

THE “DOT” TIMES THEY ARE A-CHANGIN’:
HOW NEW GENERIC TOP LEVEL DOMAINS
(gTLDs) WILL CHANGE CONSUMER PERCEPTION
ABOUT THE INTERNET

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INTRODUCTION

The Internet is about to undergo a dramatic change that will redefine how consumers understand and interact with the medium. Consumers today generally are familiar with the most common generic Top Level Domains (“gTLDs”)—such as *.com*, *.org*, *.net*, *.gov* and *.edu*—which appear to the right of the last “dot” in a domain name.¹ But the current limited roster of gTLDs is about to increase exponentially.²

The Internet Corporation for Assigned Names and Numbers (“ICANN”), the organization responsible for approving and assigning gTLDs, recently became concerned that the twenty-two gTLDs currently available could not sufficiently support the future growth of the Internet.³ Indeed, nearly every single word in the English language already is registered in connection with *.com*, the most popular gTLD.⁴ Thus, after years of analysis and planning, ICANN recently instituted a program through which an organization could apply to register nearly any term in nearly any language as a new gTLD, potentially becoming the next “dot com.”⁵

Brand owners, community and professional organizations, Internet and media companies, venture capitalists, local governments and other interested parties filed approximately 2,000 applications to register over 1,200 new gTLDs.⁶ These potential new gTLDs, some of which already have launched, include:

famous brand names, such as *.mcdonalds*, *.nokia*, *.gucci*, *.canon*, *.cadillac*, *.gap*, *.macys*, *.barclays*, *.walmart*, *.bing* and *.google*;

terms denoting industries and professions, such as *.law*, *.news*, *.fashion*, *.accountant*, *.insurance*, *.hair*, *.sports*, *.financial*, *.doctor* and *.charity*;

terms denoting goods and services, such as *.books*, *.makeup*, *.tickets*, *.movie*, *.art*, *.casino*, *.spa*, *.golf*, *.beer*, *.flowers* and *.music*; and geographic locations, such as *.nyc*, *.paris*, *.dubai*, *.istanbul*, *.tokyo*, *.sydney*, *.london*, *.berlin* and *.amsterdam*.⁷

Consumers traditionally have viewed gTLDs just as their classification suggests: *generic*, and incapable of conveying any source indicative information.⁸ Instead, consumers generally have looked to Second Level Domains (“SLDs”)—the part of the domain name

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¹ See *infra* Part I.B.

² See *infra* Part IV.

³ See *infra* Part IV.

⁴ See *infra* Part IV.

⁵ See *infra* Part IV.

⁶ See *infra* Part IV.

⁷ See *infra* Part IV.

⁸ See *infra* Part V.A.

generally found to the left of the last dot—to determine the identity of the company behind the domain name.⁹ Conventional wisdom teaches that “[t]he most common method of locating an unknown domain name is simply to type in the company name or logo with the suffix .com.”¹⁰ Thus, when analyzing claims involving uses of trademarks in domain names, tribunals have focused nearly exclusively on SLDs and have ignored any potential impact of gTLDs, finding the latter incapable of acting as source indicative trademarks, either in their own right or in conjunction with SLDs.¹¹ But in the forthcoming Internet landscape, the new gTLDs will have significant ability to convey source indicative information to consumers.¹²

Now that companies can register their brands as gTLDs, SLDs no longer will serve as *de facto* indicators of source.¹³ In many instances, the gTLD, and not the SLD, likely will tell consumers the source of the domain name.¹⁴ When consumers begin to see well-known brands utilized as gTLDs—such as *.gucci*, *.cadillac* and *.mcdonalds*—they likely will assume that all domain names in that “dot brand” name space originate from or are approved or sponsored by the companies that own these brands.¹⁵ The goodwill and source indicative properties already associated with these brands easily can be expanded into the new gTLD name space when consumers see these brands “to the right of the dot.”¹⁶ As long as these brand owners maintain adequate control over and educate consumers about their new name spaces, their “dot brand” gTLDs likely will enjoy trademark status and protection.¹⁷

Even non-brand gTLDs that relate to goods and services—such as *.law*, *.fashion* and *.shoes*—likely will provide source indicative context.¹⁸ Under trademark law, Columbia Records, Columbia University, Columbia Sportswear Company and Columbia Pictures Industries, Inc. each can use the trademark COLUMBIA in a non-confusing way to identify their distinct goods and services.¹⁹ However, in the current domain name system, no two domain names can be exactly the same.²⁰ Thus, only one of these four entities can register the

⁹ See *infra* Part V.A.

