INDEPENDENT REVIEW PROCESS

INTERNATIONAL CENTRE FOR DISPUTE RESOLUTION

VISTAPRINT LIMITED,
 	
    Claimant,
 	
    and
 	
INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS,
 	
    Respondent.
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	) ICDR CASE NO. 01-14-0000-6505

**ICANN'S RESPONSE TO CLAIMANT VISTAPRINT LIMITED'S
REQUEST FOR INDEPENDENT REVIEW PROCESS**

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INTRODUCTION

1.   The Internet Corporation for Assigned Names and Numbers ("ICANN") hereby

submits its Response to the Request for Independent Review Process ("IRP Request") submitted

by claimant Vistaprint Limited ("Vistaprint") on 11 June 2014.

2.   This Independent Review Process ("IRP") is conducted pursuant to Article IV,

Section 3 of ICANN's Bylaws, which creates a non-binding method of evaluating certain actions

of ICANN's Board of Directors.[1] This IRP Panel has one responsibility – to "declar[e] whether

the Board has acted consistently with the provisions of [ICANN's] Articles of Incorporation and

Bylaws."[2] An IRP is not an arbitration process, but rather a means by which entities that

participate in ICANN's processes can seek an independent review of decisions made by

ICANN's Board of Directors. Specifically, the IRP, when invoked, calls for the IRP Panel to

consider and then declare whether the IRP Panel believes an action or decision of ICANN's

Board of Directors was consistent with ICANN's Articles of Incorporation ("Articles") or

Bylaws.[3] The ICANN Board then considers that declaration. The declaration is not binding on

the ICANN Board but, of course, ICANN takes the IRP seriously and the Board will consider the

declaration at the first opportunity.

3.   The IRP Panel is to "apply a defined standard of review to the IRP Request,

focusing on":

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[1] ICANN's Bylaws, *available at* http://www.icann.org/en/about/governance/bylaws and Cl. Ex. RM-2.
Vistaprint submitted two sets of numbered exhibits: (1) an "Annex"; and (2) "Reference Materials".
Citations to "Cl. Ex. Annex- __" refer to exhibits submitted in Claimant Vistaprint's Annex, citations to
"Cl. Ex. RM-__" refer to exhibits submitted in Claimant Vistaprint's Reference Materials, and citations to
"Resp. Ex. __" refer to exhibits submitted with Respondent ICANN's Response.
[2] Bylaws, Cl. Ex. RM-3, at Art. IV, § 3.4. Vistaprint submitted as Cl. Ex. RM-2 ICANN's Bylaws of 11
April 2013. ICANN's Bylaws have been revised since that time, but the provisions relevant to
Vistaprint's IRP Request and ICANN's response have not changed. For ease of reference, ICANN will
refer to the Bylaws as submitted by Vistaprint in Cl. Ex. RM-2.
[3] Bylaws, Cl. Ex. RM-3, at Art. IV, § 3.4.

a. did the Board act without conflict of interest in taking its decision?;

b. did the Board exercise due diligence and care in having a reasonable amount of facts in front of them?; and

c. did the Board members exercise independent judgment in taking the decision, believed to be in the best interests of the company?[4]

4.   As the Bylaws make clear, the IRP addresses challenges to conduct undertaken by ICANN's Board of Directors; it is not available as a mechanism to challenge the actions or inactions of ICANN staff or third parties that may be involved with ICANN's activities.

5.   Vistaprint's IRP Request relates to its two applications to operate a .WEBS generic Top Level Domain, or "gTLD." Vistaprint submitted it applications to ICANN in connection with ICANN's program to facilitate the creation of hundreds of new gTLDs to supplement those that have existed for many years, such as .COM, .NET, and .ORG. ICANN is administering this "New gTLD Program" pursuant to an Applicant Guidebook ("Guidebook") that ICANN adopted in June 2011 following years of consideration and public input.[5] The window for submitting new gTLD applications, which was open to all interested entities, commenced on 12 January 2012, and ICANN received 1,930 new gTLD applications.

6.   In addition to VistaPrint's applications to operate a .WEBS gTLD, several entities applied to operate a .WEB gTLD. Pursuant to the Guidebook, Vistaprint's .WEBS applications were challenged by one of the applicants for .WEB in an independent dispute resolution process. In this dispute proceeding,[6] an expert panel ("Expert Panel") selected by the ICDR[7] was tasked with determining whether the relevant .WEBS and .WEB applications are so similar as to be

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[4] *Id.*

[5] Vistaprint included the New gTLD Applicant Guidebook (version of 4 June 2012) as Cl. Ex. RM-5 ("Guidebook"). The Guidebook is also available at http://newgtlds.icann.org/en/applicants/agb.

[6] Guidebook, Cl. Ex. RM-5, at § 3.2.3.

[7] The International Center for Dispute Resolution ("ICDR").

confusing to Internet users. If the Expert Panel determined pursuant to the process set forth in

the Guidebook that these applications were confusingly similar, only one of them could proceed.

7. In the dispute involving Vistaprint's applications for .WEBS and the Objector's

application for .WEB, the Expert Panel determined they were confusingly similar.

8. Vistaprint sought to overturn the Expert Panel's decision by filing with ICANN a

"Reconsideration Request," which is another ICANN accountability mechanism by which

ICANN's Board Governance Committee ("BGC") evaluates whether ICANN properly followed

its policies and procedures in taking the challenged action. The BGC found that neither the

Expert Panel nor ICANN failed to follow policies and procedures, and therefore it denied

Vistaprint's Reconsideration Request.

