

The New gTLDs: Trademark Issues in the Ever Evolving Online Landscape

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I. Introduction

In January 2012, the Internet Corporation for Assigned Names and Numbers (“ICANN”) opened the application period for new generic top-level domains (“gTLDs”).² Despite the \$185,000 cost to submit an application for a new gTLD,³ ICANN received 1,930 applications.⁴

A top-level domain (“TLD”) is the portion of a domain name that typically comes last. For instance, in the domain www.BRAND.com, .com is the gTLD, sometimes referred to as the first level domain. The portion that comes before the TLD is referred to as the second-level domain. In the example above, “BRAND” is the second-level domain. If the domain was written www.BRAND.icann.org, “BRAND” would be the third-level domain and “icann” would be the second-level domain.

Although just over three years have passed since the announcement was made to open the Internet to new gTLDs, the

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² *About the Program*, ICANN NEW GENERIC TOP-LEVEL DOMAINS, <http://newgtlds.icann.org/en/about/program>.

³ Julius Stobbs, Lewis Whiting, Sylvain Hirsch & Jean Fau, *ICANN and the seminal year for online IP*, INTELLECTUAL PROPERTY MAGAZINE, May 2014, at 26.

⁴ Stobbs, Whiting, Hirsch & Fau, *supra* note 3, at 26.

landscape surrounding its impact on intellectual property protection, primarily involving trademarks, remains murky. Many brand owners are unsure of the protective measures available for their trademarks, and some are uncertain about whether the economic benefits associated with pursuing new gTLDs will offset the costs.

Before the recent expansion, there were 22 TLDs in existence, including the common .com, .net, .edu, and .org.⁵ The stated purpose behind “opening” the Internet to new gTLDs was to free the overcrowded gTLDs, such as .com and .net, allowing for increased opportunities for expression in domain names.⁶ The argument goes that with such few gTLDs available, the second-level domain space was becoming overcrowded and consumers entering the domain marketplace were left with sparse options for domain names. Yet, there remains some skepticism about the true motive for the decision, given that organizations such as ICANN stand to gain considerable economic benefit.⁷

Despite the controversy, the program has been immensely popular. In 2014, new gTLD registrations totaled 1.5 million, or 0.5% of global TLD registrations.⁸ Reports also predict that by

⁵ There were 22 gTLDs originally, but technically .me could now be considered the 23rd. Originally a country-code TLD (ccTLD) for Montenegro, it now operates as a gTLD after the Montenegro government opened it up to general registration.

⁶ *About the Program*, ICANN NEW GENERIC TOP-LEVEL DOMAINS, <http://newgtlds.icann.org/en/about/program>.

⁷ See Stobbs, Whiting, Hirsch & Fau, *supra* 3, at 26 (“[I]t is hard to argue with those who suggest that the process has really been driven by the large organisations sitting behind the infrastructure of the internet, and their desire to sell more domains and make more money.”).

⁸ *The Domain Name Industry Brief*, VERISIGN INC., <http://www.verisigninc.com/assets/domain-name-report-december2014.pdf> (last visited Jan. 21, 2015).

December 2015, gTLD registrations could surpass the 10 million mark.⁹ Leading the new gTLDs in domain name creation is .guru with more than 79,000 domains registered under this gTLD thus far.¹⁰ Companies seeking to become registry operators, such as Donuts, have already received significant economic backing and stand poised to profit greatly.¹¹

The popularity of the program proves that brand owners cannot afford to ignore it. As the Internet continues to expand, brand owners must formulate a strategy to protect their valuable rights. This article discusses some of the protective mechanisms established for that goal as well as some of the cases that have been brought under them. It also discusses the new United States Patent and Trademark Office (“PTO”) regulations regarding the registration of gTLDs.

II. Rights-Protective Mechanisms

Concerned about backlash from trademark owners regarding the new gTLDs, ICANN implemented protective-rights mechanisms to help alleviate concerns of increased infringement. Perhaps most importantly, ICANN created the Trademark Clearinghouse—a central location where trademark owners can register their marks and obtain certain benefits to identify and ward off potential cybersquatters and infringers (discussed below).

