

# **Annex 1.**

**INTERNATIONAL CENTRE FOR DISPUTE RESOLUTION**

**New gTLD String Confusion Panel**

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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>

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**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  
U.S.A.

The Applicant is Vistaprint Limited, Contact Information Redacted  
Contact Information Redacted represented by Flip Petillion, Contact Information Redacted  
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.<sup>1</sup> 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.”<sup>2</sup> 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.

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<sup>1</sup> Module 3 ¶ 3.2.1; Attachment to Module 3 art. 2(e).

<sup>2</sup> 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.<sup>3</sup>

### **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

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<sup>3</sup> 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.<sup>4</sup>

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”;<sup>5</sup>

>relies on the conclusions of an expert with “a doctoral degree in linguistics (morphophonology)”,<sup>6</sup> 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”;<sup>7</sup>

>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.<sup>8</sup>

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<sup>4</sup> Objector’s String Confusion Objection at 3 [hereinafter Objection].

<sup>5</sup> *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].

<sup>6</sup> Annex R1, *supra* note 5, at 1.

<sup>7</sup> *Id.* at 3.

<sup>8</sup> *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;<sup>9</sup> 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.<sup>10</sup>

[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.<sup>11</sup>

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 meaning . . . .<sup>12</sup>

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<sup>9</sup> Objection at 7-8.

<sup>10</sup> Applicant’s Response at 9.

<sup>11</sup> *Id.* at 10.

<sup>12</sup> *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”;<sup>13</sup>

\*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?”;<sup>14</sup>

\*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”;<sup>15</sup>

\*“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”;<sup>16</sup>

\*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;<sup>17</sup>

\*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

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<sup>13</sup> *Id.* at 8.

<sup>14</sup> *Id.* at 11.

<sup>15</sup> *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.*

<sup>16</sup> *Id.* at 7.

<sup>17</sup> *Id.* at 3.

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

\*"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";<sup>19</sup>

\*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",<sup>20</sup> and "[t]he Objector has never instituted a formal challenge to the WEBS.COM domain name";<sup>21</sup>

\*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";<sup>22</sup> 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."<sup>23</sup>

The Applicant also relies on the findings of an expert, a professor "in linguistics and language teaching methodology",<sup>24</sup> 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

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<sup>18</sup> *Id.* at 11.

<sup>19</sup> *Id.* at 4.

<sup>20</sup> *Id.* at 2.

<sup>21</sup> *Id.* at 7.

<sup>22</sup> *Id.*

<sup>23</sup> *Id.* at 7-8.

<sup>24</sup> *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.<sup>25</sup>

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<sup>25</sup> *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.<sup>26</sup>

## 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.<sup>27</sup>

The Objector bears the burden of proof.<sup>28</sup>

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

Applicant’s Surreply at 1.

<sup>26</sup> 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.

<sup>27</sup> 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.”).

<sup>28</sup> 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”.<sup>29</sup> 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.”<sup>30</sup>

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,

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<sup>29</sup> Module 2 ¶ 2.2.1.1.

<sup>30</sup> 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”.<sup>31</sup>

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.<sup>32</sup> All of these determinations are publicly available on the ICDR Internet site.<sup>33</sup> The determinations resolved objections to the following seven applied-for gTLDs: <.cars> (three separate decisions<sup>34</sup>), <.games>,<sup>35</sup> <.hotels>,<sup>36</sup> <.pets> (two separate

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<sup>31</sup> Module 3 ¶ 3.5.1.

<sup>32</sup> 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.

<sup>33</sup> 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](http://images.go.adr.org/Web/AmericanArbitrationAssociation/%7Bdf3f46b6-4c35-4bd1-a428-7c70d7db53b%7D_ICANN_DRP_StringConfusion_Objections.pdf)>.

<sup>34</sup> *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).

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

decisions<sup>37</sup>), <.sports>,<sup>38</sup> <.tours>,<sup>39</sup> and <.tv>.<sup>40</sup> 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 cases<sup>41</sup>), <.games>,<sup>42</sup> <.pets> (both cases<sup>43</sup>), <.sports>,<sup>44</sup> and <.tours>.<sup>45</sup> 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.

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<sup>36</sup> *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).

<sup>37</sup> *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*].

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

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

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

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

<sup>42</sup> *Foggy Beach, LLC*.

<sup>43</sup> *John Island, LLC; Afilias Limited*.

<sup>44</sup> *SportAccord*.

<sup>45</sup> *Sugar Station, LLC*.

These four cases involve (1) <.tvs>,<sup>46</sup> (2) <.hotels>,<sup>47</sup> and the other two decisions involving (3) and (4) <.cars>.<sup>48</sup> As indicated above, the Applicant relies on three of these determinations.<sup>49</sup> 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]”.<sup>51</sup> 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.”<sup>52</sup> Initially, the Panel questions whether the factors to be considered when “testing for likelihood of confusion under Sec. 2(d)”<sup>53</sup> of the Lanham Act should be the test for determining

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<sup>46</sup> *Verisign Switzerland SA*.

<sup>47</sup> *HOTEL Top-Level-Domain S.a.r.l.*

<sup>48</sup> *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.

<sup>49</sup> See *supra* text accompanying note 26.

<sup>50</sup> 476 F.2d 1357 (C.C.P.A. 1973).

<sup>51</sup> *Verisign Switzerland SA* at 5.

<sup>52</sup> 476 F.2d at 1359.

<sup>53</sup> *Id.* at 1361. The thirteen factors are:

likelihood of confusion between two gTLD strings -- <.webs> and <.web>.<sup>54</sup> 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."<sup>55</sup> This, as well as other descriptions of the string objected to in *Verisign Switzerland SA*, is simply inapt in the present case.

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- (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.*

<sup>54</sup> 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).

<sup>55</sup> *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”.<sup>56</sup> He nevertheless concluded that the strings are “sufficiently visually and aurally different for string confusion purposes.”<sup>57</sup> 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.”<sup>58</sup>

First, ICANN’s String Similarity Assessment Tool, while relevant in the Panel’s consideration, is not determinative in resolving a string confusion objection.<sup>59</sup> 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.”<sup>60</sup> Rather, “the Objection process is an independent review process.”<sup>61</sup> Third, this Panel has considered, and found not persuasive, the opinions of the Applicant’s linguistics expert urging dissimilarity between <.webs> and <.web>.

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<sup>56</sup> *HOTEL Top-Level-Domain S.a.r.l* at 3.

<sup>57</sup> *Id.* at 4.

<sup>58</sup> *Id.*

<sup>59</sup> See *DERCars, LLC* at 29.

<sup>60</sup> *Koko Castle, LLC* at 5 (Panelist Mason).

<sup>61</sup> *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.<sup>62</sup> 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.”<sup>63</sup> 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.”<sup>64</sup> 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”.<sup>65</sup> 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.”<sup>66</sup> 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

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<sup>62</sup> *DERCars, LLC*. See *supra* note 48.

<sup>63</sup> *Koko Castle, LLC* at 5 (emphasis added).

<sup>64</sup> *DERCars, LLC* at 29.

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

<sup>66</sup> *Koko Castle, LLC* at 5-6.

association between them.”<sup>67</sup> 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>.”<sup>68</sup> 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”,<sup>69</sup> 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.”<sup>70</sup> 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.<sup>71</sup>

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

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<sup>67</sup> *Id.* at 6 (emphasis added).

<sup>68</sup> *Uniregistry, Corp.* at 10 (¶¶ 14, 17) (in original).

<sup>69</sup> *Id.* at 9 (¶ 9).

<sup>70</sup> *Id.* at 10 (¶ 15).

<sup>71</sup> *Id.* at 11 (¶ 19(a)).

probability of user confusion if the two strings are delegated into the root zone.<sup>72</sup>

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.<sup>73</sup>

Per the Guidebook, "The Objector bears the burden of proving that its Objection should be sustained in accordance with the applicable standards."<sup>74</sup> 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

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<sup>72</sup> *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).

<sup>73</sup> 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.").

<sup>74</sup> Attachment to Module 3 art. 20(c).

# **Annex 2.**




**gTLD RESPONSE TO STRING CONFUSION OBJECTION**

The named Applicant hereby submits the following response to the objection filed by Web.com Group, Inc. for resolution, under the rules of the NEW gTLD Dispute Resolution Procedures. This document and associated submissions were sent to the following addresses :  
Contact Information Redacted  
Contact Information Redacted

As required, USD 2,750 were paid to ICDR on 8 May 2013. Evidence of the payment is attached for information.  
**(Attachment 74)**

**Rules and Procedures:** NEW gTLD Dispute Resolution Procedures/ICDR Supplementary Procedures for String Confusion Objections

**Party Information**

Name of Applicant: Vistaprint Limited	Name of Objector: Web.com Group, Inc.
Address: Contact Information Redacted	Address: Contact Information Redacted
City, State/Province, Country, Postal Code: Contact Information Redacted	City, State/Province, Country, Postal Code: Contact Information Redacted
Telephone: Email Address: Contact Information Redacted	Telephone: Email Address: Contact Information Redacted
Name of Applicant's Attorney or Representative: Flip Petillion	Name of Objector's Attorney or Representative: Steven C. Sereboff
Name of Firm (if applicable): Crowell & Moring	Name of Firm (if applicable): SoCal IP Law Group LLP
Address: Contact Information Redacted	Address: Contact Information Redacted
City, State/Province, Country, Postal Code: Contact Information Redacted	City, State/Province, Country, Postal Code: Contact Information Redacted
Telephone: Email Address: Contact Information Redacted	Telephone: Email Address: Contact Information Redacted
Signature:  Attorney-at-law, 23 May 2013	

## I. The Parties

### A. The Applicant

Through its subsidiary, Webs Inc., the Applicant (also Respondent) provides free website creation tools and hosting services. Additional paid features are offered (Attachment 1).

