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Confusing the Similarity of Trademarks Law in Domain Name Disputes

Christine Haight Farley

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CONFUSING THE SIMILARITY OF TRADEMARK LAW IN DOMAIN NAME DISPUTES

*Christine Haight Farley**

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ABSTRACT

This article anticipates doctrinal disorder in domain name disputes as a result of the new generic top-level domains (gTLDs). In the course of the intense and prolonged debate over the possibility of new gTLDs, no one seems to have focused on the conspicuous fact that domain name disputes incorporating new gTLDs will be markedly different from the first-generation domain name disputes under previous gTLDs. Now second-generation disputes will have the added feature of the domain name having a suffix that will likely be a generic word, geographic term, or trademark. This addition is significant. Rather than disputes over <mcdonalds.com>, we will have disputes over <mcdonalds.ancestry>. Before these new gTLDs, Uniform Dispute Resolution Procedure (UDRP)

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panels have routinely ignored the gTLD portion of the domain concluding that the suffix is inconsequential to their determinations of confusing similarity. This approach has already changed. While this change may seem trivial especially in a non-precedential system, the consequence of this change may be profound for trademark owners' rights on the internet and portend a fundamental shift in how trademarks will be called upon to pick winners and losers in this new land grab.

I. INTRODUCTION

This article anticipates doctrinal disorder in domain name disputes resulting from the new top-level domains. In 2008, the Internet Corporation for Assigned Names and Numbers (ICANN)¹ announced that it was expanding the internet by allowing essentially unrestricted new generic top-level domains.² Generic top-level domains (gTLDs) are to the right of the dot in a URL; the most known gTLD being <.com>. The New Generic Top-level Domain Program was officially launched in 2011.³

In the course of the intense and prolonged debate over the possibility of new gTLDs, no one seems to have focused on the conspicuous fact that domain name disputes incorporating new gTLDs will be markedly different from the first-generation domain name disputes under previous gTLDs. Now second-generation disputes will have the added feature of the domain name having a suffix that will likely be a generic word, geographic term, or trademark. This addition is significant. Rather than disputes over <mcdonalds.com>, we will have disputes over <mcdonalds.ancestry>. Before these new gTLDs, panels resolving the Uniform Dispute Resolution Procedure (UDRP) disputes have routinely ignored the gTLD portion of the domain concluding that the suffix is inconsequential to their determinations of confusing similarity.⁴ This

1. ICANN is a private, nonprofit entity that, among other things, administers the policy of the global Domain Name System (DNS).

2. *Biggest Expansion in gTLDs Approved for Implementation*, ICANN (June 26, 2008), <http://www.icann.org/en/announcements/announcement-4-26jun08-en.htm> [<https://perma.cc/SH4P-2NNE>] (Then ICANN President and CEO Dr. Paul Twomey announced that the Board had “accepted a recommendation from its global stakeholders that it is possible to implement many new names to the Internet.”).

3. *New Generic Top-Level Domains*, ICANN, <https://newgtlds.icann.org/en/about/program> [<https://perma.cc/U4ZX-9M75>].

4. See WIPO Overview 2.0, ¶ 1.2 (2011), <https://www.wipo.int/amc/en/domains/search/overview2.0/> [<https://perma.cc/S7C8-3DJN>] (“The applicable top-level suffix in the domain name (e.g., “.com”) would usually be disregarded under the confusing similarity test (as it is a technical requirement of registration), except in certain cases where the applicable top-level suffix

approach has already changed. While this change may seem trivial especially in a non-precedential system, the consequence of this change may be profound for trademark owners' rights on the internet and portend a fundamental shift in how trademark law will be called upon to pick winners and losers in this new land grab.

II. THE NEW GTLD PROGRAM

The new top-level domain program is now dramatically changing the landscape of domain names. Until this change—which is still underway, gTLDs had been limited by ICANN to 22 (excluding country codes, such as <.uk>).⁵ Of those 22, the overwhelming majority of registered domain names are in the <.com> gTLD.⁶ However, as of October 2014, the new gTLDs began rolling out. When this process is finally complete, we can expect almost 1,300 new gTLDs to be available.⁷ Hence, in the space of a few years, there will be an increase in gTLDs from 22 to over 1,200. This is an enormous transformation—a 5,000% increase in gTLDs. Everyone seems to agree that this is a historic expansion of internet domain extensions and the biggest change to the internet's domain naming system since <.com> was introduced in 1985.

The introduction of these new gTLDs will undoubtedly produce a profusion of legal disputes. The large majority of these disputes will be

may itself form part of the relevant trademark.”), superseded by WIPO Jurisprudential Overview 3.0 (2017), <https://www.wipo.int/amc/en/domains/search/overview3.0/> [<https://perma.cc/32KU-MJCM>]; see also 2 JEROME GILSON & ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 7A.06 (Lexis Nexis 2018) (“Panels generally ignore the gTLD portion of the domain name (e.g., .com, .net or .org) when making a comparison between the domain name and the trademark at issue.”); 1-2 PAUL D. MCGRADY, MCGRADY ON DOMAIN NAMES § 2.102 (Lexis Nexis 2015) (“Historically, in both ACPA and UDRP analysis, judges and panelists have disregarded the top level domain name in confusion analysis.”).

5. The gTLDs <.com>, <.edu>, <.gov>, <.int>, <.mil>, <.net>, <.org>, and <.arpa> were created in the 1980s. Between 2000 and 2004, the gTLDs <.biz>, <.info>, <.name>, <.pro>, <.aero>, <.coop>, <.museum>, <.asia>, <.cat>, <.jobs>, <.mobi>, <.tel>, and <.travel> were introduced. See *Top-Level Domains (gTLDs)*, ICANN, <http://archive.icann.org/en/tlds/> [<https://perma.cc/Q97U-NTUD>]. Finally, the gTLD <.xxx> was added in 2011. See *XXX domain names go live*, THE REGISTER (Apr. 17, 2011), https://www.theregister.co.uk/2011/04/17/xxx_goes_live/ [<https://perma.cc/2WGA-SDR7>]. The use of the term “generic” in generic top-level domains was simply to distinguish these domains from country specific top-level domains, such as <.us>. See Memorandum from Jon Postel and Joyce Reynolds, IAB, RFC 920, (Oct. 1984), <https://tools.ietf.org/html/rfc920> [<https://perma.cc/FWK6-YY3C>].

6. There were 133.9 million domains registered in .com as of June 2018. VERISIGN, THE DOMAIN NAME INDUSTRY BRIEF, THE VERISIGN DOMAIN REPORT 2 (June 2018), <https://www.verisign.com/assets/domain-name-report-Q12018.pdf> [<https://perma.cc/97EP-4T6X>].

7. See *New Generic Top Level Domain Names: Delegated Strings*, ICANN, <http://newgtlds.icann.org/en/program-status/delegated-strings> [<https://perma.cc/5KXR-U884>].

domain name disputes in the second level.⁸ These are the garden-variety domain name disputes that have been abundantly arbitrated, and sometimes even litigated,⁹ over the past eighteen years.

III. UDRP DISPUTES UNTIL NOW

The first domain name dispute was resolved on January 14, 2000,¹⁰ under the UDRP.¹¹ A considerable number of domain name disputes have been decided over these past eighteen years. Just one of the four ICANN accredited arbitration providers—the World Intellectual Property Organization (WIPO) Arbitration and Mediation Center (WIPO Center)—has already decided more than 41,000 domain name disputes.¹²

Remarkably, the number of domain name disputes did not decline from the time the UDRP was promulgated until now. In fact, over this

8. Internet domain names consist of multiple components, including a top-level domain name, then a second-level domain name, and, in some cases, lower-level domain names. Take, for example, my law school's website, <www.wcl.american.edu>. The top-level domain name is the suffix, <.edu>. The second-level domain name is <american>. The lower-level domain is <wcl>. There are already a growing number of disputes involving new gTLDs. For example, in *Compagnie Générale des Etablissements Michelin v. Cameron Jackson*, the owner of the trademark for MICHELIN brought a complaint against the registrant of several domains in new gTLDs such as <michelin.lol> and <michelinfrance.online>. *Compagnie Générale des Etablissements Michelin v. Cameron Jackson*, WIPO Case No. D2016-2392, Judgment for Complainant, § 4 (Jan. 19, 2017), <http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2016-2392> [<https://perma.cc/HNJ7-6UUN>] (domain names transferred to complainant).

9. The ACPA is a Lanham Act provision that provides a federal civil action for cybersquatting. See Jonathan S. Jennings, *Developing Domain Name Enforcement Options*, 34 *FRANCHISE L.J.* 521, 522 (2015).

10. *World Wrestling Federation Entertainment, Inc. v. Michael Bosman*, WIPO Case No. D99-0001, Judgment for Complainant, § 7 (Jan. 14, 2000), <http://www.wipo.int/amc/en/domains/decisions/html/1999/d1999-0001.html> [<https://perma.cc/3Z2K-39VF>].

11. The first domain name dispute under the Anti-Cyberpiracy Consumer Protection Act (ACPA), the U.S. legislation on domain name disputes, was decided on February 2, 2000. See *Sporty's Farm L.L.C. v. Sportsman's Mkt., Inc.*, 202 F.3d 489, 496 (2d Cir. 2000) (“[O]ur opinion appears to be the first interpretation of the ACPA at the appellate level.”).

