

IN THE MATTER OF AN INDEPENDENT REVIEW PROCESS BEFORE THE
INTERNATIONAL CENTRE FOR DISPUTE RESOLUTION

Vistaprint Limited)
Contact Information Redacted)
)
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Claimant)
)
v.)
)
INTERNET CORPORATION FOR)
ASSIGNED NAMES AND NUMBERS)
)
Respondent)
_____)

ICDR Case No. 01-14-0000-6505

**ADDITIONAL SUBMISSION
REPLY TO ICANN'S RESPONSE BY VISTAPRINT LIMITED**

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1. This IRP concerns ICANN's handling of Vistaprint's application for the generic top-level domain (gTLD) .webs. ICANN has accepted an arbitrary and baseless determination by an ICDR-appointed expert in which Vistaprint's application for .webs was considered confusingly similar to Web.com Group Inc. ('Web.com')'s application for .web. If upheld, this acceptance may allow ICANN to only delegate one of both applications.
2. ICANN has set a high standard for a finding of confusing similarity between two gTLD strings, requiring a likelihood of confusion with the average, reasonable Internet user. An expert, Professor Piet Desmet, has confirmed to Vistaprint that, by any standard, no Internet user is likely to be confused between .webs and .web.
3. In addition, Web.com had previously accepted that the average, reasonable Internet user that may be interested in Web.com's services is sophisticated enough to understand the difference between WEB.COM and WEBCOM, terms which are even more similar than .webs and .web. Indeed, Web.com's <web.com> domain name and Vistaprint's <webs.com> domain name have co-existed since 1996. Significant and distinct businesses have thrived under these separate domain names, with each business possessing its own independent identity and goodwill.
4. In an attempt to prevent Vistaprint's unique application for .webs going through, Web.com was the only applicant – out of the 7 applicants for .web – arguing that .webs and .web are confusingly similar. However, Web.com has never made a sound argument why .webs and .web are confusingly similar.
5. Much to Vistaprint's surprise, Web.com's unsubstantiated allegation of confusing similarity was accepted in string confusion objection (SCO) proceedings which contain numerous substantive and procedural errors.
6. Vistaprint has raised these issues with the ICANN Board through the appropriate request for reconsideration (RfR) procedure installed by ICANN, but the ICANN Board has nonetheless decided to accept the said expert determination.

7. Other applicants have equally criticized SCO proceedings. In a letter to ICANN’s CEO, United TLD Holdco, Ltd. denounced the process flaws in the SCO proceedings involving the strings .com and .cam. DERCars, LCC filed an RfR, challenging the expert determination in the SCO proceedings relating to the strings .car and .cars. Amazon EU S.a.r.l. filed an RfR, challenging the expert determination in the SCO proceedings relating to the strings .shop and .通販 (which means ‘online shopping’ in Japanese). The ICANN Board took action in each of these matters.

- With respect to the Expert Determination finding .cam confusingly similar to .com, the ICANN Board ordered that an appeals process be developed to address the “perceived inconsistent or otherwise unreasonable SCO Expert Determination”.
- With regard to the Expert Determination finding .cars confusingly similar to .car, the ICANN Board ordered its staff to propose a review mechanism. DERCars decided to withdraw its application for .cars before the review mechanism was implemented. As a result, it was no longer necessary for the ICANN Board to further consider the proposed review process.
- With regard to the Expert Determination finding .通販 confusingly similar to .shop, the ICANN Board ordered that an appeals process be developed to address the “perceived inconsistent or otherwise unreasonable SCO Expert Determination”.

8. While the ICANN Board took action in the above-mentioned matters, it did not do so with respect to the .webs / .web determination. However, the .webs / .web determination was equally unreasonable, and at least equally serious substantive and procedural errors were made in these SCO proceedings. There is no reason for ICANN to treat the .webs / .web determination differently.

9. Vistaprint is harmed by ICANN’s unequal treatment. In addition, the substantive and procedural errors in the SCO proceedings forced Vistaprint to spend time and effort (in preparing

an RfR, CEP and this IRP) in order to resolve the unreasonable outcome of the contention set determination.

