

## **EXPERT DETERMINATION LEGAL RIGHTS OBJECTION**

United States Postal Service v. GMO Registry, Inc.

Case No. LRO2013-0046

### **1. The Parties**

The Objector/Complainant (“Objector”) is United States Postal Service of Washington, D.C., United States of America represented by Lewis and Roca LLP, United States.

The Applicant/Respondent (“Applicant”) is GMO Registry, Inc. of Tokyo, Japan represented by Hogan Lovells (Paris) LLP, France.

### **2. The applied-for gTLD string**

The applied-for gTLD string is <.mail>.

### **3. Procedural History**

The Legal Rights Objection (“LRO”) was filed with the WIPO Arbitration and Mediation Center (the “WIPO Center”) on March 13, 2013 pursuant to the New gTLD Dispute Resolution Procedure (the Procedure).

In accordance with Article 9 of the Procedure, the WIPO Center has completed the review of the Objection on March 26, 2013 and has determined that the Objection complies with the requirements of the Procedure and the World Intellectual Property Organization Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections (the WIPO Rules for New gTLD Dispute Resolution).

In accordance with Article 11(a) of the Procedure, the WIPO Center formally notified the Applicant of the Objection, and the proceedings commenced on April 18, 2013. In accordance with Article 11(b) and relevant communication provisions of the Procedure, the Response was timely filed with the WIPO Center on May 17, 2013.

The WIPO Center received a proposal from the Objector to consolidate the LRO Objections LRO2013-0043 to LRO2013-0048 on April 25, 2013. The Applicant did not respond to the Objector’s request, however, other affected parties expressed opposition to aspects of the Objector’s consolidation proposal. In accordance with Article 12 of Procedure and Paragraph 7(d) of the WIPO Rules for New gTLD Dispute Resolution, the WIPO Center did not make a decision to consolidate the referenced LRO Objections for purposes of Article 12(b) of the Procedure.

On May 29, 2013, the WIPO Center received a request from Objector to file a supplemental submission, annexing a consumer survey entitled "A Test to Determine the Meaning of the Term 'Mail' to the General Population of the United States", conducted in May 2013 by Simonson Associates, Inc. On May 31, 2013, the Center acknowledged receipt of Objector's request and advised Objector that the Panel would be notified upon appointment of the receipt of its communication and any further steps in this regard would be a matter for the Panel to consider in its discretion.

The WIPO Center appointed Roberto Bianchi as the Panel in this matter on June 11, 2013. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of the Procedure and Paragraph 9 of WIPO Rules for New gTLD Dispute Resolution.

On June 20, 2013, at the Panel's request, the Center sent to the Panel the Objector's request to file a supplemental submission. On June 24, 2013, the Panel, by Expert Panel Order No. 1, decided: a. to admit the Objector's request of May 29, 2013; b. to invite Applicant to submit its comments with regard to the Objector's request; and c. to invite Applicant, in particular, to submit comments, if any, on the following statement in the Objector's request: "Thus, the USPS believes that the submission of survey evidence would aid the Panel in determining the meaning of the term 'mail.' The USPS suggests that Applicant be given any reasonable time required to prepare and submit its own survey evidence for the Panel's consideration and that the parties be allowed to submit additional written submissions regarding the meaning of the survey(s)." The deadline to comply with the Order was set to July 4, 2013.

On July 4, 2013, Applicant sent to the Center its Reply to the Objector's Additional Submissions to Supplement Legal Rights Objection to the Center, with two Annexes.

On July 10, 2013, Objector submitted a request for a hearing via videoconference and for any extension of time the Panel deems appropriate to allow Applicant to produce its own survey evidence if desired with adequate time for Objector to consider such survey evidence, if any is submitted, before oral argument via videoconference takes place.

On July 12, 2013, the Panel issued Expert Panel Order No. 2. The Panel noted that according to Article 18 of the Procedure, these disputes are to be resolved rapidly and at reasonable cost, that according to Article 19(a) these disputes will usually be resolved without a hearing, and that according to Article 19(b) a Panel may decide to hold a hearing only in extraordinary circumstances. Taking into account the record of the present case, the Panel did not consider the circumstances alleged by Objector to be extraordinary under the Procedure. Accordingly, Objector's request for a hearing was denied.

#### **4. Factual Background**

On June 13, 2012, a New gTLD Application Submitted to ICANN by Applicant for the string "mail" was posted (Application ID: 1-890-53570) - String: MAIL.

Applicant is a Japanese corporation subsidiary of GMO Internet, Inc.

Objector is an Independent Establishment of the Executive Branch of the United States Government.

Objector owns the following U.S. trademark registrations for U.S. MAIL:

- U.S. MAIL & Design, Reg. No. 1150641. Reg. Date April 7, 1981, for delivery of mail and related postal services, of international class 39; for retail philatelic agency services, of international class 42. FIRST USE: July 1, 1963. FIRST USE IN COMMERCE: July 1, 1963.
- U.S. MAIL & Design, Reg. No. 2431839. Reg. Date February 27, 2001, for sorting, handling and receiving packages and letters of international class 35; FIRST USE: August 12, 1970. FIRST USE IN

COMMERCE: July 1, 1971 and for pickup, transportation, and delivery of packages and documents by various modes of transportation of international class 39. FIRST USE: August 12, 1970. FIRST USE IN COMMERCE: July 1, 1971.

- U.S. MAIL & Design, Reg. No. 3720179. Reg. Date December 1, 2009, for retail store services featuring stamps and value-added mailing and delivery products and supplies; mail services, namely value-added sorting, handling and receiving of postcards, letters, packages, advertisements, catalogs, publications, invoices, and other items of mail, of international class 35; FIRST USE: December 2008. FIRST USE IN COMMERCE: December 2008; for pickup, transportation, and delivery of postcards, letters, packages, advertisements, catalogs, publications, invoices, and other items of mail; rental or mailboxes, of international 39. FIRST USE: December 2008. FIRST USE IN COMMERCE: December 2008.
- U.S. MAIL MR. ZIP & Design, Reg. No. 2960663. Reg. Date June 7, 2005, for clothing, namely, aprons, blankets for use as clothing wraps, underwear, coats, jackets, sleepwear, ponchos, shirts, shorts, socks, sweatpants, sweatshirts, ties, vests, t-shirts, scarves, athletic body suits, athletic racing tights, children's apparel, namely, one piece baby undergarments, shirts, pants, jumpers, and shortalls; headwear, of international class 25. FIRST USE: May 1963. FIRST USE IN COMMERCE: May 1963; and for games and toys, namely, children's multiple activity toys; balls, namely, golf balls and miniature soccer balls, bubble blowers, toy calculators, checker sets, educational card games contained on flashcards, flying discs, board games, jump ropes, maze games, mobiles, paddle ball, pull ring water squinters, puppets, toy science sets containing materials for conducting a science experiment related to the subject displayed on a particular stamp image, spring activated action toys, toy mailboxes, train sets, yo-yo's, stuffed animals, toy vehicles, action skill games, dolls, action figures, jigsaw puzzles, dress-up kits comprised of clothing and shoes for pretend play, paper dolls, hobbycraft kits for making cloth patches and brooches of non-precious metals, and hobbycraft kits for making paper dolls, embroidery items, stain glass, ornaments, jewelry and decorative items made of beads; playing cards, of international class 28. FIRST USE: May 1963. FIRST USE IN COMMERCE: May 1963.
- U.S. MAIL MR. ZIP & Design, Reg. No. 3170355. Reg. Date November 14, 2006, for sorting, handling, and receiving packages, letters and advertisements, of international class 35; FIRST USE: 1963; FIRST USE IN COMMERCE: 1963; for pickup, transportation and delivery of packages, documents, letters and advertisements by various modes of transportation, of international class 39. FIRST USE: 1963. FIRST USE IN COMMERCE: 1963..
- UNITED STATES POSTAL SERVICE U.S. MAIL & Design, Reg. No. 4031772. Reg. Date September 27, 2011, for envelopes and boxes of paper and cardboard for shipping and packaging; cardboard mailing tubes, of international class 16. FIRST USE: July 2009. FIRST USE IN COMMERCE: July 2009; for sorting, handling and receiving packages and letters of international class 35. FIRST USE: July 1, 1971. FIRST USE IN COMMERCE: July 1, 1971; for pickup, transportation and delivery of packages and documents by various modes of transportation, of international class 39. FIRST USE: July 1, 1971. FIRST USE IN COMMERCE: July 1, 1971.
- UNITED STATES POSTAL SERVICE U.S. MAIL & Design, Reg. No. 3113972. Reg. Date July 11, 2006, for publications, namely, periodicals concerning mail delivery services; greeting cards, of international class 16. FIRST USE: July 1, 1971. FIRST USE IN COMMERCE: July 1, 1971.
- UNITED STATES POSTAL SERVICE U.S. MAIL & Design, Reg. No. 3799543. Reg. Date June 8, 2010, for printed matter, namely, printed money orders of international class 6. FIRST USE: August 12, 1970. FIRST USE IN COMMERCE: August 12, 1970.
- U.S. MAIL UNITED STATES POSTAL SERVICE & Design, Reg. No. 3761332. Reg. Date

March 16, 2010, for money order services of international class 36. FIRST USE: August 12, 1970.  
FIRST USE IN COMMERCE: August 12, 1970.