12. *Total Number of Cases per Year*, WIPO, <http://www.wipo.int/amc/en/domains/statistics/cases.jsp> [<https://perma.cc/PAD7-LFKM>]. The WIPO Arbitration and Mediation Center is the largest of the accredited service providers and arbitrates a little over half of all UDRP disputes. However, there are many other ICANN approved dispute-resolution service providers. See *List of Approved Dispute Resolution Service Providers*, ICANN <https://www.icann.org/resources/pages/providers-6d-2012-02-25-en> [<https://perma.cc/83SV-SKYB>] (providing a full list of providers). It is difficult to estimate the total number of disputes decided by all providers as the WIPO Center is the only one of the providers that publishes real-time and detailed data. See Doug Isenberg, *Domain Name Disputes Break Two Records in 2017*, *GIGALAW* (January 3, 2018), <https://giga.law/blog/2018/1/3/domain-name-disputes-break-two-records-in-2017> [<https://perma.cc/DF3N-26NY>]; Doug Isenberg, *Domain Name Disputes on the Rise - - Again*, *GIGALAW* (July 25, 2018) <https://giga.law/blog/2018/7/25/domain-name-disputes-on-the-rise-again> [<https://perma.cc/RXL7-XY5T>].

period, the number of domain name disputes has continually increased.¹³ In 2000, the WIPO Center decided 1,857 disputes, whereas last year it decided the largest number yet: 3,074.¹⁴ In addition to the increasing number of disputes, there is a corresponding increase in the number of domains at issue in each dispute. In 2000, the WIPO Center resolved complaints involving 3,760 domain names, whereas it resolved complaints involving 6,371 domain names last year, again, the most to date.¹⁵

And now, these new gTLDs will no doubt cause the already considerable number of domain name disputes to grow exponentially. Overall, domain name registrations are increasing at a rate of 4.9 percent, year over, whereas new gTLD domain name registrations have been increasing at a rate of 15.5 percent, year over year.¹⁶ These registrations will no doubt lead to many more domain name disputes.

IV. DOMAIN NAME DISPUTES TODAY

What we think about domain names in 2018 is likely not what we thought about domain names in 1999 when the UDRP was adopted by ICANN. For instance, who would you think would be the owner the domain name, <mercedes.com>? Most would guess that Mercedes-Benz would be the owner, which is correct.¹⁷ There are a few reasons why we would make this assumption, and each of these reasons should be examined. The first reason is that, until now, we have been artificially confined to only a few gTLDs. In addition to <.com>, in the U.S. we may occasionally visit sites in <.net>, <.org>, which may indicate an organization, <.edu>, which indicates an educational institution, and <.gov>, which indicates a governmental entity. That is to say, only a small fraction of the sites we visit give us information in the URL¹⁸ about the nature of the entity that owns the domain name.¹⁹ Most of the sites we visit are located in <.com> where we acquire no clues as to ownership

13. See Isenberg, *supra* note 12.

14. *Total Number of Cases per Year*, *supra* note 12.

15. *Total Number of Domain Names by Year*, WIPO, <http://www.wipo.int/amc/en/domains/statistics/domains.jsp> [<https://perma.cc/WG7T-LYAM>].

16. *The Verisign Domain Name Industry Brief: Q4 2018*, https://www.verisign.com/en_US/domain-names/dnib/index.xhtml [<https://perma.cc/98BX-KYBJ>].

17. The <www.mercedes.com> website redirects to <http://www.mercedes-benz.com/en/>.

18. The Uniform Resource Identifier (“URL”) is a synonym for web address.

19. Although <.com> was intended to indicate a commercial site, it probably conveys nothing to the public today.

from the gTLD.²⁰ Thus, our only clues as to ownership are found in the second level—“mercedes.”

The second reason we might assume that <mercedes.com> is owned by Mercedes-Benz is that at this point <mercedes.com>, for which there can only be only one owner, is the most desirable domain for Mercedes-Benz. We assume the owner to be the trademark owner because legal rights have been created to ensure that <mercedes.com> belongs to Mercedes-Benz. Therefore, we do not assume that the domain name belongs to a girl named Mercedes, which should have been another apparent possibility. The policy to afford trademark owners the rights to domain names that contain their marks was a choice, and the more those rights are successfully asserted, the more we as internet users come to have expectations of corporate ownership.²¹

Trademark owners anticipated that opening up the domain space could create problems for them so they fought for years to stop it, and along the way, they obtained some significant advantages.²² An example is the URS, which is a cheaper and faster version of the UDRP.²³

20. Actually, <.com> was originally created to represent the “commercial” intent of a website. See *Detailed History of .com*, VERISIGN, http://www.verisigninc.com/en_US/domain-names/com-domain-names/what-does-com-mean/index.xhtml [<https://perma.cc/85TB-XR4X>]. However, use of the <.com> suffix is unrestricted, and many non-businesses choose it to register their web pages. As a result, UDRP panels have consistently found that <.com> has no real legal significance because it does not “serve to identify a specific enterprise as a source of goods or services.” See *Adaptec, Inc. v. Sure Source*, WIPO Case No. D2000-1488, Judgment for Complainant, § 6 (Jan. 29, 2001), <https://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1488.html> [<https://perma.cc/FS66-JTEU>] (domain name <adaptec-store.com> transferred to Complainant).

21. According to WIPO statistics, “almost 30% of all cases were settled without a panel decision. Of the remainder, 85% of the panel decisions favored the complainant, while 15% of the complaints were denied, leaving the names in the possession of the registration holder.” *Record Number of Cybersquatting Cases in 2008, WIPO Proposes Paperless UDRP*, WIPO, (March 16, 2009) https://www.wipo.int/tech_trends/en/artificial_intelligence/patentscope.html [<https://perma.cc/Y66G-CVJ5>].

22. A range of “Rights Protection Mechanisms” were established by ICANN. Several of these are “pre-delegation,” meaning they establish objection procedures prior to any new gTLDs being delegated. Chief amongst these is the Legal Rights Objection, administered by WIPO. Under this mechanism, the owner of a registered or unregistered mark can challenge a gTLD application that either takes unfair advantage of the distinctive character or the reputation of their mark, unjustifiably impairs the distinctive character or the reputation of their mark, or otherwise creates an impermissible likelihood of confusion between the gTLD and their mark. Basically, if the applied-for gTLD harms the mark under any theory of trademark law anywhere in the world, the trademark rights trump the gTLD.

23. *New Generic Top-Level Domains: Uniform Rapid Suspension System (URS)*, ICANN, <http://newgtlds.icann.org/en/applicants/urs> [<https://perma.cc/UP94-T5RW>]. The URS is a new-rights protected mechanism designed to provide trademark owners with a faster, cheaper alternative for combating the “most clear-cut cases of [trademark] infringement.” See *id.* A trademark owner can only take advantage of the URS where there are no disputed questions of material fact, and the only

V. DOMAIN NAME POLICY IS NOT TRADEMARK LAW

Simply put, the UDRP enables a trademark owner to prevent registration of a domain name confusingly similar to its mark if it was registered with a bad faith intent to profit. More specifically, the following are the required elements of a complaint:

- i. [the challenged] domain name is identical or confusingly similar to a [common law or registered] trademark or service mark in which the complainant has rights; and
- ii. [the registrant has] no rights or legitimate interest in respect of the domain name; and
- iii. [the] domain name has been registered and is being used in bad faith.²⁴

The policy sets out the ways in which the parties can prove both bad faith and legitimate rights.²⁵ Thus, the focus is not on confusion, dilution, or any harm to the public or to the trademark owner. The critical finding is the bad faith of the registrant.

It should be clear at once that the UDRP does not map on to trademark law.²⁶ But as there is a complete absence of legal standards to invoke in UDRP proceedings, trademark law has, conveniently for trademark owners, become the legal regime to mine for concepts and doctrines. To demonstrate the contrast, consider the basic claims made by trademark owners in trademark and domain name disputes. In the case of a trademark infringement claim, essentially, trademark law requires that a claimant prove that the defendant's use of the mark is likely to confuse the relevant consumer.²⁷ Whether or not consumers will be confused depends on many facts such as who the consumer is, where they are, what they know, what they think, what they see, as well as how the two parties

remedy from the process is suspension of the domain name. Trademark owners need to file a complaint with approved URS providers, such as the National Arbitration Forum. The requirements for the URS complaint are almost identical to the UDRP. For a more detailed explanation, see James L. Bikoff et al., *The Uniform Rapid Suspension System: A New Weapon in the War Against Cybersquatters*, 6 No. 3 LANDSLIDE 32, 33 (Jan.–Feb. 2014).

24. *Uniform Domain Name Dispute Resolution Policy, Mandatory Administrative Proceeding* ¶ 4, ICANN, <https://www.icann.org/resources/pages/policy-2012-02-25-en> [<https://perma.cc/KE7B-99KW>] (approved by ICANN on October 24, 1999).

25. *Id.*

26. Miguel C. Danielson, *Confusion, Illusion and the Death of Trademark Law in Domain Name Disputes*, 6 J. TECH. L. & POL'Y 219, 221 (2001).

27. 15 U.S.C. § 1114(1)(a) (2018); see also 15 U.S.C. § 1125(a)(1)(A) (requiring that use of mark be used in such a way that “is likely to cause confusion, or to cause mistake, or to deceive”).

engage consumers in the marketplace. In other words, the test is not only fact specific, but also highly contextualized, especially in time and place. Trademark rights are therefore not universal; they are territorial and exist place to place. In contrast, domain names *are* universal. They exist everywhere. We have no idea who the public is on the internet, let alone what they know and think. At a minimum, we can expect these attributes to vary from place to place.²⁸

Another significant difference between domain name policy and trademark law is that domain name policy's focus is not on the consumer, as is the case in trademark law, but on the registrant. Specifically, domain name policy is concerned with the registrant's intent. Thus, whereas trademark law's predominant concern for the relevant consumer of the marks leads to the likelihood of confusion doctrine, the domain name policy's concern with the registrant points to the bad faith intent to profit doctrine. What the consumer thinks is simply irrelevant in domain name disputes.

