

EXPERT DETERMINATION LEGAL RIGHTS OBJECTION

United States Postal Service v. Victor Dale, LLC

Case No. LRO2013-0047

1. The Parties

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

The Applicant/Respondent (“Respondent”) is Victor Dale, LLC of Bellevue, Washington, United States, represented by The IP & Technology Legal Group, P.C. dba “New gTLDDisputes”, United States.

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 completed the review of the Objection on March 26, 2013 and 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. 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 on April 25, 2013 a proposal from the Objector to consolidate the Objection with the objections in cases LRO2013-0043 to LRO2013-0048. The Respondent 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.

The WIPO Center appointed William R. Towns, Maxim H. Waldbaum, and the Honorable Neil Brown Q.C. as the Panel in this matter on June 14, 2013. The Panel finds that it was properly constituted. Each member of 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.

The Objector on May 30, 2013 submitted to the Center an unsolicited Request for Additional Submissions to Supplement Legal Rights Objection (“Request for Additional Submissions”), seeking to submit survey evidence directed to the primary meaning of “mail” in the minds of the U.S. public and its association with the Objector. The Objector also requested that the Panel require the Respondent to disclose further information regarding a survey report discussed in the Response.¹ The Respondent, on June 21, 2013, lodged with the Center its objection to the admission of the Objector’s request on both counts. Subsequently, on July 10, 2013, the Objector submitted to the Center a Request for Hearing, asserting, *inter alia*, that the case involves novel issues and that the Panel would benefit from a further explanation of the Parties’ positions. The Respondent lodged an objection to this request with the Center on July 11, 2013.

4. Factual Background²

The Objector is the United States Postal Service (“USPS”). The Objector, an independent establishment of the Executive Branch of the United States Government, is one of the world’s largest mail carrier, delivering 40% of the world’s mail. The Objector and its predecessor have delivered mail to residences and businesses in the United States for more than 235 years. Currently this includes 152 million homes, businesses, and Post Office boxes.

The Objector owns a considerable number of composite trademark registrations in the United States and numerous other countries comprised in part of the word “mail”. Public documents available on the USPTO TESS database indicate that the Objector is the owner of forty-eight (48) current United States registrations for composite “mail”-containing trademarks in International Classes 35 and 39 covering mail delivery and other related postal services. These include trademark registrations for U.S. MAIL & Design, U.S. MAIL MR. ZIP & Design, and UNITED STATES POSTAL SERVICE U.S. MAIL & Design (hereinafter collectively referred to as the “U.S. MAIL” marks).³ The Objector owns registrations for more than twenty other composite marks containing the word “mail”, including: 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.

Public documents available through the USPTO TESS database reflect that the Objector has disclaimed “the exclusive right to use ‘MAIL’ apart from the mark as shown” in all but eight (8) of the forty-eight (48) United States registrations referred to above. A “disclaimer” is a statement in the trademark application record that the applicant does not claim exclusive rights to an unregistrable component of a mark, which includes wording that is merely descriptive or generic with respect to the claimed goods and services. See *Defender Security Company v. Lifestyle Domain Holdings, Inc.*, WIPO Case No. LRO2013-0035. The trademarks and

¹ The Respondent submitted a declaration from the marketing expert who conducted the survey as Annex D to the Response.

² This factual recitation is based on the parties’ allegations, the documentary evidence submitted by the parties, and the Panel’s independent review of public documents available through the United States Patent and Trademark Office (“USPTO”) Trademark Electronic Search System (“TESS”) database, and of the Objector’s website.

³ (i) U.S. MAIL & Design, US Reg. No. 1,150,641 (consisting of a figure holding a letter and carrying a small bag bearing words U.S. MAIL); (ii) U.S. MAIL & Design, US Reg. No. 2,431,839 (consisting of a stylized eagle mounted above the words U.S. MAIL within a double border); (iii) U.S. MAIL MR. ZIP & Design, US Reg. No. 3,170,355 (identical design for Reg. No. 1,150,641 with addition of words MR. ZIP below figure); (iv) U.S. MAIL & Design, US Reg. No. 3,720,179 (consisting of a mounted horse rider carrying bag bearing words U.S. MAIL within a double border); (v) UNITED STATES POSTAL SERVICE U.S. MAIL & Design, US Reg. No. 4,031,772 (consisting of a stylized eagle mounted above words U.S. MAIL surrounded by a border comprised of UNITED STATES POSTAL SERVICE and nine five pointed stars); .

pending applications in which such disclaimers have been made include U.S. MAIL⁴, CERTIFIED MAIL, EXPRESS MAIL, PRIORITY MAIL, CRITICAL MAIL, INTELLIGENT MAIL, STANDARD MAIL, GLOBAL EXPRESS MAIL, GLOBAL PRIORITY MAIL, and FIRST-CLASS MAIL. The Objector has not applied for and does not own a trademark registration for MAIL alone.

The Objector submitted definitions of the word “mail” derived from various online dictionaries as an annex to the Objection.⁵ Dictionary definitions provide an indication of how words are used by the public in everyday situations. In many instances a word may have multiple meanings, and dictionaries often list each meaning in order of most common usage. The dictionary definitions proffered by the Objector indicate that “mail” is commonly used as a noun in reference to letters and packages conveyed by the postal service, in reference to the postal service, to the delivery of mail, and to email, generally in that order. “Mail” also is used as a verb in relation to sending a letter or package through the postal system, or sending email.

The Respondent is a limited liability company organized and existing under the laws of the State of Delaware, with its principal place of business in Bellevue, Washington, United States of America. The Respondent states it is a subsidiary of Donuts Inc. (“Donuts”). The Declaration of Jonathon Nevett, a founder of Donuts and its Executive Vice President, was submitted as Annex B to the Response. Donuts was formed to acquire and operate new generic top level domains under ICANN’s new gTLD Program, and through various subsidiaries has applied for 307 new gTLD strings, including the applied-for gTLD string <.mail>.