¹⁰ *Sporty’s Farm L.L.C. v. Sportsman’s Mkt., Inc.*, 202 F.3d 489, 499 (2d Cir. 2000); see also *Brookfield Commc’ns. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1045 (9th Cir. 1999) (“Web users often assume, as a rule of thumb, that the domain name of a particular company will be the company name followed by ‘.com’”).

¹¹ See *infra* Part V.A.

¹² See *infra* Part V.B.

¹³ See *infra* Part V.B.1.

¹⁴ See *infra* Part V.B.1.

¹⁵ See *infra* Part V.B.1.

¹⁶ See *infra* Part V.B.1.

¹⁷ See *infra* Part V.B.1.

¹⁸ See *infra* Part V.B.2.

¹⁹ See *infra* Part V.B.2.

²⁰ See *infra* Part V.B.2.

exact, concise and intuitive domain name <columbia.com>.²¹ Until a consumer actually visits the website located at <www.columbia.com>, she will not know which of the various COLUMBIA entities owns the domain name.²² The expansion of new gTLDs will allow each of these entities to register their brand as a SLD in conjunction with a gTLD that relates to their goods and services, such as <columbia.music>, <columbia.college>, <columbia.clothing> and <columbia.film>, respectively.²³ When used in conjunction with SLDs comprised of brand names, these descriptive gTLDs should help consumers more easily identify the source of the domain names and reduce the likelihood of potential confusion as to source or affiliation.²⁴

In some instances, a descriptive gTLD itself may come to indicate a single source of origin or control.²⁵ Several brand owners have applied to register terms that describe their goods and services as gTLDs and have stated that they intend to allow only organizations and persons affiliated or associated with these brand owners to register domain names in the new name space.²⁶ For example, the National Association of Realtors has applied to register the gTLD *.home* and stated that it will not allow the general public to register and use domain names in, and will maintain strict control over, the *.home* gTLD name space.²⁷ While gTLDs such as *.com* and *.net* are generic and incapable of becoming trademarks in their own right, through restricted use, content control and significant advertising, these companies quickly can educate consumers about their new name spaces such that their descriptive gTLDs can acquire trademark distinctiveness, thereby indicating a single source of origin or control.²⁸

Given the impending changes in the domain name landscape, current generalizations regarding how consumers perceive the Internet likely will be inapplicable and inappropriate when analyzing trademark claims. Arbiters of trademark claims will need to develop jurisprudence that properly recognizes the significant source indicative properties many new gTLDs likely will convey, and afford these new gTLDs proper trademark status and protection.

²¹ See *infra* Part V.B.2.

²² See *infra* Part V.B.2.

²³ See *infra* Part V.B.2.

²⁴ See *infra* Part V.B.2.

²⁵ See *infra* Part V.B.3.

²⁶ See *infra* Part V.B.3.

²⁷ See *infra* Part V.B.3.

²⁸ See *infra* Part V.B.3.