While it is true that a plaintiff in a trademark infringement case may proffer evidence of the defendant's bad faith in using the mark as one of many factors tending towards a finding of likelihood of confusion,²⁹ and a claimant in a domain name case must show "confusing similarity" between its mark and the registered domain name, it nevertheless should be easy enough to keep the doctrines disentangled. However, the language of "confusing similarity" in particular sounds a lot like trademark law, and trademark law-like notions have continued to creep into domain name policy.

The risk is that, in second-generation domain name disputes, confusing similarity will come to be treated more like likelihood of confusion in UDRP cases. This doctrinal slippage poses a danger to domain name policy. To the extent that confusing similarity becomes interchangeable with the likelihood of confusion, suddenly once the first prong in a UDRP case is resolved favor of the claimant, we begin the central analysis with the frame that consumers will likely be deceived by the use of the claimant's property. That conclusion creates a stumbling block to finding that the registrant did not act in bad faith. It is difficult to countenance how the registrant's intent can be anything but bad if it is deceiving consumers through the use of another's property. In other

28. For one, the public speaks different languages in different places.

29. See 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:19 (5th ed. 2018) (listing "the intent of the actor in adopting and using the designation" as a foundational factor in determining likelihood of confusion).

words, if confusing similarity is analyzed as the equivalent of likelihood of confusion, it reduces pressure on the core test in the UDRP.

VI. THE MEANINGLESSNESS OF CONFUSING SIMILARITY

First generation UDRP cases set a very low bar for finding confusing similarity. Despite the words of the policy, in application this standard involves neither “confusion” nor “similarity” as we understand these concepts in trademark law.

The UDRP requires panels to decide a complaint based upon the policy, rules, and “any rules and principles of law that it deems applicable.”³⁰ Neither the policy nor the rules expressly articulate a test for determining “confusing similarity” and panels have employed varied approaches. Some have limited the test to determining the degree of resemblance of the domain name and mark at issue as to appearance.³¹ Others have in addition considered factors such as the distinctiveness of the mark, how well known the mark is, how long the mark has been used, and the nature of the goods and services with which the mark is used.³²

The confusing similarity standard under the UDRP is not the same as the likelihood of confusion standard used in trademark law.³³ The

30. *Rules for Uniform Domain Name Dispute Resolution Policy, Rule 15: Panel Decisions*, ICANN, <https://www.icann.org/resources/pages/rules-be-2012-02-25-en> [<https://perma.cc/93R8-6X93>].

31. *See, e.g., Columbia Insurance Company v. Pampered Gourmet*, WIPO Case No. D2004-0649, Judgment for Complainant, § 6 (Oct. 18, 2004), <https://www.wipo.int/amc/en/domains/decisions/html/2004/d2004-0649.html> [<https://perma.cc/3JPM-RTJ3>] (“Paragraph 4 of the Policy supports the view that confusing similarity should be determined only by the degree of resemblance. This is because Paragraph 4(a) refers only to the identity or confusing similarity of the domain name and mark. In contrast, Paragraph 4(b)(iv) does expressly refer to ‘likelihood of confusion . . . as to the source, sponsorship, affiliation, or endorsement.’ The Panel also finds persuasive the fact that the Policy is intended to be international in scope, which suggests that – absent express language – a panel should be cautious about interpreting the Policy as incorporating a test that may not exist in a number of jurisdictions.”).

32. *Columbia Insurance Company v. Pampered Gourmet*, WIPO Case No. D2004-0649 (Oct. 18, 2004) (“Others, including in the case cited by Complainant, have in addition considered factors such as the distinctiveness of the mark, how well-known the mark is, how long the mark has been used, and the nature of the goods and services with which the mark is used.”), <https://www.wipo.int/amc/en/domains/decisions/html/2004/d2004-0649.html> [<https://perma.cc/U83L-U26E>].

33. *See* David E. Sorkin, *Judicial Review of ICANN Domain Name Dispute Decisions*, 18 SANTA CLARA COMPUTER AND HIGH TECH. L.J. 35, 48 (2001) (“While both standards depend upon the likelihood of confusion, the UDRP makes this determination merely by comparing the domain name with the trademark (or its textual component, in the case of a design mark), whereas the Lanham Act considers the strength of the mark, the manner in which the mark and the domain name are used, and many other contextual fact.”); *see also* Miguel C. Danielson, *Confusion, Illusion and the Death of Trademark Law in Domain Name Disputes*, 6 J. TECH. L. & POL’Y 219, 226 (2001) (noting that

confusing similarity test typically involves a straightforward visual or aural comparison of the trademark with the domain name.³⁴ It often does not include an evaluation of the meaning of the domain name. Likewise, the content of a website (whether it is similar to or different from the business of a trademark holder) is usually disregarded in the assessment of confusing similarity under the first element of the UDRP.³⁵ But in the case of the new gTLD suffixes, the additional information supplied by the suffix will likely be regarded as more than the addition of letters and may be understood as a suggestion of the content of the website associated with that domain name. As a result of this new understanding, the ensuing analysis will begin to approximate the likelihood of confusion standard and will thus extend the UDRP beyond its anticipated limits.

The principle way that the bar has been lowered by the rules is that the addition of words to the trademark in the domain name are to be disregarded in assessing confusing similarity. For example, <pepsistrategy.com> was held to be confusingly similar to PEPSI.³⁶ Under this logic, DELTA AIRLINES and DELTA FAUCETS would be judged to be confusingly similar.

A large number of UDRP panels have thus held that a domain name that consists of a trademark plus a negative or pejorative term may nonetheless be considered confusingly similar to the trademark.³⁷ For

many of the trademark infringement “likelihood-of-confusion” factors would have an “odd fit” in the domain name context.). *But see* WIPO Overview 2.0, *supra* note 4 (“The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the domain name itself to determine *likelihood of Internet user confusion*.”) (emphasis added).

34. MCGRADY, *supra* note 4.

35. WIPO Overview 2.0, *supra* note 4 (“The content of a website (whether it is similar to or different from the business of a trademark holder) would usually be disregarded in the threshold assessment of risk of confusing similarity under the first element of the UDRP, although such content may be regarded as highly relevant to assessment of intent to create confusion. . . .”).

36. PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS), WIPO Case No. D2003-0696, Judgment for Complainant, § 6 (Oct. 28, 2003), <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0696.html> [<https://perma.cc/S95E-7NN8>]. *See also* MCCARTHY, *supra* note 29, § 25:78 (“If a hypothetical cybersquatter registers the domain name jester.com and makes no use of it except to offer to sell it for \$10,000 to the plaintiff who owns the hypothetical MY JESTER mark for children’s toys, this would probably be adjudged to satisfy the confusingly similar requirement . . .”). *But see* MCCARTHY *supra* note 29, § 25A:51 (“While the hypothetical domain name <fordtrucks.com> would be confusingly similar to the FORD mark of the Ford Motor Co., the domain name <fordstheatre.org> used for a web page of Ford’s Theatre in Washington, D.C. would probably not be confusingly similar because it would convey a different meaning.”).

37. WIPO Overview 2.0, *supra* note 4, ¶ 1.3 (“Generally, a domain name consisting of a trademark and a negative or pejorative term (such as <[trademark]sucks.com>) would be considered confusingly similar to the complainant’s trademark for the purpose of satisfying the standing requirement under the first element of the UDRP. . . .”); *Id.* at 112–114. *But see* Lockheed Martin v.

example, in *Piab AB v. EDCO USA*, the panel found that “that the word ‘quit’ is pejorative in meaning . . . [and] a pejorative phrase added to a registered trademark is likely to result in a confusingly similar domain name.”³⁸ Likewise, <gomopacrime.com> was found to be confusingly similar with the trademark GOMOPA because “the pejorative word ‘crime’ [was] not capable of distinguishing the disputed domain name from the Complainant’s trademark.”³⁹

Based on a similar reasoning, some UDRP panels have held that a domain name that includes two separate marks owned by two unaffiliated entities is nevertheless confusingly similar to either mark, apparently under the conjecture that the presence of the other mark could be disregarded. For example, the panel held that a domain comprised of the marks of two competitors was nonetheless confusingly similar to just one of the marks.⁴⁰

All of these approaches involve disregarding additional words. In contrast, when the registrant has added generic words that correspond with the business conducted under the mark by the complainant, the inclusion of such words has been judged to enhance the possibility of confusion.⁴¹ For example, in *Ansell Healthcare Products Inc. v.*

Dan Parisi, WIPO Case No. D2000-1015, Complaint Denied, § 6 (Jan. 26, 2001), <https://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1015.html>

[<https://perma.cc/N5C4-G3KF>] (“Both common sense and a reading of the plain language of the Policy support the view that a domain name combining a trademark with the word ‘sucks’ or other language clearly indicating that the domain name is not affiliated with the trademark owner cannot be considered confusingly similar to the trademark.” There was a dissent, arguing that adding gripe “suck” should be considered confusingly similar.)

38. *Piab AB v. EDCO USA Inc.*, WIPO Case No. D2002-0059, Judgment for Complainant, § 6 (Mar. 13, 2002), <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0059.html> [<https://perma.cc/EEM5-RJFK>] (finding the domain names <quitpiab.com> and <quitpiab.net> were confusingly similar with the PIAB trademark); *see* WIPO Jurisprudential Overview 3.0, § 1.13 (2017), <http://www.wipo.int/amc/en/domains/search/overview3.0/> [<https://perma.cc/H8YN-RRUT>] (“A domain name consisting of a trademark and a negative or pejorative term . . . is considered confusingly similar to the complainant’s trademark for the purpose of satisfying standing under the first element. The merits of such cases, in particular as to any potential fair use, are typically decided under the second and third elements.”).