10. Rather than mitigating Vistaprint's damage, in this IRP ICANN argues – as it did in other IRPs since the current IRP was initiated – that the ICANN Board is not responsible for ICANN accepting expert determinations and that there is no Board action for the IRP Panel to review. However, the ICANN Board is the only entity responsible for ICANN's actions. The ICANN Board deliberately decided not to remedy the substantive and procedural errors in the SCO proceedings, involving Vistaprint.

11. Vistaprint will demonstrate below that the IRP Panel has authority to decide whether or not actions or inactions on the part of the ICANN Board are compatible with ICANN's Articles of Incorporation and ICANN's By-laws. When the ICANN Board adopts policies or accepts determinations made according to those policies, it must ensure that such adoption complies with its Bylaws and Articles of Incorporation. This is no different with respect to the new gTLD program and ICANN's treatment of applications. The ICANN Board is responsible for the correct implementation of the new gTLD program. The ICANN Board cannot simply accept an expert determination because the process was allegedly followed, or because the Board finds that there is no demonstrable harm that directly follows from deviations in the process.

12. When there are clear violations of the process and the outcome is highly objectionable (all as listed in detail in the request for IRP), the ICANN Board must intervene, as it has done with regard to other applications. The ICANN Board cannot justify why it intervenes in certain cases (.cars / .car, .cam / .com and .通販 / .shop), but refuses to do so in another case (.webs / .web). This is a clear violation of its Bylaws and Articles of Incorporation. The Panel in the current IRP has authority to order that ICANN must comply with its Bylaws and Articles of Incorporation and must disregard the expert determination in relation to Vistaprint's .webs applications.

I. THE ERRONEOUS EXPERT DETERMINATION

A. ICANN applied its string similarity standard discriminatorily

13. As explained in Vistaprint’s request for IRP, the string confusion test is a high bar and SCO panels have to apply a strict standard.¹ ICANN has always stressed the strict nature of the string similarity standard. It has done so both during the development phase of the Applicant Guidebook (**RM 14**, p. 149, **RM 15**, p. 4) and, afterwards, in Board resolutions dealing with the implementation of the Applicant Guidebook’s string similarity standard (**RM 16**, rationale). Since the filing of Vistaprint’s request for IRP, the ICANN Board clarified how the string similarity standard must be applied. In its resolutions of 12 October 2014, the ICANN Board identified certain SCO determinations “*as not being in the best interest of the New gTLD Program and the Internet community*” and set out the rules for a re-evaluation of these SCO determinations (**RM 22**, p. 3):

- A first SCO determination that needed re-evaluation is the SCO determination in which ICDR’s expert accepted Verisign Inc.’s objection to United TLD Holdco Ltd. (‘United TLD’)’s application for .cam. We refer to this SCO determination as the ‘United TLD Determination’. In the United TLD Determination, ICDR’s appointed expert found United TLD’s application for .cam confusingly similar to Verisign Inc. (‘Verisign’)’s .com gTLD (**RM 23**). The ICANN Board decided that (i) the United TLD Determination was not in the best interest of the New gTLD Program and the Internet community and (ii) a new three-member panel must be established to re-evaluate the United TLD Determination (**RM 22**).

Verisign had also raised a SCO on the basis of its .com gTLD against the application for .cam by Dot Agency Limited and the application for .cam by AC Webconnecting Holding B.V. In both cases, the appointed experts determined that no confusing similarity existed

¹ Vistaprint’s Request for IRP, paras. 20-24.

between the .cam and .com strings (**RM 24 and 25**). We refer to these SCO determinations as the ‘Related .cam/.com Determinations’. The ICANN Board decided that the Related .cam/.com Determinations need no re-evaluation. In addition, the ICANN Board recommended that the three-member panel charged with re-evaluating the United TLD Determination must review the Related .cam/.com Determinations as background (**RM 22**).

