

301 E-fense: Protecting Your Trademarks and Copyrights in Cyberspace

Alan C. Drewsen
Executive Director
International Trademark Association

Alvin B. Feder
General Counsel
CCH Incorporated

Andrew L. Goldstein
Partner
Freeborn & Peters

Frederick W. Mostert
Chief Intellectual Property Counsel and Executive Director
Richemont International

Faculty Biographies

Alan C. Drewsen

Alan C. Drewsen is the executive director of the International Trademark Association (INTA), the largest organization in the world devoted exclusively to the protection and promotion of trademarks as essential elements of international commerce.

Prior to joining INTA, Mr. Drewson was in private practice, specializing in antitrust health care law. He also served as the senior vice president and general counsel of Empire Blue Cross and Blue Shield.

Mr. Drewson is a member of the ABA and belongs to the Intellectual Property Section.

He earned his BA from Denison University and his JD from the Yale Law School.

Alvin B. Feder

Alvin B. Feder is the general counsel and chief legal officer for CCH Incorporated and its subsidiaries, affiliates, business units, and divisions including CCH Legal Information Services, Inc., CT Corporation System, CCH Corsearch, Washington Service Bureau, UCC Direct Services, DPC Computers, CCH Tax Compliance, KnowledgePoint, and others. His responsibilities include providing general legal counsel and advice to the officers and managers of the various organizations and to provide review and assistance with respect to contracts, license agreements, and intellectual property. In addition, Mr. Feder provides litigation management of any employee and contract claims that may arise.

Prior to his career at CCH, Mr. Feder was in-house counsel for AVID Financial Corporation and Continental Credit Corporation. He was also vice president of Croydon China Company.

In addition to his active participation in the North Shore General Counsel Association, he is a member of ACCA and the ABA. Mr. Feder has participated in numerous committees and groups throughout his professional career.

Mr. Feder received his BA and JD degrees from the University of Illinois.

Andrew L. Goldstein

Andrew L. Goldstein is a partner in Freeborn & Peter's intellectual property practice group. He has extensive experience in the areas of trademark and copyright law, internet, ecommerce and computer law, advertising, promotion, and entertainment law.

Mr. Goldstein is on the management committee of the International Trademark Association, and has served on its board of directors and executive committee. He is also past chair of the Chicago Bar Association's Patent, Trademark, and Copyright Committee. He is general counsel for the Publicity Club of Chicago and is on the Honors Council of

Lawyers for the Creative Arts, a nonprofit organization providing legal services for needy artists.

Mr. Goldstein earned his BS with highest honors and his JD *magna cum laude* from the University of Illinois.

Frederick W. Mostert

Frederick W. Mostert is honorary chair of the International Trademark Association (INTA) which has more than 3500 members in over 120 countries. He is also chief intellectual property counsel and executive director of the Richemont Group, which includes Cartier, Alfred Sunhill, Montblanc, and Van Cleef & Arpels.

Mr. Mostert is a member of the New York Bar and has practiced corporate law at the law firm of Shearman and Sterling and international intellectual property law at the firm of Fross, Zelnick, Lehman and Zissu.

He serves on the industry advisory commission of the World Intellectual Property Organization (WIPO) in Geneva. He is principal author and coordinating editor of the book *Famous and Well-Known Marks—An International Analysis*. He has written widely on the subject of trademarks and intellectual property and some of his most recent publications have been translated into Mandarin Chinese and Russian. He has acted as a guest lecturer at Peking University School of Law and Georgetown University, McDonough School of Business.

Mr. Mostert holds a doctorate in law from RAU in Johannesburg and a master's degree from Columbia University School of Law.

E-fense: Protecting Your Trademark in Cyberspace

By

Andrew L. Goldstein

Freeborn & Peters

1. The Uniform Domain Name Dispute Resolution Policy
2. "Anticybersquatting Consumer Protection Act"
3. United States Patent & Trademark Office, Examination Guide No. 2-99
"Marks Composed, in Whole, or in Part, of Domain Names"



Uniform Domain Name Dispute Resolution Policy

Policy Adopted: August 26, 1999
Implementation Documents Approved: October 24,
1999

NOTE:

1. This policy is now in effect. See www.icann.org/udrp/udrp-schedule.htm for the implementation schedule.
2. This policy has been adopted by all accredited domain-name registrars for domain names ending in .com, .net, and .org. It has also been adopted by certain managers of country-code top-level domains (e.g., .nu, .tv, .ws).
3. The policy is between the registrar (or other registration authority in the case of a country-code top-level domain) and its customer (the domain-name holder or registrant). Thus, the policy uses "we" and "our" to refer to the registrar and it uses "you" and "your" to refer to the domain-name holder.

Uniform Domain Name Dispute Resolution Policy

(As Approved by ICANN on October 24, 1999)

1. **Purpose.** This Uniform Domain Name Dispute Resolution Policy (the "Policy") has been adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN"), is incorporated by reference into your Registration Agreement, and sets forth the terms and conditions in connection with a dispute between you and any party other than us (the registrar) over the registration and use of an Internet domain name registered by you. Proceedings under [Paragraph 4](#) of this Policy will be conducted according to the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules of Procedure"), which are available at www.icann.org/udrp/udrp-rules-24oct99.htm, and the selected administrative-dispute-resolution service provider's supplemental rules.

2. Your Representations. By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights.

3. Cancellations, Transfers, and Changes. We will cancel, transfer or otherwise make changes to domain name registrations under the following circumstances:

- a. subject to the provisions of [Paragraph 8](#), our receipt of written or appropriate electronic instructions from you or your authorized agent to take such action;
- b. our receipt of an order from a court or arbitral tribunal, in each case of competent jurisdiction, requiring such action; and/or
- c. our receipt of a decision of an Administrative Panel requiring such action in any administrative proceeding to which you were a party and which was conducted under this Policy or a later version of this Policy adopted by ICANN. (See [Paragraph 4\(i\)](#) and [\(k\)](#) below.)

We may also cancel, transfer or otherwise make changes to a domain name registration in accordance with the terms of your Registration Agreement or other legal requirements.

4. Mandatory Administrative Proceeding.

This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one of the administrative-dispute-resolution service providers listed at www.icann.org/udrp/approved-providers.htm (each, a "Provider").

- a. **Applicable Disputes.** You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that

- (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) you have no rights or legitimate interests in respect of the domain name; and
- (iii) your domain name has been registered and is being used in bad faith.

In the administrative proceeding, the complainant must prove that each of these three elements are present.

b. Evidence of Registration and Use in Bad Faith. For the purposes of [Paragraph 4\(a\)\(iii\)](#), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

c. How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint. When you receive a complaint, you should refer to [Paragraph 5](#) of the Rules of Procedure in determining how your response should be prepared. Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of [Paragraph 4\(a\)\(ii\)](#):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

d. Selection of Provider. The complainant shall select the Provider from among those approved by ICANN by submitting the complaint to that Provider. The selected Provider will administer the proceeding, except in cases of consolidation as described in [Paragraph 4\(f\)](#).

e. Initiation of Proceeding and Process and Appointment of Administrative Panel. The Rules of Procedure state the process for initiating and conducting a proceeding and for appointing the panel that will decide the dispute (the "Administrative Panel").

f. Consolidation. In the event of multiple disputes between you and a complainant, either you or the complainant may petition to consolidate the disputes before a single Administrative Panel. This petition shall be made to the first Administrative Panel appointed to hear a pending dispute between the parties. This Administrative Panel may consolidate before it any or all such disputes in its sole discretion, provided that the

disputes being consolidated are governed by this Policy or a later version of this Policy adopted by ICANN.

g. Fees. All fees charged by a Provider in connection with any dispute before an Administrative Panel pursuant to this Policy shall be paid by the complainant, except in cases where you elect to expand the Administrative Panel from one to three panelists as provided in [Paragraph 5\(b\)\(iv\)](#) of the Rules of Procedure, in which case all fees will be split evenly by you and the complainant.

h. Our Involvement in Administrative Proceedings. We do not, and will not, participate in the administration or conduct of any proceeding before an Administrative Panel. In addition, we will not be liable as a result of any decisions rendered by the Administrative Panel.