At present, the Applicant conducts its business using a website that is accessible via the domain name 'webs.com'. The 'webs.com' domain name was registered on April 4, 1995 (Attachment 2).

'Webs' is the mark under which the Applicant brands its products and services.

Webs' clients are predominantly non-US clients (54% non-US, 46% US) (Attachment 3).

### B. The Objector

The Objector primarily provides web site development services to small and medium businesses and conducts its business using a website that is accessible via the domain name 'web.com' (Attachment 4). The 'web.com' domain name was registered on July 2, 1996 (Attachment 5).

The Objector uses the mark 'Web.com' for which it has two U.S. trademark registrations (Attachment 6).

Web.com's clients are primarily US based (Attachment 7).

## II. Factual background

### A. The Objector and the Applicant have co-existed for many years without any problem

#### 1. The WEBS.COM and WEB.COM domain names have been used and coexisting in the market for many years

The 'webs.com' domain name was created on April 5, 1995 (Attachment 2), more than a year before the creation of the 'web.com' domain name on July 2, 1996 (Attachment 5).

Both 'webs.com' and 'web.com' domain names have been used simultaneously for more than 16 years. The two domain names have co-existed, and significant and distinct businesses have thrived under these separate names, with each business possessing its own independent identity and goodwill.

#### 2. The Parties have never initiated any case against each other

Neither the Applicant nor the Objector have ever litigated over the others use of their respective mark and domain name.

- 3. The Applicant's use of the WEBS.COM domain name has never been the subject of any lawsuit**

The Applicant's use of the 'webs.com' domain name has never been questioned by a party in court or in a UDRP case.

- 4. The Objector's use of the WEB.COM domain name has never been the subject of any law suit**

In so far as the Applicant is aware, the Objector's use of the WEB.COM domain name has never been questioned by a party in court or in a UDRP proceeding.

- B. Both the Applicant and the Objector have filed an application for a new generic Top Level Domain**

The Applicant has applied for the string .WEBS (standard and community application) with a view to consolidating the reputation of the Applicant's website creation tools and hosting services, known under the identifier 'WEBS' and the community it represents. The use of the 'WEBS' identifier is aimed at making it unambiguous that the TLD is related to the Applicant **(Attachments 8 and 9)**

The Objector has applied for the string .WEB **(Attachment 10)**.

- C. There are 7 applicants for .WEB**

There are 7 applicants for .WEB. Apart from the Objector, an application for .WEB was filed by DotWeb Inc. (AE), Charleston Road Registry Inc., (US), Afilias Domains No. 3 Limited (IE), Ruby Glen, LLC (US), Schlund Technologies GmbH (DE), and NU DOT CO LLC (US) **(Attachment 11-16)**.

No other party applied for .WEBS.

- D. The other applicants for .WEB have not filed a string confusion objection**

None of the other 6 applicants for .WEB has filed an objection against the Applicant. It is fair to deduce from this that these applicants either do not share the grounds for the objection filed by the Objector and/or that they did not deem it appropriate to file such an objection on these or other grounds.

### III. The purpose of ICANN's new gTLD program and the limited grounds for objection

On 12 January 2012, ICANN launched its new Generic Top-Level Domain (gTLD or TLD) program, with the goal of “*enhancing competition[,] consumer choice[,] . . . [and] innovation via the introduction of new gTLDs.*”<sup>1</sup> The Applicant filed its application for the string .WEBS, which it intends to use in connection with its free website creation and hosting business. The applied-for .WEBS gTLD will increase competition and benefit Internet users by providing new and different services within an expanded DNS, and thus enhance the goals of ICANN's new gTLD program.<sup>2</sup>

ICANN designed the objection process to protect certain legitimate rights, while also ensuring that objectors could not prevent the delegation of legitimate TLDs. Objections are only permitted on the four specific grounds enumerated in the Guidebook: string confusion, legal rights, community opposition, and limited public interest.<sup>3</sup> Any objection outside these narrow grounds must fail.

Accordingly, it is important to apply the criteria as written, and not in an overbroad way that unnecessarily interferes with the delegation of the applied-for TLD. The Applicant will show that 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.

The Applicant will also show that the objection is not only contrary to the purpose of ICANN's new gTLD program, but also fails to meet the stringent criteria of a legal rights objection.

### IV. The task of the panel expert

#### A. The relevant criterion

The applicable rule has been provided in the AGB, Section 3.5.1. which reads as follows:

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

The Applicant wishes to point out that the Objector omitted the last sentence when referring to AGB, Section 3.5.1. (Objection, p. 3). However, as will be demonstrated below, this sentence is quite relevant for this case.

<sup>1</sup> About the Program: ICANN New gTLDs, available at <http://newgtlds.icann.org/en/about/program>.

<sup>2</sup> About the Program: ICANN New gTLDs, available at <http://newgtlds.icann.org/en/about/program> (“The program's goals include enhancing competition and consumer choice, and enabling the benefits of innovation via the introduction of new gTLDs.”).

<sup>3</sup> *Id.*, Module 3.2.1.



## B. Difference with the task of the String Similarity Panel

The evaluation undertaken by the Expert Panel is different from that assigned by ICANN to the String Similarity Panel in the Initial Evaluation.

### 1. The task of the String Similarity Panel

The String Similarity Panel was assigned the task of determining contention sets. The String Similarity Panel was asked to review the entire pool of applied-for strings to determine whether the strings proposed in any two or more applications were so similar that they would create a probability of user confusion if allowed to coexist in the DNS. (AGB, Module 4-3)

The criterion to be used by the String Similarity Panel is defined in the Applicant Guidebook which states:

*“Contention sets are groups of applications containing identical or similar applied-for gTLD strings.”*

[...]

*“‘similar’ means strings so similar that they create a probability of user confusion if more than one of the strings is delegated into the root zone.*

[...]

*The String Similarity Panel will [...] review the entire pool of applied-for strings to determine whether the strings proposed in any two or more applications are so similar that they would create a probability of user confusion if allowed to coexist in the DNS. The panel will make such a determination for each pair of applied-for gTLD strings. The outcome of the String Similarity review described in Module 2 is the identification of contention sets among applications that have direct or indirect contention relationships with one another.*

*Two strings are in direct contention if they are identical or similar to one another.*

[...]

*Two strings are in indirect contention if they are both in direct contention with a third string, but not with one another.” (AGB, Module 4-2, 4-3)*

Module 2 of the Applicant Guidebook also states:

**“Standard for String Confusion** – *String confusion exists where a string so nearly resembles another **visually** 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.” (AGB, Module 2-8)*

## 2. The task of the Expert Panel

The Applicant Guidebook provides in Module 2 that – in contrast with the determination by the String Similarity Panel – a String Confusion Objection brought before an Expert Panel:

“...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.” (AGB, Module 2-8).

### V. ICANN and its String Similarity Panel do not consider the strings to be confusingly similar

#### A. ICANN's String Similarity Assessment Tool provides a low similarity rate

In the application period for new gTLDs, ICANN had made accessible a String Similarity Assessment Tool. It is still accessible on <https://icann.sword-group.com/algorithm/Default.aspx>. (Attachment 17)

According to the information published on this website, this tool “*is intended to provide an **open, objective, and predictable mechanism** for assessing the degree of **visual similarity** between TLD strings.*”

It allows for the comparison of two strings to each other.

When comparing .WEBS with .WEB, the similarity rate is 72% (Attachment 18) which is much lower than the similarity rate of various TLDs that currently co-exist (Attachments 19-55). *E.g.*, the currently co-existing .LT and .TL strings and .IL and .LI are respectively 93% and 94% similar (Attachments 53-54).

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 (Attachments 56-57). The applicants for these strings did not file a string confusion objection.

Internet users have become used to the existence of TLDs having much more similarity than the claimed similarity between .WEBS and .WEB. For instance, with a similarity rate of 83%, .IO and .JO are considered visually more similar (Attachment 44). Also, in certain languages, from an aural perspective, .IO is virtually identical to .JO. From a conceptual point of view, .IO and .JO are as meaningful, or rather equally meaningless. Nonetheless, this poses no problem for the average Internet user, who is used to small differences between TLDs.

#### B. ICANN has not put the applications for .WEBS and .WEB in a contention set

As mentioned above, in the Initial Evaluation, ICANN assigned a panel called the String Similarity Panel with the task to determine contention sets: The String Similarity Panel was asked to review the entire pool of applied-for strings to determine whether the strings

proposed in any two or more applications were so similar that they would create a probability of user confusion if allowed to coexist in the DNS (AGB, Module 4-3).

The outcome of this assignment was that two contention sets of non-exact matches were created: the set containing .HOTELS and .HOTEIS strings and the set containing the .UNICOM and .UNICORN strings (**Attachment 58**).

