

## **EXPERT DETERMINATION LEGAL RIGHTS OBJECTION**

Express, LLC v. Sea Sunset, LLC

Case No. LRO2013-0022

### **1. The Parties**

Complainant/Objector is Express, LLC of Columbus, Ohio United States of America, represented by Barnes & Thornburg LLP, United States of America.

Respondent/Applicant is Sea Sunset, LLC of Bellevue, Washington, United States of America, represented by The IP & Technology Legal Group, P.C., United States of America.

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

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

### **3. Procedural History**

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

In accordance with Article 9 of the Procedure, the WIPO Center has completed the review of the Objection on March 21, 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 Frederick M. Abbott as the Panel in this matter on June 11, 2013. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the WIPO Center to ensure compliance with Article 13(c) of the Procedure and Paragraph 9 of WIPO Rules for New gTLD Dispute Resolution.

By email dated June 17, 2013, Complainant transmitted a supplemental "Reply Brief" to the Center and Respondent. By email dated June 20, 2013, Respondent opposed the Panel's acceptance of that supplemental submission, and by email dated June 20, 2013 Complainant replied to that opposition. The Panel requested the Center to forward the aforesaid submissions to it.

By Expert Legal Rights Objection Procedural Order No 1, dated June 24, 2013, the Panel accepted a part of Complainant's Reply Brief and rejected a part of that Reply Brief, and allowed Respondent the opportunity to file a supplemental submission addressing that portion of the Reply Brief it accepted. The Panel's Procedural Order No 1 that provides the grounds for its determination is appended to this decision as Addendum.

By email dated June 29, 2013, Respondent transmitted its Sur-Reply in response to Complainant's Reply Brief. By email dated July 1, 2013, Complainant made certain objections to the content of the Sur-Reply. By email of that same date, Respondent replied to those objections.

The substance of the allowed portion of Complainant's Reply Brief concerned a word recognition survey and supporting Declaration that formed part of Respondent's Response, as did Respondent's Sur-Reply. The Panel addresses the word recognition survey in the Factual Background and Discussion and Findings, *infra*.

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

Complainant is the owner of registrations for the trademark and service mark EXPRESS in the United States of America (USA) and numerous other countries. Complainant has furnished a list of such registrations, as well as extensive samples of registration certificates corresponding to such registrations.<sup>1</sup>

The earliest registration provided by Complainant is on Principal Register of the United States Patent and Trademark Office (USPTO) for the word trademark EXPRESS, registration number 1,120,073, registration dated June 12, 1979 (Complainant as assignee/current owner), in international class (IC) 25, covering "sweaters, knit tops, blouses, pants, sport jacket, shirts, and skirts", claiming date of first use and first use in commerce of February 22, 1972, with incontestable status. Additional word trademark and service mark registrations on the USPTO Principal Register include registration number 2,290,570, registration dated November 2, 1999, in IC 25, covering "shorts, tank tops and T-shirts" (with incontestable status); registration number 2,484,122, registration dated September 4, 2001, in ICs 9, 14, 18, 25 and 26, covering, jewelry, purses and handbags, hosiery, tights and socks, and hair clips (with incontestable status); registration number 3,797,700, registration dated June 1, 2010, in ICs 26 and 35, covering various hair accessories and "retail store services featuring jewelry and hair accessories", with retail store services claiming first use and first use in commerce of December 1997; registration number 4,016,278, registration dated August 23, 2011, in IC 35, covering retail store services, mail-order catalog services, and on-line retail store services, all featuring various clothing, accessories (including footwear), and personal care products for men and women, claiming first use and first use in commerce of October 15, 1997; registration number 4,094,721, registration dated January 31, 2012, in IC 14, covering "watches", claiming first use and first use in commerce of October 27, 2011, and; registration number 4,185,593, registration dated August 7, 2012, in IC 35, covering, *inter alia*, retail store and online retail services featuring watches, claiming first use in first use in commerce of October 27, 2011.

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<sup>1</sup> Complainant has indicated that furnishing files representing each of the registrations would cause the Objection to substantially exceed the digital file size limit established by the WIPO Rules for New gTLD Dispute Resolution, and offered to supplement its submission as requested by the Panel. Because Complainant has furnished extensive representative samples, and because Respondent has not contested the fact of the registrations, the Panel has not considered it necessary to request further submission by Complainant.

Complainant has submitted an extensive listing of trademark and service mark registrations for the word EXPRESS for countries other than the USA. Such registrations cover a significant portion of the world, including member states of the European Union, Brazil, China, India, Russian Federation and South Africa, countries of the Caribbean and Middle East, Japan, Australia and many others. In many cases, such trademark and service mark registrations date back substantially (for example, registration in Brazil granted in 1990, registration granted in Chile in 1997, registration granted in China in 1989, registration granted in Costa Rica in 1999, registration in Denmark granted in 1992, registration in Egypt granted in 2006, registration in France granted in 1982, registration granted in Haiti in 1989, registration granted in Hong Kong, China in 1994, registration in India granted in 1994, registration in Indonesia granted in 1994, registration in Israel granted in 1990, registration in Italy granted in 1994, registration in Japan granted in 2002, registration in Malaysia granted in 1997, registration in Morocco granted in 1994, registration in Nepal granted in 1989, registration in New Zealand granted in 1998, registration in Pakistan granted in 2001, registration Portugal granted in 1991, registration in the Republic of Korea granted in 1984, registration in the Russian Federation granted in 2004, registration in Saudi Arabia granted in 2010, registration in Singapore granted in 1985, registration in Switzerland granted in 1992, registration in Taiwan Province of China granted in 1984, registration in Turkey granted in 1989, registration in United Arab Emirates granted in 1996, registration in Viet Nam granted in 1995, as well as international registration granted under the Madrid System in 2011).

Complainant began commercial use of the term “express” in or about 1980 in the USA in connection with retail stores primarily selling women’s clothing named “Limited Express”. By 1991, retail sales exceeded USD1 billion, and Complainant began to change to use of the term EXPRESS standing alone in connection with its retail operations. Complainant began selling men’s clothing under the name “Structure” in 1989, and in 2001 began to consolidate its women’s and men’s product lines into dual-gender stores under the EXPRESS trademark. As of 2013, Complainant operates over 600 retail stores in the USA, Canada, Kuwait, Peru, Panama, Saudi Arabia, and the United Arab Emirates. Retail stores located outside the USA and Canada appear to be operated by franchisees. In 2012, Complainant’s revenues of its “branded goods” worldwide were approximately USD 2.15 billion.

In addition to apparel, Complainant’s EXPRESS product line includes watches, shoes, jewelry and perfume. Complainant’s “target consumers” are men and women between 20 and 30 years of age. Products sold by Complainant routinely include an EXPRESS trademark tag.

Complainant advertises, offers and sells its EXPRESS product line through a commercial Internet website with principal address at <express.com>. In 2010, 60% of Complainant’s sales were through its e-commerce website, and Complainant was named one of the “Top 15 Mobile Commerce Destinations of 2010” by Mobile Commerce Daily. Consumers in over 60 countries have purchased EXPRESS-branded products through e commerce. Complainant’s EXPRESS trademark is prominently displayed on Complainant’s e-commerce website.

In addition to the <express.com> domain name, Complainant has registered over 150 domain names incorporating the term EXPRESS, including 99 in open gTLDs, such as <expressclothes.com>, <expressfashion.com> and <expressjeans.com>, and 55 in country code ccTLDs, including <expressfashion.co.uk>, <expressfashion.jp> and <expressfashion.fr>. According to Complainant, it was successful in securing sunrise applications for the following domain spaces based on existing trademark registrations: <.cm>, <.co>, <.info> and <.xxx>.

Complainant spends substantial sums on advertising and promoting its EXPRESS trademark. Since 1986, Complainant has spent over USD 800 million on advertising and promotion under the EXPRESS trademark, and in 2012 Complainant spent over USD 89 million on advertising and promotion under the EXPRESS trademark.

In 2012, EXPRESS was listed at number 59 on Women's Wear Daily's Most Recognized Consumer Brands list.

Respondent is an entity formed for the purpose of acquiring and operating new generic top-level domains in ICANN's new gTLD program. Respondent is a subsidiary of Donuts Inc., which directly or through its affiliated enterprises has applied for more than 300 new gTLDs. (Throughout this decision, references to Respondent are deemed to include Donuts Inc. and related applicant new gTLD enterprises, unless expressly stated otherwise.)

Respondent intends to act as a registry for the <.express> gTLD. Respondent indicates that it has paid more than USD 55 million to ICANN in filing fees for its collective new gTLD applications. Respondent indicates that it has spent substantial additional sums in planning to use <.express>, and has engaged a number of companies that provide back-end technology, marketing, finance, legal and consulting services. Respondent indicates that it has raised more than USD100 million from a number of capital sources, and that it is prepared to raise additional funding from current or new investors. Respondent asserts that it "has the capability and intent to launch, expand and operate its gTLDs in a secure manner, and to properly protect Internet users and rights-holders from potential abuse." (Application for <.express>.)

In terms of purpose and objectives, Respondent states in its Application:

"This TLD is attractive and useful to end-users as it better facilitates search, self-expression, information sharing and the provision of legitimate goods and services. Along with the other TLDs in the Donuts family, this TLD will provide Internet users with opportunities for online identities and expression that do not currently exist. In doing so, the TLD will introduce significant consumer choice and competition to the Internet namespace – the very purpose of ICANN's new TLD program.

