

EXPERT DETERMINATION LEGAL RIGHTS OBJECTION

United States Postal Service v. Amazon EU S.à.r.l

Case No. LRO2013-0044

1. The Parties

The Objector/Complainant is United States Postal Service of Washington, D.C., United States of America, represented by Lewis and Roca LLP, United States. The Objector is referred to in this decision as ‘the Objector’, ‘United States Postal Service’ or ‘USPS’.

The Applicant/Respondent is Amazon EU S.à.r.l of Luxembourg, represented by Covington & Burling LLP, United States. The Applicant/Respondent is referred to in this decision as ‘the Applicant’, or ‘Amazon’.

2. The applied-for gTLD string

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

3. Procedural History

The Legal Rights Objection (“Objection”) was filed by 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 Respondent of the Objection, and the proceedings commenced on April 18, 2013.

The WIPO Center on April 25, 2013 received a proposal from the Objector to consolidate the LRO Objections LRO2013-0043 to LRO2013-0048 (inclusive). On May 3, 2013 the Applicant advised that it did not object to the Objector’s request for consolidation. However, another affected LRO party indicated opposition. 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.

In accordance with Article 11(b) and relevant communication provisions of the Procedure, the Response was timely filed with the WIPO Center on May 18, 2013.

The WIPO Center received an unsolicited additional submission from the Objector on May 29, 2013, and on May 31, 2013, the Applicant submitted a communication to the WIPO Center indicating it was preparing a submission in opposition to the Objector's unsolicited submission of May 29, 2013. The Applicant submitted such communication on June 13, 2013.

The WIPO Center appointed David J.A. Cairns 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 Impartiality and Independence, as required by the WIPO Center to ensure compliance with Article 13(c) of the Procedure and Paragraph 9 of WIPO Rules for New gTLD Dispute Resolution.

On July 10, 2013 the Objector submitted a Request for Hearing. On July 12, 2013 the Applicant advised that it opposed the request for a hearing and intended to submit arguments in support of its opposition.

4. Factual Background

The Objector is an independent establishment of the Executive Branch of the Government of the United States, and the only Designed Postal Operator of the United States. The United States Postal Service is the world's largest mail carrier, delivering 40% of the world's card and letter volume.

The Objector holds various US trademark registrations that include the words "U.S. MAIL" including: (i) Reg. No. 1,150,641 for a design consisting of a figure holding a letter and carrying a small bag bearing the wording U.S. MAIL; (ii) Reg. No. 2,431,839, for a design mark consisting of a stylized eagle mounted above the wording U.S. MAIL, within a double border; (iii) Reg. No. 3,720,179 for a design featuring a mounted horse rider carrying a bag bearing the words U.S. MAIL, within a double border; (iv) Reg. No. 3,170,355 for a design consisting of a figure ('Mr Zip') holding a letter and carrying a small bag bearing the words U.S. MAIL; (v) Reg. No. 2,960,663 for a design consisting of a figure ('Mr Zip') holding a letter and carrying a small bag bearing the words U.S. MAIL; (vi) Reg. No. 4,031,772 for a design mark consisting of a stylized eagle mounted above the wording U.S. MAIL surrounded by a border comprised of the words 'United States Postal Service' and nine five pointed stars, and with a disclaimer that "No claim is made to the exclusive right to use MAIL, apart from the mark as shown"; (vii) Reg. No. 3,799,543 for a design mark consisting of a stylized eagle mounted above the wording U.S. MAIL surrounded by a border comprised of the words 'United States Postal Service' and nine five pointed stars; and (viii) Reg. No. 3,761,332 for a design mark consisting of a stylized eagle mounted above the wording U.S. MAIL surrounded by a border comprised of the words 'United States Postal Service' and nine five pointed stars.

In addition the Objector owns various international trademarks containing the words U.S. MAIL. These are design marks with the exception of registration number 31,815 in the trademark office of Andorra for the mark U.S. MAIL, registered on February 14, 2013.

The Objector also owns many other trademark registrations that include the word MAIL, such as: AIR MAIL; BECAUSE THE MAIL MATTERS; BUSINESS REPLY MAIL; CERTIFIED MAIL; CRITICAL MAIL; EVERY DOOR DIRECT MAIL; EXPRESS MAIL; EXPRESS MAIL INTERNATIONAL; FIRST-CLASS MAIL; FIRST-CLASS MAIL INTERNATIONAL; FRIEND-TO-FRIEND MAIL; GLOBAL EXPRESS MAIL; GLOBAL PRIORITY MAIL; INTELLIGENT MAIL; MEDIA MAIL; PRIORITY MAIL; PRIORITY MAIL INTERNATIONAL; STANDARD MAIL; TODAY'S MAIL; and MAIL MOMENT. Many of the US registrations for these trademarks include a disclaimer of the word 'mail'.