No other contention sets for non-exact matches in Latin script were created.

This shows that 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.

## VI. The Objector does not consider WEBS and WEB to be confusingly similar

### 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.

### B. The Objector never formally challenged the co-existence between the WEBS.COM and WEB.COM domain names

The Objector has never instituted a formal challenge to the WEBS.COM domain name, which co-exists with the Objector's WEB.COM domain name for years. Whereas 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 .

## VII. There is no overall similarity

The 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.

The Applicant asked an independent expert to provide his views on the following questions:

- 1) Regardless of the ICANN framework, would you consider both strings to be confusing?
- 2) Given the ICANN framework, would you consider both strings confusing based on any of the following types of similarity: visual, aural or similarity of meaning?

The expert to whom this request was addressed, Professor Piet Desmet, is full professor at the University of Leuven in linguistics and language teaching methodology (Attachment 60).

Professor Desmet from the University of Leuven has made the following findings:

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

Professor Desmet concludes that 'webs' and 'web' are recognized as two radically different words since their last letters are completely different.

2. 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.

Professor Desmet considers that 'webs' and 'web' have completely regular patterns allowing for one-to-one mapping of spelling to sound, which highly facilitates the word recognition of both words.

3. Third, there 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 evidenced by eye-fixation patterns. Words with fewer orthographic neighbors are more easily recognizable.

Professor Desmet concludes that this results in a higher word recognition for 'webs' and 'web' which have a limited number of orthographic neighbors.

4. Fourth, 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.

For professor Desmet, this is an extra factor that enhances the ability to recognize the difference between 'web' and 'webs'.

5. Also, the plural '-s' is a completely regular plural and easily recognizable compared to irregular plurals (e.g. with vowel change such as 'hero'/'heroes') that have been proven to be less easily recognizable.

In conclusion, Professor Desmet considers the 5 elements above reason enough to dismiss the idea of string confusion in the case of 'webs'/'web'.

### VIII. The strings are visually different

The two strings .WEBS and .WEB are visually distinct.

A number of different trademark offices provide guidance on how to interpret confusion. For example, the European Union Trade Mark Office provides guidance on how to interpret confusion. Its *Manual concerning opposition* was used by the GNSO<sup>4</sup> when it suggested language for the Applicant Guidebook of ICANN. The Manual lays down a couple of relevant principles that apply in the case at instance:

*"The visual comparison is based on an analysis of the number and sequence of the letters, the number of words and the structure of the signs." (Attachment 61, p. 10, section 3.2)*

*"The length of a name may influence the effect of differences. The shorter a name, the more easily the public is able to perceive all its single elements. Thus, small differences may frequently lead in short words to a different overall impression. In contrast, the public is less aware of differences between long names." (Attachment 61, p. 22, section 4.2)*

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. This is confirmed by the findings of Professor Desmet mentioned above.

The difference is sufficiently clear not to cause any confusion, mistake or deception, as is made clear by the longstanding coexistence between the domain names WEBS.COM and WEB.COM.

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<sup>4</sup> ICANN's Generic Names Supporting Organization ; see <http://gns0.icann.org/en/>

#### **IX. The strings are aurally different**

Also aurally, the strings are different. As evidenced by the findings of Professor Desmet, both '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.

Indeed, the sound of the letter 's' is clearly stressed in 'webs' and is not present in the word 'web'. Individuals are perfectly capable of distinguishing the sound that is generated by adding the letter 's' to a word with similar endings as the word 'web'. *E.g.*, individuals are perfectly capable of distinguishing 'step' from 'steps', 'car' from 'cars' or 'sales rep' from 'sales reps'.

Hence, also from an aural perspective, 'webs' is clearly different and distinguishable from 'web'.

#### **X. The strings have a different meaning**

The strings have a different meaning. 'Web' refers to the world wide web or to a network or silken structure created by a spider (**Attachment 62**), 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 (**Attachment 63**). 'Web' on the other hand has a clear dictionary meaning (**Attachment 64**).

In any event, as mentioned above, the Applicant Guidebook expressly provides that mere association, in the sense that the string brings another string to mind, is insufficient to find a likelihood of confusion (AGB, Section 3.5.1.).

As also explained above, the mission and purpose of the Applicant .WEBS gTLD is to consolidate the reputation of the Applicant's hosting services, known under the identifier 'WEBS' and the community it represents and to ensure that the .WEBS top-level domain will be unambiguous as regards the identity of the Registry Operator.

This purpose is in diametric opposition to the mission and purpose of the Objector's .WEB gTLD, which is to "become the most versatile gTLD on the World Wide Web" and to "quickly become as ubiquitous" and to "serve everyone, from commerce to information to community-building" (**Attachment 10**, response to evaluation question 18).

As a result, the services offered under .WEBS and .WEB will clearly distinguish themselves.

#### **XI. The real objective of the Objector**

During the Objector's first quarter 2013 earnings conference call, the Objector stated that it is certainly interested in getting the .WEB gTLD, but that it's not its core business. The objector said that it will "be perfectly content if anyone gets .web because they are going to distribute it through [the Objector] and it [i]s [their] name and [the Objector is] advertising and building a brand in the marketplace and [is] going to be a great deliverer of .web extensions, whoever gets it; whether it's [the Objector] or someone else" (**Attachment 65**, p. 13). The Objector pointed out that its strategy has always been to cooperate and that they have

looked at the people who have applied for .web and that it is talking to all of them about who would benefit from this and which team would be the best team to provide services.

While the Objector is in contention with multiple applicants for .WEB, the Applicant is not in contention with any other applicant for .WEBS. The Objector has realized that it faces a challenge in obtaining the delegation of the .WEB extension, while the Applicant does not face a similar challenge in dealing with other applicants. With the present objection, the Objector is trying to give the Applicant the same challenge.

The Objector's sole motive in filing the objection is to prevent a potential competitor, who does not have the intention to create goodwill in the Objector's name, from entering the gTLD market. Such intent, to limit competition, is clearly contrary to the purpose of ICANN's new gTLD program.

As mentioned above, no other applicant for .WEB shared the views of the Objector as none of them were of the opinion that there were reasons to file an objection against the Applicant.

## **XII. The Objector's position is incoherent**

The Objector argues 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.

The Objector does not produce any evidence in support of this argument.

Also, how can the Objector (without any evidence) know what a non-native English speaker sees and not, or what he distinguishes and what she does not?

As mentioned above, the first and last letters of a word are in combination visual clues for a word, making words more recognizable. The way individuals recognize words is not related to being a native speaker or not, but is connected to the functioning of the human brain (**Attachment 60**).

## **XIII. The Objector's allegations are unfounded**

### **A. The comparison with UDRP cases is irrelevant for this case**

The UDRP cases referred to by the Objector are all cases between a registrant of a domain name and the holder of a trade mark.

In the present case the question whether one or both of the names is related to a trademark is irrelevant. The present case is not a case about the violation of a trademark. Even if it were, "*the mark .WEB used in relation to Internet registry services is generic and cannot enjoy trademark protection*" (See *Image Online Design, Inc. v ICANN, Case No. CV 12-08968 DDP* (US District Court of California, 7 Feb. 2013), **Attachment 66**, p. 16).

And even if UDRP cases were relevant, UDRP cases relating to generic terms contradict the findings in the cases produced by the Objector. Examples include:

- Mansion (Gibraltar) Limited and Provent Holdings Ltd. v. Agens PSC, WIPO Case No. D2010-0584 (finding that “since “casino” is a well-known generic term, small visual and sound modifications are, in this Panel’s view, very obvious and are more easily remembered by the human mind.”) (**Attachment 67**).

Tire Discounters, Inc. v. TireDiscounter.com, NAF Case No. FA0604000679485 (finding that “[b]ecause the mark is merely descriptive, small differences matter. In the Internet context, consumers are aware that domain names for different websites are often quite similar and that small differences matter. See Entrepreneur Media, Inc. v. Smith, 279 F.3d 1135, 1147 (9<sup>th</sup> Cir. 2002). The omission of the letter “s” from the mark is one of those small differences that matters in this context. Complainant has failed to meet its burden to establish that Respondent’s <tirediscounter.com> domain name is confusingly similar to Complainant’s mark within the meaning of Policy ¶4(a)(i). See Men’s Warehouse, Inc. v. Wick, FA 117861 (Nat. Arb. Forum Sept. 16, 2002).”) (**Attachment 68**)

## B. There is no (Evidence of) Actual Confusion

The evidence of actual confusion to which the Objector points is exceptionally weak given the long history of coexistence of the WEBS.COM and the WEB.COM domain names and between the Objector and the Applicant’s business. Tens of millions websites have been built with Webs and, together, these sites receive 300 million page views each month (**Attachment 1**). The Objector claims to be helping over 3 million customers with its presence on the web (**Attachment 4**).

In light of the large volume of business conducted through both the Applicant’s and Objector’s websites, minimal instances of misdirected consumer communications are “at best *de minimis*,” and the paucity of evidence of actual confusion in fact creates “a presumption against likelihood of confusion in the future.” *Petro Stopping Centers, L.P. v. James River Petroleum, Inc.*, 130 F.3d 88, 96 (4th Cir. 1997) (citations omitted) (**Attachment 69**).