9. In this IRP, Vistaprint challenges the underlying Expert Panel Determination as

well as the denial of Vistaprint's Reconsideration Request. Vistaprint first claims that ICANN's

Board violated its Articles and Bylaws by "blindly accepting" the Expert Panel's Determination

without reviewing its analysis or result. There is, however, no requirement that ICANN's Board

conduct such an analysis. Indeed, "accepting" or "reviewing" the Expert Panel's Determination

is not something ICANN's **Board** is tasked with doing or not doing. Per the Guidebook, the

"findings of the panel will be considered an expert determination and advice that ICANN will

accept within the dispute resolution process."[8] Following receipt of expert determinations, it is

ICANN *staff* that is tasked with taking the next step, not ICANN's Board. As such there is no

Board action in this regard for the IRP Panel to review.

10. Next, Vistaprint claims that ICANN breached its Articles and Bylaws when

ICANN's BGC denied Vistaprint's Reconsideration Request without referring the matter to the

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[8] Guidebook, Cl. Ex. RM-5, at § 3.4.6.

entire ICANN Board. But ICANN's Bylaws specifically permit the BGC to reach its own conclusion when an ICANN staff action or inaction is at issue, as it was in Vistaprint's case.

11.   Finally, without identifying any particular Article or Bylaws provision violated, Vistaprint claims that the BGC just "got it wrong" when it denied Vistaprint's Reconsideration Request. But the BGC did precisely what it was supposed to do in reviewing Vistaprint's Reconsideration Request – it reviewed the Expert Panel's and ICANN staff's compliance with policies and procedures, rather than the substance of the Expert Panel's determination, and found no policy or process violations.[9]

12.   Ultimately, Vistaprint has initiated this IRP because Vistaprint disagrees with the Expert Panel's Determination and the BGC's finding on Vistaprint's Reconsideration Request. ICANN understands Vistaprint's disappointment, but IRPs are not a vehicle by which an Expert Panel's determination may be challenged because neither the determination, nor ICANN accepting the determination, constitutes an ICANN Board action. Nor is an IRP the appropriate forum to challenge a BGC ruling on a Reconsideration Request in the absence of some violation by the BGC of ICANN's Articles or Bylaws. Here, ICANN followed its policies and processes at every turn with respect to Vistaprint, which is all it is required to do.

BACKGROUND FACTS

Background Information On ICANN

13.   ICANN was formed in 1998. It is a California not-for-profit public benefit corporation. As set forth in its Bylaws, ICANN's mission "is to coordinate, at the overall level,

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[9] The BGC's determination is found at Cl. Ex. Annex-26.

the global Internet's system of unique identifiers, and in particular to ensure the stable and secure option of the Internet's unique identifier systems."[10]

14. ICANN is a complex organization that facilitates input from stakeholders around the globe. ICANN has an international Board of Directors, nearly 300 staff members, and an Ombudsman. However, ICANN is much more than just the corporation—it is a community of participants. In addition to the Board, the staff, and the Ombudsman,[11] the ICANN community includes an independent Nominating Committee,[12] three Supporting Organizations ("SOs"),[13] four Advisory Committees ("ACs"),[14] a group of technical expert advisors,[15] and a large, globally distributed group of community members who participate in ICANN's processes.

15. In its early years, and in accordance with its Core Values, ICANN focused on increasing the number of companies that could sell domain name registrations to consumers. ICANN also focused on expanding, although more slowly, the number of companies that operate gTLDs. In 2000, ICANN approved a few new gTLDs in a "proof of concept" phase that was designed to confirm that adding additional gTLDs would not adversely affect the stability and security of the Internet. In 2004 and 2005, ICANN approved a few more gTLDs.

Background Information On The New gTLD Program

16. The New gTLD Program constitutes by far ICANN's most ambitious expansion of the Internet's naming system. The Program's goals include enhancing competition and consumer choice, and enabling the benefits of innovation via the introduction of new gTLDs, including both new ASCII and non-ASCII internationalized domain name (IDN) gTLDs. In

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[10] Bylaws, Cl. Ex. RM-2, at Art. I, § 1.
[11] *Id*. at Art. V.
[12] *Id*. at Art. VII.
[13] *Id*. at Arts. VIII-X.
[14] *Id*. at Art. XI.
[15] *Id*. at Art. XI-A, § 2.

developing the Program with the ICANN community, numerous versions of the Guidebook were

drafted. The Guidebook provides instructions to gTLD applicants and forms the basis for

ICANN's evaluation of new gTLD applications.[16]

17. Within the New gTLD Program, section 3.2.1 of the Guidebook enumerates

grounds upon which objections to gTLD applications may be filed.[17] If an objection is filed on

the grounds that an applied-for string is confusingly similar to another string (existing or applied-

for), Section 3.2.3 provides that the ICDR will administer the dispute resolution process.[18]

18. Section 3.5.1 of the Guidebook provides that an objection will be upheld

according to the following standard:

> A DRSP panel hearing a string confusion objection will consider whether
> the applied-for gTLD string is likely to result in string confusion. String
> confusion exists where a string so nearly resembles another that it is likely
> to deceive or cause confusion. For a likelihood of confusion to exist, it
> must be probable, not merely possible that confusion will arise in the mind
> of the average, reasonable Internet user. Mere association, in the sense that
> the string brings another string to mind, is insufficient to find a likelihood
> of confusion.[19]

19. If strings are determined to so nearly resemble each other that it is likely to

deceive or cause confusion, the strings will be placed in a contention set, which is then resolved

pursuant to the contention set resolution processes set out in the Guidebook.

20. Per the Guidebook, the dispute resolution provider selects the expert panel that

renders a final determination on an objection.[20] Accordingly, ICANN's Board played no role in

selecting the Expert Panel or issuing the Determination; Vistaprint does not claim otherwise.

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[16] Vistaprint attached the 4 June 2012 version of the Guidebook to its IRP Request as Exhibit RM-5; the String Similarity Review provisions in this Guidebook version govern Vistaprint's application for .WEBS.
[17] Guidebook, Cl. Ex. RM-5, at § 3.2.1.
[18] Guidebook, Cl. Ex. RM-5, at § 3.2.3.
[19] Guidebook, Cl. Ex. RM-5, at § 3.5.1.
[20] Guidebook, Cl. Ex. RM-5, at § 3.4.4, 3.4.6.