The Applicant was founded in 1994, and is an online retailer. The nature of its business and its proposed use of the <.mail> gTLD are described in its 'New gTLD Application Submitted to ICANN' (Question 18(a): *"Describe the mission/ purpose of your proposed gTLD"*):

“Amazon seeks to be Earth’s most customer-centric company, where customers can find and discover anything they might want to buy online, and endeavours to offer its customers the lowest possible prices. Amazon and other sellers offer millions of unique new, refurbished and used items in categories such as Books; Movies, Music & Games; Digital Downloads; Electronics & Computers; Home & Garden; Toys, Kids & Baby; Grocery; Apparel, Shoes & Jewelry; Health & Beauty; Sports & Outdoors; and Tools, Auto & Industrial. Amazon Web Services provides Amazon’s developer customers with access to in-the-cloud infrastructure services based on Amazon’s own back-end technology platform, which developers can use to enable virtually any type of business.

...

The mission of the .MAIL registry is:

To provide a unique and dedicated platform for Amazon while simultaneously protecting the integrity of its brand and reputation.

A .MAIL registry will:

- *Provide Amazon with additional controls over its technical architecture, offering a stable and secure foundation for online communication and interaction.*
- *Provide Amazon a further platform for innovation.*
- *Enable Amazon to protect its intellectual property rights.”*

The responses to Question 18(b) (*“How do you expect that your proposed gTLD will benefit registrants, Internet users, and others?”*) include the following:

“The .MAIL registry will benefit registrants and internet users by offering a stable and secure foundation for online communication and interaction.

What is the goal of your proposed gTLD in terms of areas of specialty, service levels or reputation? Amazon intends for its new .MAIL gTLD to provide a unique and dedicated platform for stable and secure online communication and interaction. The .MAIL registry will be run in line with current industry standards of good registry practice.

What do you anticipate your proposed gTLD will add to the current space in terms of competition, differentiation or innovation?

Amazon values the opportunity to be one of the first companies to own a gTLD. .MAIL registry will:

- *Provide Amazon with additional controls over its technical architecture, offering a stable and secure foundation for online communication and interaction.*
- *Provide Amazon a further platform for innovation.*
- *Enable Amazon to protect its intellectual property rights.*

What goals does your proposed gTLD have in terms of user experience? Amazon intends for its new .MAIL gTLD to provide a unique and dedicated platform for stable and secure online communication and interaction.”

The response to Question 18(c) (*“What operating rules will you adopt to eliminate or minimise social costs?”*) includes the following:

“Amazon intends to initially provision a relatively small number of domains in the .MAIL registry to support the business goals of Amazon. These initiatives should not impose social costs of any type on consumers...

Domains in the .MAIL registry will be provisioned to support the business goals of Amazon. ...”

5. Parties' Contentions

A. Objector

The Objector states that the <.mail> TLD will create an impermissible likelihood of confusion and harm to the public if delegated to a private entity. The Objector elaborates its arguments in support of the Objection under eight headings.

First, the Objector states that consumers will expect the <.mail> gTLD to originate from the United States Postal Service, the sole regulated source of 'mail' delivery in the United States. It states that 'mail' cannot be viewed as a simple common term within the context of the <.mail> gTLD. The <.mail> string creates a likelihood of confusion and danger of public harm given: (i) The public associates 'mail' with the United States Postal Service (noting the function of the United States Postal Service and various definitions of the term 'mail'); (ii) consumers will view the <.mail> TLD as a source-indicative TLD (arguing that source-indicative TLDs such as <.gov> and <.int> are known by the public to be regulated and thus are afforded a greater level of trust, and consumers will not expect <.mail> TLD to identify a private, unregulated entity, especially since 'mail' delivery is an essential governmental function and the Objector delivers over 40% of the world's mail); and (iii) confusion will be exacerbated by the recent launch of the <.post> sponsored TLD (arguing that the <.mail> TLD is likely to be viewed as the equivalent of the recently launched .post sTLD).

Second, the Objector states that it owns over 240 trademark registrations for marks including the word 'mail' issued by the U.S. Patent and Trademark Office and the trademark offices of 51 other countries.

Third, the Objector states that it owns *bona fide* rights in the U.S. MAIL trademark, which is famous and well known. It provides evidence on the use of U.S. MAIL on, for example, its vehicles, the uniforms of its staff, its website and its buildings. It states that the U.S. MAIL trademark has been used for nearly 200 years, and is subject to multiple registrations, including nine U.S. registrations as well as over a dozen registrations and applications internationally. Finally, it states that the U.S. MAIL mark forms part of the United States Postal Service's official seal, and that this seal is protected by Article 6ter of the Paris Convention.

Fourth, the Objector states that the <.mail> TLD will create an impermissible likelihood of confusion in the form of: (i) confusion that <.mail> domains and e-mails are secure and private, when that is not the case (arguing that the average consumer may be misled into believing that the <.mail> TLD and second level domains conform to the heightened privacy and security standards afforded by the United States Postal Service); (ii) domains and e-mail addresses that are identical to the Objector's registered marks, including <us.mail>, <certified.mail>, <priority.mail>, <express.mail> with 'huge' potential for consumer confusion; and (iii) phishing, fraud and other abuses of the trust the public places in the United States Postal Service (on the basis that if the Applicant uses the <.mail> gTLD for e-mail account creation, then unregulated <.mail> e-mail addresses will be prime tools for fraudulent and criminal activity, citing as an example <info@us.mail>).