This TLD is a generic term and its second level names will be attractive to a variety of Internet users. Making this TLD available to a broad audience of registrants is consistent with the competition goals of the New TLD expansion program, and consistent with ICANN's objective of maximizing Internet participation. Donuts believes in an open Internet and, accordingly, we will encourage inclusiveness in the registration policies for this TLD. In order to avoid harm to legitimate registrants, Donuts will not artificially deny access, on the basis of identity alone (without legal cause), to a TLD that represents a generic form of activity and expression." (Application, at paragraph 18(a))

Respondent has provided information concerning the protection it intends to afford for its new gTLD registries. It states:

"Donuts has consulted with and evaluated the ideas of international law enforcement, consumer privacy advocacy organizations, intellectual property interests and other Internet industry groups to create a set of protections that far exceed those in existing TLDs, and bring to the Internet namespace nearly two dozen new rights and protection mechanisms to raise user safety and protection to a new level.

These include eight, innovative and forceful mechanisms and resources that far exceed the already powerful protections in the applicant guidebook. These are:

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

They also include fourteen new measures that were developed specifically by ICANN for the new TLD process. These are:

1. Controls to ensure proper access to domain management functions;
2. 24/7/365 abuse point of contact at registry;
3. Procedures for handling complaints of illegal or abusive activity, including remediation and takedown processes;
4. Thick Whols;
5. Use of the Trademark Clearinghouse;
6. A Sunrise process;
7. A Trademark Claims process;
8. Adherence to the Uniform Rapid Suspension system;
9. Adherence to the Uniform Domain Name Dispute Resolution Policy;
10. Adherence to the Post Delegation Dispute Resolution Policy;
11. Detailed security policies and procedures;
12. Strong security controls for access, threat analysis and audit;
13. Implementation DNSSEC; and
14. Measures for the prevention of orphan glue records.” (Application at paragraph 18(a))

With respect to the <.express> new gTLD, Respondent states: “Donuts’ plan and intent is for this TLD to serve the international community by bringing new users online through opportunities for economic growth, increased productivity, the exchange of ideas and information and greater self-expression.” (*Id.*)

Under the heading “Innovation”, Respondent states:

“Consistent with our principle of innovation, Donuts will be a leader in rights protection, shielding those that deserve protection and not unfairly limiting or directing those that don’t. As detailed in this application, far-reaching protections will be provided in this TLD. Nevertheless, the Donuts approach is inclusive, and second level registrations in this TLD will be available to any responsible registrant with an affinity for this string. We will use our significant protection mechanisms to prevent and eradicate abuse, rather than attempting to do so by limiting registrant eligibility.

This TLD will contribute to the user experience by offering registration alternatives that better meet registrants’ identity needs, and by providing more intuitive methods for users to locate products, services and information. This TLD also will contribute to marketplace diversity, an important element of user experience. In addition, Donuts will offer its sales channel a suite of innovative registration products that are inviting, practical and useful to registrants.

As noted, Donuts will be inclusive in its registration policies and will not limit registrant eligibility at the second level at the moment of registration. Restricting access to second level names in this broadly generic TLD would cause more harm than benefit by denying domain access to legitimate registrants. Therefore, rather than artificially limiting registrant access, we will control abuse by carefully and uniformly implementing our extensive range of user and rights protections.” (Application at paragraph 18(b)).

Both Complainant and Respondent have provided reference to a dictionary definitions of the term or string “express”. From the Objection:

Webster dictionary defines “express” as: “1a. directly, firmly, and explicitly stated <my express orders>; b : exact, precise; 2a. designed for or adapted to its purpose b : of a particular sort : specific <for that express purpose>; and 3a traveling at high speed; specifically, traveling with few or no stops along the way <express train> b : adapted or suitable for travel at high speed <an express highway>”.

Respondent refers to Dictionary.com, defining “express” as follows:

**verb (used with object)**

1. to put (thought) into words; utter or state: *to express an idea clearly.*
2. to show, manifest, or reveal: *to express one's anger.*
3. to set forth the opinions, feelings, etc., of (oneself), as in speaking, writing, or painting: *He can express himself eloquently.*
4. to represent by a symbol, character, figure, or formula: *to express water as H<sub>2</sub>O; to express unknown quantities algebraically.*
5. to send by express: *to express a package or merchandise.*

**adjective**

9. clearly indicated; distinctly stated; definite; explicit; plain: *He defied my express command.*
10. special; definite: *We have an express purpose in being here.*
11. direct or fast, especially making few or no intermediate stops: *an express train; an express elevator.*
12. used for direct or high-speed travel: *an express highway.*
13. duly or exactly formed or represented: *an express image.*

**noun**

15. an express train, bus, elevator, etc.
16. a system or method of sending freight, parcels, money, etc., that is faster and safer, but more expensive, than ordinary freight service: *We agree to send the package by express.*
17. a company engaged in this business.
18. *British.* a messenger or a message specially sent.
19. something sent by express.

**adverb**

20. by express: *to travel express.*
21. *Obsolete, expressly.*<sup>2</sup>

There are a substantial number of commercial enterprises that use of the term “express” as all or part of their business identifiers other than Complainant. Respondent has specifically referred to Federal Express, DHL Express, American Express, and the “Express” daily news publication of the Washington Post Company. Respondent has also provided evidence of registrations at the USPTO for the word and/or word and design trademark “Express” standing alone for convenience stores and gas stations,<sup>3</sup> accelerated blood collection software,<sup>4</sup> cups and mugs,<sup>5</sup> fast charging industrial batteries,<sup>6</sup> precast bridge foundations,<sup>7</sup> computer software and services from IBM,<sup>8</sup> and welding and soldering kits<sup>9</sup>.

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<sup>2</sup> Omitted numbered definitions as in Response.

<sup>3</sup> USPTO registration number 3,198,708.

<sup>4</sup> USPTO registration number 4,001,409.

<sup>5</sup> USPTO registration number 3,198,709.

<sup>6</sup> USPTO registration number 4,192,680.

<sup>7</sup> USPTO registration number 4,215,342.

<sup>8</sup> USPTO registration number 3,681,462.

<sup>9</sup> USPTO registration number 3,903,186.

Respondent has provided evidence that the country code second-level domain “express” is registered and used by entities other than Complainant in the United Kingdom, Japan, France and Hong Kong, China. For example, in the United Kingdom, <express.co.uk> addresses the online version of the Sunday Express and Daily Express newspaper, and the UK ccTLD was first registered in 1996.

## The Survey

As part of its Response, Respondent indicated that it “recently conducted a survey with a random sample of Internet users with respect to their perceptions and understandings concerning the term ‘express.’” Attached to the Response was a “Declaration of Gordon Morris re ‘Express’ Word Recognition Survey. In a supplemental filing that the Panel accepted, Complainant set out a list of alleged technical deficiencies regarding the manner in which the survey was conducted, the results presented, and the qualifications of the individual that prepared the survey and analyzed the data. Complainant suggested that the survey should be excluded from consideration, or that the Panel accord it little or no weight because of its numerous alleged deficiencies.

The Panel further allowed Respondent to file a concise response to the assertions by Complainant regarding the technical deficiencies in the survey, including its manner of presentation. Respondent filed such a response. As part of that response, Respondent attached the actual survey as presented to the Internet survey participant group, as well as raw response data from the survey group.

In its initial Response, Respondent made reference to a select group of data points. Among the group of survey respondents that had answered “yes” to the self-description “I am very interested in clothing fashion”, 8% of the respondents “spontaneously associate the word ‘express’ with ‘fashion’”. Respondents associated “express” with a range of things, ranging from speed or expediency, credit cards, fast food or transportation (including an “express line”, “American Express”, “Panda Express” and “expressway”). And, 51% of respondents identified “express” as at least more of a brand than a person, place or thing.

Complainant alleged that Respondent should have prepared the survey so as to have the survey participants consider the subject term (“express”) “as they would if Respondent is allowed to operate that TLD (*i.e.* probing whether they would associate jeans.express with Express or jobs.express with any specific entity)”. According to Complainant, the survey was designed to demonstrate that “dictionary terms can also function as trademarks and, in a vacuum, some will see them as words and others as marks. Respondent then uses the results of the survey to support its argument that Express’ mark is generic.” Complainant also faulted the survey for not adequately explaining to the survey participants the meaning of the term “brand”. Complainant noted that the results of surveys conducted by Respondent with respect to the terms “express” and “limited” yielded nearly identical results. Complainant also objected to Respondent’s failure to explain how the survey target population was selected, what control words were used, and the omission in the Response of the actual questionnaire and online visual environment.

In Respondent’s reply to Complainant’s supplemental submission, which included a supplemental Declaration from Mr. Morris, Respondent provided the materials underlying the survey results. It explained the methodology by which the survey group was selected, why it had not included second-level domains as part of the survey question, that it had briefly defined the concept of “brand”, specified the control words, and provided screenshots of the appearance of the survey for online takers.

Respondent further indicated that “it will make little difference whether that Panel considers the Survey, since Applicant would allow only legitimate uses of a common word in the English language.” Respondent indicates that even if the Panel accepts some of Complainant’s objections to the survey, this should affect only the weight the Panel chooses to give to the survey, and should not negate its admissibility.

The Panel will revert to the admissibility and weight of the survey in the course of its decision.

## 5. Parties stated' Contentions

### A. Complainant

Complainant alleges that it owns valid rights in the EXPRESS trademark which are recognized and enforceable under generally accepted and internationally recognized principles of law. Complainant states that it refers to the law of the United States throughout its pleading as both Complainant and Respondent are domiciled in the United States.

