intended to provide an approximation of similarity between a candidate generic top-level domain (gTLD) and existing TLDs and reserved names. It also allows a similarity comparison between any two strings. The algorithm compares uppercase and lowercase versions of strings. Any string yielding a similarity level of 30% or above is cited. Dots ('.') should not be included in the test strings; they are not eliminated, but cause distortions in calculation of similarity scores.

[View the Terms of Use](#)**Assess candidate string** : Compare a candidate to existing TLDs and reserved names.

Candidate top-level domain :

Assess two strings : Compare two strings to each other.

First string :

Second string :

coupons vs coupon : 84 %

 String similarity assessment tool - Terms of use**STRING SIMILARITY ASSESSMENT TOOL – TERMS OF USE**

BY USING OR ACCESSING THE INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS' ("ICANN") STRING SIMILARITY ASSESSMENT TOOL ("SSAT SOFTWARE"), YOU AGREE TO BE BOUND BY AND COMPLY WITH THESE TERMS OF USE.

IF YOU DO NOT AGREE TO THESE TERMS OF USE, DO NOT PROCEED ANY FURTHER – PLEASE DISCONTINUE AND DO NOT PROCEED TO USE THE SSAT SOFTWARE.

INFORMATIONAL USE ONLY

USE OF SSAT SOFTWARE IS FOR GENERAL INFORMATIONAL PURPOSES ONLY AND NOT INTENDED TO REPLACE HUMAN EVALUATION OF SIMILARITY BETWEEN TOP LEVEL DOMAIN (TLD) STRINGS. ANY OUTPUT OR RESULTS FROM THE SSAT SOFTWARE SHOULD NOT BE RELIED UPON, IMPLIED OR INFERRED TO INDICATE, CORRELATE TO OR DETERMINE THE SUCCESS OR FAILURE OF ANY ACTUAL FINAL EVALUATION OF A TLD STRING APPLICATION UNDER ICANN'S NEW GTLD PROGRAM.

DISCLAIMER; LIMITATION OF LIABILITY & INDEMNITY

USE OF SSAT SOFTWARE IS PROVIDED ON AN "AS IS" AND "AS AVAILABLE" BASIS. TO THE FULLEST EXTENT PERMITTED BY LAW, ICANN, ITS OFFICERS, DIRECTORS, EMPLOYEES, LICENSORS AND AGENTS DISCLAIM ALL WARRANTIES, EXPRESS OR IMPLIED, IN CONNECTION WITH THE SSAT SOFTWARE AND ITS USE. ICANN MAKES NO WARRANTIES OR REPRESENTATIONS ABOUT THE FITNESS FOR USE, NON-INFRINGEMENT, AVAILABILITY OR RELIABILITY OF SSAT SOFTWARE OR THAT IT IS ERROR-FREE.

IN NO EVENT SHALL ICANN, ITS OFFICERS, DIRECTORS, EMPLOYEES, LICENSORS OR AGENTS, BE LIABLE FOR ANY DIRECT, INDIRECT, INCIDENTAL, SPECIAL, PUNITIVE, OR CONSEQUENTIAL DAMAGES WHATSOEVER RESULTING FROM ANY (I) ERRORS, MISTAKES, OR INACCURACIES IN THE SSAT SOFTWARE, (II) INJURY OR DAMAGE, OF ANY NATURE WHATSOEVER, RESULTING FROM ACCESS TO AND USE OF THE SSAT SOFTWARE, (III) INTERRUPTION OR CESSATION OF TRANSMISSION TO OR FROM THE SSAT SOFTWARE, (IV) BUGS, VIRUSES, TROJAN HORSES, OR THE LIKE, WHICH MAY BE TRANSMITTED TO OR THROUGH THE SSAT SOFTWARE BY ANY THIRD PARTY, (V) DENIAL OF SERVICE OR ANY MALICIOUS SECURITY EXPLOIT INVOLVING THE SSAT SOFTWARE, (VI) LOSS OR DAMAGE OF ANY KIND INCURRED AS A RESULT OF ANY USE, COMPROMISE, OR LOSS OF DATA TRANSMITTED, OR OTHERWISE MADE AVAILABLE VIA THE SSAT SOFTWARE, AND/OR (VII) RELIANCE ON THE RESULTS OR OUTPUT OF THE SSAT SOFTWARE, WHETHER BASED ON WARRANTY, CONTRACT, TORT, OR ANY OTHER LEGAL THEORY, AND WHETHER OR NOT APPLICANT OR USER HAS BEEN ADVISED OF THE POSSIBILITY OF SUCH DAMAGES. THE FOREGOING LIMITATION OF LIABILITY SHALL APPLY TO THE FULLEST EXTENT PERMITTED BY LAW IN ANY APPLICABLE JURISDICTION.