The Respondent’s New gTLD application for the string <.mail> was originally posted on June 13, 2012, under Application ID: 1-1548-63140. The Respondent describes the mission/purpose of the application in terms of Donut’s overall objective of acquiring and operating a large number of “broadly generic” gTLDs “to increase competition and choice at the top level”, with each gTLD representing “discrete segments of commerce and human interest.” According to the application, Donut’s “plan and intent for this TLD is to serve the international community by bringing new users online through opportunities for economic growth, increased productivity, the exchange of ideas and information and greater self-expression.”

The Respondent in its application submits that it will encourage inclusiveness in the registration of second level names with the applied-for gTLD. The Respondent maintains that <.mail> is a generic term and will be attractive to a variety of Internet users. Hence, the Respondent states it will make second level name registrations available to any responsible registrant with an affinity for the string. To address abusive second level registrations, the Respondent represents that, in addition to the Sunrise period and other protection mechanisms mandated by ICANN for all new gTLDs,⁶ Donuts will provide an additional array of protection mechanisms.⁷ The Respondent avers that as a result the applied-for gTLD will be safer than existing gTLDs.

⁴ U.S. Reg. No. 4,031,772 issued Sept. 27, 2011; U.S. Ser. No. 85867833 filed on March 5, 2013, and published for opposition on July 2, 2013.

⁵ Annex 9 to Objection.

⁶ There are fourteen new measures developed by ICANN for new gTLDs.

1. Controls to ensure proper access to domain management functions;
2. 24/7/365 abuse point of contact at registry;
3. Procedures for handling complaints of illegal or abusive activity, including remediation and takedown processes;
4. Thick Whois;
5. Use of the Trademark Clearinghouse;
6. A Sunrise process;
7. A Trademark Claims process;
8. Adherence to the Uniform Rapid Suspension system;
9. Adherence to the Uniform Domain Name Dispute Resolution Policy;
10. Adherence to the Post Delegation Dispute Resolution Policy;
11. Detailed security policies and procedures;
12. Strong security controls for access, threat analysis and audit;
13. Implementation DNSSEC; and
14. Measures for the prevention of orphan glue records.

⁷ The Respondent’s application indicates these additional protection measures will be implemented:

1. Periodic audit of Whois data for accuracy;
2. Remediation of inaccurate Whois data, including takedown, if warranted;
3. A new Domain Protected Marks List (DPML) product for trademark protection;
4. A new Claims Plus product for trademark protection;
5. Terms of use that prohibit illegal or abusive activity;
6. Limitations on domain proxy and privacy service;

5. Preliminary Issues

A. Objector's Request for Additional Submissions and Evidence

As noted above, the Objector on May 30, 2013 submitted to the Center a Request for Additional Submissions, seeking the admission of survey evidence to supplement its Objection, directed to the primary meaning of "mail" in the minds of the U.S. public and its association with the Objector. The Objector asserts that the Panel should accept the survey and accompanying report of the Objector's marketing research expert as "rebuttal" evidence with respect to the Respondent's survey report, and to rebut to the Respondent's "incorrect assumption" that the Objector "offers no evidence whatsoever to support its fundamental and, more importantly, essential claim that people expect all 'mail' to be handled by the United States Postal Service." The Respondent objected to the Request for Additional Submissions on grounds, *inter alia*, that the Objector's survey evidence should have been included with its Objection, and that no party may submit further evidence without a request from the Panel, which the Panel may request only in "exceptional cases."

The Procedure envisages the submission of an objection and a response, with the possibility of additional written submissions and additional evidence addressed in Article 17 and 18 of the Procedure, respectively. No party has a right to insist upon the admission of additional arguments or evidence. See *TLDDOT GmbH v. InterNetWire Web-Development GmbH*, WIPO Case No. LRO2013-0052. Section 3.4.5 of the gTLD Applicant Guidebook ("Guidebook") underscores that the process is intended "to achieve the goal of resolving disputes rapidly and at reasonable cost." Article 17 of the Procedure provides that the Panel "may decide whether the parties shall submit any written statements in addition to the Objection and Response". Article 18 of the Procedure specifically limits the authority of the Panel to require a party to submit additional evidence to "exceptional cases", in order to achieve the goal of resolving disputes over new gTLDs rapidly and at reasonable cost. In all cases, it is incumbent on the Panel to "ensure that the parties are treated with equality, and that each party is given a reasonable opportunity to present its position." Article 4(e) of the Procedure.

The Panel concurs that no party to a Legal Rights Objection has a right to insist upon the admission of additional arguments or evidence. The Panel nonetheless considers it within an expert panel's discretion under Article 17 to accept or reject a supplemental submission made by a party, regardless whether the panel has specifically requested that submission. See *Express, LLC v. Sea Sunset, LLC*, WIPO Case No. LRO2013-0022. In the exercise of such discretion, the expert panel should consider whether the admission of an unsolicited additional submission sought by a party will unduly or unnecessarily frustrate ICANN's clearly stated goal of resolving disputes over new gTLDs rapidly and at reasonable cost. Further, before accepting an unsolicited additional submission the expert panel ordinarily should consider whether, after review of the objection and response, each party has been afforded a reasonable opportunity to present its position. In a situation such as here, where a party's unsolicited additional submission is primarily directed to additional evidence, this Panel considers that the moving party bears the burden to meet the "exceptional case" requirement of Article 18. See *United States Postal Service v. Amazon EU S.à.r.l.*, WIPO Case No. LRO2013-0044.