- Another SCO determination that needed re-evaluation is the determination in which ICDR’s appointed expert accepted Commercial Connect LLC’s objection to Amazon EU S.à.r.l. (‘Amazon’)’s application for .通販 (which means .onlineshopping in Japanese) (**RM 26**). We refer to this SCO determination as the ‘Onlineshopping Determination’. ICDR’s appointed expert found in the Onlineshopping Determination that Amazon’s application for .通販 was confusingly similar to Commercial Connect LLC’s application for .shop. Commercial Connect LLC also invoked its application for .shop in a SCO against Top Level Domain Holdings Limited’s application .购物 (which means ‘shop’ in Chinese). ICDR’s appointed expert rejected the latter SCO (**RM 27**). We refer to this SCO determination as the ‘Related shop/.shop Determination’. The ICANN Board decided that a three-member panel needs to re-evaluate the Onlineshopping Determination and that no re-evaluation is needed for the Related shop/.shop Determination. The ICANN Board decided that the Related shop/.shop Determination must be reviewed as background by the three-member panel that is charged with re-evaluating the Onlineshopping Determination (**RM 22**).

14. The ICANN Board’s recommendations to the three-member panels charged with the re-evaluation of the United TLD Determination and the Onlineshopping Determination are clear. Related determinations – involving the same gTLD string(s) and finding that there is no confusing similarity – will not be re-evaluated and must be taken into account in the re-evaluations.

15. Upon instigation of the ICANN Board, ICANN had developed the same process for re-evaluating the SCO determination in which ICDR's appointed expert accepted Charleston Road Registry Inc. ('CRR')'s objection to DERCars, LLC's application for .cars. We refer to this SCO determination as the 'DERCars Determination'. In the DERCars Determination, ICDR's appointed expert found DERCars, LLC's application for .cars confusingly similar to CRR's application for .car. CRR had also objected to the applications for .cars by Uniregistry, Corp. and Koko Castle, LLC, claiming confusing similarity with CRR's application for .car. The latter objections by CRR were not successful. ICANN decided that DERCars, LLC should be given the option of having the DERCars Determination reviewed. ICANN was not allowing a review of the other SCO determinations involving .car and .cars (**RM 28**).²

16. The above shows that ICANN and its Board have always decided in favor of co-existence of 'similar' strings. The ICANN Board explicitly allowed singular and plural gTLD strings to co-exist (**RM 16**). To support this view, the ICANN Board referred to the existence of thousands of examples of singular and plurals within the DNS at second level, which are not registered to or operated by the same registrant. The ICANN Board *inter alia* referred to the co-existing car.com and cars.com (**RM 16**).

17. Why did the ICANN Board intervene in the DERCars determination – involving the strings .car and .cars – but refused to intervene in the SCO Determination involving .web and .webs? In view of the small number of SCO Determinations finding confusing similarity between two strings (**RM 29**), it is a true mystery why the ICANN Board intervened in some matters, but refused to do so in the SCO determinations on Vistaprint's applications for .webs.

² DERCars decided to withdraw its application for .cars before the review mechanism was implemented. As a result, it was no longer necessary for the ICANN Board to further consider the proposed review process.

18. If anything, the .webs/.web string pair is less similar than the .cars/.car string pair. *Cars* is commonly used as the plural for *car*. Web, however, commonly refers to the world wide web, and as such, it is not normally a word where the plural form would be used.³

19. There were no reasons for a finding of confusing similarity between .webs and .web. Vistaprint is supported by the independent expert advice of Professor Piet Desmet, full professor at the University of Leuven in linguistics and language teaching methodology (Annex 32). Professor Desmet was asked whether the .webs and .web strings are confusingly similar, both regardless of the ICANN framework and within the ICANN framework on confusing similarity. Professor Desmet concluded that string confusion between .webs and .web is highly improbable. Professor Desmet's conclusion was based on the following findings, which are well supported in scientific literature:

- Exterior letters serve as visual clues for word recognition. The first and last letters of a word have been shown to be more salient than the rest of the letters and to receive priority in processing. Readers can recognize a word even when its interior letters are scrambled. Exterior letters serve as visual clues for word recognition. The first and last letters of a word have been shown to be more salient than the rest of the letters and to receive priority in processing. Readers can recognize a word even when its interior letters are scrambled. As a result, visually, 'webs' and 'web' are recognized as two radically different words since their last letters are completely different.
- In the case of 'web' and 'webs', completely regular patterns allow for a one-to-one mapping of spelling to sound. In other words, a word that consists of completely regular patterns is spelled out exactly as it sounds. The sound of the word easily translates into the spelling of the word and *vice versa*. Words consisting of completely regular patterns