Complainant contends that its Objection should be upheld based on the following reasons grounded in the ICANN Applicant Guidebook, Section 3.5.2, and Procedure, Article 8(a)(iii)(bb), in that the potential use of the applied for gTLD by Respondent: (i) takes unfair advantage of the distinctive character or the reputation of the Objector's registered in common law rights in the EXPRESS trademark and service mark, and/or; (ii) unjustifiably impairs the distinctive character or reputation of the Objector's EXPRESS mark, and/or; (iii) otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the Objector's EXPRESS mark.

Complainant argues that the applied-for gTLD is identical in appearance, sound and meaning to Complainant's existing mark, EXPRESS.

Complainant contends that its acquisition and use of its EXPRESS mark has been *bona fide*. Complainant claims that it began use of the EXPRESS mark in 1972 on clothing, and that it expanded use in retail services, including through catalog and Internet sales. Complainant has sold over USD 44 billion in EXPRESS branded goods, and has spent over USD 811 million on marketing and advertising the EXPRESS brand. Complainant has registered the EXPRESS mark in over 100 jurisdictions. The United States registrations alone are *prima facie* evidence of the registered trademarks, as well as constituting constructive notice of ownership. Several of the United States registrations are incontestable.

Complainant argues that the level of sales and advertising expenditures regarding the EXPRESS trademark establishes that "there can be no doubt that consumers of fashion apparel associate the EXPRESS mark with [Complainant]". Complainant indicates that the EXPRESS mark is 59th on Women's Wear Daily's list of the 100 most recognized consumer brands. Complainant contends that because there are over 600 retail locations in the United States under the EXPRESS mark, visiting a local shopping district will expose a consumer to that mark. Complainant states that it operates a retail store less than one mile from Respondent's headquarters in Bellevue, Washington.

Complainant contends that Respondent has no trademark rights in the term "express", and that Respondent believes this is a generic term.

Complainant acknowledges that third parties use marks that contain the word "express", often descriptively (*i.e.* Federal Express). Complainant asserts that consumers of retail services and apparel associate the EXPRESS mark exclusively with Complainant, relying on a declaration by its Senior President and Chief Financial Officer, Paul Dascoli.

Complainant argues that Respondent's stated intention for seeking the applied-for gTLD is to "facilitate search, self-expression, information sharing and the provision of legitimate goods and services". Complainant contends that Respondent does not intend to put any restrictions on the registration of second-level domains in the .express gTLD, but to make it available to a broad audience. According to Complainant, Respondent's intended usage would encompass third-party registrations of domains such as "fashion.express, womensclothing.express, shirts.express, etc." and, according to Complainant, "[e]ven worse, [Respondent] states that it may offer registration discounts to those who 'commit to publicizing their use of the TLD'". Complainant argues this will encourage others to "adopt the .express portion of the domain as part of their trademark in order to receive the discount".



Complainant contends that Respondent has applied for other gTLDs that are generic terms doubling as well-known marks in the fashion industry such as “.coach and .limited”. Complainant alleges that Respondent clearly has knowledge of the fashion industry as it also applied for the gTLD <.fashion>.

Complainant argues that Respondent was clearly aware of its EXPRESS trademark when it submitted its gTLD application and, if it was not aware, acted recklessly in disregard of Complainant’s rights by failing to conduct a preliminary trademark search.

Complainant contends that Respondent has not used or made demonstrable use of the sign corresponding to the gTLD in connection with a *bona fide* offering of goods or services, or provision of information, in a way that does not interfere with the legitimate exercise by Complainant of its trademark rights. Complainant alleges that Respondent has applied for more than 300 new gTLDs, and that other than the submitted application and the basic “footwork” done with respect to all its applications, Respondent has not made any demonstrable preparations to use the <.express> gTLD.

Complainant alleges that Respondent’s stated plans for use of the <.express> gTLD will interfere with Complainant’s legitimate exercise of rights in its trademark, because it would (1) deprive Complainant of the right to control and operate the gTLD corresponding to its mark, for which it has also applied and (2) allow third parties to show clothing and accessories on websites at domains such as “suits.express, genes.express, clothing.express, catalogue.express, etc.” According to Complainant, “[n]othing could interfere with [Complainant’s] trademark rights more than the inability to stop others from registering and using such domains”. Complainant argues that Respondent makes it clear that it will favor such uses where it considers them to be generic.

Complainant contends that Respondent has disclaimed any trademark or other intellectual property rights in the <.express> sign as Respondent has asserted that the term is generic.

Complainant alleges that Respondent has not been commonly known by the sign <.express>.

Complainant contends that Respondent’s use of the <.express> gTLD would create a likelihood of confusion with its EXPRESS trademark as to the source, sponsorship, affiliation, or endorsement of the gTLD. Complainant argues that the test for likelihood of confusion used by courts and the USPTO in the United States can be found in *In re E.I. DuPont du Nemours & Co.*, 476 F.2d 1357, (C.C.P.A. 1973) (the “Dupont” factors”). Complainant argues that an assessment conducted using the 13 DuPont factors demonstrates there is a likelihood of confusion in this case.

1. Complainant argues that the mark and the <.express> gTLD are identical in appearance, sound, connotation and commercial impression. Complainant contends that because Respondent proposes no restrictions on use of the <.express> gTLD, including as part of a business name, operation and advertisement of the <.express> registry will be tantamount to trademark use, and registrants will be able to make trademark usage of the <.express> extension by advertising under the mark. Complainant argues that where marks are identical this favors a finding of likelihood of confusion and that other DuPont factors can be given less weight.
2. Complainant argues that the goods and services likely to be sold under the <.express> gTLD are similar to the goods and services Complainant sells under its trademark. Complainant states that it offers a full line of apparel and accessories under its EXPRESS mark through various selling channels. Complainant contends that because Respondent does not intend to restrict the <.express> registry, other registrants will be able to post information about fashion and offer apparel and accessories for sale online. Complainant states that although Respondent may state that second-level domain name applicants would have to comply with Respondent’s trademark policies, Respondent does not intend to control use of fashion-related second-level domain names through whatever trademark policy it will implement. Complainant states that “all of the confusion enabled and propagated by [Respondent’s] TLD could not be stopped except through individual legal actions

against each registrant using a .express domain in [Complainant's] field of fashion." Complainant contends that Respondent may argue that it will not itself offer any information or products related to the fashion industry, but the fact that others will be able to operate apparel e-commerce sites within the <.express> gTLD means it must be viewed as identical. Complainant alleges that where marks are identical and goods and services are identical or highly related, heavy emphasis is placed on these two factors, and a finding of likelihood of confusion logically follows, citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (C.C.P.A. 1976); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1244 (TTAB 2010); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009).

3. With respect to similarity of trade channels, Complainant states that it advertises a significant volume of its EXPRESS branded goods through its website at "www.express.com", and that Respondent will sell domains to companies who will sell fashion apparel and accessories online. Further, Complainant argues, Respondent will sell domains to registrants who want to provide information about their own brick-and-mortar retail stores which would inevitably include clothing stores. Complainant contends that the trade channels should be considered identical, supporting a finding of likelihood of confusion. Complainant alleges that consumers will immediately assume an association between Complainant and the <.express> gTLD because of Complainant's strong role in fashion e-commerce.
4. Complainant argues that the conditions under which consumers will encounter the <.express> gTLD and its mark are identical, namely online advertising, e-commerce website, retail outlets, mailers and e-mails. According to Complainant, this favors a likelihood of confusion.
5. Regarding the strength of its mark, Complainant argues that when EXPRESS is used as a clothing label it has no descriptive or suggestive relationship to its goods, and when used on its stores and e-commerce site has no descriptive or suggestive relationship to the services. Complainant provides a number of dictionary meanings of the term "express" (see Factual Background, *supra*), and states that none of the definitions describe or even suggest fashion apparel and accessories or retail outlets that sell them. Therefore, according to Complainant, "when focusing on [Complainant's] mark (as a likelihood of confusion test requires) EXPRESS is arbitrary and strong." Complainant states that this factor favors a likelihood of confusion.
6. Regarding the factor of number of similar marks, Complainant acknowledges that other marks contain the word "express" (e.g., American Express). However, it states that in the fashion industry there is only one company that uses the word "express" singularly as a mark, and the gTLD at issue matches Complainant's mark identically.
7. With respect to actual confusion or length of time without confusion, Complainant states that because the <.express> gTLD has not yet launched, actual confusion would not be likely to have occurred, but is not necessary to prove a likelihood of confusion, citing *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 230 U.S.P.Q. 831 (2d Cir. 1986); *accord Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Ctr.*, 109 F.3d 275 (6th Cir. 1997). Complainant states that further, in circumstances like this where the junior user has not yet commenced use, the factor is irrelevant, citing *TCPIP Holding Co., Inc. v. Haar Communications, Inc.*, 244 F.3d 88 (2d Cir. 2001).
8. With respect to the variety of goods, Complainant states that it uses its mark on a variety of goods and services, including a full line of men's and women's clothing, and accessories such as watches, shoes, jewelry and perfume. According to Complainant "[d]ue to this broad variety of goods and services, [Respondent's] use in permitting anyone to register any domain in this TLD has the potential for massive confusion where consumers will assume the TLD is associated with [Complainant] by the very nature of the domain names registered (i.e., shoes .express, perfume .express, etc.)." Complainant further argues that anyone receiving an email from the domain such as "sales.express" will immediately assume that Complainant is connected with the email. According to Complainant "this

potential for massive confusion creates an enforcement nightmare for [Complainant], which has spent significant amounts in bolstering the goodwill embodied in the EXPRESS mark.”