⁹ Trevor Little, *Google Domains Throw Open Its Doors as gTLD Registrations Break the 4 Million Barrier*, WORLD TRADEMARK REVIEW (Jan. 15, 2015), <http://www.worldtrademarkreview.com/blog/Detail.aspx?g=4a4294af-fd3e-43f5-bb3b-de2f459fd878>.

¹⁰ NAME STAT, <http://namestat.org/guru> (last visited Jan. 21, 2015).

¹¹ See Stobbs, Whiting, Hirsch & Fau, *supra* 3, at 27 (calling Donuts a “purpose built domain name registry” that has already received \$100 million in financial support).

ICANN was not the only entity to respond with potential solutions to address the concerns about the new gTLDs. Domain registries, such as Donuts and Rightside, have created their own databases, called Domains Protected Marks Lists. Trademark owners can register their trademarks with these databases (for a price) to block their marks from being registered as second-level domain names by third parties.

Cybersquatters are not the only concern for trademark owners; registry operators are too. ICANN therefore created mechanisms whereby trademark owners can contest the actions of registry operators, specifically where there is systematic activity by the registry operator to facilitate or support the registration of infringing domain names.

A. The Uniform Domain-Name Dispute-Resolution Policy (“UDRP”)

The UDRP existed before the implementation of the new gTLD program and remains a viable option for pursuing infringers. ICANN created the UDRP and requires accredited domain registrars of all gTLD domain names—as well as gTLD domain registrants—to comply with its terms.¹² Disputes brought under the UDRP are handled by arbitration, and the available remedies include transfer or cancellation of the complained-of domain name.¹³

The benefits of a UDRP proceeding are its low cost and fast determination. UDRP proceedings can cost significantly less than litigation proceedings—and the time from filing to decision is usually between 45 and 60 days. However, the UDRP does not allow for monetary relief, injunctions, or seizure of counterfeit products. Brand owners seeking relief other than the cancellation

¹² *Uniform Domain Name Dispute Resolution Policy*, ICANN, <https://www.icann.org/resources/pages/policy-2012-02-25-en> (last visited June 16, 2014).

¹³ *Id.*

or transfer of the disputed domain name must therefore look elsewhere.

To complement the UDRP, and in the wake of the new gTLD program, ICANN created the Uniform Rapid Suspension System (discussed below)—a new procedure with an even shorter timeline than a UDRP action, but which only allows for the suspension (and not transfer) of the domain name in dispute.

B. The Trademark Clearinghouse (“TMCH”)

The TMCH (or “Clearinghouse”) was created by ICANN to house a centralized list of trademark data, which it provides to registries and registrars.¹⁴ The TMCH provides several benefits to trademark owners who register their marks with the TMCH (discussed below), including Sunrise registration preference, notification to the third-party registrant that the applied-for domain name matches a TMCH registration, and subsequent notification to the trademark owner of the third-party domain name.¹⁵

To be eligible for Clearinghouse registration, the trademark must be covered by a valid national registration, validated by a court decision, or validated by statute.¹⁶ The TMCH applies only to exact word matches.¹⁷ Thus, a typo-squatting

¹⁴ *What is the Clearinghouse?*, CLEARINGHOUSE, <http://www.trademark-clearinghouse.com/content/what-clearinghouse> (last visited June 16, 2014).

¹⁵ *Id.*

¹⁶ *Trademark Clearinghouse for Rights Holders*, ICANN, <http://newgtlds.icann.org/en/about/trademark-clearinghouse/rights-holders> (last visited June 16, 2014).