Applying these concepts, the Panel finds that the Objector has not met the "exceptional case" requirement of Article 18 respecting the proffered survey evidence. As noted earlier, the Objector's survey is directed to the primary meaning of "mail" in the minds of the U.S. public and its association with the Objector. In its Objection the USPS presented arguments in support of its position, and submitted evidence as to the primary meaning of the term "mail", including dictionary definitions. To the extent that the Objector may wish to rely on the survey as evidence that "mail" has secondary meaning as a distinctive identifier of its services,

[Footnote continued from previous page]

7. Published policies and procedures that define abusive activity; and
8. Proper resourcing for all of the functions above.

the Objector was required to submit the source and documentation of any existing legal rights the Objector claims are infringed with the Objection.⁸ The Objector had the opportunity at first instance to obtain and submit with its Objection a survey, if so desired. The Objector's characterization of the survey as "rebuttal" evidence is unpersuasive, in view of the foregoing and given indications in the record that the Objector's survey was undertaken and likely completed prior to the filing of the Response.

In sum, the Panel finds that the Objector has been afforded a reasonable opportunity in this proceeding to present its position, and to identify the source of and document its existing legal rights. Further, the Panel concludes that the Objection and Response provide the Panel with sufficient evidence to determine the nature and source of the Objector's existing legal rights. See *United States Postal Service v. Amazon EU S.à.r.l, supra*.⁹ In light of the foregoing, the Panel considers that granting the Objector's Request for Additional Submissions would unduly and unnecessarily impede the expressed goal of the Procedure to resolve new gTLD disputes rapidly and at a reasonable cost. Accordingly, the Objector's request is denied.

B. Objector's Request to the Panel to Require Respondent to Submit Further Information

As noted above, Article 18 of the Procedure authorizes the Panel to require a party to submit additional evidence only in "exceptional cases". The Objector submits that the Panel should require the Respondent to produce underlying survey data on which the sworn declaration of the Respondent's marketing expert is based. No matter how relevant this documentation might be, and regardless of why the Respondent did not provide this information, the Panel finds the Objector does not meet the "exceptional case" requirement of Article 18. In any event, it is the province of the Panel to determine what weight, if any, is to be assigned to the declaration of the Respondent's expert, and the reasons therefore. The Objector's request accordingly is denied.

C. Objector's Request for Hearing

Article 19 of the Procedure provides that the Panel may decide, on its or at the request of a party, to hold a hearing only in "extraordinary circumstances". Nothing in the record of this case suggests to the Panel that such extraordinary circumstances are present. The Objector's averments that the issues in this proceeding are novel and that the Panel would benefit from conducting a hearing carry little weight with this Panel. It appears that the primary impetus for the Objector in requesting a hearing was a desire to present arguments and testimony to explain the meaning of the Objector's survey. The Panel, even had it accepted the Objector's proffered survey evidence, would find nothing extraordinary about the circumstances of this case justifying a hearing, which clearly would build significant delay and further cost into this proceeding. As noted earlier, the Objector had an opportunity to undertake its survey and submit the report of its expert with the filing of its Objection. The Objector's Request for Hearing is denied.

6. Parties' Contentions

A. Objector

The Objector maintains that the string for which the Respondent has applied will take unfair advantage of the distinctive character and reputation of the Objector's marks, unjustifiably impair the distinctive character or reputation of the Objector's marks, and create an impermissible likelihood of confusion between the applied-

⁸ As discussed further below, in order to establish standing as a "rightsholder" within the meaning of Section 3.2 of the Guidebook, the source and documentation of the existing legal rights the Objector is claiming are infringed must be included with the Objector's filing, *i.e.*, the Objection.

⁹ The panel in *United States Postal Service v. Amazon EU S.à.r.l*, WIPO Case No. LRO2013-0044 determined that there were no exceptional circumstances to justify the admission of the objector's survey evidence at issue here. The panel concluded the survey evidence addressed a matter raised in the original objection. The panel further found that the survey did not directly address the objector's legal rights or recognition of its trademarks, but rather concerned an alleged association of the word "mail" with the objector in the United States. The panel observed: "[i]t 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'". The panel concluded that both parties had an equal opportunity to present their positions on the association of the objector with "mail" in the United States, and that the objection and response provided sufficient evidence and argument to identify the nature of the objector's legal rights.

for string and the Objector's marks. The Objector claims ownership of more than 240 trademark registrations worldwide for marks that include "mail" together with other terms. The Objector submits that awarding the <.mail> gTLD string to the Respondent would interfere with its rights in each and every one of these marks, but for sake of brevity the Objection refers primarily to its U.S. MAIL mark. The Objector asserts that the applied-for gTLD <.mail> string is confusingly similar to the Objector's U.S. MAIL mark, which the Objector represents has been used since at least as early as 1819, is a famous mark, and is also part of the USPS' official seal, which is protected as a state emblem by Article 6^{ter} of the Paris Convention.

The Objector argues that "mail" cannot be viewed as a simple common term in the context of the applied-for gTLD string. The Objector maintains that in this context "mail" will have a source-indicating meaning and that U.S. consumers will expect the <.mail> gTLD to be controlled by the Objector, as the regulated entity and designated postal operator entrusted to deliver mail in the United States. While the Objector acknowledges that the term "mail" has several different meanings in English, the Objector submits that dictionary definitions demonstrate that the primary meaning of "mail" is hard-copy correspondence delivered through a postal service, which in the United States is the Objector. This is reinforced, according to the Objector, by encyclopedia entries for "mail" reflecting the common understanding of the term, and by references in one or more state statutes to "mail" as "use of the United States Postal Service for delivery of letters, packages or other containers."