YOU SHALL INDEMNIFY AND HOLD HARMLESS ICANN, ITS OFFICERS, DIRECTORS, EMPLOYEES, LICENSORS OR AGENTS FROM AND AGAINST ANY DIRECT, INDIRECT, INCIDENTAL, SPECIAL, PUNITIVE, OR CONSEQUENTIAL DAMAGES WHATSOEVER RESULTING FROM THIRD PARTY CLAIMS ARISING IN CONNECTION WITH YOUR BREACH OF THESE TERMS OF USE.

Any non-English translation of these Terms of Use that ICANN may make available are for convenience only. In the event of any inconsistency between the translated version and the English version, the English version of these Terms of Use will prevail.

 About this tool

The Applicant Guidebook states that "Strings must not be confusingly similar to an existing top-level domain or a Reserved Name." This string similarity tool, developed by SWORD, is intended to provide an open, objective, and predictable mechanism for assessing the degree of visual similarity between TLD strings. The algorithm uses proprietary software to perform a series of mathematical calculations to assess the visual similarity between strings based upon the following parameters:

- length of the strings;
- number of similar letters within sequences of two or more letters;
- number of similar letters not in sequence;
- number of dissimilar letters;

- length of common prefixes and suffixes if greater than one.

Additionally, the tool uses an image recognition program (a pixel-by-pixel comparison) designed to assess the visual similarity between two characters (e.g., the capital letter "O" and a zero "0" have a high visual similarity score). This scoring feature is a component of the algorithm's results. This version of the algorithm supports the most common characters in Arabic, Chinese, Cyrillic, Devanagari, Greek, Japanese, Korean and Latin. It also can compare cross-script strings that belong to the same family of scripts. For example, Chinese and Japanese belong to the East-Asian script family and could be compared. Similarly, Latin and Greek belong to the European script family and could be compared. This tool will not compare scripts from different families as they are believed to be so visually different that the likelihood of confusion is thought to be zero. This version of the algorithm does not include validation of candidate strings for compliance with IDNA protocols. The algorithm computes a visual similarity score – it is not meant to consider phonetic similarity. For example, "fish", "phish", and "fiche" sound alike, but are visually distinct and unlikely to be confused.

About SWORD

SWORD is a specialist international IT services and products company offering consultancy and integration services. As well-known specialist in the area of verbal search algorithms, SWORD has its proprietary search algorithm deployed in more than 30 patent and trademark offices throughout the world.

[More information about SWORD is available at www.sword.com](#)

Annex 31.

NewgTLDs

What will be the next big thing? You name it!

location
arsache
TLD
LANGUAGE[ICANN Home](#) • [New gTLDs Home](#)**String Similarity Assessment Tool**

This algorithm is intended to provide an approximation of similarity between a candidate generic top-level domain (gTLD) and existing TLDs and reserved names. It also allows a similarity comparison between any two strings. The algorithm compares uppercase and lowercase versions of strings. Any string yielding a similarity level of 30% or above is cited. Dots ('.') should not be included in the test strings; they are not eliminated, but cause distortions in calculation of similarity scores.

[View the Terms of Use](#)**Assess candidate string** : Compare a candidate to existing TLDs and reserved names.

Candidate top-level domain :

Assess two strings : Compare two strings to each other.

First string :

Second string :

io vs jo : 83 %

 String similarity assessment tool - Terms of use**STRING SIMILARITY ASSESSMENT TOOL – TERMS OF USE**

BY USING OR ACCESSING THE INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS' ("ICANN") STRING SIMILARITY ASSESSMENT TOOL ("SSAT SOFTWARE"), YOU AGREE TO BE BOUND BY AND COMPLY WITH THESE TERMS OF USE.

IF YOU DO NOT AGREE TO THESE TERMS OF USE, DO NOT PROCEED ANY FURTHER – PLEASE DISCONTINUE AND DO NOT PROCEED TO USE THE SSAT SOFTWARE.

INFORMATIONAL USE ONLY

USE OF SSAT SOFTWARE IS FOR GENERAL INFORMATIONAL PURPOSES ONLY AND NOT INTENDED TO REPLACE HUMAN EVALUATION OF SIMILARITY BETWEEN TOP LEVEL DOMAIN (TLD) STRINGS. ANY OUTPUT OR RESULTS FROM THE SSAT SOFTWARE SHOULD NOT BE RELIED UPON, IMPLIED OR INFERRED TO INDICATE, CORRELATE TO OR DETERMINE THE SUCCESS OR FAILURE OF ANY ACTUAL FINAL EVALUATION OF A TLD STRING APPLICATION UNDER ICANN'S NEW GTLD PROGRAM.