21.   The Guidebook does not provide for any procedure by which ICANN (or anyone else) is to conduct a substantive review of the Expert Panel's results.[21]

Relevant Facts Regarding Vistaprint's Applications For .WEBS

22.   Vistaprint filed one community and one standard application for .WEBS.[22] Web.com Group, Inc. ("the Objector"), along with six other applicants, each applied for .WEB.

23.   On 13 March 2013, the Objector objected (the "Objections")[23] to each of Vistaprint's applications,[24] claiming that "the applied-for gTLD string is confusingly similar to an existing TLD or to another applied-for gTLD string in the same round of applications."[25]

24.   On 23 May 2013, Vistaprint responded to the Objections.

25.   On 28 June 2013, the ICC appointed Mr. Steve Y. Koh, Esq. as the expert to consider the Objections (the "First Expert").

26.   On 19 July 2013, the Objector submitted a supplemental written statement replying to Vistaprint's response, to which Vistaprint objected; the First Expert accepted the submission and permitted Vistaprint to submit a sur-reply.

27.   On 1 October 2013, the ICDR removed the First Expert due to a conflict that arose and on 14 October 2013, the ICDR appointed Bruce W. Belding, Esq. as the expert (the

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[21] Guidebook, Cl. Ex. RM-5, at § 3.4.6.

[22] A community-based gTLD is a gTLD that is operated for the benefit of a clearly delineated community. An applicant designating its application as community-based must be prepared to substantiate its status as representative of the community it names in the application. A standard application is one that has not been designated as community-based. *See* http://newgtlds.icann.org/en/applicants/glossary.

[23] Because the Objections were consolidated and the Expert Panel issued just one Determination, this Recommendation may reference "Objection" and "Determination" in the singular or the plural; any singular references shall apply to both objections.

[24] On 6 May 2013, the ICDR consolidated the two objections, namely Case No. 50 504 T 00221 13 and Case No. 50 504 T 00246 13.

[25] Guidebook, Cl. Ex. RM-5, at § 3.2.1; *id.*, Cl. Ex. RM-5, Attachment to Module 3, New gTLD Dispute Resolution Procedure ("Procedure"), at Art. 2(e).

"Second Expert"). On 24 October 2013, the Objector challenged the appointment of the Second Expert, to which Vistaprint responded on 30 October 2013.

28.   On 4 November 2013, the ICDR removed the Second Expert in response to the Objector's challenge. On 20 November 2013, the ICDR appointed Professor Ilhyung Lee to serve as the expert to consider the Objector's Objection (the "Expert Panel"). No party objected to the appointment of Professor Lee.

29.   On 24 January 2014, the Expert Panel issued its Determination in favor of the Objector.[26] The ICDR then notified the parties of the Determination and ICANN staff posted the Determination on ICANN's website. Thereafter, Vistaprint filed a Reconsideration Request.[27] Reconsideration, per ICANN's Bylaws, involves a review conducted by the BGC.[28] Vistaprint's Reconsideration Request asked ICANN to reject the Determination and instruct a new Expert Panel to issue a new Determination.[29]

30.   The BGC denied Vistaprint's Reconsideration Request, finding "no indication that the ICDR or the Expert violated any policy or process in reaching the Determination."[30]

31.   Dissatisfied with the denial of its Reconsideration Request, and following an informal attempt to resolve or narrow the issues,[31] Vistaprint filed this IRP.[32]

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[26] Cl. Ex. Annex-24.

[27] *See* Vistaprint's Reconsideration Request (Request 14-5), *available at* https://www.icann.org/en/system/files/files/request-vistaprint-06feb14-en.pdf, Cl. Ex. Annex-25.

[28] *See* Bylaws, Cl. Ex. RM-2, at Art. IV, § 2.

[29] *See* Vistaprint's Reconsideration Request (13-5), Cl. Ex. Annex-25.

[30] *See* BGC Recommendation on Reconsideration Request 13-5, *available at* https://www.icann.org/en/system/files/files/determination-vistaprint-27feb14-en.pdf, and Cl. Ex. Annex-26.

[31] Request ¶ 53; Annex 28. Prior to initiating an independent review, parties are urged to enter into a period of cooperative engagement with ICANN for the purpose of resolving or narrowing the issues in dispute. Bylaws, Cl. Ex. RM-2, at Art. IV, § 3.14. The parties engaged in the cooperative engagement process before commencing the independent review at issue here but were not able to resolve the dispute.

[32] *See* Vistaprint's Notice of Independent Review.

STANDARD OF REVIEW

32.   The IRP is a unique mechanism available under ICANN's Bylaws. It is a non-binding process in which persons or entities that claim to have been materially and adversely affected by a decision or action of the ICANN Board that the person or entity asserts is inconsistent with ICANN's Articles or Bylaws may submit a request for independent third party review of that decision or action.[33]

33.   The IRP Panel is tasked with determining whether the Board's actions are consistent with ICANN's Articles and Bylaws.[34] ICANN's Bylaws specifically identify the deferential standard of review that the IRP Panel must apply when evaluating the actions of the ICANN Board, and the rules are clear that the IRP Panel is neither asked to, nor allowed to, substitute its judgment for that of the Board.[35]

34.   ICANN has appointed the ICDR as ICANN's IRP Provider. ICANN's Bylaws and the Supplementary Procedures that the ICDR has adopted specially for ICANN IRP proceedings apply here.[36] Unlike arbitration or mediation, the Bylaws expressly provide that the IRP be conducted via "email and otherwise via the Internet to the maximum extent feasible."[37] The IRP Panel may also hold meetings via telephone where necessary, and "[i]n the unlikely