The Objector also asserts that the <.mail> gTLD is likely to be seen as source-indicating by comparison to the sponsored TLDs <.gov>, <.int>, and <.post>. The Objector submits that each of these sponsored TLDs is known by the public to be regulated and accordingly is afforded a greater level of trust than are generic TLDs. According to the Objector, given consumer association of "mail" with the Objector, consumers are likely to view the <.mail> gTLD as controlled by the Objector, especially since mail delivery is an essential government service. The Objector argues that the risk of confusion will be increased because the <.mail> gTLD is likely to be viewed as the equivalent of the <.post> sponsored TLD sponsored by the Universal Postal Union ("UPU"), a specialized agency of the United Nations that represents the world's postal community. The Objector notes that the United States is a member of the UPU.

The Objector maintains that protection of seemingly common terms such as "mail" has been internationally recognized in certain circumstances, citing to a 2010 ruling of the German Federal Patent Court that "post" is source-indicative to German consumers, who associate it with Deutsche Post. According to the Objector, the public's association between the Objector and "mail" is further heightened by the Objector's ownership of trademark registrations in more than twenty variations that include the word "mail."

The Objector argues that the <.mail> gTLD string will create an impermissible likelihood of confusion for U.S. consumers, and that such confusion will be impermissible because of the severity of harm such confusion may generate in various forms. First, the Objector submits that the <.mail> gTLD will create impermissible confusion in the form of a false sense of privacy and security in <.mail> domains and emails. According to the Objector, U.S. consumers rely on well-known standards of privacy and security for their mail because the USPS, a quasi-governmental entity, is subject to government regulation and its handling of the nation's mail is governed by federal statutes and regulations. The Objector maintains that the U.S. public's trust is reflected in its consistently high rankings in Ponemon Institute's "20 Most Trusted Companies for Privacy" surveys. The Objector concludes that awarding the <.mail> gTLD application to the Respondent or any other private sector applicant is likely to confuse the U.S. public into giving <.mail> domains and e-mails a similar level of trust as they afford their mail.

Equally concerning to the Objector is the possibility that the Objector's numerous trademarks that contain "mail" could be reflected in corresponding second level domain names or email addresses. The Objector asserts these could include <us.mail>, <certified.mail>, <priority.mail>, <express.mail>, to name a few. According to the Objector, it would have no control over the content of these domains or the quality of any goods and services offered through them. The Objector also warns that if the Respondent uses the <.mail> gTLD string for email account creation, unregulated <.mail> email addresses will be prime tools for fraudulent and criminal activity, citing as an example of such possible email address "info@us.mail".

The Objector contends that the Respondent's purported or intended use of the applied-for gTLD string will interfere with the Objector's legitimate exercise of its rights. According to the Objector, the Respondent's intended use of the gTLD <.mail> string to provide Internet users with opportunities for online identities and expression will result in the Respondent being falsely linked to the identity of the Objector, since each such identity will be created using the term "mail." Further, according to the Objector, nothing will prevent third parties from registering domain names that directly infringe the Objector's marks, and email addresses created in connection with any of these domain names would also directly infringe the Objector's marks. The Objector submits the Respondent's operation of the <.mail> gTLD will open the door to fraud, scamming, phishing, and other false or misleading schemes directed at consumers who will mistakenly believe these infringing domain names and/or e-mail addresses are associated with the USPS.

Although the Objector maintains that the term "mail" is primarily used and recognized to refer to hard-copy correspondence rather than email, the Objector acknowledges "[w]ithout question, in the current climate of electronic correspondence, electronic communications via e-mail are services that are closely related to hard copy correspondence." The Objector asserts that such services are a natural area of expansion for the USPS and that the Respondent should be prohibited from trading on the Objector's reputation built over the course of almost 200 years.

The Objector contends that the applied-for gTLD string, if delegated, is likely to dilute the Objector's rights in its U.S. MAIL marks, which the Objector asserts are famous in the United States as household words. Further, the Objector submits that domain names and emails associated with the <.mail> gTLD are more open to fraud and phishing schemes because they are not regulated, and may mistakenly be attributed to the Objector, resulting in tarnishment of its U.S. MAIL marks.

The Objector represents that to its knowledge the Respondent does not have marks or other intellectual property rights in the term "mail", and is not commonly known by "mail" or a name including the word "mail."

B. Respondent

The Respondent submits that its rights in the applied-for gTLD <.mail> derive from ICANN's stated goal to increase choice and competition in domain names through the introduction of new gTLDs, citing to the Guidebook at Section 1.1.2.3 and Module 2 Attachment, at A-1. Respondent asserts that it shares these goals, and that to deprive Internet users of choice the Objector must clear a high bar. The Respondent observes that ICANN expressly provided in Section 3.5 of the Guidebook that objectors bear the burden of proof in each case. Respondent finds further support for its position in the following passage from the Public Comment Summary and Analysis in Version 3 of the Draft Guidebook:

There is a presumption generally in favor of granting new gTLDs to applicants who can satisfy the requirements for obtaining a gTLD – and, hence, a corresponding burden upon a party that objects to the gTLD to show why that gTLD should not be granted to the applicant.¹⁰

The Respondent asserts that it is entitled to and will use the dictionary word "mail" in a manner that does not interfere with the Objector's rights. The Respondent submits that the Objector owns no legally protected interest in the generic term "mail" and cannot validly assert a worldwide monopoly over this common dictionary word. According to the Respondent, the Objector's entire argument hinges on the faulty assumption that consumers understand the term "mail" to apply only to "hard copy correspondence", respecting which the USPS is the only authorized provider of services for delivery. The Respondent maintains that the Objector's reliance on this flawed premise results in an erroneous assertion that any time a consumer encounters the term "mail" in association with the provision of goods or services, the consumer automatically assumes that the USPS has supplied the goods or services.

¹⁰ New gTLD Draft Applicant Guidebook Version 3 Public Comments Summary And Analysis, <http://archive.icann.org/en/topics/new-gtlds/summary-analysis-agv3-15feb10-en.pdf>.