³ When referring to networks of fine threads constructed by spiders, 'webs' may be used as a plural for 'web'. However, in the context of the DNS, the word 'web' refers to the world wide web and not to a spider web.

facilitate word recognition. Professor Desmet considers that ‘webs’ and ‘web’ have completely regular patterns allowing for one-to-one mapping of spelling to sound, which highly facilitates the word recognition of both words.

- There is an extremely limited number of words that could be generated by changing only one single letter in ‘webs’ and ‘web’. In other words, ‘webs’ and ‘web’ have a limited number of orthographic neighbors. Words with a high number of orthographic neighbors are more difficult to recognize and have an inhibitory effect when reading, as evidenced by eye-fixation patterns. Words with fewer orthographic neighbors are more easily recognizable. Professor Desmet concludes that this results in a higher word recognition for ‘webs’ and ‘web’ which have a limited number of orthographic neighbors.
- Fourth, a reader will first decompose the word ‘webs’ into meaningful units. ‘Webs’ is composed of two meaningful units, namely ‘web’ and the plural marker ‘-s’. ‘Web’ only has one meaningful unit. For professor Desmet, this is an extra factor that enhances the ability to recognize the difference between ‘web’ and ‘webs’.
- The plural ‘-s’ is a completely regular plural and easily recognizable compared to irregular plurals (e.g. with vowel change such as ‘hero’/’heroes’) that have been proven to be less easily recognizable.

20. Professor Desmet considers the 5 elements above reason enough to dismiss the idea of string confusion in the case of ‘webs’/‘web’ (Annex 32).

21. Furthermore, by its own admission, and as argued by Vistaprint, Web.com considered that the average, reasonable Internet user that may be interested in the Web.com’s services is sophisticated enough to understand the difference between the much more similar WEB.COM and WEBCOM (Annexes 10 and 33). Finally, Web.com’s <web.com> domain name and Vistaprint’s <webs.com> domain name have co-existed since 1996 (Annexes 34 and 35). Significant and distinct businesses have thrived under these separate domain names, with each business possessing its own independent identity and goodwill.

22. In sum, Vistaprint could rely on both scientific evidence and close real-life evidence (including Web.com’s own considerations) that the average, reasonable Internet user is not confused between .webs and .web. Web.com’s allegation of confusing similarity was unsubstantiated and strongly rebutted by Vistaprint’s evidence. As a result, the SCO determination by the ICDR panel very much came as a surprise to Vistaprint.

B. The erroneous and discriminatory expert determination was only possible because of the many process violations

23. The surprising nature of the manifestly incorrect SCO determination on .webs inspired Vistaprint to examine the root causes of the erroneous determination. The examination revealed that numerous process violations surrounded the SCO determination. As explained in detail in Vistaprint’s Request for IRP, (i) errors were made in the appointment procedure, (ii) the SCO determination was untimely, (iii) the appointment of a biased panel led to the unjustified acceptance of additional submissions, (iv) appointed panels failed to maintain their independence and impartiality, (v) the appointed panel reversed the burden of proof, and (vi) the appointed panel failed to duly motivate its SCO determination, as it failed to respond to Vistaprint’s arguments.⁴

24. ICANN’s New gTLD Program required that (i) there was “*a clear and pre-published application process using objective and measurable criteria*” (**RM 30**, p. 4), (ii) all applicants for a new gTLD registry be “*evaluated against transparent and predictable criteria, fully available to the applicants prior to the initiation of the process*” (**RM 30**) and (iii) “[*d*]ispute resolution and challenge processes [*were*] established prior to the start of the process”. This would only be possible if a panel (ruling on a SCO or other objection) consisted of “*appropriately qualified experts appointed to each proceeding by the designated DRSP*”, as required by the program (**RM**

⁴ Vistaprint’s Request for IRP, paras. 33 and following.