¹⁷ Nathan Smith, *Trademark Clearinghouse: keeping cybersquatters at bay?*, INTELLECTUAL PROPERTY MAGAZINE, May 2014, at 29.

domain (e.g., one that changes Facebook to Facebok), will not be picked up by the TMCH.¹⁸

Despite some perceived flaws,¹⁹ industry leaders contend that the program thus far has been successful and effective. In March 2014, the Clearinghouse announced that it had sent more than 500,000 claims notices, which apparently deterred 475,000 applications from proceeding further in the registration process.²⁰

1. The Sunrise Period

The TMCH offers two benefits to those who register their trademark(s): the Sunrise Period and the Trademark Claims Service. The Sunrise Period refers to a period of time (a minimum of 30 days) when TMCH registrants can register domain names that match their trademark once the relevant gTLD string has been delegated.²¹ If a TMCH registrant does not register a domain name within the Sunrise Period, it is made available to the public.²² If, however, multiple trademarks match a domain name, the Clearinghouse will determine who gets to register it, sometimes through a “first-come, first-served” process or via a bidding procedure.²³

2. The Trademark Claims Service

¹⁸ *Id.*.

¹⁹ See Stobbs, Whiting, Hirsch & Fau, *supra* note 3, at 28 (calling the inability to search for conflicting recorded rights a “major flaw” in the TMCH).

²⁰ Kuek Yu-Chuang, *A New Milestone for the internet*, INTELLECTUAL PROPERTY MAGAZINE, May 2014, at 25.

²¹ See Smith, *supra* note 20, at 29.

²² See Smith, *supra* note 20, at 29.

²³ Smith, *supra* note 20, at 29.

The Trademark Claims Service begins once the Sunrise Period ends and general registration begins.²⁴ If someone seeks to register a domain name that matches a trademark registered with the TMCH, he receives a notice of the TMCH registration (in hopes that such notice will deter further registration efforts).²⁵

As noted earlier, many argue that this program has been quite successful. TMCH reported at the end of March 2014 that of the more than 500,000 notices sent out, 95% of recipients chose not to pursue registration.²⁶ For parties who choose to continue pursuing registration, the TMCH informs the trademark owners that a domain name matching their registered mark has been submitted so that the brand owners may take further enforcement action if they wish.²⁷

C. Domains Protected Marks Lists (“DMPL”)

Some registries seeking to capitalize on the new gTLDs have recognized that they too need to address trademark owners’ concerns. A DPML is one of the primary ways that they have done so. For a price, trademark owners may pay a participating registry operator to block their marks from being used as a second-level domain within the gTLD registries controlled by that particular registry operator.

Not all registries have chosen to offer such a service and, as explained below, each registry has chosen to structure its DPML slightly differently.

²⁴ Smith, *supra* note 20, at 29.

²⁵ See Smith, *supra* note 20, at 29 (explaining that this period must last for a minimum of 90 days but can be extended for no extra cost by activating the Ongoing Notifications Service).

²⁶ Smith, *supra* note 20, at 29.

²⁷ Smith, *supra* note 20, at 29.

1. Donuts' DPML

Donuts, founded in 2011, seeks to become one of the largest domain-name registry operators and to compete with Verisign—the operator that controls popular TLDs including .com and .net.²⁸ After raising more than \$100 million in financial support, Donuts applied for 307 TLD strings during the first round of applications with ICANN.²⁹

Donuts offers the DPML service for a period of five years at a cost of just under \$3,000.³⁰ Donuts requires that the trademark first be validated by the TMCH and remain registered with the TMCH in order to receive DPML protection.³¹ Additionally, the service applies only to exact marks; typos are not blocked.³²

²⁸ *About Donuts*, DONUTS, <http://www.donuts.co/about/> (last visited June 16, 2014).

²⁹ *Id.*

³⁰ Kristy Holmes, *Donuts' Domains Protected Marks List (DPML) for new gTLDs*, COM LAUDE (Oct. 18, 2013), <http://www.comlaude.com/donuts-domains-protected-marks-list-dpml-for-new-gtlds>.

³¹ *DPML FAQs*, DONUTS, <http://www.donuts.co/dpml/faq/> (last visited June 16, 2014).