9. With respect to the market interface or relationship between Complainant and Respondent, Complainant states there is no market Interface or relationship that would ease any likelihood of confusion. Complainant contends this favors a likelihood of confusion.
10. Complainant argues that because Respondent has indicated that it believes “express” to be just a generic term, Respondent has no rights to exclude others from the use of an EXPRESS mark.
11. Regarding the extent of the potential for confusion, Complainant argues that the potential for confusion is “unbounded”. According to Complainant, some potential domain names will inherently cause confusion (e.g., those incorporating terms associated with fashion), while others, “which might be innocuous on their face, would have serious potential for confusion if the registrant sold fashion apparel and incorporated the domain extension as part of their own trademark (*i.e.* a domain called *davids.express*, where the registrant operated an online clothing store and created a logo/mark to promote the site that included *Davids.Express*).”
12. In terms of other probative facts, Complainant notes that a number of other brand owners in the fashion, perfume and accessories industry have applied to register their marks as gTLD extensions (referring to “.bananarepublic, .bloomingdales, .calvinklein, .coach, .chanel, .gap, .gucci, .macys, .marshalls, .next, .oldnavy, .polo, .target, .tjmaxx, etc.”), and that many of these brands compete in the same space as Complainant. Therefore, the result of the gTLD launch will be a consumer expectation that brand owners in this space control their corresponding gTLD. According to Complainant, this will compound the confusion of consumers immediately associating the <.express> gTLD with Complainant.

Complainant did not address the 13<sup>th</sup> DuPont factor of the junior user’s right to exclude others from use.

Complainant concludes its Objection as follows:

“An examination of all of the factors set forth in the Procedure as well as the test for likelihood of confusion clearly favor upholding the Objection. Should applicants for new TLDs be able to operate unrestricted TLDs represented by generic words which are also extremely well known brands, billions of dollars of goodwill will be wiped out in a TLD heartbeat. Apple, Coach, Express, and other extremely strong trademarks that also double as generic words could suffer serious and irreparable harm if applications such as the unrestricted one by Applicant are allowed to proceed. The confusion is inevitable, and the harm will be irreparable should this application move forward. Express respectfully requests that this Objection be upheld.”

## **B. Respondent**

Respondent contends that its rights derive from ICANN’s procedures and pronouncements in adopting its new gTLDs to increase choice and competition in domain names, referring to the Applicant Guidebook (AGB) Preamble, Section 1.1.2.3 and Module 2 Attachment, at A-1. Respondent states that it shares these goals and that its economies of scale allow it to offer domains on general subjects that may not otherwise have their own forums. Respondent argues that to deprive Internet users of choice, Complainant must clear a high bar, and that ICANN expressly placed the burden on objectors to prove the elements comprising the objection, citing AGB, Section 3.5. Respondent refers to Comment Summary and Analysis to AGB Version 3 at 67, stating:

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

Respondent states that it intends to offer the applied-for gTLD for non-trademark use, and that it has the same free speech rights as the general public to conduct its affairs using common words from the English language. According to Respondent, a contrary decision would impede growth and competition and set a dangerous precedent taking away choice.

Respondent contends that the Objection must be rejected because the potential use of the applied-for gTLD does not: (i) take unfair advantage of any distinctive character or reputation of Complainant's registered or unregistered trademark (without prejudice to its position on whether Complainant has legitimate trademark rights for purposes of its Objection); or (ii) unjustifiably impair the distinctive character or the reputation of Complainant's mark; or (iii) otherwise create an impermissible likelihood of confusion between the applied for gTLD and Complainant's claimed mark (citing AGB Section 3.5.2; Procedure, Article 11(d)(ii)). Respondent contends that Complainant has not met its burden of proof on any of these points, (citing AGB Section 3.5; Procedure, Article 20(c)).

Respondent contends that Complainant employs its EXPRESS mark on a limited basis in connection with its specialty apparel and accessories primarily to young adults within the United States. Respondent acknowledges that Complainant has, within this narrow category of commerce, one or more trademark registrations "for the otherwise generic term 'express', but this does not justify providing Complainant a total monopoly over such frequently used term". Respondent argues "[t]o allow this would close an entire segment of the Internet to many generic and non-trademark uses of the word's multiple meanings, and allow a proverbial 'trademark bully' to unilaterally carve a word out of the lexicon for its use only and stifle the efforts of new market entrants trying to compete fairly by using this very generic word".

Respondent argues that while Complainant has referred to sales data and advertising expenditures, Complainant "offers no supporting evidence, such as consumer surveys or similar materials, to buttress its argument. Instead, it merely propounds the uncorroborated and conclusory opinions of one of its employees." Respondent contends that there is no proof of the occurrence of any instance of actual confusion with Complainant's mark, or that it is even sufficiently likely.

Respondent contends that Complainant is objecting only to the "possibility" of infringement, but this is not sufficient. Respondent alleges that it intends to allow domain name registrants to make dictionary and other permissible uses of a <express> domain.

Respondent argues that abuses of domain name registries can be defended against by giving enforcement tools to those who have the means and incentive to find violators and use them. ICANN requires a series of trademark rights protection mechanisms, including the UDRP, along with the more recent Uniform Rapid Suspension System ("URS") and the Trademark Clearinghouse Mechanism ("TMCH"). Respondent argues that it goes beyond these updated levels of protection, "with its own extended array of rights protection mechanisms such as a 'Domain Protected Marks List' and a 'Claims Plus' service, as detailed in its application for the gTLD. Respondent states that under existing gTLDs, domain name registrants are free to register any number of domain names with the word 'express' in them, and rightfully so".

Respondent contends that it has dispute resolution procedures in place, and that these tools are the proper means for trademark enforcement, for uses that have not yet occurred. Respondent refers to Complainant's Objection as intended "to prevent a few feared but as yet unrealized threats to [Complainant's] limited rights".

Respondent argues that Complainant's contention regarding the identical character of its trademark to the applied-for gTLD fails. Respondent first argues that "express" is a generic term with a variety of meanings and usages, and that this point is conceded by Complainant. Also, Respondent contends that "express" has a number of grammatical expressions, referring to excerpts from Dictionary.com (see Factual Background, *supra*). Respondent argues that the broad array of usages drastically reduces the term's ability to serve a source-identifying function, making purported visual or auditory similarities largely irrelevant, citing 2 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 12:9, at 12-29 (4th ed. 2012).

Respondent claims that by using a generic dictionary word as its mark, Complainant voluntarily assumed the risk of not being able to prevent non-trademark use of the term in a top-level string (or in any other manner). Respondent asserts that to find against its application would unnecessarily curtail Respondent's right to free speech and would prevent fair competition, citing *Car-Freshner Corporation v. S.C. Johnson & Son, Inc.*, 70 F.3d at 267, 269 (2d Cir. 1995).

Respondent argues that some similarities are considered more acceptable than others, especially when certain components are generic, citing *Door Sys., Inc. v. Pro-Line Door Sys., Inc.*, 83 F.3d 169, 173 (7th Cir. 1996); *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F. 2d 966, 976 (11th Cir. 1983), and; *Sun Banks of Fla. v. Sun Fed. Sav. & Loan Ass'n*, 651 F.2d 311, 316 (5th Cir. 1981). Respondent argues that under the circumstances here addition of the generic "dot" character to the generic expression "express" would be sufficient for consumers to distinguish between Respondent's goods/services and those of Complainant.

Respondent contends that the plethora of ways that the common term "express" can be used, especially when considering the very narrow use to which Complainant puts it, favors Respondent; and that Complainant "does not and cannot carry its burden to prove actionable similarity".

Respondent claims that Complainant's use of the EXPRESS mark is much more limited than Complainant suggests. Respondent states that Complainant concedes it is a specialty apparel and accessories retailer targeting men and women between the ages of 20 and 30, referring to its Form 10-K filed with the Securities Exchange Commission. Also, Respondent asserts that Complainant's non-US sales operations are extremely limited, with only 4% of its retail stores located outside the United States, with almost half of those in Canada. Respondent states that the remaining 15 foreign-based stores are located in Latin America and the Middle East and are all franchise operations. Respondent states that Complainant does not appear to have any physical retail presence anywhere in Europe, Asia or South America.

Respondent argues that Complainant has not proven that the relevant sector of the public would recognize the sign corresponding to the <.express> gTLD as Complainant's claimed mark. According to Respondent, "For a top-level domain, *that* sector encompasses everyone in the world with internet access". Respondent asserts that Complainant's claims as to the well-known character of its mark are not supported by any meaningful data, and that the evidence it relies on use the self-serving observations of its CFO, who relies on its growth history, its sales figures and the number of its trademark registrations "as a method of *inferring* [Complainant's] alleged popularity". According to Respondent the absence of any offered proof is instructive, and it would be reasonable for the Panel to conclude there is no generally accepted association between the term "express" and Complainant's mark. Respondent refers to *Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1374 (Fed. Cir. 2012) in arguing that, in the absence of any actual proof of customer recognition, the mere fact of multiple registered marks in a number of different countries is of little consequence.

Respondent asserts that Complainant places significant reliance on the fact that it owns a number of domain names that incorporate the term "express" including country code TLDs under the "expressfashion" domain name for the United Kingdom, Japan, France and Hong Kong, China; but that Complainant does not claim to own the single-term "express" domain name for any of these jurisdictions, according to Respondent "no doubt because the domain names were already registered to other parties, and [Complainant] has been unable to use any legitimate legal means to force their transfer". Respondent argues that Complainant's EXPRESS brand has coexisted with commercial use of that term by third parties for a number of years without apparent injury to Complainant.