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[33] Bylaws, Cl. Ex. RM-2, at Art. IV, §§ 3.1, 3.2.
[34] *See* Bylaws, Cl. Ex. RM-2, at Art. IV, §§ 3.2, 3.4.
[35] *See id.*
[36] Absent a governing provision in ICANN's Bylaws or the ICDR's Supplemental Procedures, the ICDR Rules apply. But in the event of any inconsistency between the Supplementary Procedures and the ICDR's Rules, the Supplementary Procedures shall govern. Bylaws, Cl. Ex. RM-2, at Art. IV, § 3.8; *see also* ICDR Supplementary Procedures for Internet Corporation for Assigned Names and Numbers, Independent Review Process, § 2, *available at* https://www.adr.org/cs/groups/international/documents/document/z2uy/mde0/~edisp/adrstage2014403.pdf ("Procedure").
[37] Bylaws, Cl. Ex. RM-2, at Art. IV, § 3.12

event that a telephone or in-person hearing is convened, the hearing shall be limited to argument only; all evidence, including witness statements, must be submitted in writing in advance."[38]

35.   Consistent with ICANN's Bylaws, the IRP Panel is to issue a written declaration designating, among other things, the prevailing party.[39] The IRP Panel's declaration is not binding, however, because the Board is not permitted to outsource its decision-making authority. The Board will, of course, give serious consideration to the IRP Panel's declaration and, "where feasible," shall consider the IRP Panel's declaration at the Board's next meeting.[40]

ARGUMENT

I.   **VISTAPRINT'S CLAIM THAT ICANN BREACHED ITS BYLAWS BY "BLINDLY ACCEPTING" THE EXPERT PANEL'S DETERMINATION IS INCORRECT AND INVOLVES NO BOARD "DECISION OR ACTION."**

36.   The IRP is only available to persons "materially affected by a decision or action of the [ICANN] Board that he or she asserts is inconsistent with the Articles of Incorporation or Bylaws."[41] The IRP is thus limited to challenging ICANN Board conduct, and is not available as a means to challenge the conduct of third parties or the conduct of ICANN staff. Vistaprint argues that ICANN breached its Bylaws by "accepting," without any review or analysis, the Expert Panel's Determination involving Vistaprint's applications for .WEBS and the Objector's application for .WEB.[42] But as set forth below, there is no Article or Bylaws provision that requires the ICANN Board to review or analyze expert panel determinations.

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[38] Bylaws, Cl. Ex. RM-2, at Art. IV, § 3.12; ICDR Supplementary Procedures, ¶ 10 (Resp. Ex. 2.) The Bylaws provide that IRP requests shall not exceed 25 pages (double-spaced, 12-point font) of argument (Vistaprint's IRP Request was 25 pages), and that ICANN's response shall not exceed that same length. Vistaprint states that it is "reserving all rights to rebut ICANN's response in further briefs…." ICANN disagrees that Vistaprint has any "rights to rebut," but will reserve discussion on that topic unless and until Vistaprint seeks leave to place additional information before the IRP Panel.
[39] Bylaws, Cl. Ex. RM-2, at Art. IV, § 3.18.
[40] *Id*. at Art. IV, § 3.21.
[41] Bylaws, Cl. Ex. RM-2, at Art. IV, § 3.2.
[42] IRP Request, ¶¶ 73, 6, 50.

37.   The Guidebook states that the designated dispute resolution provider (here the ICDR), not ICANN, will appoint "one expert in proceedings involving a string confusion objection."[43] The "findings of the [ICDR] panel will be considered an expert determination and advice that ICANN will accept within the dispute resolution process."[44]

38.   The Guidebook provides that "[i]n a case where a gTLD applicant successfully asserts string confusion with another applicant, the only possible outcome is for both applicants to be placed in a contention set and to be referred to a contention resolution procedure (refer to Module 4, String Contention Procedures)."[45]

39.   The Guidebook could not be more explicit: Once the Expert Panel has sustained an objection involving two applied-for strings on string confusion grounds, "the only possible outcome" is for the two strings to be placed into a contention set.[46] This is a result not of any ICANN Board action, but a straightforward application of the Guidebook provisions to the *Expert Panel's* Determination.

40.   Vistaprint's claim that the ICANN Board violated its Bylaws by "accepting" the Expert Panel's Determination without a substantive review is not accurate. The ICANN Board took no action with respect to the Expert Panel's Determination upon its issuance because the Guidebook does not call for the Board to take any such action and it is not required by any Article or Bylaw provision. Accordingly, it cannot be a violation of ICANN's Articles or Bylaws for the Board to not conduct a "substantive review" of an Expert Determination. And because there is no Board action or decision associated with the Expert Panel's Determination, there is nothing for the IRP Panel to review.

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[43] Guidebook, Cl. Ex. RM-5, at § 3.4.4.
[44] Guidebook, Cl. Ex. RM-5, at § 3.4.6.
[45] Guidebook, Cl. Ex. RM-5, at § 3.2.2.1.
[46] Guidebook, Cl. Ex. RM-5, at § 3.2.2.1.

II.   THE BGC DID NOT VIOLATE ANY ARTICLE OR BYLAWS PROVISION IN DENYING VISTAPRINT'S RECONSIDERATION REQUEST.

41.   Article IV, Section 2 of ICANN's Bylaws permits an entity that has been adversely and materially affected by an ICANN staff or Board action or inaction to request that the Board reconsider that action or inaction.[47] In order to present a proper Reconsideration Request based on staff action or inaction, a requester must provide a detailed explanation of the facts as presented to the staff and the reasons why "one or more staff actions or inactions … contradict established ICANN policy(ies)."[48] And, as the BGC has made clear on a number of occasions with respect to Expert Panel determinations like the one at issue in this matter, the reconsideration process does not allow for a full-scale, substantive review.[49] The BGC's focus instead is whether the Expert Panel complied with its own and ICANN's *policies and procedures* in reaching its determination.[50]

42.   Vistaprint filed a Reconsideration Request seeking a review of the Expert Panel's finding that .WEBS and .WEB are confusingly similar.[51] The BGC denied Vistaprint's

