

**REFERENCE MATERIALS TO NEW gTLD PROGRAM COMMITTEE
SUBMISSION 2013-10-XX-XX**

TITLE: **Reconsideration Request 13-7**

Summary Background

While the full background can be found in the documentation attached to these Reference Materials, Reconsideration Request 13-7 brought by Dish DBS Corporation (“Dish”) seeks reconsideration of the 29 July 2013 Expert Determination from a dispute resolution panel (“Panel”) established by the Arbitration and Mediation Center of the World Intellectual Property Organization regarding The DirecTV Group, Inc.’s (“DirecTV”) objection to the application for .DIRECT. Specifically, the Request seeks reconsideration of the Panel’s determination sustaining DirecTV’s objection to Dish’s application for .DIRECT. The BGC evaluated Request 13-7 at its 25 September 2013 meeting and recommended that the Request be denied and that no further action be taken in response to the Request. As detailed in the Recommendation and documents attached to this Reference Materials, the BGC determined that Dish has not stated proper grounds for reconsideration because it failed to identify any policy or process that was allegedly violated by the staff action. The BGC further recommends that Dish’s request for an opportunity to respond to the BGC, as well as the request for a hearing, be denied on the basis that no policy or process has been identified that the Panel or ICANN failed to follow and that said requests do not have the potential to bring before the BGC additional material information that is relevant to the evaluation of this Request 13-7.

The New gTLD Program Committee agrees with the BGC and is adopting the BGC Recommendation and Reconsideration Request 13-7.

Document/Background Links

The following attachments are relevant to the BGC’s recommendation regarding Booking.com’s Reconsideration Request 13-7.

Attachment A is [Reconsideration Request 13-7](#), submitted on 23 August 2013.

Attachment B is [Attachments 1-2 to Request 13-7](#), submitted on 23 August 2013.

Attachment 3 to Request 13-7 was the complete New gTLD Applicant Guidebook, available at <http://newgtlds.icann.org/en/applicants/agb/guidebook-full-04jun12-en.pdf>.

Attachment C is [Attachments 4-11 to Request 13-7](#), submitted on 23 August 2013.

Attachment D is the [Letter from Jim Davis to the BGC](#), submitted on 6 September 2013.

Attachment E is the [BGC's Recommendation on Reconsideration Request 13-7](#), issued on 25 September 2013.

Submitted by: Amy A. Stathos
Position: Deputy General Counsel
Date Noted: 21 November 2013
Email: amy.stathos@icann.org

“.direct” gTLD application (Application ID: 1-2007- 43424) - Request for Reconsideration of ICANN’s Decision on August 8, 2013

1. Requester Information

Name: DISH DBS Corporation

Address: Contact Information Redacted

Email: Contact Information Redacted

Phone Number: Contact Information

C/O

Name: Deborah M. Lodge, Patton Boggs LLP

Address: Contact Information Redacted

Email: C
o

Phone Number: Contact Information

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

Board action/inaction

Staff action/inaction

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

- Dish DBS Corporation (hereinafter, “DISH” or “Respondent”) seeks reconsideration of ICANN’s decision to accept the Panel’s determination in LRO2013-0005 (“Decision”) (**Attachment 1**) as an expert determination and advice pursuant to section 3.4.6 of the Applicant Guide Book (“AGB”).
- DISH also seeks reconsideration of ICANN’s inaction in providing clear and well-defined standards to the Dispute Resolution Service Providers (“DRSP”) that have resulted in inconsistent decisions from the DRSP Panels for Legal Rights Objections.

4. Date of action/inaction:

The Decision was published on August 8, 2013. (**Attachment 2**)

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

The Decision was communicated from the World Intellectual Property Organization (“WIPO”) to DISH’s representatives by email on August 8, 2013.

DISH's representatives informed DISH of the Decision on August 8, 2013.

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

DISH is one of two applicants for the “.direct” generic top level domain (“gTLD”). The Decision will have the following impact on DISH, as the Applicant Guide Book (“AGB”) indicates that the “Applicant Withdraws” if it cannot clear all objections. (**Attachment 3**, AGB at page 3-26).

- DISH will not be allowed to operate the ‘.direct’ gTLD based on its application (Application ID: 1-2007-43424), if that the ‘.direct’ gTLD by Half Trail, LLC (Application ID: 1-1424-94823) is recommended for delegation; and
- If DISH wants to use the .direct gTLD in the manner specified in response to question 18(a) in its application, then it will need to purchase/reserve over 3,000 second level domains for the .direct gTLD from Half Trail, LLC or enter into an agreement with Half Trail, LLC. Both of these options will require significant investments, in addition to DISH's existing investments with the Internet Corporation for Assigned Names and Numbers (ICANN) new gTLD process to secure the .direct gTLD. This is not justified given ICANN's inaction in failing to provide an automatic right of appeal in the existing new gTLD dispute resolution process.

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

DISH believes that the Decision also affects the following:

- Other similarly situated applicants/respondents across the various DRSPs, that have suffered inconsistent or erroneous decisions by Panels, including, but not limited to: the applicant for the “.delmonte” gTLD in LRO2013-0001; the applicant for the “.pets” gTLD in ICDR Case No. 50 504 00274 13; and the applicant for “.cam” in ICDR Case No. 50 504 T 229 13. These applicants will not have a uniform or clear forum to challenge these inconsistent and erroneous DRSP panel determinations.
- Over 14 million existing satellite television consumers and internet consumers or new consumers searching for legitimate DISH products and services will have to navigate a number of disjointed second level domains to locate these products and services.

8. Detail of Board or Staff Action – Required Information

Section 3.2 of the Applicant Guide Book (“AGB”) provides:

“a path for formal objections during evaluation of the applications. It allows a party with standing to have its objection considered before a panel of qualified experts... A formal objection initiates a dispute resolution proceeding. In filing an application for a gTLD, the applicant agrees to accept the applicability of this gTLD dispute resolution process. Similarly, an objector accepts the applicability of this gTLD dispute resolution process by filing its objection.”

Section 3.2.1 of the AGB provides that a Legal Rights Objection (“LRO”) may be filed where:

“The applied-for gTLD string infringes the existing legal rights of the objector.”

Section 3.2.3 of the AGB provides that to trigger an LRO, an objection must be filed with:

“The Arbitration and Mediation Center of the World Intellectual Property Organization [, which] has agreed to administer disputes brought pursuant to legal rights objections.”

In the recommendation of the Board Governance Committee (“BGC”) for Reconsideration Request 13-5 dated August 1, 2013, the BGC noted that:

“ICANN has determined that the Reconsideration process can properly be invoked for challenges of the third party’s decisions where it can be stated that either the vendor failed to follow its process in reaching the decision, or that ICANN staff failed to follow its process in accepting that decision.”
(Attachment 4, Page 4).

Based on the above guidance from the BGC, because the WIPO Arbitration and Mediation Center is a third party selected by ICANN, the Request for reconsideration is applicable to WIPO actions by the WIPO Panels.

Section 2.4.3 of the AGB governs the code of third-party panelists appointed by ICANN and provides that:

“Panelists shall conduct themselves as thoughtful, competent, well prepared, and impartial professionals throughout the application process. Panelists are expected to comply with equity and high ethical standards while assuring the Internet community, its constituents, and the public of objectivity, integrity, confidentiality, and credibility.

[...]

Bias -- Panelists shall...

*examine facts as they exist and **not be influenced by past reputation, media accounts**, or unverified statements about the applications being evaluated...”*
(Emphasis Added)

Further, article 20 of the Attachment to Module 3 – New gTLD Procedure (“Procedure), which defines the standards for the Procedure, provides that:

“(a) For each category of Objection identified in Article 2(e), the Panel shall apply the standards that have been defined by ICANN.

(b) 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.

(c) The Objector bears the burden of proving that its Objection should be sustained in accordance with the applicable standards.”

Here, the Panelists, in contravention of section 2.4.3 of the AGB, were improperly influenced by media accounts as the Decision itself candidly admits:

“the Panel notes that as it has been deliberating over this case, Respondent is running a series of television advertisements aimed squarely at Objector and its satellite television offerings.” (Attachment 1, Page 4-5).

No television advertisement of Respondent was submitted in the record of this proceeding. This biased selection of advertisements outside of the record, which appears to have influenced the Panel’s erroneous determination of the Respondent’s bad faith, directly contravenes Article 20(b).

Additionally, section 3.4.6 of the AGB provides that the:

“findings of the panel will be considered an expert determination and advice that ICANN will accept within the dispute resolution process.”

Because ICANN is the final arbiter about whether an applied-for new gTLD application proceeds to delegation, this advice to ICANN clearly indicates that the DRSP panels are only providing a recommendation to ICANN. ICANN makes the ultimate decision with respect to whether an application may proceed to delegation. As a result of the above, a staff action by ICANN is present in this matter.

ICANN’s **automatic** acceptance of the DRSP panelist decisions, even those that are erroneous or inconsistent, is contrary to ICANN’s mandate to act transparently and fairly. Paragraph 7 of the Summary of ICANN Generic Names Supporting Organisation’s (GNSO’s) Final Report on the Introduction of New Generic Top- Level Domains (gTLDs) and Related Activity provides that the

“evaluation and selection process [for the introduction of new top-level domains] should respect the principles of fairness, transparency and non-discrimination. Further, all applicants should be evaluated against transparent

and **predictable criteria**, fully available before initiation of the process.”
(Emphasis added) (**Attachment 5**)

Thus, ICANN’s actions above are also inconsistent with this guidance.

ICANN’s Articles of Incorporation require it to act “through open and transparent processes,” and its Bylaws further provide that ICANN must “operate to the maximum extent feasible in an open and transparent manner and consistent with procedures designed to ensure fairness.” (Articles of Incorporation, Art. 4; Bylaws, Art. III. sec. 1) The Bylaws also require that ICANN “mak[e] decisions by applying documented policies neutrally and objectively, with integrity and fairness.” (Bylaws, Art. I, Sec. 2.8). ICANN’s Bylaws also prohibit discriminatory treatment: “ICANN shall not apply its standards, policies, procedures, or practices inequitably or single out any particular party for disparate treatment . . .”. (Bylaws, Art. II, Sec. 3).

ICANN’s failure to provide a mechanism for redress for erroneous and inconsistent DRSP Expert Determinations is contrary to ICANN’s mandate to act with fairness and prevents DISH and other applicants from challenging erroneous and inconsistent DRSP Expert Determinations in a non-arbitrary and non-discriminatory fashion. DRSP panelists are taking “diverse and sometimes opposing views in their decision-making.” (**Attachment 6**). For example, a panelist in *Charleston Road Registry v Koko Castle*, (ICDR Case No. 50 504 00233 13) August 7, 2013, decided that it was inappropriate to consider trademark law in his decision, while the panelist in *VeriSign Switzerland SA v TV Sundram Iyengar & Son Limited* (ICDR Case No. 50 504 00257 13) August 8, 2013, gave trademark law considerable weight. Other examples of this inconsistency are provided in the response to Question 10 below. Fundamental fairness requires that Panels or panelists apply the same standards and principles in their decision-making. These inconsistent positions by the Panels or panelists are hardly consistent with ICANN’s mandate to act with fairness.

Background of Facts related to action/inaction of ICANN Staff or third party vendor

On March 12, 2013, pursuant to the new gTLD Dispute Resolution Procedure, The DirecTV Group Inc. (“Objector”) filed an LRO with the WIPO DRSP.

On March 20, 2013, the WIPO DRSP completed its administrative review of the Objection and determined it completed with the requirements of the Procedure.

WIPO notified DISH’s representatives on April 16, 2013, of the Objection.

DISH timely filed its response on May 16, 2013.

The WIPO DRSP appointed Robert A. Badgley, Mark Partridge, and Maxim Waldbaum as members of the Panel in this matter on June 20, 2013.

On May 22, 2013, Objector requested an opportunity to file a reply brief, which it reiterated on June 20, 2013.

DISH also requested an opportunity to respond to any additional reply briefs filed by the Objector on June 20, 2013.

On June 26, 2013, the Panel issued Procedural Order No. 1 in which it ordered Objector to submit a short Reply Brief by July 1, 2013, and Respondent to submit a short Rejoinder thereto within three business days thereafter. Both parties made timely submissions.

On July 25, 2013, the Panel extended the deadline for the rendering of the Expert Determination in this matter by 14 days.

On August 8, 2013, the Panel notified the parties and ICANN of its Expert Determination.

9. What are you asking ICANN to do now?

- DISH is asking ICANN to reverse the Decision. This reversal by the BGC will allow the DISH .direct gTLD application, which is part of ICANN String Similarity contention set no. 64, to proceed to string contention and eventual delegation.
- DISH is asking for ICANN to discard the Panel's determination under section 2.4.3.2 of the AGB and for the Decision to be reviewed by a new Panel.
- DISH is also asking ICANN to provide applicants of inconsistent or erroneous DRSP panel determinations with an avenue for redress that is consistent with ICANN's mandate to act with fairness.
- In the event that ICANN will not immediately reverse the Decision, DISH requests that it be provided an opportunity to respond to the BGC, before the BGC makes a final determination.

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

Pursuant to section 3.5.2 of the AGB, in determining whether an Objector in an LRO may prevail, the Panel must determine whether the potential use of the applied-for gTLD:

(i) takes unfair advantage of the distinctive character or the reputation of the objector's registered or unregistered trademark or service mark ("mark"); or

(ii) unjustifiably impairs the distinctive character or the reputation of the objector's mark; or
(iii) otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector's mark.

a) DISH's application for the .direct gTLD was bona fide.

Section 3.5 of the AGB indicates that the Objector bears the burden of proof; however, ICANN has failed to articulate what the burden of proof is – Preponderance of the Evidence, Clear and Convincing, etc. This has also contributed to different Panels using different standards for the burden of proof.

Here, in its response to Question 18(a) of the .direct application, DISH indicated on the record that it sought the “.direct” gTLD:

as a restricted, exclusively-controlled gTLD for the purpose of expanding Applicant and its affiliated entities' ability to:

- create a connected digital presence and personalized brand experience for customers and other business partners;*
- deliver product and service marketing/advertising;*
- enable marketing campaign activation;*
- facilitate secure interaction and communication with individuals and entities with whom Applicant has a business relationship;*
- improve business operations;*
- simplify Internet user navigation to information about Applicant products and services;*
- demonstrate market leadership in protecting customer privacy and confidential information online; and*
- meet future client expectations and competitive market demands.*

Further, an affidavit submitted by DISH's Senior Vice President of Product Management, Vivek Khemka, stated that the application for the “.direct” gTLD was filed in good faith, as part of Respondent's business plan to increase its connectivity and offerings to consumers. (Attachment 1, page 4). Mr. Khemka also noted that the concept of providing "direct" services to its customers has been key to DISH's business and success:

"DISH provides [satellite television] programming and content 'direct' to consumers, direct to their homes, direct to their screens. DISH also will provide telecommunications services 'direct' to consumers. DISH offers consumers direct choice, direct value, and direct service. 'Direct' service has been a key element of DISH's offerings since its founding. That is why DISH selected <.direct> as a gTLD."

Without according Mr. Khemka's declaration sufficient weight, the Panel while deliberating indiscriminately reviewed DISH advertisements outside of the record

as discussed above in the response to Question 9. This indiscriminate review by the Panel appears to have led to their conclusion that the .direct gTLD application was not a *bona fide* application. (**Attachment 1**, Page 4-5).

In Right at Home v. Johnson Shareholdings, Inc., WIPO Case No. LRO2013-0030, Robert Badgley, the presiding panelist in the Decision, indicated that the language of section 3.5.2 of the AGB created a very high burden for trademark-based objections:

*The use of the terms "unfair," "unjustifiably," and "impermissible" as modifiers, respectively, of "advantage," "impairs," and "likelihood of confusion" in Section 3.5.2 suggests that there **must be something more than mere advantage gained, or mere impairment, or mere likelihood of confusion for an Objection to succeed under the Procedure.** It seems, rather, that there must be something untoward- even if not to the level of bad faith - in the conduct or motives of Respondent, or something intolerable in the state of affairs which would obtain if the Respondent were permitted to keep the String in dispute. (emphasis added) (**Attachment 7**).*

This decision was also followed a number LRO panels, including the panels in subsequent LRO decisions: *Canadian Real Estate Association v. Affiliat Limited*, WIPO Case No. LRO2013-0008; *Pinterest, Inc. v. Amazon EU S.a.r.l*, WIPO Case No. LRO2013-0050; and *Defender Security Company v. Lifestyle Domain Holdings, Inc.*, WIPO Case No. LRO2013-0035. *Id.* Based on the record, there is nothing to suggest that there was something untoward about DISH's behavior as DISH has not applied for any competitor brands or trademarks, but rather applied for its brand names and generic terms that were pertinent to its business model. Therefore, the advertisements, which were outside of the record, improperly affected the Panel's decision and rendered it erroneous.

Further, a Respondent's business model does not automatically translate into a finding of bad intent. See *Express, LLC v. Sea Sunset, LLC*, WIPO Case No. LRO2013-0022; and *Limited Stores, LLC v. Big Fest, LLC*, WIPO Case No. LRO2013-0049. Indeed, as the Panel found in the *Express, LLC* case, this risk is an inherent function of the Objector's decision to use a dictionary word as its brand name. The Panel's view of DISH's business model was not only inconsistent with decisions from other panels, but also improperly biased by the DISH advertisements viewed outside of the record.

The "DBS" in DISH DBS Corporation is an acronym for "Direct Broadcast Satellite." "Direct Broadcast Satellite" is a generic term used to describe satellite television broadcasts intended for home reception. (**Attachment 8**). In his declaration Mr. Khemka also confirmed that the provision of satellite television broadcasts to consumers is one of DISH's primary business models, since its founding in 1980. Additionally, DISH has used the acronym for Direct Broadcast Satellite, "DBS", since the formation of DISH DBS Corporation in 1996.

Therefore, there is nothing in the record that would support a finding of “something untoward” or “something intolerable in the state of affairs” in DISH’s *bona fide* application for the .direct gTLD.

DISH respectfully submits that Mr. Khemka’s declaration was not accorded the proper weight. Mr. Khemka’s declaration along with DISH’s response to questions 18(a) and (b) of the application, clearly show on the record that DISH filed a *bona fide* application for the .direct gTLD. Further, a more objective review of other information outside of the record by the Panel would clearly have showed that: (i) DISH has used the phrase “direct” on its website, since as early as 1996 (“**Attachment 9**”); (ii) some of DISH’s over 3,000 exclusive and non-exclusive retailers have used the phrase “direct” in conjunction with the phrase “DISH” and/or DISH products and services since at least **December 1998**. (**Attachment 10**); and (iii) a recent television segment on AZCentral.com (available at <http://www.azcentral.com/video/750995585001>) reviewing the DISH products and services offered in Arizona also refers to the phrase “DISH Direct.” (**Attachment 11**). These examples clearly show DISH’s goals to “[u]nify the full breadth of products and services offered by Applicant and its affiliated entities under one brand umbrella” as stated in its response to Question 18(b) of the application. (**Attachment 1**, page 3). The brand referenced in the phrase “one brand umbrella” is DISH, as confirmed by Mr. Khemka in his declaration.

The above discussions clearly contradict the following assertions by the Panelist and demonstrate that DISH filed a *bona fide* application for the .direct gTLD:

*“there is something untoward in Respondent’s motives here, and that an intolerable state of affairs would obtain if Respondent’s application for the String were allowed to stand;” (**Attachment 1**, Page 5); and*

*“Respondent has never used the term “direct” as a trademark or service mark, and with good reason. If it tried to do so, it would likely be enjoined by a court of law at Objector’s behest. Respondent’s claim that it has applied for the <.direct> string because it provides services (in the generic sense) directly to consumers is viewed by the Panel as a contrivance.” (**Attachment 1**, Page 7).*

- b) DISH has not 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.

DISH’s gTLD applications have consisted of generic words, which are related to its businesses or its trademarks. DISH has not applied for any competitor trademarks as gTLD applications. Thus, there is nothing in the record showing that DISH has engaged in a pattern of conduct that may infer any type of bad faith. To the contrary, DISH merely applied for a generic term, which it had used personally and through its affiliates and retailers since at least 1996. LRO panels

such as the panel in *Express, LLC v. Sea Sunset, LLC*, WIPO Case No. LRO2013-0022, regard this as permissible.

c) Internet users will not be confused.

As discussed above, contrary to the incorrect assertion by the Panel, DISH, its affiliates and some of its retailers have used the phrase “direct” in conjunction with DISH’s products and services for at least 17 years. Robert Badgley, the Presiding Panelist in this matter, noted in his dissent in *Del Monte Corporation v. Del Monte Int’l GmbH*, WIPO Case No. LRO2013-0001, “[t]he fact that multiple entities have been using the same mark in the same general area of commerce (food) for many years suggests that the consuming public has not been too troubled or confused by this state of affairs.” Here, as discussed above, both DISH and the Objector have used the phrase “direct” for over 17 years in the satellite services industry and the consuming public does not appear to have been confused. There is nothing in the record that would support a finding of confusion.

d) DISH will be injured if the decision is allowed to stand.

DISH has spent hundreds of thousands of dollars in attempting to secure the .direct gTLD for the purposes articulated in its application. It will likely spend even more in a string content auction with Half Trail, LLC if the BGC reverses the Decision. If the BGC chooses not to uphold the ICANN mandate of fairness by providing the remedy sought in response to Question 9, then the AGB only provides DISH with the ability to obtain a \$37,000 refund, which is patently unfair.

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

Yes

No

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

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

Attachment 1 – *The DirecTV Group Inc. v. Dish DBS Corporation*, WIPO Case LRO2013-0005.

Attachment 2 – Legal Rights Objections filed with the WIPO Arbitration and Mediation Center

Attachment 3 - gTLD Application Guidebook Version 2012-06-04

Attachment 4 – Recommendation of the Board Governance Committee (“BGC”) for Reconsideration Request 13-5 dated August 1, 2013

Attachment 5 - Summary of ICANN Generic Names Supporting Organisation’s (GNSO’s) Final Report on the Introduction of New Generic Top- Level Domains (gTLDs) and Related Activity

Attachment 6 - Interview: Atallah on new gTLD objection losers, available at <http://domainincite.com/14208-interview-atallah-on-new-gtld-objection-losers> (last accessed August 23, 2013)

Attachment 7 - ICANN Legal Rights Objections: What's Past Is Prologue I Bloomberg BNA, available at <http://www.bna.com/icann-legal-rights-b17179875369/> (last accessed July 23, 2013)

Attachment 8 – Wikipedia page for “Direct Broadcast Satellite”.

Attachment 9 – Screenshot from 19 DISH website.

Attachment 10 – Screenshots showing the use of the phrase “direct” with DISH products and services.

Attachment 11 –Screenshot from Arizona Midday video on AZ central describing the DISH products and services

Terms and Conditions for Submission of Reconsideration Requests

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

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

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

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

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

DISH hereby requests a hearing.

Dzbrnny Ledy

Signature

August 23, 2013
Date

EXPERT DETERMINATION LEGAL RIGHTS OBJECTION

The DirecTV Group Inc. v. Dish DBS Corporation

Case No. LRO2013-0005

1. The Parties

Objector/Complainant (“Objector”) is The DirecTV Group Inc. of El Segundo, California, United States of America represented by Arent Fox LLP, United States.

Applicant/Respondent (“Respondent”) is Dish DBS Corporation of Englewood, Colorado, United States represented by Patton Boggs LLP, United States.

2. The applied-for gTLD string

The applied-for gTLD string (the “String”) is <.direct>.

3. Procedural History

The Legal Rights Objection (“the Objection”) was filed with the WIPO Arbitration and Mediation Center (the “WIPO Center”) on March 12, 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 20, 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 Respondent of the Objection, and the proceedings commenced on April 16, 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 16, 2013.

The WIPO Center appointed Robert A. Badgley, Mark Partridge, and Maxim Waldbaum as the Panel in this matter on June 20, 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 May 22, 2013, Objector requested an opportunity to file a reply brief, which it reiterated on June 20, 2013. On the same day, the Respondent requested an opportunity to respond to any additional reply briefs filed by Objector, if the Panel granted Objector's request. On June 26, 2013, the Panel issued Procedural Order No. 1 in which it ordered Objector to submit a short Reply Brief by July 1, 2013 and Respondent to submit a short Rejoinder thereto within three business days thereafter. Both parties made timely submissions.

4. Factual Background

Objector and its subsidiaries provide digital television entertainment services, and provide television and audio services via satellite to subscribers. Objector provides such services under its DIRECTV mark and other marks containing the term "direct".

Since 1994, Objector has used the mark DIRECTV to identify and distinguish its digital and satellite television services. Objector is a leading satellite television provider in the United States, offering more than 285 digital channels to more than 20 million subscribers in the United States. Objector has another 15 million subscribers in other countries, including a large presence in Latin America.

Objector and its affiliates hold numerous trademark registrations. For example, the word mark DIRECTV was registered on the Principal Register of the United States Patent and Trademark Office ("USPTO") in March 2003 for telecommunications products (which are detailed and include satellite dishes). The word and design service mark DIRECTV was registered with the USPTO in September 2002 for "television programming and production services and distribution of television programs for others." These USPTO registered marks indicate first use in commerce in June 1994.