DISCLAIMER; LIMITATION OF LIABILITY & INDEMNITY

USE OF SSAT SOFTWARE IS PROVIDED ON AN "AS IS" AND "AS AVAILABLE" BASIS. TO THE FULLEST EXTENT PERMITTED BY LAW, ICANN, ITS OFFICERS, DIRECTORS, EMPLOYEES, LICENSORS AND AGENTS DISCLAIM ALL WARRANTIES, EXPRESS OR IMPLIED, IN CONNECTION WITH THE SSAT SOFTWARE AND ITS USE. ICANN MAKES NO WARRANTIES OR REPRESENTATIONS ABOUT THE FITNESS FOR USE, NON-INFRINGEMENT, AVAILABILITY OR RELIABILITY OF SSAT SOFTWARE OR THAT IT IS ERROR-FREE.

IN NO EVENT SHALL ICANN, ITS OFFICERS, DIRECTORS, EMPLOYEES, LICENSORS OR AGENTS, BE LIABLE FOR ANY DIRECT, INDIRECT, INCIDENTAL, SPECIAL, PUNITIVE, OR CONSEQUENTIAL DAMAGES WHATSOEVER RESULTING FROM ANY (I) ERRORS, MISTAKES, OR INACCURACIES IN THE SSAT SOFTWARE, (II) INJURY OR DAMAGE, OF ANY NATURE WHATSOEVER, RESULTING FROM ACCESS TO AND USE OF THE SSAT SOFTWARE, (III) INTERRUPTION OR CESSATION OF TRANSMISSION TO OR FROM THE SSAT SOFTWARE, (IV) BUGS, VIRUSES, TROJAN HORSES, OR THE LIKE, WHICH MAY BE TRANSMITTED TO OR THROUGH THE SSAT SOFTWARE BY ANY THIRD PARTY, (V) DENIAL OF SERVICE OR ANY MALICIOUS SECURITY EXPLOIT INVOLVING THE SSAT SOFTWARE, (VI) LOSS OR DAMAGE OF ANY KIND INCURRED AS A RESULT OF ANY USE, COMPROMISE, OR LOSS OF DATA TRANSMITTED, OR OTHERWISE MADE AVAILABLE VIA THE SSAT SOFTWARE, AND/OR (VII) RELIANCE ON THE RESULTS OR OUTPUT OF THE SSAT SOFTWARE, WHETHER BASED ON WARRANTY, CONTRACT, TORT, OR ANY OTHER LEGAL THEORY, AND WHETHER OR NOT APPLICANT OR USER HAS BEEN ADVISED OF THE POSSIBILITY OF SUCH DAMAGES. THE FOREGOING LIMITATION OF LIABILITY SHALL APPLY TO THE FULLEST EXTENT PERMITTED BY LAW IN ANY APPLICABLE JURISDICTION.

YOU SHALL INDEMNIFY AND HOLD HARMLESS ICANN, ITS OFFICERS, DIRECTORS, EMPLOYEES, LICENSORS OR AGENTS FROM AND AGAINST ANY DIRECT, INDIRECT, INCIDENTAL, SPECIAL, PUNITIVE, OR CONSEQUENTIAL DAMAGES WHATSOEVER RESULTING FROM THIRD PARTY CLAIMS ARISING IN CONNECTION WITH YOUR BREACH OF THESE TERMS OF USE.

Any non-English translation of these Terms of Use that ICANN may make available are for convenience only. In the event of any inconsistency between the translated version and the English version, the English version of these Terms of Use will prevail.

 About this tool

The Applicant Guidebook states that "Strings must not be confusingly similar to an existing top-level domain or a Reserved Name." This string similarity tool, developed by SWORD, is intended to provide an open, objective, and predictable mechanism for assessing the degree of visual similarity between TLD strings. The algorithm uses proprietary software to perform a series of mathematical calculations to assess the visual similarity between strings based upon the following parameters:

- length of the strings;
- number of similar letters within sequences of two or more letters;
- number of similar letters not in sequence;
- number of dissimilar letters;

- length of common prefixes and suffixes if greater than one.

Additionally, the tool uses an image recognition program (a pixel-by-pixel comparison) designed to assess the visual similarity between two characters (e.g., the capital letter "O" and a zero "0" have a high visual similarity score). This scoring feature is a component of the algorithm's results. This version of the algorithm supports the most common characters in Arabic, Chinese, Cyrillic, Devanagari, Greek, Japanese, Korean and Latin. It also can compare cross-script strings that belong to the same family of scripts. For example, Chinese and Japanese belong to the East-Asian script family and could be compared. Similarly, Latin and Greek belong to the European script family and could be compared. This tool will not compare scripts from different families as they are believed to be so visually different that the likelihood of confusion is thought to be zero. This version of the algorithm does not include validation of candidate strings for compliance with IDNA protocols. The algorithm computes a visual similarity score – it is not meant to consider phonetic similarity. For example, "fish", "phish", and "fiche" sound alike, but are visually distinct and unlikely to be confused.

About SWORD

SWORD is a specialist international IT services and products company offering consultancy and integration services. As well-known specialist in the area of verbal search algorithms, SWORD has its proprietary search algorithm deployed in more than 30 patent and trademark offices throughout the world.

[More information about SWORD is available at www.sword.com](#)