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[47] *See* Article IV, Section 2.2 of ICANN's Bylaws states in relevant part that any entity may submit a request for reconsideration or review of an ICANN action or inaction to the extent that it has been adversely affected by:
    (a) one or more staff actions or inactions that contradict established ICANN policy(ies); or
    (b) one or more actions or inactions of the ICANN Board that have been taken or refused to be taken without consideration of material information, except where the party submitting the request could have submitted, but did not submit, the information for the Board's consideration at the time of action or refusal to act; or
    (c) one or more actions or inactions of the ICANN Board that are taken as a result of the Board's reliance on false or inaccurate material information.
[48] Bylaws, Cl. Ex. RM-2, at Art. IV, §2.2.
[49] *See* BGC Determination on Reconsideration Request 14-9, p. 6, https://www.icann.org/en/system/files/files/determination-merck-29apr14-en.pdf; *see also* Bylaws, Art. IV, § 2.2(a).
[50] *Id.*
[51] *See* Vistaprint's Reconsideration Request 14-5 at 18, Cl. Ex. Annex-25.

Reconsideration Request because it found "no indication that the ICDR or the Expert violated any policy or process in reaching the Determination."[52]

43.   Vistaprint takes issue with two aspects of the BGC's decision. First, Vistaprint claims the BGC should have referred Vistaprint's Reconsideration Request to the entire ICANN Board rather than decide the issue on its own.[53] Second, Vistaprint argues that the BGC got it wrong when it denied Vistaprint's Reconsideration Request.[54] Neither of these claims supports Vistaprint's IRP Request.

A.   **ICANN'S BYLAWS PERMIT THE BGC TO MAKE FINAL DETERMINATIONS OF RECONSIDERATION REQUESTS.**

44.   ICANN's Bylaws specifically state that the BGC has the authority to "make a final determination of Reconsideration Requests regarding staff action or inaction, *without reference to the Board of Directors*."[55] Because Vistaprint's Reconsideration Request was a challenge to alleged staff action,[56] the BGC was well within its authority – and in compliance with the Bylaws – by denying Vistaprint's Reconsideration Request.

B.   **VISTAPRINT'S CLAIM THAT THE BGC "GOT IT WRONG" HAS NO PLACE IN AN IRP, AND IS WITHOUT MERIT IN ANY EVENT.**

45.   Vistaprint dedicates most of its IRP Request to the notion that the BGC substantively erred in denying the Reconsideration Request. In its Reconsideration Request, Vistaprint argued that the Expert Panel did not comply with its own policies and processes in

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[52] BGC Determination on Reconsideration Request 14-5, Cl. Ex. Annex-26.
[53] IRP Request, ¶ 52.
[54] IRP Request, ¶¶ 72-80.
[55] Bylaws, Art. IV, § 2.3(f), Cl. Ex. RM-2 (emphasis added).
[56] Vistaprint's Reconsideration Request 14-5, Cl. Ex. Annex-25, at § 2 (seeking reconsideration of "Staff action/inaction."); BGC Determination on Reconsideration Request 14-5, Cl. Ex. Annex-26, at 19 (noting the BGC reviews expert panel determinations as staff action).

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reaching its Determination.[57] Here, Vistaprint argues, exactly as it did in its Reconsideration

Request, that the Expert Panel violated its processes or policies in the following fashions:

1. The ICDR's appointment of the First Expert was untimely;

2. The Expert Panel improperly accepted and considered unsolicited supplementary filings;

3. The ICDR violated established procedure when it informed the parties that an expert determination would be issued on 4 October 2013;

4. The First Expert failed to maintain his impartiality and independence;

5. The ICDR improperly accepted the Objector's challenge to the Second Expert; and

6. The Determination was untimely;

7. The Expert Panel improperly concluded that the Objector had met its burden of proof; and

8. The Expert Panel improperly applied the standards governing a string confusion objection.

46.   But Vistaprint does not suggest that anything about the ***BGC's*** handling of

Vistaprint's Reconsideration Request violated ICANN's Bylaws or Articles. In fact, Vistaprint

fails to identify any ICANN Article or Bylaws provision that was allegedly violated by the BGC

in reviewing Vistaprint's Reconsideration Request. Instead, just as it did in its Reconsideration

Request, Vistaprint seeks to use the IRP to challenge the substantive decision of the IRP Panel.

But again, the IRP may only be used to challenge ICANN Board actions, and may only challenge

them on the grounds that they do not comply with ICANN's Articles or Bylaws, neither of which

are present here.

47.   Putting aside the fact that an IRP is not a forum for challenging substantive

decisions of the BGC in connection with the reconsideration process, the BGC properly denied

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[57] IRP Request, ¶¶ 52, 71, 75, 77.

Vistaprint's Reconsideration Request. The following briefly addresses why the BGC correctly

determined that reconsideration was not warranted.

1.   ICDR's Purported Failure To Appoint The First Expert In A Timely Manner Did Not Support Reconsideration.

48.   Vistaprint claimed in its Reconsideration Request that the ICDR's appointment of

the First Expert was untimely. Specifically, Vistaprint claimed that because its response to the

Objection was submitted on May 23, 2013, the Expert Panel "had to be appointed by June 22,

2013."[58] Because it "took the ICDR until June 28, 2013 to appoint Steve Y. Koh, Esq.,"

Vistaprint contended that the First Expert's appointment was in violation of Article 13(a) of the

Procedure, which provides: "The DRSP shall select and appoint the Panel of Expert(s) within

thirty (30) days after receiving the Response."[59]

49.   The BGC determined that Vistaprint failed to provide any evidence that it

contemporaneously challenged the timeliness of the ICDR's appointment of the First Expert, and

that a Reconsideration Request was not the appropriate mechanism to raise the issue for the first

time.[60] More importantly, the BGC concluded that Vistaprint had failed to show that it was

"materially" and "adversely" affected by the brief delay in appointing the First Expert, rendering

reconsideration inappropriate.[61]