5, Module 3-16). ICANN committed itself to communicate regularly with the ICDR and to seek to optimize the service that the ICDR provides as a DRSP in the New gTLD Program.

25. ICANN clearly failed. On 8 October 2014, ICANN’s former Chief Strategy Officer and Senior Vice President of Stakeholders Relations, Kurt Pritz, who had been leading the introduction of the New gTLD Program, witnessed on ICANN’s objection procedure:

“There is no doubt that the New gTLD Program objection results are inconsistent, and not predictable. The fact is most easily demonstrated in the ‘string confusion,’ objections where challenges to exactly the same strings yielded different results. [...] With globally diverse, multiple panelists invoking untried standards and questions of first impression in an industry with which they were not familiar and had little training, the panelists were bound to deliver inconsistent, unpredictable results. ICANN put no mechanism put [sic] into place to rationalize or normalize the answers. [...] It is my opinion that ICANN, having proven in the initial evaluation context that it could do so, should have implemented measures to create as much consistency as possible on the merits in the objection rulings, requiring DRSPs to educate and train their experts as to the specific (and only) standards to employ, and to review and correct aberrant results. The failure to do so resulted in violation of the overarching policy articulated by the GNSO and adopted by the Board at the outset of the new gTLD Program, as well as policies stated in the Bylaws and Articles of Incorporation concerning on discrimination, application of document policies neutrally, objectively and fairly, promotion of competition, and accountability.” (RM 31, emphasis added).

26. This man who had been leading the introduction of the New gTLD Program recognizes that the appointed panels had not received adequate training and were not familiar with the industry. In other words, he acknowledged that the panels were not ‘appropriately qualified experts’. This violation resulted in clear policy violations and a failure of ICANN to provide due process.

27. Justice must not only be done, it must also be seen to be done. ICANN has a duty to ensure compliance with its obligations to act in good faith, transparently, fairly, and in a manner that is non-discriminatory and ensures due process.⁵ In view of (i) the erroneous application of the string similarity standard, (ii) the numerous violations of the procedural rules, (iii) the lack of adequate training and appropriately qualified experts, and (iv) the resulting failure to provide the

⁵ Vistaprint’s Request for IRP, paras. 55-68.

required legal certainty, ICANN's acceptance of the erroneous SCO determination on .webs was a clear violation of ICANN's fundamental obligations.⁶

28. ICANN and its Board have done nothing to correct the numerous errors in the SCO process. The ICANN Board selected SCO determinations for which it proposed a re-evaluation. There is no reason for the ICANN Board to intervene in some matters and not to intervene in other matters, where the applicant suffered from at least equally severe policy violations. This is a clear violation of ICANN's duty to apply its standards, policies, procedures, or practices equitably and without discrimination.

II. THE ICANN BOARD'S OBLIGATION TO INTERVENE

29. ICANN only acts through its Board. As ICANN expressly recognizes⁷, the Board is ICANN's decision-making body and it cannot delegate its responsibilities.⁸ It is the only entity that can be held responsible for ICANN's actions. In relation to the New gTLD Program, the Applicant Guidebook explicitly confirms that "*ICANN's Board of Directors has ultimate responsibility for the New gTLD Program*" (**RM 5**, Module 5-4).

30. The fact that the ICANN Board may rely on third parties for advice does not alter the Board's responsibility. The Board remains ICANN's decision-making body. This means that the ICANN Board cannot blindly accept advice by third parties or expert determinations. The ICANN Board must always verify compliance with its Articles of Incorporation and Bylaws, particularly when the third party advice or expert determination is questioned. The fact that the ICANN Board cannot blindly accept third-party expert determinations is the reason why the Applicant Guidebook explicitly mentions that "*[t]he Board reserves the right to individually consider an application for a new gTLD to determine whether approval would be in the best*

⁶ Vistaprint's Request for IRP, 33-49.

⁷ ICANN's Response, para. 35: "*the Board is not permitted to outsource its decision-making authority*".