The Objector does not actually provide details of any of the “abundant evidence” of actual confusion that it alleges in the Objection.

The examples of alleged actual confusion that the Objector has provided through links are examples of typographical errors, not actual confusion. The standard for actual consumer confusion requires a mental state of actual confusion as to the source of two products or services. See 3 *McCarthy on Trademarks* § 23:13 (“[E]vidence of actual confusion is the testimony of a ‘reasonably prudent purchaser’ who was in fact confused by defendant’s trademark.”) (emphasis added); *Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.*, 104 F. Supp. 2d 427, 464 (D.N.J. 2000) (same), *aff’d* 269 F.3d 270 (3d Cir. 2001). Accordingly, courts have routinely rejected typographical errors as evidence of actual confusion. See, e.g., *Heartsprings, Inc. v. HeartSpring, Inc.*, 949 F. Supp. 1539, 1545 n.4 (D. Kan. 1996) (rejecting typographical error in press release as evidence of actual confusion); *Water Pik, Inc. v. Med-Systems, Inc.*, 2012 WL 224447, at \*7 n.7 (D. Colo. Jan. 25, 2012) (rejecting typographical error in blog entry as evidence of actual confusion) (**Attachment 70-73**).



The only examples of alleged confusion for which the Objector provides citations do not evidence actual confusion. Instead, they appear to be typographical errors on the webs.com forum:

- 1) [http://support.webs.com/webs/topics/web\\_com\\_examples](http://support.webs.com/webs/topics/web_com_examples)

The headline for the topic is "[web.com](#) examples" but immediately under this, the question has the correct reference to [webs.com](#): "Is there really no way/place to see examples of real sites created on [webs.com](#)?"

This is obviously a typographical error and not genuine confusion.

- 2) [http://support.webs.com/webs/topics/can\\_dns\\_be\\_hosted\\_elsewhere\\_and\\_still\\_have\\_a\\_site\\_name\\_web\\_com\\_site\\_work](http://support.webs.com/webs/topics/can_dns_be_hosted_elsewhere_and_still_have_a_site_name_web_com_site_work)

Here the headline refers to [web.com](#) but the question underneath correctly refers to [webs.com](#). Headline: "Can DNS be hosted elsewhere, and still have a [site-name.web.com](#) site work?" Question underneath: "I do not want to transfer my domain registration to [webs.com](#) . . . Is there an IP address I can point our DNS to, to make a [webs.com](#) site work?"

This too, is plainly a typographical error, and not actual confusion.

- 3) [http://support.webs.com/webs/topics/my\\_web\\_com\\_site\\_disappeared](http://support.webs.com/webs/topics/my_web_com_site_disappeared)

Here, the customer is complaining about her '[web.com](#)' site disappearing. She is, however, a registered user of the Webs user forum, and responses to the post and subsequent user posts clearly reference Webs.

Again, this post appears to be a typographical error, not actual confusion.

Also, even if the Applicant were to accept that each of the forums that the Objector cites contained examples of individuals who were actually confused as to the source of a product or service (as opposed to someone who made a typographical error), it would underscore the tiny percentage of consumers who would be affected by that confusion.

A final example of alleged confusion is the case in which the Applicant's CEO and co-founder made a typographical error in a press release by PR.com. This typographical error was quickly corrected after discovering the mistake. Does the Objector truly believe that the Applicant's co-founder and CEO was confused about his own company name?

Finally, the fact that the Attorney General of Kentucky and the Attorney General of Arkansas would have sent a letter by mistake to web.com instead of to webs.com does not prove that the Attorneys General were confused. The Attorney General in Arkansas was provided with the incorrect address in the complaint form, filed by a non-customer. With both the Applicant and the Objector having millions of customers, the fact that only two letters were addressed to the wrong party, shows how limited the likelihood of confusion between 'webs.com' and 'web.com' is. The likelihood of confusion between .WEBS and .WEB is even more limited,

given the fact that the last letter in both words is different (which makes the difference more apparent, as shown above).

### CONCLUSION

As explained above there is no risk of confusion in the mind of the average, reasonable Internet user, nor is such risk probable. Accordingly, there is no likelihood of confusion between the strings .WEB and .WEBS such that the strings should be placed in the same contention set.

The Applicant requests that the objection be declared Unsuccessful and that the Applicant and the Objector both move forward in the process without being considered in direct contention with one another.

Respectfully submitted,



Flip Petillion, Advocaat

Authorized Representative of the Respondent

May 23, 2013

### Attachments

1. Company information on the Applicant and its subsidiary
2. Whois records of <webs.com>
3. Overview of US and non-US clients of the Applicant
4. Company information on the Objector
5. Whois records of <web.com>
6. USPTO Reg. Nos. 2521314 and 3666813
7. Objector's most recent annual report
8. Application No. 1-1033-73917 for gTLD '.webs' by the Applicant
9. Application No. 1-1033-22687 for gTLD '.webs' by the Applicant
10. Application No. 1-1009-97005 for gTLD '.web' by the Objector
11. Application for gTLD '.web' by DotWeb Inc. (AE)
12. Application for gTLD '.web' by Charleston Road Registry Inc., (US)
13. Application for gTLD '.web' by Afiliis Domains No. 3 Limited (IE)

14. Application for gTLD '.web' by Ruby Glen, LLC (US)
15. Application for gTLD '.web' by Schlund Technologies GmbH (DE)
16. Application for gTLD '.web' by NU DOT CO LLC (US)
17. Printout of the website where the String Similarity Assessment Tool is accessible via <https://icann.sword-group.com/algorithm/Default.aspx>
18. Printout of the website where the String Similarity Assessment Tool is used to compare '.webs' with '.web'
19. Printout of the website where the String Similarity Assessment Tool is used to compare .BV and .BY
20. Printout of the website where the String Similarity Assessment Tool is used to compare .BA and .BE
21. Printout of the website where the String Similarity Assessment Tool is used to compare .CU and .CV
22. Printout of the website where the String Similarity Assessment Tool is used to compare .FI and .FR
23. Printout of the website where the String Similarity Assessment Tool is used to compare .AC and .AE
24. Printout of the website where the String Similarity Assessment Tool is used to compare .AW and .AU
25. Printout of the website where the String Similarity Assessment Tool is used to compare .CM and .CN
26. Printout of the website where the String Similarity Assessment Tool is used to compare .CU and .CV
27. Printout of the website where the String Similarity Assessment Tool is used to compare .CV and .CY
28. Printout of the website where the String Similarity Assessment Tool is used to compare .GM and .GN
29. Printout of the website where the String Similarity Assessment Tool is used to compare .TL and .TJ
30. Printout of the website where the String Similarity Assessment Tool is used to compare .IL and .IT
31. Printout of the website where the String Similarity Assessment Tool is used to compare .LU and .LV
32. Printout of the website where the String Similarity Assessment Tool is used to compare .LV and .LY
33. Printout of the website where the String Similarity Assessment Tool is used to compare .PK and .PH
34. Printout of the website where the String Similarity Assessment Tool is used to compare .MV and .MW
35. Printout of the website where the String Similarity Assessment Tool is used to compare .EC and .EE
36. Printout of the website where the String Similarity Assessment Tool is used to compare .IT and .TL
37. Printout of the website where the String Similarity Assessment Tool is used to compare .BI and .BJ
38. Printout of the website where the String Similarity Assessment Tool is used to compare .AI and .AL
39. Printout of the website where the String Similarity Assessment Tool is used to compare .GI and .GL
40. Printout of the website where the String Similarity Assessment Tool is used to compare .LT and .IT

41. Printout of the website where the String Similarity Assessment Tool is used to compare .ME and .MF (UC)
42. Printout of the website where the String Similarity Assessment Tool is used to compare .BE and .BF (UC)
43. Printout of the website where the String Similarity Assessment Tool is used to compare .FI and .FJ
44. Printout of the website where the String Similarity Assessment Tool is used to compare .IO and .JO
45. Printout of the website where the String Similarity Assessment Tool is used to compare .IE and .JE
46. Printout of the website where the String Similarity Assessment Tool is used to compare .SI and .SJ
47. Printout of the website where the String Similarity Assessment Tool is used to compare .SL and .LS
48. Printout of the website where the String Similarity Assessment Tool is used to compare .AU and .UA
49. Printout of the website where the String Similarity Assessment Tool is used to compare .ES and .SE
50. Printout of the website where the String Similarity Assessment Tool is used to compare .TP and .PT
51. Printout of the website where the String Similarity Assessment Tool is used to compare .TG and .GT
52. Printout of the website where the String Similarity Assessment Tool is used to compare .IO and .IQ (UC)
53. Printout of the website where the String Similarity Assessment Tool is used to compare .LT and .TL
54. Printout of the website where the String Similarity Assessment Tool is used to compare .IL and .LI
55. List of all currently existing TLDs, as delegated by IANA
56. Printout of the website where the String Similarity Assessment Tool is used to compare .ACCOUNTANTS and .ACCOUNTANT
57. Printout of the website where the String Similarity Assessment Tool is used to compare .COUPONS and .COUPON
58. Printout of the website with ICANN contention sets for exact and non-exact matches
59. Supplemental Consent to Registration of the Objector with Verio
60. Expert opinion by Professor Dr. Piet Desmet
61. OHIM document on confusion
62. Dictionary meaning of 'web'
63. Wikipedia on 'webs'
64. Wikipedia on 'web'
65. Transcript of Q1 2013 Web.com Group Inc. Earnings Conference Call
66. *Image Online Design, Inc. v ICANN, Case No. CV 12-08968 DDP* (US District Court of California, 7 Feb. 2013)
67. *Mansion (Gibraltar) Limited and Provent Holdings Ltd. v. Agens PSC, WIPO Case No. D2010-0584*
68. *Tire Discounters, Inc. v. TireDiscounter.com, NAF Case No. FA0604000679485*
69. *Petro Stopping Centers, L.P. v. James River Petroleum, Inc.*, 130 F.3d 88, 96 (4th Cir. 1997)
70. *Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.*, 104 F. Supp. 2d 427, 464 (D.N.J. 2000)
71. *Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.*, 269 F.3d 270 (3d Cir. 2001)

72. *Heartsprings, Inc. v. Heartspring, Inc.*, 949 F. Supp. 1539, 1545 n.4 (D. Kan. 1996)
73. *Water Pik, Inc. v. Med-Systems, Inc.*, 2012 WL 224447, at \*7 n.7 (D. Colo. Jan. 25, 2012)
74. Proof of payment of filing fee.