39. *Goldman Morgenstern & Partners Consulting LLC v. DomainsByProxy LLC*, WIPO Case No. D2015-1877, Judgment for Complainant, § 6 (Jan. 8, 2016), <http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2015-1877> [<https://perma.cc/CW3L-7G2A>].

40. *F. Hoffmann-La Roche AG v. P. Martin*, WIPO Case No. D2009-0323, Judgment for Complainant, § 6 (May 15, 2009), <https://www.wipo.int/amc/en/domains/decisions/html/2009/d2009-0323.html> [<https://perma.cc/YA7B-LWAK>] (domain name <alli-xenical.com> transferred to Complainant where domain registrant included an additional word, “alli,” which was actually the competitor of the complainant’s trademark XENICAL).

41. MELISE R. BLAKESLEE, *INTERNET CRIMES, TORTS, & SCAMS: INVESTIGATIONS AND REMEDIES* 91 (2d ed. 2012) (“Confusion is particularly likely where registrant has added a word to complainant’s trademark that is related to services offered by complainant.”).

Australian Therapeutics Supplies Pty., Ltd., <ansellcondoms.com> was found to be confusingly similar to the mark ANSELL because “the term describe[d] the Complainant’s products, [and] the addition of ‘condoms’ [was] more likely to increase confusion.”⁴² Further, in a case involving <ebaymoving.com>, the panel also found that the addition of “moving” was “likely to give rise to confusion because it points to a field of goods and services in which Complainant’s mark is actually used.”⁴³

VII. DOMAIN NAME DISPUTES TOMORROW

Second generation UDRP disputes involving new gTLDs present an even more alluring invitation to muddle the doctrines, but also a new opportunity to clarify confusing similarity. In the first-generation cases, a general rule had developed to disregard the gTLD in the evaluation of confusing similarity.⁴⁴ That is, confusing similarity was evaluated only in

42. *Ansell Healthcare Prods. Inc. v. Australian Therapeutics Supplies Pty., Ltd.*, WIPO Case No. D2001-0110, Judgment for Complainant, § 6 (Apr. 2, 2001), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0110.html> [<https://perma.cc/YPT9-GW5V>].

43. *eBay Inc. v. ebayMoving / Izik Apo*, WIPO Case No. D2006-1307, Judgment for Complainant, § 6 (Jan. 31, 2007), <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-1307.html> [<https://perma.cc/S35S-L73T>] (“It is a well-established principle that descriptive or generic additions to a trademark, and particularly those that designate the goods or services with which the mark is used, do not avoid confusing similarity of domain names and trademarks. . .”).

44. WIPO Overview 2.0, *supra* note 4, Introduction, ¶ 1.2 (The WIPO “Overview of Panel Views on Selected UDRP Decisions” is a description of the “consensus” views of UDRP panels on issues that commonly arise in UDRP cases. It is based on a review of approximately 20,000 UDRP disputes WIPO has administered through 2011, and it is designed to assist awareness of panel views on certain questions that commonly arise in proceedings under the UDRP. The WIPO Overview 2.0, at paragraph 1.2 states: “The applicable top-level suffix in the domain name (e.g., ‘.com’) would usually be disregarded under the confusing similarity test (as it is a technical requirement of registration), except in certain cases where the applicable top-level suffix may itself form part of the relevant trademark.”); 1 MCCARTHY, *supra* note 29, § 7:17.50 (“the Top Level Domain indicator ‘.com’ (or any of the other top level domain indicators) adds nothing to the distinctiveness of the designation as a trademark or service mark. . . The author agrees that a top-level domain designation has no ability to distinguish one source from another and thus, has no trademark significance. Such a top-level domain indicator has no source indicating significance and cannot serve any trademark purpose. The same is true of other nondistinctive modifiers used in domain names, such as ‘http://www’ and ‘html.’ The PTO analogizes a TLD to a nondistinctive part of a telephone number such as the ‘800’ part of a toll free telephone number. The average person that uses the Internet is aware of the standard format for a domain name and knows that the designations ‘http,’ ‘www,’ and a TLD like ‘.com’ are a part of every Internet domain name and identifier. Thus, the TLD ‘.com’ functions in the world of cyberspace much like the generic indicators ‘Inc.,’ ‘Co.,’ or ‘Ltd.’ placed after the name of a company.”); 2 GILSON et al., *supra* note 4, § 7A.06 (“Panels generally ignore the gTLD portion of the domain name (e.g., .com, .net or .org) when making a comparison between the domain name and the trademark at issue.”); MCGRADY, *supra* note 4 (“Historically, in both ACPA and UDRP analysis, judges and panelists have disregarded the top level domain name in confusion analysis.”); BLAKESLEE, *supra* note 41 (the addition of a top-level domain does not distinguish a

the second level of the domain name. Thus, the comparison is not <mercedes.com> vs. MERCEDES, but instead is “mercedes” vs. “mercedes.”

The issue is the potential impact of the gTLD suffix when considering whether the domain name is confusingly similar to the protected mark. Historically, UDRP cases have looked primarily at the second-level portion of a disputed domain name. There is, however, no blanket rule that panelists must ignore the gTLD suffix in such assessment.

The new feature in second-generation UDRP disputes is that the gTLD will likely not be content free as in the case of <.com>. For instance, if the challenged domain is <mercedes.car>, UDRP panelists may choose not to disregard the gTLD in their evaluation of confusing similarity. The gTLD could also be something like <.name>, or <.girlsname>, or <.spanishgirlsname>. In these latter instances, there is much less reason for the public to assume that any of these domain names are owned by Mercedes-Benz. But what about <mercedes.email>? This example presents ambiguity, but it also presents an attractive domain name for both Mercedes-Benz and our hypothetical girl named Mercedes.

These are very live questions. Approximately 60% of the new gTLDs are comprised of generic words.⁴⁵ Remarkably, ICANN seems not to have

domain name from a trademark); *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1055 (9th Cir. 1999) (discounting the <.com> in <moviebuff.com>); *Image Online Design, Inc. v. Core Ass’n*, 120 F. Supp. 2d 870, 878 (C.D. Cal. 2000) (“Not once has any court imputed trademark rights to a gTLD. In fact, rather than look at a gTLD to determine trademark rights, the Ninth Circuit and others ignore the TLD as though it were invisible next to the second level domain name in an infringement action.”); *Ceritler Bilgi Hizmetleri Ltd.Sti., Mr.Ali Nabi Cerit v. Arif Cerit, Ceritler Konfeksiyon San. Ve Tic.Ltd.Sti*, WIPO Case No. D2008-1339, Complaint denied, § 6 (Nov. 18, 2008) <https://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-1339.html> [<https://perma.cc/4RE2-BMP8>] (“Panels disregard the top-level domain name suffix in evaluating whether a respondent’s domain name is identical or confusingly similar to a complainant’s marks.”); *BHP Billiton Innovation Pty. Ltd., BMA Alliance Coal Operations Pty. Ltd. V. Cameron Jackson*, WIPO Case No.D2008-1338, Judgment for Complainant, § 6 (November 24, 2008), <https://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-1338.html> [<https://perma.cc/9AFE-R7GR>] (domain name <auriasdiamonds.info> transferred to Complainant; gTLDs are not part of the confusingly similar analysis); *Espire Infolabs Pvt. Ltd. V. TW Telecom*, WIPO Case No.D2010-1092, Complaint Denied, § 6 (Aug. 9, 2010) <https://www.wipo.int/amc/en/domains/search/text.jsp?case=d2010-1092> [<https://perma.cc/CNE7-CKSG>] (<espire.com>, Denial (TLD <.com> is generally not a distinguishing element); *L’Oréal S.A. v. Lianfa*, WIPO Case No. DPW2014-0003, Judgment for Complainant, § 6 (Apr. 25, 2014), <https://www.wipo.int/amc/en/domains/decisions/text/2014/dpw2014-0003.html> [<https://perma.cc/HQR2-RACN>] (<lorealchina.pw>, Transfer (<.pw> had no legal significance because it was “technically required to operate the domain name.”)).

45. Eleanor M. Lackman, *Getting a Handle on the New Generic Top-Level Domains: Strategies for Brand Protection in the Era of New gTLDs*, COWAN, DEBAETS, ABRAHAMS &

anticipated this issue as it had not offered any guidelines on how to deal with this new feature. Unsurprisingly, the first decided dispute incorporating a new gTLD posed this very question.

The first dispute involving a new gTLD was over the domain name <canyon.bike> and the complainant owned the trademark CANYON for bicycles. The panel wasted no time cogitating, and simply declared that the gTLD would be included in the evaluation of confusing similarity:

The Panel finds that, given the advent of multiple new gTLD domain names, panels may determine that it is appropriate to include consideration of the top-level suffix of a domain name for the purpose of the assessment of identity or similarity in a given case, and indeed that there is nothing in the wording of the Policy that would preclude such an approach.⁴⁶

Here the gTLD was seen to enhance the similarity, especially since the word “canyon” could otherwise be understood as a generic term.

Subsequent panels have followed this approach.⁴⁷ Noting that the gTLD suffix is typically disregarded in the confusing similarity analysis, other panels faced with similar facts have concluded the information within the gTLD suffix augmented the similarity. For example, a UDRP panel found <porsche.cars> to be confusingly similar to PORSCHE “given that the Complainant’s business is making Porsche cars.”⁴⁸

SHEPPARD LLP (Aug. 12, 2014), <http://cdas.com/brandprotection-new-gtlds/> [<https://perma.cc/5FAF-PQLP>].