i. Remedies. The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant.

j. Notification and Publication. The Provider shall notify us of any decision made by an Administrative Panel with respect to a domain name you have registered with us. All decisions under this Policy will be published in full over the Internet, except when an Administrative Panel determines in an exceptional case to redact portions of its decision.

k. Availability of Court Proceedings. The mandatory administrative proceeding requirements set forth in [Paragraph 4](#) shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded. If an Administrative Panel decides that your domain name registration should be canceled or transferred, we will wait ten (10) business days (as observed in the location of our principal office) after we are informed by the applicable Provider of the Administrative Panel's decision before implementing that decision. We will then implement the decision unless we have received from you during that ten (10) business day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the complainant in a

jurisdiction to which the complainant has submitted under [Paragraph 3\(b\)\(xiii\)](#) of the Rules of Procedure. (In general, that jurisdiction is either the location of our principal office or of your address as shown in our Whois database. See [Paragraphs 1](#) and [3\(b\)\(xiii\)](#) of the Rules of Procedure for details.) If we receive such documentation within the ten (10) business day period, we will not implement the Administrative Panel's decision, and we will take no further action, until we receive (i) evidence satisfactory to us of a resolution between the parties; (ii) evidence satisfactory to us that your lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from such court dismissing your lawsuit or ordering that you do not have the right to continue to use your domain name.

5. **All Other Disputes and Litigation.** All other disputes between you and any party other than us regarding your domain name registration that are not brought pursuant to the mandatory administrative proceeding provisions of [Paragraph 4](#) shall be resolved between you and such other party through any court, arbitration or other proceeding that may be available.

6. **Our Involvement in Disputes.** We will not participate in any way in any dispute between you and any party other than us regarding the registration and use of your domain name. You shall not name us as a party or otherwise include us in any such proceeding. In the event that we are named as a party in any such proceeding, we reserve the right to raise any and all defenses deemed appropriate, and to take any other action necessary to defend ourselves.

7. **Maintaining the Status Quo.** We will not cancel, transfer, activate, deactivate, or otherwise change the status of any domain name registration under this Policy except as provided in [Paragraph 3](#) above.

8. **Transfers During a Dispute.**

a. **Transfers of a Domain Name to a New Holder.** You may not transfer your domain name registration to another holder (i) during a pending administrative proceeding brought pursuant to [Paragraph 4](#) or for a period of fifteen (15) business days (as observed in the location of our principal place of business) after such proceeding is concluded; or (ii) during a pending court proceeding or arbitration commenced regarding your domain name unless the party to whom the domain name registration is being transferred agrees, in writing, to be bound by the decision of the court or arbitrator. We reserve the right to

cancel any transfer of a domain name registration to another holder that is made in violation of this subparagraph.

b. Changing Registrars. You may not transfer your domain name registration to another registrar during a pending administrative proceeding brought pursuant to [Paragraph 4](#) or for a period of fifteen (15) business days (as observed in the location of our principal place of business) after such proceeding is concluded. You may transfer administration of your domain name registration to another registrar during a pending court action or arbitration, provided that the domain name you have registered with us shall continue to be subject to the proceedings commenced against you in accordance with the terms of this Policy. In the event that you transfer a domain name registration to us during the pendency of a court action or arbitration, such dispute shall remain subject to the domain name dispute policy of the registrar from which the domain name registration was transferred.

9. Policy Modifications. We reserve the right to modify this Policy at any time with the permission of ICANN. We will post our revised Policy at <URL> at least thirty (30) calendar days before it becomes effective. Unless this Policy has already been invoked by the submission of a complaint to a Provider, in which event the version of the Policy in effect at the time it was invoked will apply to you until the dispute is over, all such changes will be binding upon you with respect to any domain name registration dispute, whether the dispute arose before, on or after the effective date of our change. In the event that you object to a change in this Policy, your sole remedy is to cancel your domain name registration with us, provided that you will not be entitled to a refund of any fees you paid to us. The revised Policy will apply to you until you cancel your domain name registration.

(c) 2000 The Internet Corporation for Assigned Names and Numbers. All rights reserved.

TITLE III--TRADEMARK CYBERPIRACY PREVENTION

SEC. 3001. SHORT TITLE; REFERENCES.

(a) Short Title.--This title may be cited as the ``Anticybersquatting Consumer Protection Act".

(b) References to the Trademark Act of 1946.--Any reference in this title to the Trademark Act of 1946 shall be a reference to the Act entitled ``An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes", approved July 5, 1946 (15 U.S.C. 1051 et seq.).

SEC. 3002. CYBERPIRACY PREVENTION.

(a) In General.--Section 43 of the Trademark Act of 1946 (15 U.S.C. 1125) is amended by inserting at the end the following:

``(d)(1)(A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person--

 ``(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and

[[Page 113 STAT. 1501A-546]]

 ``(ii) registers, traffics in, or uses a domain name that--

 ``(I) in the case of a mark that is distinctive at the time of registration of the domain name, is

identical or confusingly similar to that mark;

``(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

``(III) is a trademark, word, or name protected by reason of section 706 of title 18, United States Code, or section 220506 of title 36, United States Code.

``(B)(i) In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factors such as, but not limited to--

``(I) the trademark or other intellectual property rights of the person, if any, in the domain name;

``(II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

``(III) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

``(IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

``(V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

``(VI) the person's offer to transfer, sell, or otherwise

assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

``(VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

``(VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

``(IX) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection (c)(1) of section 43.

``(ii) Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.

``(C) In any civil action involving the registration, trafficking, or use of a domain name under this paragraph, a court may order

[[Page 113 STAT. 1501A-547]]

the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.

“(D) A person shall be liable for using a domain name under subparagraph (A) only if that person is the domain name registrant or that registrant's authorized licensee.

“(E) As used in this paragraph, the term ‘traffics in’ refers to transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.

“(2)(A) The owner of a mark may file an in rem civil action against a domain name in the judicial district in which the domain name registrar, domain name registry, or other domain name authority that registered or assigned the domain name is located if--

“(i) the domain name violates any right of the owner of a mark registered in the Patent and Trademark Office, or protected under subsection (a) or (c); and

“(ii) the court finds that the owner--

“(I) is not able to obtain in personam jurisdiction over a person who would have been a defendant in a civil action under paragraph (1); or

“(II) through due diligence was not able to find a person who would have been a defendant in a civil action under paragraph (1) by--

“(aa) sending a notice of the alleged violation and intent to proceed under this paragraph to the registrant of the domain name at the postal and e-mail address provided by the registrant to the registrar; and

“(bb) publishing notice of the action as the court may direct promptly after filing the action.

“(B) The actions under subparagraph (A)(ii) shall constitute service of process.

“(C) In an in rem action under this paragraph, a domain name shall be deemed to have its situs in the judicial district in which--

“(i) the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located; or

“(ii) documents sufficient to establish control and authority regarding the disposition of the registration and use of the domain name are deposited with the court.

“(D)(i) The remedies in an in rem action under this paragraph shall be limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark. Upon receipt of written notification of a filed, stamped copy of a complaint filed by the owner of a mark in a United States district court under this paragraph, the domain name registrar, domain name registry, or other domain name authority shall--

“(I) expeditiously deposit with the court documents sufficient to establish the court's control and authority regarding the disposition of the registration and use of the domain name to the court; and

“(II) not transfer, suspend, or otherwise modify the domain name during the pendency of the action, except upon order of the court.

[[Page 113 STAT. 1501A-548]]

“(ii) The domain name registrar or registry or other domain name

authority shall not be liable for injunctive or monetary relief under this paragraph except in the case of bad faith or reckless disregard, which includes a willful failure to comply with any such court order.

“(3) The civil action established under paragraph (1) and the in rem action established under paragraph (2), and any remedy available under either such action, shall be in addition to any other civil action or remedy otherwise applicable.

“(4) The in rem jurisdiction established under paragraph (2) shall be in addition to any other jurisdiction that otherwise exists, whether in rem or in personam.”.