The Respondent argues that the Objector ignores wide and varied Internet use of “mail” with services provided by others in association with the delivery of correspondence. The Respondent points Microsoft’s Hotmail, Apple’s Mail, Google’s Gmail, AOL Mail (with its “you’ve got mail” catchphrase), and Yahoo Mail as evidence that consumers are fully capable of understanding that the Objector is not the exclusive provider of mail. The Respondent further observes that the “www.mail.com” website has existed for over 15 years, providing a variety of services as an information portal as well as email addresses using the “mail.com” extension. In addition, the Respondent submits that the Objector ignores the significant role played by various shipping services that deliver “hardcopy correspondence”, including UPS, Federal Express, and DHL.

Addressing the non-exclusive factors of Section 3.5.2 of the Guidebook, the Respondent contends first that no similarity of sight, sound or meaning exists between the applied-for <.mail> string and any protectable interest of the Objector. The Respondent does not dispute that the USPS, established by Congress, is authorized to deliver mail in the United States, or that Objector has adopted and utilized a number of compound marks that include the term “mail” to identify its various delivery services. The Respondent contends, however, that the Objector does not have legal rights in the dictionary term “mail” standing alone. The Respondent characterizes the Objector’s composite marks as combining the descriptive or generic element “mail” with other descriptive or generic elements, resulting in extremely weak and in many cases virtually unenforceable trademark rights, citing *Luigino’s, Inc. v. Stouffer, Corp.*, 170 F.3d 827 (8th Cir. 1999) (MICHELINA’S LEAN ‘N TASTY and LEAN CUISINE do not create same overall commercial impression for frozen foods, despite the inclusion of generic term “lean” in both marks). Additionally, the Respondent submits that the Objector cannot dissect from its composite marks the generic term “mail” and claim that another’s use of that term alone infringes the combined mark, citing *Franklin Mint Corp. v. Master Mfrg. Co.*, 667 F.2d 1005, 1007 (C.C.P.A. 1981).

In its Response, the Respondent noted that the Objection is not supported by any study or survey of consumer behavior to support a claim that the public automatically associates the term “mail” with a service provided by the USPS. According to the Respondent, the Objector instead focuses on its size and length of service, along with its legal standing as authorized by Congress. The Respondent concedes that people may associate the term “mail” with a service provided by the Objector, but reiterates that many other services that deliver correspondence for the public also use “mail” to describe their services. The Respondent dismisses the Objector’s reliance on the sponsored TLD <.gov> for the proposition that the gTLD <.mail> will be seen as an indicator of source, asserting that any such recognition arises from the exclusive use limitations for <.gov> as established under federal law, and noting that no similar protection has been accorded to the term “mail” under U.S. law. The Respondent indicates it has undertaken a survey in which the respondents overwhelmingly associate “mail” with its dictionary definition and not with any single provider of physical or electronic mail services. The Respondent also states that it has conducted its own research on the Internet and found over 68,000 uses of the term “mail” at the second level of six existing TLDs, including <.com>.

Relying on U.S. case law, the Respondent submits that one who adopts a common, descriptive word as a trademark necessarily takes the risk that many others will use the same or similar terms to identify their companies, goods or services. The Respondent argues that the creation of trademark rights in such a term cannot prevent others from using the word in good faith in its descriptive sense, and not as a trademark, citing *Car-Freshner Corp. v. S.C. Johnson & Son*, 70 F.3d 267, 269, 270 (2d Cir.1995). The Respondent further asserts that U.S. courts have consistently held that trademark rights do not prevent the non-trademark use of a dictionary term in or with a top-level domain, citing *Image Online Design v. ICANN*, 2013 U.S. Dist. LEXIS 16896, 22-24 (C.D. Cal. 2013) (finding no protectable interest in .WEB); *Advertise.com v. AOL Advertising*, 616 F.3d 974, 978-979 (9th Cir. 2010) (AOL’s “advertising.com” usage insufficient to prevent use of <advertise.com>, as each identifies a type of service and not the supplier of it, or merely a “genus” of which the particular service of each is a “species”); *Hasbro v. Clue Computing*, 66 F. Supp. 2d 117, 133 (D. Mass. 1999), *aff’d*, 232 F.3d 1 (1st Cir. 2000) (summary judgment in favor of defendant registrant of <clue.com> site against rights holder in “Clue” board game; trademark law does not support monopoly over domain name uses, such that “[i]f another Internet user has an innocent and legitimate reason for using the ... mark as a domain name and is the first to register it, that user should be able to use” the name).

The Respondent contends that it has made substantial preparations to use the sign corresponding to the applied-for gTLD <.mail> in order to provide *bona fide* information over the Internet that does not interfere with any legitimate rights of the Objector. The Respondent indicates that its parent company has invested more than USD 57 million in filing fees paid to ICANN for more than 300 new gTLD applications. The Respondent asserts that it has also invested additional time, money, technical and other resources in planning and preparing to use <.mail> and its other applied-for strings.

The Respondent further submits that the Objector ignores the “unprecedented security mechanisms” that the Respondent will provide for this gTLD. This includes not only the fourteen (14) protection measures ICANN demands for all new gTLDs but an additional eight (8) measures that the Respondent represents will address the exact types of concern raised by the Objector. The Respondent asserts that the concerns raised by the Objector do not square with the facts, and that what the Objector fears may happen does not constitute proof that it will so as to divest the Respondent of its free speech right to use the dictionary term “mail” to the same extent as any member of the general public can and does.