**Janssen, Jan**

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**From:** Nelissen, Mariet on behalf of Petillion, Flip  
**Sent:** jeudi 23 mai 2013 16:06  
**To:** Tom Simotas  
**Cc:** Contact Information Redacted  
**Subject:** 50 504 T 00221 13 - Response (mail 1 of 4)  
**Attachments:** 3109179\_.WEBS (case 50 504 T 00221 13) Response.PDF

<b>Tracking:</b>	<b>Recipient</b>	<b>Delivery</b>	<b>Read</b>
	Tom Simotas Contact Information Redacted		
	Petillion, Flip	Delivered: 23/05/2013 16:06	Read: 23/05/2013 16:14
	Janssen, Jan	Delivered: 23/05/2013 16:06	Read: 23/05/2013 16:09

Dear Madam,  
Dear Sir,

Please find attached the Response in case number 50 504 T 00221 13. The Annexes will be sent in three separate mails.

Yours sincerely,

Flip Petillion

**Flip Petillion**  
Partner  
Contact Information Redacted

**Crowell & Moring LLP** | [www.crowell.com](http://www.crowell.com)

Contact Information Redacted

## Janssen, Jan

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**From:** Tom Simotas      Contact Information Redacted  
**To:** Nelissen, Mariet  
**Sent:** jeudi 23 mai 2013 16:06  
**Subject:** Read: 50 504 T 00221 13 - Response (mail 1 of 4)

Your message

To:  
Subject: 50 504 T 00221 13 - Response (mail 1 of 4)  
Sent: Thursday, May 23, 2013 10:06:30 AM (UTC-05:00) Eastern Time (US & Canada)

was read on Thursday, May 23, 2013 10:06:25 AM (UTC-05:00) Eastern Time (US & Canada).






**gTLD RESPONSE TO STRING CONFUSION OBJECTION**

The named Applicant hereby submits the following response to the objection filed by Web.com Group, Inc. for resolution, under the rules of the NEW gTLD Dispute Resolution Procedures. This document and associated submissions were sent to the following addresses : Contact Information Redacted  
Contact Information Redacted

As required, USD 2,750 were paid to ICDR on 8 May 2013. Evidence of the payment is attached for information. (**Attachment 74**)

**Rules and Procedures:** NEW gTLD Dispute Resolution Procedures/ICDR Supplementary Procedures for String Confusion Objections

**Party Information**

Name of Applicant:  Vistaprint Limited	Name of Objector:  Web.com Group, Inc.
Address: Contact Information Redacted	Address: Contact Information Redacted
City, State/Province, Country, Postal Code: Contact Information Redacted	City, State/Province, Country, Postal Code: Contact Information Redacted
Telephone:                      Email Address: Contact Information Redacted	Telephone:                      Email Address: Contact Information Redacted
Name of Applicant's Attorney or Representative:  Flip Petillion	Name of Objector's Attorney or Representative:  Steven C. Sereboff
Name of Firm (if applicable):  Crowell & Moring	Name of Firm (if applicable):  SoCal IP Law Group LLP
Address: Contact Information Redacted	Address: Contact Information Redacted
City, State/Province, Country, Postal Code: Contact Information Redacted	City, State/Province, Country, Postal Code: Contact Information Redacted
Telephone:                      Email Address: Contact Information Redacted	Telephone:                      Email Address: Contact Information Redacted
Signature:   Attorney-at-law, 23 May 2013	

## I. The Parties

### A. The Applicant

Through its subsidiary, Webs Inc., the Applicant (also Respondent) provides free website creation tools and hosting services. Additional paid features are offered (Attachment 1).

At present, the Applicant conducts its business using a website that is accessible via the domain name 'webs.com'. The 'webs.com' domain name was registered on April 4, 1995 (Attachment 2).

'Webs' is the mark under which the Applicant brands its products and services.

Webs' clients are predominantly non-US clients (54% non-US, 46% US) (Attachment 3).

### B. The Objector

The Objector primarily provides web site development services to small and medium businesses and conducts its business using a website that is accessible via the domain name 'web.com' (Attachment 4). The 'web.com' domain name was registered on July 2, 1996 (Attachment 5).

The Objector uses the mark 'Web.com' for which it has two U.S. trademark registrations (Attachment 6).

Web.com's clients are primarily US based (Attachment 7).

## II. Factual background

### A. The Objector and the Applicant have co-existed for many years without any problem

#### 1. The WEBS.COM and WEB.COM domain names have been used and coexisting in the market for many years

The 'webs.com' domain name was created on April 5, 1995 (Attachment 2), more than a year before the creation of the 'web.com' domain name on July 2, 1996 (Attachment 5).

Both 'webs.com' and 'web.com' domain names have been used simultaneously for more than 16 years. The two domain names have co-existed, and significant and distinct businesses have thrived under these separate names, with each business possessing its own independent identity and goodwill.

#### 2. The Parties have never initiated any case against each other

Neither the Applicant nor the Objector have ever litigated over the others use of their respective mark and domain name.

3. **The Applicant's use of the WEBS.COM domain name has never been the subject of any lawsuit**

The Applicant's use of the 'webs.com' domain name has never been questioned by a party in court or in a UDRP case.

4. **The Objector's use of the WEB.COM domain name has never been the subject of any law suit**

In so far as the Applicant is aware, the Objector's use of the WEB.COM domain name has never been questioned by a party in court or in a UDRP proceeding.

- B. Both the Applicant and the Objector have filed an application for a new generic Top Level Domain**

The Applicant has applied for the string .WEBS (standard and community application) with a view to consolidating the reputation of the Applicant's website creation tools and hosting services, known under the identifier 'WEBS' and the community it represents. The use of the 'WEBS' identifier is aimed at making it unambiguous that the TLD is related to the Applicant (**Attachments 8 and 9**)

The Objector has applied for the string .WEB (**Attachment 10**).

- C. There are 7 applicants for .WEB**

There are 7 applicants for .WEB. Apart from the Objector, an application for .WEB was filed by DotWeb Inc. (AE), Charleston Road Registry Inc., (US), Afiliias Domains No. 3 Limited (IE), Ruby Glen, LLC (US), Schlund Technologies GmbH (DE), and NU DOT CO LLC (US) (**Attachment 11-16**).

No other party applied for .WEBS.

- D. The other applicants for .WEB have not filed a string confusion objection**

None of the other 6 applicants for .WEB has filed an objection against the Applicant. It is fair to deduce from this that these applicants either do not share the grounds for the objection filed by the Objector and/or that they did not deem it appropriate to file such an objection on these or other grounds.

### III. The purpose of ICANN's new gTLD program and the limited grounds for objection

On 12 January 2012, ICANN launched its new Generic Top-Level Domain (gTLD or TLD) program, with the goal of "enhancing competition[,] consumer choice[,] . . . [and] innovation via the introduction of new gTLDs."<sup>1</sup> The Applicant filed its application for the string .WEBS, which it intends to use in connection with its free website creation and hosting business. The applied-for .WEBS gTLD will increase competition and benefit Internet users by providing new and different services within an expanded DNS, and thus enhance the goals of ICANN's new gTLD program.<sup>2</sup>

ICANN designed the objection process to protect certain legitimate rights, while also ensuring that objectors could not prevent the delegation of legitimate TLDs. Objections are only permitted on the four specific grounds enumerated in the Guidebook: string confusion, legal rights, community opposition, and limited public interest.<sup>3</sup> Any objection outside these narrow grounds must fail.

Accordingly, it is important to apply the criteria as written, and not in an overbroad way that unnecessarily interferes with the delegation of the applied-for TLD. The Applicant will show that 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.

The Applicant will also show that the objection is not only contrary to the purpose of ICANN's new gTLD program, but also fails to meet the stringent criteria of a legal rights objection.

### IV. The task of the panel expert

#### A. The relevant criterion

The applicable rule has been provided in the AGB, Section 3.5.1. which reads as follows:

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

The Applicant wishes to point out that the Objector omitted the last sentence when referring to AGB, Section 3.5.1. (Objection, p. 3). However, as will be demonstrated below, this sentence is quite relevant for this case.