46. Canyon Bicycles GmbH v. Domains by Proxy, WIPO Case No. D2014-0206, Judgment for Complainant, § 6 (Mar. 14, 2014) <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2014-0206> [<https://perma.cc/WDK7-93FV>] (<canyon.bike>, Transferred; finding that <.bike> only exacerbated the confusing similarity); *see also* project.me GmbH v. Alan Lin, WIPO Case No. DME2009-0008, Complaint Denied, § 6 (Nov. 11, 2009), <https://www.wipo.int/amc/en/domains/decisions/html/2009/dme2009-0008.html> [<https://perma.cc/639M-4Y2L>] (<project.me>, Denial; recognizing that, *in appropriate cases*, the Panel should consider the domain name as a whole when determining confusing similarity, especially when the gTLD has “legal significance”).

47. Zions Bancorporation v. Mohammed Akik Miah, WIPO Case No. D2014-0269, Judgment for Complainant, § 6 (Apr. 12, 2014), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2014-0269> [<https://perma.cc/M4SB-C3D3>] (finding <zionsbank.holdings> confusingly similar to the Complainant’s ZIONS BANK mark); JA Apparel Corp. v. farris nawas, Claim Number: FA1404001553753 (Apr. 28, 2014) (Nat’l Arbitration Forum), <http://domains.adrforum.com/domains/decisions/1553753D.htm> [<https://perma.cc/G4DS-4HUT>] (“The Domain Name, <josephabboud.clothing> is identical to Complainant’s JOSEPH ABOUND marks since it includes the exact wording of the registered trademarks. The generic word “clothing” which serves as a gTLD does not distinguish the Domain Name. Moreover, it rather increases risk of confusion – Complainant’s trademarks were registered in connection with clothing.”).

48. Dr. Ing. h.c. F. Porsche AG v. Domains By Proxy, LLC / Deng Weikang, Dengweikang, WIPO Case No. D2017-0362, Judgment for Complainant, § 6 (Apr. 24, 2017),

Without citing any previous panel decisions, this panel stated that “[p]revious panels have consistently held that a disputed domain name that consists merely of a complainant’s trademark and an additional term that closely relates to and describes that complainant’s business is confusingly similar to that complainant’s trademarks.”⁴⁹

VIII. DOCTRINAL PRECISION

In U.S. trademark law, confusing similarity is a single factor in the multi-factor test for the likelihood of confusion.⁵⁰ That is, confusing similarity is in aid of the ultimate question of whether confusion is likely and asks if the similarity of the marks supports such a conclusion. Within this factor is a trilogy of similarities that must be examined: appearance, sound, and meaning.⁵¹ Thus, in U.S. trademark law, confusing similarity involves more than a straightforward side-by-side comparison of the visual and auditory similarities; significantly, it requires an inquiry into the likely perceived meaning of the marks involved.⁵² And the determination of meaning is also not straightforward “[s]ince likelihood of confusion is judged by considering marketplace realities, the relevant meaning of a word is the one it will have to prospective purchasers, not to semanticists or experts.”⁵³ That is, evidence of the context in which a mark is used is probative of the significance which the mark is likely to project.⁵⁴

For example, are the marks GULP and GULPY confusingly similar? If we were to compare only the appearance and sound of the marks, we would conclude that they are confusingly similar. However, when we consider the market context of the uses of the marks, we may conclude

<https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2017-0362> [<https://perma.cc/F4KE-NSTU>].

49. *Id.*

50. *See* Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492, 495 (2d Cir. 1961) (determining that a likelihood of confusion demands an evaluation of eight non-exclusive factors).

51. 5 LOUIS ALTMAN & MALLA POLLACK, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS & MONOPOLIES § 21:19 (4th Ed. 2014) (“The mark’s effects on the eye, on the ear, and on the mind often differ from each other, depending upon the character of the words in issue.”).

52. Streetwise Maps, Inc. v. Vandam, Inc., 159 F.3d 739, 744 (2d Cir.1998) (the inquiry does not end with a comparison of the marks themselves, but in determining whether two marks are confusingly similar, one must “appraise ‘the overall impression created by . . . the context in which they are found and consider the totality of factors that could cause confusion among prospective purchasers.’”).

53. 2 ALTMAN et al., *supra* note 47.

54. Lang v. Retirement Living Publ’g Co., 949 F.2d 576, 581 (2d Cir.1991) (“In [determining whether marks are confusingly similar], a court should look at the general impression created by the marks, taking into account all factors that potential purchasers will likely perceive and remember.”).

that the difference in meaning of the marks is sufficient to conclude that the marks are not confusingly similar. In this case, GULP was used for fountain drinks, whereas GULPY was used for pet drinking dishes. When GULPY is considered in the context of a portable animal water dish, it suggests a puppy drinking water from a bowl or even a pet's name. Consequently, the marks were found to create different commercial impressions.⁵⁵

Even the comparison of visual similarities is not straightforward under the confusing similarity factor in the likelihood of confusion test. In an infringement analysis, the marks will not be compared as two words typed in the same font because that is not how the relevant consumer will encounter them. Instead, they will be compared as they appear in a marketplace context.⁵⁶ That is, a consideration of the marks' similarities will take into account the entire commercial presentation made to the relevant consumer including font, color, stylization, packaging, the use of a house mark, etc. Thus, in a trademark case, the court will not simply compare the visual similarities between the words but will engage in a much more complex analysis. For instance, when considering whether DENTYNE ICE and ICE BREAKERS are confusing similar, the court made the following findings:

[T]he parties present their marks in starkly different typefaces and styles. Moreover, although the packages for DENTYNE ICE and ICE BREAKERS share a generally rectangular shape, there are salient differences in both their dimensions and overall look that result in distinctly different commercial impressions. The DENTYNE ICE package is noticeably longer and wider than the ICE BREAKERS package. And the DENTYNE ICE package is boxy and flat relative to the ICE BREAKERS package, which has a traditional, brick-like shape. Further, although both packages use blue and white colors, the shades and patterns of these colors are different. The front panel of the DENTYNE ICE package has a light-blue background broken by a thick, dark-blue band and two smaller white bands. Nabisco's package, on the other hand, has a homogenous, metallic-blue background broken only by the ICE BREAKERS mark itself. Further still, the wrapping used on the respective packages is dissimilar. ICE BREAKERS comes in a holographic wrapper, while DENTYNE ICE is sold in a non-holographic, foil-sealed blister pack with a cardboard overwrap. Finally,

55. 7-Eleven, Inc. v. Wechsler, 83 U.S.P.Q.2d 1715, 1726 (T.T.A.B. May 15, 2007).

56. Jim Beam Brands Co. v. Beamish & Crawford Ltd., 937 F.2d 729, 735 (2d Cir.1991) (“[I]n determining the similarity of marks in an infringement action, a court *must examine the visual appearance of each mark in the context of its use.*”) (emphasis added).

the products are sold in different forms: DENTYNE ICE as a candy-coated pellet and ICE BREAKERS as a traditional stick.⁵⁷

The meaning prong of the confusing similarity trilogy in trademark law has been omitted from the confusing similarity analysis under the UDRP. UDRP panels routinely conclude that the addition of letters or even words to the trademark in the domain name should be disregarded in assessing confusing similarity because they amount to only slight visual differences.⁵⁸ This principle is unambiguous about ignoring meaning. As a result, the doctrine that goes by the same name in trademark law and domain name policy leads to different results. GULP and GULPY, for instance, would be judged to be confusingly similar under a UDRP analysis, but may not be confusingly similar under a trademark analysis.

As a result of more recent decisions involving new gTLDs, UDRP panels are now assessing confusing similarity in one of two ways. Either they are disregarding the gTLD suffix, in which case they are overtly omitting the meaning portion of the confusing similarity trilogy,⁵⁹ or they are considering the gTLD suffix, in which case they are purporting to evaluate the meaning of the suffix.⁶⁰ However, even when a UDRP panel purports to evaluate the meaning of a suffix, it does so in a manner that is unavoidably flawed.

The inquiry into meaning begs for an examination of the context of use. It is conspicuous that UDRP determinations, unlike infringement determinations, do not include a full-blown analysis of the use of the mark in the commercial marketplace. That is, UDRP panels typically do not

57. *Nabisco, Inc. v. Warner-Lambert Co.*, 220 F.3d 43, 47–48 (2d Cir. 2000) (finding DENTYNE ICE and ICE BREAKERS not to be confusingly similar).

58. 5 MCCARTHY, *supra* note 28, § 25A:51 (“The addition in the accused domain name of generic or descriptive matter to the mark will usually not prevent a finding of confusing similarity.”); BLAKESLEE, *supra* note 41 (“Slight differences between domain names and registered marks, such as the addition of minor or generic words to a trademark, are irrelevant in assessing confusing similarity.”); *Hachette Filipacchi Presse v. Vanilla Limited/Vanilla Inc./Domain Finance Ltd.*, WIPO Case No. D2005-0587, Denial in Part, § 6 (Sep. 30, 2005), <https://www.wipo.int/amc/en/domains/decisions/html/2005/d2005-0587.html> [<https://perma.cc/ZX37-2J5N>] (<naturelle.com> *inter alia*, Transfer, with Denial in Part; addition of generic words to the mark in the domain name do not avoid a finding of confusing similarity).