Objector also owns trademark/service mark registrations that include the word "mail", issued by the USPTO and the trademark offices of various countries, such as: AIR MAIL, FRIEND-TO-FRIEND MAIL, BECAUSE THE MAIL MATTERS, GLOBAL EXPRESS MAIL, BUSINESS REPLY MAIL, GLOBAL PRIORITY MAIL, CERTIFIED MAIL, INTELLIGENT MAIL, CRITICAL MAIL, MEDIA MAIL, EVERY DOOR DIRECT MAIL, PRIORITY MAIL, EXPRESS MAIL, PRIORITY MAIL INTERNATIONAL, EXPRESS MAIL INTERNATIONAL, STANDARD MAIL, FIRST-CLASS MAIL, TODAY'S MAIL, FIRST-CLASS MAIL INTERNATIONAL, MAIL MOMENT.

In total, Objector owns over 240 trademark registrations for marks that include the word "mail".

The following U.S. trademark registrations of Objector contain a disclaimer stating, "No claim is made to the exclusive right to use 'mail', apart from the mark as shown":

- CERTIFIED MAIL, Reg. No. 3898915, Reg. Date January 4, 2011;
- CRITICAL MAIL, Reg. No. 4099682, Reg. Date February 14, 2012;
- EVERY DOOR DIRECT MAIL, Reg. No. 4085135, Reg. Date January 10, 2012;
- EXPRESS MAIL, Reg. No. 2194853, Reg. Date October 13, 1998;
- FRIEND-TO-FRIEND MAIL, Reg. No. 3181254, Reg. Date December 5, 2006;
- INTELLIGENT MAIL, Reg. No. 2845991, Reg. Date May 25, 2004;
- MEDIA MAIL, Reg. No. 2741474, Reg. Date July 29, 2003;
- PRIORITY MAIL, Reg. No. 2247552, May 25, 1999;
- TODAY'S MAIL, Reg. No. 2509277, Reg. Date November 20, 2001;
- UNITED STATES POSTAL SERVICE U.S. MAIL, Reg. No. 4031772, Reg. Date September 27, 2011, mixed mark with design consisting of a stylized eagle with outstretched wings over the stylized wording 'U.S. MAIL' with a line above and below the wording. The eagle design and wording is surrounded by the stylized wording 'UNITED STATES POSTAL SERVICE' and nine, five-pointed stars.

Objector's registration for FIRST-CLASS MAIL, Reg. No. 1094739, Reg. Date June 27, 1978, for delivery services – namely, delivery of letters and goods by mail in class 39, with a first use and first use in commerce of July 1, 1863, contains a disclaimer stating: "The term 'Mail' is disclaimed apart from the mark as shown."

Objector has filed Legal Rights Objections against all of the other existing applications for the <.mail> TLD, namely the applications filed by Charleston Road Registry Inc., Afiliis Domains No. 2 Limited, Amazon EU S.a.r.l., Victor Dale, LLC, WhitePages TLD LLC, and 1&1 Mail & Media GmbH.

## **5. Parties' Contentions**

### **A. Objector**

Objector basically contends as follows:

Objector's basis for standing under the Procedure is the following: Objector is the sole entity entrusted to deliver "mail" in the United States. Consumers understand "mail" to mean hard copy correspondence, and expect that "mail" to be handled by the Postal Service, a trusted source. When consumers encounter the word "mail" within the context of the applied-for TLD they will expect control by the Postal Service, just as they expect <.gov> correspondence to come from a U.S. governmental source. Thus, the applied-for TLD will have a source-indicative meaning for U.S. consumers and hundreds of thousands of U.S. citizens living abroad, who are likely to attribute greater trust and security to domains with and correspondence from any ICANN-authorized <.mail> TLD.

Objector argues that because many other countries use the term “post” to designate their mailing services, even non-U.S. consumers associate the term “mail” with the United States Postal Service since this entity delivers U.S. mail to over 500 countries and localities worldwide – and more than 40 percent of the world’s mail. The Postal Service owns more than 240 trademark registrations worldwide for trademarks that include the term “mail” (collectively, the “MAIL Marks”). The applied-for TLD is confusingly similar within the TLD context to the Postal Service’s U.S. MAIL mark, which it has used since at least as early as 1819. Although the Postal Service submits that awarding the applied-for TLD to Applicant would interfere with its legal rights in each and every MAIL mark, for the sake of brevity, the Objection primarily references the U.S. MAIL mark. The mark U.S. MAIL is also part of the Postal Service’s official seal, which is protected as a state emblem by Article 6ter of the Paris Convention.

Objector argues that to the U.S. public, “mail” refers to hard copy correspondence, printed matter and parcels delivered by the Objector. The Objector is the sole entity entrusted to deliver the mail in the United States. The applied-for string will infringe on the Postal Service’s rights and harm the public because:

- Within the context of a TLD, “mail” will have source-indicative meaning and U.S. consumers will expect the applied-for TLD to be controlled by the Postal Service, the regulated entity and designated postal operator entrusted to deliver “mail” in the United States; and
- the Postal Service owns dozens of registered trademarks that include the word “mail,” both in the U.S. and internationally; and
- the TLD <.mail> is confusingly similar to the Postal Service’s U.S. MAIL trademark. The U.S. MAIL mark has been used for nearly 200 years and forms part of the Postal Service’s official seal, which is protected by Article 6ter of the Paris Convention.

Objector concludes that the <.mail> TLD will create an impermissible likelihood of confusion and harm to the public if delegated to a private entity.

The remaining contentions of Objector are considered under each of the factors in section 6.D. below.

## **B. Applicant**

In its Response, Applicant basically contends as follows:

The potential use of the applied-for gTLD by Applicant does not (i) take unfair advantage of the distinctive character or the reputation of Objector’s registered or unregistered trademark or service mark (“mark”), and/or (ii) unjustifiably impair the distinctive character or the reputation of Objector’s mark, and/or (iii) otherwise create an impermissible likelihood of confusion between the Applicant’s applied-for gTLD and Objector’s mark.

Objector does not have any trademark or service mark that could be considered as identical or confusingly similar to the sign MAIL and has consequently no standing to object. This is due to the complete absence of distinctiveness of the sole term MAIL, as acknowledged by Objector in the Objection, contained in the trademarks produced by the Objector.

The word “mail” which corresponds to the applied-for TLD, is, in the context of an Internet extension, generic and descriptive of electronic mail as opposed to postal mail as recognized internationally (both in English speaking countries and non-English speaking countries). Internet users globally will know what the word “mail” refers to, in the context of the Internet, namely electronic mail and not postal mail thus eliminating any risks of confusion with the Objector. The visibility of the term “mail” on the Internet in relation to email is substantial due to this term being used widely to designate email services such as “Yahoo! Mail”, “Gmail” and “Hotmail”.

The portion of Internet users which should serve as a basis for assessing the Objection and the Response far exceeds the territory of the United States of America and covers all 54 countries where English is an official language as well as many other countries where English is understood and where “mail” is a common descriptive term for “email” in the field of the Internet.

The <.mail> TLD which the Applicant proposes to operate would be completely in accordance with the purely descriptive nature of the term “mail” and would contain appropriate safeguards based on the extensive experience of the Applicant in terms of Internet security and infrastructures.

The remaining contentions of Applicant are considered under each of the factors of section 6.D.

## **6. Discussion and Findings**

### **A. Objector’s Standing to File the Objection**

According to Section 3.2.2.2 of the gTLD Applicant Guidebook (“Guidebook”), a rightsholder that claims that an applied-for TLD infringes its legal rights on either registered or unregistered trademarks has standing to file a legal rights objection. The objector must include the source and documentation of its existing legal rights in the filing.

The Panel believes that the requisite for standing under Procedure is rather straightforward, and can be met by claiming, a) that the objector has rights in a mark (whether registered or not) and, b) that the applied-for TLD infringes such rights in the specified manner and c) including the source and documentation of the existing legal rights in the filing. A finding whether such rights exist or not should be made by the Panel in conjunction with the examination of the contentions and evidence under the first non-exclusive factor, while whether infringement exists or not will have to be determined after examining the submissions and evidence under all eight non-exclusive factors.