Respondent argues that Complainant has conceded that third parties use the EXPRESS mark in a prominent manner as a descriptive element, including Federal Express (as well as DHL Express), and that other well-known uses of the term include the American Express credit card, and the Express daily newspaper publication from the Washington Post Company. Respondent asserts that there are a number of registered trademarks for the singular term "express" at the USPTO (see Factual Background, *supra*).

Respondent argues that Complainant, by claiming a common, descriptive word as a trademark, “takes the risk that many others will use the same or similar terms to identify their companies, goods and/or services”, citing *Car-Freshner Corp. v. S.C. Johnson, supra*.

Respondent asserts that case law in the United States has been consistent that trademark rights do not prevent the non-trademark use of a dictionary term with a top-level domain, or in domains generally, citing as examples, “*Image Online Design v. ICANN, 2013 U.S. Dist. LEXIS 16896, 22-24 (C.D. Cal. 2013)* (finding no protectable interest in the proposed top-level domain name <.WEB>); see also *Advertise.com v. AOL Advertising, 616 F.3d 974, 978-979 (9th Cir. 2010)* (AOL’s “advertising” usage insufficient to prevent use of <ADVERTISING.COM>, as each identifies a type of service and not the supplier of it, or merely a “genus” of which the particular service of each is a “species”); *Hasbro v. Clue Computing, 66 F. Supp. 2d 117, 133 (D. Mass. 1999)*, aff’d, 232 F.3d 1 (1st Cir. 2000) (summary judgment entered in favor of defendant registrant of <clue.com> domain name against rights holder in “Clue” board game; trademark law does not support monopoly over domain name uses, such that “[i]f another Internet user has an innocent and legitimate reason for using the ... mark as a domain name and is the first to register it, that user should be able to use” the name)”. [Description of holdings as provided by Respondent]

Respondent refers to a survey it had recently conducted (see Factual Background, *supra*), in support of its argument that Complainant does not and cannot demonstrate that the Internet using public so associates the English language word “express” with Complainant that its claimed rights in that term can prevent Respondent from using that generic term as a gTLD.

Respondent argues that to constitute trademark infringement, an alleged infringer must have an intent to deceive or confuse others, not merely to compete with the trademark owner, citing *Banfi Products Corp. v. Kendall-Jackson Winery, Ltd., 74 F.Supp.2d 188 (E.D.N.Y. 1999)*. Respondent argues that Complainant has not presented any evidence of such intent on Respondent’s part. Respondent argues that intended confusing use of a trademark cannot be inferred from use of a generic term.

Respondent contends that Complainant’s allegation of questionable intent based on Respondent’s application for a substantial number of gTLDs is wholly without foundation. Respondent has applied for more than 300 gTLDs, and of those three (including Complainant’s) double as a registered trademark for a fashion industry business (*i.e.* Coach, The Limited and Express). Respondent argues that this is not proof of an ulterior motive on the part of Respondent, as Respondent has a legitimate right to use the term “express” for non-trademark purposes.

Respondent argues that it has prepared to use the sign corresponding to the gTLD in connection with providing *bona fide* access to information on the Internet and does not interfere with any legitimate rights of Complainant. Respondent states that it has invested over USD 55 million in ICANN filing fees for its more than 300 applications, plus additional substantial money, time and resources in planning and preparing to use the <.express> gTLD and other applied-for strings. It has also engaged a number of companies that provide backend technology, marketing, finance, legal and consulting services. Respondent contends that there is a UDRP decision recognizing that a substantial investment in planning a strategy for acquiring numerous geographic portal domains may constitute *bona fide* preparations to use a domain name, citing *Empresa Municipal Promoción Madrid S.A. v. Easylink Services Corporation, WIPO Case No. D2002-1110*.

Respondent states that Complainant has mischaracterized its application which states that it is not a control body obligated to perform a gate-keeping function. Respondent will have terms and conditions that prohibit unlawful conduct, reserving the right to delete second level domain names for such behavior. Respondent argues that what Complainant “expects”, or what “may happen”, does not constitute proof that can divest Respondent of its rights. The fact that Respondent establishes the qualifications to operate the <.express> gTLD creates a presumption in favor of granting the gTLD to Respondent, and places a corresponding burden on Complainant to show why it should not be granted. Respondent argues that Complainant has failed to meet its burden or overcome the presumption in favor of granting the application.

Respondent argues “[f]or [Complainant] to succeed would mean that no one could register a name in the <.express> TLD. No delivery service or transportation provider would be able to use the generic term in a TLD geared towards that specific use. [Complainant] would have this Panel restrict all speech in advance, instead of dealing only with unlawful speech, and then only when and if it occurs.”

Respondent refers to the DuPont factors, as well as to a similar list of factors set out in *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-349 (9th Cir. 1979) (the “Sleekcraft” factors), often used to assess likelihood of confusion.

1. Regarding the strength of Complainant’s mark, Respondent alleges that Complainant has chosen a dictionary term and used it for specific goods marketed to a specific demographic almost entirely within the United States, and that Complainant cannot prevent others, including Respondent, from using the term online worldwide, with all its possible meanings not associated in any way with Complainant’s goods.
2. Respondent reverts to its arguments that Complainant has failed to show similarity in sight, sound and meaning.
3. Respondent restates that Complainant has used its mark in a limited way, and that, by contrast, the term has infinite uses online – social, educational, informational, editorial, etc. – “that do not involve goods and services, much less those of [Complainant]”.
4. Respondent contends that the parties employ the “express” string in differing channels of trade. Complainant offers clothing and accessories at physical retail locations and online at “www.express.com”. Respondent provides a service, not goods. The service offers access to the World Wide Web, not tied to any particular goods or services. Respondent provides access in essentially a wholesale manner to customers who offer their content to third parties who ultimately consume such content. Complainant, by way of contrast, conducts trade directly with consumers on a retail basis. The <.express> domain has countless potential uses worldwide, whereas Complainant employs EXPRESS to sell specific goods to a specific clientele. Respondent contends that consumers will recognize the <.express> gTLD as a generic term that many use to convey their respective messages – whether commercial, political, etc. – online.
5. Respondent argues that Internet users are sophisticated about the medium that enables them to distinguish among various uses of domain names at the top and secondary levels, and are not likely to find themselves confused concerning the source of goods or services for which they search, or the source of Complainant’s goods in particular in contrast with the numerous other meanings and usages to which an owner of a generic <.express> domain may put its site. Respondent contends that Complainant’s speculation about what might happen does not satisfy its burden of proof to deprive Respondent of its right to operate the gTLD which it has spent resources to acquire.
6. Respondent contends that Complainant has shown no improper intent on Respondent’s part, but that Complainant has mischaracterized Respondent’s application and statements.
7. Respondent claims that Complainant has shown no actual confusion between the applied-for <.express> string and its trademark. Respondent states that no real confusion can exist between a dictionary term used in a neutral way throughout the world, as Respondent would do, and the same term associated with particular products in a particular geographic location.
8. In terms of other considerations, Respondent contends that law and policy makers, including ICANN in this case, have not imposed the initial policing burden on the Internet service provider. That responsibility has always fallen on the content provider that has a much greater interest, incentive and ability to uncover misuses of its claimed intellectual property. Respondent argues that to require otherwise would unjustifiably burden the service provider, Respondent here, and stifle free speech,

impede the growth and progress of the Internet and other media for conducting business and disseminating information, and harm the public by hindering or prohibiting access to content, goods, services and other material. Dispute resolution providers, including under the UDRP, have resisted imposing prior restraint on speech, commerce and other Internet activities, and regularly grant “easements” over intellectual property rights (such as trademark) in order to facilitate that (citing 15 U.S.C. § 1115(b)(4); *United States Shore Corp. v. Brown Group, Inc.*, 923 F.2d 844 (2d Cir. 1990); see also *Equality Charter School, Inc. v. Mona Davids / A Happy DreamHost Customer*, WIPO Case No. D2011-1226 (Sept. 20, 2011) (<equalitycharterschool.com>).

Respondent argues that the Panel should reject the Objection firmly and without hesitation.

## 6. Discussion and Findings

Complainant and Respondent are admirably represented by sophisticated counsel, and each side has presented its position in a clear and well-supported way.

This is a somewhat unusual proceeding in that it involves a Procedure that has been newly-created for a set of circumstances that is newly-created. The parties are not in substantial disagreement regarding the basic facts relevant to the Panel’s decision, though differing as to their weighting. The parties certainly are in disagreement about what the Panel should decide based on those facts.

ICANN has created a framework for the establishment of a set of new domain name registries identified by newly-established gTLDs. Like the existing gTLDs, these new gTLDs will be comprised of “strings”. Many of these strings will represent words in some language. These words may in some cases be identical from a visual and auditory standpoint to words adopted and functioning as trademarks. String-similarity or identicalness between applied-for gTLDs and common dictionary or generic terms was certainly foreseeable – it was, as a practical matter, inevitable. That being the case, ICANN might have prescribed a rule that common dictionary or generic terms are automatically entitled to serve as gTLDs notwithstanding the presence of an identical trademark term, and that any misuse of the trademark term by a third party with a second-level domain needs to be addressed in *ex post* dispute settlement proceedings. Alternatively, ICANN could have decided that a trademark owner with rights in a common dictionary or generic term (e.g., based on arbitrary usage) was automatically entitled to block third-party adoption of the common term as a gTLD, placing a strong premium on brand protection, with trademark ownership trumping common dictionary or generic usage. ICANN chose neither of these categorical options, instead placing assessments of disputes between owners of trademarks making use of common dictionary or generic terms and new gTLD applicants asserting legitimate interests in use of those terms in the hands of panels such as this one.