59. *See, e.g.*, 5 MCCARTHY, *supra* note 28, § 25A:24 (“Application of the confusing similarity test under the UDRP would typically involve a straightforward visual or aural comparison of the trademark.”) (quoting WIPO Overview of WIPO Panel Views on Selected UDRP Decisions, Second Edition ¶ 1.2).

60. *See, e.g., id.* § 25A:51 (“In the cybersquatting context, ‘confusingly similar’ means that the plaintiff’s mark and the defendant’s domain name are so similar in sight, sound or meaning that confusion is likely.”); BLAKESLEE, *supra* note 41 (“Under the ACPA, confusing similarity simply means that the plaintiff’s mark and the defendant’s domain name are so similar in sight, sound, and meaning that they could be confused.”)

consider other likelihood of confusion factors that reveal context of use such as the proximity of the parties' goods or services, marketing channels, or the sophistication of the consumer.⁶¹ But even within the factor of confusing similarity in the likelihood of confusion test, the inquiry into meaning requires some consideration of the context of the use.

Under this new approach that considers gTLD suffixes, how would <mercedes.red> fare? Is <ferrari.red> an easier case? Since the iconic Ferrari is red, perhaps as with <canyon.bike>, a panel would find that the meaning of the gTLD enhances the confusing similarity. But this raises the question of how meaning should be determined. In Spanish, "red" means network. Thus, it is certainly possible that Spanish speakers might assume that the domain name <ferrari.red> was associated with a site for the Ferrari enthusiast community. To reach such a conclusion, a panel would have to take into account the context of the domain name.

The determination of meaning in a UDRP case is necessarily flawed because domain names often do not have a context that may be considered. The potential audience for a domain name is the universal public. This public has no particular language, age, gender, sophistication, or familiarity with any particular information other than that which is universally known. UDRP panels may take into account the goods or services that trademarks are used with. In contrast, in the case of registered domain names, many have no operational websites and there is no requirement to indicate a proposed use of the domain name. And even if there is an associated website, most panels have stated that it is irrelevant whether consumers could avoid confusion by viewing the content of respondent's website.⁶² That is, the content of a website would usually be

61. See Gerald M. Levine, *UDRP is Niche Forum for Cybersquatting, Not Trademark Infringement*, IPLEGALCORNER (Dec. 5, 2015), <http://iplegalcorner.com/udrp-is-niche-forum-for-cybersquatting-not-trademark-infringement/> [<https://perma.cc/FA6E-DTCR>] ("In the UDRP the term is limited to a side-by-side comparison of the domain name and mark, whereas under the Lanham Act the term refers to the marketing and use factors usually considered in traditional infringement actions.").

62. Harry Winston Inc. and Harry Winston S.A. v. Jennifer Katherman, WIPO Case No. D2008-1267, Complaint Denied, § 6 (Oct. 18, 2008) <https://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-1267.html> [<https://perma.cc/7ABF-7CSV>] ("[I]t is now well-established that the content of the Respondent's website is an irrelevant factor when assessing confusing similarity under the first element of the Policy. The test is to be conducted by way of a side-by-side comparison of the Complainants' trade mark and the Domain Name. As the WIPO Overview of WIPO Panel Views on Selected UDRP Questions puts it (paragraph 1.2):

The content of a website (whether it is similar or different to the business of a trademark owner) is irrelevant in the finding of confusing similarity. This is because trademark holders often suffer from "initial interest confusion", where a potential visitor does not

disregarded in the threshold assessment of risk of confusing similarity under the first element of the UDRP.⁶³ This is because the UDRP test simply does not contemplate a comparison of the proximity of the goods and services of the parties.⁶⁴ Finally, the UDRP contemplates a quick and streamlined arbitration procedure: there is no discovery or opportunity to develop much of a factual record. For all of these reasons, an investigation into the meaning of a domain name in a UDRP case will never mirror a trademark infringement analysis.

To illustrate this point, consider two words that are visually and audibly dissimilar but are similar in meaning. Although these facts could result in a trademark infringement, they should not result in a UDRP transfer because the mark owner does not fulfill the standing requirement.

Given the inevitable divergence in the analysis of confusing similarity under trademark law and the UDRP, it is unfortunate that the

immediately reach their site after typing in a confusingly similar domain name, and is then exposed to offensive or commercial content. The test for confusing similarity should be a comparison between the trademark and the domain name to determine the likelihood of confusion.

63. 5 MCCARTHY, *supra* note 29, § 25A:51 (“It is irrelevant under the ACPA that confusion about a web site’s source or sponsorship could be resolved by visiting the web site identified by the accused domain name.”); BLAKESLEE, *supra* note 41 (“The fact that confusion about a website’s source or sponsorship could be resolved by visiting the website is not relevant to whether the domain name itself is identical or confusingly similar to a plaintiff’s trademark.”); SoftCom Technology Consulting Inc. v. Olariu Romeo/Orv Fin Group S.L., WIPO Case No. D2008-0792, Judgment for Complainant, § 6 (July 8, 2008) <https://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-0792.html> [<https://perma.cc/Q44W-SQQ7>] (Domain <myhostingfree.com> transferred to complainant. Confusing similarity only examines whether the letter string of the domain name is confusingly similar to the letter string of the trademark, devoid of marketplace factors. Panel explicitly addresses that it does not look at mental reaction of Internet users to the domain name); Harry Winston Inc. and Harry Winston S.A. v. Jennifer Katherman, WIPO Case No. D2008-1267, Complaint Denied, § 7 (Oct. 18, 2008), <https://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-1267.html> [<https://perma.cc/SE7J-N4Q2>] (Although such content may be regarded as highly relevant in the assessment of intent to create confusion under subsequent elements (i.e., rights or legitimate interests and bad faith)).

64. 5 MCCARTHY, *supra* note 29 (“Because the ACPA states that liability is ‘without regard to the goods or services of the parties,’ the analysis is a shortened one compared to the usual likelihood of confusion analysis of the typical trademark dispute, which factors in differences between the goods or services of the disputing parties.”) (discussing the test under the ACPA, which in this regard is identical to the UDRP); Pfizer Inc. v. BargainName.com, WIPO Case No. D2005-0299, Judgment for Complainant, § 7 (Apr. 28, 2005), <https://www.wipo.int/amc/en/domains/decisions/html/2005/d2005-0299.html> [<https://perma.cc/UA5B-MJYF>], Disney Enterprises, Inc. v. John Zuccarini, Cupcake City and Cupcake Patrol, WIPO Case No. D2001-0489, Judgment for Complainant, § 7 (June 19, 2001), <https://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0489.html> [<https://perma.cc/Q8UJ-X2J5>]; IKB Deutsche Industriebank AG v. Bob Larkin, WIPO Case No. D2002-0420, Complaint Denied, § 7 (July 23, 2002), <https://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0420.html> [<https://perma.cc/X9VH-CXPP>].

phrase “confusing similarity” was used at all in the UDRP. A more accurate description of the level of analysis contemplated in the UDRP would have been better captured by the phrase “substantially similar” from copyright law.⁶⁵

Based on the rationale supplied by panels as well as the analysis possible within the confines of the UDRP, it seems that the confusing similarity standard seeks to discern not whether the similarity is such that confusion would follow, but simply whether the mark is recognizable within the domain name.⁶⁶ This standard is consistent with the rule that even where a registrant adds an entire word or words to the trademark, it may still be confusingly similar. In *Hachette Filipacchi Presse v. Vanilla Limited/Vanilla Inc/Domain Finance Ltd.*, the panel found that 171 of 172 complained of domain names that included one of the complainant’s marks, such as ELLE and a generic word, either preceding, following, or surrounding the mark, were confusingly similar.⁶⁷ The only domain name that the panel found not to be confusingly similar was <naturelle.com> in which “natur” was added to the trademark ELLE. In that instance, the panel concluded that the mark was not recognizable within the domain name.

A better way of stating the relevant inquiry may be, Does the domain name point to the trademark owner? In the case of either <targetsucks.com> or <target.sucks>, one would have to answer that, yes, the trademark TARGET is still recognizable and the domain names point to the trademark owner. In contrast, in the case of <targetpractice.com> or <target.guns>, the trademark is no longer recognizable even though it is reproduced exactly within the domain name. The domain name no longer points to the trademark owner but instead suggests the generic meaning of “target.” The only way to arrive at this conclusion, however, is to evaluate meaning of the entire domain name.

65. 1 WILLIAM C. HOLMES, INTELLECTUAL PROPERTY AND ANTITRUST LAW § 4:15 (2018).

66. 5 MCCARTHY, *supra* note 29, § 25A:24 (in order to be actionable “the relevant trademark would generally need to be recognizable as such within the domain name. . . .”) (quoting WIPO Panel Views on Selected UDRP Decisions, Second Edition).

67. *Hachette Filipacchi Presse v. Vanilla Limited/Vanilla Inc/Domain Finance Ltd.*, WIPO Case No. D2005-0587, Denial in Part, § 6-7 (Sep. 30, 2005), <https://www.wipo.int/amc/en/domains/decisions/html/2005/d2005-0587.html> [<https://perma.cc/J8DS-PVTS>] (For instance, <ellegarcon.com>, <ellehomme.com>, <ellemonde.com>, <ellemusique.com>, and <ellenoir.com> were each found to be confusingly similar. The panel cancelled all of the domain names except <naturelle.com>. “The majority of the Panel finds that the additions and deductions of generic words to the different marks, do not alter the fact that the domain names are confusingly similar to the marks.”).

