



Newsletter

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Our office will be closed for the following holidays:

April 21st – Good Friday

May 29th – Memorial Day

June 30th – July 5th - VACATION

Our next newsletter will be mailed out the beginning of September 2000.

Remember if you have an article that you would like to contribute to our newsletter just fax it to us for our review. We must receive the article no later than August 15th for our September newsletter. ♦

TRADEMARKS COMPOSED, IN WHOLE OR IN PART, OF DOMAIN NAMES

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 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 the 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 designed 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

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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 in Japan
- .tm for use in 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 services
- .store businesses offering goods to purchase
- .web entities emphasizing activities web related

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 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 goods or services.

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.

Use As a Mark

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 merely as informational indication of the domain name address used to access a web site.

In *Eilberg*, the Trademark Trial and Appeal 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. The Board affirmed the examining attorney's refusal of registration on the ground that the manner presented for registration did not function as a mark, stating that:

The asserted mark, as displayed on the 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. The asserted mark identifies the 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.

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 letterhead and business card as the name under which applicant was rendering its legal services, then that mark may well be registrable.

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. 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.

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.

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

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.

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](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."

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](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.](http://www)", the specimens of use must also show the mark used with those terms.

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), a registration should be refused on the grounds 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 on the ground that the TLD is merely descriptive of the registry services.

Surnames

If a mark is composed of a surname and a TLD, the examining attorney must refuse registration because the mark is primarily a surname. 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.

Descriptiveness

If a proposed mark is composed of a merely descriptive term(s) combined with a TLD, the examining attorney should refuse registration 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 the registration.

Example: The mark is NATIONAL BOOK OUTLET.COM for retail book store services. The examining attorney must refuse registration.

The TLD will be perceived as part of an Internet address, and does not add source identifying significance to the composite mark.

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 grounds that the mark is generic and the TLD has no trademark significance. Marks comprised of generic terms combined with TLDs are not eligible for registration on the Supplemental Register, or on the Principal Register. 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 based on the grounds that a mark is a generic name for the goods or services unless the applicant asserts that the mark has acquired distinctiveness. 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. ♦

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ADDRESS CORRECTION REQUESTED