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. There are a wide range of second-level domains that might be used in association with the <.express> gTLD string that would not give rise to a likelihood of confusion with Complainant’s trademark (e.g., <restaurant.express>, <trucking.express>, <banking.express>, <internetaccess.express>, <news.express>, <travel.express>, and so on). The Panel



recognizes that, should Respondent successfully secure the gTLD, Complainant may be required to address potential Internet user confusion in the commercial marketplace for its products based on the registration (or attempted registration) of certain second level domains. However, Complainant faces this risk because it adopted a common word in the English language for its trademark. It may be difficult to protect that term outside its channel of trade. Moreover, Complainant has applied for the identical <.express> string as a gTLD in competition with Respondent. Ultimately, the parties may well end up in an auction contest for the gTLD. This is not Complainant's last chance to secure its trademark as a gTLD.

As the Objection is based on trademark rights, the Panel has considered the following non-exclusive factors:

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

The Panel notes that both parties have listed the relevant gTLD string in their pleadings incorporating the dot (".") that precedes the word term "express". On the other hand, Respondent's application to ICANN lists the applied-for string as "express", and the ICANN general posting of applied-for strings shows terms, including "express", without the ".".

It is in this case an interesting esoteric question whether the applied-for gTLD should be assessed from a likelihood of confusion standpoint with or without the ".". In the present proceeding, because the trademark term EXPRESS and the applied-for string use an identical set of letters, the Panel considers that the terms are either "identical" or "essentially identical" from the standpoint of appearance and sound, regardless whether the string is understood to include the ".". If addition of the prefix "." in a case where word terms are identical is sufficient to eliminate likelihood of confusion, then it is difficult to see how virtually any trademark term and gTLD string could be confusingly similar. The "." in virtually every case would eliminate that possibility. On the assumption that ICANN did not intend a result that would render the Applicant Guidebook and Procedure inutile, the Panel compares the EXPRESS trademark and the <.express> gTLD without further consideration of the ".".

On that understanding, the appearance and sound of the applied-for gTLD and Complainant's EXPRESS trademark are identical.<sup>10</sup> It is possible that in languages other than English the two terms would be pronounced in a different way than they are in English. However, the Panel presumes that in such case the terms would have the same sound, even if different from the sound in English, and therefore are identical in sound from the perspective of that other language.

A much more difficult question is whether the Complainant's EXPRESS trademark and the applied-for gTLD are similar in meaning. Complainant has argued, and the Panel accepts, that Complainant uses the term EXPRESS in an arbitrary manner to identify apparel and fashion accessories. Both Complainant and Respondent agree that EXPRESS serves a trademark function for Complainant in an arbitrary association with the goods and services provided under the trademark. EXPRESS has no accepted meaning associated with apparel and fashion accessories.

Both Complainant and Respondent have provided a substantial number of "dictionary" meanings for the term EXPRESS, which may function as a verb, noun or adjective<sup>11</sup> (see Factual Background, *supra*). Without exhausting the possibilities, as a verb the term can mean to put into words or state an idea (e.g., I "express" my views in this decision), or to demonstrate feelings (e.g., the artist will "express" himself); as a noun it can mean a type of delivery system or transportation (sending the package by "express"); as an adjective it can refer to an explicit statement (e.g., the contract stated in "express" language), or a type of travel (e.g., taking

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<sup>10</sup> Even assuming inclusion of the "." in the gTLD string, Complainant's EXPRESS trademark and the <.express> string are "essentially identical" in appearance.

<sup>11</sup> The term may also function as an adverb, but in this regard overlaps with the adjectival use, and for sake of clarity the decision limits the list of possibilities.

the “express” train or the “express” routing). The term is routinely used in common English for a variety of intended meanings that must be determined from the context of usage. When a person says “I am going to send it to you by express”, they mean they will send it by a rapid form of transportation, not that they intend to create a work of art.

EXPRESS as used by Complainant in its trademark, according to Complainant, has no defined meaning. The term is used arbitrarily. Respondent has indicated that it has applied for the <.express> gTLD string because it is a generic term with a wide variety of meanings that may appeal to the general public for use with second-level domain terms that may be associated with one or more of those meanings. If the term EXPRESS as a trademark when associated with apparel has *no* particular meaning, it logically follows that Respondent’s applied-for <.express>, standing alone, could well have a different meaning when used in the traditional or common language usage sense.

The Panel concludes that Complainant’s trademark and Respondent’s applied for gTLD are identical in appearance and sound, but here are not necessarily identical or similar in meaning.

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

Respondent does not dispute that Complainant has rights in the EXPRESS mark, nor does it argue that Complainant acquired or used those rights in a way that was not *bona fide*.<sup>12</sup> Respondent’s argument goes to the scope of the rights conferred by Complainant’s EXPRESS trademark, and the extent to which they may be used to prevent third-party usage.

The Panel determines that Complainant acquired and has used its mark in a *bona fide* way.

*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.*

Complainant argues that its EXPRESS trademark is well known in the relevant sector of the public as associated with its goods and services. The parties are not in material disagreement as to Complainant’s product and services line. Complainant offers and sells women’s and men’s apparel, and fashion accessories including watches, shoes, jewelry and perfume. Complainant’s trademark registrations with the USPTO cover such apparel and fashion accessories.

Complainant by its own account targets male and female consumers between 20 and 30 years of age.

Complainant argues that its trademark is well-known worldwide, or at least in a large number of countries.

Complainant seeks to establish the well-known character of its EXPRESS trademark by reference to sales volumes and advertising expenditures. Complainant provides evidence that in 2012 its gross revenues were approximately USD 2.15 billion, and that in 2012 its advertising expenditures were approximately US\$89 million. Complainant has provided evidence that by 1991 its retail sales of EXPRESS-branded goods and services exceeded USD1 billion per year. Complainant had provided evidence that since 1986, its total sales volume is approximately USD 43.4 billion, and advertising expenditures for the same time frame are approximately USD 811.7 million.

Complainant indicates that it operates over 600 retail store outlets. However, as Respondent notes (with reference to Complainant’s public annual report), only a small percentage of these stores are outside the United States, and most of those are in Canada. Complainant indicates that since 2009 it has sold approximately USD 90 million of EXPRESS-branded products at stores outside the United States. If one

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<sup>12</sup> While Respondent uses “reservation of rights” language in some parts of its pleading, it does not make a direct and supported argument that Complainant lacks trademark rights as to its specific goods and services.

may assume that means roughly USD 30 million a year of sales outside the United States, and that total revenues in 2012 were approximately USD 2.15 billion, this means that about 1.4% of Complainant's revenues were generated from retail stores outside the United States.

Complainant indicates that in 2010, 60% of its sales were through its e-commerce website located at <express.com>. Complainant indicates that in 2010 EXPRESS was named one of the Top 15 Mobile Commerce Destinations of 2010 by Mobile Commerce Daily. Complainant further indicates that consumers in over 60 countries have purchased EXPRESS-branded products through e-commerce.

To establish recognition of its EXPRESS mark, Complainant indicates that in 2012 EXPRESS was listed at number 59 on Women's Wear Daily's (WWD) Most Recognized Consumer Brands list. Complainant has not provided any explanation regarding how the WWD list is compiled or the factors that are considered in the rankings. Nor has Complainant indicated what it considers to be the trademark law significance of this particular ranking. Being ranked 59th among an industry group may have quite different significance depending on the industry or the target consumer group.

Complainant has not provided information regarding how its revenue figures compare with other providers of apparel and fashion accessories, and where it stands relative to its peer group. Such information would be useful in an assessment of whether consumers are more or less familiar with its branded goods.

Complainant has provided evidence sufficient to establish that there is recognition of its EXPRESS trademark among a segment of the consuming public in connection with its operation of branded retail stores in the United States and online sales of EXPRESS branded goods. Complainant appears to have acknowledged that its advertising and promotion efforts are directed toward a relatively narrow band of consumers, i.e., those within the 20 to 30 year old age group. Complainant has not presented survey evidence that might best establish the extent to which consumers in that 20 to 30-year-old age group associate the term EXPRESS with its trademark products and services.

The sales volumes outside the United States are a small fraction of its overall sales volumes, and this does not appear to the Panel sufficient to establish that the EXPRESS brand is well known among the relevant consuming public outside the United States.

Respondent has presented survey evidence which it suggests establishes that among Internet user survey participants who indicated a significant interest in fashion (41% of participants, significantly more likely to be female, under 35 years old, and earning over USD 75,000 per year), only a small portion (8%) "spontaneously associate the word 'express' with 'fashion'", even though 51% of such participants identified "express" as at least more of a brand than a person, place or thing. One half of the respondents associated "express" with speed, 10% with communication, 8% with transportation, and 13% with postage. Associations were also made with brands such as "Federal Express", "American Express" and "Panda Express". According to Respondent, because of the associations of "express" with a variety of brands, it was not possible to identify what part of the survey population believed "express" referred to Complainant and not another brand.

Complainant has criticized the structure and administration of the survey, and has suggested that the Panel exclude it from evidence, or give it little weight. Respondent has addressed the criticism, but also indicated that the Panel might use that criticism to evaluate the weight of the survey evidence, rather than disregarding it entirely. Respondent indicates that its case here does not rely on the survey.

Complainant indicates that its target consumer group is men and women 20 to 30 years old, and Respondent's group indicating "very interested in fashion" is predominantly women under 35 years old. There is not a "perfect overlap" between Respondent's very interested participants, and Complainant's target consumer group, but it is reasonable to infer some level of relevance.