Disputes involving trademarks that are generic terms present a challenge in determining confusing similarity. Some panels have held that the whole incorporation of a complainant's mark may be sufficient to establish confusing similarity.⁶⁸ As a result, the domain name <unofficialblackberrystore.com> was found to be confusing similar to BLACKBERRY.⁶⁹ At least this domain name points to the trademark owner, even though the domain name effectively communicates, "we are *not* the trademark owner." In other cases where a generic trademark is combined with another generic word, such as BLACKBERRY combined with "shots," for example, the resulting domain name does not appear to reference the trademark owner. Yet such domain names have also been held to be confusingly similar.⁷⁰ So <unofficialblackberrystore.com> and <blackberryshots.com> are both found to be confusingly similar to BLACKBERRY. The panel that decided <blackberryshots.com> was confusingly similar to BLACKBERRY also decided that <blackjackberry.com> and <obamaberry.com> were confusingly similar to BLACKBERRY. That panel, however, did find an endpoint to this reasoning. Finding that the complainant's BERRY mark to be "not highly distinctive," it ruled that when combined with a generic word that did not suggest a connection with the complainant, it was not confusingly similar.⁷¹ Thus, <hisberry.com> and curiously <berrynegro.com> were found not to be confusingly similar because these combinations of generic words were not "evocative of the nature of the complainant's business."⁷² It is not clear why this reasoning did not apply in the case of <blackberryshots.com>.

X. CONFUSING SIMILARITY AND CONFUSION IN LEGAL RIGHTS OBJECTIONS

A search of places in which the phrase "confusing similarity" is used by ICANN produces more uncertainty about the intended meaning. The

68. *Research in Motion Limited v. One Star Global LLC*, WIPO Case No. D2009-0227, Judgment for Complainant, § 6 (Apr. 9, 2009), <https://www.wipo.int/amc/en/domains/decisions/html/2009/d2009-0227.html> [<https://perma.cc/B4P8-HR9P>] (Domain name <unofficialblackberrystore.com> transferred to Complainant).

69. *Id.*

70. *Research in Motion Limited, v. Georges Elias*, WIPO Case No. D2009-0218 Judgment for Complainant, § 6-7 (Apr. 27, 2009), <https://www.wipo.int/amc/en/domains/decisions/html/2009/d2009-0218.html> [<https://perma.cc/A4K7-2YWC>] (Moreover, using BLACKBERRY in its plural form did not alleviate the confusing similarity so that <blackberriesonblondes.com> was also found to be confusingly similar.).

71. *Id.*

72. *Id.*

Generic Names Supporting Organization (GNSO), a sub-group within ICANN, drafted the policy to implement the New gTLD Program.⁷³ The policy included a number of recommendations on what the constraints were on what could be applied for as a new gTLD. Among these was a prohibition on strings that are “confusingly similar” either to existing top-level domains or to existing trademarks.⁷⁴

In this context, there is evidence that the GNSO appreciated the doctrinal difference posed by the use of “confusing similarity” in the domain name space:

There are two other key concepts within this recommendation. The first is the issue of “confusingly similar” and the second “likelihood of confusion”. There is extensive experience within the Committee with respect to trademark law and the issues found below have been discussed at length, both within the Committee and amongst the Implementation Team.⁷⁵

According to WIPO, however, the prescribed standard would be met when “the string comprising the potential new gTLD infringes the existing legal rights of others that are recognizable as enforceable under the generally accepted and internationally recognized principles of law.”⁷⁶ The approach envisioned by WIPO therefore approximates trademark law’s likelihood of confusion.

WIPO announced that in determining legal rights objections, panels would use “generally accepted and internationally recognized principles of law.”⁷⁷ This language suggests a high standard of consensus on applicable legal principles. However, the gTLD Applicant Guidebook 3.5.2, states that infringement would be found if an applied for string: “takes unfair advantage of the distinctive character or the reputation of the objector’s [mark]”; “unjustifiably impairs the distinctive character . . . of the objector’s mark”; or “otherwise creates . . . confusion between the

73. *Generic Names Supporting Organisation, Final Report, Introduction of New Generic Top-Level Domains*, ICANN (August 8, 2007), <http://gnso.icann.org/en/issues/new-gtlds/pdp-dec05-fr-part-a-08aug07.htm> [<https://perma.cc/YR4C-FYEN>].

74. *Id.* (Recommendation 2: “Strings must not be confusingly similar to an existing top-level domain.” Recommendation 3: “Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law.”).

75. *Id.* (excerpt taken from Recommendation 2 Discussion).

76. GTLD APPLICANT GUIDEBOOK, NEW GTLD DISPUTE RESOLUTION PROCEDURE, P-2–P-3 (2012), <https://newgtlds.icann.org/en/applicants/agb/guidebook-full-11jan12-en.pdf> [<https://perma.cc/XAT3-CDN2>].

77. *Id.*

applied-for gTLD and the [registered] mark.”⁷⁸ This legal standard, however, does not reflect any international treaty provision and is not consistent with U.S. trademark law. To assist the application of this proposed test, the Guidebook offers eight non-exclusive factors to consider. The first factor is “[w]hether the applied-for gTLD is identical or similar, including in appearance, phonetic sound, or meaning, to the objector’s existing mark.”⁷⁹ And the eighth factor is “[w]hether 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.”⁸⁰ These factors make it apparent that the use of the phrase “confusingly similar” as the basis of a legal rights objection is not the equivalent of “confusingly similar” in either the UDRP or the likelihood of confusion test.

Further mystifying what “confusingly similar” means within the legal rights objections procedure is the panel decision in *The DirecTV Group Inc. v. Dish DBS Corp.* In this case, DirecTV, a provider of satellite television in the U.S. operating under the mark DIRECTV,⁸¹ filed a legal rights objection to its competitor’s application for the gTLD <.direct>. The panel upheld the objection finding that even though the applied-for gTLD was not identical with “directv” because it was missing the “v,” it was nevertheless similar enough. Significantly, the panel found that the first factor does not require that the two words being compared be “confusingly similar,” just similar.⁸²

XI. THE IMPLICATIONS OF A CONFUSINGLY APPLIED DOCTRINE

In sum, first generation UDRP disputes employed the “confusing similarity” doctrine in a manner that is conceptually distinct from trademark law. With the advent of new gTLDs, we have already witnessed a changed understanding of “confusing similarity” within the domain name space in the legal rights-objections procedure. But now with second-generation domain name disputes—those involving new gTLDs—

78. GTLD APPLICANT GUIDEBOOK, OBJECTION PROCEDURES, 3-18 (2012), <https://newgtlds.icann.org/en/applicants/agb/guidebook-full-04jun12-en.pdf> [<https://perma.cc/PS25-MYCB>] (The first prong resembles well-known marks protection under European law, the second prong resembles U.S. dilution law, and the third prong resembles likelihood of confusion).

79. *Id.* at 3–19.

80. *Id.*

81. DIRECTV, Registration No. 85,580,999.

82. *The DirecTV Group Inc. v. Dish DBS Corp.*, WIPO Case No. LRO2013-0005, Objection Upheld, 5–6 (July 29, 2013), <https://www.wipo.int/export/sites/www/amc/en/domains/lro/docs/lro2013-0005.pdf> [<https://perma.cc/3EV8-D5WW>].

evaluation of the confusing similarity prong will inevitably morph because gTLDs now offer more information to include into the analysis.

Although in first generation disputes the general rule was to disregard the gTLD for purposes of assessing similarity, there were certainly exceptions. One such exception is *Tesco Stores Limited v. Mat Feakins*, where the domain name <tes.co> was found to be confusingly similar to TESCO.⁸³ This conclusion was only possible because the gTLD was considered in the confusing similarity analysis. The looseness of the guidelines about how panels should conduct the comparison has given them wide latitude to create new approaches. Even the reversal on considering the gTLD has not been uniformly applied.

How should a panel judge the similarity of the trademark PORSCHE with the domain <porsche.social> if the panel considers the gTLD suffix in its analysis confusing similarity? How should the panel evaluate that suffix and its effect on similarity? This was the issue in a URS appeal.⁸⁴ Certainly, <.social> does not enhance similarity because there is no obvious connection between the meaning of “social” and the mark owner. At this point in time, the gTLD <.social> has not developed any particular meaning. It is possible, however, that <.social> could become known as a gTLD where internet users found information about shared interests.

In this dispute, the registrant argued that it planned to use the domain name as a free community or fan site for Porsche car enthusiasts.⁸⁵ It also stated an intent to disclaim “on every webpage” any affiliation with or authorization by the Porsche brand.⁸⁶ The URS Examiner held this was fair use, finding that “[t]he use of ‘.social’ in the domain name, and the screenshot from Respondent’s website are evidence of that intent.”⁸⁷ On appeal, however, the panel reversed stating that the gTLD is “generally

83. *Tesco Stores Limited v. Mat Feakins*, WIPO Case No. DCO2013-0017, Judgment for Complainant, § 7 (Oct. 4, 2013), <https://www.wipo.int/amc/en/domains/decisions/text/2013/dco2013-0017.html> [<https://perma.cc/HJF4-WZTJ>] (“There is no rule either within the Policy or that might affect its application, that precludes panels from taking into account TLDs. It is the case that most panels do not, because most of the analysis that takes place is at the second level. And that is because, simply, the TLD, being generic in nature, does not usually form part of the trademark to which a domain name is being compared. But that does not establish any kind of rule that precludes TLDs being taken into account.”).

84. *Dr. Ing. h.c. F. Porsche AG v. Interactiv Corporation*, Claim No. FA1407001571774 (Sep. 10, 2014) (Nat’l Arbitration Forum), <http://www.adrforum.com/domaindecisions/1571774A.htm> [<https://perma.cc/9ZN3-EJ5B>] (appeal from August 18, 2014 determination).