Other USPTO Principal Register registrations held by Objector or its affiliates include: (1) the word mark DIRECTV PLUS registered in January 2001 for "electronic equipment for receiving direct broadcast satellite signals, namely, receivers, satellite dishes, antennas and remote controllers therefore [*sic*] sold together as a unit" with a first use in commerce in September 1999; (2) the word service mark DIRECTV AIRBORNE registered in January 2004 for "satellite television transmission and broadcasting services" with a first use in commerce in April 1999; (3) the word service mark WORLDDIRECT registered in January 2006 for "television programming and production services and distribution of television programs for others" with a first use in commerce in December 2004; (4) the word service mark WORLDDIRECT registered in October 2007 for "satellite television transmission and broadcasting services" and "pay-per-view television transmission services" with a first use in commerce in December 2004; (5) the word service mark DIRECTVIEW registered in October 2012 for research and analysis of consumer viewing habits with a first use in commerce in April 2010; (6) the word service mark PINOYDIRECT registered in July 2010 for "television programming and production services, programming on a global computer network," and related services with a first use in commerce in September 2008; (7) the word service mark HINDIDIRECT registered in July 2007 for "satellite television broadcasting" and related services with a first use in commerce in October 2004; and (8) the word service mark MANDARINDIRECT registered in August 2007 for "satellite television broadcasting" and related services with a first use in commerce in May 2005.

Outside the United States, Objector holds several trademark registrations, including: (1) DIRECTV CINEMA registered in Argentina in September 2011; (2) DIRECTV NEXUS registered in Chile in July 2012 for telecommunications products and services; (3) DIRECTV registered in Colombia in July 2011 for telecommunications services; (4) DIRECTV registered in the Bolivarian Republic of Venezuela in April 2000 for telecommunications products; (5) ACCESS DIRECTV registered in the European Union in December 2011 for various goods and services, including telecommunication and satellite broadcasting services; and (6) DIRECTVIEW registered in the European Union in July 2011 for various goods and services.

For each year from 2008 through 2012, the DIRECTV brand was ranked among the world's 500 most valuable brands by BrandFinance.

Objector has maintained a website at “www.directv.com” since 1995. In 2012, that website received an average of more than 10 million visits each month. Objector also uses the toll-free telephone number 1-800-DIRECTV to promote its services.

Respondent is a subsidiary of Dish Network Corporation. According to Respondent’s Senior Vice President of Product Management:

“DISH provides satellite television, broadband services, audio programming, and interactive television services to commercial and residential customers in the United States. DISH currently provides satellite television services to 14 million subscribers in the United States. DISH has been a leader and innovator since it was founded in 1980. Since 1996, DISH has provided direct to home satellite based television services.”

In 2011, Dish purchased Blockbuster L.L.C. out of bankruptcy. Through its Blockbuster affiliate, Dish now provides movie and video game rental services to consumers “by DVD-by-mail, streaming and video-on-demand.” Dish also asserts that it intends to expand its presence and activities in the communications field.

Respondent describes itself in marketing materials as “a leader in satellite TV, providing subscribers with the highest-quality programming and technology at the best value.” Objector and Respondent are direct competitors, and both vie for the same customers as satellite dish television subscribers.

There is no evidence in the record that Respondent has ever used DIRECT (or any derivation of that word) as a trademark or service mark.

In section 18(a) of its application for the <.direct> gTLD, Respondent wrote in relevant part:

Applicant seeks the proposed .direct gTLD as a restricted, exclusively-controlled gTLD for the purpose of expanding Applicant and its affiliated entities’ ability to:

- create a connected digital presence and personalized brand experience for customers and other business partners;
- deliver product and service marketing/advertising;
- enable marketing campaign activation;
- facilitate secure interaction and communication with individuals and entities with whom Applicant has a business relationship;
- improve business operations;
- simplify Internet user navigation to information about Applicant products and services;
- demonstrate market leadership in protecting customer privacy and confidential information online; and
- meet future client expectations and competitive market demands.

In section 18(b) of its application, Respondent identified its anticipated “user experience goals” as follows:

- Unify the full breadth of products and services offered by Applicant and its affiliated entities under one brand umbrella;
- Improve and streamline the manner in which customers and other business partners can interact with Applicant and its affiliated entities in the online digital space;
- Foster trust and confidence in online interactions by customers and other business partners with Applicant and its affiliated entities;
- Reduce the risk of Internet users being misled, believing and/or acting on erroneous, information about Applicant and its affiliated entities, its business partners and/or its products and services presented online by unauthorized third parties; and
- Simplify online navigation to products, services and business partner information for Applicant and its affiliated entities.

In an affidavit submitted by Respondent's Vice President, Vivek Khemka, in response to the Objection, Respondent claims that its application for the <.direct> gTLD was filed in good faith, as part of Respondent's business plan to increase its connectivity and offerings to consumers. As Mr. Khemka notes in his affidavit, Respondent intends to continue to provide programming and content "direct" to consumers, using the <.direct> gTLD as a closed, secure network for its eco-system. As Mr. Khemka notes, the concept of providing "direct" services to its customers has been key to Respondent's business and success:

"DISH provides programming and content 'direct' to consumers, direct to their homes, direct to their screens. DISH also will provide telecommunications services 'direct' to consumers. DISH offers consumers direct choice, direct value, and direct service. 'Direct' service has been a key element of DISH's offerings since its founding. That is why DISH selected <.direct> as a gTLD."

5. Parties' Contentions

A. Objector

According to Objector, this is a clear case of underhanded business practices by a competitor. Objector states: "Dish and DIRECTV are direct competitors. Dish acknowledges this in promotional and marketing materials, including at its Web site where it dedicates numerous pages and charts to comparisons between Dish and DIRECTV." Objector also asserts that Respondent has never used the term "direct" to identify or distinguish its goods and services in commerce, but instead has chosen to apply for the <.direct> string in order to confuse consumers who were looking for Objector's goods and services.

Objector emphasizes the following quote from Respondent's application, in which Respondent describes its plan to use the <.direct> string to "[u]nify the full breadth of products and services offered by Applicant [DISH] and its affiliated entities under one brand umbrella." According to Objector, this stated plan is an admission by Respondent that it plans to use <.direct> as a trademark. In this vein, Objector points to several other stated goals of Respondent as reflected in section 18(a) of its application, including:

- creating a connected digital presence and personalized brand experience for customers and other business partners;
- delivering product and service marketing and advertising;
- enabling marketing campaign activation;
- simplifying Internet user navigation to information about Dish's products and services; and
- meeting future client expectations and competitive market demands.

B. Respondent

Respondent denies that it intends to use <.direct> as a trademark, stating that the word "direct" is generic and hence cannot serve as a mark. Respondent also claims that its proposed use of the String is *bona fide* and will not cause confusion with Objector and its goods and services.

6. Discussion and Findings

For the reasons set forth below, the Panel concludes that the Objection should be sustained. Respondent, a purveyor of satellite television services, is seeking to use the word "direct," which is the dominant part of the family of marks owned and used by its chief competitor in the satellite television business, Objector. On the record before it, the Panel therefore unanimously concludes that Respondent likely chose the <.direct> string for the sole purpose of disrupting the business of Objector.

That these two parties are direct competitors can scarcely be doubted. Indeed, the Panel notes that as it has been deliberating over this case, Respondent is running a series of television advertisements aimed

squarely at Objector and its satellite television offerings.

The Panel rejects Respondent's professed *bona fide* motives for applying for the String. Rather, the Panel views Respondent's effort as part of a battle for satellite television market share. Accordingly, under the standards set forth in the Procedure, the Panel concludes that the potential use of the applied-for gTLD by Respondent takes unfair advantage of the distinctive character or the reputation of Objector's registered marks, and unjustifiably impairs the distinctive character or the reputation of Objector's mark, and otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and Objector's mark. gTLD Applicant Guidebook ("Guidebook"), Section 3.5.2. The Panel concludes that there is something untoward in Respondent's motives here, and that an intolerable state of affairs would obtain if Respondent's application for the String were allowed to stand.

The Guidebook sets forth eight non-exclusive factors which should be considered by the Panel when applying the Section 3.5.2 standards to the facts of this case. The Panel will address them below in order.

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

According to Objector, it is "indisputable that the gTLD string '.DIRECT' is nearly identical to DIRECTV's core intellectual property, including its name, and its family of DIRECTV and DIRECT-formative trademarks, and its primary domain name <directv.com>.

According to Respondent:

"The applied-for gTLD <.direct> is not identical or substantially similar to any of Objector's marks. While Objector submitted a roster of many trademark registrations in the U.S. and internationally using the term 'DIRECTV' 'direct+{suffix}', none of these registrations is for 'direct' by itself. That is, Objector has not established that it owns any trademark rights, anywhere in the world, in 'DIRECT' in and by itself. Instead, each of Objector's trademark registrations is for 'direct' in combination with another term, such as 'tv', 'hindi', 'mandarin', 'pinoy', 'world', 'view', etc., as is shown by the registrations set forth in Objector's Attachments B and C. In view of the inherent generic and descriptive nature of the word 'direct,' it is highly unlikely that Objector – or anyone else – could own exclusive trademark rights in 'direct' – especially when used for television or other services offered directly to consumers.

Further, while 'DIRECT' and 'DIRECTV' have some similarities in appearance, a critical aspect of DIRECTV is 'TV,' and as the survey evidence discussed below confirms, that the term 'direct' is not uniquely associated with Objector. Similarly, while 'DIRECT' and 'DIRECTV' have some phonetic similarities, they are significantly different, as the latter requires addition of third and fourth syllables for the 'TV' portion (DIR-ECT-TEE-VEE). That 'TV' portion is critical to Objector's marks and provides meaning, context and association of goods/services with a unique provider thereof. Without the 'TV' segment, the 'DIRECT' portion provides no such association – with Objector or anyone else. By itself, 'DIRECT' is simply a generic term. It is possible that, as stated in paragraph 12.e of Objector's complaint, that its 'DIRECTV' brand was valued at \$8.2 Billion. That is for the full mark, with the critical 'TV' component. It is telling that Objector does not claim that any value was established for 'DIRECT' alone. Objector's failure to establish any use of 'DIRECT' by itself in its advertising and as a free-standing brand compels the conclusion that Objector too has used 'DIRECT' only generically and not as a brand. That is not surprising, as Objector cannot claim any exclusive rights to that generic term."

The Panel concludes that the String is similar to the DIRECTV mark inasmuch as it differs by only one letter, and is similar to the other DIRECT-formative marks of Objector. The Panel is well aware of the fact that Objector's main mark is a contraction of the terms DIRECT and TV, with the T serving a dual role. Even so,

the String and the marks are similar. It bears noting that *confusing* similarity is not required under this factor.

As respects the “survey evidence” alluded to by Respondent under this head, the Panel will address it later in this opinion.

The Panel finds that this factor weighs in favor of Objector.

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

There is no serious dispute that Objector’s acquisition and use of rights in its various DIRECT-formative marks is *bona fide*. Accordingly, the Panel finds that this factor favors Objector.

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 Objector, of Respondent or of a third party.

According to Respondent:

“Objector failed to show that the public recognizes ‘DIRECT’ as its mark. Indeed, the facts show that ‘Direct’ is not associated with Objector. Dr. Maronick’s survey shows that less than 6% of persons responding to his survey made any connection between .direct and Objector. Maronick Decl., para. 7 (Attachment 2 hereto). As Dr. Maronick states: ‘In this survey, respondents were asked ‘If you were to see a domain name ending with ‘.direct’ would you associate it with any particular company or organization?’ Those who said yes were asked ‘what company or organization?’ Less than 6% of respondents (11 persons out of 216 responding) mentioned DirecTV as that company. Most respondents (159 out of 216) did not name any company at all.’ *Id.* That result is far less than the 15-20% minimum that would be needed to show any association or confusion. See Thomas McCarthy, 6 McCarthy on Trademarks and Unfair Competition § 32:188 (4th ed.).

That result is not surprising. Thousands of trademark registrations use the word ‘direct.’ Most of those use other words or symbols with ‘direct’ – again because no one entity can have exclusive rights to such a generic word. Thus, a search of live trademark applications and registrations at the U.S. Patent and Trademark Office alone revealed over 3,000 results incorporating ‘direct’ in a mark, See Declaration of Paralegal Karen Agee, annexing results of trademark searches (Attachment 3 hereto).”

The Panel is not convinced that the Maronick survey supports Respondent’s case here. First, the context of the survey is not provided. That is to say, the precise circumstances under which the survey was conducted are not laid out by Respondent or its expert, Dr. Maronick. Rather, a bare summary of the methodology and the salient findings is provided. As such, the Panel finds the survey to be of little probative value.

The Panel also questions certain aspects of the methodology, at least as far as it understands it. For instance, it is arguable that survey respondents who do not know the major players in the transmission of entertainment via satellite should not even be counted in the survey.

Further, the Panel notes, assuming the validity of the survey (and the Respondent’s clarifications as to survey responses in its Rejoinder), that nine out of 46 survey respondents who did associate the hypothetical domain name <television.direct> with a particular company identified Objector. This outcome, albeit with a very small sample, confirms that more than 19% of the survey participants who identified some company identified Objector.

Respondent asserted in its Rejoinder that, while not bearing on the main point of the conclusions it makes from its survey, some members of the public associate the <.direct> gTLD with DISH. As respects third-party uses, the Panel accepts that numerous parties have made use of the term “direct” as part of their trademark or service mark. These facts and assertions, however, are of little moment here. In the Panel’s

opinion, the essential fact in this proceeding is that Respondent, a purveyor of satellite television services, is seeking to use the word “direct,” which is the dominant part of the family of marks owned and used by its chief competitor in the satellite television business, Objector.

The Panel finds that this factor weighs in favor of Objector.

iv. Respondent’s intent in applying for the gTLD, including whether Respondent, at the time of application for the gTLD, had knowledge of Objector’s mark, or could not have reasonably been unaware of that mark, and including whether 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.

This factor, in the Panel’s view, is of paramount importance in this case. There is no doubt that Respondent is well aware of Objector and its DIRECTV and other DIRECT-formative marks. Objector is Respondent’s main competitor, and vice-versa, in the major market of satellite television services in the United States.

Respondent has never used the term “direct” as a trademark or service mark, and with good reason. If it tried to do so, it would likely be enjoined by a court of law at Objector’s behest. Respondent’s claim that it has applied for the <.direct> string because it provides services (in the generic sense) *directly* to consumers is viewed by the Panel as a contrivance.

Rather, the Panel concludes, based on the record before it, that Respondent has applied for the String as part of an ongoing battle for market share, at Objector’s expense.

Respondent essentially admits as much in its application, wherein it states that it applied for the String to “unify the full breadth of products and services offered by Applicant and its affiliated entities under one brand umbrella.” The String, therefore, would serve as the “one brand umbrella” under which the “full breadth” of Respondent’s products and services would be unified. The Panel finds this admission in the application as far more reliable than the statements, quoted above, by Respondent’s vice president, who disavows Respondent’s brand-centered motivation in applying for the String.

In contrast to applying for a gTLD string on the basis of its generic or dictionary meaning, which LRO panels regard as permissible in many circumstances (see *Express, LLC v. Sea Sunset, LLC*, WIPO Case No. LRO2013-0022), this Panel finds that Respondent’s likely intention was to target the trademark of a direct competitor.

The Panel concludes that this factor favors Objector.

v. Whether and to what extent 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 Objector of its mark rights.

The discussion under factor 4 applies with equal force here. The Panel concludes that this factor favors Objector.

vi. Whether 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 Respondent is consistent with such acquisition or use.

Respondent has no marks or other intellectual property rights that correspond to the word “direct.” The Panel finds that this factor favors Objector.

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

The Panel finds that Respondent has not been commonly known by the word “direct.” By contrast, Objector has long been associated with the word “direct” (albeit with the term “TV” or a geographical or other descriptive indicator) in the entertainment sector. The Panel finds that this factor favors Objector.

viii. Whether Respondent’s intended use of the gTLD would create a likelihood of confusion with Objector’s mark as to the source, sponsorship, affiliation, or endorsement of the gTLD.

As noted above, Respondent stated in its application that it intended to use the String to “unify the full breadth of products and services offered by Applicant and its affiliated entities under one brand umbrella.” Notwithstanding Respondent’s subsequent, and unconvincing, efforts to disavow this stated motive, the Panel believes that consumer confusion would be likely if this application were allowed to stand. It appears very likely, based on Respondent’s survey alone, that some Internet users seeking Objector’s satellite television services would be confused to land at a website accessible at, for example, the domain name <television.direct>.

The parties are in direct competition for the satellite television market, and the dominant word in Objector’s family of marks is the word “direct.” Under these circumstances, the Panel concludes that consumer confusion would be the likely result if Respondent were allowed to keep and use the <.direct> string.

The Panel concludes that this factor favors Objector.

7. Decision

For the foregoing reasons, the Objection is upheld.

[signed]

Robert A. Badgley
Presiding Panel Expert

[signed]

Mark Partridge
Panel Expert

[signed]

Maxim Waldbaum
Panel Expert
Date: July 29, 2013



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Geneva, Switzerland, October 29 and 30, 2013

PROPOSED STRING TO WHICH THE OBJECTION IS DIRECTED	OBJECTOR	APPLICANT	GROUND FOR OBJECTION	DATE OF THE WIPO CENTER'S RECEIPT OF THE OBJECTION	DETERMINATION
.delmonte	Del Monte Corporation	Del Monte International GmbH	Legal Rights Objection	March 2, 2013	Objection Upheld with Dissenting Opinion
.coach	Coach, Inc.	Koko Island, LLC aka Dozen Donuts, LLC aka Donuts, Inc	Legal Rights Objection	March 8, 2013	Objection Rejected
.academy	Academy, Ltd., d/b/a Academy Sports + Outdoors	Half Oaks, LLC	Legal Rights Objection	March 11, 2013	Objection Rejected
.blue	Blue Cross and Blue Shield Association ("BCBSA")	Afilias Limited	Legal Rights Objection	March 12, 2013	Objection Rejected
.direct	The DirecTV Group Inc.	Dish DBS Corporation	Legal Rights Objection	March 12, 2013	Objection Upheld
.mls	The Canadian Real Estate Association (CREA)	Afilias Limited	Legal Rights Objection	March 12, 2013	Objection Rejected
.merck	Merck KGaA	Merck Registry Holdings, Inc.	Legal Rights Objection	March 12, 2013	Pending
.merck	Merck KGaA	Merck Registry Holdings, Inc.	Legal Rights Objection	March 13, 2013	Pending
.merckmsd	Merck KGaA	MSD Registry Holdings, Inc	Legal Rights Objection	March 13, 2013	Pending
.goo	NTT Resonant Inc.	Charleston Road Registry Inc.	Legal Rights Objection	March 13, 2013	Terminated
.yellowpages	Hibu (UK) Limited	Telstra Corporation Limited	Legal Rights Objection	March 13, 2013	Objection Rejected
.vip	I-Registry Ltd.	VipSpace Enterprises LLC	Legal Rights Objection	March 13, 2013	Objection Rejected

.vip	I-Registry Ltd.	John Corner, LLC.	Legal Rights Objection	March 13, 2013	Objection Rejected
.vip	I-Registry Ltd.	VIP Registry Pte. Ltd	Legal Rights Objection	March 13, 2013	Objection Rejected
.vip	I-Registry Ltd.	Charleston Road Registry Inc.	Legal Rights Objection	March 13, 2013	Objection Rejected
.vip	I-Registry Ltd.	Top Level Domain Holdings Limited	Legal Rights Objection	March 13, 2013	Objection Rejected
.diy	Scripps Networks, LLC	Charleston Road Registry Inc.	Legal Rights Objection	March 13, 2013	Objection Rejected
.food	Scripps Networks Interactive, Inc.	Dot Food, LLC	Legal Rights Objection	March 13, 2013	Objection Rejected
.food	Scripps Networks Interactive, Inc.	Wild Orchard, LLC	Legal Rights Objection	March 13, 2013	Pending
.express	Express, LLC	Sea Sunset, LLC	Legal Rights Objection	March 13, 2013	Objection Rejected
.zone	AutoZone Parts, Inc.	Outer Falls, LLC	Legal Rights Objection	March 13, 2013	Terminated
.gcc	The Cooperation Council for the Arab States of the Gulf also known as the Gulf Cooperation Council or GCC	GCCIX WLL	Legal Rights Objection	March 13, 2013	Terminated
.now	Starbucks (HK) Limited	Grand Turn, LLC	Legal Rights Objection	March 13, 2013	Objection Rejected
.now	Starbucks (HK) Limited	Global Top Level ApS	Legal Rights Objection	March 13, 2013	Objection Rejected
.now	Starbucks (HK) Limited	Amazon EU S.a.r.l.	Legal Rights Objection	March 13, 2013	Objection Rejected
.now	Starbucks (HK) Limited	One.com A/S	Legal Rights Objection	March 13, 2013	Objection Rejected
.now	Starbucks (HK) Limited	XYZ.COM LLC	Legal Rights Objection	March 13, 2013	Objection Rejected
.rightathome	Right At Home, Inc.	Johnson Shareholdings, Inc	Legal Rights Objection	March 13, 2013	Objection Rejected
.gmbh	TLDDOT GmbH	InterNetWire Web-Development GmbH	Legal Rights Objection	March 13, 2013	Objection Rejected
.music	DotMusic Limited	Amazon EU S.à r.l.	Legal Rights Objection	March 13, 2013	Pending
.music	DotMusic Limited	Charleston Road Registry Inc.	Legal Rights Objection	March 13, 2013	Objection Rejected
.music	DotMusic Limited	dot Music Limited	Legal Rights Objection	March 13, 2013	Objection Rejected
.music	DotMusic Limited	DotMusic Inc.	Legal Rights Objection	March 13, 2013	Pending
.music	DotMusic Limited	Entertainment Names Inc.	Legal Rights Objection	March 13, 2013	Objection Rejected
.music	DotMusic Limited	Victor Cross	Legal Rights	March 13,	Objection

			Objection	2013	Rejected
.music	DotMusic Limited	.music LLC	Legal Rights Objection	March 13, 2013	Objection Rejected
.song	DotSong Limited	Amazon EU S.à.r.l.	Legal Rights Objection	March 13, 2013	Objection Rejected
.tunes	DotTunes Limited	Amazon EU S.à.r.l.	Legal Rights Objection	March 13, 2013	Objection Rejected
.eco	planet.ECO, LLC	Top Level Domain Holdings Limited	Legal Rights Objection	March 13, 2013	Pending
.KOM	Regtime Ltd.; Legato Ltd.	VeriSign Sarl	Legal Rights Objection	March 13, 2013	Pending
.opr	Regtime Ltd.; Legato Ltd.	Public Interest Registry	Legal Rights Objection	March 13, 2013	Pending
.cam	AC Webconnecting Holding B.V.	United TLD Holdco Ltd.	Legal Rights Objection	March 12, 2013	Objection Rejected
.cam	AC Webconnecting Holding B.V.	Dot Agency Limited	Legal Rights Objection	March 12, 2013	Objection Rejected
.limited	Limited Stores, LLC	Big Fest, LLC	Legal Rights Objection	March 13, 2013	Objection Rejected
.pin	Pinterest, Inc.	Amazon EU S.à.r.l.	Legal Rights Objection	March 13, 2013	Objection Rejected
.axis	Axis Communications AB/ Axis AB	Saudi Telecom Company	Legal Rights Objection	March 13, 2013	Pending
.tube	Latin American Telecom, LLC	Charleston Road Registry, Inc.	Legal Rights Objection	March 13, 2013	Objection Rejected
.bio	Biotechnology Industry Organization	Starting Dot	Legal Rights Objection	March 13, 2013	Objection Rejected
.	Sina Corporation	Tencent Holdings Limited	Legal Rights Objection	March 13, 2013	Pending
.weibo	Sina Corporation	Tencent Holdings Limited	Legal Rights Objection	March 13, 2013	Pending
.mail	United States Postal Service	1&1 Mail & Media GmbH	Legal Rights Objection	March 13, 2013	Terminated
.mail	United States Postal Service	Afilias Domains No. 2 Limited	Legal Rights Objection	March 13, 2013	Terminated
.mail	United States Postal Service	Amazon EU S.à r.l	Legal Rights Objection	March 13, 2013	Objection Rejected
.mail	United States Postal Service	Charleston Road Registry Inc.	Legal Rights Objection	March 13, 2013	Objection Rejected
.mail	United States Postal Service	GMO Registry, Inc.	Legal Rights Objection	March 13, 2013	Objection Rejected
.mail	United States Postal Service	Victor Dale, LLC	Legal Rights Objection	March 13, 2013	Objection Rejected
.mail	United States Postal Service	WhitePages TLD LLC	Legal Rights Objection	March 13, 2013	Objection Rejected
.home	Defender Security Company	Baxter Pike LLC	Legal Rights Objection	March 13, 2013	Objection Rejected
.home	Defender Security	Charleston Road	Legal Rights	March 13,	Objection

	Company	Registry Inc.	Objection	2013	Rejected
.home	Defender Security Company	Dot Home LLC	Legal Rights Objection	March 13, 2013	Objection Rejected
.home	Defender Security Company	DotHome Inc.	Legal Rights Objection	March 13, 2013	Objection Rejected
.home	Defender Security Company	Lifestyle Domain Holdings, Inc.	Legal Rights Objection	March 13, 2013	Objection Rejected
.home	Defender Security Company	Merchant Law Group LLP	Legal Rights Objection	March 13, 2013	Objection Rejected
.home	Defender Security Company	Top Level Domain Holdings Limited	Legal Rights Objection	March 13, 2013	Objection Rejected
.home	Defender Security Company	Uniregistry, Corp.	Legal Rights Objection	March 13, 2013	Objection Rejected
.home	Defender Security Company	.Home Registry Inc.	Legal Rights Objection	March 13, 2013	Objection Rejected
.emerck	Merck & Co., Inc.	Merck KGaA	Legal Rights Objection	March 13, 2013	Objection Rejected
.merck	Merck & Co., Inc.	Merck KGaA	Legal Rights Objection	March 13, 2013	Objection Rejected
.moto	Motorola Trademark Holdings LLC	United TLD Holdco Ltd.	Legal Rights Objection	March 13, 2013	Objection Rejected

RECOMMENDATION
OF THE BOARD GOVERNANCE COMMITTEE (BGC)
RECONSIDERATION REQUEST 13-5

1 AUGUST 2013¹

On 7 July 2013, Booking.com B.V. (“Booking.com”), through its counsel, Crowell & Moring, submitted a reconsideration request (“Request”). The Request was revised from Booking.com’s 28 March 2013 submission of a similar reconsideration request, which was put on hold pending the completion of a request pursuant to ICANN’s Documentary Information Disclosure Policy (“DIDP”).