2.   The First Expert's Acceptance Of Additional Submissions Did Not Support Reconsideration.

50.   On 19 July 2013, the Objector submitted a supplementary filing to the First

Expert. Vistaprint claimed that the First Expert's acceptance of this supplementary filing

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[58] IRP Request, ¶ 33.
[59] Procedure, Cl. Ex. RM-5, attachment to Module 3, at Art. 13(a).
[60] BGC Determination on Reconsideration Request 14-5, Cl. Ex. Annex-26, at 8-9.
[61] BGC Determination on Reconsideration Request 14-5, Cl. Ex. Annex-26 at 9; Bylaws, Cl. Ex. RM-2, at Art. IV, §2.2.

violated Article 17 of the Procedure. But Article 17 of the Procedure clearly provides the Expert

Panel with the discretion to accept such a filing:

> **The Panel may decide** *whether the parties shall submit any written*
> *statements in addition to the Objection and the Response, and it shall fix*
> *time limits for such submissions.*[62]

As the BGC correctly found, it was not the BGC's place to second-guess the Expert's exercise of

permitted discretion.[63]

3. The ICDR's Representation That An Expert Panel Determination Would Be Issued By 4 October 2013 Did Not Support Reconsideration.

51.   In its Reconsideration Request, Vistaprint claimed that "[o]n September 18, 2013

(*i.e.* 82 days after the appointment of Mr. Koh as the Expert Panel) . . . the [ICDR] informed the

parties that the expert determination was going to be issued on or about October 4, 2013 (*i.e.* 98

days after the appointment of Mr. Koh as the Expert Panel)."[64] Vistaprint contended, as it

contends again here, that this would have resulted in the issuance of an untimely Determination

because Article 21(a) of the Procedure provides that "[t]he DSRP and the Panel shall make

reasonable efforts to ensure that the Expert Determination is rendered within forty-five (45) days

of the constitution of the Panel."

52.   The BGC properly determined that Vistaprint's claims in this regard did not

support reconsideration, for two reasons.[65] First, on 1 October 2013, ***before*** the Determination

was purportedly to be issued, the ICDR removed the First Expert. The BGC therefore could not

evaluate whether the First Expert rendered an untimely Determination in violation of the

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[62] Procedure, Cl. Ex. RM-5, attachment to Module 3, at Art. 17(a) (emphasis added).
[63] *See* BGC Determination on Reconsideration Request 14-5, Cl. Ex. Annex-26 at 9-10 (alterations in original).
[64] IRP Request, ¶ 34.
[65] BGC Determination on Reconsideration Request 14-5, Cl. Ex. Annex-26, at 10-11.

Procedure, given that he was removed before a Determination could be issued. As such, the BGC concluded no established policy or procedure was violated.

53. Second, the 45-day timeline cited by Vistaprint applies to the Expert's submission of the Determination "in draft form to the DRSP's scrutiny as to form before it is signed."[66] The BGC correctly noted that the ICDR and the Expert are merely required to exercise "***reasonable efforts***" to issue a determination within forty-five days of the constitution of the Panel.[67]

4. Removal Of The First Expert Did Not Support Reconsideration.

54. On 1 October 2013, the ICDR informed the parties that "due to a new conflict, the Expert, Steve Koh … will no longer be able to serve and has been removed."[68] Vistaprint argued in its Reconsideration Request that this "shows that Mr. Koh failed to maintain his impartiality and independence" in violation of the Procedure,[69] but this claim was (and is) unsupported, as the BGC properly found.

55. As the BGC noted when denying Vistaprint's Reconsideration Request, Article 13(c) of the Procedure states that "[a]ll Experts acting under this Procedure shall be impartial and independent of the parties."[70] Section 3.4.4 of the Guidebook provides that the ICDR will "follow its adopted procedures for requiring such independence, including procedures for challenging and replacing an expert for lack of independence."[71]

56. As the BGC noted, Vistaprint provided no evidence demonstrating that the First Expert failed to follow the applicable ICDR procedures for independence and impartiality.[72]

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[66] Procedure, Cl. Ex. RM-5, attachment to Module 3, at Art. 21(a)-(b).
[67] Procedure, Cl. Ex. RM-5, attachment to Module 3, at Art. 21(a) (emphasis added).
[68] IRP Request, ¶ 43; Cl. Ex. Annex-15 at 11.
[69] IRP Request, ¶ 43.
[70] Procedure, Cl. Ex. RM-5, attachment to Module 3, at Art. 13(c).
[71] Guidebook, Cl. Ex. RM-5, at § 3.4.4.
[72] BGC Determination on Reconsideration Request 14-5, Cl. Ex. Annex-26, at 11-12.

Rather, all indications are that the First Expert and the ICDR complied with these rules as to this "new conflict," which resulted in a removal of the First Expert. Further, Vistaprint presented no evidence of being materially and adversely affected by the First Expert's removal, which is another justification for the BGC's denial of the Reconsideration Request.[73]

5. The ICDR's Acceptance Of The Objector's Challenge To The Second Expert Did Not Support Reconsideration.

57. On 14 October 2013, the ICDR informed the parties that it had appointed Bruce W. Belding, Esq. as the Second Expert, the appointment of which the Objector timely challenged. On 4 November 2013, the ICDR accepted the Objector's challenge and denied Vistaprint's request to reconsider that challenge. Vistaprint claims that the ICDR's acceptance of the Objector's challenge to the Second Expert and denial of Vistaprint's request to reconsider this decision constitute a violation of the Procedure.

58. As the BGC properly determined, this claim does not support reconsideration.[74]

59. Vistaprint has not stated which provision of the Procedure was purportedly violated, and the Procedure makes clear that the ICDR had the "sole discretion" to review and decide challenges to the appointment of expert panelists/.[75]

60. While Vistaprint may disagree with the ICDR's decision to accept the Objector's challenge, it is not the BGC's role to second guess the ICDR's discretion, and it was not a violation of the ICANN Articles or Bylaws for the BGC to deny reconsideration on this ground, particularly given that Vistaprint provided no basis to believe that the ICDR's decision was in violation of the ICDR's policies.