Fifth, the Objector refers to the Applicant's intent in applying for the <.mail> gTLD. The Objector states that the Applicant intends to operate <.mail> as a "closed" registry for its own purposes but does not specify those purposes. The Objector states that the Applicant presents no specific information as to how the platform will be innovative, nor does Applicant state its business goals.

Sixth, the Objector states that the Applicant has used or made preparations to use the <.mail> gTLD in a way that interferes with the legitimate exercise by the Objector of its rights. The Objector states that the <.mail> gTLD is confusingly similar to many of its trademarks, including U.S. MAIL, MAIL MOMENT and PRIORITY MAIL where the only difference between the <.mail> gTLD and these marks is a single term. The Objector states that the proposed use will block its access to <.mail> registrations, and nothing will prevent Applicant from registering second-level names on <.mail> (such as <us.mail> or <priority.mail>) which will infringe its trademarks and confuse consumers, and open the door to fraud, scamming, phishing, and other false or misleading schemes aimed at acquiring private data from consumers.

The Objector states that the Applicant's intended use of the <.mail> gTLD as a closed registry further

interferes with the United States Postal Service' exercise of its legitimate rights because the United States Postal Service would not be able to obtain a Sunrise Registration. Moreover, under the Applicant's planned operation of the <.mail> gTLD, the Objector's Uniform Domain Name Dispute Resolution Policy (UDRP) or Uniform Rapid Suspension (URS) remedies would be restricted.

Seven, the Objector states that Applicant does not have marks or other intellectual property rights in the term 'mail'.

Finally, the Objector states that the Applicant is not commonly known by 'mail'.

On May 29, 2013 the Objector submitted a 'Request for Additional Submissions to Supplement Legal Rights Objection'. In this document the Objector requested *"permission to submit a survey concerning the primary meaning of 'MAIL' in the minds of U.S. consumers, as well as the accompanying expert report."* This request was accompanied by an expert report by Dr. Alex Simonson entitled 'A Test to Determine the Meaning of the Term 'mail' to the General Population of the United States' dated May 19, 2013, and five appendices including (in Table 6 to Appendix E) the individual responses to the survey questionnaire (hereafter "Objector's Survey Evidence"). In support of its request the Objector argued that the Procedure contemplates additional submissions (Section 3.4.5 of the gTLD Applicant Guidebook and Article 17(a) of the Procedure), and that the Objector's Expert Report should be accepted by the Panel to assist its decision because the Objector's Survey Evidence is necessary to rebuff incorrect assumptions in the Applicant's Response, surveys are common tools in trademark cases, and the admission of the Objector's Survey Evidence would aid the Panel in its determination. The Objector also suggests that *"Applicant be given any reasonable time required to prepare and submit its own survey evidence for the Panel's consideration. USPS further suggests that the parties be allowed additional written submissions regarding the meaning of the survey(s)"*.

In its Request for Hearing the Objector requested a hearing by videoconference as contemplated by Article 19(c) of the Procedure as extraordinary circumstances existed and the dispute did not lend itself to a decision on the pleadings alone.

B. Applicant/Respondent

The Applicant states that the application for the <.mail> gTLD is based on a dictionary word in which the Objector has failed to prove its trademark rights. It states that the application should be upheld because the potential use of the applied-for gTLD by Amazon does not: (i) take unfair advantage of the distinctive character or the reputation of the Objector's registered or unregistered trademarks or service marks; or (ii) unjustifiably impair the distinctive character or the reputation of the Objector's marks; or (iii) otherwise create an impermissible likelihood of confusion between the Amazon's applied-for gTLD and the Objector's marks.

The Applicant states that the United States Postal Service LRO is based on three arguments: (i) U.S. consumers will view the dictionary-word <.mail> gTLD as USPS-source identifying; (ii) USPS owns extensive trademark rights in marks that consist of U.S. MAIL or contain the word 'mail'; and (iii) Amazon's application for the <.mail> gTLD creates an impermissible likelihood of confusion. The Applicant states that these arguments are simply not credible. It further states that analysis of the eight factors set forth in Section 3.5.2 of the gTLD Applicant Guidebook demonstrates that the Panel should dismiss USPS's LRO.

First, the Applicant states that the applied-for gTLD is not identical or confusingly similar to the Objector's existing trademarks. It states that the Objector does not own enforceable trademark rights in the word 'mail'. It states that the Objector must prove that it actually owns enforceable and relevant rights in a 'mail' mark before it can rely on those rights in this proceeding (which the Applicant states should be shown to exist in United States law which accordingly is the law examined in the Response). The Applicant states that the Objector has not proven its ownership of enforceable and relevant rights in the word 'mail' or a mark that consists solely of the word 'mail'.