In the present case Objector contends that the applied-for TLD infringes its rights in the U.S. MAIL mark, and that awarding the TLD would interfere with Objector’s legal rights in each of its MAIL marks. In the filing, Objector submitted evidence to the satisfaction of the Panel as to the source and documentation of its existing rights on registered trademarks and service marks that contain the term “mail”. Accordingly, the Panel is satisfied that Objector has standing in this proceeding.

The contentions made by Applicant to contest Objector’s standing are dealt with under section 6.D.1. *infra* as contentions made with regard to Objector’s marks.

### **B. Preliminary Issue: Objector’s Request to Submit a Survey**

As seen at section 3 above (Procedural History), after the Response was filed and before the Panel was appointed, Objector filed a request to submit a survey. Upon appointment of the Panel, the Center informed the Panel about Objector’s request. The Panel then requested and received from the Center Objector’s request. The Panel, by Expert Panel Order 1, admitted the request and invited Applicant to submit its comments, if any, about Objector’s request, and in particular, about Objector’s statement that “the submission of survey evidence would aid the Panel in determining the meaning of the term ‘mail’”, and Objector’s suggestion “that Applicant be given any reasonable time required to prepare and submit its own survey evidence for the Panel’s consideration and that the parties be allowed to submit additional written submissions regarding the meaning of the survey(s)”.

In its comment, Applicant submitted that the unsolicited supplemental evidence submitted by Objector should be disregarded given that the survey results were not relevant and thus lacked probative value, and that Objector had failed to justify why it was unable to submit such evidence at the time of filing the Objection. Additionally, Applicant considered that conducting a relevant and valid survey would unjustifiably put the

Applicant to additional costs, which would seem unfair to the Applicant, where the Applicant had already provided detailed and convincing evidence. Applicant concluded that conducting a survey in the present context would also further delay the proceedings in a manner inconsistent with Article 18 Procedure.

The Panel believes that Objector's survey evidence was untimely submitted, and without explaining why it was not provided with the Objection. Also, for the Panel to consider and assess survey evidence untimely submitted most likely would require that the Panel give Applicant the opportunity to submit its own survey. This would put Applicant to substantial costs. Further, such complex evidence would probably require the Panel to request further comments on the surveys, and thus considerably delay the proceedings.

The Panel, having due regard to all these circumstances, considering that according to Article 18 of the Procedure these disputes are to be resolved rapidly and at reasonable cost, and that pursuant to Article 17(a) of the Procedure the Panel may decide whether the parties shall submit any written statements in addition to the Objection and the Response, denies Objector's request for submission of survey evidence.

### **C. General Principles (Standards) for Adjudication of a Legal Rights Objection**

GNSO Recommendation 3 states, "[s]trings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law".

According to Section 3.5.2 of the Guidebook, in interpreting and giving meaning to Recommendation 3, a panel of experts presiding over a legal rights objection will determine whether the potential use of the applied-for gTLD by the applicant:

- takes unfair advantage of the distinctive character or the reputation of the objector's registered or unregistered trademark or service mark, or
- unjustifiably impairs the distinctive character or the reputation of the objector's mark, or
- otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector's mark.

### **D. Factors Considered in Adjudicating the Objection**

As indicated in Section 3.5.2, in adjudicating the Objection the Panel will consider the contentions and arguments of the Parties under each of the following non-exclusive factors.

#### **1. Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound, or meaning, to the objector's existing mark.**

Objector contends that it owns several federal trademarks and service marks for U.S. MAIL (See Factual Background above), and dozens of registered trademarks that also include the word "mail," both in the U.S. and internationally. Objector also contends that the <.mail> TLD is confusingly similar to its U.S. MAIL trademark.

Objector further contends that the U.S. MAIL mark has been used for nearly 200 years and forms part of the Postal Service's official seal, which is protected by Article 6ter of the Paris Convention.

Objector refers to its registrations that include the word "mail," such as: AIR MAIL, FRIEND-TO-FRIEND MAIL, BECAUSE THE MAIL MATTERS, GLOBAL EXPRESS MAIL, BUSINESS REPLY MAIL, GLOBAL PRIORITY MAIL, CERTIFIED MAIL, INTELLIGENT MAIL, CRITICAL MAIL, MEDIA MAIL, EVERY DOOR DIRECT MAIL, PRIORITY MAIL, EXPRESS MAIL, PRIORITY MAIL INTERNATIONAL, EXPRESS MAIL INTERNATIONAL, STANDARD MAIL, FIRST-CLASS MAIL, TODAY'S MAIL, FIRST – CLASS MAIL INTERNATIONAL, and MAIL MOMENT. These registrations were issued by the U.S. Patent and Trademark

Office and the trademark offices of 51 other countries or jurisdictions, including Argentina, Australia, the European Union, Hong Kong, China, Japan, Mexico, China, Republic of Korea, Singapore, South Africa, and Switzerland.

Objector argues that to the U.S. public, “mail” refers to hard-copy correspondence, printed matter and parcels delivered by the Objector. Objector is the sole entity entrusted to deliver the mail in the United States. Objector argues that “mail” cannot be viewed as a simple common term within the context of the applied-for TLD. The <.mail> string creates a likelihood of confusion and danger of public harm given the public understanding of “mail” as referencing secure correspondence delivered by the Postal Service, the history of source-indicative TLDs such as <.gov> and <.int>, and the recent launch of the sponsored TLD <.post>.

Objector also argues that although “mail” has several different meanings in English, the primary meaning is hard-copy correspondence delivered through a post. In the United States, this organization is the Postal Service. The following dictionary definitions demonstrate the primary meaning of “mail” in English:

- (i) Merriam-Webster “Mail” Definition, “<http://www.merriam-webster.com/dictionary/mail>”: 1. chiefly Scottish: bag, wallet 2. a: material sent or carried in the postal system b: a conveyance that transports mail c: e-mail 3. a nation's postal system – often used in plural.
- (ii) Google “Mail” Definition (search terms: “mail definition”) Noun 1. Letters and packages conveyed by the postal system. 2. Flexible armor made of metal rings or plates. Verb 1. Send (a letter or package) using the postal system: “please mail the postcard”. 2. Clothe or cover with mail. (Emphasis added by Objector).

Objector further argues that each of these definitions references materials handled by a postal system. The average U.S. consumer hearing the sentence, “[s]torms delayed delivery of the mail” would immediately recognize that ‘delivery of the mail’ means delivery of hard-copy correspondence by the Postal Service, rather than delivery by any of the Postal Services competitors in the expedited courier or package delivery field or delivery by electronic mail.” Only some dictionaries make any reference to e-mail within the definition of “mail,” and then only as a less common meaning of “mail.”

Objector contends that encyclopedia entries for “mail” also reflect the common understanding of the term “mail” – correspondence delivered by the nation’s regulated mail provider, which in the United States is the Postal Service. For example, Encyclopedia Britannica’s entry for “mail” states “mail” is “the postal matter consigned under public authority from one person or post office to another.” The ‘public authority’ in the United States is the Postal Service. Even the U.S. judicial system recognizes that ‘mail’ refers to hardcopy correspondence delivered by the Postal Service. As just one example, the Oregon Revised Statutes define ‘mail’ as ‘use of the United States Postal Service for delivery of letters, packages or other containers.’

Objector also contends that the <.mail> TLD is likely to be viewed as the equivalent of the <.post> sTLD, which is sponsored by the Universal Postal Union, thus increasing the confusion. “Mail” and “post” are listed as synonyms in several thesauri. The interchangeability of the words “post” and “mail” increases the risk of confusion because consumers will assume .mail is the equivalent of the sTLD <.post> in the United States and thus assume <.mail> is controlled by the Postal Service. Moreover, protection of seemingly common terms such as “mail” has been internationally recognized in certain circumstances. In 2010, the German Federal Patent Court ruled that “post” is source-indicative to German consumers, who associate it exclusively with Deutsche Post. “Mail” is the English-speaking equivalent of “post” as recognized by articles reporting on this German decision.

Applicant contends that Objector does not have any trademark or service mark whatsoever in the term “mail”. Objector thus lacks standing to object so that the Objection filed by Objector should be rejected on this basis. The reason for the absence of any trademark or service mark in the term “mail” is clear: it is a term which is undisputedly and merely generic and descriptive in relation to Objector’s business. This explains why, *inter alia*, the term “mail” is consistently and invariably disclaimed in trademarks registered by



the USPTO as being completely generic and descriptive in relation to postal or electronic mail, as can be seen in the trademark registrations of other entities and, ironically, in Objector's very own trademark certificates.

Applicant argues that the requirement for Objector to own a trademark or service mark is clear. In addition such mark will have to be infringed by the applied-for TLD, which includes a requirement that the applied-for TLD be identical or confusingly similar to the mark.