The Respondent maintains that its intended use of the applied-for <.mail> string will not create a likelihood of confusion with the Objector’s marks as to source, sponsorship, affiliation or endorsement of the gTLD. In addressing this factor, the Respondent looks for guidance to a non-exclusive, multi-factor analysis traditionally utilized by U.S. Courts in evaluating likelihood of confusion, citing *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-349 (9th Cir. 1979).

7. Discussion and Findings

As set forth in Module 3 of the Guidebook, the new gTLD Dispute Resolution Procedure is triggered by a formal objection to a gTLD application by a third party. A formal objection can be filed on one of four enumerated grounds described in Section 3.2.1 of the Guidebook. A Legal Rights Objection is one of those grounds. Under Article 2(e)(ii) of the Procedure, a Legal Rights Objection is defined as an objection that the string comprising a potential new gTLD infringes existing third-party legal rights that are recognized or enforceable under generally accepted and internationally recognized principles of law.

Objectors must satisfy standing requirements to have their objections considered. Section 3.2.2.2 of the Guidebook provides that only a “rightsholder” has standing to object on the grounds that its existing legal rights are infringed by the applied-for gTLD. The source and documentation of the existing legal rights the objector is claiming are infringed must be included in the filing. *Id.* Such legal rights may include rights asserted in either registered or unregistered trademarks. *Id.* The expert panel presiding over the case is responsible under Section 3.2.2 of the Guidebook for determining whether the standing requirements have been met.

As provided for in Section 3.5.2 of the Guidebook, an expert panel presiding over a Legal Rights Objection will consider whether, under generally accepted and internationally recognized principles of law, the applied-for gTLD takes unfair advantage of or unjustifiably impairs the distinctive character of the objector’s registered or unregistered mark, IGO name or acronym, or otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector’s mark, IGO name, or acronym. In reaching a determination respecting trademark rights, the expert panel is to be guided by eight non-exclusive factors set out in Section 3.5.2 of the Guidebook. Pursuant to Section 3.5 of the Guidebook, the objector bears the burden of proof as to all elements of its legal rights objection.

A. Objector’s Standing Requirement

1. MAIL as a Stand-Alone Mark

The Objector does not own word or design trademark registrations consisting solely of MAIL, and no evidence of the Objector’s use of MAIL as a stand-alone mark for its services has been presented to the Panel. As noted earlier, the Objector has disclaimed exclusive rights in “mail” in the vast majority of its U.S.

registrations for composite marks that include the term. While the Objector urges that the U.S. public overwhelmingly recognizes the primary meaning of “mail” as hard-copy correspondence and associates it with the Objector, “mail” is a generic term for letters and packages conveyed by a postal service, and sending letters and packages through a postal system. As such, any public association of the term “mail” with the Objector does not demonstrate that the public recognizes “mail” as the mark of the Objector. “[N]o matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.” *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

The survey evidence sought to be admitted by the Objector does not establish otherwise. The report of the Objector’s expert concluded that the primary meaning of the term “mail” to a majority of adults in the United States is hardcopy correspondence related to the USPS. As discussed above, the Panel has decided not to accept the Objector’s Request for Additional Submission and Evidence. Nevertheless, the Panel finds that the Objector’s survey evidence does not establish that “mail” has secondary meaning as the mark of the Objector for purposes of the proceeding. See Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12:11 (4th ed. 2012) (hereinafter “McCarthy”) (that a particular service provider is called to mind by consumer when prompted by the name of a service does not infuse the generic term with trademark significance).¹¹ A claim by the Objector to exclusive rights to use “mail” is inconsistent with the Objector’s disclaimer of “mail”, as well as with coexisting U.S. registrations of composite “mail” marks owned by third parties such as Federal Express¹², the United Parcel Service¹³, and DHL¹⁴, in which exclusive rights to “mail” also are disclaimed.

Accordingly, the Panel finds that the Objector has not demonstrated existing legal rights in MAIL as a stand-alone mark for purposes of this proceeding.

2. U.S. MAIL and Other Composite MAIL Marks

The Objector has submitted evidence of United States trademark registrations for U.S. MAIL. These are marks in which the text U.S. MAIL is part of composite designs including other elements. The Objector also has submitted evidence of United States registrations for other composite marks including “mail”. The Panel finds that the Objector has demonstrated existing legal rights in U.S. MAIL and in other composite marks that include the word “mail” sufficient to establish standing for purposes of its Objection.

Accordingly, the Panel finds that the Objector has standing to bring this Objection.

B. The Panel’s Multi-Factor Analysis

Where the Objection is based on trademark rights, Section 3.5.2 of the Guidebook directs the Panel to consider eight non-exclusive factors in connection with the determination of whether the objection should be sustained. It is to be noted that the eight factors are not a scorecard and that a panel’s view on them does not, by itself, determine the outcome of the Objection, but, rather, that they are factors to be considered. The

¹¹ The Panel in *United States Postal Service v. Amazon EU S.à.r.l.*, *supra*, also came to this conclusion after considering substantially the same arguments and evidence advanced by the Objector in this proceeding. Refer to Note 9 *supra*.

¹² Federal Express Corporation owns United States trademark registrations for FEDEX INTERNATIONAL MAILSERVICE, U.S. Reg. No. 2,912,878, issued December 21, 2004, for “transportation of mail by airplane and truck” in International Class 39, and FEDEX INTERNATIONAL MAIL VIEW, U.S. Reg. No. 4,123,018, issued April 3, 2012, for “cargo services, namely, pick up, transportation and delivery of documents and packages by truck and plane.”

¹³ United Parcel Services of America, Inc. (UPS) owns United States trademark registrations for UPS MAIL LOGIC, U.S. Reg. No. 2,671,437, issued January 7, 2003, for “parcel and personal property sorting services” in International Class 35 and services including “transportation and delivery of packages and personal property by air, rail, boat and motor vehicle” in International Class 39, and UPS MAIL INNOVATIONS, U.S. Reg. No. 2,971,164, issued July 19, 2005, for services including “preparing online status reports regarding the tracking of mail and packages” in International Class 35 and services including “expedited document, package and personal property delivery by air, rail, boat and motor vehicles” in International Class 39.