⁸ Article I, Section 1 of ICANN's Bylaws provide: "*Except as otherwise provided in the Articles of Incorporation or these Bylaws, the powers of ICANN shall be exercised by, and its property controlled and its business and affairs conducted by or under the direction of, the Board*" (**RM 2**).

interest of the Internet community. Under exceptional circumstances, the Board may individually consider a gTLD application. For example, the Board might individually consider an application as a result of [...] the use of an ICANN accountability mechanism” (RM 5, Module 5-4). Vistaprint used an ICANN accountability mechanism when it challenged the SCO proceedings and the expert determination on its application for .webs in RfR 14-5.

31. When the ICANN Board individually considers an application, it must make sure that it does not treat applicants inequitably and that it does not discriminate among applicants. Article II, Section 3 of ICANN’s Bylaws provides that “*ICANN shall not apply its standards, policies, procedures, or practices inequitably or single out any particular party for disparate treatment unless justified by substantial and reasonable cause, such as the promotion of effective competition” (RM 2).* However, with regard to the SCO proceedings, the ICANN Board has done the exact opposite. It created the opportunity for some aggrieved applicants to participate in an appeals process, while denying others.

32. As explained above, there is no justification for this disparate treatment, and the ICANN Board has not given any substantial and reasonable cause that would justify this discrimination.

III. THE IRP PANEL HAS THE AUTHORITY TO ORDER THAT THE ICANN BOARD REJECTS THE CHALLENGED EXPERT DETERMINATION

33. In accordance with Article IV(3) of ICANN’s Bylaws, an IRP Panel must determine whether the contested actions of the ICANN Board are consistent with applicable rules.⁹

34. As described in detail in Vistaprint’s Request for IRP, the set of rules against which the actions of the ICANN Board must be assessed includes: (i) ICANN’s Articles of Incorporation and Bylaws – both of which must be interpreted in light of ICANN’s Affirmation of Commitments, and both of which require compliance with *inter alia* International law and generally accepted good governance principles – and (ii) secondary rules created by ICANN,

⁹ See also ICANN’s Response, para. 36.

such as the Applicant Guidebook. In setting up, implementing and supervising its policies and processes, the Board must comply with the fundamental principles embodied in these rules. That obligation includes a duty to ensure compliance with its obligations to act in good faith, transparently, fairly, and in a manner that is non-discriminatory and ensures due process.¹⁰

35. The IRP Panel has authority to decide whether or not actions or inactions on the part of the ICANN Board are compatible with these principles. The most recent version of ICANN’s Bylaws¹¹ – which had not been introduced at the time of Vistaprint’s submission of its application for .webs¹² – also requires the IRP Panel to focus on whether the ICANN Board was free from conflicts of interest and exercised an appropriate level of due diligence and independent judgment in its decision making. However, these issues are mentioned by way of example only. The Bylaws nowhere restrict the IRP Panel’s remit to these issues alone.

36. In its Response to the Request for IRP, ICANN submits that its “*Bylaws specify that a deferential standard of review be applied when evaluating the actions of the ICANN Board*”.¹³ This is simply wrong. No such specification is made in ICANN’s Bylaws or elsewhere, and a restrictive interpretation of the standard of review would be inappropriate. It would fail to ensure accountability on the part of ICANN and would be incompatible with ICANN’s commitment to maintain (and improve) robust mechanisms for accountability, as required by Article 9.1 of ICANN’s Affirmation of Commitments (**RM 4**) and ICANN’s core values, which require ICANN to “*remain accountable to the Internet community through mechanisms that enhance ICANN’s effectiveness*” (**RM 2-3**, Article I(2)(10)).

37. The outcome of the IRP is binding upon ICANN. Since ICANN’s amendment of its Bylaws on 11 April 2013, IRP declarations have precedential value (**RM 2**, Article IV(3)(21), *in*

¹⁰ See Vistaprint’s Request for IRP, paras. 55-68.

¹¹ Adopted on 11 April 2013.

¹² In 2012.