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[73] Indeed, had Vistaprint successfully challenged Mr. Koh for lack of independence at the time he was removed, the remedy under the applicable ICDR procedures would have been the removal of Mr. Koh, which was the result here.

[74] *See* BGC Determination on Reconsideration Request 14-5, Cl. Ex. Annex-26, at 12-13.

[75] ICDR Supplemental Procedure, Cl. Ex. RM-17, at Art. 2, § 3.

6.   Vistaprint's Argument That The Expert Panel's Determination Was Untimely Did Not Support Reconsideration.

61.   On 20 November 2013, the ICDR appointed Professor Ilhyung Lee as the Expert Panel. Vistaprint claimed in its Reconsideration Request that, pursuant to Article 21 of the Procedure, the Determination therefore "should have been rendered by January 4, 2014," which was forty-five (45) days after the Panel was constituted.[76] Because "it took this Panel until January 24, 2014 to render the Decision," Vistaprint contended that the Determination was untimely because it was twenty days late.[77] The BGC properly held that this claim did not support reconsideration.[78]

62.   According to the Procedure, the Expert must exercise "reasonable efforts" to ensure that it submits the Expert Determination "in draft form to the DRSP's scrutiny as to form before it is signed" within forty-five (45) days of the Expert Panel being constituted.[79] As the BGC noted, there is no evidence that the Expert failed to comply with this Procedure, and reconsideration was therefore unwarranted on this ground.

7.   Vistaprint's Argument That The Expert Panel Incorrectly Applied The Burden Of Proof Did Not Support Reconsideration.

63.   In its Reconsideration Request, Vistaprint claimed that the Expert Panel contravened ICANN process because "the Panel does not give an analysis showing that the Objector had met the burden of proof" and that "[i]t is unclear how the Panel came to [the] conclusion [that the .WEBS string would result in string confusion]."[80]

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[76] IRP Request, ¶ 39; Procedure, Cl. Ex. RM-5, attachment to Module 3, at Art. 21.
[77] IRP Request, ¶ 39.
[78] BGC Determination on Reconsideration Request 14-5, Cl. Ex. Annex-26, at 13-14.
[79] Procedure, Cl. Ex. RM-5, attachment to Module 3, at Art. 21 (b).
[80] IRP Request, ¶ 46.

64.   The BGC found that the Expert Panel extensively detailed the support for its

conclusion that the .WEBS string so nearly resembles .WEB—visually, aurally and in

meaning—that it is likely to cause confusion.[81] Indeed, the BGC noted that the Expert Panel

adhered to the procedures and standards set forth in the Guidebook relevant to determining the

existence of string confusion.[82] The BGC therefore properly found that reconsideration was not

warranted on this basis.[83]

8.   Vistaprint's Argument That Expert Panel Incorrectly Applied The Standards Governing String Confusion Objections Did Not Support Reconsideration.

65.   Finally, Vistaprint argued to the BGC that the Expert Panel violated ICANN

processes by incorrectly applying the standards governing string confusion objections.[84]

Specifically, Vistaprint contended that the Expert "failed to provide a description of the average,

reasonable Internet user."[85]

66.   As the BGC set out in the reconsideration proceeding, Section 3.5.1 of the

Guidebook states that, "For the likelihood of confusion to exist, it must be probable, not merely

possible that confusion will arise in the mind of the average, reasonable Internet user."[86]

Vistaprint failed to cite any Guidebook provision or otherwise that requires the Expert to

"provide a description of the average, reasonable Internet user" in the Determination. Absent an

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[81] BGC Determination on Reconsideration Request 14-5, Cl. Ex. Annex-26, at 15-16; Determination, Cl. Ex. Annex-24, at 10.

[82] BGC Determination on Reconsideration Request 14-5, Cl. Ex. Annex-26, at 15-16.

[83] Vistaprint also claims that "it is unclear whether [the Objector] could have met the burden of proof if its unauthorized additional submission had not been accepted." IRP Request, ¶ 45. As set forth above, the acceptance of additional written submissions by both parties did not contravene ICANN process or policy. The acceptance of the supplementary filings therefore does not impact the BGC's conclusion concerning the application of the burden of proof.

[84] IRP Request, ¶ 47.

[85] IRP Request, ¶ 47.

[86] Guidebook, Cl. Ex. RM-5, at § 3.5.1.

articulation of what policy or procedure Vistaprint claimed was violated in this regard, the BGC properly found that reconsideration was not appropriate.

67.   Vistaprint also claims that the Expert Panel "failed to apply the burden of proof and the standards imposed by ICANN" because the Expert "questions whether the co-existence between Vistaprint's <webs.com> and the Objector's <web.com> for many years without (any evidence of) actual confusion is relevant to his determination."[87]

68.   As the BGC noted in the reconsideration process, the relevant consideration for the Expert is whether the applied-for gTLD string is likely to result in string confusion. Vistaprint does not cite any provision of the Guidebook, the Procedure, or the Rules that have been contravened in this regard, and accordingly, the BGC did not find a basis for reconsideration.

69.   In sum, Vistaprint disagrees with the Expert Determination, but the BGC correctly stated that its job was not to evaluate the Expert Panel's substantive Determination.[88] Likewise, an IRP is not intended to be an appeal mechanism to challenge the outcome of a request for reconsideration. The BGC followed the applicable policies and procedures in considering Vistaprint's Request for Reconsideration, and Vistaprint does not argue those policies themselves violate any Article of Bylaw provision. Because Vistaprint presses the same arguments now that the BGC already rejected—and with good reason—the IRP Request should be denied.

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[87] IRP Request, ¶ 48.
[88] *See* BGC Determination on Reconsideration Request 14-5, Cl. Ex. Annex-26 at 16-18.