(b) Cyberpiracy Protections for Individuals.--

(1) In general.--

(A) Civil liability.--Any person who registers a domain name that consists of the name of another living person, or a name substantially and confusingly similar thereto, without that person's consent, with the specific intent to profit from such name by selling the domain name for financial gain to that person or any third party, shall be liable in a civil action by such person.

(B) Exception.--A person who in good faith registers a domain name consisting of the name of another living person, or a name substantially and confusingly similar thereto, shall not be liable under this paragraph if such name is used in, affiliated with, or related to a work of authorship protected under title 17, United States Code, including a work made for hire as defined in section 101 of title 17, United States Code, and if the person registering the domain name is the copyright owner or licensee of the work, the person intends to

sell the domain name in conjunction with the lawful exploitation of the work, and such registration is not prohibited by a contract between the registrant and the named person. The exception under this subparagraph shall apply only to a civil action brought under paragraph (1) and shall in no manner limit the protections afforded under the Trademark Act of 1946 (15 U.S.C. 1051 et seq.) or other provision of Federal or State law.

(2) Remedies.--In any civil action brought under paragraph (1), a court may award injunctive relief, including the forfeiture or cancellation of the domain name or the transfer of the domain name to the plaintiff. The court may also, in its discretion, award costs and attorneys fees to the prevailing party.

(3) Definition.--In this subsection, the term "domain name" has the meaning given that term in section 45 of the Trademark Act of 1946 (15 U.S.C. 1127).

(4) Effective date.--This subsection shall apply to domain names registered on or after the date of the enactment of this Act.

SEC. 3003. DAMAGES AND REMEDIES.

(a) Remedies in Cases of Domain Name Piracy.--

(1) Injunctions.--Section 34(a) of the Trademark Act of 1946 (15 U.S.C. 1116(a)) is amended in the first sentence by striking "(a) or (c)" and inserting "(a), (c), or (d)".

[[Page 113 STAT. 1501A-549]]

(2) Damages.--Section 35(a) of the Trademark Act of 1946 (15 U.S.C. 1117(a)) is amended in the first sentence by inserting `` , (c), or (d)" after ``section 43(a)".

(b) Statutory Damages.--Section 35 of the Trademark Act of 1946 (15 U.S.C. 1117) is amended by adding at the end the following:

``(d) In a case involving a violation of section 43(d)(1), the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits, an award of statutory damages in the amount of not less than \$1,000 and not more than \$100,000 per domain name, as the court considers just.

SEC. 3004. LIMITATION ON LIABILITY.

Section 32(2) of the Trademark Act of 1946 (15 U.S.C. 1114) is amended--

(1) in the matter preceding subparagraph (A) by striking ``under section 43(a)" and inserting ``under section 43 (a) or (d)"; and

(2) by redesignating subparagraph (D) as subparagraph (E) and inserting after subparagraph (C) the following:

``(D)(i)(I) A domain name registrar, a domain name registry, or other domain name registration authority that takes any action described under clause (ii) affecting a domain name shall not be liable for monetary relief or, except as provided in subclause (II), for injunctive relief, to any person for such action, regardless of whether the domain name is finally determined to infringe or dilute the mark.

``(II) A domain name registrar, domain name registry, or

other domain name registration authority described in subclause (I) may be subject to injunctive relief only if such registrar, registry, or other registration authority has--

``(aa) not expeditiously deposited with a court, in which an action has been filed regarding the disposition of the domain name, documents sufficient for the court to establish the court's control and authority regarding the disposition of the registration and use of the domain name;

``(bb) transferred, suspended, or otherwise modified the domain name during the pendency of the action, except upon order of the court; or

``(cc) willfully failed to comply with any such court order.

``(ii) An action referred to under clause (i)(I) is any action of refusing to register, removing from registration, transferring, temporarily disabling, or permanently canceling a domain name--

``(I) in compliance with a court order under section 43(d); or

``(II) in the implementation of a reasonable policy by such registrar, registry, or authority prohibiting the registration of a domain name that is identical to, confusingly similar to, or dilutive of another's mark.

``(iii) A domain name registrar, a domain name registry, or other domain name registration authority shall not be liable for damages under this section for the registration or maintenance of a domain name for another absent a showing of

[[Page 113 STAT. 1501A-550]]

bad faith intent to profit from such registration or maintenance of the domain name.

“(iv) If a registrar, registry, or other registration authority takes an action described under clause (ii) based on a knowing and material misrepresentation by any other person that a domain name is identical to, confusingly similar to, or dilutive of a mark, the person making the knowing and material misrepresentation shall be liable for any damages, including costs and attorney's fees, incurred by the domain name registrant as a result of such action. The court may also grant injunctive relief to the domain name registrant, including the reactivation of the domain name or the transfer of the domain name to the domain name registrant.

“(v) A domain name registrant whose domain name has been suspended, disabled, or transferred under a policy described under clause (ii)(II) may, upon notice to the mark owner, file a civil action to establish that the registration or use of the domain name by such registrant is not unlawful under this Act. The court may grant injunctive relief to the domain name registrant, including the reactivation of the domain name or transfer of the domain name to the domain name registrant.”.

SEC. 3005. DEFINITIONS.

Section 45 of the Trademark Act of 1946 (15 U.S.C. 1127) is amended by inserting after the undesignated paragraph defining the term “counterfeit” the following:

“The term ‘domain name’ means any alphanumeric designation which is registered with or assigned by any domain name registrar, domain name

registry, or other domain name registration authority as part of an electronic address on the Internet.

``The term `Internet' has the meaning given that term in section 230(f)(1) of the Communications Act of 1934 (47 U.S.C. 230(f)(1)).".

SEC. 3006. STUDY ON ABUSIVE DOMAIN NAME REGISTRATIONS INVOLVING PERSONAL NAMES.

(a) In General.--Not later than 180 days after the date of the enactment of this Act, the Secretary of Commerce, in consultation with the Patent and Trademark Office and the Federal Election Commission, shall conduct a study and report to Congress with recommendations on guidelines and procedures for resolving disputes involving the registration or use by a person of a domain name that includes the personal name of another person, in whole or in part, or a name confusingly similar thereto, including consideration of and recommendations for--

(1) protecting personal names from registration by another person as a second level domain name for purposes of selling or otherwise transferring such domain name to such other person or any third party for financial gain;

(2) protecting individuals from bad faith uses of their personal names as second level domain names by others with malicious intent to harm the reputation of the individual or the goodwill associated with that individual's name;

(3) protecting consumers from the registration and use of domain names that include personal names in the second level domain in manners which are intended or are likely to confuse or deceive the public as to the affiliation, connection, or association of the domain name registrant, or a site accessible

[[Page 113 STAT. 1501A-551]]

under the domain name, with such other person, or as to the origin, sponsorship, or approval of the goods, services, or commercial activities of the domain name registrant;

(4) protecting the public from registration of domain names that include the personal names of government officials, official candidates, and potential official candidates for Federal, State, or local political office in the United States, and the use of such domain names in a manner that disrupts the electoral process or the public's ability to access accurate and reliable information regarding such individuals;

(5) existing remedies, whether under State law or otherwise, and the extent to which such remedies are sufficient to address the considerations described in paragraphs (1) through (4); and

(6) the guidelines, procedures, and policies of the Internet Corporation for Assigned Names and Numbers and the extent to which they address the considerations described in paragraphs (1) through (4).

(b) Guidelines and Procedures.--The Secretary of Commerce shall, under its Memorandum of Understanding with the Internet Corporation for Assigned Names and Numbers, collaborate to develop guidelines and procedures for resolving disputes involving the registration or use by a person of a domain name that includes the personal name of another person, in whole or in part, or a name confusingly similar thereto.

SEC. 3007. HISTORIC PRESERVATION.

Section 101(a)(1)(A) of the National Historic Preservation Act (16 U.S.C. 470a(a)(1)(A)) is amended by adding at the end the following: ``Notwithstanding section 43(c) of the Act entitled `An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes', approved July 5, 1946 (commonly known as the `Trademark Act of 1946' (15 U.S.C. 1125(c))), buildings and structures on or eligible for inclusion on the National Register of Historic Places (either individually or as part of a historic district), or designated as an individual landmark or as a contributing building in a historic district by a unit of State or local government, may retain the name historically associated with the building or structure.".