The Request asked the Board to reconsider the ICANN staff action of 26 February 2013, when the results of the String Similarity Panel were posted for the New gTLD Program. Specifically, the Request seeks reconsideration of the placement of the applications for .hotels and .hoteis into a string similarity contention set.

I. Relevant Bylaws

As the Request is deemed filed as of the original 28 March 2013 submission, this Request was submitted and should be evaluated under the Bylaws that were in effect from 20 December 2012 through 10 April 2013. Article IV, Section 2.2 of that version of ICANN’s Bylaws states in relevant part that any entity may submit a request for reconsideration or review of an ICANN action or inaction to the extent that it has been adversely affected by:

¹ At its 1 August 2013 meeting, the Board Governance Committee deliberated and reached a decision regarding this Recommendation. During the discussion, however, the BGC noted revisions that were required to the draft Recommendation in order to align with the BGC’s decision. After revision and allowing for the BGC member review, the BGC Recommendation on Request 13-5 was finalized and submitted for posting on 21 August 2013.

(a) one or more staff actions or inactions that contradict established ICANN policy(ies); or

(b) one or more actions or inactions of the ICANN Board that have been taken or refused to be taken without consideration of material information, except where the party submitting the request could have submitted, but did not submit, the information for the Board's consideration at the time of action or refusal to act.

A third criteria was added to the Bylaws effective 11 April 2013, following the Board's adoption of expert recommendations for revisions to the Reconsideration process. That third basis for reconsideration, focusing on Board rather than staff conduct, is "one or more actions or inactions of the ICANN Board that are taken as a result of the Board's reliance on false or inaccurate material information." (See <http://www.icann.org/en/about/governance/bylaws#IV>.)

When challenging a staff action or inaction, a request must contain, among other things, a detailed explanation of the facts as presented to the staff and the reasons why the staff's action or inaction was inconsistent with established ICANN policy(ies). See Article IV §2.6(g) of the 20 December 2012 version of Bylaws (<http://www.icann.org/en/about/governance/bylaws/bylaws-20dec12-en.htm#IV>) and the current Reconsideration form effective as of 11 April 2013 (<http://www.icann.org/en/groups/board/governance/reconsideration/request-form-11apr13-en.doc>).

Dismissal of a request for reconsideration is appropriate if the Board Governance Committee ("BGC") finds that the requesting party does not have standing because the party failed to satisfy the criteria set forth in the Bylaws. These standing requirements are intended to protect the reconsideration process from abuse and to ensure that it is not used as a mechanism simply to challenge an action with which someone disagrees, but that it is limited to situations where the staff acted in contravention of established policies.

The Request was originally received on 28 March 2013, which makes it timely under the then effective Bylaws.² Bylaws, Art. IV, § 2.5.

II. Background

Within the New gTLD Program, every applied-for string has been subjected to the String Similarity Review set out at Section 2.2.1.1 of the Applicant Guidebook. The String Similarity Review checks each applied-for string against existing TLDs, reserved names and other applied-for TLD strings (among other items) for “visual string similarities that would create a probability of user confusion.” (Applicant Guidebook, Section 2.2.1.1.1.) If applied-for strings are determined to be visually identical or similar to each other, the strings will be placed in a contention set, which is then resolved pursuant to the contention resolution processes in Module 4 of the Applicant Guidebook. If a contention set is created, only one of the strings within that contention set may ultimately be approved for delegation.

After issuing a request for proposals, ICANN selected InterConnect Communications (“ICC”) to perform the string similarity review called for in the Applicant Guidebook. On 26 February 2013, ICANN posted ICC’s report, which included two non-exact match contention sets (.hotels/.hoteis and .unicorn/.unicom) as well as 230 exact match contention sets. <http://www.icann.org/en/news/announcements/announcement-26feb13-en.htm>. The String Similarity Review was performed in accordance with process documentation posted at <http://newgtlds.icann.org/en/program-status/evaluation-panels/geo-names-similarity-process-07jun13-en.pdf>. As part of ICANN’s acceptance of the ICC’s results, a quality assurance review

² ICANN staff and the requester communicated regarding the holds placed on the Request pending the DIDP Response, and the requester met all agreed-upon deadlines, thereby maintaining the timely status of this Request.

was performed over a random sampling of applications to, among other things, test whether the process referenced above was followed.

Booking.com is an applicant for the .hotels string. As a result of being placed in a contention set, .hotels and .hoteis cannot both proceed to delegation. Booking.com will have to resort to private negotiations with the applicant for .hoteis, or proceed to an auction to resolve the contention issue. Request, page 4.

Although the String Similarity Review was performed by a third party, ICANN has determined that the Reconsideration process can properly be invoked for challenges of the third party's decisions where it can be stated that either the vendor failed to follow its process in reaching the decision, or that ICANN staff failed to follow its process in accepting that decision. Because the basis for the Request is not Board conduct, regardless of whether the 20 December 2012 version, or the 11 April 2013 version, of the Reconsideration Bylaws is operative, the BGC's analysis and recommendation below would not change.

III. Analysis of Booking.com's Request for Reconsideration

Booking.com seeks reconsideration and reversal of the decision to place .hotels and .hoteis in a non-exact match contention set. Alternatively, Booking.com requests that an outcome of the Reconsideration process could be to provide "detailed analysis and reasoning regarding the decision to place .hotels into a non-exact match contention set" so that Booking.com may "respond" before ICANN takes a "final decision." (Request, Page 9.)

A. Booking.com's Arguments of Non-Confusability Do Not Demonstrate Process Violations

The main focus of Booking.com's Request is that .hotels and .hoteis can co-exist in the root zone without concern of confusability. (Request, pages 10 – 12.) To support this assertion, Booking.com cites to the opinion of an independent expert that was not part of the string

similarity review panel (Request, pages 10-11), references the intended uses of the .hotels and .hoteis strings (Request, page 11) and the difference in language populations that is expected to be using .hotels and .hoteis (Request, page 11), references ccTLDs that coexist with interchangeable “i”s and “l”s (Request, page 11), notes the keyboard location of “i”s and “l”s (Request, page 12), and contends that potential users who get to the wrong page would understand the error they made to get there (Request, page 12).

Booking.com does not suggest that the process for String Similarity Review set out in the Applicant Guidebook was not followed, or that ICANN staff violated any established ICANN policy in accepting the String Similarity Review Panel (“Panel”) decision on placing .hotels and .hoteis in contention sets. Instead, Booking.com is supplanting what it believes the review methodology for assessing visual similarity should have been, as opposed to the methodology set out at Section 2.2.1.1.2 of the Applicant Guidebook. In asserting a new review methodology, Booking.com is asking the BGC (and the Board through the New gTLD Program Committee (NGPC)) to make a substantive evaluation of the confusability of the strings and to reverse the decision. In the context of the New gTLD Program, the Reconsideration process is not however intended for the Board to perform a substantive review of Panel decisions.. While Booking.com may have multiple reasons as to why it believes that its application for .hotels should not be in contention set with .hoteis, Reconsideration is not available as a mechanism to re-try the decisions of the evaluation panels.³

³ Notably, Booking.com fails to reference one of the key components of the documented String Similarity Review, the use of the SWORD Algorithm, which is part of what informs the Panel in assessing the visual similarity of strings. .hotels and .hoteis score a 99% on the publicly available SWORD algorithm for visual similarity. See <https://icann.sword-group.com/algorithm/>.

Booking.com also claims that its assertions regarding the non-confusability of the .hotels and .hoteis strings demonstrate that “it is contrary to ICANN policy⁴ to put them in a contention set.” (Request, pages 6-7.) This is just a differently worded attempt to reverse the decision of the Panel. No actual policy or process is cited by Booking.com, only the suggestion that – according to Booking.com – the standards within the Applicant Guidebook on visual similarity should have resulted in a different outcome for the .hotels string. This is not enough for Reconsideration.

Booking.com argues that the contention set decision was taken without material information, including Booking.com’s linguistic expert’s opinion, or other “information that would refute the mistaken contention that there is likely to be consumer confusion between ‘.hotels’ and ‘.hoteis.’” (Request, page 7.) However, there is *no* process point in the String Similarity Review for applicants to submit additional information. This is in stark contrast to the reviews set out in Section 2.2.2 of the Applicant Guidebook, including the Technical/Operational review and the Financial Review, which allow for the evaluators to seek clarification or additional information through the issuance of clarifying questions. (AGB, Section 2.2.2.3 (Evaluation Methodology).) As ICANN has explained to Booking.com in response to its DIDP requests for documentation regarding the String Similarity Review, the Review was based upon the methodology in the Applicant Guidebook, supplemented by the Panel’s process documentation; the process does not allow for additional inputs.

Just as the process does not call for additional applicant inputs into the visual similarity review, Booking.com’s call for further information on the decision to place .hotels and .hoteis in

⁴ It is clear that when referring to “policy”, Booking.com is referring to the process followed by the String Similarity Review.

a contention set “to give the Requester the opportunity to respond to this, before taking a final decision” is similarly not rooted in any established ICANN process at issue. (Request, page 9.) First, upon notification to the applicants and the posting of the String Similarity Review Panel report of contention sets, the decision was already final. While applicants may avail themselves of accountability mechanism to challenge decisions, the use of an accountability mechanism when there is no proper ground to bring a request for review under the selected mechanism does not then provide opportunity for additional substantive review of decisions already taken.

Second, while we understand the impact that Booking.com faces by being put in a contention set, and that it wishes for more narrative information regarding the Panel’s decision, no such narrative is called for in the process. The Applicant Guidebook sets out the methodology used when evaluating visual similarity of strings. The process documentation provided by the String Similarity Review Panel describes the steps followed by the Panel in applying the methodology set out in the Applicant Guidebook. ICANN then coordinates a quality assurance review over a random selection of Panel’s reviews to gain confidence that the methodology and process were followed. That is the process used for a making and assessing a determination of visual similarity. Booking.com’s disagreement as to whether the methodology should have resulted in a finding of visual similarity does not mean that ICANN (including the third party vendors performing String Similarity Review) violated any policy in reaching the decision (nor does it support a conclusion that the decision was actually wrong).⁵

⁵ In trying to bring forward this Request, Booking.com submitted requests to ICANN under the Documentary Information Disclosure Policy (DIDP). As of 25 July 2013, all requests had been responded to, including the release of the Panel process documentation as requested. See Request 20130238-1 at <http://www.icann.org/en/about/transparency>. Booking.com describes the information it sought through the DIDP at Pages 8 – 9 of its Request. The discussion of those requests, however, has no bearing on the outcome of this Reconsideration.

B. Booking.com’s Suggestion of the “Advisory Status” of the String Similarity Panel Decision Does Not Support Reconsideration

In its Request, Booking.com suggests that the Board has the ability to overturn the Panel’s decision on .hotels/.hoteis because the Panel merely provided “advice to ICANN” and ICANN made the ultimate decision to accept that advice. Booking.com then suggests that the NGPC’s acceptance of GAC advice relating to consideration of allowing singular and plural versions of strings in the New gTLD Program, as well as the NGPC’s later determination that no changes were needed to the Applicant Guidebook regarding the singular/plural issue, shows the ability of the NGPC to override the Panel determinations. (Request, pages 5-6.) Booking.com’s conclusions in these respects are not accurate and do not support Reconsideration.

The Panel reviewed all applied for strings according to the standards and methodology of the visual string similarity review set out in the Applicant Guidebook. The Guidebook clarifies that once contention sets are formed by the Panel, ICANN will notify the applicants and will publish results on its website. (AGB, Section 2.2.1.1.1.) That the Panel considered its output as “advice” to ICANN (as stated in its process documentation) is not the end of the story. Whether the results are transmitted as “advice” or “outcomes” or “reports”, the important query is what ICANN was expected to do with that advice once it was received. ICANN had always made clear that it would rely on the advice of its evaluators in the initial evaluation stage of the New gTLD Program, subject to quality assurance measures. Therefore, Booking.com is actually proposing a new and *different* process when it suggests that ICANN should perform substantive review (instead of process testing) over the results of the String Similarity Review Panel’s outcomes prior to the finalization of contention sets.

The subsequent receipt and consideration of GAC advice on singular and plural strings does not change the established process for the development of contention sets based on visual

similarity. The ICANN Bylaws require the ICANN Board to consider GAC advice on issues of public policy (ICANN Bylaws, Art. XI, Sec. 2.1.j); therefore the Board, through the NGPC, was obligated to respond to the GAC advice on singular and plural strings. Ultimately, the NGPC determined that no changes were needed to the Guidebook on this issue. (Resolution 2013.06.25.NG07, at <http://www.icann.org/en/groups/board/documents/resolutions-new-gtld-25jun13-en.htm#2.d>.) Notably, neither the GAC advice nor the NGPC resolution focused on the issue of visual similarity (which the String Similarity Review Panel was evaluating), but instead the issue was potential consumer confusion from having singular and plural versions of the same word in the root zone. It is unclear how the NGPC's decision on a separate topic – and a decision that did not in any way alter or amend the work of an evaluation panel – supports reconsideration of the development of the .hotels/.hoteis contention set.

VIII. Recommendation And Conclusion

Based on the foregoing, the BGC concludes that Booking.com has not stated proper grounds for reconsideration and we therefore recommend that Booking.com's request be denied without further consideration. This Request challenges a substantive decision taken by a panel in the New gTLD Program and not the process by which that decision was taken. As stated in our Recommendation on Request 13-2, Reconsideration is not a mechanism for direct, de novo appeal of staff or panel decisions with which the requester disagrees, and seeking such relief is, in fact, in contravention of the established processes within ICANN. See <http://www.icann.org/en/groups/board/governance/reconsideration/recommendation-nameshop-01may13-en.pdf>.

The BGC appreciates the impact to an applicant when placed in a contention set and does not take this recommendation lightly. It is important to recall that the applicant still has the

opportunity to proceed through the New gTLD Program subject to the processes set out in the Applicant Guidebook on contention. We further appreciate that applicants, with so much invested and so much at stake within the evaluation process, are interested in seeking any avenue that will allow their applications to proceed easily through evaluation. However, particularly on an issue such as visual similarity, which is related to the security and stability of the domain name system, there is not – nor is it desirable to have – a process for the BGC or the Board (through the NGPC) to supplant its own determination as to the visual similarity of strings over the guidance of an expert panel formed for that particular purpose. As there is no indication that either the Panel or ICANN staff violated any established ICANN policy in reaching or accepting the decision on the placement of .hotels and .hoteis in a non-exact contention set, this Request should not proceed.

If Booking.com thinks that it has been treated *unfairly* in the new gTLD evaluation process, and the NGPC adopts this Recommendation, Booking.com is free to ask the Ombudsman to review this matter. (See ICANN Bylaws the Ombudsman shall “have the right to have access to (but not to publish if otherwise confidential) all necessary information and records from ICANN staff and constituent bodies to enable an informed evaluation of the complaint and to assist in dispute resolution where feasible (subject only to such confidentiality obligations as are imposed by the complainant or any generally applicable confidentiality policies adopted by ICANN)”.)

**Summary of ICANN Generic Names Supporting
Organisation's (GNSO's)
Final Report on the Introduction of New Generic Top-
Level Domains (gTLDs)
and Related Activity**

*Prepared for the GNSO's 29 October 2007 New gTLDs Workshop
in Los Angeles*

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Introduction

1. The process for the introduction of new generic top-level domains (gTLDs) is central to fostering choice and competition in domain registration services, and as such is significant to the promotion of ICANN's core values. The evolution of the namespace toward enhanced diversity of services and service providers must be planned and managed effectively to ensure that the security, stability, reliability, and global interoperability of the Internet is maintained.
2. The proposed policy that would guide the introduction of new gTLDs was created by the Generic Names Supporting Organization (GNSO)¹ through its bottom-up, multi-stakeholder policy development process. The questions that have been addressed by the GNSO in the development of new gTLD policy are complex and involve technical, economic, operational, legal, public policy, and other considerations. The intended result is a straightforward process that awards new gTLDs if they satisfy the criteria and no objections are sustained.
3. The GNSO completed its Final Report on the Introduction of New Top-Level Domains², This document summarizes the recommendations contained in the Report and notes other work under way to facilitate the introduction of new gTLDs in an orderly and transparent way. Where particularly applicable, it also attempts to briefly provide information about various issues considered by the Committee and the rationale behind the final wording of principles, recommendations and implementation guidelines. This document is meant to provide a concise and easy to read summary of the key elements of the Report and is not intended to replace the full report that the GNSO Council provided.

Goal of the New gTLD Process

4. The GNSO formed a Committee on New Top-Level Domains (the Committee) to address the subject of new gTLDs. The Committee identified five main reasons why ICANN should proceed to introduce new gTLDs at this time:
 - (i) It is consistent with the reasons articulated in 1999 when the first proof-of-concept round for new gTLDs was initiated;³

¹ See <<http://gns0.icann.org/>>

² See <<http://gns0.icann.org/issues/new-gtlds/pdp-dec05-fr-parta-08aug07.htm>> and <<http://gns0.icann.org/issues/new-gtlds/pdp-dec05-fr-partb-01aug07.htm>>

³ See <<http://www.icann.org/yokohama/new-tld-topic.htm>>

(ii) There are no technical impediments to the introduction of new gTLDs, as evidenced by the two previous rounds and as confirmed by technical experts;

(iii) Expanding the domain name space to accommodate the introduction of both new ASCII and internationalised domain name (IDN) TLDs will give end-users more choice about the nature of their presence on the Internet. In addition, users may be able to use domain names in their language of choice;

(iv) There is demand for additional top-level domains as a business opportunity, which can stimulate competition at the registry service level; and

(v) No compelling reason has been articulated not to proceed with a new gTLD round.

It should be noted that, as with several elements of the Report, disagreements over these reasons were worked through and rough consensus was reached by the Committee. For example, early in the PDP, the Business and Intellectual Property Constituencies provided reasons for restricting a new gTLD round to sponsored TLDs (sTLDs), but ultimately the Committee reached rough consensus not to limit the introduction of new gTLDs.

GNSO Terms of Reference

5. The Committee divided its work into four broad Terms of Reference (TOR). The first TOR raised the preliminary question of whether to move ahead to establish new gTLDs. The Committee answered this question affirmatively and proceeded to consider which policies would enable the introduction of new gTLDs with respect to selection criteria (TOR 2), allocation methods (TOR 3) and policies for contractual conditions (TOR 4). The Committee developed the principles, recommendations and implementation guidelines that are set forth in its report and were approved by the GNSO Council on 6 September 2007 by a supermajority vote. They are summarized below in the order that they will be discussed at the GNSO's 29 October New gTLDs Workshop scheduled for the ICANN Los Angeles meeting. The principles, recommendations, and implementation guidelines have been grouped thematically, in accordance with the Terms of Reference listed above, so that each set is discussed in the most relevant session.

Workshop Session 1: Introductory Material and Contractual Conditions for New gTLDs (TOR 1 & TOR 4)

GNSO Principles, Recommendations 1, 4, 9, 10,⁴ 16, 17, 19, Related Implementation Guidelines, and Other Details

6. The Report outlines seven principles that have rough consensus from all GNSO constituencies and Nominating Committee representatives:
 - a. **New gTLD Process: Principle A** supports introducing new gTLDs in an orderly, timely and predictable way.
 - b. **Availability of IDNs: Principle B** supports having some new gTLDs be IDNs, subject to the approval of IDNs being available in the root.
 - c. **Rationale for New gTLDs: Principle C** outlines reasons for introducing new gTLDs, which include demand from potential applicants, as well as the potential to add to consumer choice, market differentiation, and geographical and service-provider diversity.
 - d. **Technical Criteria: Principle D** supports having a set of technical criteria to assess applicants to minimise the risk of harming the operational stability, security and global interoperability of the Internet.
 - e. **Capability Criteria: Principle E** supports having a set of capability criteria for applicants to provide assurance that it has the capability to meet its obligations under the terms of a registry agreement. This principle also was the result of extensive discussion and compromise among Committee members. Some supported the need for applicants to provide full business plans, while others argued that business plans were not needed. The final wording of Principle E was intended to reach a compromise that all could support by requiring applicants to provide sufficient capability information to demonstrate that an applicant can fulfill what is proposed and what would then become a part of the registry agreement.
 - f. **Operational Criteria: Principle F** supports having a set of operational criteria in the registry agreement to ensure compliance with ICANN policies.
 - g. **Freedom of Expression: Principle G** specifies that the process of evaluating the proposed gTLD not infringe on an applicant's freedom of expression rights under internationally recognized principles of law. Note that this principle was added after very long and intense discussions about Recommendations 3 and 6 with the

⁴ There is no Recommendation 11, which was replaced by Recommendation 20.

purpose of addressing concerns that were primarily communicated by representatives of the Non-Commercial Users Constituency.

7. **Fairness of Process:** The GNSO recommends that ICANN implement a process that allows the introduction of new top-level domains. In addition, the evaluation and selection process should respect the principles of fairness, transparency and non-discrimination. Further, all applicants should be evaluated against transparent and predictable criteria, fully available before initiation of the process. Normally, no additional selection criteria should be used (**Recommendation 1**).
 - a. Rationale: It is important that all applications are evaluated against clear criteria in a fair, transparent and non-discriminatory manner.
 - b. Issues: There was very strong agreement that selection criteria should be objective and measurable to ensure a predictable and fair process. It was also recognized, however, that some criteria are easier to define in objective and measurable ways than others. Some Committee members suggested excluding any recommendations that could not be absolutely objective. Others felt that there were some cases where concerns of certain members of the community needed to be addressed even if doing so could not achieve the highest standards of objectivity. In all cases, the Committee tried to minimize the need for subjective judgments but it is recognized that there are several areas where this was especially challenging; in those cases, considerable effort was made to make the criteria and process as objectively measurable as possible. (See the discussion of Recommendation 9 that follows).
 - c. Implementation Considerations: ICANN Staff has been working over the past year to prepare the groundwork for an orderly process consistent with this recommendation. It is in the process of retaining a provider to assist with preparation of the RFP, which will set forth the relevant criteria and explain all aspects of the application process in detail. (The Statement of Work for preparation of the RFP was posted on 6 September 2007 and is available at <http://www.icann.org/tlds/new-gtld-sow-06sep07.htm>.)
 - d. Potential Impact: Clear criteria, evaluated in a fair, transparent and non-discriminatory manner will instill confidence in ICANN's ability to introduce new gTLDs in a smooth process.
 - e. Note: The GNSO's Implementation Guideline C suggests that ICANN provide frequent communications with applicants and the public including comment forums, which is consistent with a transparent and orderly process.
8. **Technical Instability:** Strings must not cause any technical instability (Recommendation 4).

- a. Rationale: New gTLDs should not lead to technical instability or unexpected results in the DNS.
- b. Issues: The criteria that will be used to review this element will be stated in the RFP.
- c. Implementation Considerations: The review is expected to be done by ICANN, drawing on technical expertise as needed.
- d. Potential Impact: Applications for strings that are determined to potentially create technical instability or unexpected results in the DNS will not be approved, so as not to jeopardize the continuing stability and security of the Internet's unique identifier systems.

9. **Clear Process & Criteria:** The GNSO recommends that there be a clear and pre-published application process using objective and measurable criteria (**Recommendation 9**).

- a. Rationale: To be fair and credible, the application process must be made clear in advance and use objective, measurable criteria.
- b. Issues: Certain recommendations, such as those relating to public morality and order, or to community opposition, may not lend themselves readily to development of objective, measurable criteria. (See the Issues comments included for Recommendation 1 above.)
- c. Implementation Considerations: Staff and outside counsel are examining how best to address these issues. In most of the areas covered by the Report, it will be possible to develop measurable criteria.
- d. Potential Impact: A fair, credible round of applications for new gTLDs will benefit the ICANN community and others.
- e. Note: The GNSO's Implementation Guideline A suggests that the application process provide a "pre-defined roadmap" for applicants that encourages the submission of applications for new top-level domains. The GNSO's Implementation Guideline I suggests that an applicant granted a new gTLD must use it "within a fixed timeframe" to be specified in the application process. This guideline is intended to prevent gTLD squatting.

10. **Base Contract:** There must be a base contract provided to applicants at the beginning of the application process (Recommendation 10).⁵

- a. Rationale: Applicants should be on notice as to what the ICANN community expects from a registry operator.
- b. Issues: While it is possible to provide a base contract, it should be recognized that contracts with individual registry operators may vary depending on the particulars of the new gTLD they are being awarded.

⁵ The intent is that the base contract will be available before the beginning of the initial, minimum 4-month period that will precede the application period.

- c. Implementation Considerations: A draft base contract will be posted for public comment as soon as it is available. Much of the work done by the RFP provider will inform elements of the draft base contract. An outline of the draft base contract was posted in June 2007 (see <http://gns0.icann.org/drafts/draft-outline-tld-agreement-20070619.pdf>).
- d. Potential Impact: A draft base contract provides applicants with realistic expectations about what their contract with ICANN will contain if their application is successful. This is intended to save applicants time and money.
- e. Note: The GNSO's Implementation Guidelines (IG) suggest that the base contract should "balance market certainty and flexibility for ICANN to accommodate a rapidly changing market place" (IG-J); that ICANN "should take a consistent approach to the establishment of registry fees" (IG-K); and that "the use of personal data must be limited to the purpose for which it is collected" (IG-L).