Applicant contends that Objector does not own any marks in any jurisdiction that would satisfy these requirements. Objector only provided evidence of trademarks which only include the word "MAIL", as well as, in particular, the words "air", "service", "express", "intelligent". These trademarks could not conceivably give any rights or exclusivity whatsoever in the term "mail" on its own as it completely lacks distinctiveness, just like it would not give any rights in the term "service" on its own.

Applicant submits that the applied-for gTLD is not identical or similar to the Objector's existing marks containing the generic term "mail". To give the illusion of the existence of a mark in the term "mail", the Objector resorted to referring to all these trademarks which are not in the term "mail" as the "mail" Marks. The Objector is misrepresenting the reality of its rights in order to distract from the fact that it does not have any relevant mark in the sign corresponding to the TLD.

With regard to Objector's argument that one of its trademarks in "U.S. MAIL" is included in the Postal Service's seal protected by the Paris Convention, Applicant contends that Article 6ter of the Paris Convention also states that there is no protection of a seal when: "the use or registration (...) is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization."

Applicant argues that the <.mail> TLD does not reproduce the Postal Service seal. In order to assess whether or not a trademark has any distinctive character, the overall impression given by it must be considered (ECJ (European Court of Justice), 25 October 2007, *Develey Holding & Beteiligungs/OHIM*, C-238/06 P, paragraph 82). It may be useful, in the course of the overall assessment, to examine each of the components of which the sign at stake is composed (ECJ, 25 October 2007, *Develey Holding & Beteiligungs/OHIM*, C-238/06 P, paragraph 82).

Applicant further argues that the applied-for TLD only includes the word "mail". As a result, it is necessary to determine if "mail" is a dominant element of the seal. When assessing the dominant character of one or several given elements of a complex trademark, account should be taken, in particular, of the inherent characteristics of each of the elements by comparing them to those of the other elements (Court of First Instance of the European Union (CFI), 13 December 2007, *Miguel Cabrera Sanchez/OHIM-Industrias Carnicas Valle*, T-242/06, paragraph 47). Also, account should be taken, in particular, of the inherent characteristics of the element in question in the light of whether it is at all descriptive of the goods or services for which the mark has been registered (CFI, 13 December 2007, *Miguel Cabrera Sanchez/OHIM-Industrias Carnicas Valle*, T-242/06, paragraph 51) and if necessary, account may be taken of the relative position of the various components within the arrangement of the compound mark (*ibid.*, paragraph 47).

Applicant contends that in the Postal Service's seal, the central part mainly consists of a figurative element, an eagle, under which the word "mail" appears in conjunction with "U.S." between two lines and this central element is surrounded by the words "UNITED STATES POSTAL SERVICE" and nine stars. The American postal service seal is thus a highly complex sign consisting of both verbal and figurative elements of which the word "mail" is a very minor part and one that completely lacks distinctiveness. It would thus be inconceivable to consider that the term "mail" is at all dominant in the postal service seal relied upon by the Objector.

In light of the above, under Article 6ter of the Paris Convention the word “mail” included in the Postal Service’s seal could not result in any confusion in the mind of the relevant community of Internet users between the TLD <.mail> and the Objector.

Applicant adds that Objector should also be fully aware of Article 6 Quinquies (B)(2) of the Paris Convention stating that trademarks may not be denied registration or invalidated except when they “have become customary in the current language or in the *bona fide* and established practices of the trade of the country where protection is claimed”.

Applicant states that in any case it has provided answers to all of Objector’s allegations to show that even if Objector had satisfied the requirement to have a relevant trademark or service mark, it has failed to demonstrate any of its allegations and has misused the present proceedings.

Applicant refers to the rules applicable to the protection of Community Trademarks applicable within the European Union, the basic legal requirements being stated in the Community Trade Mark Regulation (Council Regulation (EC) No 40/94 of 20 December 1993 – “CTMR”). Under Article 7(1)(d) CTMR: “trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade” shall not be protected. In the United States of America, §15(4) of the U.S. Trademark Law, the Lanham Act (15 U.S.C. §1065), bars registration of an applied-for trademark which is the generic name for the goods or services.

Applicant contends that it has demonstrated that “mail” is merely a generic and descriptive term in the context of postal mail in the physical world and electronic mail when used as an Internet extension. In assessing the generic character of a sign, it is only necessary to take into account its current usage in the sectors covering trade in those services (ECJ, 5 October 2004, *Alcon/OHIM - Dr. Robert Winzer Pharma*, C-192/03 P, paragraph 28).

Applicant contends that, as stated by Objector, the term “mail” has several different meanings in English, but all dictionaries available online define the term “mail” in the context of Internet and computing, as a short for electronic mail, for example, Oxford Dictionaries define “mail” as “email” and provides the following example: “you’ve got mail”.

Applicant remarks that many of the definitions provided by the Objector define “mail” as electronic mail or e-mail, including the Merriam-Webster dictionary definition provided on page 5 of the Objection and other dictionary entries provided at Annex 9 of the Objection.

Applicant argues that numerous trademark registries, such as the USPTO, allow trademark applications including the sign MAIL and relating to products in international class 16 or services in international classes 35, 38 and 39 provided that the term “mail” is disclaimed. (See the disclaimers at section 4 above – Factual Background.) The same applies to trademarks registered by third parties that contain the “mail” term.

Applicant provides several rulings by courts and OHIM. One of the rulings considered that the relevant German consumers link “mail”-suffixed terms with e-mail. Another held that the word “mail” beside its meaning as “any item transported and delivered by the post office”, in relation to telecommunication services is internationally is short for “electronic mail, so that the German consumer is familiar with this word and will perceive its meaning, and still another, that although the word ‘mail’ does not exist as such in Spanish, it is a widespread English term used mainly as ‘mail’ or ‘e-mail’ to define message, electronic message (mensaje correo electrónico)”. Thus, applicant argues that “[w]hen used in relation to services such as those covered by the opponent’s mark in class 38 the word ‘mail’ is descriptive or at least suggestive of these services. This component does not have a significant impact on the overall impression of the sign as its inherent distinctiveness is very weak.

Applicant concludes that Objector's allegations that it has a trademark or a service mark identical or confusingly similar to the sign to which the TLD <.mail> corresponds, are fabricated and incorrect, and that Objector does not have standing to object according to internationally recognized standards, and that the Objection should be rejected on this basis.

Applicant lastly contends that all arguments put forward by the Objector in relation to an alleged risk of confusion amongst Internet users are spurious and fabricated, since Applicant has demonstrated that its use of the <.mail> TLD could not possibly create a likelihood of confusion with the Objector, let alone impermissible confusion.

### Panel's Findings under Factor 1

The Panel notes that Objector owns several federal registrations for the U.S. MAIL mark, as well as several other compound marks that include the term "mail", issued in the United States and elsewhere.

As shown at section 4 above (Factual Background), a number of Objector's trademark registrations for compound marks that include the term "mail" contain disclaimers stating, "No claim is made to the exclusive right to use 'mail', apart from the mark as shown." Applicant has shown that a similar disclaimer exists for the term "mail" in a number of third parties' U.S. trademark registrations for compound marks that include the term "mail".

The Panel also notes that within the context of the Internet, the term "mail" commonly is short for "e-mail" or "email". In fact, as shown in the citations of dictionaries, thesauri and encyclopedias provided by the Parties, both meanings for the term "mail" appear to co-exist in contemporary English. While the meaning as "materials sorted, handled, transported and delivered by a postal office" usually appears in the first place, the meaning as equivalent to "email or e-mail" appears immediately next or closely thereafter. For example, in the course of a wiki search for "mail" conducted by the Panel on Wikipedia, a disambiguation entry appeared, which, when clicked-on, resulted in the following two lines:

"Mail is part of a postal system wherein letters, parcels, and packages are delivered to destinations".  
"Mail may also refer to: E-mail, electronic mail".<sup>1</sup>

The Panel notes that according to Wikipedia, "[s]ome dictionaries include each separate meaning in the order of most common usage while others list definitions in historical order, with the oldest usage first."<sup>2</sup> Thus, it is not clear whether dictionaries enter the different meanings of "mail" in order of frequency of use, or in historical order. In this regard, the Panel notes that email messages are relatively new since this type of communications were developed around 1970.<sup>3</sup>

The Panel notes that several UDRP panels have found that the term "mail" is generic, descriptive in the field of telecommunications, commonly identifying emails, and a common noun. See *Mobsat Group Holding SARL v. Sharon Ting (CTLGDN-564616)*, WIPO Case No. D2012-0861 (relating to <vizadail.com>) ("The disputed domain name is dominated solely by the element 'vizada', since 'mail' is a purely descriptive term, in particular in the field of telecommunications, where it commonly identifies emails, a method of exchanging digital messages from an author to one or more recipients (see e.g. definition on Wikipedia). Thus, the disputed domain name <vizadail.com> is solely dominated by the element 'vizada' which is identical to the Complainant's VIZADA trademarks."); see also *Microsoft Corporation v. Superkay Worldwide, Inc.*, WIPO Case No. D2004-0071 (relating to <microsoftmail.com>) ("In accordance with decisions such as

<sup>1</sup> [http://en.wikipedia.org/wiki/Mail\\_%28disambiguation%29](http://en.wikipedia.org/wiki/Mail_%28disambiguation%29), visited by the Panel on July 18, 2013.