¹⁴ Deutsche Post AG (DHL) owns United States trademark registrations for GLOBAL MAIL PARCEL, U.S. Reg. No. 2,808,405, and GLOBAL MAIL BUSINESS, U.S. Reg. No. 2,808,406, both issued on January 27, 2004, for services in International Class 39 including “postal services, namely, transport and delivery of letters, parcels, and small packets for third parties.” Federal Express, UPS and DHL have disclaimed the exclusive right to use “mail” apart from the marks as shown. The Objector maintains that Federal Express and UPS use these marks only in connection with partnering arrangements with USPS, and only with mail originating from USPS.

Panel addresses these factors below.

(i) Whether the applied-for gTLD is identical or similar, including in appearance, phonetic sound, or meaning, to the Objector's existing mark.

The Panel finds that the applied-for gTLD string <.mail> is similar to appearance to the Objector's U.S. MAIL word and design marks and to other composite MAIL marks held by the Objector to the extent the text of the applied-for gTLD string appears in its entirety in the Objector's marks.

(ii) Whether the Objector's acquisition and use of rights in the mark has been *bona fide*.

The Panel finds from the evidence in the record that the Objector's acquisition and use of its trademark rights in its U.S. MAIL marks and in various other composite MAIL marks has been *bona fide*.

(iii) 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 Respondent, or of a third party.

The Panel finds no indication in the record that that the Objector, the Respondent, or any third party have acquired recognizable or enforceable trademark rights in the term "mail" in itself through registration or by virtue of public recognition of "mail" as a distinctive indicator of the source of the party's goods or services. The Panel's search of public documents available on the USPTO TESS database disclosed no existing registrations for MAIL (*i.e.*, as a stand-alone mark).

(iv) Respondent's intent in applying for the gTLD, including whether the Respondent, 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 Respondent 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 Respondent's expressed intent in applying for the <.mail> gTLD string is to operate an open registry based on the descriptive or dictionary meaning of "mail", in furtherance of ICANN's stated goal to increase choice and competition in domain names through the introduction of new gTLDs, and there is no indication in the record that the Respondent's intent is otherwise. The Respondent has not indicated whether it had knowledge of the Objector's marks, but the Panel considers it unlikely that the Objector would have been unaware of the Objector and its U.S. MAIL marks. As noted by the Panel in *United States Postal Service v. Amazon EU S.à.r.l, supra*, an applicant for a new gTLD can be assumed to have made a trademark search on the proposed string, which in this case would have revealed the Objector's U.S. MAIL marks and other MAIL-containing composite marks. Regardless, the Panel finds no evidence in the record indicating that the Respondent has engaged in a pattern of applying for new gTLD strings that are identical or confusingly similar to the marks of others. The record reflects that the Respondent's parent company has applied for a large number of gTLDs strings that appear to be descriptive or dictionary words.

(v) Whether and to what extent the Respondent 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.

There is no indication in the record that the Respondent, either before or since applying for the <.mail> gTLD string, has used or made demonstrable preparation to use the sign corresponding to the applied-for gTLD in any capacity other than as a gTLD. The Respondent's parent company has invested more than USD 57 million in filing fees paid to ICANN for more than 300 new gTLD applications. The Respondent has also invested additional time, money, technical and other resources in planning and preparing to use <.mail>. The Respondent submits that it will use the dictionary word "mail" as a gTLD in a manner that does not interfere with the Objector's legitimate exercise of its trademark rights. The Respondent also points to the

additional rights protection mechanisms implemented by ICANN respecting all new gTLDs, and the additional rights protection mechanisms to be implemented by the Respondent.¹⁵

(vi) Whether the Respondent 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 Respondent is consistent with such acquisition or use.

There is no indication in the record that the Respondent has marks or other intellectual property rights in any sign corresponding to the applied-for gTLD <.mail> string. The Respondent has submitted that the application for the new gTLD itself gives rise to intellectual property rights, but the Panel does not agree with that proposition.

(vii) Whether and to what extent the Respondent 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 Respondent is consistent therewith and *bona fide*.

There is no indication in the record that the Respondent has been commonly known by a sign corresponding to the applied-for gTLD <.mail> string.

(viii) Whether the Respondent'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.

The Panel in assessing this non-exclusive factor considers whether the Respondent's intended use of the applied-for gTLD string would create a likelihood of confusion between the gTLD and the marks in which the Objector has demonstrated existing legal rights. The issue as framed is whether the Respondent's prospective use of the gTLD <.mail> is likely to cause confusion with the Objector's marks as to the source, sponsorship, affiliation, or endorsement of the gTLD.

As noted above, the Respondent's expressed intention is to use the <.mail> gTLD string in the context of an open registry, based on the descriptive or dictionary meaning of "mail", in furtherance of ICANN's stated goal to increase choice and competition in domain names through the introduction of new gTLDs. While the Panel may accept for purposes of its present analysis that some members of the U.S. public associate the term "mail" with the Objector, (although not necessarily residents in countries other than the United States) the Panel does not accept as tenable the Objector's position that the Respondent's use of the <.mail> gTLD string will be systematically misperceived as an indicator of source for the Objector's services. The Panel considers the term "mail" to be merely descriptive or generic respecting some of the Objector's services, and likely incapable of serving by itself as a distinctive indicator of source.