11. Consensus Policies: Registries must apply existing Consensus Policies and adopt new Consensus Policies as they are approved (**Recommendation 16**).

- a. Rationale: New and existing gTLD operators should be bound by the same consensus policies.
- b. Issues: While concern was discussed in the Committee regarding special situations where a gTLD serves a specific and well-defined community for which they believe a specific consensus policy may not readily apply, ICANN will maintain and enforce the requirements to adhere to Consensus Policies.
- c. Implementation Considerations: The draft base contract contains a requirement that operators comply with new and existing Consensus Policies.
- d. Potential Impact: Compliance with existing and new Consensus Policies benefits the ICANN community in important ways, including helping to ensure the Internet's security and stability.

12. Sanctions Program: A clear compliance and sanctions process must be set out in the base contract which could lead to contract termination (**Recommendation 17**).

- a. Rationale: Enhanced compliance with registry contract provisions benefits the ICANN community.
- b. Issues: Recent registry agreements have not included a sanctions program (compare, e.g., the 2006 .COM agreement with the 2001 .NAME agreement).
- c. Implementation Considerations: The draft base contract does not contain a sanctions program and staff work continues on this issue.
- d. Potential Impact: Standard sanctions procedures which may be applied by ICANN to gTLD registries under contract.

13. Use of Registrars: Registries must use only ICANN accredited registrars in registering domain names and may not discriminate among such accredited registrars (**Recommendation 19**).

- a. Rationale: ICANN-accredited registrars are under contract with ICANN and must fulfill certain obligations.
- b. Issues: There are differing opinions as to whether smaller registries should be able to start a registrar if larger ones are uninterested in servicing their gTLD.
- c. Implementation Considerations: ICANN's current registry agreements require the use of registrars that must be ICANN-accredited and registries are prohibited from being ICANN – accredited registrars even for their own gTLDs.
- d. Potential Impact: Operators of smaller gTLDs may have difficulty locating registrars to certify. Regions where there are no, or few, ICANN-accredited registrars may also be at a disadvantage. ICANN is aware of the situation and is in the process of working with registrars and registries on possible solutions.

14. Application Fee: The GNSO's Implementation Guideline B suggests that application fees be designed to ensure that adequate resources exist to cover the total cost of administering the new gTLD process, and that application fees may vary for different applicants. The GNSO's Implementation Guideline N suggests that ICANN may also develop a "fee reduction model for gTLD applicants from economies classified by the UN as least developed."

- a. Rationale: The entire evaluation and review process should be conducted on a cost-recovery basis. At the same time, there could be a situation in which an applicant that comes from a least developed country or similarly challenged economy might have difficulty in obtaining the funds necessary to pay the required fees.
- b. Issues: Questions that should be examined include whether a potential applicant that cannot raise the required fees (directly or through a partnership or joint venture) would have the capital necessary to launch a new gTLD registry that meets ICANN specifications and is consistent with security and stability requirements as defined in this process. Other questions include how to distinguish applicants that can afford the fees even if they are from a least developed economy or similarly challenged economy, and how to avoid situations where potential applicants try to take advantage of any exception.
- c. Implementation Considerations: ICANN has stated that (i) the entire evaluation and review process will be conducted on a cost-recovery basis; (ii) the costs associated with the initial evaluation will be covered by the application fee; and (iii) the costs associated with any objections or contention resolution (or other review beyond

basic evaluation) will be borne by the parties utilizing those processes.

- d. Potential Impact: ICANN Staff and the GNSO will discuss the issues described above, carefully balancing the importance of encouraging applications from all parts of the world with the financial and other resources required to operate a new gTLD registry.

15. Working Languages: The GNSO's Implementation Guideline M suggests that ICANN establish a capacity building and support mechanism to help facilitate effective communication on important and technical Internet governance functions in a way that no longer requires all participants know English. The GNSO's Implementation Guideline O suggests that ICANN provide information about the new gTLD process in major languages other than English (e.g., the six working languages of the United Nations).

- a. Rationale: It is important to use different languages in order to reach as many potential applicants as possible, particularly as the goal is to solicit applications for new IDN gTLDs as well as ASCII. ICANN has already begun to conduct consultations and distribute documents in other languages, and is implementing a translation policy that will benefit the new gTLD process.
- b. Issues: ICANN will publicize the new gTLD process in different languages, but it remains to be seen if applications could be accepted in languages other than English.
- c. Implementation Considerations: There could be a trade-off between the duration of the round and the number of languages used during the evaluation period.
- d. Potential Impact: Even with using the 6 languages of the UN, it is possible that some potential applicants will not learn of the gTLD application process. ICANN's communications team is already developing a proactive plan to reach as many potential applicants as possible.

Workshop Session 2: Selection Criteria for New gTLDs (TOR 2)

GNSO Recommendations 2, 5, 7, 8, 13, 14, 15, 18 & Related Implementation Guidelines

16. Confusingly Similar: Strings must not be confusingly similar to an existing top-level domain or a Reserved Name (**Recommendation 2**).

- a. Rationale: A confusingly similar string could cause technical or consumer confusion.
- b. Issues: A string that resembles another string is not necessarily confusingly similar. In reviewing the approval of .BIZ in light of the existence of .BZ in 2001, ICANN's Reconsideration Committee

concluded that the two TLDs “do not appear reasonably subject to confusion,” see

<http://www.icann.org/committees/reconsideration/rc01-1.htm>.

Indeed, the following TLDs co-exist today: .CO and .COM; .BZ and .BS; .BS, .BZ and .BIZ; .INT, .IN and .INFO; and .NE and .NET.

Examples of strings that could cause confusion include “.COM” (using a zero) and .COM, or “.1NFO” (using the number one) and .INFO. Staff has begun discussions regarding an algorithm that could provide guidance on which applications require further scrutiny.⁶

- c. Implementation Considerations: Staff is exploring various options for implementation of this recommendation, including the application of an algorithm that provides guidance on which TLD strings are considered to be confusingly similar, and providing a capability for formal objection to be filed to an application by a third party on the grounds that the proposed gTLD is confusingly similar to an existing TLD.
- d. Potential Impact: Internet users throughout the world would benefit from the avoidance of creating new gTLDs that are confusingly similar to existing TLDs or reserved names.

17. Reserved Names: Strings must not be a Reserved Name (Recommendation 5).

- a. Rationale: Reserved Names may not be used at the top level.
- b. Issues: Some of the conclusions of the Reserved Names Working Group (RN-WG) were incorporated in the Report’s recommendations and guidelines. The RN-WG’s full set of recommendations may be found in Part B of the Report.⁷ The RN-WG recommended (and the GNSO agreed) that the following names be reserved: ICANN and IANA related names; any names that appear in the IDN Evaluation Facility that consist exclusively of translations of ‘example’ and ‘test’; NIC, Whois and www; single characters; symbols; tagged names; digits; and two letter names (for ccTLD use). The group recommended (and the GNSO agreed) that controversial names; geographic and geopolitical indicators, single and two character U-labels and single letter/single-digit combinations not be reserved. It was difficult for the group to define clear reservation requirements for geographical/geopolitical names and controversial names, and members believed those issues could be addressed by the new gTLD dispute resolution and challenge processes. ICANN Staff prepared a document for the GNSO Council providing information on implementation of the RN-WG recommendations, which was released on 4 September 2007

⁶ http://gns0.icann.org/issues/new-gtlds/pdp-dec05-fr-parta-08aug07.htm#_Toc35657638

⁷ See http://gns0.icann.org/issues/new-gtlds/pdp-dec05-fr-partb-01aug07.htm#_Toc47680304.

and is available at <http://www.gnso.icann.org/drafts/icann-implementation-doc-gnso-rswg-04sep07.pdf>.

- c. Implementation Considerations: As part of the administrative review of each application, ICANN Staff will determine whether the proposed string is on the Reserved Names list that will be published by ICANN.
- d. Potential Impact: Applicants that propose strings that are a Reserved Name will not be approved.

18. Technical Capability: Applicants must be able to demonstrate their technical capability to run a registry operation for the purpose that the applicant sets out. (**Recommendation 7**).

- a. Rationale: An applicant must be technically capable of operating a new gTLD registry to ensure that its operation does not negatively affect the stability and integrity of the DNS.
- b. Issues: There will be minimal technical criteria for all applicants to ensure security, stability and interoperability of the Internet. Also, technical requirements may vary depending on the purpose and use of the gTLD. For example, a gTLD designed to serve a specific geographical region or a small community would not need the same DNS constellation requirements that would be needed by a global gTLD.
- c. Implementation Considerations: Staff has asked the provider that will develop the RFP to propose the technical criteria, based on previous rounds.
- d. Potential Impact: Applicants will have to demonstrate that their operation of a new gTLD will not adversely affect the stability or security of the DNS.

19. Operational Capability: Applicants must be able to demonstrate their financial and organisational operational capability (**Recommendation 8**).

- a. Rationale: An applicant must have the financial and organisational operational capability to operate a new gTLD registry without jeopardizing the stability or integrity of the DNS.
- b. Issues: It remains to be seen whether there are ways to improve the operational criteria that have been used in previous rounds⁸. As noted regarding technical criteria, financial and operational requirements can vary depending on the gTLD. Principle E states, "A set of capability criteria for a new gTLD registry applicant must be used to provide an assurance that an applicant has the capability to meet its obligations under the terms of ICANN's registry agreement." Obligations may vary depending on what is proposed by an applicant.

⁸ See <http://www.icann.org/tlds/tld-criteria-15aug00.htm> and <http://www.icann.org/tlds/stld-apps-19mar04/PostAppA.pdf>.

- c. Implementation Considerations: Staff has asked the provider that will develop the RFP to propose the relevant business, financial and organisational criteria, based on previous rounds.
- d. Potential Impact: Applicants will be assessed to help ensure that their operation of a new gTLD will not adversely affect the stability or security of the DNS and that they are capable of implementing the gTLD as proposed.

20. Application Rounds: Applications must initially be assessed in rounds until the scale of demand is clear (**Recommendation 13**).

- a. Rationale: There is likely to be a need to assess applications in rounds until demand for new gTLDs levels off.
- b. Issues: Staff is factoring unknown application volume and scalability issues into its proposed implementation plans. The Committee suggested that ICANN should attempt to staff itself to accommodate whatever demand occurs while recognizing that it is not possible to accurately predict demand. The intent of this recommendation was that applications would be processed in rounds until such time as an ongoing application process could be put into place. Consistent with that, it is expected that the date for a second round will be communicated in the RFP for the first round.
- c. Implementation Considerations: It remains to be seen if there is a limit to the number of applications that ICANN can process in one round. Within a round, all applicants will be evaluated on the same grounds (i.e., order of receipt within a round will not be an evaluation criterion but will only be considered with regard to processing order).
- d. Potential Impact: The concept of rounds is important in terms of enabling any technical issues to be quickly identified and addressed. At the same time, it is important to clarify for applicants in this round whether there will be sub-rounds if more than “x” number of applications are received. It is also important to provide parties that might wish to apply in the future with appropriate guidance.

Note: The GNSO’s Implementation Guideline D suggests that ICANN use a “first- come, first-served” processing schedule within each round, continuing for other rounds, if necessary. Upon receipt by ICANN, applications would be time and date stamped. The GNSO’s Implementation Guideline E suggests that the application submission date be at least four months after the RFP is issued, and that ICANN take steps to publicize the opening of the round. The rationale behind the minimum 4-month period before the application submission period included 1) to allow entities to adequately prepare their response to the RFP and 2) to allow time for adequate and broad communication of the round within and external to ICANN circles.

- 21. Duration of Registry Agreement:** The initial registry agreement term must be of a commercially reasonable length (**Recommendation 14**).
- a. Rationale: Operating a first-class registry requires substantial resources, which operators may be unlikely to make without an assurance that they will be able to run a registry for at least a specific term and recoup their investment.
 - b. Issues: None – this issue has already been addressed, with existing gTLD operators.
 - c. Implementation Considerations: The draft base contract contains a term of ten years.
 - d. Potential Impact: A contract of a commercially reasonable duration provides incentives for a registry operator to make the investment necessary to operate a new gTLD in a stable and secure manner.
- 22. Renewal Expectancy:** There must be renewal expectancy (**Recommendation 15**).
- a. Rationale: A registry operator is also more likely to invest significant resources if it has the expectation that its contract will be renewed, absent malfeasance or other situations.
 - b. Issues: None – this issue has already been addressed, with respect to existing gTLD operators.
 - c. Implementation Considerations: The draft base contract provides an expectancy of renewal unless an arbitrator or court determines that the operator has breached the agreement and failed to cure it.
 - d. Potential Impact: The expectation of renewal provides a further incentive for a registry operator to invest the necessary resources in operating a new gTLD.
- 23. IDN Guidelines:** If an applicant offers an IDN service, then ICANN's IDN guidelines must be followed (**Recommendation 18**).
- a. Rationale: The IDN Guidelines must be followed to ensure security, stability and interoperability issues are sufficiently addressed, to minimize the risk of cybersquatting and consumer confusion, and to respect the interests of local languages and character sets.
 - b. Issues: ICANN staff will coordinate with other ICANN stakeholders to help ensure that the IDN Guidelines are successfully implemented. Any future IDN policy that relates to or effects gTLDs will be addressed by the GNSO.
 - c. Implementation Considerations: ICANN Staff and others are working to ensure that IDN gTLDs are introduced in a timely manner, and that the activities of the ccNSO⁹ related to the introduction of IDN ccTLDs, and activities in organizations such as the IETF with regard to the IDNA standards are coordinated, as needed.

⁹ See <http://ccnso.icann.org/>

- d. Potential Impact: Following the IDN Guidelines will support the diversity, security and stability of the domain name system (DNS).

Workshop Session 3: Allocation Methods for New gTLDs (TOR 3)

GNSO Recommendations 3, 6, 12, 20 & Related Implementation Guidelines

- 24. Legal Rights of Others:** Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law. Examples of these legal rights that are internationally recognized include, but are not limited to, rights defined in the Paris Convention for the Protection of Industry Property (in particular trademark rights), the Universal Declaration of Human Rights (UDHR) and the International Covenant on Civil and Political Rights (ICCPR) (in particular freedom of expression rights) **(Recommendation 3)**.
- a. Rationale: A party holding rights that believes it would be harmed may file an objection that a proposed gTLD will infringe on legal rights that are recognized or enforceable under generally accepted and internationally recognized principles of law.
 - b. Issues: Efforts should be made to clarify the kinds of legal rights that are derived from internationally recognized principles of law and applicable to the context of new gTLDs.
 - c. Implementation Considerations: Further legal research is being done on the potential applicability of the Paris Convention on the Protection of Industrial Property, the International Covenant on Civil and Political Rights (ICCPR) and the Universal Declaration of Human Rights (UDHR). Article 6bis of the Paris Convention, for example, prohibits the “reproduction, [an] imitation, or [a] translation, liable to create confusion, of a [trade]mark,” although it does not appear to have ever been applied in the context of a TLD. Provisions of the ICCPR and other human rights treaties prohibit a state party from arbitrary or unlawful interference with an individual’s privacy and family, and protect an individual’s freedom of thought, conscience, religion, opinion and expression. Further legal research can help determine what rights could be at issue in the context of establishing new gTLDs.
 - d. Potential Impact: It is important that the new gTLD process respect the concerns that have been expressed by groups representing both trademark and freedom of expression interests.

- 25. Public Morality & Public Order:** Strings must not be contrary to generally accepted legal norms relating to morality and public order that are recognized under international principles of law. Examples of such principles of law include, but are not limited to, the Universal Declaration of Human Rights

(UDHR), the International Covenant on Civil and Political Rights (ICCPR), the Convention on the Elimination of All Forms of Discrimination Against Women (CEDAW) and the International Convention on the Elimination of All Forms of Racial Discrimination, intellectual property treaties administered by the World Intellectual Property Organisation (WIPO) and the WTO Agreement on Trade-Related Aspects of Intellectual Property (TRIPS) (**Recommendation 6**).

- a. Rationale: Anyone may file an objection to a proposed gTLD on the ground that it is contrary to generally accepted legal norms relating to morality and public order that are recognized under international principles of law.
- b. Issues: Efforts should be made to clarify the meaning of “generally accepted legal norms relating to morality and public order that are recognized under international principles of law” and would be applicable to decisions regarding new gTLDs.
- c. Implementation Considerations: Further legal research is being done on the potential applicability of the Universal Declaration of Human Rights (UDHR), the International Covenant on Civil and Political Rights (ICCPR), the Convention on the Elimination of all forms of Discrimination Against Women (CEDAW), the International Convention on the Elimination of All Forms of Racial Discrimination, intellectual property treaties administered by the World Intellectual Property Organization (WIPO), the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) and other potentially useful agreements, as well as how various national legal systems have addressed this question. Under Article 29(2) of the UDHR, for example, limitations on an individual’s rights and freedoms may be permitted “as are determined by law solely for the purpose of securing due recognition and respect for the rights and freedoms of others and of meeting the just requirements of morality, public order and the general welfare in a democratic society.” Article 6quinquies of the Paris Convention contains language relating to the denial of trademark registration in cases “when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public.” Legal research thus far suggests that international law has not addressed concepts of “morality” in connection with gTLDs or, the DNS or the Internet more generally. Other ideas may also be considered, such as having panels of internationally recognized experts review an objection under guidelines drawn from (or informed by) the practice of various ccTLDs with respect to second-level registration of domain names.
- d. Potential Impact: There is subjectivity involved in an expert panel making determinations on objections brought on these grounds. Concern has been expressed that the notion of public morality varies by region, by country, and by individual. As such, it will be

difficult to find any common standard to apply, much less to do so in an objective manner.

- 26. Dispute Resolution:** Dispute resolution and challenge processes must be established prior to the start of the process (**Recommendation 12**).
- a. Rationale: As noted above, it is important that all aspects of the application process be known before applications for new gTLDs are prepared and submitted.
 - b. Issues: Dispute resolution and challenge are intended to address two types of situations: (i) the filing of an objection against an application on certain specific grounds developed from the GNSO's recommendations (relating to confusingly similar (see paragraph 15 in the Report); legal rights of others (see paragraph 23 in the Report); morality & public order (see paragraph 24 in the Report); or community opposition pursuant to an "Objection Resolution Process (see paragraph 26 in the Report);" and (ii) when two or more applicants are vying for the same new gTLD ("contention resolution"). The procedures, standing and criteria for assessment need to be developed, and ICANN Staff has begun this process in consultation with outside counsel and other experts.
 - c. Implementation Considerations: ICANN Staff is taking steps to recruit an expert provider to supervise and help develop the Objection Resolution Process, and also exploring options for resolving cases of contention. (This is consistent with the GNSO's Implementation Guideline H, which suggests that independent external dispute providers render decisions on objections.) A "cooling off period" will be encouraged to enable parties involved in an objection or contention proceeding to try and resolve the issue on their own, as suggested by the GNSO's Implementation Guideline R.
 - d. In addition to setting forth all aspects of the final process in the RFP and announcements about the new gTLD process, ICANN plans – consistent with the GNSO's Implementation Guideline Q – to provide an automatic reply to acknowledge all public comments received and along with that acknowledgement provide links to dispute resolution information and processes.
 - e. Potential Impact: Explaining these processes before the application round is launched will facilitate implementation of the entire process, and periodic reminders during the process, particularly about any deadlines, will also be helpful.
 - f. Note: The GNSO's Implementation Guideline F suggests that applicants may resolve contention between them by mutual agreement within a pre-established timeframe. Otherwise, a "claim to support a community by one party will be a reason to award priority to that application." The GNSO also suggests that "the ICANN Board may be used to make a final decision, using advice

from staff and expert panels.” As noted above, contention resolution can provide for resolving cases where two or more applications, which have been judged qualified and have overcome any formal objections, are competing for the same string, or for strings that have been determined to be "confusingly similar." The Committee discussed methods such as 'comparative evaluation', 'lotteries' or 'auctions' but was unable to reach agreement to include them in the implementation guidelines. There were those who referred derogatorily to 'comparative evaluations' as 'beauty contests' while others supported such an approach. There were those who saw auctions as the ultimate in objectivity while others criticized them for favoring the rich. Some favored lotteries for fairness but there were concerns about the legal issues involved in running lotteries. ICANN Staff is exploring processes that enable contention to be resolved informally by the parties, or through comparative evaluation, auction, mediation, lottery, arbitration or some other objective delegation method. It should be noted that the role of the Board in the process remains to be defined.

- g. The GNSO's Implementation Guideline H suggests that an applicant's claim that the TLD is intended to support a particular community, such as a sponsored TLD or any other TLD intended for a specified community, will be taken on trust unless (i) the claim relates to a string that is also subject to another application and is being used only to gain priority for one of the applications; and (ii) a formal objection process is initiated pursuant to Recommendation 20).

27. Community Opposition: An application will be rejected if an expert panel determines that there is substantial opposition to it from a significant portion of the community to which the string may be explicitly or implicitly targeted (**Recommendation 20**).

- a. Rationale: An established institution representing a specified community may file an objection on the ground that there is substantial opposition to the application by a significant portion of the community to which the string may be explicitly or implicitly targeted.
- b. Issues: The definitions of the terms involved in an objection of this kind are important in terms of trying to limit subjectivity.
- c. Implementation Considerations: The GNSO's Implementation Guideline P suggests the following definitions:
 - i. Defining "substantial opposition" by reference to "significant portion," "community," "explicitly targeting," "implicitly targeting," "established institution," "formal existence" and "detriment;"
 - ii. Defining "significant portion" in terms of the "balance between the level of objection submitted by one or more

- established institutions and the level of support provided in the application from one or more such institutions;”
- iii. Defining “community” broadly, such as “an economic sector, a cultural community, or a linguistic community. It may also be a closely related community which believes it is impacted;”
 - iv. Defining “explicitly targeted” as meaning there is “a description of the intended use of the TLD in the application;”
 - v. Defining “implicitly targeted” as meaning a reasonable person would make “an assumption of targeting” or believe that “there may be confusion by users over its intended use;”
 - vi. Defining an “established institution” as one that “has been in formal existence for at least 5 years” (with fewer than five years “in exceptional circumstances,” such as a “re-organisation, merger, or an inherently younger community”) and including certain ICANN organizations (GAC, ALAC, GNSO, ccNSO and ASO); and
 - vii. Defining “formal existence” as evidenced by appropriate public documentation or validation.

This Guideline also suggests that the “objector must provide sufficient evidence to allow the panel to determine that there would be a likelihood of detriment to the rights or legitimate interests of the community or to users more widely.

- d. Potential Impact: Notwithstanding the GNSO’s effort to provide definitional suggestions, challenges remain in implementing this recommendation. In addition, questions have arisen about the impact on a community if the purpose or business model of the new gTLD changes after approval. This issue might be addressed in a new registry’s agreement with ICANN, or the registry could reach an agreement directly with the affected community, without limiting innovation.

Background Material

Policy Development Background

28. The Generic Names Supporting Organization (GNSO)¹⁰ has completed its Final Report on the Introduction of New Top-Level Domains (the Report).

¹⁰ <http://gns0.icann.org/>

Part A of the Report contains the substantive discussion of the Principles, Policy Recommendations and Implementation Guidelines (<http://gnso.icann.org/issues/new-gtlds/pdp-dec05-fr-parta-08aug07.htm>). Part B contains a range of supplementary materials that were used by the Committee during the Policy Development Process (PDP), including Constituency Impact Statements (CIS), Working Group Reports on sub-elements of the Committee's deliberations, a collection of external reference materials and procedural documentation (<http://gnso.icann.org/issues/new-gtlds/pdp-dec05-fr-partb-01aug07.htm>). Part B includes the reports of the Internationalised Domain Names Working Group (IDN-WG), the Reserved Names Working Group (RN-WG) and the Protecting the Rights of Others Working Group (PRO-WG). In addition, an ad-hoc group is developing an informational resource on rights protection mechanisms and their implementation; this resource will accompany the RFP.

29. More than 80 comments on the Report were submitted during the GNSO [public comment forum](http://www.icann.org/announcements/announcement-10aug07.htm) that ran from 10 to 30 August 2007 (<http://www.icann.org/announcements/announcement-10aug07.htm>), and a synopsis of the comments is posted at <http://forum.icann.org/lists/gtldfinalreport-2007/msg00082.html>. The comments can be roughly divided into three categories:
- (i) Concern about the subjectivity of language in Recommendations 6 and 20, relating to morality and public order, and to significant community opposition and belief that ICANN should “confine itself to technical and operational matters.”
 - (ii) General comments related to process and urging ICANN to move towards a robust and objective application process available as quickly as possible; and
 - (iii) Other comments relating to specific elements, such as IDN issues, the use of accredited registrars and protection of trademark rights.
30. On 6 September 2007, the GNSO Council voted 19-1-3 to support the recommendations in the Report, which exceeds the minimum required supermajority under the ICANN Bylaws.
31. Over the last year, based on the evolving work of the GNSO, ICANN Staff have been developing the various processes that would be needed to implement the GNSO's recommendations, taking into account the GNSO's work and the lessons learned from two previous rounds of gTLD expansion, as well as the .ORG and .NET rebids. ICANN Staff had numerous discussions with the GNSO members developing the Report and provided the GNSO with two "Discussion Points" documents containing questions regarding how certain draft recommendations might be implemented (<http://gnso.icann.org/drafts/GNSO-PDP-Dec05-StaffMemo-14Nov06.pdf> and <http://gnso.icann.org/drafts/PDP-Dec05-StaffMemo-19-jun-07.pdf>). Upon approval of the Report by the ICANN Board, this work will be completed and a

“proposed implementation plan” will be posted for public comment before being finalized and initiated.