³² The DPML does, however, protect keywords that contain the mark. This means that any domain that contains the exact trademark, even if combined with other words, would be protected. For example, DMLP protection would allow the owner of the trademark BRIDGESTONE to protect mybridgestone.com, but it would not protect against alterations of the mark, such as mybridgstne.com.

Furthermore, previously registered domains and “premium reserved names” are not eligible for DPML protection.³³ Premium domain names are those domains designated by a registry operator for non-standard pricing and are typically generic terms. Additionally, if another TMCH trademark holder registers a domain name during the Sunrise Period, this trumps the DPML protection.³⁴ This process is known as a “DPML Override.”³⁵

2. Rightside’s DPML

Rightside, a smaller registry, also started offering a DPML for its gTLD registries as of last year.³⁶ Rightside’s DPML provides protection for all of its registries, present or future, for a period of up to ten years.³⁷ Donuts has a portfolio of more than 300 domain extensions³⁸, while Rightside has a growing portfolio of over 30 top level domains³⁹.

³³ *DPML FAQs*, DONUTS, <http://www.donuts.co/dpml/faq/> (last visited June 16, 2014).

³⁴ *Id.*

³⁵ *Id.*

³⁶ Jeff Eckhaus, *Rightside Registry Announces New DPML Product*, RIGHTSIDE (Feb. 6, 2014) <http://rightside.com.co/rightside/rightside-registry-announces-new-dpml-product/>.

³⁷ *Top Level Domains: Domain Protected Marks List*, RIGHTSIDE, <http://rightside.co/rightside-registry/dpml-rights-protection/> (last visited June 16, 2014).

³⁸ About Donuts Domain Names, GODADDY, <https://support.godaddy.com/help/article/8918/about-donuts-domain-names> (last visited Jan. 26, 2015).

³⁹ RIGHTSIDE REGISTRY, <http://rightside.co/brands/rightside-registry/> (last visited Jan. 26, 2015).

Like Donuts' service, Rightside's DPML protects only exact trademark matches and requires that the trademark remain current with the TMCH.⁴⁰ Additionally, Rightside DPML protection is subject to the DPML Override and does not extend to premium domains or previously registered domains.⁴¹

D. Challenging a Registry Operator and/or its Behavior

There are a variety of ways in which a trademark owner can challenge a registry operator and/or its behavior. Before ICANN approves an application for a new gTLD string, third parties are given an opportunity to file a Legal Rights Objection (or "LRO").⁴² The LRO is a mechanism that allows brand owners or other community-based stakeholders to challenge a registry operator's application for a gTLD string.⁴³ For example, if Del Monte Foods wants to oppose an application filed by a registry operator related to the use of ".delmonte" as a gTLD, it could file an LRO with the appropriate dispute provider designated by ICANN. An independent panel of one to three experts then determines whether the potential gTLD would likely infringe the asserted trademark.⁴⁴ The window in which to file a LRO for the first round of gTLDs has ended,⁴⁵ but should ICANN decide to

⁴⁰ Eckhaus, *supra* note 39.

⁴¹ *Id.*

⁴² *Frequently Asked Questions*, WIPO, <http://www.wipo.int/amc/en/domains/lro/faq/#1a> (last visited June 16, 2014).

⁴³ *Id.*

⁴⁴ *Id.*

⁴⁵ *Id.*

permit a second round of gTLD applications to be submitted, brand owners would once again be able to use LRO mechanism to challenge the application of gTLD strings that they allege infringe their brands. According to ICANN, 2016 is the earliest a subsequent application round is expected to launch.⁴⁶

Other procedures remain open for third parties to challenge registry operator behavior. For instance, the Post Delegation Dispute Resolution Procedure, designed by ICANN, is another administrative alternative to resolving disputes.⁴⁷ Specifically, this mechanism allows a party to challenge a registry operator's systematic actions of permitting or encouraging trademark infringement either at the top-level or second-level of the domain.⁴⁸

Similarly, there is the Registration Restriction Dispute Resolution Procedure, which is available to challenge a registry operator who deviates from its registry agreement by systematically failing to police registration and use of domains.⁴⁹ This is another arbitration process that is governed by the National Arbitration Forum ("NAF").⁵⁰

⁴⁶ Announcements, INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS (Sept. 22, 2014), <https://www.icann.org/news/announcement-3-2014-09-22-en>.

