

Reconsideration Request Form

Version of 11 April 2013

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

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

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

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

Please submit completed form to reconsideration@icann.org.

1. Requester Information

Name: Vistaprint Limited

Address: Contact Information Redacted

Email:

Phone Number (optional):

C/o:

Name: Flip Petillion, Crowell & Moring LLP

Address: Contact Information Redacted

Email:

Phone Number (optional): Contact Information Redacted

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

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

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

Board action/inaction

Staff action/inaction

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

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

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

4. Date of action/inaction:

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

January 24, 2014

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

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

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

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

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

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

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

with additional obligations in the daily operation of the gTLD.

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

Various third parties are adversely affected by the Decision:

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

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

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

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

8. Detail of Board or Staff Action – Required Information

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

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

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

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

Provide the Required Detailed Explanation here:

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

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

The new gTLD program included a dispute resolution procedure pursuant to which disputes between a person or entity who applies for a new gTLD and a person or entity who objects to that gTLD are resolved in accordance with the so-called New gTLD Dispute Resolution Procedure (Article 1(b), New gTLD Dispute Resolution Procedure (hereinafter, the 'Procedure'). Pursuant to Article 1(c) of the Procedure, Dispute resolution proceedings shall be administered by a Dispute Resolution Service Provider (DRSP) in accordance with the Procedure and the applicable DRSP Rules. In accordance with Article 20(a) the Panel appointed by the DRSP had to apply the standards that have been defined by ICANN.

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

Requester reminds that ICANN shall not apply its standards, policies, procedures, or practices inequitably or single out any particular party for disparate treatment unless justified by substantial and reasonable cause, such as the promotion of effective competition (Article II(3), ICANN Bylaws). Requester also reminds that ICANN should always apply its policies neutrally and objectively, with integrity and fairness. The Decision is unfair, not neutral and accepting it creates disparate treatment without justified cause. Also for this reason, ICANN should not accept the Decision.

9. What are you asking ICANN to do now?

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

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

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

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

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

- The Appointment Procedure, developed by ICANN

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

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

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

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

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

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

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

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

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

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

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

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

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

The unjustified acceptance of the challenge of the second Panel

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

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

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

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

ICDR.

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

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

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

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

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

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

independence;

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

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

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

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

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

The unjustified and unreasoned acceptance of additional submissions

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

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

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

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

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

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

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

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

The incorrect application of the burden of proof

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

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

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

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

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

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

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

The incorrect application of the standard, defined by ICANN

- The standard, defined by ICANN

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

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

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

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

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

This high standard was explicitly confirmed by the NGPC in the rationale to NGPC Resolution 2013.06.25.NG07 stating that ‘similar’ in the Applicant Guidebook means:

“strings so similar that they create a probability of user confusion if more than one of the strings is delegated into the root zone. During the policy development and implementation design phases of the New gTLD Program, aural and conceptual string similarities were considered. These types of similarity were discussed at length, yet ultimately not agreed to be used as a basis for the analysis of the string similarity panels’ consideration because on balance, this could have unanticipated results in limiting the expansion of the DNS as well as the reach and utility of the Internet.” (Rationale for NGPC

Resolution 2013.06.25.NG07)

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

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

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

- The application of a different standard in the decision

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

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

(Annex 1, p. 11)

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

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

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

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

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

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

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

(Annex 2)

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

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

In the second determination involving <.cars> in which the string confusion objection was dismissed, the panelist ultimately concluded that “the string <.cars> is not confusingly similar to the string <.car>.”⁶⁸ Given that the panelist’s task was “to place itself in the position of the average, reasonable internet user and to assess whether such a person would probably be confused by the proposed string”,⁶⁹ he wrote, “Users will recognize that one of the strings is singular and one of them is plural and that that difference means that they should regard the two strings as different, as they are.”⁷⁰ Specifically,

the reader and the user will appreciate the fact that the two words that constitute the strings, “cars” and “car”, are separate words, with distinct meanings, with each of them being capable of being given their own function, namely that the former invokes cars in general and as a group, while the latter clearly invokes the concept of a single entity and that there is no reason why they should be understood as regarded as being used, in the internet context, in anything other than those distinct meanings.⁷¹

The panelist also noted that Internet users of today are

very well aware that, on the internet, small differences in spelling and meaning are significant and that they mean different things Internet users have become increasingly aware of such differences and are now mature and sophisticated enough to realize it, when they are being presented with such differences; indeed, internet users are so astute to such matters that they now look for them to ensure as best they can that they are not being misle[]d or deceived. There will therefore, in the opinion of the Expert, be no

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

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

(Annex 1, pp. 17-18)

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

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

In *Koko Castle, LLC*, the panelist wrote, "There . . . does appear to be visual 'peaceful coexistence' at the secondary domain name level between singular and plural names. Applicant has presented evidence that singular and plural websites have existed together commercially without much internet user confusion between them."⁶⁶ In this vein, the Applicant here argues that the Applicant's <webs.com> domain name has co-existed with the Objector's <web.com>. Yet the Panel questions whether this consideration, alone or in combination with others, is relevant in this determination.

Ultimately, Panelist Mason concluded that "[the] Objector has not met its heavy burden of proving that there is a probability, not just a possibility, of aural and/or visual similarity between the strings <.CAR> and <.CARS>, as opposed to mere

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

(Annex 1, pp. 16-17)

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

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

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

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

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

Conclusion

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

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

Yes

No

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

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

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

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

Terms and Conditions for Submission of Reconsideration Requests

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

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

Hearings are not required in the Reconsideration Process, however Requestors may request a hearing. The BGC retains the absolute discretion to determine whether a hearing is appropriate, and to call people before it for a hearing.

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

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

Flip Petition

Signature

February 6, 2014

Date