<sup>2</sup> <http://en.wikipedia.org/wiki/Dictionary>, visited by the Panel on July 21, 2013.

<sup>3</sup> According to Wikipedia, "Ray Tomlinson is generally credited as having sent the first email across a network, initiating the use of the "@" sign to separate the names of the user and the user's machine in 1971, when he sent a message from one Digital Equipment Corporation DEC-10 computer to another DEC-10. The two machines were placed next to each other."

See <http://en.wikipedia.org/wiki/Email#History> (visited by the Panel on July 17, 2013).

ACCOR, *Société Anonyme à Directoire et Conseil de surveillance v. Tigertail Partners*, WIPO Case No. D2002-0625, *the Panel finds that the term 'mail' should be considered generic.*"); see also *Toyota Motor Sales U.S.A. Inc. v. Tony Mwangi*, WIPO Case No. D2003-0623 (relating to <lexusmail.com> and <mylexus.com>) ("Similarly, the domain name <lexusmail.com> is not sufficiently distinct from the mark LEXUS to create a wholly distinct domain name. *The addition of the generic term 'mail' does not affect the prominence of the LEXUS mark.* In addition, Internet users could be confused by believing that this domain name is somehow associated with Complainant and is a place to send mail relating to LEXUS cars. See *Google, Inc. v. Dotname Communications*, NAF Case No. FA0206000114712 (August 18, 2002) (<googlemail.com> found confusingly similar to GOOGLE); *Volkswagen Aktiengesellschaft v. Iggi Networks, Inc.*, NAF Case No. FA0107000098077 (August 17, 2001) (<vwmail.com> found confusingly similar to VW)". See also *Virgin Enterprises Limited v. Internet Domains*, WIPO Case No. D2001-1008 (relating to <virginmail.com>) ("Secondly, the word 'virgin' is a common noun. It has a number of meanings essentially connoting a sexually inexperienced female. *The word 'mail' is another common noun.*"; see also *Chanel, Inc. v. IGGI Networks, Inc.*, WIPO Case No. D2000-1831 (relating to <chanelmail.com>) ("The domain name <chanelmail.com> incorporates the entire registered mark CHANEL. Although the domain name incorporates another term, 'mail', *this generic term does not affect the prominence of the CHANEL mark.* Internet users would be confused by believing that this site is somehow associated with CHANEL and is a place to send mail involving CHANEL."). (Emphasis added by the Panel).

Applicant showed that "mail" is a generic term equivalent of email in its citation to *Baltimore Technologies Ltd. v. OHIM*, November 14, 2001, Case No. R 40/2001-3 and *America Online Inc v AT&T Corp*, 243 F.3d 812 (2001) and even as a term broadly understood with the same meaning even in non-English speaking countries, in OHIM Cases No. R 461/2008-2 and No. B 216 749 (involving German consumers), and Case No. B 510 398 (involving Spanish consumers).

The Panel concludes that the term "mail" is generic, and that, as evidenced by Objector, in the physical world or context of sorting, receiving, handling, collecting and delivering correspondence, is descriptive of the matter received, delivered, etc., by a postal service, or of related services, such as those provided by Objector in the United States. Similarly, the term "mail", short for "email" and "e-mail", is generic, and descriptive of a type of electronic communication. Presently, both meanings coexist; which one is being used at any given moment depends on the context.

It is clear that the applied-for gTLD in the visual (appearance) and aural (phonic) dimensions appears to be nearly identical to "mail", one of the components of Objector's U.S. MAIL and other compound marks that also contain this term. When the semantic dimension is considered and the "mail" term is used descriptively as equivalent of "email" or "e-mail", or with regard to email/e-mail-related activities, the applied-for gTLD does not appear to be identical or similar to the "mail" element in Objector's marks.

However, in the Panel's opinion, the comparison between the applied-for gTLD and Objector's marks should not be limited to one of the components of the marks. Instead the signs should be compared considering each of the marks of Objector as a whole. In this regard, the Panel considers particularly relevant the fact that Objector does not own any mark in the term "mail" standing alone, and that this term is disclaimed in many of its registrations for compound marks that contain "mail" as a component.

The Panel concludes that any distinctive character that Objector's compound marks may possess is afforded by the combination of the generic term "mail" with the remaining element or elements of the marks, and that whatever reputation that these compound marks may enjoy should be attributed to the compound, and not to any of its components singularly considered. For instance, in the U.S. MAIL mark, the presence of the "U.S." letters, well known in the United States and probably recognizable in other countries, affords distinctive character to the U.S. MAIL mark, which otherwise would not obtain due to the generic and descriptive character of the "mail" term considered alone. The same applies to other compound marks of Objector that include the term "mail".

Having regard to all these facts and circumstances, the Panel concludes that the applied-for gTLD is not identical or similar, including in appearance, phonetic sound, or meaning, to the objector's existing mark. This factor weighs for Applicant.

## **2. Whether the objector's acquisition and use of rights in the mark has been *bona fide*.**

Objector contends that it owns *bona fide* rights in the famous U.S. MAIL trademark, which has been used for nearly 200 years, is subject to multiple registrations, and forms a part of the Postal Service's official seal. The Postal Service began using the U.S. MAIL mark as early as 1819. Reference to "United States mail" appeared in legislation as early as 1845. The 1902 Issue of Postal Laws and Regulations included language regulating the use of "U. S. Mail" on automobiles. The first collection boxes were introduced in 1847. Mailboxes, vehicles of contractors and carriers are marked with "U.S. MAIL". The Postal Service also uses the U.S. MAIL mark on its website, "www.usps.com", to advertise its services. Additionally, Post Office facilities and Postal Service Mail Carriers' mailbags and uniforms are imprinted with "U.S. MAIL".

Objector also contends that it owns nine U.S. registrations that include the U.S. MAIL mark (See Factual Background above). In addition, the Postal Service owns over a dozen registrations and applications for the U.S. MAIL mark internationally.

Lastly, Objector argues that the U.S. MAIL mark forms part of the Postal Service's official seal, which is protected by Article 6ter of the Paris Convention.

Applicant did not address under this factor the issue of *bona fide* acquisition and use of Objector's mark. However, under another factor, Applicant does contend that Objector does not produce evidence that it is using this term "mail" outside of the United States.

Applicant also argues that the types of uses of the term "mail" shown by Objector are immaterial as they are limited to the U.S. territory and give no indication as to whether any use is made in the context of the Internet. Applicant argues that genuine use of a trademark must be proven in the countries concerned. It cannot be proven by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark in the market concerned.

### **Panel's Findings under Factor 2**

In the opinion of the Panel, on the existing evidence there is no doubt that Objector acquired and used its rights in the U.S. MAIL compound mark *bona fide* since it began using it early in the nineteenth century.

While thus the Objector benefits from *bona fide*, the Panel does not attach particular weight to this factor.

## **3. Whether and to what extent there is recognition in the relevant sector of the public of the sign corresponding to the gTLD, as the mark of the objector, of the applicant or of a third party.**

Objector contends that the applied-for string will infringe on the Postal Service's rights and harm the public because within the context of a TLD, "mail" will have source-indicative meaning and U.S. consumers will expect the applied-for TLD to be controlled by the Postal Service, the regulated entity and designated postal operator entrusted to deliver "mail" in the United States. The public associates "mail" with the Postal Service. In the United States the Postal Service is and has been the only entity that sorts, handles and/or delivers "mail," since its predecessor was established in 1775. By law, the term "mail" in the United States means matter physically delivered by the Postal Service.

Objector argues that the American public depends on the Postal Services delivery of "mail." In U.S. vernacular, "mail" refers to hard-copy correspondence delivered by the Postal Service.

Objector contends that the term “mail” cannot be viewed as a common term within the context of a TLD. Within the context of a TLD, even seemingly non-distinctive, non-trademark terms have a source-indicative function. For at least the last decade, registrations of domains with the <.gov> TLD have been limited to official governmental organizations in the United States. The purpose of assigning <.gov> as a sponsored TLD rather than a gTLD was to “promote government services and increase the ease of finding these services.” 41 C.F.R. § 102-173.5 (2003). Consistent with this purpose the public gives a higher level of trust to <.gov> domains and e-mails with a <.gov> address. Objector argues that similarly, <.int> is restricted to inter-governmental organizations and organizations with United Nations observer status. Likewise, the <.post> sTLD is sponsored by the Universal Postal Union. All of these sTLDs are known by the public to be regulated and thus are afforded a greater level of trust.