GNSO Participation

32. The GNSO Committee on New Top-Level Domains consisted of GNSO Council members <http://gns0.icann.org/council/members.shtml> or their designees. All meetings were open to a wide range of interested stakeholders and observers. A set of participation data is found in Part B.

Constituency Impact Statements

33. Key points from Constituency Impact Statements have been reflected in the sections above addressing “Impact.” The full texts are available in Part B of the Report. Part B also includes comments submitted by a Councilor appointed to the Council by the Nominating Committee.

For More Information

34. See <<http://www.icann.org/topics/gtld-strategy-area.html>> or contact <policy@icann.org>

Annex: Reserved Names Summary

The following information is provided to give a complete but concise summary of all reserved name requirements for new gTLDs. Please note that reserved name requirements include both those listed in the alphabetical list in the table and the requirements described in the Special Reserved Names Categories section.

Alphabetical List

ASCII			IDN		
Top Level	2 nd Level	3 rd Level	Top Level	2 nd Level	3 rd Level***
0	AFRINIC	AFRINIC	All Unicode versions of 'Example' and 'Test'	All Unicode versions of 'Example' ** and names that appear in the IDN Evaluation Facility.	All Unicode versions of 'Example' **
1	APNIC	APNIC			
2	ARIN	ARIN			
3	ASO	ASO			
4	ccNSO	ccNSO			
5	Example	Example			
6	GNSO	GNSO			
7	gtd-servers	gtd-servers			
8	IAB	IAB			
9	IANA	IANA			
a	iana-servers	iana-servers			
AFRINIC	ICANN	ICANN			
APNIC	IESG	IESG			
ARIN	IETF	IETF			
ASO	Internic	Internic			
b	IRTF	IRTF			
c	ISTF	ISTF			
ccNSO	LACNIC	LACNIC			
d	LATNIC	LATNIC			
e	NIC*	NIC*			
Example	rfc-editor	rfc-editor			
f	RIPE	RIPE			
g	root-servers	root-servers			
GNSO	Whois*	Whois*			
gtd-servers	www*	www*			
h					
i					
IAB					
IANA					
iana-servers					
ICANN					
IESG					
IETF					
Internic					
IRTF					
ISTF					
j					

ASCII			IDN		
Top Level	2 nd Level	3 rd Level	Top Level	2 nd Level	3 rd Level***
k					
l					
LACNIC					
LATNIC					
m					
n					
NIC					
o					
p					
q					
r					
rfc-editor					
RIPE					
root-servers					
s					
t					
test					
u					
v					
w					
Whois					
www					
x					
y					
z					

* For use by registry operators only.

** The RN-WG recommended that ICANN not try to translate 'example' into Unicode versions for various scripts or to reserve any ACE versions of such translations or transliterations if they exist, except on a case by case basis as proposed by given registries.

*** Applicable only in cases where a registry registers names at the third level.

Special Reserved Names Categories

In addition to the reserved names included in the table above, the following requirements also apply for all new gTLDs:

- Symbols may not be used in any ASCII name at any level except in cases where the hyphen (-) is allowed.
- Tagged names may not be used in any ASCII name at any level except when a registry has approval to offer IDN names and, in such cases, only the currently approved IDNA prefix may be used in tagged names (e.g., xn--).

- Two letter ASCII names at the top level are reserved for the use of ccTLD names only.

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Interview: Atallah on new gTLD objection losers

Kevin Murphy, August 16, 2013, 11 20:59 (UTC), Domain Policy

Filing a lawsuit against a competitor won't stop ICANN rejecting your new gTLD application.

That's according to Akram Atallah, president of ICANN's Generic Domains Division, who spoke to DI yesterday about possible outcomes from new gTLD objection rulings.

He also said that applicants that believe they've been wronged by the objection process may have ways to appeal the decisions and addressed what happens if objection panels make conflicting decisions.

Lawsuits won't stay ICANN's hand

In light of the lawsuit by Del Monte International GmbH against Del Monte Corp, as reported by Domain Name Wire yesterday, I asked Atallah if ICANN would put applications on hold pending the outcome of legal action.

The GmbH lost a Legal Rights Objection filed by the Corp, which is the older company and owner of the "Del Monte" trademark pretty much everywhere, meaning the GmbH's bid, under ICANN rules, must fail.

Atallah said lawsuits should not impact ICANN's processes.

"For us it's final," Atallah said. "If they have to go outside and take legal action then the outcome of the legal action will be enforceable by law and we will have to abide by it. But from our perspective the [objection panel's] decision is final."

There might be ways to appeal

In some cases when an applicant loses an objection — such as a String Confusion Objection filed by an existing TLD or an LRO filed by a trademark owner — the only step left is for it to withdraw its application and receive whatever refund remains.

There have been no such withdrawals so far.

I asked Atallah whether there were any ways to appeal a decision that would lead to rejection.

"The Applicant Guidebook is very clear," he said. "When an applicant loses an objection, basically their application will not proceed any further. We would like to see them withdraw their application and therefore finish the issue."

"Of course, as with anything ICANN, they have some other avenues for asking for reconsidering the decision," he added. "Basically, going to the Ombudsman, filing a Reconsideration Request, or even lobbying the board or something."

I wondered whether the Reconsideration process would apply to decisions made by third parties such as arbitration panels, and Atallah admitted that the Guidebook was "murky" on this point.

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[String confusion in disarray as Demand's .cam loses against Verisign's .com](#)

[ICANN passes 92 new gTLDs](#)

[Uniregistry wins .gift and AOL yanks .patch bid](#)

[Google beats Donuts in objection — .pet and .pets ARE confusingly similar](#)

[Interview: Atallah on new gTLD objection losers](#)

[Three gTLD contracts to be renewed next week](#)

[Artemis plans name collision conference next week](#)

[Chehade hopes for lower round two gTLD fees](#)

[Second private auction nets \\$1.2m per gTLD](#)

[Dotless domains are dead dotShabaka Diary — Day 4](#)

[NTAG rubbishes new gTLD collision risk report](#)

[Verisign confirms .gov downtime, blames algorithm](#)

[Reports: .gov fails due to DNSSEC error](#)

[dotShabaka Diary — Day 3](#)

“There are two mentions in the Guidebook of this, I think,” he said. “One mentions that it [the panel's decision] is final — the application stops — the other mentions that it is advice to staff.”

That seems to be a reference to the Guidebook at 3.4.6, which states:

The findings of the panel will be considered an expert determination and advice that ICANN will accept within the dispute resolution process.

This paragraph suggests that ICANN staff have to accept the objection panel's decision. That would make it an ICANN decision to reject the application, which can be challenged under Reconsideration.

Of course, the Reconsideration process has yet to see ICANN change its mind on any matter of substance. My feeling is that to prevail you'd at a minimum have to present the board with new information not available at the time the original decision was made.

What if different panelists reach opposite conclusions?

While the International Centre for Dispute Resolution has not yet published its panels' decisions in String Confusion Objection cases, a few have leaked out.

(UPDATE: This turns out not to be correct. The decisions have been published, but the only way to find them is via obscured links in a [PDF file](#) buried on the ICDR web site. Way to be transparent, ICDR.)

I've read four, enough to see that panelists are taking diverse and sometimes opposing views in their decision-making.

For instance, a panelist in .car v .cars ([pdf](#)) decided that it was inappropriate to consider trademark law in his decision, while the panelist in .tv v .tvs ([pdf](#)) apparently gave trademark law a lot of weight.

How the applicants intend to use their strings — for example, one may be a single-registrant space, the other open — seems to be factoring into panelists' thinking, which could lead to divergent opinions.

Even though Google's .car was ruled not confusingly similar to Donuts' .cars, it seems very possible that another panelist could reach the opposite conclusion — in one of Google's other two .cars objections — based on trademark law and proposed usage of the gTLD.

If that were to happen, would only one .cars application find itself in the .car contention set? Would the two contention sets be linked? Would all three .cars applications wind up competing with .car, even if two of them prevailed against Google at the ICDR?

It doesn't sound like ICANN has figured out a way to resolve this potential problem yet.

“I agree with you that it's an issue to actually allow two panels to review the same thing, but that's how the objection process was designed in the Guidebook and we'd just have to figure out a way to handle exceptions,” Atallah said.

“If we do get a case where we have a situation where a singular and a plural string — or any two strings actually — are found to be similar, the

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Rubens Kuhl:

The way AGB is written, .sports is not in contention with the other .sport, only with SportAccord's .sport. So we could ... [read more](#)

Constantine Roussos (.MUSIC):

Zack, Unfortunately the open portfolio applicants for open music-themed strings objected-to have been spreading their... [read more](#)

Dr Markus:

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Dr Markus:

It is interesting to note that famous four media ain't got no objection on .health anymore. Not the kind of applicant wo... [read more](#)

John Berryhill:

Why would a community TLD string, being managed by the community signified by the string, need any safeguards at all? ... [read more](#)

Zack:

I assume you submitted several baseless music objections? So...what community are you representing? Musicians? Music... [read more](#)

Constantine Roussos (.MUSIC):

best outcome might be to go back to the GNSO or to the community and get their read on that," he said. "That might be what the board might request us to do."

"There are lots of different ways to figure out a solution to the problem, it just depends on how big the problem will be and if it points to an unclear policy or an unclear implementation," he said.

But Atallah was clear that if one singular string is ruled confusing to the plural version of the same string, that panel's decision would not cause all plurals and singulars to go into contention.

"If a panel decides there is similarity between two strings and another panel said there is not, it will be for that string in particular, it would not be in general, it would not affect anything else," he said.

ICANN, despite Governmental Advisory Committee advice to the contrary, decided in late June that singular and plural gTLDs [can coexist](#) under the new regime.

Related posts (automatically generated):

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COMMENTS (3)

Andrew Allemann

August 16, 2013 at 3:06 pm

So prescient in light of your next story about .pet and .pets

[Reply](#)

Kevin Murphy
 August 16, 2013 at 3:23 pm
 I prefer "preincient".
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Andrew Allemann
 August 16, 2013 at 3:31 pm
 nice 😊
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Under that note Paul, the Community Objections against Donuts in .BAND and .MUSIC should be upheld since both your open ... [read more](#)

Constantine Roussos (.MUSIC):

The biggest issue now affecting Community Objections is the one surrounding GAC Advice on Safeguards and Objections conc... [read more](#)

Tyler Durden:

The expert testimony from Dr. Wright & Dr. Golovina in the AC Webconnecting case was quite thorough and persuasive. ... [read more](#)

Paul Stahura:

With regard to the objections, the Applicant Guidebook must be followed explicitly. If the panelist made independent de... [read more](#)

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Thomas O'Toole

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BLOG

Tuesday, July 23, 2013

ICANN Legal Rights Objections: What's Past Is Prologue

by Thomas O'Toole

As of today, panelists at the World Intellectual Property Organization's Arbitration and Mediation Center have decided 12 trademark-based legal rights objections to a proposed top-level domain under the Internet Corporation for Assigned Names and Numbers' new gTLD initiative. They rejected every one, almost categorically so.

With 53 legal rights objections remaining to be decided, the only surprise the future might hold is the faint prospect that a WIPO panelist might actually rule in favor of a trademark owner.

Legal Rights Objection Rulings to Date OK

gTLD String	Party Rights
.express	Objector owned word mark EXPRESS; respondent lacked TM rights
.home	Objector owned design marks for .home and true.home; respondent lacked TM rights
.home	Objector owned design marks for .home and true.home; respondent lacked TM rights
.home	Objector owned design marks for .home and true.home; respondent lacked TM rights
.home	Objector owned design marks for .home and true.home; respondent lacked TM rights
.limited	Objector owned word mark for THE LIMITED; respondent lacked TM rights
.mail	Objector owned word mark for U.S. MAIL and other marks containing MAIL; respondent lacked TM rights
.mls	Objector owned word mark for MLS; respondent lacked TM rights
.pin	Objector owned design mark for P, word mark for PINTEREST, figurative mark for PIN IT; respondent lacked TM rights
.rightathome	Objector owned word mark for RIGHT@HOME; respondent owned word mark for RIGHT AT HOME
.tunes	Objector owned design mark for .tunes; respondent lacked TM rights
.vip	Objector possessed rights in word mark for VIP; respondent owned word mark for DOTVIP

The biggest lesson so far has been that the Legal Rights Objection process is wholly ineffective for trademark owners seeking to knock down proposed domains containing generic strings. In many cases, companies owning marks for terms such as EXPRESS, HOME, VIP, LIMITED, MAIL, TUNES have lost LROs to domain applicants with no intellectual property rights in those terms whatsoever. Pinterest's failed challenge to Amazon's proposed .pin domain was particularly ominous for mark owners, because Amazon seems pretty clearly to be moving in on Pinterest's business. Proposed domains for dozens of

generic terms (e.g., .academy, .blue, .cam, .coach, .direct, .food, .music, .now, .song) and many others all appear highly likely to emerge unscathed from the legal rights objections process. Law is a "never say never" profession but, seriously, the adverse results in the .express and .mail proceedings ought to be writing on the wall for the remaining trademark-based challengers to generic string domains.

The reason for this dour outlook can be found in passages from two early LRO rulings: the first one, *Right at Home v. Johnson Shareholdings Inc.*, No. LRO2013-0300 (WIPO, July 3, 2013); and the second, my favorite, *Express LLC v. Sea Sunset LLC*, No. LRO2013-0022 (WIPO, July 9, 2013).

In *Right at Home*, panelist Robert A. Badgley offered the first interpretation of key terms in Section 3.5 of ICANN's [New gTLD Applicant Guidebook](#). The guidebook uses highly qualified language, directing LRO panelists to decide whether the proposed new domain "takes unfair advantage" of the trademark owner's rights, or "unjustifiably impairs" the value of the mark, or creates an "impermissible likelihood of confusion" between the mark and the proposed domain.

In Badgley's view, this language creates a very high burden for trademark-based objections:

*The use of the terms "unfair," "unjustifiably," and "impermissible" as modifiers, respectively, of "advantage," "impairs," and "likelihood of confusion" in Section 3.5.2 suggests that there must be something more than mere advantage gained, or mere impairment, or mere likelihood of confusion for an Objection to succeed under the Procedure. It seems, rather, that **there must be something untoward – even if not to the level of bad faith – in the conduct or motives of Respondent, or something intolerable in the state of affairs** which would obtain if the Respondent were permitted to keep the String in dispute. (emphasis added)*

Obviously, it is going to be very difficult for any trademark owner to demonstrate that a proposed domain is so fishy it satisfies the "something untoward ... if not to the level of bad faith" standard.

So far, no panel has challenged Badgley's interpretation of Section 3.5.2. In fact, his *Right at Home* decision has been cited with approval in three subsequent LRO decisions: *Canadian Real Estate Association v. Afilias Limited*, *Pinterest, Inc. v. Amazon EU S.à.r.l.*, and *Defender Security Company v. Lifestyle Domain Holdings, Inc.*

The second opinion, *Express LLC v. Sea Sunset LLC*, was one of the better opinions (and I am including the federal court stuff that we wade through every day) I have read in a while. Panelist Frederick M. Abbott carefully summarized the arguments on each side (there are good lessons here for attorneys working on the next round of legal rights objections), and the law that he was required to apply to the dispute. When Abbott turned to the reasoning behind his decision to reject Express LLC's objection to the proposed .express top-level domain, I got that sense that this panelist was a teeny bit irked that ICANN itself had not made the hard policy choices that the LRO had just dropped in his lap. It's one thing to ask a panelist to transfer a domain name that might have cost the registrant \$10 or so; and it's quite another to ask a panelist to upset an investment of at least a half-million dollars in a new top-level domain. All based on a trademark registration for a generic term, in a single market, issued by a single government entity. Abbott declined to do it.

In *Express LLC v. Sea Sunset LLC*, panelist Frederick M. Abbott wrote:

*The relative interests of trademark owners and prospective users of common terms may be sufficiently nuanced or context-sensitive that automatic or general rules would constantly be in search of exceptions, or that such rules would lead to unintended consequences. Whatever might have motivated ICANN's approach, it puts this Panel where it is now – with this Panel charged with deciding whether a trademark owner of a common dictionary or generic term used in an arbitrary way should be permitted to prevent an applicant for a new gTLD to secure that common term. The Panel ultimately decides that the trademark owner (Complainant) should not be able to prevent adoption by the applicant (Respondent) of the applied-for gTLD <.express> in the particular context presented here. While Complainant certainly owns rights in the EXPRESS trademark for use in connection with apparel and fashion accessories, and while that trademark is reasonably well known among a relevant segment of consumers in the United States, **there are so many common usages of the term "express" that it is not reasonable to foreclose its use by Respondent as a gTLD.** (emphasis added)*

These two opinions, taken together, look like a terminal diagnoses for trademark owners with rights in generic terms. *Right at Home* creates a very permissive standard for what constitutes "unfair advantage" by a domain applicant. *Express LLC* states, almost categorically, that it is "not reasonable" to allow a trademark owner for a generic term to prevent that term from being used as a top-level domain.

Looking to the future, it will be interesting to see how these trademark owners will fare in the other rights-protection remedies offered by ICANN.

Using EXPRESS as an example, will the owner of this mark have a good claim under the Uniform Domain Name Dispute Resolution Policy to recuperate domains that encroach on the mindshare embodied in its mark? Today, nearly all UDRP cases involve an examination of that part of the domain residing to the left of the dot. Trademark owners such as Express LLC will have to convince UDRP panelists to look at their case a little differently -- to pay more attention than usual to the string to the left of the dot. For example, would Express Ltd. have a viable UDRP claim against the registrant of <clothing.express> or <fashion.express> or <shoes.express>? It is easy to imagine many other similar sorts of claims.

The Uniform Rapid Suspension System seems unlikely to provide relief here, as does the Trademark Clearinghouse. The URS is not for novel cases, which these would be. And Express LLC doesn't have trademark rights in CLOTHING.

In the end, the most effective course for owners of generic marks could be to play the game the way ICANN wants it to be played: apply to operate a new top-level domain if you feel you must, or register as many of your marks as possible in all relevant top-level domains.

By Thomas O'Toole

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Direct-broadcast satellite

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For the Japanese communication satellites, see [Broadcasting Satellite \(Japanese\)](#).

Direct-broadcast satellite (DBS) is a term used to refer to **satellite television** broadcasts intended for home reception.

A designation broader than DBS would be **direct-to-home** signals, or DTH. This has initially distinguished the transmissions directly intended for home viewers from cable television distribution services that sometimes carried on the same satellite. The term DTH predates DBS and is often used in reference to services carried by lower power satellites which required larger [dishes](#) (1.7m diameter or greater) for reception.

In [Europe](#), prior to the launch of [Astra 1A](#) in 1988, the term DBS was commonly used to describe the nationally commissioned satellites planned and launched to provide TV broadcasts to the home within several European countries (e.g. [BSB](#) in the [UK](#), [TV-Sat](#) in [Germany](#)). These services were to use the [D-Mac](#) and [D2-Mac](#) format and BSS frequencies with circular [polarization](#) from orbital positions allocated to each country. Before these DBS satellites, home satellite television in Europe was limited to a few channels, really intended for cable distribution, and requiring dishes typically of 1.2m. [SES](#) launched the [Astra 1A](#) satellite to provide services to homes across Europe receivable on dishes of just 60 cm-80 cm and, although these mostly used PAL video format and FSS frequencies with linear polarization, the DBS name slowly came to applied to all Astra satellites and services too.



A DTH dish antenna mounted on wall 

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Terminology confusion [edit source | edit beta]

As a technical matter, DBS (also known by the International Telecommunication Union as Broadcasting Satellite Service, or BSS) refers only to services transmitted by satellite in specific frequency bands: 11.7-12.2 GHz in ITU Region 3 (Asia, Australia), 10.7 - 12.75 GHz in ITU Region 1 (Europe, Russia, Africa), and 12.2-12.7 GHz ITU Region 2 (North and South America). In 1977, the ITU adopted an international BSS Plan under which each country was allocated specific frequencies

at specific orbital locations for domestic service. Over the years, this plan has been modified to, for example, accommodate new countries, increase coverage areas, and reflect digital (rather than analog) technology. At present, numerous countries have brought into use their BSS Plan allocations.

By contrast, DTH can apply to similar services transmitted over a wider range of frequencies (including standard *K_u* band and *K_a* band) transmitted from satellites that are not part of any internationally planned band. Nonetheless, the term DBS is often used interchangeably with DTH to cover both analog and digital video and audio services (including **video-on-demand** and **interactive** features) received by relatively small dishes (less than 1 meter). A "DBS service" usually refers to either a commercial service, or a group of free channels available from one orbital position targeting one country. In certain regions of the world, especially in North America, DBS is used to refer to providers of subscription satellite packages, and has become applied to the entire equipment chain involved.

Commercial DBS services [[edit source](#) | [edit beta](#)]

The second commercial DBS service, **Sky Television plc** (now **BSkyB** after its merger with **British Satellite Broadcasting's** five-channel network), was launched in 1989. Sky TV started as a four-channel free-to-air analogue service on the **Astra 1A satellite**, serving both **Ireland** and the **United Kingdom**. By 1991, Sky had changed to a **conditional access** pay model, and launched a digital service, **Sky Digital**, in 1998, with analogue transmission ceasing in 2001. Since the DBS nomenclature is rarely used in the UK or Ireland, the popularity of Sky's service has caused the terms "**minidish**" and "**digibox**" to be applied to products other than Sky's hardware. **News Corporation** has a 32% stake in BSkyB.

PrimeStar began transmitting an analog service to North America in 1991, and was joined by **DirecTV** (then owned by a division of General Motors, **GM Hughes Electronics**), in 1994. At the time, DirecTV's introduction was the most successful **consumer electronics** debut in **American** history. Although PrimeStar transitioned to a digital system in 1994, it was ultimately unable to compete with **DirecTV**, which required a smaller satellite dish and could deliver more programming. **DirecTV** purchased **PrimeStar** in 1999 and moved all **PrimeStar** subscribers to DirecTV equipment. In a series of transactions consummated in 2003, **Hughes Electronics** was spun out of GM and the **News Corporation** purchased a controlling interest in the new company, which was renamed The **DIRECTV** Group. In 2008, **Liberty Media Corporation** purchased News Corporation's controlling interest in **DIRECTV**.

In 1996, **EchoStar's Dish Network** went online in the United States and, as DirecTV's primary competitor, achieved similar success. **AlphaStar** also started but soon went under. **Astro** was also started, using a direct broadcast satellite system.

Dominion Video Satellite Inc.'s **Sky Angel** launch on a satellite platform in the United States in 1996 with its DBS service geared toward the faith and family market. It grew from six to 36 TV and radio channels of family entertainment, Christian-inspirational programming, and 24-hour news. Dominion, under its former corporate name Video Satellite Systems Inc., was actually the second from among the first nine companies to apply to the FCC for a high-power DBS license in 1981, and it was the sole surviving DBS company from the first round of applicants until the sale of their license to **EchoStar Communications Corporation** in 2007 and departure from satellite distribution in 2008. Sky



Astro satellite dishes



Angel, although a separate and independent DBS service, used the same satellites, transmission facilities, & receiving equipment used for Dish Network through an agreement with Echostar. Because of this, Sky Angel [subscribers](#) also had the option of subscribing to Dish Network's channels as well.

In 2003, EchoStar attempted to purchase DirecTV, but the FCC and U.S. Department of Justice denied the purchase based on anti-competitive concerns.

As of 2010, India has the most competitive Direct-broadcast satellite market with 7 operators vying for more than 110 million TV homes. India is set to overtake the US as the world's largest Direct-broadcast satellite market by 2012. "[Thinking blue sky](#)" , *Business Today*, July 21, 2010.

Free DBS services [edit source | edit beta]

[Germany](#) is likely the leader in [free-to-air](#) (FTA) DBS, with approximately 200 digital FTA channels (including 18 [HDTV](#) channels and various regional channels) broadcast from the [Astra 19.2°E](#) satellite constellation. These are not marketed as a DBS service, but are received in approximately 12 million homes, as well as in any home using the [Sky Deutschland](#) commercial DBS system. All German analogue satellite broadcasts ceased on 30 April 2012.^{[1][2]}

The [United Kingdom](#) has approximately 160 digital channels (including the regional variations of [BBC](#) channels, [ITV](#) channels, [Channel 4](#) and [Channel 5](#)) are broadcast without encryption from the [Astra 28.2°E](#) satellite constellation, and receivable on any [DVB-S](#)-compliant receiver (a [DVB-S2](#) receiver is required for certain [HDTV](#) services). Most of these channels are included within the [Sky EPG](#), and an increasing number within the [Freesat](#) EPG.

India's national broadcaster, [Doordarshan](#), promotes a free-to-air DBS package as "[DD Direct Plus](#)", which is provided as in-fill for the country's terrestrial transmission network. It is broadcast from Insat 4B at 93.5°E and contains about 57 FTA channels.

While originally launched as [backhaul](#) for their [digital terrestrial television](#) service, a large number of French channels are free-to-air on satellites at 5°W, and have recently been announced as being official in-fill for the DTT network.

In [North America](#) (US, Canada and Mexico) there are over 80 FTA digital channels available on [Galaxy 19](#) (with the majority being ethnic or religious in nature). Other FTA satellites include [AMC-4](#), [AMC-6](#), [Galaxy 18](#), and [Satmex 5](#). A company called [GloryStar](#) promotes FTA religious broadcasters on [Galaxy 19](#).

See also [edit source | edit beta]

- [Freesat](#)
- [Television receive-only \(TVRO\)](#) - early satellite equipment for broadcasts *not* intended for home reception

References [edit source | edit beta]

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- ↑ "HDTV: Neue HD-Kanäle von ARD und ZDF ab 30. April 2012" [HDTV: New HD channels from ARD and ZDF after 30 April 2012] . *T-online.de* (in German). 20 January 2012. Retrieved 8 April 2012.