¹³ ICANN’s Response, para. 33. A standard of review refers to the amount of deference that must be given in reviewing a decision of a lower court or tribunal. There is no legal basis and no reason to accord deference to actions of the ICANN Board.

fine).¹⁴ The precedential value – and binding force – of IRP declarations was recently confirmed in an IRP Panel declaration¹⁵ that itself has precedential effect. It follows that the IRP declaration requested in this case by Vistaprint would be binding upon ICANN. Any other outcome would effectively grant ICANN arbitrary and unlimited power. It would make ICANN virtually untouchable, something which was never intended¹⁶ and it would be incompatible with ICANN’s obligation to maintain and improve robust mechanisms for accountability (*E.g.*, **RM 4**, Article 9.1 and **RM2-3**, Article I(2)(10)).

IV. THE IRP PANEL MUST ORDER THAT THE ICANN BOARD REJECTS THE CHALLENGED EXPERT DETERMINATION

38. Vistaprint has demonstrated that numerous process violations in the SCO process have led to an erroneous SCO determination. Vistaprint was not given due process and ICANN’s acceptance of the SCO determination was not a fair and neutral application of ICANN’s policy on SCOs. ICANN’s acceptance of the SCO determination despite the lack of due process is attributable to the ICANN Board. The ICANN Board refused to take any action, even after Vistaprint – and many others, including Kurt Pritz who led the introduction of the New gTLD Program – demonstrated numerous policy violations. Rather than correcting these errors, the ICANN Board discriminated against Vistaprint even further by granting remedies to some, but

¹⁴ “*The declarations of the IRP Panel [...] are final and have precedential value*”.

¹⁵ See the declaration of 14 August 2014 by the IRP panel in Case No. 50 2013 001083 where it was decided that “[v]arious provisions of ICANN’s Bylaws and the Supplementary Procedures support the conclusion that the [IRP] Panel’s decisions, opinions and declarations are binding” and that “[t]here is certainly nothing in the Supplementary Rules that renders the decisions, opinions and declarations of the [IRP] Panel either advisory or non-binding” (**RM 32**, para. 98). The panel considered that ICANN’s Bylaws and the Supplementary Procedures were unambiguous as to the binding nature of an IRP declaration and that “*even if it could be argued that ICANN’s Bylaws and Supplementary Procedures are ambiguous on the question of whether or not a decision, opinion or declaration of the IRP Panel is binding, [...] this ambiguity would weigh against ICANN’s position*” (**RM 32**, para 108).

¹⁶ When ICANN was assigned the task of managing the Domain Name System, ICANN’s interim Chairman at the time, Esther Dyson, wrote, on behalf of the ICANN Board: “*We must create an organization that can begin to assume responsibility for the administration and policies of the Internet name and address system, and we must do so quickly, openly and effectively. This Board is committed to accomplishing all of these somewhat conflicting objectives*” (**RM 33**).

not to Vistaprint. The ICANN Board decision to discriminate and to deny Vistaprint of its right to due process are clear violations of ICANN's most fundamental obligations.

39. Any relief ordered must be sufficient to avoid another unfair, arbitrary and discriminatory decision. Evidently, Vistaprint's request for relief may have an impact on the outcome of the case on the merits. Vistaprint is convinced that .webs and .web would not have been put into a contention set – and that there would have been a different decision on the merits – if the SCO process had been organized, implemented and supervised in accordance with ICANN's established policies and ICANN's fundamental obligations. The expert advice submitted by Vistaprint shows that a proper implementation of the SCO process should have led to a different decision on the merits. The ICANN Board's decision to put .webs and .web into a contention set is unfair, arbitrary and discriminatory. This does not, however, make the request for relief a request for a decision on the merits.