Putting aside the specific details of the percentages, Respondent's "very interested" survey participants appear to have substantially associated the term "express" with common dictionary meanings, with several well-known brands, and Complainant's EXPRESS apparel and fashion accessory brand among those brands.

The Panel has reviewed Complainant's criticism of the survey structure and administration. It does not agree with Complainant that Respondent's survey should have qualified the term "express" with terms relating to fashion so as to identify for survey participants the nature of the industry as to which the trademark was being assessed. Respondent was attempting to provide an assessment of how Internet users would view the gTLD <.express> without a second-level domain attached. This is to support its claim that the gTLD does not itself unfairly take advantage of rights of Complainant. Complainant by way of contrast is attempting to demonstrate that the gTLD when accompanied by a second-level domain, such as "jeans" or "blouses", is likely to be associated with Complainant. But these are different questions. Respondent has as much as conceded that certain second-level domains may give rise to a likelihood of confusion with Complainant's mark, but argues that this will be a limited number of second-level domains (out of a large universe), and that Complainant will have ample legal and procedural mechanisms to address such offending domain names.

The Panel does not exclude the survey from evidence. It takes from the survey some support for Respondent's position that the term "express" has a variety of meanings in the English language, and that when used standing alone among a part of the population under 35 years old the term does not predominantly call to mind Complainant's trademark.

The specific weight of this finding is of small or minor materiality to this decision. Complainant has not presented evidence that among any group of consumers the term "express" when used standing alone predominantly or strongly calls to mind Complainant and its trademark goods or services. Instead, Complainant has presented evidence that it sells a significant volume of EXPRESS branded apparel and fashion accessories. Complainant has not presented evidence regarding how even its target consumer group understands the term "express" relative to various potential meanings. That is, Complainant's target consumers may appreciate that Complainant's apparel and fashion accessories carry the EXPRESS brand or label, but when they see or hear the word "express" do they think "clothing"? Or, do they think, "fast"? Does the "express" checkout sign cause 20 to 30-year-olds to think of clothing, or getting through a line more quickly?

The Panel may accept for purposes of this decision that Complainant's EXPRESS mark is reasonably well known among 20 to 30-year-olds in the United States who are interested in fashion. But, being a reasonably well-known trademark is not the same thing as being a "strong" mark in the sense of legal capacity for excluding others from uses not within the class of goods or services provided under the trademark. Complainant may have a reasonably well-known trademark, but only insofar as it applies to apparel and fashion accessories. Because the term "express" is a common term in the English language with a variety of meanings, and is used frequently for those meanings, the scope of Complainant's trademark rights is circumscribed. See *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F. 2d 966, 973-76 (11th Cir. 1983), and; *Sun Banks of Fla. v. Sun Fed. Sav. & Loan Ass'n*, 651 F.2d 311, 315-17 (5th Cir. 1981); *Door Sys., Inc. v. Pro-Line Door Sys., Inc.*, 83 F.3d 169, 171-73 (7th Cir. 1996).

*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.*

Respondent claims to have conducted substantial due diligence in connection with preparing to submit its applications for various gTLDs, including the string that is subject of this proceeding. Complainant's trademark has been registered at the USPTO (and in countries outside the United States) for many years.

The Panel infers that Respondent knew, or reasonably should have known, of Complainant's EXPRESS trademark when it submitted its application for the gTLD.

Respondent acknowledges that it has submitted applications for several gTLDs that serve dual roles as generic terms and trademarks in the fashion industry (*i.e.* Coach, The Limited, and EXPRESS). In each case, Respondent considers that it should be allowed to operate the respective gTLD taking advantage of the generic term. Respondent points out that its application for more than 300 gTLDs would provide domain name applicants with a wide range of choice for domain names.

Regardless of outcome of the proceedings, the Panel considers that Respondent has at least a colorable argument that it has chosen the three dual-role gTLDs because of their common dictionary or generic meaning, and not to take unfair advantage of third-party trademark rights. The Panel stresses that each of these terms (*i.e.* "coach", "limited" and "express") has different characteristics and it may not be assumed that the outcome of proceedings under the Procedure involving them will share the same outcome. The Panel does not conclude that Respondent has engaged in a pattern of applying for gTLDs that are identical or confusingly similar to the trademarks of third parties in order to take unfair advantage of third-party trademark rights. Some or all of these applications may involve close or difficult decisions, but that does not provide a reason for attributing here some inappropriate motive to Respondent.

*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.*

Complainant has argued that Respondent has not used or made demonstrable preparations to use the sign corresponding to the gTLD in connection with a *bona fide* offering of goods or services because Respondent's sole use of the gTLD has been in connection with submitting its application to ICANN for the <.express> string registry, as well as applications for more than 300 other strings, and doing the basic "footwork" in connection with operating the registry. Complainant further argues that Respondent's proposed operation of the <.express> registry necessarily will interfere with legitimate exercise of Complainant's rights in its trademark because of second-level domains that would create a likelihood of confusion on the part of Internet users.

Respondent has argued that preparing the necessary technical and regulatory infrastructure to operate the <.express> registry, organizing investors, and working through the process of applying for the registry constitutes good-faith preparations to use the <.express> string. Respondent contends that providing prospective domain name registrants with the ability to establish second-level domains using the <.express> string will constitute provision of a service. Respondent states that its application indicates it will have in place all of the protections for trademark owners required by ICANN, as well as additional protections that it has devised. Respondent contends that because there is a much larger set of potential second-level domains than those that could potentially cause confusion with Complainant's EXPRESS trademark, Respondent should not be foreclosed from providing Internet users with the opportunity to register in legitimate ways that do not interfere with Complainant's trademark rights.

For the Panel, it seems reasonably clear that Respondent's operation of a new gTLD registry using the <.express> string would constitute provision of a service to domain name registrants and ancillary parties, and that Respondent's efforts to establish the technical and administrative infrastructure necessary to operate the registry constitute preparations to use the <.express> string.

A key question in this proceeding is whether Respondent's proposed operation of that service (*i.e.* providing opportunity to Internet users to register domain names using the <.express gTLD>) will "interfere with the legitimate exercise by [Complainant] of its mark rights". The string <.express>, as previously discussed, has a substantial variety of meanings useful to businesses and other prospective Internet users in connection with a substantial number of goods and services, and for conveying information. Complainant has rights in a

trademark that permit it to prevent third-party use of that trademark in ways that are likely to cause confusion as to whether Complainant is the source of goods or services, or sponsors or is affiliated with such goods or services. But, as a matter of basic trademark law principles recognized around the world, Complainant's rights to prevent third-party use are generally limited to the classes of goods and services for which it has established trademark rights. Such trademark rights may be extended to a certain degree through the application of antidilution laws and/or doctrines regarding well-known marks. In the United States, for example, dilution may be argued under theories of blurring or tarnishment. However, when a trademark owner has adopted a common dictionary term with a substantial number of potential meanings, antidilution law cannot be used to prevent common or generic usages of the common dictionary term. See *Hasbro v. Clue Computing*, 66 F. Supp. 2d 117, 130-36 (D. Mass. 1999), *aff'd*, 232 F.3d 1 (1st Cir. 2000); *Image Online Design v. ICANN*, 2013 U.S. Dist. LEXIS 16896, 22-24 (C.D. Cal. 2013). Otherwise, it would be possible for trademark owners to remove generic or common dictionary terms from the language usage by the public by arguing that any use of the generic term is confusing and blurs the trademark. Conceivably, an exceptionally well-known trademark using a common dictionary or generic term might be entitled to a somewhat enlarged scope of protection under an antidilution theory (see *Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1372-77 (Fed. Cir. 2012); *Image Online Design v. ICANN*, 2013 U.S. Dist. LEXIS 16896, 24 (C.D. Cal. 2013), but the record of this proceeding does not suggest that Complainant's EXPRESS trademark is such an exceptionally well-known mark. It is a mark that is reasonably well known among a segment of the public interested in a type of product.

The Panel is not in a position to make a technical assessment of Respondent's capacity to operate the proposed <.express> registry in the manner described in its application. That is a matter for ICANN and its related authorities to assess in connection with the process for approving or disapproving the application. ICANN has laid out certain requirements that gTLD registry operators will need to meet, including with respect to providing the opportunity for trademark owners to protect their rights in the new registries. Respondent has indicated in its application and in its pleadings in this proceeding that it intends to provide a series of mechanisms by which trademark owners will be able to protect their rights. Even if these mechanisms present efficiency concerns from a trademark-enforcement perspective, the Panel does not draw the conclusion that Respondent is intending to provide a service (*i.e.* operate the <.express> registry) in a way that will interfere with Complainant's legitimate exercise of its trademark rights.

Respondent's operation of a <.express> gTLD registry may create additional work for Complainant and its counsel. Complainant will need to monitor the <.express> gTLD, and use the procedures contemplated under ICANN rules to protect its trademark as it considers appropriate. The Panel accepts that second-level domains in that registry relating to apparel and fashion may create a likelihood of confusion among Internet users regarding whether Complainant is the source of the goods or services. But, this is a problem that Complainant will face because it has adopted a trademark that is a common dictionary or generic term, while using it in an arbitrary way. In doing that, Complainant does not achieve complete control over the "express" English-language lexicon.

The Panel determines that Respondent has made demonstrable preparations to use the <.express> gTLD for the *bona fide* provision of services in a manner that does not interfere with the legitimate exercise by Complainant of its trademark 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.*

Respondent has not asserted any trademark or other intellectual property rights in the <.express> string.