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- [General frequency allocation information, mainly for U.S.](#)

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<input type="checkbox"/>	dishdirectamerica.biz	SAVE! \$5 99*/yr
<input type="checkbox"/>	dishdirectamerica.me	SAVE! \$9 99/yr
<input type="checkbox"/>	dishdirectamerica.mobi	SAVE! \$9 99*/yr
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<input type="checkbox"/>	OnlineDish.com	\$3,299.00*
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 Whois Server: whois.register4less.com
 Creation Date: 14-OCT-2004
 Updated Date: 18-OCT-2012
 Expiration Date: 14-OCT-2013

Nameserver: NS1.R4L.COM
 Nameserver: NS2.R4L.COM

Registry Status: clientTransferProhibited

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Language:

Country:

Currency:

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- [My Renewals](#)
- [Order History](#)
- [Create Account](#)

Shopping

- [Domain Search](#)
- [Web Hosting](#)
- [Product Catalog](#)
- [Go Daddy Gear](#)
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Ask how you can save a bundle when you add high-speed Internet and phone service.

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Look no further than **Dish Direct Satellite** in Pasco, Washington, when you are searching for the best deals in town on satellite television or TV and Internet bundles. We are your one-stop shop for TV, phone, and Internet installations supported by more than 10 years of experience.



Our [team](#) focuses on building personal relationships with every customer and providing first class service. Ask us about new [bundle promotions!](#)

Our Services & Products Include:

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Dish Direct Satellite

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Pasco, WA 99301-5561

Phone: (509) 586-3474

info@satellitetricities.com



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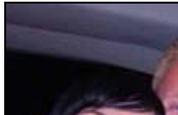


Dish Direct Satellite

38 likes · 1 was here

Like Liked Message and other interaction buttons.

Mobile Phone Shop · Business Services · Add A Category
824 W Lewis Street #202, Pasco, Washington 99301
(509) 591-0534
Always open



Likes section showing 38 likes.



Dropdown menu with '1'.

About - Suggest an Edit

Photos

Business

Likes

Map

Highlights

Post creation form with 'Write something...' text input.

Post from Dish Direct Satellite dated August 15. Text: 'While our customer teams will gladly help you with any questions you have regarding the operation of your television or telephone system, we recommend reading the owner's manual to understand how the system works and tips on basic troubleshooting.' Includes Like, Comment, and Share buttons.

Post from Dish Direct Satellite dated August 13. Text: 'One benefit of satellite Internet is that your computer is always connected, so, instead of having to dial in every time you want to surf the Web, all you have to do is launch your Internet browser.' Includes Like, Comment, and Share buttons.

Post from Dish Direct Satellite dated August 8.

Invite Your Friends to Like this Page section. Includes a search bar and 'Invite' buttons for Rat Blundell, Anthony Mark, and Gordon Adams.

Recent Posts by Others on Dish Direct Satellite section.

Recommendations section with a star rating and a text input field asking 'What do you think about this place?'. Includes Public dropdown and Recommend button.

Likes section showing 'DISH' and '1 friend also likes this.' with a LikeUndo button.

Did you know that a complete satellite network can work independently of terrestrial infrastructure and can maintain connectivity as long as the equipment has power? That makes satellite technology much more reliable.

Like · · Share

 **Dish Direct Satellite**
August 1

If you live in a rural area where you can't get cable or DSL, satellite television and phone service is the perfect answer. It frees up your phone lines so there are no missed calls and no dialing in, and you can use it on both Windows and MacIntosh operating systems.

Like · · Share

 **Dish Direct Satellite**
August 6

If you're looking for a variety of different sports programming, then satellite TV is the way to go. You can see a wider variety of sports as well as popular sports from other countries of the world with satellite TV.

Like · · Share

 **Dish Direct Satellite**
July 30

Our Internet telephone services are nominally priced, and are far less expensive than service provided by your local telephone companies. Additionally, there are flat-rate plans available, allowing you to make both local and long-distance calls.

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dish
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For Quick Service Give Operator Code Number A-12749001

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- Offers
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- Receivers
- Channels
- Sign Me Up!

WANT CHOICES? YOU GET CHOICES!

Now that you've seen all the great features of Dish Network satellite TV, all you have to do is call and we can set it up for you.

A-12749001

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Get it with our Domain Buy service.

[GO!](#)

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Registrant:
DishDirect, Inc.
DishDirect, Inc. DishDirect, Inc.
2515 Tarpley Rd 104
Carrollton, TX 75006
US
Phone: +1.2143908800
Email: dratcliff@dishdirect.com
Registrar Name....: Register.com
Registrar Whois....: whois.register.com
Registrar Homepage: www.register.com

Domain Name: dishdirect.com
Created on.....: 1998-12-04
Expires on.....: 2017-12-03

Administrative Contact:
DishDirect, Inc.
Dan Ratcliff
2515 Tarpley Rd #104
Carrollton, TX 75006
US
Phone: +1.2143908800
Email: dratcliff@dishdirect.com

Technical Contact:
Register.Com
Domain Registrar
575 8th Avenue
New York, NY 10018
US
Phone: 212-798-9200
Email: domain-registrar@register.com

DNS Servers:
ns1.inwebtime.net
ns2.inwebtime.net

Registrant:
DishDirect, Inc.
DishDirect, Inc. DishDirect, Inc.
2515 Tarpley Rd 104

Domain already taken?

.com [Search](#)



NameMatch Recommendations

GoDaddy.com NameMatch has found similar domain names related to your search. Registering multiple domain names may help protect your online brand and enable you to capture more Web traffic, which you can then direct to your primary domain.

Domains available for new registration:

<input checked="" type="checkbox"/> Alternate TLDs		
<input type="checkbox"/>	dishdirect.co	SAVE! \$12.99/yr
<input type="checkbox"/>	dishdirect.info	SAVE! \$2 99*/yr
<input type="checkbox"/>	dishdirect.us	SAVE! \$3 99/yr
<input type="checkbox"/>	dishdirect.ca	\$12.99/yr
<input type="checkbox"/>	dishdirect.me	SAVE! \$9 99/yr
<input type="checkbox"/>	dishdirect.mobi	SAVE! \$9 99*/yr
<input type="checkbox"/>	dishdirect.tv	\$39.99/yr
<input type="checkbox"/>	dishdirect.ws	\$15.99/yr
<input checked="" type="checkbox"/> Similar Premium Domains ?		
<input type="checkbox"/>	OnlineDish.com	\$3,299.00*
<input type="checkbox"/>	DishAiming.com	\$1,199.00*
<input type="checkbox"/>	DishWand.com	\$588.00*
<input type="checkbox"/>	DirectDish.net	\$2,588.00*
<input type="checkbox"/>	DishDay.com	\$2,332.00*
<input type="checkbox"/>	DishSet.com	\$4,330.00*

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Domains available at Go Daddy Auctions@:

<input type="checkbox"/>	directres.com Ends on: 11/11/2013 12:00:00 AM PDT	\$10,000.00*
<input type="checkbox"/>	directaccountant.com Ends on: 10/25/2013 12 00 00 AM PDT	\$10,000.00*
<input type="checkbox"/>	directaccountant.net Ends on: 10/25/2013 12 00 00 AM PDT	\$1,000.00*
<input type="checkbox"/>	windish.com Ends on: 9/25/2013 4:29:00 PM PDT	\$3,888.00*
<input type="checkbox"/>	mairdish.net Ends on: 9/23/2013 8:06:00 PM PDT	\$888.00*
<input type="checkbox"/>	cgdirect.com Ends on: 9/22/2013 7:58:00 PM PDT	\$3,788.00*

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US
Phone: +1.2143908800
Email: dratcliff@dishdirect.com
Registrar Name.....: Register.com
Registrar Whois....: whois.register.com
Registrar Homepage: www.register.com

Domain Name: dishdirect.com
Created on.....: 1998-12-04
Expires on.....: 2017-12-03

Administrative Contact:
DishDirect, Inc.
Dan Ratcliff
2515 Tarpley Rd #104
Carrollton, TX 75006
US
Phone: +1.2143908800
Email: dratcliff@dishdirect.com

Technical Contact:
Register.Com
Domain Registrar
575 8th Avenue
New York, NY 10018
US
Phone: 212-798-9200
Email: domain-registrar@register.com

DNS Servers:
ns1.inwebtime.net
ns2.inwebtime.net
Visit AboutUs.org for more information about dishdirect.com

[AboutUs: dishdirect.com](#)

Registrar: REGISTER.COM, INC.
Whois Server: whois.register.com
Creation Date: 04-DEC-1998
Updated Date: 13-JUL-2012
Expiration Date: 03-DEC-2017

Nameserver: NS1.INWEBTIME.NET
Nameserver: NS2.INWEBTIME.NET

Registry Status: clientTransferProhibited

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- Features
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- Channels
- Sign Me Up!

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12
MILLION
CUSTOMERS
& COUNTING



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Finally delivering on the promise of HD.

High Definition Television, or HDTV, gives you crystal-clear picture integrated with Dolby Digital 5.1 channel surround sound, the latest in surround sound technology. This gives you the entertainment experience



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ADVERTISING
TM



\$349*

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(original purchase)



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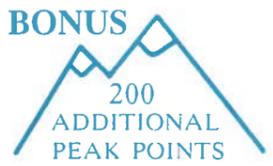
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- Direct channel access
- Audio mute
- Programmable video and audio frequency
- Programmable video noise reduction



* VideoCipher®II Module +\$150(at time of original purchase)

A great deal to see the shows you love

azcentral.com

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Paid for by:
Dish Direct

00:20 02:38

PAUSE email share get link get code MENU

Like 0 Tweet 0 +1

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- Raw video: Haboob hits downtown Yuma**
A large haboob storm hit downtown Yuma Thursday afternoon. This video was
- GOP congressmen hold hearing on abuse**
Target EPA regulations, iRS scandal
- Ahwatukee's Nick Selby Delivered Viral Georgia Tech Welcome Speech**
How Nick Selby Went from Kindergarten in Phoenix to a
- Circumcision Decision: hospital circumcisions down 10% over 30 years**
A Valley Pediatrician and mom weigh in on their opinions

Done



September 6, 2013

VIA E-MAIL (reconsider@icann.org)

ICANN BOARD GOVERNANCE COMMITTEE

Re: Comment by The DIRECTV Group Inc. Re Dish DBS Corp.'s
August 23, 2013 Request for Reconsideration

Dear Members of the Board Governance Committee:

On August 23, 2013, Dish DBS Corporation filed with ICANN a Request for Reconsideration (“RFR”) concerning the WIPO panel’s unanimous decision denying Dish’s application for the .DIRECT gTLD. LRO2013-0005 (July 29, 2013). DIRECTV did not learn of Dish’s filing until August 27, when Dish’s counsel sent DIRECTV’s counsel an email with a “courtesy copy” of the filing. Attachment 1. DIRECTV respectfully requests ICANN to deny Dish’s RFR.

As an initial matter, it is inappropriate for Dish to attempt to challenge and re-litigate a Legal Rights Objection (“LRO”) decision via a RFR. Article 1(d) of ICANN’s New gTLD Dispute Resolution Procedure states, “[b]y applying for a new gTLD, an applicant accepts the applicability of this Procedure and the applicable DRSP’s Rules that are identified in Article 4(b)...The parties cannot derogate from this Procedure without the express approval of ICANN and from the applicable DRSP Rules without the express approval of the relevant DRSP.”

TECH/1423438.1

Furthermore, in its LRO response Dish expressly agreed to be bound by the New gTLD Dispute Resolution Procedure and WIPO Rules for New gTLD Dispute Resolution. Dish's Response, page 11 (attached hereto as Attachment 2). Those procedures and rules do not provide for an administrative appeal of a LRO decision, nor do they contemplate or permit a losing party to file a RFR seeking to overturn an expert panel's reasoned decision.

To the contrary, Module 3.4.6 of the Applicant Guidebook states that, "[t]he findings of the panel will be considered an expert determination and advice that ICANN will accept within the dispute resolution process." There is no reference to an appeal of WIPO's decision in the Guidebook. Similarly, Article 21(d) of ICANN's New gTLD Dispute Resolution Procedure states "[t]he Expert Determination shall be in writing, shall identify the prevailing party and shall state the reasons upon which it is based. The remedies available to an Applicant or an Objector pursuant to any proceeding before a Panel *shall be limited to the success or dismissal of an Objection* and to the refund by the DRSP to the prevailing party, as determined by the Panel in its Expert Determination." (emphasis added) Again, there is no provision to appeal a decision.

In an attempt to provide a valid basis for its RFR, Dish argues that ICANN failed to provide "clear and well-defined standards" for LRO panelists. This is simply untrue, and is refuted by Dish's own LRO response, where Dish takes the better part of two pages listing the legal grounds and factors that LRO panels should consider in such cases. Dish's LRO response, pp. 3-4 ("In its guidance, ICANN has proposed that the panel consider certain non-exclusive

factors in assessing whether an Objector's claim of trademark rights should be upheld.""). As the parties and ICANN know, the LRO factors were drafted over several years and are based on multiple revisions to the Applicant Guidebook after considering input during numerous public comment periods. There are, therefore, no grounds on which Dish can validly argue that ICANN did not provide sufficient standards for LRO panelists; nor can Dish request ICANN to unilaterally revise the existing LRO rules and procedures.

ICANN also should deny Dish's RFR as being an improper and veiled attempt to re-litigate the underlying dispute. As a general legal principle, it is inappropriate to support a RFR with new evidence and arguments that were not raised or considered in the underlying dispute. In the present case, Dish supports its RFR with, among other things, Web site screen shots, domain name Whois records, and alleged advertisements for Dish services. Dish did not submit these documents or arguments during the LRO, and it is clear that Dish's true motive for filing the RFR is to have another bite at the apple by making new arguments on what essentially is an improper appeal of the LRO panel's decision.

Notably, ICANN's Board Governance Committee ("BGC") recognized just last month that a RFR is not a proper venue to re-litigate an expert panel determination in the new gTLD Program. There, Booking.com B.V. filed a RFR regarding ICANN's implementation of the expert panel decision placing .hotels and .hoteis into a string similarity contention set. The BGC recommended denying the RFR, stating that "[i]n the context of the New gTLD Program, the

Reconsideration process is not however intended for the Board to perform a substantive review of Panel decisions...Reconsideration is not available as a mechanism to re-try the decisions of the evaluation panels.” See Recommendation of the BGC on Reconsideration Request 13-5 (Aug. 1, 2013, publ. Aug. 21, 2013). This is just what Dish is trying to do in the present matter by submitting new evidence to try to re-try WIPO’s decision. However, the RFR is “not [to be] used as a mechanism simply to challenge an action with which someone disagrees...it is limited to situations where the staff acted in contravention of established policies.” Here the Applicant Guidebook clearly states that “[t]he findings of the panel will be considered an expert determination and advice that ICANN will accept within the dispute resolution process.” Applicant Guidebook Module 3.4.6. ICANN’s staff therefore acted in accordance with established policies by accepting WIPO’s well-reasoned decision. Thus, Dish’s RFR should be denied.

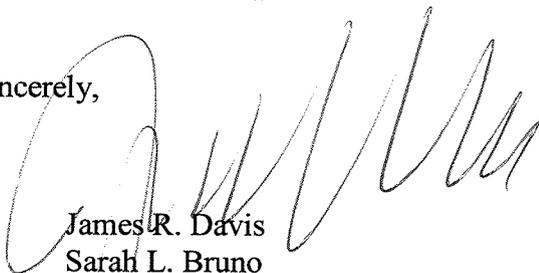
Dish also falsely alleges that the panelists were influenced by media accounts. Dish’s RFR, p. 4. The television advertisements referenced by the panel were related to the evidence (including Dish’s online advertising) and arguments submitted by DIRECTV in its LRO complaint, and merely demonstrate that DIRECTV and Dish are competitors. See DIRECTV’s LRO complaint, Para. 12(1) (“Dish and DIRECTV are direct competitors. Dish acknowledges this in promotional and marketing materials, including at its Web site where it dedicates numerous pages and charts to comparisons between Dish and DIRECTV. Annex J”) (attached hereto as Attachment 3). Dish does not – and cannot - dispute that the two companies are

TECH/1423438.1

competitors, and that was never an area of contention in the LRO. It therefore is misleading and specious for Dish to allege the panel was “improperly influenced by media accounts” or that the advertisements cited by the panel were somehow improperly considered or even relevant to an issue in dispute between the parties.

For the foregoing reasons DIRECTV requests ICANN to deny Dish’s RFR and accept the panel’s well-reasoned and unanimous decision denying Dish’s application for the .DIRECT gTLD. Should the BGC require any additional information or submissions from DIRECTV regarding this matter, please contact the attorneys listed below.

Sincerely,



James R. Davis
Sarah L. Bruno
Amy E. Salomon
Arent Fox LLP
1717 K Street, NW
Washington, DC 20036-5342
(202) 857-6000
Attorneys for DIRECTV

cc: The DIRECTV Group Inc.

Enclosures

ATTACHMENT 1

Davis, Jim

From: Adams, Christopher
Sent: Tuesday, August 27, 2013 11:00 AM
To: Davis, Jim
Cc: Lodge, Deborah; Oparil, Richard
Subject: .direct TLD application - Request for Reconsideration
Attachments: .direct (Application ID - 1-2007- 43424) Request for Reconsideration.pdf; Attachment 1.pdf; Attachment 2.pdf; Attachment 3.pdf; Attachment 4.pdf; Attachment 5.pdf; Attachment 6.pdf; Attachment 7.pdf; Attachment 8.pdf; Attachment 9.pdf; Attachment 10.pdf; Attachment 11.pdf

Dear Jim,

Annexed for your information is a courtesy copy of a Request for Reconsideration for the .direct TLD filed with ICANN on August 23, 2013.

Sincerely,

Chris

Christopher W. Adams | Associate
Patton Boggs LLP
2550 M Street, NW | Washington, DC 20037

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ATTACHMENT 2

Before the:

**WORLD INTELLECTUAL PROPERTY ORGANIZATION
ARBITRATION AND MEDIATION CENTER**

The DIRECTV Group, Inc.
(Objector)

-v-

DISH DBS CORPORATION

(Applicant/Respondent)

TLD string objected to: <.DIRECT>
Application ID: 1-2007-43424

RESPONSE TO LEGAL RIGHTS OBJECTION
(Applicant Guidebook, Module 3; Procedure, art. 6, 11;
WIPO Rules for New gTLD Dispute Resolution, para. 4)

I. Introduction

Applicant DISH DBS Corporation (“DISH”) hereby submits this Response to a Legal Rights Objection filed by The DirecTV Group. The objection was submitted to the World Intellectual Property Organization Arbitration and Mediation Center (“WIPO Center”) for determination in accordance with the New gTLD Dispute Resolution Procedure (“Procedure”), provided as an Attachment to Module 3 of the gTLD Applicant Guidebook (“Applicant Guidebook”) approved by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on June 20, 2011 and as updated on June 4, 2012, and the World Intellectual Property Organization Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections (“WIPO Rules for New gTLD Dispute Resolution”) in effect on the day when the relevant Application for a new gTLD was submitted.

As set forth in greater detail below, DISH’s application is valid and should be confirmed because: (1) it does not take any advantage, unfair or otherwise, of Objector’s marks as the term “direct” is generic; (2) does not impair Objector’s marks as Objector’s marks do not singularly or solely contain “direct” – some suffix has been repeatedly required by the US Trademark Office and other governmental bodies; and (3) DISH’s

application does not create a likelihood of confusion – as established by survey evidence establishing no association of “direct” with Objector’s marks.

II. Applicant/Respondent Contact Details

The Applicant/Respondent in this proceeding is Dish DBS Corporation, a Colorado corporation with a principle place of business at 9601 S. Meridian Boulevard, Englewood Colorado 80112.

The Applicant’s/Respondent’s contact details are:

Contact Information Redacted

The Applicant/Respondent’s authorized representative in this proceeding is:

Name: *Deborah M. Lodge*

Address: *Patton Boggs LLP*

2550 M Street, N.W.

Washington, D.C. 20037

Contact Information Redacted

The Applicant/Respondent’s preferred contact details for purposes of this proceeding are:

For electronic-only material

Contact Information Redacted

For any hardcopy material

Method: *post/courier*

Address: *Patton Boggs LLP*

2550 M Street, N.W.

Washington, D.C. 20037 U.S.A.

III. TLD string objected to (applied-for TLD string)

(Procedure, art. 7, 11)

This Response concerns the applied-for TLD string: <DIRECT>

IV. Jurisdictional Basis for the Response

(Procedure, art. 1(d), 4(b)(ii))

By applying for a new gTLD, and by filing the present Response to a Legal Rights Objection, the Applicant/Respondent DISH has accepted the applicability of the Procedure and the WIPO Rules for New gTLD Dispute Resolution.

Having filed its Objection, the Objector has accepted the applicability of this Procedure and the WIPO Rules for New gTLD Dispute Resolution.

The parties cannot derogate from the Procedure without the express approval of ICANN and from the WIPO Rules for New gTLD Dispute Resolution without the express approval of the WIPO Center.

V. Factual and Legal Grounds

(Applicant Guidebook Module 3, art. 3.5.2; Procedure, art. 11)

As set forth in Applicant Guidebook, art. 3.5.2, to sustain an Objection based upon purported existing legal rights, Objector must establish that the potential use of the applied-for gTLD by Applicant/Respondent DISH would:

(i) **take unfair advantage** of the distinctive character or the reputation of the Objector's registered or unregistered trademark or service mark ("mark") or IGO name or acronym (as identified in the treaty establishing the organization), and/or

(ii) **unjustifiably impair** the distinctive character or the reputation of the Objector's mark or IGO name or acronym], and/or

(iii) otherwise **create an impermissible likelihood of confusion** between the Applicant's/Respondent's applied-for gTLD and the Objector's mark or IGO name or acronym.

As demonstrated below, the applied-for TLD is NOT based on any existing, recognized trademarks or legal rights of any entity.

More specifically, no unfair advantage, impairment (unjustifiable or otherwise), or likelihood of confusion will arise because DISH does not base its applied-for TLD on any trademark or other legal rights of any entity. The term "DIRECT" is a generic English language term which simply and commonly means "extending or moving from one place to another without changing direction or stopping" (See Oxford Online

Dictionaries.com). "DIRECT" generically describes services provided by any of a number of companies, ranging from delivery mail services, such as those provided by United Parcel Services, to direct to home television services, such as those provided by DISH to its respective customers. While Objector indisputably also provides direct television services to its respective customers, it does so under the DIRECTV brand and not the "direct" brand. Hence, the intellectual leap Objector requests this panel to make is unfounded. As the evidence below shows, the applied-for TLD <.direct> does not reference or refer to Objector's services any more so than it references or refers to any generic provider of direct services. The Objector owns no exclusive or legal rights in the word "direct" as a trademark or otherwise, and no unfair advantage, impairment or confusion or harm will arise from DISH's operation of the <.direct> TLD.

The evidence submitted by DISH irrefutably establishes that the present objection is improper, baseless and should be denied. The points made herein are supported by the Declaration of DISH Vice-President Vivek Khemka (Attachment 1), the Declaration of Dr. Thomas Maronick (Attachment 2), and the Declaration of Karen Agee (Attachment 3). As noted below, Dr. Maronick, a consumer perception expert, conducted an Internet survey, which established that consumers are NOT likely to think that <.direct> is associated with Objector. A copy of Dr. Maronick's survey report is annexed to Dr. Maronick's Declaration.

In its guidance, ICANN has proposed that the panel consider certain non-exclusive factors in assessing whether an Objector's claim of trademark rights should be upheld. None of these factors supports Objector's position. The factors are:

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.

Consideration of these factors shows why Objector's complaint is meritless. Addressing each of these factors in turn:

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

The applied-for gTLD <.direct> is not identical or substantially similar to any of Objector's marks. While Objector submitted a roster of many trademark registrations in the U.S. and internationally using the term "DIRECTV" "direct+{suffix}", none of these registrations is for "direct" by itself. That is, Objector has not established that it owns any trademark rights, anywhere in the world, in "DIRECT" in and by itself. Instead, each of Objector's trademark registrations is for "direct" in combination with another term, such as "tv", "hindi", "mandarin", "pinoy", "world", "view", etc., as is shown by the registrations set forth in Objector's Attachments B and C. In view of the inherent generic and descriptive nature of the word "direct," it is highly unlikely that Objector – or anyone else – could own exclusive trademark rights in "direct" – especially when used for television or other services offered directly to consumers.

Further, while "DIRECT" and "DIRECTV" have some similarities in appearance, a critical aspect of DIRECTV is "TV," and as the survey evidence discussed below confirms, that the term "direct" is not uniquely associated with Objector. Similarly, while "DIRECT" and "DIRECTV" have some phonetic similarities, they are significantly different, as the latter requires addition of third and fourth syllables for the "TV" portion (DIR-ECT-TEE-VEE). That "TV" portion is critical to Objector's marks and provides meaning, context and association of goods/services with a unique provider thereof. Without the "TV" segment, the "DIRECT" portion provides no such association—with Objector or anyone else. By itself, "DIRECT" is simply a generic term. It is possible that, as stated in paragraph 12.e of Objector's complaint, that its "DIRECTV" brand was valued at \$8.2 Billion. That is for the full mark, with the critical "TV" component. It is telling that Objector does not claim that any value was established for "DIRECT" alone. Objector's failure to establish any use of "DIRECT" by itself in its advertising and as a free-standing brand compels the conclusion that Objector too has used "DIRECT" only generically and not as a brand.¹ That is not surprising, as Objector cannot claim any exclusive rights to that generic term.