I. THE INTERNET AND DOMAIN NAMES

A. *The Domain Name System (DNS)*

The Internet is a global network of networks of interlinked computer devices, such as desktops, laptops, servers, smart phones and tablets.²⁹ Each computer device connected to the Internet is assigned a unique series of numbers and decimal points called an Internet Protocol Address (“IP Address”).³⁰ IP Addresses allow computers to identify each other and exchange information via the Internet.³¹ Because IP Addresses are unwieldy and difficult to remember, in the 1980s, Internet developers created the Domain Name System (“DNS”).³² The DNS translates easily memorized domain names, *e.g.*, <google.com>, into their numerical IP Addresses, *e.g.*, 173.194.34.105, obviating the need for Internet users to memorize seemingly random numerical IP Addresses when accessing the Internet.³³

When an Internet user types a domain name into a web browser, the computer device first sends that domain name to a DNS server.³⁴ The DNS server then converts the domain name into an IP Address and sends that IP Address back to the user’s computer device.³⁵ The computer device then sends the user’s original request to the Internet using the IP Address of the website to which the domain name resolves.³⁶ This conversion happens nearly instantaneously, without any additional input by the Internet user.³⁷

B. *Anatomy of a Domain Name*

Domain names are comprised of at least two parts and operate in a hierarchal structure, from the broadest level of organization at the right to the most specific level of organization at the left.³⁸ The rightmost part of the domain name—just beyond the last dot—is the top level domain

²⁹ See 47 U.S.C. § 230(f)(1); *ACLU v. Reno*, 929 F. Supp. 824, 830 (E.D. Pa. 1996).

³⁰ See Jonathan Weinberg, *ICANN and the Problem of Legitimacy*, 50 *DUKE L.J.* 187, 194 (2000).

³¹ See *id.* at 195.

³² See James N. Duchesne, *Running Amuck: Using the Debacle of Recent Top Level Domain Expansions to Argue for Greater Governmental Participation in DNS Management*, 21 *COMMLAW CONSPECTUS* 151, 154–55 (2012); Matthew E. Nigriny, *Remembering the Consumer on the Advent of ICANN’s New gTLD Expansion*, 91 *N.C. L. REV.* 72, 74 (2013).

³³ See Wei-erh Chen, *Optimizing Online Trademark Protections Given the Proliferation of Generic Top Level Domains*, 38 *IOWA J. CORP. L.* 585, 588 (2013); see also Nigriny, *supra* note 32, at 74.

³⁴ See Kadambari Bhandari, *DNS Cache Poisoning*, SANDIP INFORMATION TECHNOLOGY RESEARCH COLLABORATION (June 27, 2013), <http://itsitrc.blogspot.com/2013/06/dns-spoofing.html>.

³⁵ See *id.*

³⁶ See *id.*

³⁷ See *id.*

³⁸ See Chen, *supra* note 33, at 589; Nigriny, *supra* note 32, at 74–75.

(“TLD”).³⁹ Just to the left of the TLD is the second level domain (“SLD”).⁴⁰ To the left of the SLD is the third level domain (“3LD”), and so on.⁴¹ Thus, as illustrated in the diagram that follows, in the domain name <mail.google.com>, from its broadest to most specific level of organization, “.com” is the TLD, “google” is the SLD and “mail” is the 3LD:



Domain names can be comprised of multiple sub-level domains.⁴²

There are two main types of TLDs.⁴³ The most common TLDs are *generic* TLDs (“gTLDs”).⁴⁴ Currently, there are twenty-two gTLDs,

³⁹ See Chen, *supra* note 33, at 589; Nigriny, *supra* note 32, at 74–75.

⁴⁰ See Chen, *supra* note 33, at 589; Nigriny, *supra* note 32, at 74–75.

⁴¹ See Chen, *supra* note 33, at 589; Nigriny, *supra* note 32, at 74–75.