The Panel determines that Respondent does not have trademark or other intellectual property rights in the <.express> string.

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.*

Respondent has not argued that it has been commonly known by the sign corresponding to the <.express> string.

The Panel determines that Respondent has not been commonly known by the <.express> string.

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.*

As discussed under paragraph 5 above, Respondent intends to offer prospective domain name registrants the opportunity to register second-level domains using the <.express> gTLD. According to its application and pleading, Respondent does not itself intend to register and/or use such domain names in connection with its own websites.

The question can be reframed as whether Respondent's operation of a registry that allows third parties to register second-level domains in combination with a <.express> gTLD would create a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the gTLD.

As manifest from the long functioning of the .com, .org, .net and other gTLD registries, and the literally thousands of disputes under the UDRP (as well as national court proceedings) there are a myriad of ways in which second-level domains may create a likelihood of confusion with respect to trademarks. Does the use by existing registries of the .com, etc., gTLDs "create" a likelihood of confusion with respect to trademarks? Yes, in a sense, because without the operation of those registries, prospective domain name registrants would have more limited *fora* in which to take unfair advantage of trademark rights. But, as a general proposition, registries operating in a *bona fide* manner are not held legally responsible for allowing domain names to be registered that create a likelihood of confusion with respect to existing trademarks. It is the domain name registrants that are legally responsible.

Respondent is not intending to use the <.express> gTLD to create a likelihood of confusion with respect to Complainant's trademark. Respondent's intended use of the <.express> gTLD may heighten risk that third parties will seek to register domain names that are likely to create a likelihood of confusion with Complainant's trademark. The prospective presence of such risk is not a sufficient basis to deny Respondent the ability to secure the <.express> gTLD.

## 7. Decision

The Panel rejects the Objection for the following reasons:

The potential use of the applied-for gTLD by the Applicant/Respondent does not:

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

Respondent has applied for the <.express> gTLD string. As discussed in the detailed assessment above, the term "express" is a common dictionary or generic term in the English language with a variety of meanings. Complainant uses the term arbitrarily to identify apparel and fashion accessories, and related services. Respondent intends to operate a registry that will permit domain name registrants to register (through registrars) second-level domains that may take advantage of the wide variety of meanings of the term "express". By making available the use of the common dictionary or generic term "express" to Internet

users as a gTLD, Respondent is not as such taking unfair advantage of the distinctive character or reputation of Complainant's registered mark.

Or, (ii) unjustifiably impairs the distinctive character or the reputation of the Objector's mark;

Complainant has adopted a common dictionary or generic term in the English language as its trademark. The term "express" is not distinctive except in the channel of trade in which Complainant uses it. By using the term "express" as a gTLD string, Respondent is not unjustifiably impairing the distinctive character or reputation of Complainant's trademark. It is making available the use of a common term in the English language for Internet user registration in domain names. As such, the making available is justified.

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

Respondent is not proposing to register domain names using the <.express> gTLD for its own account. Third parties may register or seek to register domain names that may, if made operational, create a likelihood of confusion with Complainant's trademark by using second-level domains associated with apparel or fashion accessories. Respondent is obligated by ICANN rules to put in place mechanisms pursuant to which trademark owners may remedy abuse by third parties of their trademark rights. Respondent indicated its intention to put in place remedial mechanisms in addition to those required by ICANN rules. Even though a number of these mechanisms remain to be proven in practice, and Respondent has indicated that the gTLD string <.express> may initially allow certain domain name registrants to create a likelihood of confusion with Complainant's mark, a level of such risk is inherent with respect to all gTLDs.

ICANN could have but did not adopt a rule precluding adoption of gTLDs using common dictionary or generic terms that may also serve as trademarks. Respondent has applied for a gTLD that is a commonly used term with a variety of meanings in the English language. The Panel does not regard the possibility that some second-level domain name registrants may create domain names that seek to take unfair advantage of Complainant's trademark as a sufficient ground for finding that Respondent's intended use of the <.express> gTLD creates an impermissible likelihood of confusion with Complainant's trademark.

[signed]

**Frederick M. Abbott**

Sole Panel Expert

Date: July 9, 2013



**Addendum**

**EXPERT LEGAL RIGHTS OBJECTION PROCEDURAL ORDER NO. 1**  
**Express, LLC v. Sea Sunset, LLC**  
**Case No. LRO2013-0022**

The Panel has undertaken a preliminary review of the case file in this matter, including the supplemental “Reply Brief” transmitted by Objector to the Center by email dated June 17, 2013, the opposition by Applicant/Respondent to the Panel’s acceptance of that supplemental submission by email dated June 20, 2013, and the email response to that opposition by Objector by email dated June 20, 2013.

Objector’s Reply Brief is principally in two parts. The first part (“The Survey”) is directed to the word recognition survey that was referenced in and attached as a Declaration to Applicant’s Response (Declaration of Gordon Morris, Annex I), and attaches Exhibits A and B. The second part is self-styled “Fallacious Arguments and Misstatements of Law”, and attaches Exhibits C and D.

Applicant objects on two grounds. First, Applicant argues that this Panel did not request Objector’s Reply Brief such that there is no procedural basis for the Panel to accept the submission, grounding its argument in Article 17 of the New gTLD Dispute Resolution Procedure (“Procedure”), and referring also to Articles 14 and 18.

Article 17 of the Procedure does not use the term “request”, but rather states that the “Panel may decide whether the parties shall submit any written statements in addition”. This distinguishes it from Paragraph 12 of the Rules for Uniform Domain Name Dispute Resolution Policy (“UDRP Rules”), which uses the word “request”. The difference in wording may have been intended to anticipate the type of objection raised by Applicant by reducing the implication that an affirmative reaching out (i.e., a “request”) by the Panel is a predicate to a supplemental submission. But, even the more affirmative term “request” has been interpreted broadly by international adjudicatory bodies to include the acceptance of submissions that were not affirmatively solicited (see, e.g., WTO Appellate Body, United States-Import Prohibition of Certain Shrimp and Shrimp Products, WT/DS58/AB/R, 12 Oct. 1998, at paras. 107-08). It has been a consistent practice of dispute settlement panels under the Uniform Domain Name Dispute Resolution Policy (“UDRP”) to permit the acceptance of supplemental submissions that have not been affirmatively requested by a panel (see paragraph 4.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition). Reference to “exceptional cases” appears in Article 18 of the Procedure regarding the authority of the Panel to require the provision of additional evidence, not written statements as such.

The Panel considers that it has ample authority under Article 17 of the Procedure to accept or reject a written submission made by a party, regardless whether the Panel has specifically requested that submission. The Panel may decide to accept a supplemental submission that has been submitted.

Applicant’s second argument is that the Procedure is intended as an expeditious and cost-effective mechanism for the resolution of disputes typically based on a single round of pleadings. Applicant contends that Objector should have prepared its initial Objection to make its case in a way that anticipated Applicant’s Response, and that Objector is now attempting to cure a deficiency in its own preparation.

The Panel agrees that the overall objective of the Procedure is to provide an efficient and cost-effective means for resolving Legal Rights Objection disputes, and that, all things being equal, the Panel should not unnecessarily burden the parties with requests for additional legal pleadings and/or evidence. At the same time, the Panel considers it fundamental to equitable dispute settlement that parties have a reasonable opportunity to present their positions within the framework of the established rules.

Objector might have anticipated that Applicant would attempt to bolster its position by reference to a survey (as is not uncommon in fully litigated trademark disputes). Objector might have initially provided its own consumer survey as a counterweight to whatever survey Applicant might have produced. Recognizing this, the Panel nonetheless accepts the argument of Objector that it could not have reasonably anticipated and addressed in its initial pleading what it regards as significant technical deficiencies in the survey submitted by Applicant. As this is evidence “newly generated” by Applicant and not reasonably available to Objector prior to receipt of Applicant’s Response, it appears to the Panel fair and reasonable to allow Objector an opportunity to address it through its Reply Brief. The Panel accepts as an additional written submission from Objector that portion of its Reply Brief headed “The Survey” along with Exhibits A and B thereto.

However, the Panel does not accept that part of Objector’s Reply Brief headed “Fallacious Arguments and Misstatements of Law” or Exhibits C and D. The additional legal arguments are directed to resolving questions previously put before the Panel, and the Exhibit materials were available to Objector prior to the filing of its Objection.

Applicant has requested that it be allowed to provide further briefing if the Panel grants Objector’s request, and accepts Objector’s Reply Brief.

The Panel has rejected that part of Objector’s Reply Brief involving additional legal arguments and related exhibits. The Panel does not authorize Applicant to file additional argumentation that would be directed to the rejected portion of Objector’s Reply Brief.

Applicant’s request to file a further submission in respect to the word recognition survey presents certain difficulties. Objector has pointed to what it views as a number of technical deficiencies in the way in which the survey was conducted and the results reported, and therefore to the conclusions drawn from it. The Panel is not inclined to allow Applicant to revise the survey data or its presentation. To do so would open this proceeding to another round of briefing and argumentation. However, in the interests of fairness, the Panel allows Applicant to respond to Objector’s specific claims regarding the deficiencies of the survey and its presentation, without providing additional data or modifying the survey presentation. Such submission shall be limited to seven (7) typed pages.

Applicant has a period of five (5) calendar days from the date of this Procedural Order within which to provide a response as allowed in the preceding paragraph in electronic form to the Center and Objector. The Center will further communicate with the Panel.

This Procedural Order is issued without prejudice to the Panel’s authority to decide on additional written statements and/or evidence as it may be deemed appropriate.