¹ See Objector's Exhibits E and F, wherein the word "direct" appears only in conjunction with descriptive uses, such as on page 6 of Exhibit F where "DIRECTV International World Direct Satellite DISH DTV36EDS" is identified. Such usage of "direct" is simply insufficient to establish trademark rights

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

DISH does not contest that Objector has bona fide rights in its registered and other trademarks. However, those rights are limited to its specific marks, to DIRECTV and its logos/iterations. Objector has NOT shown, and cannot show, any exclusive rights in the word "direct." That is not Objector's mark.

Indeed, Objector has only narrow rights in its marks. This is due to the descriptive and generic nature of the word "direct" which is a key component of Objector's marks. Objector does not have trademark rights in the word "direct." "Direct" is used in many ways, in advertising, promotions, trademarks, and in daily life. The word "direct" has many meanings and applications, including but not limited to direct marketing, direct-to-consumer, direct signals, direct service, and other commonly-used phrases.

"Direct" is a common, generic word that is not within the legal rights of Objector. It is well-known that generic terms are not entitled to trademark protection. See, e.g., *Nartron Corp. v. STMicroelectronics, Inc.*, 305 F.3d 397, 404 (6th Cir. 2002) ("A generic term can never function as a trademark."); Restatement (Third) of Unfair Competition § 15(1) ("A user cannot acquire rights in a generic designation as a trademark, trade name, collective mark, or certification mark."). 1-2 Anne Gilson, *Gilson on Trademarks* § 2.02.

The weakness of a trademark using the term "direct" is evidenced by the Declaration of Karen Agee (Attachment 3). Ms. Agee's search of the U.S. Patent and Trademark (PTO) records showed over 3000 live trademark registrations and applications that include the term "DIRECT." According to the PTO's records, 68 of these marks appear to be owned by The DIRECTV Group, Inc. or an affiliate using "DirecTV" in its name. Agee Decl., para. 4. That means that over 2,800 live trademark applications and registrations in the U.S. using the term "direct" apparently are owned by entities other than Objector. Similarly, Ms. Agee's search found 147 live trademark applications and registrations in Trademark Class 38, which covers telecommunications and related services, using the term "direct." Of those 147 entries, 27 appear to be owned by The DIRECTV Group, Inc. or an affiliate using "DirecTV" in its name, according to the PTO records. Agee Decl., para. 5. These findings show that Objector does not have, and cannot claim, exclusive rights in the term "direct," as part of a trademark, domain name, or otherwise.

in "direct," just as it would be insufficient to establish trademark rights in the terms "international", "world", "satellite" or even "dish" (when "dish" is used to specifically refer to parabolic shaped antennas as per the Amazon posted advertisement submitted by Objector).

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

Objector failed to show that the public recognizes “DIRECT” as its mark. Indeed, the facts show that “Direct” is not associated with Objector. Dr. Maronick’s survey shows that less than 6% of persons responding to his survey made any connection between .direct and Objector. Maronick Decl., para. 7 (Attachment 2 hereto). As Dr. Maronick states: “In this survey, respondents were asked “If you were to see a domain name ending with ‘.direct’ would you associate it with any particular company or organization?” Those who said yes were asked “what company or organization?” Less than 6% of respondents (11 persons out of 216 responding) mentioned DirecTV as that company. Most respondents (159 out of 216) did not name any company at all.” *Id.* That result is far less than the 15-20% minimum that would be needed to show any association or confusion. See Thomas McCarthy, 6 McCarthy on Trademarks and Unfair Competition § 32:188 (4th ed.).

That result is not surprising. Thousands of trademark registrations use the word “direct.” Most of those use other words or symbols with “direct” – again because no one entity can have exclusive rights to such a generic word. Thus, a search of live trademark applications and registrations at the U.S. Patent and Trademark Office alone revealed over 3,000 results incorporating “direct” in a mark. See Declaration of Paralegal Karen Agee, annexing results of trademark searches (Attachment 3 hereto).

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

Objector also failed to prove any bad faith on Applicant DISH’s part. To the contrary, as explained in the Declaration of Applicant’s Vice President Vivek Khemka (Attachment 1 hereto), DISH’s gTLD application was filed in good faith, as part of DISH’s business plan to increase its connectivity and offerings to consumers. The link to “direct” offerings and connectivity is understandable. As Mr. Khemka notes in his Declaration, DISH intends to continue to provide programming and content “direct” to consumers, using the <.direct> gTLD as a closed, secure network for its eco-system. While DISH no doubt was aware of Objector, it acted in good faith in applying for the <.direct> gTLD. Objector’s allegations of bad faith are without merit or credibility.

Moreover, Objector has not shown, and cannot show, that DISH applied for or operates TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others.² DISH has strong trademarks and intends to brand its .direct websites

² DISH notes that Objector could have, but did not, apply for a gTLD consisting of its brand.

with its trademarks. Objector has failed to show any bad faith or intent. DISH has acted in good faith and candidly.

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.

As Mr. Khemka notes, the concept of providing “direct” services to its customers has been key to DISH’s business and success. “DISH provides programming and content “direct” to consumers. It will provide telecommunications services “direct” to consumers. DISH offers consumers direct choice, direct value, and direct service. “Direct” service has been a key element of DISH’s offerings since its founding. That is why DISH selected <.direct> as a gTLD.” Khemka Decl., para. 7 (Attachment 1 hereto). DISH did not select <.direct> with the intent that it refer to Objector or its services. Khemka Decl., para. 11.

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.

DISH applied for .direct as a “true” generic gTLD. It is not intended to be a brand. It is too common a word to be a brand. However, as noted above, it has direct application to the kind of services DISH offers—direct to the consumer.

As noted, DISH intends to use the closed domain to reinforce its brands and in promoting consumer confidence. As a closed domain, DISH will set the criteria for registration, which will be limited to persons and entities which meet the DISH-established criteria. As Mr. Khemka states: “Operating .direct as a closed domain will help us to deliver and arrange for DISH services in a secure fashion and help us to fight counterfeit and unauthorized sellers. DISH currently has over 3000 retailers, which are authorized to sell and set up the DISH services for consumers. We envision that our retailers will be able to register for second level domain names; the retailer will then use those domain names and associated websites for communications with their customers and to promote their services as authorized DISH retailers.” Khemka Decl., para. 8 (Attachment 1 hereto).

By controlling the use of the gTLD, DISH will increase consumer confidence in the DISH Network as well as its ability to oversee the retailers servicing its network. That will assist DISH in guarding against the use or sales of counterfeit or unauthorized signals or products. DISH’s use of this gTLD thus will be in the public interest as well as consistent with DISH’s business plan.

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.

DISH has been a provider of direct-to-home satellite based television services since 1996. Khemka Decl., para. 3. As the second largest provider in the United States of such “direct” services, DISH’s application for <.direct> must be viewed as bona fide. The generic term “direct” is readily applicable to DISH as well as to other entities that provide direct-to-consumer or direct-to-home services. DISH does not intend to claim exclusive trademark rights in the term “direct.” Indeed, it could not have exclusive rights in such a generic term (as demonstrated by the thousands of registered U.S. trademarks using that word). Nevertheless, as also noted above, DISH intends to use the <.direct> TLD as a closed domain to facilitate and further its business and service the public.

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

Objector has failed to show that DISH’s use of “direct” as a gTLD would create a likelihood of confusion with Objector’s marks. As the ICANN standards state, for a likelihood of confusion to exist, “it must be probable, not merely possible that confusion will arise in the mind of the average, reasonable Internet user. Mere association, in the sense that the applied-for TLD brings another trademark to mind, is insufficient to find a likelihood of confusion.” Dispute Resolution Procedures, ICANN gTLD Applicant Guidebook at Module 3.5.1.

The applied for gTLD <.direct> simply is not confusingly similar to Objector’s marks. As noted above, “direct” is not identical to any of Objector’s marks; Objector’s marks create very different overall impressions, with the “TV” portion often most prominent. Objector’s marks are best understood as compound words composed of 2 parts, “direct” and “tv”. The addition of “tv” makes Objector’s marks into a two word phrase. Additionally, “tv” is a well-understood word in the English language referring to a television. In contrast, the applied-for TLD <.direct> has no connotation or commercial impression associated with television. As “direct” by itself without a “v” added is a generic English word, the appearance, sound, connotation and commercial impression of the applied for TLD is not confusingly similar to Objector’s marks.

Dr. Maronick’s survey confirmed that there is no likelihood of confusion between the applied for gTLD .direct and “DirecTV” or Objector. In this survey, respondents were asked “If you were to see a domain name ending with “.direct” would you associate it with any particular company or organization?” Those who said yes, were asked “what company or organization?” Less than 6% of respondents (11 persons out of 216 responding) mentioned DirecTV as that company. Most respondents (159 out of 216) did not name any company at all. See Survey Report, annexed to Maronick Declaration (Attachment 32 hereto). That demonstrates that there is no association or likely confusion here.

When asked whether the hypothetical second-level domain name “television.direct” was associated with any company, 46 respondents (out of 213 answering that question) said yes, it was associated with a company. When those 46 were then asked to identify the company, 9 persons then said DirecTV and 6 persons said DISH. When any such company was identified, only 3 people out of 216 identified any association of “television.direct” with DIRECTV versus DISH. *Id.* That is, only 4% of the sample population associated <television.direct> with the Objector. See Maronick Decl. and annexed Survey Report (Attachment 2 hereto). While Objector clearly has some association with “direct television” it is *de minimus*, at best, and at worst, statistically no greater than DISH’s own association with <television.direct>. As Dr. Maronick notes, at least 15%-20% association generally is required before a finding of likely confusion would be made³ Accordingly, no likelihood of confusion exists or will likely arise between the applied-for .direct gTLD and Objector’s trademarks.

Objector has failed to show that the applied for gTLD in <direct> **takes unfair advantage** of and/or **unjustifiably impairs** or creates any likelihood or probability of confusion by and between Objectors limited trademark rights. As the totality of the evidence establishes no such harm will arise, Applicant’s application for the <direct> gTLD should be confirmed and Objector’s attempt to monopolize the common, generic word “direct” rejected.

CONCLUSION

For the above reasons, Objector’s Legal Rights Objection to the DISH application for the .direct gTLD should be dismissed.

A schedule and description listing all supporting evidence/documentation for Attachments 1 through 4 is attached.

VI. Panel (of Experts)

(Procedure, art. 13; WIPO Rules for New gTLD Dispute Resolution, para. 8)

The Applicant/Respondent elects to have the dispute decided by a three-member Panel.

³ That is consistent with the holdings of various courts in the United States assessing confusion in trademark cases. “Figures below 20% become problematic because they can only be viewed against the background of other evidence weighing for and against a conclusion of likely confusion.” J. Thomas McCarthy, 6 McCarthy on Trademarks and Unfair Competition § 32:188. See also *RJR Foods, Inc. v. White Rock Corp.*, 603 F.2d 1058, 1061 (2d Cir. 1979) (upholding district court’s finding of likelihood of confusion based on consumer study showing 15-20% rate of confusion in conjunction with other evidence).

VII. Other Legal Proceedings

Applicant DISH is not aware of any other legal proceedings that have been commenced or terminated in connection with the applied-for TLD.

VIII. Communications (Procedure, art. 6(b), 11(c))

A copy of this Response has been sent electronically to WIPO on 16 May 2013, by email to lro@wipo.int.

IX. Payment

(Procedure, art. 11(f); WIPO Rules for New gTLD Dispute Resolution, para. 10; Annex D to WIPO Rules for New gTLD Dispute Resolution)

As required by the Procedure and WIPO Rules for New gTLD Dispute Resolution, payment in the amount of USD 10,000 was made by wire transfer on 15 May 2013. Evidence of such payment is provided as Annex 4.

By submitting this Response, the Applicant/Respondent acknowledges and agrees that further payments may be required, e.g., in the event the parties elect Determination by a three-member Panel, or as may otherwise be provided in the Procedure and WIPO Rules for New gTLD Dispute Resolution.

X. Certification

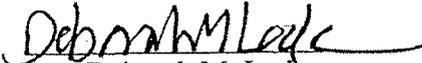
The Applicant/Respondent understands and agrees that its claims and remedies concerning this proceeding in relation to the applied-for TLD, the instant Response to a Legal Rights Objection and the Determination thereof shall be solely against the Objector, and neither the Expert(s)/Panel(ists), nor WIPO and its staff, nor ICANN and its Board members, employees and consultants shall be liable to any person for any act or omission in connection with any proceeding conducted under this Procedure.

By submitting this Response to a Legal Rights Objection to the WIPO Center the Applicant/Respondent hereby agrees to abide and be bound by the provisions of the applicable New gTLD Dispute Resolution Procedure and WIPO Rules for New gTLD Dispute Resolution.

The Applicant/Respondent certifies that the information contained in this Response is to the best of the Applicant's/Respondent's knowledge complete and accurate, that this Response is not being presented for any improper purpose, such as to harass, and that the assertions in this Response are warranted under the Procedure and

under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully submitted,


Deborah M. Lodge
Patton Boggs LLP

Outside counsel for Applicant

May 16, 2013

ATTACHMENT 3

Before the:

**WORLD INTELLECTUAL PROPERTY ORGANIZATION
ARBITRATION AND MEDIATION CENTER**

THE DIRECTV GROUP INC.

(Objector)

-v-

Dish DBS Corporation

(Applicant/Respondent)

TLD string objected to: <.DIRECT>

LEGAL RIGHTS OBJECTION

I. Introduction

1. This Legal Rights Objection is hereby submitted to the World Intellectual Property Organization Arbitration and Mediation Center (“WIPO Center”) for determination in accordance with the New gTLD Dispute Resolution Procedure (“Procedure”), provided as an Attachment to Module 3 of the gTLD Applicant Guidebook (“Applicant Guidebook”) approved by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on June 20, 2011 and as updated on January 11, 2012, and the World Intellectual Property Organization Rules for New gTLD Dispute Resolution for Existing Legal Rights Objections (“WIPO Rules for New gTLD Dispute Resolution”) in effect on the day when the relevant Application for a new gTLD was submitted.

II. The Parties

A. The Objector

2. The Objector in this proceeding is The DIRECTV Group, Inc., a Delaware corporation with a place of business at 2230 East Imperial Highway, El Segundo, California 90245.
3. The Objector’s contact details are:

Address: 2230 East Imperial Highway
El Segundo, California 90245
Contact Information Redacted

4. The Objector's authorized representative in this proceeding is:

Name: James R. Davis, II c/o Arent Fox LLP
Address: 1717 K Street, NW
Washington, DC 20036

Contact Information Redacted

5. The Objector's preferred contact details for purposes of this proceeding are:

For electronic-only material

Contact Information Redacted

For any hardcopy material

Method: post/courier
Name: James R. Davis, II c/o Arent Fox LLP
Address: 1717 K Street, NW
Washington, DC 20036

B. The Applicant/Respondent

6. The Applicant/Respondent in this proceeding is Dish DBS Corporation, a Colorado corporation with a principal place of business at 9601 S. Meridian Boulevard, Englewood Colorado 80112. Copies of the printout of the relevant ICANN posting are provided as **Annex A**.
7. All information known to the Objector regarding how to contact the Applicant/Respondent is as follows:

Address: Dish DBS Corporation
Gretchen Olive and Chad Hilyard
9601 S. Meridian Boulevard
Englewood, Colorado 80112

Contact Information Redacted

III. TLD string objected to (applied-for TLD string):

8. This Objection concerns the applied-for TLD string identified below:

<.DIRECT>

IV. Jurisdictional Basis for the Objection

9. By applying for a new gTLD, the Applicant/Respondent has accepted the applicability of the Procedure and the WIPO Rules for New gTLD Dispute Resolution.

By filing the present Objection to a new gTLD, the Objector accepts the applicability of this Procedure and the WIPO Rules for New gTLD Dispute Resolution.

The parties cannot derogate from the Procedure without the express approval of ICANN and from the WIPO Rules for New gTLD Dispute Resolution without the express approval of the WIPO Center.

V. Factual and Legal Grounds

10. The Objector's basis for standing under the Procedure is:

Objector The DIRECTV Group Inc. and its subsidiaries (collectively "DIRECTV") own exclusive worldwide rights to the name and mark DIRECTV and a family of DIRECT marks. DIRECTV owns numerous trademark registrations in the United States and globally for its DIRECTV and DIRECT marks. Attached as **Annexes B and C** is information regarding DIRECTV's global portfolio of DIRECTV and DIRECT trademark registrations. DIRECTV uses its name and marks in various ways to advertise and promote a wide range of goods and services, including digital television entertainment services and providing television and audio services to subscribers through satellite transmissions. DIRECTV and Applicant/Respondent are direct competitors and promote and provide their services to the same actual and prospective customers using many of the same marketing and trade channels.

11. This Objection is based on the following grounds:

"Existing Legal Rights Objection", which 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.

12. This Objection is valid and should be upheld for the following reasons:

The potential use of the applied-for gTLD by the Applicant/Respondent

(i) takes unfair advantage of the distinctive character and the reputation of the Objector DIRECTV's name and registered and unregistered DIRECTV and DIRECT trademarks and service marks ("Marks"),

(ii) unjustifiably impairs the distinctive character and the reputation of DIRECTV's name and Marks, and

(iii) otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and DIRECTV's name and Marks.

a. DIRECTV is the owner of the distinctive and famous name and mark DIRECTV, as well as a family of DIRECTV and DIRECT marks. DIRECTV aggressively protects its valuable marks through registration with the United States Patent & Trademark Office and trademark offices around the world. By issuing registrations those trademark offices have repeatedly recognized the validity of the DIRECTV and DIRECT marks, and DIRECTV's exclusive ownership of and right to use those marks in connection with a wide range of goods and services, particularly with regard to providing telecommunications and television services to consumers.

Among others, DIRECTV owns the following DIRECTV trademark registrations:

Trademark	Country	Reg. No.	Goods & Services
DIRECTV and Design	U.S.	2,939,061	Telecommunications equipment
DIRECTV and Design	U.S.	2,618,102	Telecommunications services
DIRECTV	U.S.	2,698,197	Various telecommunications and TV programming services, and other goods and services
DIRECTV	U.S.	2,503,432	Various telecommunications services and other goods
DIRECTV PLUS	U.S.	2,418,301	Telecommunications equipment
DIRECTV AIRBORNE	U.S.	2,802,621	Satellite transmission and programming services
DIRECTV CINEMA	Argentina	2,411,727	Class 38 services
DIRECTV CINEMA	Argentina	2,411,728	Class 41 services
DIRECTV NEXUS	Chile	954942	Telecommunications products and services
DIRECTV	Columbia	216133	Telecommunications services
DIRECTV	Venezuela	217970	Telecommunications products
DIRECTV	Venezuela	011907	Television programming and production services
ACCESS DIRECTV	European Union	010084713	Various goods and services in Classes 16, 35, 38 and 42

See **Annex B** for copies of selected DIRECTV trademark registration certificates.

Among others, DIRECTV owns the following DIRECT-based trademark registrations:

Trademark	Country	Reg. No.	Goods and Services
WORLDDIRECT	U.S.	3,040,990	TV programming services
WORLDDIRECT	U.S.	3,301,673	Satellite TV and broadcasting services
DIRECTVIEW	U.S.	4,234,282	Research and analysis re consumer viewing habits
DIRECTVIEW and Design	U.S.	4,234,313	Research and analysis re consumer viewing habits
PINOYDIRECT	U.S.	3,822,587	TV programming services
HINDIDIRECT	U.S.	3,272,839	Satellite TV broadcasting and

			TV programming
MANDARINDIRECT	U.S.	3,283,553	Satellite TV broadcasting and TV programming
DIRECTVIEW	European Union	008447542	Various goods and services in Classes 9, 16, 35 and 42

See **Annex C** for copies of selected DIRECT-based trademark registration certificates.

DIRECTV also makes common law use of DIRECT trademarks. For example, the company's monthly programming publication is branded "Satellite DIRECT Magazine" and it uses the mark DIRECTTOTAL for one of its Caribbean programming options. **Annex F. *Id.***¹

b. At least as early as 1994, Objector began using its DIRECTV name and mark in connection with the delivery of high quality digital television services and the distribution and installation of satellite television dish receivers, tuning boxes and other products and services related to such services. Since that time, Complainant has continually used its Marks in commerce and created a globally famous family of DIRECTV and DIRECT marks.

c. DIRECTV is America's leading satellite television service. Its more than 16,000 employees offer more than 285 digital channels to over 20 million subscribers in the United States, with approximately 15 million additional subscribers in Latin America, the Caribbean and globally. The company provides access to quality programming delivered to homes, airports, hotels, restaurants, hospitals, office buildings, airplanes, automobiles and portable electronics. It offers content of such famous networks as CNN, CNBC, Fox, HBO, ABC, CBS, NBC, ESPN, Discovery, Animal Planet and others, and its innovations in creating its own broadcast content have led to several Emmy Awards. DIRECTV has won seven Emmy Awards for technical achievement in engineering and one Primetime Emmy award for interactive television.

d. DIRECTV extensively promotes its name and family of DIRECTV and DIRECT marks through a wide range of media, including print, radio, television and Internet advertising. As a result of such extensive advertising and promotion, DIRECTV's DIRECTV and DIRECT marks have become globally famous and consumers associate the marks solely with DIRECTV.

e. The DIRECTV trademark was listed in the 2012 edition of the BrandFinance Global 500 ranking of the world's most valuable brands, with a value of approximately \$8.2 Billion. **Annex D.** The DIRECTV brand has appeared on the BrandFinance Global 500 ranking every year since 2008. In 2012 DIRECTV received significant press coverage when the company's "Cable Effects" advertising campaign received the prestigious Cannes Lion award and, during a speech in Cannes at the time, former President Bill Clinton identified the DIRECTV advertisements as his favorite commercial campaign. **Id.**

¹ DIRECTV has provided representative examples of registration certificates and specimens showing uses of DIRECTV and DIRECT trademarks; however, given the substantial scope of relevant registrations and uses of the trademarks DIRECTV has not provided an exhaustive list. DIRECTV can provide additional evidence if requested by the panel.

- f. DIRECTV generates significant sales revenue as a result of the advertising and marketing it conducts under its name and family of DIRECTV and DIRECT marks.
- g. As a result of DIRECTV's extensive and global promotional and advertising activities, the DIRECTV and DIRECT marks serve to identify and indicate the source of DIRECTV's goods and services to the consuming public and have become well-known to, and widely recognized by consumers. Examples of how the Marks are used on DIRECTV's goods and services are provided as **Annexes E and F**.
- h. DIRECTV operates and promotes its services via the toll-free telephone number 1-800-DIRECTV. See **Annex G**.
- i. Since at least as early as 1995, DIRECTV has used the domain name DIRECTV.COM to promote its services online and communicate with existing and potential customers by, for example, sending promotional and other emails under the "DIRECTV.COM" domain name and operating a Web site at www.DIRECTV.com **Annex H**. In 2012 an average of more than 10 million people visited DIRECTV's primary Web site each month at www.DIRECTV.com, generating a monthly average of more than 110 million page views.
- j. Notwithstanding DIRECTV's substantial and longstanding prior investment in its family of DIRECTV and DIRECT marks, Applicant Dish DBS Corporation - a subsidiary of Dish Network Corporation and a direct competitor of DIRECTV - seeks approval to operate the gTLD string .DIRECT as a restricted TLD for exclusive use by Dish, its affiliates and business partners. **Annex A** (gTLD App. Para. 18(a)).
- k. At its Web site, Dish describes itself as "a leader in satellite TV, providing subscribers with the highest-quality programming and technology at the best value." **Annex I**. Similarly, in its gTLD application Dish claims that it and its affiliated entities are leading providers of subscription television services and satellite and Internet access services. **Annex A** (gTLD App. Para. 18(b)).
- l. Dish and DIRECTV are direct competitors. Dish acknowledges this in promotional and marketing materials, including at its Web site where it dedicates numerous pages and charts to comparisons between Dish and DIRECTV. **Annex J**.
- m. Dish plans to use the gTLD string .DIRECT as part of a new branding strategy, e.g., to "[u]nify the full breadth of products and services offered by Applicant and its affiliated entities under one brand umbrella." **Annex A** (gTLD App. Para. 18(b)(iii)) (emphasis added).
- n. In its application, Dish lists several ways in which it seeks to use the gTLD string .DIRECT, including:
- creating a connected digital presence and personalized brand experience for customers and other business partners;
 - delivering product and service marketing and advertising;
 - enabling marketing campaign activation;
 - simplifying Internet user navigation to information about Dish's products and services; and
 - meeting future client expectations and competitive market demands.