SEC. 3008. SAVINGS CLAUSE.

Nothing in this title shall affect any defense available to a defendant under the Trademark Act of 1946 (including any defense under section 43(c)(4) of such Act or relating to fair use) or a person's right of free speech or expression under the first amendment of the United States Constitution.

SEC. 3009. TECHNICAL AND CONFORMING AMENDMENTS.

Chapter 85 of title 28, United States Code, is amended as follows:

(1) Section 1338 of title 28, United States Code, is amended--

(A) in the section heading by striking ``trade-marks" and inserting ``trademarks";

(B) in subsection (a) by striking ``trade-marks" and inserting ``trademarks"; and

[[Page 113 STAT. 1501A-552]]

(C) in subsection (b) by striking ``trade-mark" and inserting ``trademark".

(2) The item relating to section 1338 in the table of sections for chapter 85 of title 28, United States Code, is amended by striking ``trade-marks" and inserting ``trademarks".

SEC. 3010. EFFECTIVE DATE.

Sections 3002(a), 3003, 3004, 3005, and 3008 of this title shall apply to all domain names registered before, on, or after the date of the enactment of this Act, except that damages under subsection (a) or (d) of section 35 of the Trademark Act of 1946 (15 U.S.C. 1117), as amended by section 3003 of this title, shall not be available with respect to the registration, trafficking, or use of a domain name that occurs before the date of the enactment of this Act.

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS

EXAMINATION GUIDE NO. 2-99
September 29, 1999
MARKS COMPOSED, IN WHOLE OR IN PART,
OF DOMAIN NAMES

- I. Introduction And Background ***
- II. Use as a Mark ***
- III. Surnames ***
- IV. Descriptiveness ***
- V. Generic Refusals ***
- VI. Marks Containing Geographical Matter ***
- VII. Disclaimers ***
- VIII. Material Alteration ***
- IX. Likelihood of Confusion ***
- X. Marks Containing The Phonetic Equivalent of A Top Level Domain ***

I. Introduction And Background

A domain name is part of a Uniform Resource Locator (URL), which is the address of a site or document on the Internet. In general, a domain name is comprised of a second-level domain, a "dot," and a top-level domain (TLD). The wording to the left of the "dot" is the second-level domain, and the wording to the right of the "dot" is the TLD.

Example: If the domain name is "XYZ.COM," the term "XYZ" is a second-level domain and the term "COM" is a TLD.

A domain name is usually preceded in a URL by "http://www." The "http://" refers to the protocol used to transfer information, and the "www" refers to World Wide Web, a graphical hypermedia interface for viewing and exchanging information. There are two types of TLDs: generic and country code.

Generic TLDs

Generic TLDs are designated for use by the public. Each generic TLD is intended for use by a certain type of organization. For example, the TLD ".com" is for use by commercial, for profit organizations. However, the administrator of the .com, .net, .org and .edu TLDs does not check the requests of parties seeking domain names to ensure that such parties are a type of organization that should be using those TLDs. On the other hand, .mil, .gov, and .int TLD applications are checked, and only the U.S. military, the U.S. government, or international organizations are allowed in the domain space. The following is a list of the current generic TLDs and the intended users:

- .com commercial, for profit organizations
- .edu 4 year, degree granting colleges/universities
- .gov U.S. federal government agencies
- .int international organizations
- .mil U.S. military organizations, even if located outside the U.S.
- .net network infrastructure machines and organizations
- .org miscellaneous, usually non-profit organizations and individuals

Country Code TLDs

Country code TLDs are for use by each individual country. Each country determines who may use their code. For example, some countries require that users of their code be citizens or have some association with the country, while other countries do not. The following are examples of some of the country code TLDs currently in use:

- .jp for use by Japan
- .tm for use by Turkmenistan
- .tv for use by Tuvalu
- .uk for use by the United Kingdom

Proposed TLDs

Due to growing space limitations, several new TLDs have been proposed, including the following:

- .arts cultural and entertainment activities
- .firm businesses
- .info entities providing information services
- .nom individual or personal nomenclature
- .rec recreation or entertainment activities
- .store businesses offering goods to purchase
- .web entities emphasizing activities related to the web

While these proposed TLDs are not currently used on the Internet as TLDs, applicants may include them in their marks.

Applications for registration of marks composed of domain names

Since the implementation of the domain name system, the Patent and Trademark Office (Office) has received a growing number of applications for marks composed of domain names. While the majority of domain name applications are for computer services such as Internet content providers (organizations that provide web sites with information

about a particular topic or field) and online ordering services, a substantial number are for marks used on other types of services or goods.

When a trademark, service mark, collective mark or certification mark is composed, in whole or in part, of a domain name, neither the beginning of the URL (http://www.) nor the TLD have any source indicating significance. Instead, those designations are merely devices that every Internet site provider must use as part of its address. Today, advertisements for all types of products and services routinely include a URL for the web site of the advertiser. Just as the average person with no special knowledge recognizes "800" or "1-800" followed by seven digits or letters as one of the prefixes used for every toll-free phone number, the average person familiar with the Internet recognizes the format for a domain name and understands that "http," "www," and a TLD are a part of every URL.

Applications for registration of marks consisting of domain names are subject to the same requirements as all other applications for federal trademark registration. This Examination Guide identifies and discusses some of the issues that commonly arise in the examination of domain name mark applications.

II. Use as a Mark

A. Use Applications

A mark composed of a domain name is registrable as a trademark or service mark only if it functions as a source identifier. The mark as depicted on the specimens must be presented in a manner that will be perceived by potential purchasers as indicating source and not as merely an informational indication of the domain name address used to access a web site. *See In re Eilberg*, 49 USPQ2d 1955 (TTAB 1998).

In *Eilberg*, the Trademark Trial and Appeal Board (Board) held that a term that only serves to identify the applicant's domain name or the location on the Internet where the applicant's web site appears, and does not separately identify applicant's services, does not function as a service mark.

The applicant's proposed mark was WWW.EILBERG.COM , and the specimens showed that the mark was used on letterhead and business cards in the following manner:

WILLIAM H. EILBERG
ATTORNEY AT LAW
820 HOMESTEAD ROAD, PO BOX 7
JENKINTOWN, PENNSYLVANIA 19046
215-883-4600
FAX. 215-883-4603
EMAIL WHE@EILBERG.COM

PATENTS TRADEMARKS
AND COPYRIGHTS

WWW.EILBERG.COM

The Board affirmed the examining attorney's refusal of registration on the ground that the matter presented for registration did not function as a mark, stating that:

[T]he asserted mark, as displayed on applicant's letterhead, does not function as a service mark identifying and distinguishing applicant's legal services and, as presented, is not capable of doing so. As shown, the asserted mark identifies applicant's Internet domain name, by use of which one can access applicant's Web site. In other words, the asserted mark WWW.EILBERG.COM merely indicates the location on the Internet where applicant's Web site appears. It does not separately identify applicant's legal services as such. *Cf. In re The Signal Companies, Inc.*, 228 USPQ 956 (TTAB 1986).

This is not to say that, if used appropriately, the asserted mark or portions thereof may not be trademarks or [service marks]. For example, if applicant's law firm name were, say, EILBERG.COM and were presented prominently on applicant's letterheads and business cards as the name under which applicant was rendering its legal services, then that mark may well be registrable.

Id. at 1956.

The examining attorney must review the specimens in order to determine how the proposed mark is actually used. It is the perception of the ordinary customer that determines whether the asserted mark functions as a mark, not the applicant's intent, hope

or expectation that it do so. *See In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (C.C.P.A. 1960).

If the proposed mark is used in a way that would be perceived as nothing more than an address at which the applicant can be contacted, registration must be refused. Examples of a domain name used only as an Internet address include a domain name used in close proximity to language referring to the domain name as an address, or a domain name displayed merely as part of the information on how to contact the applicant.

Example: The mark is WWW.XYZ.COM for on-line ordering services in the field of clothing. Specimens of use consisting of an advertisement that states "visit us on the web at www.xyz.com" do not show service mark use of the proposed mark.