The Applicant argues that USPS has provided no evidence of trademark rights in marks that consist solely of MAIL. The Applicant states that *“Amazon does not dispute that USPS owns trademark rights in the U.S. MAIL mark and the various design marks containing U.S. MAIL and other marks that contain the word MAIL, such as the Postal Service Seal. However, USPS owns trademark rights in the composite marks, such as the entire Postal Service Seal, not in the MAIL element of those marks.”* [emphasis original]

Further, the Applicant states that USPS has expressly disclaimed exclusive rights to use ‘mail’ in the vast majority of the U.S. registrations for its composite MAIL-containing marks. The Applicant states that such a disclaimer is an admission of descriptiveness, which justifies giving less weight to the disclaimed element in assessing likelihood of confusion. It says that the Objector cannot argue that <.mail> is confusingly similar to any of the marks in which it has disclaimed ‘mail’.

The Applicant adds that some registrations of USPS’s composite marks do not contain disclaimers because the marks identify goods and services for which ‘mail’ is not generic or descriptive, such as luggage tags, clothing, and money orders, or the element ‘mail’ combines to create a new word or a longer phrase in which ‘mail’ is a minor element. For these reasons the Applicant states that the Objector’s U.S. trademark registration practice makes clear that it has not claimed exclusive rights to the word ‘mail’ and should not now be permitted to do so in this proceeding.

The Applicant further states that the Objector’s LRO improperly seeks to take the dictionary word ‘mail’ out of the English language for its exclusive use. It states that the Objector cannot claim exclusive use of the dictionary word ‘mail’ for all goods and services, including those for which ‘mail’ is generic or descriptive. It refers to the term ‘email’ and concludes that MAIL is a non-distinctive, non-trademark term for delivery of hard copy correspondence and postal-related goods and services.

Finally under this heading the Applicant states that even if the Objector could prove that it owns trademark rights in the word ‘mail’, it cannot appropriate a descriptive term for its exclusive use and so prevent others from accurately describing a characteristic of their goods. Further, the Applicant states that the *“.MAIL gTLD is not identical or confusingly similar to any of the marks in which USPS does have enforceable, relevant rights, such as the U.S. MAIL mark or the Postal Service seal. .MAIL does not look similar or sound similar to U.S. MAIL, PRIORITY MAIL, or any of the other registered marks upon which USPS purports to rely. It shares only the dictionary-word element in which USPS fails to show its own trademark rights. Nor does .MAIL have a similar meaning to any of these marks, most if not all of which relate to hardcopy mail delivery services performed by USPS. Amazon has no current intent to use the .MAIL registry to provide hard copy mail delivery services comparable to those provided by USPS”*.

Second, the Applicant states that the Objector exaggerates its rights in ‘mail’ and has failed to prove that it has valid trademark rights in the dictionary word ‘mail’.

Third, the Applicant states that the Objector offers no evidence that the public recognises ‘mail’ as its trademark, and refers to the use of the word mail in everyday expressions such as ‘email’, ‘voicemail’ and ‘mail me’. It states that there are hundreds of third-party U.S. registrations for trademarks that contain ‘MAIL’ (which further demonstrate consumers do not currently recognize MAIL as a trademark owned by anyone) and hundreds of third-party uses of the word ‘mail’ (referring to Google searches). The Applicant also rejects the Objector’s contention that consumers will expect the <.mail> gTLD to originate from the United States Postal Service.

Fourth, the Applicant states that it applied for the <.mail> gTLD in good faith and without any intent to infringe or otherwise violate the Objector’s rights. Moreover, the Applicant states that it *“does not intend to use .MAIL in a way that violates USPS’s actual rights in its trademarks”*.

Fifth, the Applicant states that it will use the <.mail> gTLD for *bona fide* offerings of goods or services in a manner that will not interfere with the Objector’s exercise of its intellectual property rights. It further states that *“Amazon has no current intent to use the .mail registry to provide hardcopy mail delivery services comparable with those provided by [the Objector]”* and *“Amazon will use .mail to further Amazon’s own*

legitimate non-infringing business purposes”.

Sixth, the Applicant states that it bases its right to use the <.mail> gTLD on the right to use for registry services a dictionary word in which the Objector has failed to prove trademark rights.

Seventh, the Applicant states that its likely use of the <.mail> gTLD string is *bona fide* and will be to further Amazon’s legitimate business goals.

Eighth, the Applicant states that its intended use of the <.mail> gTLD will not create a likelihood of confusion with the Objector’s trademark as to the source sponsorship, affiliation or endorsement of .mail. It states that the Objector’s arguments of consumer confusion are speculative. The Applicant states that *“Amazon has no intention of infringing use of USPS’s legitimate marks on similar services through creation of second-level domains or email using those marks....Further, USPS’s concerns about fraud and security are unfounded. Amazon will have complete control over the .MAIL registry and will take appropriate steps to prevent fraudulent or criminal activity...”* (referring to the response to question 28 in the Applicant’s ‘New gTLD Application Submitted to ICANN’).