Objector further argues that given the public’s understanding of the foregoing sponsored TLDs, and given consumer association of “mail” with the Postal Service, consumers are likely to view the <.mail> TLD as originating from or controlled by the Postal Service. Consumers will not expect the <.mail> TLD to identify a private, unregulated entity, especially since “mail” delivery is an essential governmental function. Such confusion could not only materially harm the reputation of the Postal Service and the interest of the public who relies on its secure delivery services, but could also undermine public confidence in the DNS. This is especially true since the Postal Service delivers over 40% of the world’s “mail.”

Objector contends that increasing this risk of confusion is the fact that the TLD <.mail> is likely to be viewed as the equivalent of the <.post> sTLD, which is sponsored by the Universal Postal Union, the specialized agency of the United Nations. The United States is a member of the UPU. In countries such as the U.S., in which “mail” identifies hard copy correspondence delivered by the country’s government, the public is likely to expect the <.mail> TLD to be sponsored by their government and in the case of the U.S. public, the Postal Service. The equivalence between the <.mail> and <.post> TLDs is further evidenced by the fact that “mail” and “post” are listed as synonyms in several thesauri. This equivalence increases the risk of confusion because consumers will assume .mail is the equivalent of the sTLD <.post> in the United States and thus assume <.mail> is controlled by the Postal Service.

Objector also contends that protection of seemingly common terms such as “mail” has been internationally recognized in certain circumstances. In 2010, the German Federal Patent Court ruled that “post” is source-indicative to German consumers, who associate it exclusively with Deutsche Post. “Mail” is the English-speaking equivalent of “post” as recognized by articles reporting on this German decision.

Applicant contends that Objector does not produce evidence that it is using this term “mail” outside of the United States. More precisely, USPS states that it “is the sole entity entrusted to deliver ‘mail’ in the United States” and that its trademarks are only famous in the United States.

Applicant argues that the types of uses of the term “mail” shown by Objector are immaterial as they are limited to the U.S. territory and give no indication as to whether any use is made in the context of the Internet. Genuine use of a trademark, be it Community, national or international, must be proven in the countries concerned. It cannot be proven by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark in the market concerned.

Applicant also argues that Objector completely fails to substantiate how non-US trademarks owned by the USPS could possibly be used in their respective territories. The association between the term “mail” or “post” and a particular entity can only be confined to one single territory and in the context of the Internet the assessment cannot be confined to one territory and must be global. It is clear that the portion of Internet users which should serve as a basis for assessing the Objection and the Response far exceeds the territory of the United States of America and covers all 54 countries where English is an official language as well as many other countries where English is understood and where “mail” is a common descriptive term for “email”.

Applicant concludes that the term “mail” is internationally considered synonymous with “email” by the target public concerned in the context of a new Internet extension, where physical or postal mail is irrelevant. This would be rather obvious to Internet users who know that use of the term “mail” in the context of Internet refers to electronic mail and nothing else. Similarly, “mailbox” could refer to a physical letterbox in the physical world but on the Internet it is not conceivable that anyone would ever entertain the idea that it refers to anything but the mailbox of an electronic messaging service. The contextualization of the use of the term “mail” for a TLD is such that it leaves no room for ambiguity. This is also the reason why many companies providing electronic mail services include the descriptive word “mail” in their names, such as “Yahoo! Mail”, “Gmail” or “Hotmail”.

Applicant explains that it proposes to operate the <.mail> TLD as stated in its Application to ICANN, in response to question 18: “.MAIL provides a unique TLD choice that is unavailable in the current spread of gTLDs. The term ‘mail’ is immediately recognizable, universal and memorable, and is commonly associated with email when applied to an online context.” Thus the Applicant is clearly not targeting or even interfering with the postal mail sector but confined to electronic mail so that it is difficult to understand the Objector’s concerns.

Further, the association between the term “mail” and the Objector in the context of the Internet and domain names is virtually inexistent or extremely minimal at best. This is illustrated, for instance, by the fact that the first thirty natural search results obtained by typing the term “mail” in the Google search engine available at the URL “www.google.com/ncr” (Google US) do not refer to the Objector at all.

The fact that the Objector’s potential association with the term “mail” is very limited (to say the least) in the context of Internet is also illustrated by the fact that the Objector does not seem to have registered any domain names consisting of the term “mail”. However, there are numerous domain names consisting of the term “mail” owned by other entities throughout the world.

Thus there is no evidence whatsoever of any potential presence, visibility or reputation of the Objector on the Internet in relation to the term “mail”. This clearly negates any possibility of any Internet user confusion and if there was any it would rather be in relation to <mail.com> perhaps but certainly not the Objector.

Given that Internet users visiting a “mail” website have no reason to expect to find content relating to the Objector, as the Objector has no “mail” website (as opposed to many other entities), there is no reason to believe that Internet users’ expectations would be any different when the term “mail” moves from the left to the right of the dot.

Applicant concludes that any potential confusion for the purpose of the present proceedings has to be assessed within the context of the Internet.

### **Panel’s Findings under Factor 3**

The Panel notes that the Parties disagree as to the relevant part of the public to consider. Objector refers to “the public”, “the American public”, and “the consumers”. Applicant argues that the association between the term “mail” or “post” and a particular entity can only be confined to one single territory and that instead in the context of Internet the assessment cannot be confined to one territory and must be global. Applicant also contends that any potential confusion for the purpose of the present proceedings has to be assessed “within the context of the Internet”, and that “the portion of Internet users” which should serve as a basis for assessing the Objection and the Response “far exceeds the U.S. territory and covers all 54 countries where English is an official language as well as many other countries where English is understood and where ‘mail’ is a common descriptive term for ‘email’”.

The Panel believes that even if a part of the U.S. public would associate “mail” to physical material and correspondence delivered by the U.S. Postal Service, this does not mean that the same part of the public within the context of the Internet would not recognize “mail” as meaning “email”.

Also, there is no evidence or indication that “the public outside the United States” would mostly associate the term “mail” with the U.S. Postal Service, or with their own postal services, or with any postal services at all. Instead, on the record there are citations to European courts and administrative bodies finding that even non-English speaking Europeans such as German consumers and Spanish consumers understand “mail” as an equivalent for “email”.

The Panel considers that the intended use by Applicant of the applied-for gTLD is addressed to provide “Internet identity” to businesses and individuals in the global environment, by providing them the opportunity to own email accounts at domain names in the <.mail> gTLD. In this regard, the Panel believes that the “email” meaning of the term “mail” appears to be consistent with the purpose and intended use, as stated by Applicant, corresponding to the applied-for gTLD. In any case, the Panel does not find any reason to restrict this interpretation of the term “mail” because some indeterminate part of the public of just one country might eventually associate this term, in the best of hypotheses for Objector, with a specific provider of postal services, especially considering that Objector does not own any mark in the “mail” term standing alone, and that in several Objector’s compound marks that include this term, it is clearly disclaimed.

Moreover, since the Parties have submitted evidence consisting of dictionary and thesauri citations, and Objector even supports its allegations as to public recognition with dictionary citations, the Panel notes that most dictionary citations, included the Wikipedia disambiguation entry independently consulted by the Panel, indicate that one of the main meanings of the term “mail” is “email” or “e-mail”. The Panel considers that well-known dictionaries and thesauri cited by the Parties normally reflect the general use as well as different meanings for each entry.

Finally, there is no evidence on the record that either Applicant or any third party owns any mark in “mail”.

For the above reasons, the Panel considers that there is no evidence that the relevant sector of the public recognizes the sign corresponding to the gTLD as the mark of Objector. Also, there is no evidence that the sign corresponding to the applied-for gTLD is recognized as the mark of Applicant or of a third party.

The Panel believes that this factor should count as neutral.

**4. Applicant’s intent in applying for the gTLD, including whether the applicant, at the time of application for the gTLD, had knowledge of the objector’s mark, or could not have reasonably been unaware of that mark, and including whether the applicant has engaged in a pattern of conduct whereby it applied for or operates TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others.**

Objector asserts, with regard to Applicant’s stated purpose in the Application, that the “dedicated online identity” proposed by Applicant will in fact create a false association between the Applicant and the Postal Service due to the proposed use of the term “mail”.

(For more on the Applicant’s contentions, see Factor 8 below.)