85. *Dr. Ing. h.c. F. Porsche AG v. Interactiv Corporation*, Claim No. FA1407001571774 (Aug. 18, 2014) (Nat’l Arbitration Forum), <http://www.adrforum.com/domaindecisions/1571774F.htm> [<https://perma.cc/CZ9J-QGGM>] (final determination).

86. *Id.*

87. *Id.*

irrelevant when assessing whether or not a mark is identical or confusingly similar.”⁸⁸ In any event, the panel concluded that the <.social> gTLD “does nothing to distinguish the disputed domain name from the Complainant’s trademark.”⁸⁹

Another <.social> domain dispute was resolved similarly. Audi, Lamborghini, Skoda, and Volkswagen brought a consolidated complaint over domain name registrations that comprised their trademarks in the <.social> gTLD.⁹⁰ There the panel explicitly acknowledged:

UDRP panels have been consistent in their interpretation of the impact of the TLD for purposes of the first element of the Policy. . . . [T]he TLD is usually disregarded. . . . Some UDRP panels have considered whether the new TLDs may impact the typical UDRP assessment in terms of Internet user confusion. With regard to the first issue raised by the Respondent which asserts that a “.social” domain name is “unique” simply by virtue of that TLD, the Panel notes that the threshold test under the UDRP is not a matter of the specific status or degree of popular recognition of the TLD as such. . . . In any event, for purposes of assessing identity/confusing similarity under the Policy, the Panel in this case views no reason to treat the present TLD differently than any other TLD, such as “.com”, “.net” or “.org.”⁹¹

As a result of adopting the approach that the addition of the new gTLD was irrelevant in assessing confusing similarity, the panel found that the domain name and the mark were identical.

A third panel in a <.social> dispute reached the same result. In a dispute between Australian telecom giant, Telstra and the registrant of <telstra.social>, the panel stated that a “TLD suffix generally has no capacity to distinguish a domain name from a trademark for the purposes of a comparison under the Policy.”⁹² Remarkably, the panel cited two <.com> disputes to support this proposition.

88. Dr. Ing. h.c. F. Porsche AG v. Interactiv Corporation, Claim No. FA1407001571774 (Sep. 10, 2014) (Nat’l Arbitration Forum), <http://www.adrforum.com/domaindecisions/1571774A.htm> [<https://perma.cc/9ZN3-EJ5B>] (appeal from final determination).

89. *Id.*

90. Audi AG, Automobili Lamborghini Holding S.p.A., Skoda Auto a.s., Volkswagen AG v. JUS TIN Pty Ltd., WIPO Case No. D2015-0827, Judgment for Complainants, § 3 (July 9, 2015), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2015-0827> [<https://perma.cc/UY3P-KH7R>].

91. *Id.*

92. Telstra Corporation Limited v. Omrite Pty Ltd., WIPO Case No. D2016-2021, Judgment for Complainant, § 3 (Dec. 6, 2016), <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2016-2021> [<https://perma.cc/WWZ3-LASB>].

A fourth panel cited the *Audi, Lamborghini, Skoda, and Volkswagen* panel for the principle that the gTLD suffix generally should not be taken into account or influence the confusing similarity analysis since it exists for technical reasons.⁹³ As a result, the panel found the domain name <marriott.social> to be identical to the claimant's trademark MARRIOTT.⁹⁴

These panels have overstated the applicable principle. It is no longer the case that gTLDs are irrelevant to a confusing similarity assessment because we have already seen that where they form part of the mark or where relate to the mark owner's business they are highly relevant. Rather these panels should have confined their propositions only to the case at hand and opined only on the relevancy of <.social> *at this time*. At a minimum, domain name registrants in the new gTLDs face a serious lack of predictability in UDRP outcomes.

Consider the application of the existing rules with regard to various hypothetical domain names including the word "amazon." The domain name <amazon.books> would likely be found to be confusingly similar to the mark AMAZON for the same reason that <canyon.bike> was found confusingly similar to CANYON. But what should be the result for <amazon.forest>? Under two lines of precedent-like principles, it would also be found to be confusingly similar to AMAZON. Either the gTLD should be disregarded in the analysis of confusing similarity and the domain would thus be confusingly similar, or the addition of generic terms would be held not to distract from the similarity with the mark. There now exists either an exception to the rule of disregarding the gTLD, or indeed, a new rule that the gTLD should not be disregarded. In any event, the question as to how to deal with the meaning of the gTLD is pressing. It is nonsensical, let alone unjust, to employ a double standard. If the meaning of the extra words should be evaluated when they possibly enhance similarity, they should also be evaluated when they diminish similarity. Even if equitably applied, the problem with this rule, however, is that it is difficult to apply in the absence of context.

93. *Marriott International, Inc. v. Marriott Worldwide Corporation c. Miguel Sanchez Barco*, WIPO Case No. D2018-0983, Judgment for Complainant, § 6-7 (July 23, 2018) <https://www.wipo.int/amc/en/domains/decisions/text/2018/d2018-0983.html> [<https://perma.cc/AB63-APU4>].

94. *Id.*

XII. CONFUSING SIMILARITY AS A STANDING REQUIREMENT

The confusing similarity prong of the UDRP test should function as a standing requirement, as it was originally intended. But it should be an exacting standing requirement; one that actually does work. If the standing requirement was applied rigorously, cases could be resolved at this point. As a result, less would ride on the bad faith prong of the test.

As a standing requirement, confusing similarity should test whether the complainant has a sufficient connection to the harm to proceed. In <canyon.bike>, the similarity is such that Canyon has a sufficient connection to the alleged harm. If Canyon complained about <canyon.hike> however, the <.hike> gTLD suffix should not be disregarded. In these cases, Canyon should be found to be too distanced from any possible harm.

In domain name policy, confusing similarity was meant to be a standing requirement. The WIPO Overview of WIPO Panel Views on Selected UDRP Questions states simply: “The first element of the UDRP serves essentially as a standing requirement.”⁹⁵ The essential purpose of a standing requirement is to ensure that the complainant is sufficiently connected to the alleged harm.⁹⁶ The WIPO Overview 2.0 articulates this connection as recognizability: “In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name, with the addition of common, dictionary, descriptive, or negative terms . . . typically being regarded as insufficient to prevent threshold Internet user confusion.”⁹⁷

For a trademark to be “recognizable as such” it should not just be visible as a string of letters, as ELLE is in <naturelle.com>, but it should be recognizable as a reference to that trademark.

Now that the large majority of gTLDs are generic there will be more strain on the fair use defense in UDRP disputes. In these cases, the complainant must shoulder its burden on the first element since these disputes will likely be decided before many of the facts that could support a fair use argument can be known, such as what type of information will appear on the website and what consumers will make of it.

95. See WIPO Overview 2.0, *supra* note 4.

96. See *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 560 (“[T]here must be a causal connection between the injury and the conduct complained of. . . .”); see also Doug Isenberg, *Confusing Similarity is Only a ‘Standing Requirement’ Under the UDRP*, GIGALAW (Nov. 1, 2017), <https://giga.law/blog/2017/11/01/confusing-similarity-is-only-a-standing-requirement-under-the-udrp> [<https://perma.cc/BJJ6-2258>] (explaining that standing means “a person . . . is qualified to assert a legal right”).

97. WIPO Overview 2.0, *supra* note 4.

At this point, the predictions about how the public will view these new gTLDs are mixed. How will <.coupons>, owned by Donuts, or <.lol>, owned by Google, be used by domain name registrants and how will they be experienced by internet users? According to one commentator,

In the domain name system: new domain name extensions now have a simple and highly descriptive function. When you read a domain name: not only you read [sic] a name but you also receive the information of the community it belongs to: the equivalent of the Trademark classification. In two words separated by a 'dot', you receive a complete information. The right domain name has more value than a Trademark in the short . . . and long term.⁹⁸

Many new gTLDs may be used to describe the core business offered under a mark in the second-level domain (e.g. <canyon.bike>). In these cases, the new gTLD actually reinforces the trademark and confusing similarity. Some new gTLDs, however, are less specific and do not necessarily describe a product or service, but instead suggest a particular use—for example: <.club>, <.buzz>, <.parts>, <.wtf>, <.email>, <.social>, etc. The weight given to the words in these new gTLDs, when combined with a third-party trademark may end up depending on the context of their use. Should this occur, the confusing similarity test will veer into a more contextual analysis.

These possible new meanings associated with new gTLDs play a role in how domain disputes should be decided. Recall that <.com> was originally intended for commercial sites. By the time the rule had developed to disregard gTLD suffixes, however, <.com> no longer retained that original meaning. Instead, by that time, <.com> meant nothing. It may be that some or even all of the new gTLDs will develop specialized meanings such that internet users will make assumptions about a domain name based on the gTLD it is in.

XIII.CONCLUSION

The stated objective of the New gTLD Program was to enhance competition and consumer choice and enable the benefits of innovation via the introduction of new gTLDs.⁹⁹ That objective would imply that new

98. Jean Guillon, *Forget Search Engines*, LINKEDIN (Mar. 5, 2015), <https://www.linkedin.com/pulse/forget-search-engines-jean-guillon> [<https://perma.cc/4E4N-STPE>].

99. *About the Program*, ICANN, <http://newgtlds.icann.org/en/about/program> [<https://perma.cc/2LPF-H2KY>].

second-level domains should be widely available for registration. Registrants should be forewarned, however, that any second-level domain name registration that contains a trademark may be found to be confusingly similar even though the new gTLD should indicate to internet users that the domain name would not belong to the trademark owner. Continued lowering of the threshold as to what constitutes a “confusingly similar” domain name may make most of the newly created domain names subject to trademark holder takeover.