The Applicant refers to a standard legal test in the United States in relation to likelihood of confusion derived from the United States Court of Appeals for the Ninth Circuit decision in *Rearden LLC v. Rearden Commerce*, 683 F.3d 1190, 1209-10 (9th Circuit, 2012). The Applicant examines the eight factors referred to in this case, being (i) the similarity of the marks; (ii) the relatedness of the underlying goods or services; (iii) the marketing channels used; (iv) the strength of the senior mark; (v) the degree of consumer care; (vi) the likelihood of expansion of the goods or services; (vii) evidence of actual confusion, and (viii) the intent of the junior user.

The Applicant concludes that the Objector’s LRO should be dismissed.

The Applicant also submitted an ‘Opposition to United States Postal Service Request for Additional Submissions to Supplement Legal Rights Objections’ dated June 12, 2013. The Applicant opposed the request to make an additional submission to present the Objector’s Survey Evidence. It argued that the Objector had not demonstrated that an additional submission was justified. Further, this LRO proceeding was not the appropriate forum to consider a secondary meaning survey and the Objector’s Expert Report, and in any event ‘mail’ is a generic term and the survey *‘does not somehow change a generic term into a protectable mark’*. Further, the Applicant says there are significant flaws in the survey. Finally, if the Panel grants the Objector’s request then the Applicant requested two months in which to prepare and submit a complete substantive response to the Objector’s Survey Evidence.

6. Discussion and Findings

(a) Additional Submissions/Objector’s Survey Evidence: The Panel deals first with the Objector’s request to submit the Objector’s Survey Evidence, and the Applicant’s opposition to this request.

This request invokes two distinct powers. Firstly, there is the power of the Panel to decide whether there should be additional written submissions (Procedure, Article 17; gTLD Applicant Guidebook Section 3.4.5, first sentence). Secondly there is the power of the Panel to require a party to provide additional evidence (Procedure, Article 18; gTLD Applicant Guidebook, Section 3.4.5 second sentence). The power to require additional evidence is limited to ‘exceptional cases’ while the power to request additional submissions is subject only to the need to fix a time limit. Both powers are subject to the due process rule that *“the Panel shall ensure that the parties are treated with equality, and that each party is given a reasonable opportunity to present its position”* (Procedure, Article 4(e)).

The Applicant submitted that the Panel should apply the same standard to the admission of new submissions as has developed under the UDRP Rules where the prevailing view is that *“additional evidence or submissions should only be admitted in exceptional circumstances, such as where the party could not*

reasonably have known the existence or relevance of the further material when it made its primary submission; that if further material is admitted, it should be limited so as to minimise prejudice to the other party..." (per *Mejeriforeningen Danish Dairy Board v. Cykon Technology Limited*, WIPO Case No. D2010-0776). However, as already noted 'exceptional circumstances' is the standard in the Procedure for additional evidence, and the failure to require exceptional circumstances for additional submissions can be assumed to be intentional. This is consistent with the more expansive nature of the LRO procedure in comparison with the UDRP procedure, while at the same time requiring the presentation of the additional submissions within time limits.

The function of this proceeding is to provide an expedited expert determination to ICANN ("*[t]he findings of the panel will be considered an expert determination and advice that ICANN will accept within the dispute resolution process*": gTLD Applicant Handbook, Module 3, Section 3.4.6). The process is intended "*to achieve the goal of resolving disputes rapidly and at reasonable cost*" (gTLD Applicant Handbook, Section 3.4.5; see also Article 18 of the New gTLD Dispute Resolution Procedure). The Parties have both accepted the Procedure and done so without prejudice to their legal rights in other *fora*. Other *fora* may be better placed for the detailed examination of certain types of evidence, particularly expert evidence, and to the exchange of multiple rounds of submissions. The Parties may attend to these *fora* if they so wish.

The Objector has primarily requested permission to submit the Objector's Expert Report as additional evidence. The Objector anticipates (and the Applicant requests) the submission of further survey evidence in response. Accordingly, the Objector also requests permission for both Parties to present additional written submissions regarding the meaning of the surveys.

The Panel considers that there are no exceptional circumstances to justify the admission of the Objector's Expert Report. It is presented as additional evidence to address a matter raised in its original Objection. It is in the nature of reply evidence in a procedure that does not contemplate a reply. Both Parties have had an equal and reasonable opportunity to present their positions on the association of the Objector with 'mail' in the United States.

Further, survey evidence is a difficult form of evidence to evaluate, as the Objector acknowledges by its request to present written submissions regarding the meaning of the survey. Nor does the Objector's Survey Evidence directly address the Objector's legal rights or recognition of its trademarks; rather it addresses the alleged association of the word 'mail' with the Objector in the United States. It does not necessarily follow that the fact that consumers associate 'mail' with the Objector means that the Objector has any legal rights in the word 'mail' (it may, for example, mean no more than U.S. consumers know the identity of their mail service provider). Had the survey been completed earlier it could have been submitted with the Objection, and the Applicant (and the Panel) would have had to deal with its implications. However, this is not the case, and there are no 'exceptional circumstances' that justify the Panel opening a separate procedure for the consideration of survey evidence after the submission of the Applicant's Response.