**Panel’s Findings under Factor 4**

The Panel notes that neither Party has alleged or denied that Applicant had any knowledge of Objector’s mark, or that Applicant could not have reasonably been unaware of that mark, or that Applicant has engaged in a pattern of conduct whereby it applied for or operates TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others.

The Panel also notes that, as stated in the Applicant’s Application, the “purpose of .mail is to establish a dedicated online identity for email, online communication, and related products and services. The primary target audience of .mail includes Internet and email service providers or email distribution services seeking to differentiate their service through the provision of memorable and intuitive email addresses, vendors of



communication technologies who understand the brand power of a TLD with relevance, as well as individuals who wish to take control of their own email identity.” On the evidence, there is no reason for the Panel to assume that Applicant’s purpose is other than as stated.

The Panel finds it likely that Applicant was aware of Objector’s mark. However this may be, considering the important costs and time, and the sophistication required for the operation of a TLD registry, the Panel believes that it is reasonable to assume that an applicant would in any event conduct reasonable and affordable searches for the term “mail” on the most obvious databases, such as TESS of the USTPO, and similar others elsewhere, as well as searches on the Internet by using regular search engines, to determine whether the applied-for gTLD at least is identical or similar to existing marks.

The rationale for the Panel’s assumption is similar to the adopted by some UDRP panels, as reported in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”), paragraph 3.4.

Had Applicant searched for the “mail” term on the TESS and similar other databases, or conducted an Internet search with a search engine, it presumably would have found many marks containing the “mail” term, such as Objector’s and third-parties’ compound marks.

However, Applicant would not have found any mark of Objector in “mail” standing alone. Moreover, as seen in the Panel’s finding under Factor 1, the “mail” term is generic, descriptive both of goods and services provided by post offices, and of email-related goods and services. Furthermore, Applicant would have found that in many of Objector’s trademark registrations, the term is disclaimed. Accordingly Applicant would not have had any reason to conclude that there were any previous existing rights of Objector in such term standing alone that should prevent Applicant from applying for the <.mail> TLD.

For the foregoing reasons, the Panel concludes that this factor is neutral.

**5. Whether and to what extent the applicant has used, or has made demonstrable preparations to use, the sign corresponding to the gTLD in connection with a *bona fide* offering of goods or services or a *bona fide* provision of information in a way that does not interfere with the legitimate exercise by the objector of its mark rights.**

Objector contends that Applicant has used or made preparations to use the gTLD in a way that interferes with the legitimate exercise by the Postal Service of its rights. The <.mail> TLD is confusingly similar to many Postal Service trademarks, including U.S. MAIL, MAIL MOMENT and PRIORITY MAIL. The only difference between the <.mail> TLD and these marks is a single term. Should the Applicant be awarded the <.mail> TLD, nothing will prevent a third party from registering domain names that directly infringe the Postal Service’s marks. Any party could register <us.mail>, <certified.mail>, <priority.mail>, <express.mail>, or any other domain name that contains a valid trademark of the Postal Service in its entirety. Furthermore, Applicant intends to target the <.mail> TLD at e-mail service providers and their customers. Thus, e-mail addresses created in connection with any of these domain names would also directly infringe the Postal Service’s valid trademarks. For example, e-mail addresses such as “[NAME]@us.mail” and “postmaster@priority.mail” not only infringe the Postal Service’s trademarks, but are likely to confuse consumers. The many thousands of potentially confusing email addresses on such domains multiply this risk of confusion exponentially. The multiple domain names and potential email addresses available through Applicant’s operation of the <.mail> TLD open the door to fraud, scamming, phishing, and other false or misleading schemes aimed at acquiring private data from consumers who mistakenly believe these domain names and/or e-mail addresses are associated with the Postal Service.

Objector further contends that the term “mail” is primarily used and recognized to refer to hard-copy correspondence, rather than e-mail. However, Objector’s customers and the public generally will be easily misled into believing that domains on the <.mail> TLD have begun to offer secure and trusted e-mail services if Applicant is successful in obtaining the TLD. In the current climate of electronic correspondence, electronic

communications via e-mail are services that are closely related to hard copy correspondence. They are also services which are a natural area of expansion for the Postal Service and the Applicant should be prohibited from trading on the Postal Service's reputation built over the course of almost 200 years to attract new customers to Applicant's proposed TLD. Applicant might have applied for <.email> rather than <.mail> in order to avoid confusion with Objector's registered marks, but chose not to do so.

Objector concludes that placing the <.mail> TLD in the hands of a private entity may also limit the Postal Service's access to "mail" domains and email addresses, thereby interfering with its ability to communicate with the public about hardcopy mail delivery, its primary activity. The TLD, if delegated, is also likely to dilute the Postal Service's rights in its U.S. MAIL marks, which are famous in the United States as household words. Further, because the e-mail services intended for Applicant's TLD will not be regulated, these services are more open to fraud and phishing schemes, which may mistakenly be attributed to the Postal Service, resulting in tarnishment of its U.S. MAIL marks.

Applicant argues, referring to the statement in its Application, that it would operate the <.mail> TLD in relation to the services it describes in a secure manner and with the appropriate safeguards. The purpose of the <.mail> TLD applied-for, as stated, is to establish a dedicated online identity for email. (See other related contentions of Applicant under Factor 8.)

Applicant concludes that it has made considerable preparations to use the sign corresponding to the gTLD in connection with a *bona fide* offering of goods or services or a *bona fide* provision of information in a way that does not interfere with the legitimate exercise by the Objector of its mark rights.

#### **Panel's Findings under Factor 5**

The Panel notes that the sign corresponding to the gTLD is the term "mail", and that there is no contention or evidence on the record that previous to its Application, Applicant has ever used it in connection with an offering of goods or services or provision of information, *bona fide* or otherwise.

However, it is clear to the Panel that the application process for a new gTLD requires serious efforts in time, money, and sophisticated technical abilities. In this regard, the Panel notes that the Applicant appears committed to that process, and that its stated purpose is "to establish a dedicated online identity for email" in the delegated portion of the DNS.

The Panel sees no evidence of Objector's contention that the applied-for gTLD has been used or is being prepared to be used in a way that interferes with the legitimate exercise by the Postal Service of its rights. As concluded by the Panel in its opinion under Factor 1, the applied-for gTLD is not similar to any of Objector's compound marks, including U.S. MAIL, MAIL MOMENT and PRIORITY MAIL.

Objector also raises the argument that should the Applicant be awarded the <.mail> TLD, nothing will prevent a third party from registering domain names that directly infringe the Postal Service's marks. Provided that such actions are not attributable to the gTLD operator, there is no reason that operator of a new gTLD should be held responsible for eventual fraudulent or other illegal or reprehensible actions, such as cybersquatting, phishing, pharming, etc. perpetrated by future registrants of domain names in the new gTLD.

Applicant states in its response to Question 29 in the Application that "[i]n order to minimize abusive activities and protect the legal rights of others, the registry will adopt the following policies and practices: - Sunrise Registration Process - Trademark Claims Service - Uniform Rapid Suspension (URS) System - Uniform Domain Name Dispute Resolution Policy (UDRP) - Abusive Use Policy". Whether such measures and other additional precautions proposed by Applicant once the TLD is delegated will be sufficient to afford reasonable protection to trademark owners, the Panel cannot say.

Since Applicant's stated purpose and intended use appears to be legitimate, and there being no evidence to the contrary the Panel finds that Applicant has made demonstrable preparations to use the sign

corresponding to the applied-for gTLD in connection with a *bona fide* offering of goods or services or a *bona fide* provision of information in a way that does not interfere with the legitimate exercise by Objector of its mark rights.

In the circumstances, the Panel does not attach particular importance to this factor.

**6. Whether the applicant has marks or other intellectual property rights in the sign corresponding to the gTLD, and, if so, whether any acquisition of such a right in the sign, and use of the sign, has been *bona fide*, and whether the purported or likely use of the gTLD by the applicant is consistent with such acquisition or use.**

Objector contends that to its knowledge, Applicant does not have marks or other intellectual property rights in the term “mail”.

**Panel’s Findings under Factor 6**

Given that Applicant does not contest Objector’s contention above, the Panel finds that Applicant does not have marks or other intellectual property right in the sign corresponding to the gTLD.

The Panel notes that normally, it should be impossible to obtain a trademark or service mark registration in “mail” to protect the intended use or purpose for the applied-for gTLD as stated in the Application, because “mail” is generic and would be descriptive of the protected goods or services. Under current trademark laws, such registrations usually are forbidden, and they are not protected by international conventions, such as the Paris Convention or TRIPS. In this regard, the Panel notes that presumably the term “mail” is attractive to Applicant because it is monosyllabic *and* descriptive of the purpose or intended use for the applied-for TLD.

For this reason, the Panel finds that the mere lack of marks or other intellectual property rights in the applied-for gTLD does not weigh against Applicant.