Example: The mark is XYZ.COM for financial consulting services. Specimens of use consisting of a business card that refers to the service and lists a phone number, fax number, and the domain name sought to be registered do not show service mark use of the proposed mark.

Refusal of registration

If the specimens of use fail to show the domain name used as a mark and the applicant seeks registration on the Principal Register, the examining attorney must refuse registration on the ground that the matter presented for registration does not function as a mark. The statutory bases for the refusals are:

For trademarks: Trademark Act §§1, 2 and 45, 15 U.S.C. §§1051, 1052, and 1127

For service marks: Trademark Act §§1, 2, 3 and 45, 15 U.S.C. §§1051, 1052, 1053 and 1127

If the applicant seeks registration on the Supplemental Register, the examining attorney must refuse registration under Trademark Act §23, 15 U.S.C. §1091.

B. Advertising One's Own Products or Services on the Internet is not a Service

Advertising one's own products or services is not a service. *See In re Reichhold Chemicals, Inc.*, 167 USPQ 376 (TTAB 1970); TMEP §1301.01(a)(ii). Therefore, businesses that create a web site for the sole purpose of advertising their own products or services cannot register a domain name used to identify that activity. In examination, the issue usually arises when the applicant describes the activity as a registrable service, e.g., "providing information about [a particular field]," but the specimens of use make it clear that the web site merely advertises the applicant's own products or services. In this situation, the examining attorney must refuse registration because the mark is used to identify an activity that does not constitute a "service" within the meaning of the Trademark Act. Trademark Act §§1, 2, 3 and 45, 15 U.S.C. §§1051, 1052, 1053 and 1127.

C. Agreement of Mark on Drawing with Mark on Specimens of Use

In a domain name mark (e.g., XYZ.COM or HTTP://WWW.XYZ.COM), consumers look to the second level domain name for source identification, not to the TLD or the terms "http://www." or "www." Therefore, it is usually acceptable to depict only the second level domain name on the drawing page, even if the specimens of use show a mark that includes the TLD or the terms "http://www." or "www." *Cf. Institut National des Appellations D'Origine v. Vintners Int'l Co., Inc.*, 954 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992) (CHABLIS WITH A TWIST held to be registrable separately from CALIFORNIA CHABLIS WITH A TWIST); *In re Raychem Corporation*, 12 USPQ2d 1399 (TTAB 1989) (refusal to register "TINEL-LOCK" based on specimens showing "TRO6AI-TINEL-LOCK-RING" reversed). *See also* 37 C.F.R. §2.51(a)(1) and TMEP §807.14 *et. seq.*

Example: The specimens of use show the mark HTTP://WWW.XYZ.COM. The applicant may elect to depict only the term "XYZ" on the drawing page.

Sometimes the specimens of use fail to show the entire mark sought to be registered (e.g., the drawing of the mark is HTTP://WWW.XYZ.COM, but the specimens only show XYZ). If the drawing of the mark includes a TLD, or the terms "http://www.," or "www.," the specimens of use must also show the mark used with those terms. Trademark Act §1(a)(1)(C), 15 U.S.C. §1051(a)(1)(C).

Example: If the drawing of the mark is XYZ.COM, specimens of use that only show the term XYZ are unacceptable.

D. Marks Comprised Solely of TLDs for Domain Name Registry Services

If a mark is composed solely of a TLD for "domain name registry services" (e.g., the services currently provided by Network Solutions, Inc. of registering .com domain names), registration should be refused under Trademark Act §§1, 2, 3 and 45, 15 U.S.C. §§1051, 1052, 1053 and 1127, on the ground that the TLD would not be perceived as a mark. The examining attorney should include evidence from the NEXIS® database, the Internet, or other sources to show that the proposed mark is currently used as a TLD or is under consideration as a new TLD.

If the TLD merely describes the subject or user of the domain space, registration should be refused under Trademark Act §2(e)(1), 15 U.S.C. §2(e)(1), on the ground that the TLD is merely descriptive of the registry services.

E. Intent-to-Use Applications

A refusal of registration on the ground that the matter presented for registration does not function as a mark relates to the manner in which the asserted mark is used. Therefore, generally, in an intent-to-use application, a mark that includes a domain name will not be refused on this ground until the applicant has submitted specimens of use with either an amendment to allege use under Trademark Act §1(c), or a statement of use under Trademark Act §1(d), 15 U.S.C. §1051(c) or (d). However, the examining attorney should include an advisory note in the first Office Action that registration may be refused if the proposed mark, as used on the specimens, identifies only an Internet address. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided to the applicant prior to the filing of the allegation of use, the Office is in no way precluded from refusing registration on this basis.

III. Surnames

If a mark is composed of a surname and a TLD, the examining attorney must refuse registration because the mark is primarily merely a surname under Trademark Act

§2(e)(4), 15 U.S.C. §1052(e)(4). A TLD has no trademark significance. If the primary significance of a term is that of a surname, adding a TLD to the surname does not alter the primary significance of the mark as a surname. *Cf. In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 98 USPQ 265 (C.C.P.A. 1953) (S. SEIDENBERG & CO'S. held primarily merely a surname); *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993) (HAMILTON PHARMACEUTICALS for pharmaceutical products held primarily merely a surname); *In re Cazes*, 21 USPQ2d 1796 (TTAB 1991) (BRASSERIE LIPP held primarily merely a surname where "brasserie" is a generic term for applicant's restaurant services). *See also* TMEP §1211.01(b).

IV. Descriptiveness

If a proposed mark is composed of a merely descriptive term(s) combined with a TLD, the examining attorney should refuse registration under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the mark is merely descriptive. This applies to trademarks, service marks, collective marks and certification marks.

Example: The mark is SOFT.COM for facial tissues. The examining attorney must refuse registration under §2(e)(1).

Example: The mark is NATIONAL BOOK OUTLET.COM for retail book store services. The examining attorney must refuse registration under §2(e)(1).

The TLD will be perceived as part of an Internet address, and does not add source identifying significance to the composite mark. *Cf. In re Page*, 51 USPQ2d 1660 (TTAB 1999) (addition of a telephone prefix such as "800" or "888" to a descriptive term is insufficient, by itself, to render the mark inherently distinctive); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998) (PATENT & TRADEMARK SERVICES INC. is merely descriptive of legal services in the field of intellectual property; the term "Inc." merely indicates the type of entity that performs the services and has no significance as a mark); *In re The Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988) (PAINT PRODUCTS CO. is no more registrable as a trademark for goods emanating from a company that sells paint products than it would be as a service mark for retail paint store services offered by such a company); *In re E.I. Kane, Inc.*, 221 USPQ 1203 (TTAB 1984)

(OFFICE MOVERS, INC. incapable of functioning as a mark for moving services; addition of the term "Inc." does not add any trademark significance to matter sought to be registered). *See also* TMEP §1209.01(b)(12) regarding marks comprising in part "1-800," "888," or other telephone numbers.

V. Generic Refusals

If a mark is composed of a generic term(s) for applicant's goods or services and a TLD, the examining attorney must refuse registration on the ground that the mark is generic and the TLD has no trademark significance. *See* TMEP §1209.01(b)(12) regarding marks comprised in part of "1-800" or other telephone numbers. Marks comprised of generic terms combined with TLDs are not eligible for registration on the Supplemental Register, or on the Principal Register under Trademark Act §2(f), 15 U.S.C. §1052(f). This applies to trademarks, service marks, collective marks and certification marks.

Example: TURKEY.COM for frozen turkeys is unregistrable on either the Principal or Supplemental Register.

Example: BANK.COM for banking services is unregistrable on either the Principal or Supplemental Register.

The examining attorney generally should not issue a refusal in an application for registration on the Principal Register on the ground that a mark is a generic name for the goods or services unless the applicant asserts that the mark has acquired distinctiveness under §2(f) of the Trademark Act, 15 U.S.C. §1052(f). Absent such a claim, the examining attorney should issue a refusal on the ground that the mark is merely descriptive of the goods or services under §2(e)(1), and provide an advisory statement that the matter sought to be registered appears to be a generic name for the goods or services. TMEP §1209.02.