The procedural ramifications of the admission of the Objector's Expert Report at this stage would violate the express goal of the Procedure "*of resolving disputes rapidly and at reasonable cost*" (gTLD Applicant Guidebook, Section 3.4.5.)

In any event, the Panel is satisfied that the Objection and the Response provide sufficient evidence and argument to identify the nature of the Objector's legal rights.

For these reasons the request to submit the Objector's Expert Report is refused.

(b) Request for Hearing: The Panel also finds that there are no 'exceptional circumstances' to justify a hearing, which is accordingly refused. The Request for Hearing was based in part on the need to interpret survey evidence if admitted by the Panel. The other circumstances relied upon by the Objector amount to no more than a request to make further submissions. As the Panel has stated, it is satisfied that the Objection and the Response provide sufficient evidence and argument to identify the nature of the Objector's legal rights.

(c) The Legal Standard for the Determination of a Legal Rights Objection: An Existing Legal Rights Objection refers to the objection that the string comprising the potential new gTLD infringes *“the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law.”* The grounds on which an Existing Legal Rights Objection may be made are set out in full in Module 3 of the gTLD Applicant Guidebook, and are based upon the Final Report on the Introduction of New Generic Top-Level Domains dated August 7, 2007, issued by the ICANN Generic Names Supporting Organization (GNSO).

Article 20(a) of the Procedure requires the Panel to *“apply the standards that have been defined by ICANN”* to the determination of an Existing Legal Rights Objection. Article 20(b) states that: *“In addition, the Panel may refer to and base its findings upon the statements and documents submitted and any rules or principles that it determines to be applicable.”* Article 20(c) states that: *“The Objector bears the burden of proving that its Objection should be sustained in accordance with the applicable standards.”*

The ‘standards defined by ICANN’ referred to in Article 20(a) of the Procedure are set out in Section 3.5 (‘Dispute Resolution Principles (Standards)’) of Module 3 (‘Dispute Resolution Procedures’) of the gTLD Applicant Guidebook. The standards in relation to Legal Rights Objections appear in Section 3.5.2 which reads as follows (omitting the references to the names or acronyms of Intergovernmental Organizations that are not relevant in the present case):

“3.5.2 Legal Rights Objection

In interpreting and giving meaning to GNSO Recommendation 3 (“Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law”), a DRSP 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....”

In the case where the objection is based on trademark rights, the panel will consider 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.*
- 2. Whether the objector’s acquisition and use of rights in the mark has been bona fide.*
- 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.*
- 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.*
- 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.*
- 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.

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.*

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."*

Section 3.5 also states that the Panel may "*refer to other relevant rules of international law in connection with the standards.*"

The Panel's duty is therefore to apply a multi-layered standard. At the highest level, GNSO Recommendation 3 establishes a mandatory rule that "*Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law*". Internationally recognized principles of law include trademark rights (such as, but not limited to, the rights defined in the Paris Convention on the Protection of Industrial Property).

The second layer of the standard requires the Panel to determine whether the potential use of the applied-for gTLD falls within one (or more) of the three defined circumstances in Section 3.5.2. However, while the Panel is required to address these circumstances, Section 3.5.2 does not define the effect of the determination; rather the Panel must use this determination "*in interpreting and giving meaning to GNSO Recommendation 3*"; in other words, to guide an assessment as to whether the string in question infringes the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law.

The third layer consists of eight non-exclusive factors that the Panel must address ("will consider") when the objection is based on trademark rights. Although it is not expressly stated, the purposes of the Panel's consideration of these factors is to enable it to make the determinations required in the second layer of the standard. These eight factors refer to a number of concepts that are familiar in international trademark law or in domain name dispute resolution under the UDRP Policy. The factors refer to the strength of the Objector's trademark rights (factors 2, 3 & 4), the nature of the Applicant's trademark rights (factors 3, 5, 6, & 7), the Applicant's intentions and proposed use of the gTLD (factors 4, 5, 6, & 7); and the similarity and likelihood of confusion between the Objector's trademark rights and the gTLD (factors 1 & 8).

Finally, the Legal Rights Objection procedure does not require the Panel to make any abstract determination of the suitability of the applied-for gTLD registry. The Public Interest and Community Objections procedures are available to address some broader concerns. The third-layer factors demonstrate that the Legal Rights Objection procedure involves a determination of a 'party-specific' and 'application-specific' objection. There may be multiple applicants and multiple objectors in respect of the same gTLD string, and each must succeed or fail on its own merits.

(d) Determination of the LRO: The starting point for the determination in this case is a precise definition of the Objector's trademark rights.

The Objector has no registered trademark for the word mark MAIL. Many of its US trademark registrations include a disclaimer of the word MAIL. The effect of the disclaimers is twofold. On the one hand, a disclaimer is an admission that the disclaimed word is descriptive. On the other hand, the disclaimed material still forms part of a composite mark, and is not ignored in determining the likelihood of confusion (*cf.* McCarthy on Trademarks and Unfair Competition (4th ed.) §19:65 and §19:72).