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<sup>1</sup> About the Program: ICANN New gTLDs, available at <http://newgtlds.icann.org/en/about/program>.

<sup>2</sup> About the Program: ICANN New gTLDs, available at <http://newgtlds.icann.org/en/about/program> ("The program's goals include enhancing competition and consumer choice, and enabling the benefits of innovation via the introduction of new gTLDs.").

<sup>3</sup> *Id.*, Module 3.2.1.

## B. Difference with the task of the String Similarity Panel

The evaluation undertaken by the Expert Panel is different from that assigned by ICANN to the String Similarity Panel in the Initial Evaluation.

### 1. The task of the String Similarity Panel

The String Similarity Panel was assigned the task of determining contention sets. The String Similarity Panel was asked to review the entire pool of applied-for strings to determine whether the strings proposed in any two or more applications were so similar that they would create a probability of user confusion if allowed to coexist in the DNS. (AGB, Module 4-3)

The criterion to be used by the String Similarity Panel is defined in the Applicant Guidebook which states:

*“Contention sets are groups of applications containing identical or similar applied-for gTLD strings.”*

[...]

*“‘similar’ means strings so similar that they create a probability of user confusion if more than one of the strings is delegated into the root zone.*

[...]

*The String Similarity Panel will [...] review the entire pool of applied-for strings to determine whether the strings proposed in any two or more applications are so similar that they would create a probability of user confusion if allowed to coexist in the DNS. The panel will make such a determination for each pair of applied-for gTLD strings. The outcome of the String Similarity review described in Module 2 is the identification of contention sets among applications that have direct or indirect contention relationships with one another.*

*Two strings are in direct contention if they are identical or similar to one another.*

[...]

*Two strings are in indirect contention if they are both in direct contention with a third string, but not with one another.” (AGB, Module 4-2, 4-3)*

Module 2 of the Applicant Guidebook also states:

**“Standard for String Confusion** – *String confusion exists where a string so nearly resembles another **visually** 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.” (AGB, Module 2-8)*

## 2. The task of the Expert Panel

The Applicant Guidebook provides in Module 2 that – in contrast with the determination by the String Similarity Panel – a String Confusion Objection brought before an Expert Panel:

“...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.” (AGB, Module 2-8).

### V. ICANN and its String Similarity Panel do not consider the strings to be confusingly similar

#### A. ICANN's String Similarity Assessment Tool provides a low similarity rate

In the application period for new gTLDs, ICANN had made accessible a String Similarity Assessment Tool. It is still accessible on <https://icann.sword-group.com/algorithm/Default.aspx>. (**Attachment 17**)

According to the information published on this website, this tool “*is intended to provide an **open, objective, and predictable mechanism** for assessing the degree of **visual similarity** between TLD strings.*”

It allows for the comparison of two strings to each other.

When comparing .WEBS with .WEB, the similarity rate is 72% (**Attachment 18**) which is much lower than the similarity rate of various TLDs that currently co-exist (**Attachments 19-55**). *E.g.*, the currently co-existing .LT and .TL strings and .IL and .LI are respectively 93% and 94% similar (**Attachments 53-54**).

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 (**Attachments 56-57**). The applicants for these strings did not file a string confusion objection.

Internet users have become used to the existence of TLDs having much more similarity than the claimed similarity between .WEBS and .WEB. For instance, with a similarity rate of 83%, .IO and .JO are considered visually more similar (**Attachment 44**). Also, in certain languages, from an aural perspective, .IO is virtually identical to .JO. From a conceptual point of view, .IO and .JO are as meaningful, or rather equally meaningless. Nonetheless, this poses no problem for the average Internet user, who is used to small differences between TLDs.

#### B. ICANN has not put the applications for .WEBS and .WEB in a contention set

As mentioned above, in the Initial Evaluation, ICANN assigned a panel called the String Similarity Panel with the task to determine contention sets: The String Similarity Panel was asked to review the entire pool of applied-for strings to determine whether the strings

proposed in any two or more applications were so similar that they would create a probability of user confusion if allowed to coexist in the DNS (AGB, Module 4-3).

The outcome of this assignment was that two contention sets of non-exact matches were created: the set containing .HOTELS and .HOTEIS strings and the set containing the .UNICOM and .UNICORN strings (**Attachment 58**).

No other contention sets for non-exact matches in Latin script were created.

This shows that 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.

## **VI. The Objector does not consider WEBS and WEB to be confusingly similar**

### **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.

### **B. The Objector never formally challenged the co-existence between the WEBS.COM and WEB.COM domain names**

The Objector has never instituted a formal challenge to the WEBS.COM domain name, which co-exists with the Objector’s WEB.COM domain name for years. Whereas 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 .

## VII. There is no overall similarity

The 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.

The Applicant asked an independent expert to provide his views on the following questions:

- 1) Regardless of the ICANN framework, would you consider both strings to be confusing?
- 2) Given the ICANN framework, would you consider both strings confusing based on any of the following types of similarity: visual, aural or similarity of meaning?

The expert to whom this request was addressed, Professor Piet Desmet, is full professor at the University of Leuven in linguistics and language teaching methodology ([Attachment 60](#)).

Professor Desmet from the University of Leuven has made the following findings:

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

Professor Desmet concludes that 'webs' and 'web' are recognized as two radically different words since their last letters are completely different.

2. 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.

Professor Desmet considers that 'webs' and 'web' have completely regular patterns allowing for one-to-one mapping of spelling to sound, which highly facilitates the word recognition of both words.

3. Third, there 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 evidenced by eye-fixation patterns. Words with fewer orthographic neighbors are more easily recognizable.



Professor Desmet concludes that this results in a higher word recognition for 'webs' and 'web' which have a limited number of orthographic neighbors.

4. Fourth, 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.

For professor Desmet, this is an extra factor that enhances the ability to recognize the difference between 'web' and 'webs'.

5. Also, the plural '-s' is a completely regular plural and easily recognizable compared to irregular plurals (e.g. with vowel change such as 'hero'/'heroes') that have been proven to be less easily recognizable.

In conclusion, Professor Desmet considers the 5 elements above reason enough to dismiss the idea of string confusion in the case of 'webs'/'web'.

### **VIII. The strings are visually different**

The two strings .WEBS and .WEB are visually distinct.

A number of different trademark offices provide guidance on how to interpret confusion. For example, the European Union Trade Mark Office provides guidance on how to interpret confusion. Its *Manual concerning opposition* was used by the GNSO<sup>4</sup> when it suggested language for the Applicant Guidebook of ICANN. The Manual lays down a couple of relevant principles that apply in the case at instance:

*"The visual comparison is based on an analysis of the number and sequence of the letters, the number of words and the structure of the signs." (Attachment 61, p. 10, section 3.2)*

*"The length of a name may influence the effect of differences. The shorter a name, the more easily the public is able to perceive all its single elements. Thus, small differences may frequently lead in short words to a different overall impression. In contrast, the public is less aware of differences between long names." (Attachment 61, p. 22, section 4.2)*

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. This is confirmed by the findings of Professor Desmet mentioned above.

The difference is sufficiently clear not to cause any confusion, mistake or deception, as is made clear by the longstanding coexistence between the domain names WEBS.COM and WEB.COM.

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<sup>4</sup> ICANN's Generic Names Supporting Organization ; see <http://gnso.icann.org/en/>

**IX. The strings are aurally different**

Also aurally, the strings are different. As evidenced by the findings of Professor Desmet, both '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.

Indeed, the sound of the letter 's' is clearly stressed in 'webs' and is not present in the word 'web'. Individuals are perfectly capable of distinguishing the sound that is generated by adding the letter 's' to a word with similar endings as the word 'web'. *E.g.*, individuals are perfectly capable of distinguishing 'step' from 'steps', 'car' from 'cars' or 'sales rep' from 'sales reps'.

Hence, also from an aural perspective, 'webs' is clearly different and distinguishable from 'web'.

**X. The strings have a different meaning**

The strings have a different meaning. 'Web' refers to the world wide web or to a network or silken structure created by a spider (**Attachment 62**), 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 (**Attachment 63**). 'Web' on the other hand has a clear dictionary meaning (**Attachment 64**).

In any event, as mentioned above, the Applicant Guidebook expressly provides that mere association, in the sense that the string brings another string to mind, is insufficient to find a likelihood of confusion (AGB, Section 3.5.1.).

As also explained above, the mission and purpose of the Applicant .WEBS gTLD is to consolidate the reputation of the Applicant's hosting services, known under the identifier 'WEBS' and the community it represents and to ensure that the .WEBS top-level domain will be unambiguous as regards the identity of the Registry Operator.

This purpose is in diametric opposition to the mission and purpose of the Objector's .WEB gTLD, which is to "become the most versatile gTLD on the World Wide Web" and to "quickly become as ubiquitous" and to "serve everyone, from commerce to information to community-building" (**Attachment 10**, response to evaluation question 18).

As a result, the services offered under .WEBS and .WEB will clearly distinguish themselves.