Annex A (gTLD App. Para. 18(a)).

o. Paragraph 18(a) of Dish's application therefore provides some detail to support the company's claims under Paragraph 18(b)(iii), i.e., Dish intends to use .DIRECT as a tool and medium to communicate with the public and consolidate Dish's advertising and marketing of its television, broadcasting and other services, and to do so under the umbrella brand .DIRECT or DIRECT.

p. It is indisputable that the gTLD string ".DIRECT" is nearly identical to DIRECTV's core intellectual property, including its name, and its family of DIRECTV and DIRECT trademarks, and its primary domain name "DIRECTV.COM."

q. Upon information and belief Dish does not own any trademark registrations for, or proprietary rights to, DIRECT. DIRECTV is unaware of any public information demonstrating that Dish has made a bona fide use of .DIRECT or DIRECT trademarks, and certainly no use or preparation that predates DIRECTV's established rights and priority. To the contrary, consumers have long associated DIRECT with DIRECTV and its services and trademarks, not Dish.

r. As a result, if Dish is permitted to consolidate "the full breadth of [its] products and services . . . under one brand umbrella" of .DIRECT, the millions of consumers that have for many years associated the DIRECTV and DIRECT marks with DIRECTV will be misled and confused into believing that DIRECTV created, is responsible for, or endorses any communications, Web sites, emails or other marketing activity generated by Dish using the TLD .DIRECT. Indeed, regardless of the trademarks used, any advertising or promotional activity emanating from .DIRECT for satellite, television and similar services will be perceived by the public as originating from DIRECTV.

s. Dish is deemed to at least have constructive knowledge of DIRECTV's registered trademarks. As a direct competitor, Dish has for many years had actual knowledge of DIRECTV's extensive uses of and exclusive rights to a family of DIRECTV and DIRECT trademarks. There is no legitimate, bona fide reason why Dish – a company that has created equity in its own DISH mark – would seek to operate a gTLD string that is one letter short of a direct competitor's name and house brand, and identical to its DIRECT marks. Any use by Dish of such a gTLD or branding strategy is certain to confuse and mislead consumers as to the source, origination and sponsorship of the underlying services.

t. Dish's bad faith is further shown by its expressed intent to use the confusingly similar string .DIRECT to create an "umbrella" branding platform for Dish to promote and market services that compete with DIRECTV and its DIRECTV and DIRECT marks, and are the same as or closely related to the services protected under DIRECTV's trademark registrations and promoted through emails sent under ".DIRECTV.COM" and provided at www.DIRECTV.com.

u. Ironically, in its application Dish acknowledges that "the proliferation of cybersquatting and typosquatting has placed a great burden on consumers to carefully tread online because there is no guarantee that what looks like a branded website is indeed an authorized website of the brand owner." **Annex A** (gTLD App. Para.

18(b)). After acknowledging this serious problem, Dish then proceeds to allege that the confusingly similar string .DIRECT

“will enable customers and other business partners and Internet users to distinguish on the face of the domain name alone whether the site is an authorized company site because the gTLD will be a restricted, exclusively - controlled online environment where only authorized Applicant and affiliated entity web properties and e-mail will exist and operate online.”

Id. To the contrary, consumers immediately and overwhelmingly will be confused and misled “on the face of the domain name alone” if Dish is permitted to use .DIRECT to brand, advertise and promote television services that compete directly with DIRECTV’s well-established and famous DIRECTV and DIRECT services.

v. The panelists should therefore reject Dish’s application to help ensure consumers will not be confused or misled as to the source of television and similar services promoted under the .DIRECT domain and brand, and to prevent Dish from piggybacking unfairly on the enormous international goodwill that DIRECTV has created in its portfolio of DIRECTV and DIRECT trademarks.

VI. Panel (of Experts)

13. The Objector elects to have the dispute decided by a three-member Panel

VII. Other Legal Proceedings

14. Objector is not aware of any other legal proceedings that have been commenced or terminated in connection with the applied-for TLD that forms the basis for the Objection.

VIII. Communications

15. A copy of this Objection has been sent electronically to the Applicant/Respondent on March 12, 2013, by Federal Express and email to

Dish DBS Corporation
Gretchen Olive and Chad Hilyard
9601 S. Meridian Boulevard
Englewood, Colorado 80112

and to ICANN on March 12, 2013, by email to newgtld@icann.org

IX. Payment

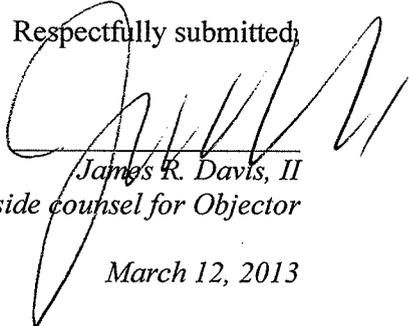
16. As required by the Procedure and WIPO Rules for New gTLD Dispute Resolution, payment has been made by credit card in the amount of USD 10,000 (plus additional fees related to the method of payment).

By submitting this Objection, the Objector acknowledges and agrees that further payments may be required, e.g., in the event the parties elect Determination by a three-member Panel, or as may otherwise be provided in the Procedure and WIPO Rules for New gTLD Dispute Resolution.

X. Certification

17. The Objector understands and agrees that its claims and remedies concerning the application of the applied-for TLD, the instant Legal Rights Objection and the Determination thereof shall be solely against the Applicant/Respondent, and neither the Expert(s)/Panel(ists), nor WIPO Center and its staff, nor ICANN and its Board members, employees and consultants shall be liable to any person for any act or omission in connection with any proceeding conducted under this Procedure.
18. By submitting this Objection to the WIPO Center the Objector hereby agrees to abide and be bound by the provisions of the applicable New gTLD Dispute Resolution Procedure and WIPO Rules for New gTLD Dispute Resolution.
19. The Objector certifies that the information contained in this Objection is to the best of the Objector's knowledge complete and accurate, that this Objection is not being presented for any improper purpose, such as to harass, and that the assertions in this Objection are warranted under the Procedure and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully submitted,


James R. Davis, II
Outside counsel for Objector

March 12, 2013

EXHIBIT J

DON'T
PAY 19% MORE
WITH
DIRECTV

**DON'T PAY MORE WITH
DIRECTV.**

The average DISH customer spent 19% less than the average DIRECTV customer. Switch to DISH and start getting more for your money.

GET STARTED

Comparison based on DIRECTV quarterly earnings press release and DISH 10-Q reports for Q3 2012.

SIMPLY SUPERIOR SERVICE.

DISH is #1 in Customer Satisfaction among the nation's largest cable and satellite providers.¹ Meanwhile, DIRECTV has been working hard to earn a D+ rating from the Better Business Bureau.² Plus, DIRECTV doesn't



LEARN MORE

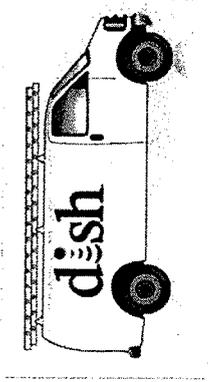


Choose Wisely.

DIRECTV removed over 20 channels and raised the price of Choice Xtra—that's not much of a choice.

LEARN MORE

LEARN MORE

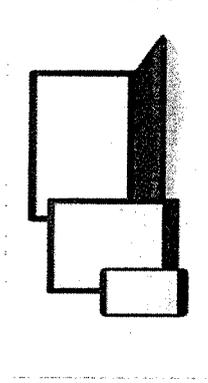


Free Installation.

Get TV installed in up to 6 rooms FREE — DIRECTV charges extra for that.

GET STARTED

LEARN MORE



DISH Anywhere™ Technology.

Only DISH offers DISH Anywhere™, giving you the ability to watch live and recorded TV anywhere on any compatible mobile device.

LEARN MORE



MY ACCOUNT

PERKS

UPGRADES

PAY-PER-VIEW

DISH ANYWHERE™

THE BEST VALUE IN TV.

It's simple. The competition continues to make their customers pay more money and gives them less value. DISH offers 5 packages with everyday prices under \$60. The competition? Not even close.



AND THE NATION'S LARGEST CABLE PROVIDERS.

RECOMMENDATION OF THE BOARD GOVERNANCE COMMITTEE (BGC)

RECONSIDERATION REQUEST 13-7

25 SEPTEMBER 2013

On 23 August 2013, Dish DBS Corporation (“Dish”) submitted a reconsideration request (“Request”). The Request asked the Board to reconsider the 29 July 2013 Expert Determination from a dispute resolution panel established by the Arbitration and Mediation Center of the World Intellectual Property Organization (“WIPO”) regarding The DirecTV Group, Inc.’s (“DirecTV”) objection to the application for .DIRECT. Specifically, the Request seeks reconsideration of the Panel’s determination sustaining DirecTV’s objection to Dish’s application for .DIRECT.

I. Relevant Bylaws

Article IV, Section 2.2 of ICANN’s Bylaws states in relevant part that any entity may submit a request for reconsideration or review of an ICANN action or inaction to the extent that it has been adversely affected by:

- (a) one or more staff actions or inactions that contradict established ICANN policy(ies); or
- (b) one or more actions or inactions of the ICANN Board that have been taken or refused to be taken without consideration of material information, except where the party submitting the request could have submitted, but did not submit, the information for the Board's consideration at the time of action or refusal to act; or
- (c) one or more actions or inactions of the ICANN Board that are taken as a result of the Board's reliance on false or inaccurate material information.

To properly initiate a request for reconsideration, the requesting party must review and follow the Reconsideration Request Form posted on the ICANN website

(<http://www.icann.org/en/groups/board/governance/reconsideration/request-form-11apr13->

en.doc). The requesting party must also acknowledge and agree to the terms and conditions set forth in the form when filing.

Dismissal of a request for reconsideration is appropriate if the Board Governance Committee (“BGC”) recommends, and in this case the New gTLD Program Committee agrees, that the requesting party does not have standing because the party failed to satisfy the criteria set forth in the Bylaws. These standing requirements are intended to protect the reconsideration process from abuse and to ensure that it is not used as a mechanism simply to challenge an action with which someone disagrees. The reconsideration process is for situations where the staff acted in contravention of established policies (when the Request is based on staff action or inaction).

Dish was notified of the 29 July 2013 Expert Determination on 8 August 2013. The Request was received on 23 August 2013, which makes it timely under the Bylaws. Bylaws, Art. IV, § 2.5.

II. Background

A. The New gTLD Objection Procedure

The New gTLD Program includes an objection procedure pursuant to which objections to applications for new gTLDs are submitted to an independent dispute resolution service provider (“DRSP”). The objection procedures are set out in Module 3 of the Applicant Guidebook (<http://newgtlds.icann.org/en/applicants/agb/objection-procedures-04jun12-en.pdf>) and the New gTLD Dispute Resolution Procedure (the “Procedure”) attached thereto.

There are four (4) grounds upon which an objection to a new gTLD application may be filed:

- (i) “String Confusion Objection” – the applied-for string is confusingly similar to an existing TLD or to another applied-for gTLD string in the same round of applications.

(ii) “Legal Rights Objection” – the applied-for gTLD string infringes the existing legal rights of the objector.

(iii) “Limited Public Interest Objection” – the applied for gTLD string is contrary to generally accepted legal norms of morality and public order that are recognized under principles of international law.

(iv) “Community Objection” – there is substantial opposition to the gTLD application from a significant portion of the community to which the gTLD string may be explicitly or implicitly targeted.

(Applicant Guidebook, Section 3.3.2.1; Procedure, Art. 2(e).)

As part of the dispute resolution proceedings, properly stated objections for which a response has been submitted will be considered by a panel of appropriately qualified expert(s) appointed by the designated DRSP. (Applicant Guidebook, Section 3.4.4.)

Each panel will determine whether the objector has standing to object and will use appropriate general principles/standards to evaluate the merits of each objection. The panel must apply the standards that have been defined in Section 3.5 of the Applicant Guidebook for each type of objection. The panel may also refer to and base its findings upon the statements and documents submitted and any rules or principles that it determines to be applicable. The objector bears the burden of proof in each case. (Applicant Guidebook, Section 3.5; Procedure, Art. 20.)

The panel’s final determination will include a summary of the dispute and findings, identify the prevailing party, and provide the reasoning upon which the expert determination is based. (Applicant Guidebook, Section 3.4.6.; Procedure, Art. 21.) The findings of the panel will be considered an expert determination and advice that ICANN will accept within the dispute resolution process. (Applicant Guidebook, Section 3.4.6.)

B. DirecTV's Objection to Dish's Application for .DIRECT

Dish is an applicant for the .DIRECT string. DirecTV timely filed a legal rights objection (the "Objection"), and Dish timely filed a response (the "Response"). DirecTV was permitted to file a reply brief (the "Reply"), and Dish was permitted to file a rejoinder (the "Rejoinder"). WIPO's appointed panelists (the "Panel") rendered their expert determination on 29 July 2013 ("Expert Determination"), and the parties were notified of the determination on 8 August 2013.

The Panel determined that DirecTV had standing to object as a rights holder in the "DirecTV" mark and other marks containing the term "direct." Applying the standards that have been defined in Section 3.5.2 of the Applicant Guidebook for a legal rights objection ("LRO"), the Panel sustained DirecTV's objection on the grounds that Dish likely chose the .DIRECT string for the sole purpose of disrupting the business of DirecTV. (Expert Determination, Page 4.)

Although the LRO was determined by a third-party DRSP, ICANN has determined that the Reconsideration process can properly be invoked for challenges of the third-party DRSP's decisions where it can be stated that either the DRSP failed to follow the established policies or processes in reaching the decision, or that ICANN staff failed to follow its policies or processes in accepting that decision. See BGC Recommendation on Reconsideration Request 13.5 at <http://www.icann.org/en/groups/board/governance/reconsideration/recommendation-booking->.

III. Analysis of Dish’s Request for Reconsideration¹

Dish seeks reconsideration of the decision to sustain DirecTV’s objection to Dish’s application for the .DIRECT new gTLD. More specifically, Dish requests that ICANN disregard the Panel’s Expert Determination and requests that the decision be reviewed by a new expert panel. Dish also requests that ICANN provide applicants of “inconsistent or erroneous DRSP panel determinations with an avenue of redress that is consistent with ICANN’s mandate to act with fairness.” In the event that ICANN will not immediately reverse the decision, Dish requests that it be provided an opportunity to respond to the BGC, before the BGC makes a final recommendation. (Request, Section 9.) Dish also requests a hearing. (Request, Page 11.)²

A. The Panel’s Alleged Influence by Media Accounts Does Not Demonstrate A Process Violation

Dish’s Request is based primarily on a claim that the Panel, in reaching its conclusion that Dish’s application for .DIRECT was not a “bona fide application,” failed to accord proper weight to the declaration of Dish’s Senior Vice President of Product Management, Vivek Khemka (“Khemka Declaration”), and instead, was improperly influenced by Dish advertisements that were not part of the record. (Request, Section 10.) To support this assertion, Dish claims that other LRO Expert Determinations have applied a “very high burden for trademark-based objections” and have found that an applicant’s business model does not

¹ A letter from DirecTV’s counsel, requesting that Dish’s Request be denied, was received on 6 September 2013 (<http://www.icann.org/en/groups/board/governance/reconsideration/davis-to-bgc-06sep13-en.pdf>). DirecTV’s letter has been reviewed and given appropriate consideration in connection with this Recommendation.

² Hearings are not required in the Reconsideration Process, however requestors may request a hearing. The BGC retains the absolute discretion to determine whether a hearing is appropriate, and to call people before it for a hearing. See Reconsideration Request Form at <http://www.icann.org/en/groups/board/governance/reconsideration/request-form-11apr13-en.doc>.

automatically translate into a finding of bad intent. (Request, Section 10, Page 8.) Dish contends that the Khemka declaration along with Dish’s responses in its application for the .DIRECT string “clearly show on the record that Dish filed a bona fide application” for the string, and that a “more objective review of other information outside the record” would have clearly shown that Dish has used the term “direct” in connection with Dish productions and services since at least December 1998. (Request, Section 10, Page 9.) Dish further asserts that there is nothing in the record showing that Dish engaged in a pattern of conduct from which any type of bad faith can be inferred, there is nothing in the record to support a finding of confusion, and Dish will be injured if the Expert Determination is permitted to stand. (Request, Section 10, Page 9-10.)

The relevant standard for evaluating a LRO is set out in Section 3.5.2 of the Applicant Guidebook:

[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 (“mark”) or IGO name or acronym ... or unjustifiably impairs the distinctive character or the reputation of the objector’s mark or IGO name or acronym, or otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector’s mark or IGO name or acronym.

The Applicant Guidebook sets forth eight non-exclusive factors that a panel will need to consider in cases where the objection is based on trademark rights. (Applicant Guidebook, Section 3.5.2.) The Procedure also makes clear that, in addition to applying the standards that have been defined by ICANN, 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.”

(Procedure, Art. 20(b).) Contrary to Dish’s contention, there is no provision in the Procedures that restricts a panel’s ability to refer to or rely upon media accounts.³

Moreover, Dish misstates the alleged influence of media accounts on the Panel in rendering its determination. The Panel noted:

That these two parties are direct competitors can scarcely be doubted. Indeed, the Panel notes that as it has been deliberating over this case, [Dish] is running a series of television advertisements squarely at [DirecTV] and its satellite television offerings.

(Expert Determination, Pages 4-5.) These statements show that the Panel referenced the advertisements to illustrate the fact that Dish and DirecTV are direct competitors in the satellite television industry. Dish does not dispute the fact that the two are competitors, and both parties acknowledge that they provide satellite television services. (Expert Determination, Pages 2-3.) Thus, even if the Panel’s reference to television advertisements was somehow improper, there does not appear to be any prejudice to Dish. The BGC also notes that the “media accounts” at issue here are advertisements produced by the parties to the objection proceedings, and not statements of journalists, so Dish’s opposition to the decision because of these “media accounts” seems misplaced in any event.

³ Dish relies on the wrong section (Section 2.4.3) of the Applicant Guidebook in its attempt to establish the alleged breach of ICANN policy and procedure. (Request, Section 8.) Module 2 of the Applicant Guidebook describes the evaluation procedures and criteria used to determine whether applied-for gTLDs are approved for delegation. The Module explains that all applicants will undergo an Initial Evaluation, which includes various reviews (as part of the string review and applicant review) by third-party panelists appointed by ICANN. (Applicant Guidebook, Section 2.2 & 2.4.) Section 2.4.3 of the Applicant Guidebook provides the code of conduct for panelists used at the Initial Evaluation – not objection – stage of the evaluation process. Section 2.4.3, and its statement against panelists being influenced through media accounts, does not govern the code of conduct for panelists used in the dispute resolution procedure set out in Module 3 of the Applicant Guidebook.

As required by the Applicant Guidebook, the Panel applied the eight non-exclusive factors to Dish's LRO and determined that each factor was in favor of DirecTV: (i) .DIRECT is similar to the DirecTV mark; (ii) DirecTV's acquisition and use of rights in its various Direct-formative marks is bona fide; (iii) the public recognizes "direct" as a mark of DirecTV, noting that Dish, a purveyor of satellite television services, is seeking to use the dominant part of the family of marks owned and used by its chief competitor in the satellite television business; (iv) Dish is well aware of DirecTV's DirecTV and Direct-formative marks and applied for the .DIRECT string in order to gain market share over a competitor; (v) Dish has not used the term "direct" as a trademark or service mark; (vi) Dish has no marks or other intellectual property rights that correspond to the word "direct"; (vii) Dish is not commonly known by the word "direct"; and (viii) consumer confusion would likely result if Dish were allowed to keep and use the .DIRECT string. (Expert Determination, Pages 5-8.)

In evaluating the fourth factor – Dish's intent in applying for the .DIRECT string – the Panel concluded "based on the record before it" that Dish applied for the .DIRECT string as "part of an ongoing battle for market share." (Expert Determination, Page 7.) The Panel indicated that Dish's application essentially admitted as much and found that Dish's admission in its application was more reliable than the statements in the Khemka Declaration disavowing Dish's brand-centered motivation in applying for .DIRECT. (Expert Determination, Page 7.) It is within the Panel's purview to weigh the evidence in front of it in making its Expert Determination.

Ultimately, Dish has not been able to identify any policy or process that the Panel did not follow. Rather, the Request challenges the Panel's substantive determination. In the context of the New gTLD Program, Reconsideration is not a mechanism for direct, de novo appeal of panel

decisions with which the requester disagrees, and seeking such relief is, in fact, in contravention of the established processes within ICANN. See BGC Recommendation on Reconsideration Request 13.5 at

<http://www.icann.org/en/groups/board/governance/reconsideration/recommendation-booking->

For the reasons stated above, Dish's claim that the Panel failed to accord proper weight to the Khemka Declaration, and was instead, improperly influenced by Dish advertisements that were not part of the record, do not demonstrate policy or process violations. Similarly, Dish's references to standards applied by other DRSP panels and Dish's general claims that the evidence supports a different outcome, are not enough for Reconsideration. Reconsideration is not available as a mechanism to re-try the decisions of the DRSP panels.

B. ICANN's Purported Breach from "Automatic Acceptance" of DRSP Decisions Does Not Support Reconsideration

In its Request, Dish contends that ICANN's automatic acceptance of DRSP panel decisions, including those that are "erroneous or inconsistent," is contrary to ICANN's mandate to act transparently and fairly. (Request, Section 8, Page 4.) To support this assertion, Dish relies on the following:

(a) Paragraph 7 of the "Summary of ICANN Generic Names Supporting Organisation's (GNSO's) Final Report on the Introduction of New Generic Top-Level Domains (gTLDs) and Related Activity" (prepared for the GNSO's 29 October 2007 New gTLD Workshop in Los Angeles, available at <http://losangeles2007.icann.org/files/losangeles/gnso-newgtlds-workshop-29oct07.pdf>). Paragraph 7 is entitled "Fairness of Process" and refers to the GNSO's recommendation that ICANN implement an evaluation and selection process that respects the principles of fairness, transparency and non-discrimination. The GNSO further provides that "all applicants should be evaluated against transparent and predictable criteria, fully available before initiation of the process."

(b) ICANN’s Articles of Incorporation (<http://www.icann.org/en/about/governance/articles>), which requires ICANN to act “through open and transparent processes.”

(c) ICANN’s Bylaws (<http://www.icann.org/en/about/governance/bylaws>). Dish references ICANN’s obligation to “operate to the maximum extent feasible in an open and transparent manner and consistent with procedures designed to ensure fairness” (Art. III, § 1), to “mak[e] decisions by applying documented polices neutrally and objectively, with integrity and fairness (Art. 1, § 2.8), and “not to apply its standards, policies, procedures, or practices inequitably or single out any particular party for disparate treatment unless justified by substantial and reasonable cause, such as the promotion of effective competition (Art. II, § 3).

Dish is not suggesting here that the dispute resolution procedures set out in Module 3 of the Applicant Guidebook, or the attached Procedure, were not followed. To the contrary, Dish is asserting that if the procedures are followed – *i.e.*, ICANN accepts the findings of the Panel pursuant to Section 3.4.6 of the Applicant Guidebook – ICANN will in some way be in violation of its mandate to act transparently and fairly. Dish’s conclusions in these respects are not accurate and do not support Reconsideration.

ICANN’s decision to proceed with the New gTLD Program followed many years of discussion, debate and deliberation with the Internet community, including end users, business groups and governments. ICANN’s work to implement the New gTLD Program – including the creation of an application and evaluation process for new gTLDs that is aligned with the policy recommendations and provides a clear roadmap for applicants to reach delegation – is reflected in the drafts of the applicant guidebook that were released for public comment, and in the explanatory papers giving insight into the rationale behind some of the conclusions reached on specific topics. Meaningful input from participants around the globe led to numerous and significant revisions of each draft version of the applicant guidebook, resulting in the Applicant Guidebook that is used in the current application round.

The current Applicant Guidebook is publicly posted on an ICANN website dedicated to the New gTLD Program. See <http://newgtlds.icann.org/en/applicants/agb>. The standards for evaluating the merits of a legal rights objection are provided in the Applicant Guidebook, and by filing an application for a new gTLD, each applicant agrees to accept the applicability of the gTLD dispute resolution process. (Applicant Guidebook, Section 3.5.2 & Section 3.3.2; Procedure, Art. 1(d).) Applicants are evaluated against transparent and predictable criteria, and the procedures are designed to ensure fairness.

Dish's attempt to claim here that the procedures set forth in the Applicant Guidebook, which followed years of inclusive policy development and implementation planning, are inconsistent with ICANN's Articles of Incorporation and Bylaws (or the recommendations of the GNSO) is not supported and must be rejected. The Applicant Guidebook sets out the standards used to evaluate and resolve objections. The Expert Determination shows that the Panel followed the evaluation standards. ICANN's acceptance of that Expert Determination as advice to ICANN is also in accordance with the established process. (Applicant Guidebook, Section 3.4.6.) Dish's disagreement as to whether the standards should have resulted in a finding in favor of DirecTV's objection does not mean that ICANN (or the Panel) violated any policy or process in reaching the decision (nor does it support a conclusion that the decision was actually wrong).

Dish further contends that DRSP panels are taking "diverse and sometimes opposing views in their decision-making." (Request, Section 8, Page 5.) Dish claims that ICANN's failure to provide a mechanism for redress for erroneous and inconsistent DRSP panel decisions is contrary to ICANN's mandate to act with fairness, and prevents Dish (and other applicants) from challenging erroneous and inconsistent decisions in a "non-arbitrary and non-

discriminatory fashion.” (Request, Section 8, Page 5.) For the same reasons as stated above, ICANN’s purported inaction in implementing certain quality controls does not demonstrate a violation of any ICANN policy or process.

While parties to a dispute resolution proceeding may not always be satisfied with the determinations of the DRSP panels – and there may be divergence in the conclusions reached between the various panels – the Reconsideration process is not intended to reexamine the established dispute resolution process. Dish’s belief that the objection and dispute resolution procedures should be changed does not constitute a policy or process violation that supports reconsideration.

IV. Recommendation and Conclusion

Based on the foregoing, the BGC concludes that Dish has not stated proper grounds for reconsideration and we therefore recommend that Dish’s Request be denied without further consideration. Based on the information available, Dish’s request for the provision of additional information as well as the request for a hearing both have the potential to put before the BGC additional information that only challenges the substantive ruling of the DRSP, as the record before the BGC makes clear that no policy or process has been identified that the Panel or ICANN failed to follow. As a result, Dish’s request for an opportunity to respond to the BGC, as well as the request for a hearing, do not have the potential to bring before the BGC additional material information that is relevant to the evaluation of this Request and we therefore recommend they be denied.

As there is no indication that either the Panel or ICANN violated any policy or process in reaching or accepting the determination sustaining DirecTV’s objection, this Request should not proceed. If Dish thinks that it has somehow been treated unfairly in the process, and the Board

(through the New gTLD Program Committee) adopts this Recommendation, Dish is free to ask the Ombudsman to review this matter.

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