

International Centre for Dispute Resolution
New gTLD String Confusion Panel

Re: 50 504 00233 13

Charleston Road Registry, OBJECTOR

and

Koko Castle, APPLICANT

String: < .cars >

EXPERT DETERMINATION

The parties

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

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

The New gTLD String Objected To

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

Prevailing Party

The Applicant has prevailed and the Objection is dismissed.

The New gTLD String Confusion Process

Module 3 of the ICANN gTLD Applicant Guidebook contains Objection Procedures and the New gTLD Dispute Resolution Procedure (“the Procedure” or “DRP”).

Article 1(b) of the Procedure states that “The new gTLD program includes a dispute resolution procedure, pursuant to which disputes between a person or entity who applies for a new gTLD and a person or entity who objects to that gTLD are resolved in accordance with this New gTLD Dispute Resolution Procedure.

As expressed in the Guidebook, and the Procedure, there are four (4) grounds to object to the registration of new gTLDs. One of these grounds expressed String Confusion, as described in DRP Article 2(e)(i): **“(i) ‘String Confusion Objection’ refers to the objection that the string comprising the potential gTLD is confusingly similar to an existing top-level domain or another string applied for in the same round of applications.”**

Article 3(a) states that “String Confusion Objections shall be administered by the International Centre for Dispute Resolution”.

Procedural History of this Case

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

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

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

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

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

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

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

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

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

Factual Background

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

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

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

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

Parties’ Contentions

Objector

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

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

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

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

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

Applicant

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

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

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

- ICANN’s initial string similarity review tests did not place other singular and plural gTLD applications, such as <.game> and <.games>, in common contention sets.
- ICANN’s third-party expert panel found that <.car> and <.cars> were not visually similar to each other. The visual similarity test is much narrower, such as the paradigm <.COM> versus <.COM> using the letter “O” versus the number “zero” in the TLD, or <.unicorn> versus <.unicom> where that panel did place these in the same contention sets.
- As the ICANN initial string similarity review test panel did not find string confusion in this case, the Applicant has the right to an evidentiary presumption in favor of ICANN approval of its application.
- The Objector cannot prove that “Cars” and “Car” are so similar in appearance as to result in likelihood of internet user confusion. To support this contention, Applicant states that the initial ICANN string visual similarity assessment tool yielded a result of only 72% between “car” and “cars”. To buttress its case further, Applicant provided a table of so-called “false positives” which are much more different from each other than “car” vs. “cars”, where the ICANN string similarity assessment tool yielded much higher scores in the range of 86% (“PRINCES” vs. “PRINCESS”) - 94% (“GOOGLE” vs. “GOGGLE”).
- “Peaceful Coexistence” for second level domain names: Similar and plural words are used differently more often than not in existing TLDs (e.g. car.com and cars.com). Some 50,886 singular/plural string pairs currently exist which do not point to the same IP address, compared to 1,330 pairs which do.
- Compilations from Alexa Internet show that plural websites function as online businesses independently of their singular name counterparts.
- Singular and plural versions as TLDs are easier to distinguish at the top level than they would be at the second level: <hot.car> vs. <hot.cars> are easier to distinguish than <hotcar.com> vs. <hotcars.com>.
- Objector does not prove an aural similarity between “car” and “cars”, as the latter ends with “s” which is distinguishable in pronunciation.
- The terms “car” and “cars” may not have similar meanings because the word “car” has different meanings in French (because), Croatian (emperor), or Serbian (geographic indicator).
- Studies cited by the Objector regarding difficulty of Korean and Francophone speakers to distinguish English singular vs. plural words are not valid because the methodology was not adequately elaborated.
- Even assuming some similarity between “car” and “cars”, this does not automatically suffice to find likelihood of confusion. Other applicants have applied for synonyms in gTLDs, such as “<.auto>” and “<.autos>”.
- Earlier ICANN public comments cited by Objector regarding string confusion in NameSpace’s and MDMA’s gTLD applications with singular vs. plural names were most likely caused by factors other than singular vs. plural confusion.
- Objector’s use of the term “confusingly similar” is inappropriate here because under U.S. trademark law, there is one test for likelihood of confusion and another test for similarity. In contrast, the ICANN “string confusion objection standard *only* takes into account the similarity of the two strings (whereas [*sic*] visual, aural, or in meaning”), citing ICANN Guidebook § 2.2.1.1.3.

Discussion and Findings

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

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

“3.5.1. String Confusion Objection

A DRSP panel hearing a string confusion objection will consider whether the applied-for gTLD string is likely to result in string confusion. String confusion exists where a string so nearly resembles another that it is likely to deceive or cause confusion. For a likelihood of confusion to exist, it must be probable, not merely possible that confusion will arise in the mind of the average, reasonable internet user. Mere association, in the sense that the string brings another string to mind, is insufficient to find a likelihood of confusion.”

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

A. Identical or Confusingly Similar Strings

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Determination

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

by: Paul E. Mason

A handwritten signature in black ink that reads "Paul E. Mason". The signature is written in a cursive style with a long horizontal stroke at the beginning.

Date: August 7, 2013