VI. Marks Containing Geographical Matter

The examining attorney should examine marks containing geographic matter in the same manner that any mark containing geographic matter is examined. *See generally* TMEP §§1210.05 and 1210.06. Depending on the manner in which it is used on or in connection with the goods or services, a proposed domain name mark containing a geographic term may be primarily geographically descriptive under §2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2), or primarily geographically deceptively misdescriptive under §2(e)(3) of the Trademark Act, 15 U.S.C. §1052(e)(3), and/or merely descriptive or deceptively misdescriptive under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

Geographic matter may be merely descriptive of services provided on the Internet

When a geographic term is used as a mark for services that are provided on the Internet, sometimes the geographic term describes the subject of the service rather than the geographic origin of the service. Usually this occurs when the mark is composed of a geographic term that describes the subject matter of information services (e.g., NEW ORLEANS.COM for "providing vacation planning information about New Orleans, Louisiana by means of the global computer network"). In these cases, the examining attorney should refuse registration under Trademark Act §2(e)(1) because the mark is merely descriptive of the services.

VII. Disclaimers

Trademark Act §6(a), 15 U.S.C. §1056(a), provides for the disclaimer of "an unregistrable component" of a mark. The guidelines on disclaimer set forth in TMEP §1213 *et. seq.* apply to domain name mark applications.

If a composite mark includes a domain name composed of unregistrable matter (e.g., a merely descriptive or generic term and a TLD), disclaimer is required. *See* examples below and TMEP §§1213.03.

If a disclaimer is required and the domain name includes a misspelled or telescoped word, the correct spelling must be disclaimed. *See* examples below and TMEP §§1213.04(a) and 1213.09(c).

A compound term composed of arbitrary or suggestive matter combined with a "dot" and a TLD is considered unitary, and therefore no disclaimer of the TLD is required. See examples below and TMEP §1213.04(b).

Mark Disclaimer

XYZ BANK.COM BANK.COM

XYZ FEDERALBANK.COM FEDERAL BANK.COM

XYZ GROCERISTOR.COM GROCERY STORE.COM

XYZ.COM no disclaimer

XYZ.BANK.COM no disclaimer

XYZBANK.COM no disclaimer

VIII. Material Alteration

Amendments may not be made to the drawing of the mark if the character of the mark is materially altered. Trademark Rule 2.72, 37 C.F.R §2.72. The test for determining whether an amendment is a material alteration was articulated in *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740 (TTAB 1983):

The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark. The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark appropriate for a new application.

Id. at 743-44.

Each case must be decided on its own facts. The controlling question is always whether the new and old form of the marks create essentially the same commercial impression. TMEP §807.14(a).

Example: Amending the mark PETER, used on kitchen pots and pans, from PETER to PETER PAN would materially change the mark because adding the

generic word PAN dramatically changes the meaning of the mark – from a person's name, to a well known storybook character's name.

Adding or deleting TLDs in domain name marks

Generally, for domain name marks (e.g., COPPER.COM), the applicant may add or delete a TLD to the drawing of the mark without materially altering the mark. A mark that includes a TLD will be perceived by the public as a domain name, while a mark without a TLD will not. However, the public recognizes that a TLD is a universally-used part of an Internet address. As a result, the essence of a domain name mark is created by the second level domain name, not the TLD. The commercial impression created by the second level domain name usually will remain the same whether the TLD is present or not.

Example: Amending a mark from PETER to PETER.COM would not materially change the mark because the essence of both marks is still PETER, a person's name.

Similarly, substituting one TLD for another in a domain name mark, or adding or deleting a "dot" or "http://www." or "www." to a domain name mark is generally permitted.

Example: Amending a mark from XYZ.ORG to XYZ.COM would not materially change the mark because the essence of both marks is still XYZ.

Adding or deleting TLDs in other marks

If a TLD is not used as part of a domain name, adding or deleting a TLD may be a material alteration. When used without a second level domain name, a TLD may have trademark significance. *See* TMEP §807.14(a).

Example: Deleting the term .COM from the mark .COM ? used on sports magazines would materially change the mark.

IX. Likelihood of Confusion

In analyzing whether a domain name mark is likely to cause confusion with another pending or registered mark, the examining attorney must consider the marks as a whole, but generally should accord little weight to the TLD portion of the mark. *See* TMEP §1207.01(b) *et. seq.*

X. Marks Containing The Phonetic Equivalent of A Top Level Domain

Marks containing the phonetic equivalent of a TLD (e.g., XYZ DOTCOM) are treated in the same manner as marks composed of a regular TLD. If a disclaimer is necessary, the disclaimer must be in the form of the regular TLD and not the phonetic equivalent. *See* TMEP §1213.09(c).

Example: The mark is INEXPENSIVE RESTAURANTS DOT COM for providing information about restaurants by means of a global computer network. Registration should be refused because the mark is merely descriptive of the services under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1).

Example: The mark is XYZ DOTCOM. The applicant must disclaim the TLD ".COM" rather than the phonetic equivalent "DOTCOM."

Protecting Trademarks in the Domain Name System (DNS)

**Alan C. Drewsen
Executive Director
International Trademark Association**

**American Corporate Counsel Association
October 16, 2001**

I Introduction

On behalf of the membership of the International Trademark Association (INTA), I would like to thank ACCA for the opportunity to demonstrate how trademark owners are working to ensure a safer and more reliable online environment. In this paper, I will primarily cover the new global top-level domains (gTLDs), which were approved for further negotiations by the Board of Directors of the Internet Corporation for Assigned Names and Numbers (ICANN)¹ on November 16, 2000.² I will also briefly cover trademark protection in country-code top-level domains (ccTLDs), as well as some emerging issues that businesses and consumers should be alert to as the Internet continues to evolve. My comments during the panel discussion will include developments since the submission of this paper.

II About INTA

INTA is a worldwide trade association with approximately 4,000 members in more than 150 countries. It is the largest organization devoted exclusively to the support and advancement of trademarks and related concepts of intellectual property as critically important to effective international commerce. INTA's membership includes major corporations, mid-size and start-up companies, intellectual property and general practice law firms, service consultants and academic institutions that are concerned about trademark issues. For more information about INTA, you can logon to our web site, <http://www.inta.org>

III The New gTLDs

The IPC

Trade associations, such as INTA, bar associations and other interested parties from all over the globe have been pleased to participate in the gTLD selection process on behalf of their members. To increase their effectiveness, organizations and associations representing intellectual property interests have, at the direction of the ICANN Board, formed the Intellectual Property Constituency (IPC). The IPC is part of the ICANN entity known as the Domain Name Supporting Organization (DNSO).³ The IPC's mission is "to review and raise all IP matters including any proposals, issues, policies, or otherwise, which may affect intellectual property, particularly as it interfaces with the DNS, and to provide to the DNSO and the ICANN Board timely and expert advice before it must make any decision or take any position thereon."⁴

¹ In November 1998, on behalf of the United States Government (USG), the Department of Commerce (DOC) entered into a Memorandum of Understanding with ICANN, recognizing ICANN as the private, not-for-profit entity to whom the USG would transfer responsibility for DNS management.

² The scribe notes for the November 16, 2000 meeting of the ICANN Board can be found at <http://cyber.law.harvard.edu/icann/la2000/archive/scribe-icann-111600.html>. See, also, ICANN Board Resolution 00.89 at <http://www.icann.org/minutes/prelim-report-16nov00.htm#SecondAnnualMeeting>.

Discussion Concerning New gTLDs

Nothing was viewed as being more crucial towards accomplishing the mission of the IPC than providing meaningful, well-considered comments concerning the new gTLD proposals. Adding new gTLDs is in essence making the Internet bigger, offering more space for legitimate purposes, but also providing opportunities for those who would in bad faith seek to capitalize on the hard work and investment of intellectual property owners to the detriment of consumers and other users of the Internet.