The Objector made various arguments to suggest a public association of 'mail' with the United States Postal Service, or that the public will view <.mail> gTLD as a source-indicative TLD. However, the Objector has not demonstrated that it is known simply as 'mail', or that 'mail' is used as a trademark.

The Panel considers that 'mail' is a descriptive and generic term for the material sent or carried in the postal system, or alternatively a nation's postal system in general. The fact that a nation's postal system is vested by statute or otherwise associated with a single entity does not convert the generic term into a trademark. Further, the fact that a particular service provider is called to mind by consumers when prompted by the name of a service does not infuse a generic term with trademark significance (see McCarthy on Trademarks and Unfair Competition (4th ed.) §12.11, referring to *Eastern Air Lines, Inc. v. New York Air Lines, Inc.*, 559 F. Supp. 1270, 1275, 218 U.S.P.Q. 71, 75 (S.D. N.Y. 1983) and explaining that the mere fact that a survey respondent answered 'Eastern Air Lines' when he heard the word 'shuttle' does not necessarily prove that 'shuttle' is a trademark. *"All that it demonstrates is that a likely response to any generic word is the name of the best known producer or manufacturer of that product"*).

For these reasons, the Panel finds that the Objector has not demonstrated any legal rights in the word MAIL, and turns now to the mark U.S. MAIL.

The United States trademark registrations presented in evidence (Objector's Exhibit 29) involve design marks where the text U.S. MAIL is part of a composite design featuring other elements. USPTO registration N° 4,031,772 dated September 27, 2011 includes a disclaimer that *"No claim is made to the exclusive right to use 'Mail', apart from the mark as shown"*. In the United States there is no registration for the word mark U.S. MAIL, although the Objector has filed a trademark application for this word mark on March 5, 2013 (N° 85867833). Internationally, the word mark U.S. MAIL was registered by the Objector in Andorra on February 14, 2013. The Objector's seal includes the wording U.S. MAIL, but also as part of a composite seal including the stylized eagle and the border consisting of the words 'United States Postal Service' and nine five-pointed stars.

The Objector provided evidence of use of the U.S. MAIL trademark that could support an unregistered trademark under U.S. law. The majority of this evidence involved the use of the wording U.S. MAIL in conjunction with the same design elements that appear in the registered trademarks, but there is also evidence of trademark use of the word mark U.S. MAIL. Further, the Applicant concedes that the Objector has rights in the word mark U.S. MAIL (*"Amazon does not dispute that USPS owns trademark rights in the U.S. MAIL mark and the various design marks containing U.S. MAIL and other marks that contain the word MAIL, such as the Postal Service Seal"*).

In addition to its rights in U.S. MAIL, the Objector also owns many other trademarks that include the word 'mail' as described above. The existence of these trademarks rights (in many cases with a disclaimer of 'mail') is not disputed.

The first factor to consider in the third layer of the standard in Section 3.5.2 is whether the <.mail> gTLD is identical or similar with the Objector's existing trademarks. The Panel concludes that the <.mail> gTLD is not identical but is similar in appearance to various trademarks of the Objector, and in particular is similar to the U.S. MAIL trademark, in that the applied-for gTLD string appears in its entirety in the Objector's trademarks.

There is no question that the Objector's acquisition and use of its trademark rights has been *bona fide*.

As to the third factor, the Panel concludes that there is no recognition by the public that 'mail' is a mark of the Objector, of the Applicant or of a third party. As already noted, the Panel considers that 'mail' is a generic term, and any association with the Objector is a result not of the recognition of 'mail' as a trademark.

The fourth, fifth, sixth and seventh factors relate to the Applicant's intentions and proposed use of the <.mail> gTLD. The Applicant has not denied that it knew of the Objector's trademarks at the time of its application for the <.mail> gTLD. An applicant for a new gTLD can be assumed to have made a trademark search on the string proposed, which in this case would have revealed the Objector's trademarks including the word 'mail'. Accordingly, the Panel concludes the Applicant knew of the Objector's trademarks.

There is no evidence of any pattern of conduct by the Applicant of seeking gTLDs that are identical or confusingly similar to the trademarks of others.

There is no evidence that the Applicant has any intellectual property rights in the word 'mail', or has been commonly known by any name comprising or including the word 'mail'.

The Applicant has been reticent regarding its proposed use of the gTLD. The Applicant's 'New gTLD Application Submitted to ICANN' (answers to Questions 18(a) and 18(b) set out above) describes the purposes of the <.mail> gTLD in generic terms without reference to any particular product or services except 'online communication and interaction' and 'the business goals of Amazon'. The Response filed in this proceeding describes the likely use of the <.mail> gTLD minimalistically as *"to further Amazon's legitimate business goals"* (page 10). It also states that *"Amazon has no current intent to use the .MAIL registry to provide hardcopy mail delivery services comparable to those provided by USPS"* (page 9, emphasis added).