⁴⁷ *Rights Protection Mechanisms for New Top-Level Domains (TLDs)*, WIPO, <http://www.wipo.int/amc/en/domains/rpm/#f> (last visited June 16, 2014).

⁴⁸ *Id.*

⁴⁹ *See Generally Registration Restrictions Dispute Resolution Procedure (RRDRP)*, ICANN, <https://www.icann.org/resources/pages/rrdrp-2014-01-09-en> (last visited June 16, 2014).

⁵⁰ *Id.*

III. A Review of the Uniform Rapid Suspension System (“URS”) Case Law in Its First Year

The URS is a domain name dispute resolution procedure available to a trademark owner seeking to contest registration of a domain name that is confusingly similar to its trademark(s). It was created to provide fast, cost-effective resolution for straightforward domain name infringement cases.

Importantly, the URS differs from the UDRP in that it does not award ownership of the domain to the prevailing party.⁵¹ Instead, if the challenger is successful, the domain name is suspended for the duration of its registration term.⁵² If a challenger seeks ownership of the domain and wishes to control or stop its associated content, the UDRP is the more appropriate avenue for enforcement. But if the challenger has no desire to use the domain name at issue (such as in instances of typo-squatting), the URS is a good alternative to the lengthier, more expensive UDRP process.

Additionally, the URS is available only for those domain names that were registered under gTLD strings that were created or delegated on or after January 1, 2013, whereas the UDRP is available to challenge the registration of domain names registered under any gTLD string. It is important to first evaluate the brand owner’s objectives and needs before deciding whether to pursue enforcement via the UDRP or the URS, as the costs, timeline, and available remedies differ.

A. Bringing a URS Case

The first step in filing a URS case is identifying the domain owner and the registrar. Usually, this information is

⁵¹ *Uniform Rapid Suspension System (“URS”)*, ICANN (Mar. 1, 2013), <http://newgtlds.icann.org/en/applicants/urs> (follow “URS Procedure” link to the document).

⁵² *Id.*

available through a WHOIS search, but sometimes the true identity of the domain owner may be unavailable.⁵³

The second step is selecting a URS dispute resolution provider. There are currently two options: the NAF and the Asian Domain Name Dispute Resolution Centre. The complaint may then be filed electronically. Importantly, the complainant must show by clear and convincing evidence that: (1) the contested domain name is identical or confusingly similar to a registered mark, (2) the domain registrant has no legitimate interest or rights in the domain name, and (3) the registrant registered, and is using, the domain name in bad faith.⁵⁴ To ensure the URS remains a fast and efficient method for handling disputes, once the complaint is filed there is no opportunity to change or correct the complaint.⁵⁵

If there are no deficiencies in the complaint, the URS dispute resolution provider notifies the registry operator that a complaint has been filed, triggering the registry operator to place a “lock” on the domain name to prevent any changes to the website or its content.⁵⁶ Once the URS dispute resolution provider receives confirmation of the lock, it provides the registrant with notice of the complaint.⁵⁷ The registrant then has 14 days to submit a response.⁵⁸

The response, complaint, and any other necessary materials are then forwarded to an examiner, and a final decision is typically reached within three and five business days.⁵⁹ Like the

⁵³ *See id.*

⁵⁴ *Id.*

⁵⁵ *Id.*

⁵⁶ *Id.*

⁵⁷ *Id.*

⁵⁸ *Id.*

UDRP, there is no discovery or hearing involved with a URS proceeding, and the materials sent to the examiner serve as the entire record.⁶⁰

Both parties have the right to seek a *de novo* appeal, which must be filed within 14 days after a determination is made.⁶¹ The record will remain the same, but new evidence may be introduced so long as it pre-dates the filing of the original URS complaint.⁶² Importantly, a URS proceeding will not preclude other enforcement proceedings, such as a UDRP proceeding.⁶³

B. *Facebook Inc. v. Radoslav*⁶⁴

Facebook was the first to file a complaint under the URS in August 21, 2013 when it challenged Radoslav, the owner of the domain facebook.pl domain name, which omits an “o” from “Facebook.”