Proponents of increasing the number of gTLDs suggested that adding new gTLDs would "increase consumer choice, and create opportunities for entities that have been shut out under the current name structure."⁵ Intellectual property owners have expressed concern for some time that new gTLDs would lead to an increase in instances of piracy, including *cybersquatting*. *Cybersquatting* can be referred to generally as the registration and trafficking in Internet domain names with the bad-faith intent to benefit from another's trademark.⁶ Increased *cybersquatting* as well as other instances of piracy, including copyright infringement, will inevitably lead to consumer confusion and to greater costs associated with policing and litigation. In the end, these increased costs will also be borne by consumers. In addition, intellectual property owners concluded that it was an exaggeration to suggest that there is an acute shortage of available names in existing gTLDs, noting that domain names can be as long as 63 characters and that domain name registrants can combine two or more common words, which are still memorable to Web surfers looking for a particular site.

Notwithstanding its disagreement with the rationale offered by proponents of new gTLDs, the IPC agreed that a limited number of new gTLDs could be introduced as long as this initial rollout was in conjunction with mechanisms to protect IP owners and consumers and was followed by an appropriate evaluation period.⁷

³ For more information on the DNSO, please logon to <http://www.dnso.org>.

⁴ Proposed IPC By-laws, http://ipc.songbird.com/Vincenzo_bylaws_oct_26_00.htm.

⁵ Report of Working Group C Presented to the Names Council, March 21, 2000, <http://www.icann.org/dnso/wgc-report-21mar00.htm>.

⁶ Testimony of Anne H. Chasser, president of INTA, U.S. House of Representatives, Committee on the Judiciary, Subcommittee on Courts and Intellectual Property, July 22, 1999.

⁷ IPC, *Response of the Intellectual Property Constituency of the ICANN/DNSO to ICANN's 2000 Posting Regarding the Introduction of New Top-Level Domains*, 2000, Question 12.

ICANNs Position Concerning IP Protection in the New gTLDs

The IPC presented its position on new gTLDs to the ICANN Board at the ICANN meeting in Yokohama, Japan in July 2000. As a result of IPC efforts, the Board, in its resolution concerning new gTLDs, said the gTLD applications should include ". . . measures proposed for minimizing use of the TLD to carry out infringements or other abuses of intellectual property rights."⁸ The Board's resolution also provided a list of factors it would consider in assessing proposals for the selection of new gTLD registries, including:

The importance of appropriate protections of rights of others, including intellectual property rights, in connection with the operation of the TLD, especially during the start-up phases.

gTLD Application and Review Period

On August 15, 2000, ICANN made public the application for those parties interested in becoming a TLD registry. Completed applications were to be sent to ICANN by October 2, 2000.

To assist the applicants in complying with the intellectual property provisions of the ICANN Board's Yokohama resolution on new gTLDs, the IPC developed criteria for IP protection so that they essentially fell into three categories:

- (1) Preventing Disputes;
- (2) Identifying the Registrants; and
- (3) Remedies.¹⁰

The preventive mechanisms are:

- (1) Adequate Registration Procedures (i.e., provision of contact information, certification that the information contained in the application is correct, etc.);
- (2) Adequate Charter Compliance Pre-screening; and
- (3) A "Sunrise" type mechanism.

⁸ ICANN Board Resolution 0049, July 16, 2000, <http://www.icann.org/minutes/prelim-report-16jul00.htm>.

⁹ ICANN Board Resolution 0050, July 16, 2000, <http://www.icann.org/minutes/prelim-report-16jul00.htm>.

¹⁰ For a more detailed explanation of the IPC proposals for IP protection in the new gTLDs, please see *IP Protection in New TLDs* http://ipc.songbird.com/New_TLD_Safeguards.htm.

As proposed by the IPC, the "*Sunrise*" mechanism is a procedure whereby owners of trademarks and service marks that have been registered in a national trademark office for at least one year prior to the creation of a new gTLD can pre-register the material textual element(s), i.e., the word portion of their marks. No variations can be pre-registered, only the word(s) itself.

In terms of "Identifying the Registrants," the IPC was specifically referring to access to the WHOIS database. WHOIS permits intellectual property owners to learn the identity of bad faith domain name registrants. The IPC said that "applications for new TLDs should set forth the means by which the registry administrator will work with accredited participating registrars to provide the public unfettered access to complete and up-to-date data for each registered domain name record."¹¹

In terms of the remedial measures, the IPC was specifically looking for:

- (1) Adherence to the ICANN Uniform Dispute Resolution Policy (UDRP), an alternative dispute resolution system that has already proven to be successful in disputes involving .com, .net and .org; and
- (2) A means for resolving disputes involving alleged violations of a gTLD's charter.¹²

By the time the application process was complete, the ICANN Board had 44 applications to consider. The IPC evaluated each of the 44 applications and met with many of the applicants to discuss the scope of the proposed protection for trademarks and other intellectual property.¹³ In the end, the IPC concluded that 19 of the 44 applications submitted were acceptable from an intellectual property perspective.

Some Basics About the gTLDs Selected by ICANN

On November 16, 2000, the ICANN Board selected the seven gTLD applications set forth below for further negotiation with the ICANN staff. The chart below provides the highlights concerning the seven gTLDs that were selected.

¹¹ *IP Protection in New TLDs* Section C, WHOIS.

¹² *IP Protection in New TLDs* Section B, UDRP.

¹³ For a copy of the IPC evaluation chart, please logon to http://ipc.songbird.com/Proposed_TLDs_chart_nov_00_1st_try.htm.

GTLT	Operator	Un-sponsored or Sponsored^a	Nature of gTLD (Who can register? Special features.)	Charter	IPC Choice
.info	Afilias	un-sponsored	open to all	no	yes
.biz	NeuLevel	un-sponsored	businesses	yes	no
.pro	RegistryPro	un-sponsored	professionals; domain names registered beginning on the third level, e.g., <i>alandrewsen.law.pro</i>	yes	yes
.name	Global Name Registry	un-sponsored	personal names and fictional characters; domain names registered on the 2 nd and 3 rd levels, e.g., <i>alan.drewsen.name</i>	yes	no
.coop	National Cooperative Business Association	sponsored	cooperatives	yes	yes
.museum	Museum Domain Name Management Association	sponsored	museums	yes	yes
.aero	Societe Internationale de Telecommunications Aeronautiques SC, (SITA)	sponsored	aerospace	yes	yes

a. The term Un-sponsored^a refers to a gTLD whose registrants must hold membership in the specialized accrediting organization or entity that has sponsored the gTLD.

What Types of Protections are Afforded to Trademarks and Consumers?

† = Compliance with IPC standards.

⊕ = Non-compliant with IPC standards.

N/A = Not Applicable due to nature of the gTLD.

gTLD	Reg.	Check for Charter Compliance	Sunrise	WHOIS	UDRP	Charter Enforcement
.info	†	N/A	†	†	†	N/A
.biz	†	⊕	⊕ ^a	†	†	†/⊕ ^d
.pro	†	†	†	†	†	†
.name	†	⊕	⊕ ^b	† ^c	†	†
.coop	†	†	†	†	†	†
.museum	†	†	N/A	†	†	†
.aero	†	†	N/A	†	†	†

- a. *.Biz* has a *Start-Up Intellectual Property Notification (SIPN)* service. For a fee, a mark owner pays for its precise trademark (no variations) to be watched during the "land rush" registration period. Procedures are in place to resolve cases whereby someone other than the trademark owner registers the mark as a *.biz* domain name.
- b. *.Name* has developed a *Defensive Registration Service*. A second level *Defensive Registration* will prevent anyone from registering a domain name that includes, as a second level domain, the string that is the subject of a *Defensive Registration*. A third level *Defensive Registration* will prevent anyone from registering a domain name that includes, as a third level domain, the string that is the subject of the *Defensive Registration*. The cost for either a second or third level defensive registration is \$6,000. A combined second and third level *Defensive Registration* will only prevent the registration of the identical combined strings as a domain name. The combined *Defensive Registration* will cost a maximum \$250. There will be a period prior to the general opening of the *.name* gTLD in which individuals and trademark owners will be permitted to purchase a *Defensive Registration*.
- c. Global Name Registry is based in the United Kingdom. Due to UK data protection laws, the only information that will be provided during an initial search of the *.name* WHOIS database will be the registrant's name and postal address. Those parties wishing to receive additional contact details (e.g., fax # and e-mail) will have to complete and then submit electronically a standard form whereby the reasons needed for the additional information will have to be indicated. There will be no examination of this form. According to representatives from *.name*, the information will be returned immediately.
- d. The IPC has been critical of the *.biz* charter violation mechanism, because it does not permit a cause of action to be brought against a third party who is operating a "business" that sells counterfeit items.