40. Any outcome that allows the contention set between .webs and .web to remain would leave ICANN in ongoing violation of the fundamental principles that bind it, because, since this case began, ICANN has delegated various strings that are at least as similar to each other as .webs and .web. As shown in the [Annexes 36 and 37](#), the .car and .cars gTLDs have both been delegated and allow for the registration of domain names. The .auto and .autos gTLDs have also been delegated ([Annexes 38 and 39](#)), as have the .accountant and .accountants gTLDs ([Annexes 40 and 41](#)), as well as the .fan and .fans gTLDs ([Annexes 42 and 43](#)), the .gift and .gifts gTLDs ([Annexes 44 and 45](#)), the .loan and .loans gTLDs ([Annexes 46 and 47](#)), the .new and .news gTLDs ([Annexes 48 and 49](#)), and the .work and .works gTLDs ([Annexes 50 and 51](#)). ICANN should therefore delegate both .webs and .web. If the decision to put .webs and .web in a single contention set is upheld, then ICANN should also revoke the delegation of those gTLDs with at least equal string similarities. Any other outcome would result in Vistaprint continuing to suffer discrimination. ICANN would also remain in

violation of its contractual obligations and continue to deprive registry operators of legal certainty and their legitimate expectations. The only way in which ICANN can act in accordance with its Articles of Incorporation and Bylaws is to reject the determination that .webs and .web are confusingly similar and to dissolve the resulting contention set.

41. At the very least, it must be ordered that the SCO determination on Vistaprint's application is re-evaluated in accordance with the same procedure and with similar recommendations as in the re-evaluation procedures on the United TLD Determination and the Onlineshopping Determination. The appointed panel should take into account (i) the ICANN Board's resolutions on singular and plural gTLDs, on the DERCars Determination, on the United TLD Determination, and on the Onlineshopping Determination, and (ii) ICANN's decisions to delegate the car and .cars gTLDs, the .auto and .autos gTLDs, the .accountant and .accountants gTLDs, the .fan and .fans gTLDs, the .gift and .gifts gTLDs, the .loan and .loans gTLDs, the .new and .news gTLDs and the .work and .works gTLDs. For reasons of procedural economy, Vistaprint sees no reason why the IRP Panel would not be entitled to make such a determination.

V. RELIEF REQUESTED

42. In light of the foregoing and Vistaprint's request for IRP, Vistaprint respectfully requests that the IRP Panel issue a declaration:

- Finding that ICANN breached its Articles of Incorporation, its Bylaws, and the gTLD Applicant Guidebook;
- Requiring that ICANN reject the determination that .webs and .web are confusingly similar and disregard the resulting contention set;
- In subordinate order, requiring that ICANN organizes a new independent and impartial string confusion objection procedure, according to which a three-member panel re-evaluates the Expert Determination in the matter before the ICDR with case numbers 50 504 T 00221 13 and 50 504 T 00246 13, taking into account (i) the ICANN Board's resolutions on singular and plural gTLDs, on the DERCars Determination, on the United TLD Determination, and on the Onlineshopping Determination, and (ii) ICANN's decisions to delegate the .car and .cars gTLDs, the .auto and .autos gTLDs, the .accountant and .accountants gTLDs, the .fan and .fans gTLDs, the .gift and .gifts gTLDs, the .loan and .loans gTLDs, the .new and .news gTLDs and the .work and .works gTLDs;
- In any event, awarding Vistaprint its costs in this proceeding; and
- In any event, awarding such other relief as the Panel may find appropriate or Vistaprint may request.

Respectfully submitted,



Flip Petillion,
Crowell & Moring LLP

Contact Information Redacted

Counsel for Claimant

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2. ICANN's Bylaws of 11 April 2013
3. ICANN's Bylaws as amended on 16 March 2012, *available at* <http://www.icann.org/en/about/governance/bylaws/bylaws-16mar12-en.htm>
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17. ICDR Supplementary Procedures for String Confusion Objections (DRSP Rules)
18. Announcement by the ICDR
19. Memorandum of Understanding between ICANN and the ICDR
20. NGPC Resolution 2014.02.05.NG02
21. Declaration of the Independent Review Panel in ICDR Case No. 50 117 T 00224 08
22. NGPC Resolutions 2014.10.12.NG02 – 2014.10.12.NG03
23. Expert Determination in the matter before the ICDR with case number 50 504 229 13
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27. Expert Determination in the matter before the ICDR with case number 50 504 258 13
28. ICANN's Proposed Review Mechanism to Address Perceived Inconsistent Expert Determinations on String Confusion Objections
29. Overview of SCO determinations
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33. Transmittal Letter from Esther Dyson to Becky Burr of 6 November 1998.