Facebook argued that the domain-name registrant had no legitimate interest in the domain name and that the disputed domain name was being used in bad faith to host a pay-per-click website. The NAF panelist agreed with Facebook’s allegations and found that the disputed domain name had been registered and used in bad faith. Thus, all three prongs of the test were satisfied and the panelists suspended the domain name until its expiration in March 2015.

C. *Virgin Enterprises Limited v. Lawrence Fain*⁶⁵

⁵⁹ *Id.*

⁶⁰ *See id.*

⁶¹ *Id.*

⁶² *Id.*

⁶³ *Id.*

⁶⁴ (NAF FA1308001515825).

Virgin Enterprises challenged the domain branson.guru in the eighth published case under the URS. Richard Branson is the founder of The Virgin Group, and Virgin Enterprises owns multiple registered trademarks for the mark BRANSON. Virgin alleged that the registrant had no legitimate interest in branson.guru and that the disputed domain name had been registered and used in bad faith because it served as a parking page for the registrar, Go Daddy.

The registrant did not submit a response to the complaint. Nonetheless, the examiner found in the registrant's favor, holding that Virgin had not shown by clear and convincing evidence that its rights in the BRANSON mark were sufficiently strong or that the domain name was being used in such a way as to associate itself with Branson or Virgin Enterprises. Importantly, the fact that the website was merely being used as a click-through site seemed, for the examiner, to favor the respondent because it showed that the website content was not intended to create a connection with Virgin Enterprises.

This was the first case heard by the URS in which the complainant was unsuccessful in satisfying the three-prong test for bad faith registration and use.

D. *IBM Corp. v. Denis Antipov*⁶⁶

In February 2014, IBM challenged the domain names ibm.guru and ibm.ventures. Interestingly, both domains forwarded to IBM's websites: ibm.guru forwarded to www.ibm.com and ibm.ventures forwarded to www.ibm.com/venturecapitalgroup. The registrant decided to register the domains despite having received notification from the TMCH that the domain names matched a mark registered with the Clearinghouse.

⁶⁵ (NAF FA1402001545807).

⁶⁶ (NAF FA1402001542313).

The registrant responded to the allegations by claiming that the domains were intended to be used for a news and/or community support website. Without sufficient proof of this, the panelist determined that IBM established by clear and convincing evidence all three elements required by the URS and suspended both domains for the duration of their registration.

E. *Dr. Ing. h.c. F. Porsche G v. Interactiv Corp.*⁶⁷

In August 2014, a three-member-panel reversed the URS examiner's decision. The examiner previously found that use of the domain name Porsche.social was fair use when used for a car-enthusiast fan site. Although the Respondent stated its intent to disclaim affiliation with the car company, the panel concluded that use of Porsche.social was an indicator of bad-faith registration.

The panel held that the .social TLD “does nothing to distinguish the disputed domain name from the Complainant’s trademark.” Moreover, it found the TLD is “generally irrelevant when assessing whether or not a mark is identical or confusingly similar.” Because the disputed domain name was identical or confusingly similar to the Complainant's trademark, and because the Respondent had no legitimate interests in the disputed domain name, the review panel suspended use of the name for the duration of its registration.

IV. The New U.S. Patent and Trademark Office Guidelines for Registering gTLD-Formative Trademarks

Previously, the U.S. Patent and Trademark Office (PTO) prohibited applications to register marks comprised solely of gTLDs for “registrar” or “registry operator” services on the grounds that they were incapable of functioning as a source identified for the relevant services.⁶⁸ Indeed, in the world of

⁶⁷ (NAF FA1407001571774).