The Panel concludes that the Applicant does not wish to disclose in any detail its plans for the <.mail> gTLD registry. The evidence does not enable the Panel to identify the goods and services in respect of which the <.mail> gTLD will be used, except that it will involve 'online communication and interaction' in 'support of the business goals of Amazon'. It may in future be used in relation to hardcopy mail delivery services. On the other hand, there is no evidence currently before the Panel to call into question the *bona fides* of the Applicant, or to suggest that the Applicant will in future use the <.mail> gTLD in a way that might interfere with the legitimate exercise by the Objector of its trademark rights.

The final factor requires the Panel to consider whether the Applicant's intended use of the gTLD would create a likelihood of confusion with the Objector's trademarks as to the source, sponsorship, affiliation or endorsement of the gTLD. For the purposes of this assessment and consistent with the Applicant's own reluctance to reveal its business purposes, the Panel assumes the use might relate to any aspect of the Applicant's business and may in future include hardcopy mail delivery services.

The Panel concludes that confusion between the word mark U.S. MAIL and the <.mail> gTLD as to source or affiliation is possible but is likely to be reduced in extent and time. The Panel accepts that some US consumers may associate, at least initially, the <.mail> gTLD with the trademark U.S. MAIL, that is, with the Objector. There is also a risk, in theory at least, of confusion (both with the U.S. MAIL trademark and other registered trademarks consisting of composite phrases concluding with the word 'mail' such as CERTIFIED MAIL or PRIORITY MAIL) through the reproduction of the entire trademark in the second level and top level portions of the domain name (e.g. <us.mail>, <certified.mail> or <priority.mail>).

U.S. MAIL as a word mark consists of two descriptive elements, with the MAIL element disclaimed by the Objector in trademark applications. The only registration for U.S. MAIL as a word mark is in Andorra and postdates the Applicant's gTLD submission. The evidence demonstrates that the Objector's use of U.S. MAIL has largely been as part of a design mark (particularly the design mark incorporating the elements of an eagle, nine stars and the words United States Postal Service) and efforts to establish U.S. MAIL as a word mark are recent. The possibility of confusion arises from the long association of US consumers of their mail service with its sole provider, rather than from the similarity of any trademark with the Applicant's proposed gTLD.

The use of U.S. MAIL as an element in design marks will not be directly affected by the <.mail> gTLD, and it has not been suggested that the distinctiveness of the registered design marks will be impaired by the gTLD. 'Mail' is a generic word, and the Panel has not been presented with indications that over time US consumers will be unable to distinguish between the providers of a mail delivery service under various trademarks, including U.S. MAIL, and online business services under the <.mail> gTLD. Finally, any risks of confusion are likely to be reduced by the Applicant's proposed use of the <.mail> gTLD as a closed registry. In this regard, the Panel notes the Applicant has stated that it *"has no intention of infringing use of USPS's legitimate marks or similar services through creation of second-level domains or email using those marks."*

On the basis of this consideration of the eight third-layer factors the Panel now returns to ask whether there is an impermissible likelihood of confusion between the <.mail> gTLD and the Objector's trademarks. The Panel notes that an impermissible likelihood of confusion is the only second-layer ground alleged by the

Objector. The Objector does not allege that the potential use of the applied-for gTLD either takes unfair advantage of the distinctive character or the reputation of the Objector's registered or unregistered trademarks, or unjustifiably impairs the distinctive character or the reputation of the Objector's trademarks, and the Panel confirms that the applied-for gTLD in its opinion does not do so.

In the Panel's view there is not an impermissible likelihood of confusion between the <.mail> gTLD and the Objector's trademarks. The Panel decision is based on a consideration of all the evidence, and in particular on the following circumstances: (i) the Objector does not have rights in any trademark identical with the applied-for gTLD; (ii) the applied-for gTLD is a common descriptive word; (iii) a trademark owner that incorporates a generic term into its trademark must bear the risk of confusion resulting from the use of the term in its generic sense, even by potential competitors; (iv) although the Applicant has been reticent regarding its future business uses of the <.mail> gTLD, the word 'mail' has functional applications in relation to the provision of online communication services of the kind proposed by the Applicant; (v) the risk of confusion is limited, likely to be temporary, can be further reduced by the good faith of the Parties, and can be monitored by the Objector in accordance with its legal options in the United States or elsewhere; (vi) the Panel considers that the Objector's allegations of confusion on the basis of consumer assumptions relating to security or confidentiality or through the possible fraudulent use of the <.mail> gTLD are not supported by the evidence.

(e) Conclusion: The Panel finds that the potential use of the applied-for gTLD by the Applicant does not not infringe the existing legal rights of the Objector that are recognized or enforceable under generally accepted and internationally recognized principles of law, and in particular does not:

(i) take unfair advantage of the distinctive character or the reputation of the Objector's registered or unregistered trademark or service mark ("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. Decision

For the above reasons, the Objection is rejected.

[signed]

David J. A. Cairns

Sole Panel Expert

Date: July 18, 2013