⁴² See *Top-Level Domains (gTLDs)*, ICANN, <http://www.icann.org/en/tlds/> (last visited Nov. 21, 2013). A domain name often is part of, but distinct from, a Uniform Resource Locator (“URL”), which is a formatted text string used by web browsers, email clients and other software to identify a network resource on the Internet, such as <http://mail.google.com/user_1234.htm>. URLs begin, from left to right, with a “scheme,” which tells the computer *how* to connect to the Internet, e.g., “http”. The scheme is followed by a colon and two forward slashes, e.g., “://”. Following the colon and two forward slashes is the “host,” usually in the form of a domain name, which tells a computer device *where* on the Internet the information sought is located, e.g., “mail.google.com”. Lastly, comes the “path of the URL,” which is preceded by a forward slash and identifies a *specific location* on the host, e.g., “/user_1234.htm”. See Steven Blackerby, *Flat Broke and Busted, But Can I Keep My Domain Name? Domain Name Property Interests in the First, Fifth, and Eleventh Circuits*, 11 J. INTELL. PROP. L. 117, 121 (2003); G. Andrew Barger, *Cybermarks: A Proposed Hierarchical Modeling System of Registration and Internet Architecture for Domain Names*, 29 J. MARSHALL L. REV. 623, 628–29 n.15 (1996); 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 25:72 (4th ed. 2013); *Patmont Motor Werks v. Gateway Marine*, 1997 U.S. Dist. LEXIS 20877, at *13 n.6 (N.D. Cal. Dec. 17, 1997).

⁴³ See Chen, *supra* note 33, at 589; ICANN, *supra* note 42.

⁴⁴ See Chen, *supra* note 33, at 589; ICANN, *supra* note 42.

including familiar extensions such as *.com*, *.net*, *.org*, *.edu* and *.gov*.⁴⁵ The creators of the DNS originally intended for users to select a gTLD based upon their organizational purpose; such as *.com* for commercial purposes, *.net* for network infrastructure purposes or *.edu* for educational purposes.⁴⁶ However, most gTLDs no longer are restricted to such uses.⁴⁷ Over the past two decades, the gTLD *.com* has been used by many different types of Internet users and has become the most popular gTLD, presently accounting for approximately seventy-five percent of all domain names utilizing gTLDs.⁴⁸

The second most common TLDs are *country code* TLDs (“ccTLDs”), which are controlled by individual countries and territories.⁴⁹ With limited exceptions, the ccTLD for any country or territory is the same as its two-letter ISO 3166 code, such as *.cn* for China, *.uk* for the United Kingdom and *.ca* for Canada.⁵⁰

In order for the DNS to function properly, each domain name must be unique.⁵¹ Once a party registers a domain name using a specific combination of <SLD.TLD>, no other party can simultaneously register the same combination.⁵² However, identical SLDs can exist among various TLDs.⁵³ For example, <united.com>, <united.net> and <united.org> each can coexist in the DNS. Thus, while United Airlines, United Van Lines and United Health cannot simultaneously own the domain name <united.com>, each hypothetically could use their brand UNITED as a SLD in a different TLD. With some more recent exceptions, domain names traditionally have been offered to Internet users on a first-come, first-serve basis.⁵⁴

⁴⁵ See Chen, *supra* note 33, at 589; ICANN, *supra* note 42.

⁴⁶ See 4 MCCARTHY, *supra* note 42, at § 25:72; *Virtual Works, Inc. v. Volkswagen of Am., Inc.*, 238 F.3d 264, 266 (4th Cir. 2001).

⁴⁷ See 4 MCCARTHY, *supra* note 42, at § 25:72.

⁴⁸ See *Global Domain Registry Statistics*, WEBHOSTING.INFO (Sept. 23, 2013), <http://webhosting.info/registries>; *Borescopes R US v. 1800Endoscope.com, LLC*, 728 F. Supp. 2d 938, 941 (M.D. Tenn. 2010).

⁴⁹ See Chen, *supra* note 33, at 589.

⁵⁰ See A. Michael Froomkin, *ICANN's "Uniform Dispute Resolution Policy"—Causes and (Partial) Cures*, 67 BROOK. L. REV. 605, 619 (2002); Peter K. Yu, *The Origins of ccTLD Policymaking*, 12 CARDOZO J. INT'L & COMP. L. 387, 388–94 (2004).

⁵¹ See Andrew D. Murray, *Internet Domain Names: The Trade Mark Challenge*, 6 INT'L. J.L. INFO. TECH. 285, 290 (1998); Lisa M. Sharrock, *The Future of Domain Name Dispute Resolution: Crafting Practical International Legal Solutions from within the UDRP Framework*, 51 DUKE L.J. 817, 820 (2001).