**XI. The real objective of the Objector**

During the Objector's first quarter 2013 earnings conference call, the Objector stated that it is certainly interested in getting the .WEB gTLD, but that it's not its core business. The objector said that it will "*be perfectly content if anyone gets .web because they are going to distribute it through [the Objector] and it [i]s [their] name and [the Objector is] advertising and building a brand in the marketplace and [is] going to be a great deliverer of .web extensions, whoever gets it; whether it's [the Objector] or someone else*" (**Attachment 65**, p. 13). The Objector pointed out that its strategy has always been to cooperate and that they have looked at the people who have applied for .web and that it is talking to all of them about who would benefit from this and which team would be the best team to provide services.

While the Objector is in contention with multiple applicants for .WEB, the Applicant is not in contention with any other applicant for .WEBS. The Objector has realized that it faces a challenge in obtaining the delegation of the .WEB extension, while the Applicant does not face a similar challenge in dealing with other applicants. With the present objection, the Objector is trying to give the Applicant the same challenge.

The Objector's sole motive in filing the objection is to prevent a potential competitor, who does not have the intention to create goodwill in the Objector's name, from entering the gTLD market. Such intent, to limit competition, is clearly contrary to the purpose of ICANN's new gTLD program.

As mentioned above, no other applicant for .WEB shared the views of the Objector as none of them were of the opinion that there were reasons to file an objection against the Applicant.

**XII. The Objector's position is incoherent**

The Objector argues 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.

The Objector does not produce any evidence in support of this argument.

Also, how can the Objector (without any evidence) know what a non-native English speaker sees and not, or what he distinguishes and what she does not?

As mentioned above, the first and last letters of a word are in combination visual clues for a word, making words more recognizable. The way individuals recognize words is not related to being a native speaker or not, but is connected to the functioning of the human brain (**Attachment 60**).

**XIII. The Objector's allegations are unfounded****A. The comparison with UDRP cases is irrelevant for this case**

The UDRP cases referred to by the Objector are all cases between a registrant of a domain name and the holder of a trade mark.

In the present case the question whether one or both of the names is related to a trademark is irrelevant. The present case is not a case about the violation of a trademark. Even if it were, *"the mark .WEB used in relation to Internet registry services is generic and cannot enjoy trademark protection"* (See *Image Online Design, Inc. v ICANN*, Case No. CV 12-08968 DDP (US District Court of California, 7 Feb. 2013), **Attachment 66**, p. 16).

And even if UDRP cases were relevant, UDRP cases relating to generic terms contradict the findings in the cases produced by the Objector. Examples include:

- *Mansion (Gibraltar) Limited and Provent Holdings Ltd. v. Agens PSC*, WIPO Case No. D2010-0584 (finding that *"since "casino" is a well-known generic term, small visual and sound modifications are, in this Panel's view, very obvious and are more easily remembered by the human mind."*) (**Attachment 67**).

*Tire Discounters, Inc. v. TireDiscounter.com*, NAF Case No. FA0604000679485 (finding that *"[b]ecause the mark is merely descriptive, small differences matter. In the Internet context, consumers are aware that domain names for different websites are often quite similar and that small differences matter. See Entrepreneur Media, Inc. v. Smith, 279 F.3d 1135, 1147 (9<sup>th</sup> Cir. 2002). The omission of the letter "s" from the mark is one of those small differences that matters in this context. Complainant has failed to meet its burden to establish that Respondent's <tirediscounter.com> domain name is confusingly similar to Complainant's mark within the meaning of Policy ¶4(a)(i). See Men's Warehouse, Inc. v. Wick, FA 117861 (Nat. Arb. Forum Sept. 16, 2002)." (Attachment 68)*

## B. There is no (Evidence of) Actual Confusion

The evidence of actual confusion to which the Objector points is exceptionally weak given the long history of coexistence of the WEBS.COM and the WEB.COM domain names and between the Objector and the Applicant's business. Tens of millions websites have been built with Webs and, together, these sites receive 300 million page views each month (**Attachment 1**). The Objector claims to be helping over 3 million customers with its presence on the web (**Attachment 4**).

In light of the large volume of business conducted through both the Applicant's and Objector's websites, minimal instances of misdirected consumer communications are "at best *de minimis*," and the paucity of evidence of actual confusion in fact creates "a presumption against likelihood of confusion in the future." *Petro Stopping Centers, L.P. v. James River Petroleum, Inc.*, 130 F.3d 88, 96 (4th Cir. 1997) (citations omitted) (**Attachment 69**).

The Objector does not actually provide details of any of the "abundant evidence" of actual confusion that it alleges in the Objection.

The examples of alleged actual confusion that the Objector has provided through links are examples of typographical errors, not actual confusion. The standard for actual consumer confusion requires a mental state of actual confusion as to the source of two products or services. See 3 *McCarthy on Trademarks* § 23:13 ("[E]vidence of actual confusion is the testimony of a 'reasonably prudent purchaser' who was in fact confused by defendant's trademark.") (emphasis added); *Checkpoint Systems, Inc. v. Check Point Software*

*Technologies, Inc.*, 104 F. Supp. 2d 427, 464 (D.N.J. 2000) (same), *aff'd* 269 F.3d 270 (3d Cir. 2001). Accordingly, courts have routinely rejected typographical errors as evidence of actual confusion. See, e.g., *Heartsprings, Inc. v. HeartSpring, Inc.*, 949 F. Supp. 1539, 1545 n.4 (D. Kan. 1996) (rejecting typographical error in press release as evidence of actual confusion); *Water Pik, Inc. v. Med-Systems, Inc.*, 2012 WL 224447, at \*7 n.7 (D. Colo. Jan. 25, 2012) (rejecting typographical error in blog entry as evidence of actual confusion) (**Attachment 70-73**).

The only examples of alleged confusion for which the Objector provides citations do not evidence actual confusion. Instead, they appear to be typographical errors on the webs.com forum:

- 1) [http://support.webs.com/webs/topics/web\\_com\\_examples](http://support.webs.com/webs/topics/web_com_examples)

The headline for the topic is "[web.com](#) examples" but immediately under this, the question has the correct reference to [webs.com](#): "Is there really no way/place to see examples of real sites created on [webs.com](#)?"

This is obviously a typographical error and not genuine confusion.

- 2) [http://support.webs.com/webs/topics/can\\_dns\\_be\\_hosted\\_elsewhere\\_and\\_still\\_have\\_a\\_site\\_name\\_web\\_com\\_site\\_work](http://support.webs.com/webs/topics/can_dns_be_hosted_elsewhere_and_still_have_a_site_name_web_com_site_work)

Here the headline refers to [web.com](#) but the question underneath correctly refers to [webs.com](#). Headline: "Can DNS be hosted elsewhere, and still have a [site-name.web.com](#) site work?" Question underneath: "I do not want to transfer my domain registration to [webs.com](#) . . . Is there an IP address I can point our DNS to, to make a [webs.com](#) site work?"

This too, is plainly a typographical error, and not actual confusion.

- 3) [http://support.webs.com/webs/topics/my\\_web\\_com\\_site\\_disappeared](http://support.webs.com/webs/topics/my_web_com_site_disappeared)

Here, the customer is complaining about her '[web.com](#)' site disappearing. She is, however, a registered user of the Webs user forum, and responses to the post and subsequent user posts clearly reference Webs.

Again, this post appears to be a typographical error, not actual confusion.

Also, even if the Applicant were to accept that each of the forums that the Objector cites contained examples of individuals who were actually confused as to the source of a product or service (as opposed to someone who made a typographical error), it would underscore the tiny percentage of consumers who would be affected by that confusion.

A final example of alleged confusion is the case in which the Applicant's CEO and co-founder made a typographical error in a press release by PR.com. This typographical error was quickly corrected after discovering the mistake. Does the Objector truly believe that the Applicant's co-founder and CEO was confused about his own company name?

Finally, the fact that the Attorney General of Kentucky and the Attorney General of Arkansas would have sent a letter by mistake to web.com instead of to webs.com does not prove that the Attorneys General were confused. The Attorney General in Arkansas was provided with the incorrect address in the complaint form, filed by a non-customer. With both the Applicant and the Objector having millions of customers, the fact that only two letters were addressed to the wrong party, shows how limited the likelihood of confusion between 'webs.com' and 'web.com' is. The likelihood of confusion between .WEBS and .WEB is even more limited, given the fact that the last letter in both words is different (which makes the difference more apparent, as shown above).

### CONCLUSION

As explained above there is no risk of confusion in the mind of the average, reasonable Internet user, nor is such risk probable. Accordingly, there is no likelihood of confusion between the strings .WEB and .WEBS such that the strings should be placed in the same contention set.

The Applicant requests that the objection be declared Unsuccessful and that the Applicant and the Objector both move forward in the process without being considered in direct contention with one another.