⁶⁸ T.M.E.P. § 1215.02(d); *U.S. Patent and Trademark Office Examination Guide 1-14*, “Applications for Marks Comprising

limited gTLDs, .com and .edu did not serve as an indication of a website's source or the registry/registrar services of the related domain name. In response to the expanding availability of gTLDs and the nature of the gTLD strings themselves, the PTO revised its policy for gTLD trademark applications on March 20, 2014 to allow for the registration of marks that comprise gTLD strings under certain, limited circumstances.⁶⁹

Registration for gTLD marks will ultimately still be initially refused. However, the new guidelines allow for applicants to overcome the initial refusal by showing three things. The applicant must present: (1) evidence that the mark will be perceived as a source identifier, (2) proof of a registry agreement with ICANN, and (3) proof that the identified services will be primarily for the benefit of others.⁷⁰

A. Evidence that the Mark Will be Perceived as a Source Identifier

This element requires that the applicant prove two things. First, the applicant must provide evidence of a valid, prior U.S. registration for use on similar goods or services.⁷¹ The underlying registration must be currently valid and in force, and the goods or services of the applied-for mark must limit the "field of use" for the registry/registrar services to the goods/services listed in the registrations(s).⁷² The lack of a "." in the underlying U.S. trademark registration is not relevant in determining whether this requirement has been met.⁷³

gTLDs for Domain-Name Registry Operator and Registrar Services", March 2014.

⁶⁹ *Id.*

⁷⁰ *See generally id.*

⁷¹ *Id.*

⁷² *Id.*

The second required element is additional proof that the mark, when used as a gTLD, will be perceived as a source identifier.⁷⁴ Because consumers are not yet accustomed to viewing a gTLD as a source identifier, significant evidence is required to show that the gTLD wording serves this purpose. The amount of evidence required may vary, and examples of relevant evidence include samples of, and the amount spent on, advertising or promotional materials and consumer statements attesting that the applied-for mark is a recognized trademark.⁷⁵

B. Proof of a Registry Agreement with ICANN

Proof of a registry agreement is also a required element for registration. Without it, the applied-for mark will be refused on deceptiveness grounds.⁷⁶ The requirement for a registry agreement may be satisfied with evidence demonstrating a valid registry agreement with ICANN, such as a verified statement by the applicant.⁷⁷ Further, the registry agreement must designate the applicant as the registry operator for the gTLD identified by the mark.⁷⁸ Absent such evidence, the trademark application will be refused as deceptive under Section 2(a) on the ground that consumers may be confused about the use of a gTLD as a mark and its ultimate source.⁷⁹

⁷³ *Id.*

⁷⁴ *Id.*

⁷⁵ *Id.*

⁷⁶ *Id.*

⁷⁷ *Id.*

⁷⁸ *Id.*

⁷⁹ *Id.*

**C. Proof that the Identified Services Will be
Primarily for the Benefit of Others**

The Trademark Act requires that services be primarily for the benefit of others.⁸⁰ Thus, examining attorneys must issue requests for information to the domain-name registry or registrar about the services they offer for others.⁸¹ In particular, the examining attorney may ask: (1) does the applicant intend to use the mark as a gTLD?; (2) does the applicant intend to operate a registry and sign a Registry Agreement for the gTLD?; (3) which entities and industries will the applicant's registry operator and registrar services target?; and (4) does the applicant intend to register domain names for others using this gTLD, and if so, will there be restrictions as to who is eligible for registration?⁸²

V. Conclusion

There have been many changes over the past few years in the structure of the Internet and its impact on trademark law. As the gTLD expansion is only going to continue, it is more important than ever that trademark owners develop a strategy with how best to enforce and protect their marks. Remaining vigilant and understanding the multiple rights protective mechanisms that are available will enable trademark owners to swiftly combat infringers and cybersquatters alike.

⁸⁰ *Id.*

⁸¹ *Id.*

⁸² *Id.*