**7. Whether and to what extent the applicant has been commonly known by the sign corresponding to the gTLD, and if so, whether any purported or likely use of the gTLD by the applicant is consistent therewith and *bona fide*.**

Objector contends that to its knowledge, Applicant is not commonly known by “mail” or a name including the word “mail”. Applicant does not claim that it has been commonly known by the sign corresponding to the applied-for TLD.

**Panel’s Findings under Factor 7**

Considering the above, the Panel finds that Applicant has not been commonly known by the sign corresponding to the applied-for gTLD. Also, the Panel finds no evidence on the case file suggesting that the purported or likely use of the gTLD by Applicant as stated in the Application might not be *bona fide*.

Accordingly, the Panel believes that this factor should count as neutral.

**8. Whether the applicant’s intended use of the gTLD would create a likelihood of confusion with the objector’s mark as to the source, sponsorship, affiliation, or endorsement of the gTLD.**

Objector contends that the applied-for TLD will create an impermissible likelihood of confusion in U.S. consumers. This likelihood of confusion is impermissible because of the severity of harm such confusion may generate in the form of (1) confusion that <.mail> domains and e-mails are secure and private, when that is not the case, (2) domains and e-mail addresses that are identical to Postal Service registered marks, and (3) phishing, fraud and other abuses of the trust the public places in the Postal Service.

Objector contends that the <.mail> TLD will create impermissible confusion in the form of a false sense of privacy and security in <.mail> domains and e-mails. In the U.S., "mail" is a regulated industry that delivers hard copy correspondence, printed matter, and parcels. Only the Postal Service, a quasi-governmental entity, is entrusted to deliver the "mail." The Postal Service is subject to government regulation and its handling of the nation's mail is governed by federal statutes and regulations. Mail in the United States is granted a high level of privacy under Title 39 of the United States Code. For these reasons, U.S. consumers view "mail" as secure and private. In 2013, the Postal Service was ranked the "Most Trusted" governmental entity and the fourth "Most Trusted" company for privacy in the United States by the Ponemon Institute's "20 Most Trusted Companies for Privacy" survey.

Objector further contends that granting any of the current <.mail> TLD applications is likely to confuse the United States public into giving <.mail> domains and e-mails a similar level of trust as they afford their "mail." The average consumer may be misled into believing that the owners of the <.mail> TLD and second level domains conform to the heightened privacy and security standards afforded by the Postal Service when, in fact, they do not. This will harm not only the Postal Service's goodwill and reputation, but also the consumer whose expectation of privacy was not met. This is particularly true because Applicant proposes to use the <.mail> TLD for e-mail services.

Objector also contends that reportedly, e-mail providers regularly data-mine the contents of e-mail accounts, and that allowing "mail" to be used within a TLD will confuse the public into believing that correspondence from <.mail> addresses is more secure and private than typical e-mail, when that is not necessarily the case.

Objector argues that equally concerning is the possibility that the Postal Service's MAIL-formative marks in their entirety could appear in a domain name or e-mail address such as <us.mail>, <certified.mail>, <priority.mail> or <express.mail>. The Postal Service would have no control over the content located at these domains, nor the quality of the goods and services offered through them. The potential for consumer confusion is thus huge.

Objector further argues that, given that Applicant intends to use the .mail TLD primarily for e-mail account creation, unregulated <.mail> e-mail addresses will be prime tools for fraudulent and criminal activity. For example, an e-mail address containing a confusingly similar mark, such as "info@us.mail", would mislead consumers into believing that the e-mail is associated with the Postal Service, while the existing gTLD Rights Protection Mechanisms are completely inadequate to prevent such confusion. Consumers are vulnerable to criminal schemes because they expect to receive e-mail communications from the Postal Service. E-mail is an integral part of the Postal Service's business because the Postal Service communicates with customers via e-mail in connection with a variety of its services.

Objector concludes that Applicant's intended use of the <.mail> TLD would create an impermissible likelihood of confusion with the MAIL marks by exposing consumers to harmful scams or criminal activity and preventing the Postal Service from protecting its reputation with the public.

Applicant argues, referring to its Application, that it proposes to operate the <.mail> TLD in relation to the services it describes in a secure manner and with the appropriate safeguards. The stated purpose of the <.mail> TLD applied-for is to establish a dedicated online identity for email, online communication, and related products and services. The primary target audience of <.mail> includes Internet and email service providers or email distribution services seeking to differentiate their service through the provision of memorable and intuitive email addresses, vendors of communication technologies who understand the brand power of a TLD with relevance, as well as individuals who wish to take control of their own email identity. The scope and purpose of the applied-for <.mail> TLD is so expressly stated that it leaves no room for ambiguity and Internet users would never expect the <.mail> TLD to relate to postal mail so that any potential confusion with postal mail and entities operating postal mail services in different countries would be completely eliminated and irrelevant.

Applicant recognizes that email is a critical service that is expected to be highly available and reliable, and is committed to providing industry-leading service levels in order to maintain an impeccable reputation for security, reliability and availability.

Applicant states that it will implement proven security measures at every level of business and technical operation in order to provide maximum protection for its stakeholders. This includes stringent security policies and procedures, as well as comprehensive abuse-handling mechanisms to mitigate security threats to the <.mail> TLD. GMO Group comprises globally trusted online security brand GlobalSign and some of the longest established ISP service brands in Japan.

Applicant adds that, in order to minimize abusive activities and protect the legal rights of others, the registry will adopt, *inter alia*, a Sunrise Registration Process, a Trademark Claims Service, the Uniform Rapid Suspension (URS) System, the Uniform Domain Name Dispute Resolution Policy (UDRP), the Trademark Post-Delegation Dispute Resolution Procedures (PDDRP) and a robust Anti-Abuse Policy under which Applicant, as the Registry Operator, will reserve the right to deny, cancel or transfer any registration.

Applicant concludes that abusive use(s) of <.mail> domain names will not be tolerated and contends that allegations from the Objector suggesting otherwise are purely speculative and made in bad faith.

### **Panel's Findings under Factor 8**

The Panel found under Factor 1 that in the context of TLDs, DNS and generally the Internet, "mail" is a generic term, short for "e-mail" or "email" and a descriptive term of a type of digital communication. This Panel finding is based on citations of online dictionaries and thesauri provided by the Parties, on findings by courts and administrative bodies deciding on issues of trademark infringement and opposition to registration of marks, as well as on several UDRP Panel decisions relating to domain names that incorporated the term "mail". Also, it has been shown that Objector does not own a mark in the term "mail" standing alone, but a number of compound marks that merely include this generic term. In addition, the term "mail" is disclaimed in a number of Objector's applications for trademark registration before the USPTO.

From these facts the Panel concluded that any distinctive character that Objector's compound marks may possess is afforded by the combination of "mail" with the remaining element or elements of the marks, and whatever reputation that these compound marks may enjoy benefits the compound and not any of its components singularly. For instance, in the U.S. MAIL mark, the presence of the "U.S." letters, generally known in the United States and probably recognizable in other countries, afford distinctive character to the U.S. MAIL mark, which otherwise would not obtain due to the generic and descriptive character of the "mail" term considered alone. The same applies to other compound marks of Objector that incorporate the term "mail". The Panel then concluded that the applied-for gTLD is not similar to any of Objector's marks. Also, under Factor 4, the Panel found on the evidence that there is no reason for the Panel to assume that Applicant's purpose and intended use for the applied-for gTLD is other than as stated in the Application, in response to Question 18(a), "to establish a dedicated online identity for email, online communication, and related products and services. The primary target audience of .MAIL includes Internet and email service providers or email distribution services seeking to differentiate their service through the provision of memorable and intuitive email addresses, vendors of communication technologies who understand the brand power of a TLD with relevance, as well as individuals who wish to take control of their own email identity."

Having in mind that Applicant, as stated in the Application and the Response, intends to use the applied-for gTLD based on its generic character and as an equivalent of "email" or e-mail", and descriptively in relation to a type of digital communication and related activities, the Panel finds that Applicant's intended use for the applied-for gTLD would not create a likelihood of confusion with the objector's mark as to the source, sponsorship, affiliation, or endorsement of the gTLD.

## **Conclusion**

In conclusion, the Panel finds as follows:

The applied-for gTLD does not:

- (i) take unfair advantage of the distinctive character or the reputation of the objector's registered or unregistered trademark or service mark, or
- (ii) unjustifiably impair the distinctive character or the reputation of the objector's mark, or
- (iii) otherwise create an impermissible likelihood of confusion between the applied-for gTLD and the objector's mark.

## **7. Expert Determination**

For the above reasons, the Objection is rejected.

[signed]

**Roberto Bianchi**  
Sole Panel Expert  
Date: July 30, 2013