III. VISTAPRINT DOES NOT IDENTIFY ANY INSTANCE WHERE THE ICANN BOARD VIOLATED ITS BYLAWS OR ARTICLES OF INCORPORATION.

70.   In an attempt to frame its claims in a manner that suggests they are amenable to an IRP, Vistaprint argues that ICANN violated five principles enunciated in the Bylaws. However, each consists of a thinly veiled attack on the Expert Panel's Determination, which neither forms a proper basis for an IRP nor (as set forth above) identifies any substantive or procedural deficiency in the Determination. Moreover, Vistaprint does not identify any ICANN *Board* action that supports its asserted Bylaws violation.

71.   First, Vistaprint contends that ICANN failed to comply with the general principle of "good faith." But the only reason Vistaprint asserts ICANN failed to act in good faith is in "refus[ing] to reconsider the substance" of the Determination or to "act with independent judgment[.]"[89] The absence of an appeal mechanism by which Vistaprint might challenge the Determination does not form the basis for an IRP because there is nothing in ICANN's Bylaws or Articles of Incorporation requiring ICANN to provide one.

72.   Second, Vistaprint contends that ICANN failed to apply its policies in a neutral manner. Here, Vistaprint complains that other panels let other applications proceed without being placed into a contention set, even though they, in Vistaprint's opinion, presented "at least equally serious string similarity concerns" as .WEBS/.WEB.[90] Vistaprint's claims about ICDR's treatment of *other* string similarity disputes cannot be resolved by IRP, as they are even further removed from Board conduct. Different outcomes by different expert panels related to different gTLDs are to be expected. Claiming that other applicants have not suffered adverse

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[89] IRP Request, ¶ 71.
[90] IRP Request, ¶ 74.

determinations does not convert the Expert Panel's Determination into a "discriminatory ICANN Board act."

73. Third, Vistaprint contends that the ICANN Board violated its obligation to act transparently for not investigating the "impartiality and independence" of the Expert Panel and thereby "did not seek to communicate with [ICDR] to optimize [its] service."[91] Aside from the disconnect between the particular Bylaws provision invoked by Vistaprint requiring ***ICANN's*** transparency, and the complaint that the ***ICDR*** did not act transparently, Vistaprint fails to identify any procedural deficiency in the ICDR's actions regarding the removal of the First Expert, as set forth above. Moreover, Vistaprint cites no obligation in the Articles or Bylaws that the ICANN Board affirmatively investigate the impartiality of an Expert Panel, outside of the requirement that the ICDR follow its policies on conflicts, which the ICDR did.

74. Fourth, Vistaprint contends that ICANN "has not created any general process for challenging the substance of the so-called expert determination," and thus has "brashly flouted" its obligation to remain accountable.[92] But again, Vistaprint does not identify any provision of the Articles or Bylaws that requires ICANN to provide such an appeals process.

75. Fifth, Vistaprint "concludes" that the ICANN Board neglected its duty to promote competition and innovation[93] when it failed to overturn the Expert Panel's Determination. Vistaprint claims that the Objector's "motive in filing the objection was to prevent a potential competitor from entering the gTLD market" and therefore ICANN's "acceptance" of the objection purportedly contravenes ICANN's core value of promoting competition. But every objection to a gTLD application by an applicant for the same string seeks to hinder a

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[91] IRP Request ¶ 77.
[92] IRP Request, ¶ 79.
[93] Bylaws, Art. I, §2(10); Art. IV, § 1.

competitor's application. By Vistaprint's logic, ICANN's commitment to promoting

competition requires that no objections ever be sustained and every applicant obtains the gTLD it

requests. There is no provision in the Articles or Bylaws that require such an unworkable system.

76.	All in all, Vistaprint's attempt to frame its disappointment with the Expert Panel's

decision as the ICANN Board's dereliction of duties does not withstand scrutiny.

## IV.	RESPONSE TO VISTAPRINT'S REQUESTED RELIEF.

77.	Vistaprint requests that, this IRP Panel issue a declaration "[r]equiring that

ICANN reject the determination that .WEBS and .WEB are confusingly similar and disregard the

resulting contention set" and "[r]equiring that ICANN organizes a new independent and

impartial string confusion objection procedure between Vistaprint and [Objector] Web.com."[94]

78.	Any request that the IRP Panel grant affirmative relief goes well beyond the IRP

Panel's authority. An IRP Panel is limited to "declaring whether an action or inaction of the

Board was inconsistent with the Articles of Incorporation or Bylaws" and ***recommending*** that

the Board stay any action or decision or take any interim action until such time as the Board

reviews and acts upon the opinion of the IRP Panel.[95] This IRP Panel simply does not have the

authority to award affirmative relief or to require ICANN to undertake specific conduct.[96]

CONCLUSION

79.	ICANN's conduct with respect to Vistaprint's application for .WEBS was fully

consistent with ICANN's Articles and Bylaws. ICANN followed the procedures in the

Guidebook and followed the procedures set forth in its Bylaws in evaluating Vistaprint's

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[94] *See* IRP Request, ¶ 84.
[95] Bylaws, Cl. Ex. RM-2, at Art. IV, § 3.4 and § 3.11(c).
[96] Indeed, the IRP Panel in the first IRP ever constituted under ICANN's Bylaws found that "[t]he IRP cannot 'order' interim measures but do no more than 'recommend' them, and this until the Board 'reviews' and 'acts upon the opinion' of the IRP." *See* Advisory Declaration of IRP Panel, ICM Registry, LLC v. ICANN, ICDR Case No. 50 117 T 00224 08, at ¶ 133, Cl. Ex. RM-21.

Reconsideration Request. The fact that Vistaprint disagrees with the Expert Panel's

Determination that put .WEBS and .WEB in a contention set does not give rise to an IRP.

Vistaprint's IRP Request should be denied.

Respectfully submitted,

JONES DAY

Dated: July 21, 2014   By:_____
                                                Eric P. Enson

Counsel for Respondent ICANN