The Panel considers that the prospective use of the applied-for gTLD string with an open registry admits of the possibility for second level domain name registrations corresponding to the Objector's trademarks. In the absence of evidence that the potential for such second level name registrations is likely to result in systemic trademark abuse, however, the Panel does not find that the mere possibility of such a risk demonstrates a likelihood of confusion between the applied-for gTLD string and the Objector's marks. The Panel further notes that the rights protective mechanisms mandated by ICANN for all new gTLDs and the additional rights protection mechanisms to be implemented by the Respondent, afford a degree of protection against abusive second level domain registrations. See *Defender Security Company v. Baxter Pike LLC*, WIPO Case No. LRO2013-0031.

In the final analysis, "mail" is a descriptive or generic term when used in relation to the Objector's services, and the Objector does not have an exclusive right to use "mail" in a descriptive or generic sense. Given the Respondent's stated intention is to use the applied-for gTLD <.mail> in reference to the descriptive or dictionary meaning of "mail", the Panel finds that the intended use of the applied-for gTLD <.mail> is unlikely

¹⁵ Refer to Notes 6, 7 & accompanying text *supra*.

to cause confusion with the Objector's marks as to the source, sponsorship, affiliation or endorsement of the gLTD. As the United States Supreme Court noted in *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122 (2004): "[i]f any confusion results, that is a risk the plaintiff accepted when it decided to identify its product with a mark that uses a well-known descriptive phrase." See also *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 201 (1985) (noting safeguards in Lanham Act to prevent commercial monopolization of language); *Car-Freshner Corp. v. S. C. Johnson & Son, Inc.*, 70 F. 3d 267, 269 (2d Cir. 1995) (noting importance of "protect[ing] the right of society at large to use words or images in their primary descriptive sense"). As the Supreme Court explained in *KP Permanent Make-Up*, 543 U.S. at 121, "some possibility of consumer confusion must be compatible with fair use, and so it is."

C. Panel's Findings

As has already been noted, the eight factors discussed above are not exclusive, and are not intended as a rote checklist. The relative importance of individual factors may vary with the particular facts and circumstances of each case, and it is possible that not all factors will be applicable in every case. The Panel considers these factors, along with any others factors the Panel deems relevant, in deciding the ultimate issue: whether the proposed string takes unfair advantage or unjustifiably impairs the distinctive character or the reputation of the Objector's marks, or whether it otherwise creates an impermissible likelihood of confusion.

The language used in Section 3.5.2 of the Guidebook makes this dichotomy clear, for while the Panel is to "consider" the 8 non-exclusive factors, it is mandated that it "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 ... trademark or service mark ("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 or IGO name or acronym."

Several panels have considered that for an objector to prevail, "there must be something more than mere advantage gained, or mere impairment, or mere likelihood of confusion." See *e.g.*, *Right at Home v. Johnson Shareholdings*, WIPO Case No. LRO2013-0030; *Defender Security Company v. Lifestyle Domain Holdings, Inc.*, WIPO Case No. LRO2013-0035. In the view of these panels, while the terms "unfair", "unjustifiably," and "impermissible" are not uniformly defined or understood in the trademark context, their use in this context of Section 3.5.2 of the Guidebook suggests that, in order to sustain the Objection, the Panel must find something untoward about the Respondent's behavior or something intolerable about the Respondent being permitted to keep the string in dispute, even if the Respondent's conduct or motives do not rise to the level of bad faith. Similar views have been expressed by several other panels. See *Defender Security Company v. Baxter Pike LLC*, WIPO Case No. LRO2013-0031; *AC Webconnecting Holding B.V. v. United TLD Holdco Ltd*, WIPO Case No. LRO2013-0006.¹⁶

In view of the all of the foregoing, the Panel finds that the potential use of the applied-for gTLD by the Respondent does not:

(i) take unfair advantage of the distinctive character or the reputation of the Objector's registered or unregistered trademarks or service marks ("mark"), or

(ii) unjustifiably impair the distinctive character or the reputation of the Objector's mark, or

¹⁶ In *Defender Security Company v. Baxter Pike LLC*, WIPO Case No. LRO2013-0031, the panel concluded that the terms "unfair", "unjustifiably" and "impermissible" imply some malfeasance on the part of the respondent or an obvious adverse impact upon the objector's mark. The panel in *AC Webconnecting Holding B.V. v. United TLD Holdco Ltd*, WIPO Case No. LRO2013-0006, concluded that the terms "unfair advantage" and "unjustifiable impairment" in concern acts that have a commercial effect on a trademark which are undertaken in bad faith. The panel looked to the meaning given these concepts in WIPO's *Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet* and *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks*. The panel *AC Webconnecting* concluded that a likelihood of confusion is "impermissible" in the sense that it cannot be justified.

(iii) otherwise create an impermissible likelihood of confusion between the applied-for gTLD and the Objector's mark.

The reasons for those conclusions are that the Panel finds on the totality of the evidence and submissions, that:

- (i) while the potential use of the applied-for gTLD by the applicant may take some advantage of the distinctive character or the reputation of the Objector's trademarks, the Objector has not discharged the onus imposed on it by Section 3.5 of the Guidebook to show that any such possible advantage would be "unfair";
- (ii) while that potential use may impair the distinctive character or the reputation of the objector's mark, the Objector has not discharged its onus imposed on it by Section 3.5 of the Guidebook to show that any such impairment could be described as "unjustifiable";
- (iii) while the potential use may create some confusion in limited cases, the Objector has not discharged the onus imposed on it by Section 3.5 of the Guidebook to show that any such confusion could be described as "impermissible".

Accordingly, the Panel finds that the Objector has failed to satisfy the circumstances that would allow the Panel to uphold the Objection.

7. Decision

The Panel rejects the Objection.

[signed]

William R. Towns
Presiding Panelist

[signed]

Maxim H. Waldbaum
Panelist

[signed]

The Honourable Neil Brown Q.C.
Panelist
Date: August 7, 2013