Respectfully submitted,



Flip Petillion, Advocaat

Authorized Representative of the Respondent

May 23, 2013

### Attachments

1. Company information on the Applicant and its subsidiary
2. Whois records of <webs.com>
3. Overview of US and non-US clients of the Applicant
4. Company information on the Objector
5. Whois records of <web.com>
6. USPTO Reg. Nos. 2521314 and 3666813

7. Objector's most recent annual report
8. Application No. 1-1033-73917 for gTLD '.webs' by the Applicant
9. Application No. 1-1033-22687 for gTLD '.webs' by the Applicant
10. Application No. 1-1009-97005 for gTLD '.web' by the Objector
11. Application for gTLD '.web' by DotWeb Inc. (AE)
12. Application for gTLD '.web' by Charleston Road Registry Inc., (US)
13. Application for gTLD '.web' by Afilias Domains No. 3 Limited (IE)
14. Application for gTLD '.web' by Ruby Glen, LLC (US)
15. Application for gTLD '.web' by Schlund Technologies GmbH (DE)
16. Application for gTLD '.web' by NU DOT CO LLC (US)
17. Printout of the website where the String Similarity Assessment Tool is accessible via <https://icann.sword-group.com/algorithm/Default.aspx>
18. Printout of the website where the String Similarity Assessment Tool is used to compare '.webs' with '.web'
19. Printout of the website where the String Similarity Assessment Tool is used to compare .BV and .BY
20. Printout of the website where the String Similarity Assessment Tool is used to compare .BA and .BE
21. Printout of the website where the String Similarity Assessment Tool is used to compare .CU and .CV
22. Printout of the website where the String Similarity Assessment Tool is used to compare .FI and .FR
23. Printout of the website where the String Similarity Assessment Tool is used to compare .AC and .AE
24. Printout of the website where the String Similarity Assessment Tool is used to compare .AW and .AU
25. Printout of the website where the String Similarity Assessment Tool is used to compare .CM and .CN
26. Printout of the website where the String Similarity Assessment Tool is used to compare .CU and .CV
27. Printout of the website where the String Similarity Assessment Tool is used to compare .CV and .CY
28. Printout of the website where the String Similarity Assessment Tool is used to compare .GM and .GN
29. Printout of the website where the String Similarity Assessment Tool is used to compare .TL and .TJ
30. Printout of the website where the String Similarity Assessment Tool is used to compare .IL and .IT
31. Printout of the website where the String Similarity Assessment Tool is used to compare .LU and .LV
32. Printout of the website where the String Similarity Assessment Tool is used to compare .LV and .LY
33. Printout of the website where the String Similarity Assessment Tool is used to compare .PK and .PH
34. Printout of the website where the String Similarity Assessment Tool is used to compare .MV and .MW
35. Printout of the website where the String Similarity Assessment Tool is used to compare .EC and .EE
36. Printout of the website where the String Similarity Assessment Tool is used to compare .IT and .TL
37. Printout of the website where the String Similarity Assessment Tool is used to compare .Bl and .BJ

38. Printout of the website where the String Similarity Assessment Tool is used to compare .AI and .AL
39. Printout of the website where the String Similarity Assessment Tool is used to compare .GI and .GL
40. Printout of the website where the String Similarity Assessment Tool is used to compare .LT and .IT
41. Printout of the website where the String Similarity Assessment Tool is used to compare .ME and .MF (UC)
42. Printout of the website where the String Similarity Assessment Tool is used to compare .BE and .BF (UC)
43. Printout of the website where the String Similarity Assessment Tool is used to compare .FI and .FJ
44. Printout of the website where the String Similarity Assessment Tool is used to compare .IO and .JO
45. Printout of the website where the String Similarity Assessment Tool is used to compare .IE and .JE
46. Printout of the website where the String Similarity Assessment Tool is used to compare .SI and .SJ
47. Printout of the website where the String Similarity Assessment Tool is used to compare .SL and .LS
48. Printout of the website where the String Similarity Assessment Tool is used to compare .AU and .UA
49. Printout of the website where the String Similarity Assessment Tool is used to compare .ES and .SE
50. Printout of the website where the String Similarity Assessment Tool is used to compare .TP and .PT
51. Printout of the website where the String Similarity Assessment Tool is used to compare .TG and .GT
52. Printout of the website where the String Similarity Assessment Tool is used to compare .IO and .IQ (UC)
53. Printout of the website where the String Similarity Assessment Tool is used to compare .LT and .TL
54. Printout of the website where the String Similarity Assessment Tool is used to compare .IL and .LI
55. List of all currently existing TLDs, as delegated by IANA
56. Printout of the website where the String Similarity Assessment Tool is used to compare .ACCOUNTANTS and .ACCOUNTANT
57. Printout of the website where the String Similarity Assessment Tool is used to compare .COUPONS and .COUPON
58. Printout of the website with ICANN contention sets for exact and non-exact matches
59. Supplemental Consent to Registration of the Objector with Verio
60. Expert opinion by Professor Dr. Piet Desmet
61. OHIM document on confusion
62. Dictionary meaning of 'web'
63. Wikipedia on 'webs'
64. Wikipedia on 'web'
65. Transcript of Q1 2013 Web.com Group Inc. Earnings Conference Call
66. Image Online Design, Inc. v ICANN, Case No. CV 12-08968 DDP (US District Court of California, 7 Feb. 2013)
67. Mansion (Gibraltar) Limited and Provent Holdings Ltd. v. Agens PSC, WIPO Case No. D2010-0584
68. Tire Discounters, Inc. v. TireDiscounter.com, NAF Case No. FA0604000679485



69. *Petro Stopping Centers, L.P. v. James River Petroleum, Inc.*, 130 F.3d 88, 96 (4th Cir. 1997)
70. *Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.*, 104 F. Supp. 2d 427, 464 (D.N.J. 2000)
71. *Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.*, 269 F.3d 270 (3d Cir. 2001)
72. *Heartsprings, Inc. v. Heartspring, Inc.*, 949 F. Supp. 1539, 1545 n.4 (D. Kan. 1996)
73. *Water Pik, Inc. v. Med-Systems, Inc.*, 2012 WL 224447, at \*7 n.7 (D. Colo. Jan. 25, 2012)
74. Proof of payment of filing fee.

**Janssen, Jan**

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**From:** Microsoft Outlook  
**To:** Tom Simotas; Contact Information Redacted  
**Sent:** jeudi 23 mai 2013 16:10  
**Subject:** Relayed: 50 504 T 00246 13 - Response (mail 1 of 4)

**Delivery to these recipients or groups is complete, but no delivery notification was sent by the destination server:**

Contact Information Redacted

Subject: 50 504 T 00246 13 - Response (mail 1 of 4)

**Janssen, Jan**

---

**From:** Microsoft Outlook  
**To:** Tom Simotas; Contact Information Redacted  
**Sent:** jeudi 23 mai 2013 16:14  
**Subject:** Relayed: 50 504 T 00246 13 - Response (mail 3 of 4)

**Delivery to these recipients or groups is complete, but no delivery notification was sent by the destination server:**

Contact Information Redacted

Subject: 50 504 T 00246 13 - Response (mail 3 of 4)

# **Annex 3.**



INTERNATIONAL CENTRE  
FOR DISPUTE RESOLUTION®

Thomas Ventrone  
Vice President

1633 Broadway, 10th Floor, New York, NY 10019  
telephone: 212-484-4181 facsimile: 212-246-7274  
internet: <http://www.adr.org/ICDR>

May 31, 2013

Via Email

Steven Sereboff, Esq.  
SoCal IP Law Group, L.L.P.  
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

*A Division of the American Arbitration Association*

# **Annex 4.**



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 Information Redacted

Cc: Steve Y. Koh, Esq.



# **Annex 5.**

---

**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

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# **Annex 6.**

Contact Information Redacted

**From:** Tom Simotas  
**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

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# **Annex 7.**

**From:** Tom Simotas Contact Information Redacted  
**Sent:** mardi 1 octobre 2013 18:06  
**To:** Pettillion, Flip; Steve Sereboff  
**Cc:** 'Koh, Steve Y. (Perkins Cole)'; 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

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# **Annex 8.**



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**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

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# **Annex 9.**

Contact Information Redacted

**From:** Steve Serreboff

**Sent:** Thursday, October 24, 2013 2:15 AM

**To:** Tom Simolas

**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/

Contact Information Redacted

# **Annex 10.**

## Nelissen, Mariet

---

**From:** Petillion, Flip  
**Sent:** mercredi 30 octobre 2013 20:13  
**To:** Tom Simotas  
**Cc:** Contact Information Redacted  
**Subject:** FW: Cases 50-504-I-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 11.**

**From:** Tom Simotas [mailto:SimotasAt@adr.org]  
**Sent:** lundi 4 novembre 2013 17:42  
**To:** Petillion, Flip; JSereboff@socalip.com  
**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**

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# **Annex 12.**

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**Janssen, Jan**

**From:** Petillion, Flip  
**Sent:** mardi 5 novembre 2013 18:32  
**To:** Tom Simotas; Contact Information Redacted  
**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      Contact Information Redacted  
**Sent:** lundi 4 novembre 2013 17:42  
**To:** Petillion, Flip;      Contact Information Redacted  
**Cc:** Tom Simotas

# **Annex 13.**

**From:** Tom Simotas Contact Information Redacted

**Sent:** vendredi 8 novembre 2013 22:35

**To:** Pettillion, Flip; Contact Information 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. Pettillion'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

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# **Annex 14.**



INTERNATIONAL CENTRE  
FOR DISPUTE RESOLUTION®

Thomas Ventrone  
Vice President

Contact Information Redacted

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 15.**

---

**Janssen, Jan**

**From:** Pettilion, Flip  
**Sent:** mercredi 31 juillet 2013 16:54  
**To:** Steve Koh **Contact Information Redacted**  
**Cc:** Contact Information Redacted; Steve Sereboff; 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