Status of New gTLDs (as of July 13, 2001)

GTLT	Status of Negotiations with ICANN	Approved by U.S. Government for Entry Into Root	Entered into Root	Expected "Go-Live" Date^a
.info	complete	yes	June 28, 2001	September 19, 2001*
.biz	complete	yes	June 28, 2001	October 1, 2001*
.pro	ongoing	no	TBD	2002
.name	complete	no	TBD	late 2001/early 2002
.coop	waiting to start	no	TBD	2002
.museum	waiting to start	no	TBD	2002
.aero	waiting to start	no	TBD	2002

a. "Go-Live" Date refers to the date upon which domain names ending in the new suffix will resolve.

Evaluating the New gTLDs

The ICANN Board has authorized the formation of a *New TLD Evaluation Process Planning Task Force*. This task force is intended to develop a plan for monitoring the introduction of new TLDs and for evaluating their performance and their impact on the performance of the DNS. INTA and the other members of the IPC are working to secure a seat for IP owners on this task force.

IV The ccTLDs

In addition to *.com*, *.net* and *.org* the gTLDs most Internet users are associated with, there are four other lesser known gTLDs that are highly restricted: *.gov* (U.S. Government); *.mil* (U.S. military); *.edu* (U.S. educational institutions of higher learning); and *.int* (international intergovernmental organizations). Beyond these, there are more than 240 country-code top-level domains (ccTLDs).

The ccTLDs are interesting and somewhat puzzling creatures of the Internet that were intended for the benefit of Internet users in a particular country. Unlike their bigger gTLD cousins, ccTLDs consist of two letters that represent a particular country. For example, .uk is the United Kingdom. The ccTLD designations are based on a list of nation-states maintained by the International Standards Organization (ISO).

There is no central governing authority for ccTLDs. Although they are technically part of the ICANN root and are therefore accessible to the majority of Internet users around the world, the extent to which they are bound by rules and regulations set forth by ICANN is not clear. Moreover, there is no uniform set of regulations as to how a ccTLD may be used. Some are even marketed by the country or its contract partners as though they were gTLDs. At present, ICANN is attempting to construct an agreement it can enter into with the ccTLDs in order to bring some semblance of order to the ccTLD process.

INTA supports the effort to bring greater order to the ccTLDs. In doing so, however, it is the expectation not only of INTA, but others in the IPC, that we will see the same types of mechanisms we fought so hard for in the new gTLDs guaranteed in the ccTLDs as well.

V Emerging Issues Concerning DNS Governance

Keeping WHOIS Open

WHOIS is an essential tool that provides valuable contact data. It is used by IP owners to identify cybersquatters, but is also used by law enforcement, consumers, and even parents of young Internet users to obtain the information they need to contact owners of a particular website. That is why it is vital that the WHOIS information continues to be complete, accurate and accessible.

There are those that argue that WHOIS data should not be made publicly available, because of abuses of the system that have led to unsolicited commercial e-mail or *spam*. INTA is aware that misuse of the publicly available WHOIS system has taken place and condemns such activity. We strongly advocate the imposition of increased penalties by national governments, as well as penalties that might be imposed by registration authorities, against those who would misuse the publicly available WHOIS system either through an individual WHOIS query or via a bulk access service. We also endorse a principle that domain registrants should be unambiguously informed about the type of data that will be collected, the purposes for which it is collected, and how it may be used. INTA does not believe, however, that a "blackout" of WHOIS data is an option in light of the value it provides to intellectual property owners, law enforcement, consumers, and parents.

Universal WHOIS

Because of the extreme importance of WHOIS, and especially in light of the fact that ICANN is expanding the domain name space with the addition of the seven new global top-level domains, INTA strongly believes that it is necessary to enhance the functionality of the existing WHOIS to enable searches across all registries. INTA

was an early advocate of such a searchable database.¹⁴ In March 2001, through our participation in the IPC, INTA urged that amendments specifying the development of a "one-stop-shop" WHOIS be made to the revised ICANN - VeriSign Agreement. This "one-stop-shop" WHOIS, which would be particularly helpful in demonstrating that an alleged cybersquatter has engaged in a pattern of bad-faith activity, should be searchable using the criteria advocated by the IPC: domain name, registrant's name or postal address, contact's names, NIC handles and Internet Protocol address.

Alternate Roots and Alternate Naming Systems

There exists today a single, authoritative root for the DNS. It is the legacy root B the root established through the work of Internet pioneers and the root currently administered by ICANN. It is the main artery of the DNS through which e-mails and requests for website addresses ending in *.com.net.org.gov.mil.edu* and *.int*, the recently approved ICANN gTLDs and the ccTLDs are sent and received. It is the backbone of the Internet and the means by which businesses have been able to reach consumers in every corner of the world in order to advertise and sell a variety of products and services.

There are parties who have become frustrated with what they deem as the unnecessarily slow pace at which ICANN is adding new gTLDs and have therefore devised their own roots with gTLDs other than those approved by ICANN. Others have created domain naming systems that make it appear to the Internet user as though the domain name that appears on the user's computer screen is perhaps something more than it is in reality. These are known as alternative naming systems.

At present, due to technological considerations, very few of the world's Internet users have access to these alternative roots and naming systems. The question has arisen as to the impact of removing the technical considerations and providing access to these alternative naming systems to Internet users. Would there, for example, be a collision of some kind between users of *.bizin* one root and the users of *.bizin* another? Would the two systems be able to talk to one another? If not, what impact would that have on businesses that use the Internet? Finally, with respect to the alternate naming systems, are they likely to cause consumer confusion? INTA is presently grappling with these and other questions and may in the near future offer a policy statement on the subject of alternate roots and alternate naming systems.

Ensuring Accountability for Technical Decisions

As was noted earlier, in promoting the growth of the Internet, ICANN has simultaneously taken steps to ensure proper conditions for trademarks and, in turn, consumer protection. INTA applauds this decision. Tools such as the UDRP and an open and reliable WHOIS system have proven to be valuable means for trademark owners to put a stop to piracy and online consumer fraud. ICANN moved forward with these safeguards with the intent of ensuring a stable Internet.

Those seeking to open up the DNS to thousands of new domain names at the "flip of a switch" seek the opposite. They advocate an Internet without responsibility, an

¹⁴ See INTA Response to U.S. Department of Commerce Request for Comment on the *Improvement of Technical Management of Internet Names and Addresses*, March 18, 1998.

ICANN that closes its eyes to the ramifications of its technical decisions. INTA respectfully disagrees with this point of view. Growth can be healthy for the Internet, but not if it occurs unchecked and not if it occurs without taking into account the consequences of introducing thousands of new gTLDs at once. We cannot ignore the implications for the stability of the Internet and for those who use the Internet to obtain reliable information about everything from a grocery store purchase to a medical procedure. The Internet will continue to grow, but INTA wants that growth to occur responsibly and with the goal of ensuring safety and stability.

Electing the ICANN Board of Directors

The UDRP, open access to WHOIS, the Sunrise, charter mechanisms and responsibility for technical decisions, all of the things that IP owners have worked so hard for over the last two years, can best be preserved by electing at-large ICANN Board members who possess an understanding of the Internet and what it means to trademark owners and the consumers who use trademarks to help them navigate through cyberspace. The best way to have your voice and that of your clients heard is to register to vote in the next ICANN Board election. Refer to the ICANN website and keep an eye on the INTA site for details about when the next election will take place and how you can register to vote. In this instance, every individual vote really does matter. If you want to get involved even earlier, please become active in the IPC or attend ICANN meetings, the details of which can also be found on those web sites.

VI Conclusion

Once again, I would like to thank the ACCA for this opportunity. As the evolution of cyberspace continues, I would encourage all members of the business community to stay online, stay involved and make their voices heard. Our collective goal should be a safe, stable and reliable Internet.