⁵² *Id.*

⁵³ See Froomkin, *supra* note 50, at 621.

⁵⁴ See *id.* at 620. With some more recently introduced gTLDs, such as *.xxx*, brand owners have been permitted to register their trademarks as SLDs before the general public can. See Robert D. Richards & Clay Calvert, *Adult Websites and the Top-Level Domain Debate: ICANN's Adoption of .XXX Draws Adult-Industry Ire*, 29 CARDOZO ARTS & ENT. L.J. 527, 548 (2011).

C. *The Internet Corporation for Assigned Names and Numbers (ICANN)*

Originally, the United States government managed the DNS.⁵⁵ However, as the Internet's popularity grew in the mid-1990s, and government oversight became more difficult, the Department of Commerce recommended that DNS management should vest with a private non-profit organization.⁵⁶ In response to this recommendation, the Department of Commerce facilitated the formation of the Internet Corporation for Assigned Names and Numbers ("ICANN"), which was incorporated in 1998, and began managing the DNS shortly thereafter.⁵⁷ ICANN's main objective is to provide a competitive, market-friendly DNS.⁵⁸ To that end, ICANN creates markets for domain name registrars, introduces new gTLDs, and develops and maintains uniform approaches to domain name disputes.⁵⁹

D. *Registries and Registrars*

Domain name *registries* manage the entire database of all domain names under a specific TLD.⁶⁰ For example, VeriSign, Inc. is the domain name registry for all domain names under the gTLD *.com*⁶¹ and Neustar, Inc. is the domain name registry for all domain names under the *.us* and *.biz* TLDs.⁶² Domain name registries do not assign domain names directly to end users—that is the job of domain name *registrars*, such as Go Daddy and Network Solutions, LLC, who allocate available domain names within the registry's database for use by Internet users.⁶³

Registrars and registries generally do not prescreen domain name registrants, prevent registration of available domain names, control a registrant's use of a domain name, or determine rights concerning disputed domain names.⁶⁴ Rather, as one court analogized, their

⁵⁵ See Chen, *supra* note 33, at 590; Nigriny, *supra* note 32, at 75.

⁵⁶ See Chen, *supra* note 33, at 590; Nigriny, *supra* note 32, at 75.

⁵⁷ See Chen, *supra* note 33, at 590; Nigriny, *supra* note 32, at 75–76.

⁵⁸ *Articles of Incorporation of Internet Corporation for Assigned Names and Numbers*, ICANN (Nov. 21, 1998), <http://www.icann.org/en/general/articles.htm>.

⁵⁹ See Chen, *supra* note 33, at 590; Nigriny, *supra* note 32, at 75–76; *Articles of Incorporation of Internet Corporation for Assigned Names and Numbers*, ICANN (Nov. 21, 1998), <http://www.icann.org/en/general/articles.htm>.

⁶⁰ See *New gTLD Registries and Registrars*, NEWGTLDSITE.COM, <http://www.newgtldsite.com/registry-vs-registrar/> (last visited Oct. 4, 2013); Chen, *supra* note 33, at 591.

⁶¹ See *Fact Sheet*, VERISIGN.COM, http://www.verisigninc.com/en_US/company-information/about-verisign/fact-sheet/index.xhtml (last visited Nov. 1, 2013).

⁶² See *Domain Name Registry*, NEUSTAR.BIZ, <http://www.neustar.biz/enterprise/domain-name-registry/what-is-a-domain-name-registry#.UnQVIXA3t8E> (last visited Nov. 1, 2013).

⁶³ See *New gTLD Registries and Registrars*, NEWGTLDSITE.COM, <http://www.newgtldsite.com/registry-vs-registrar/> (last visited Oct. 4, 2013).

⁶⁴ See *Size, Inc. v. Network Solutions, Inc.*, 255 F. Supp. 2d 568, 573 (E.D. Va. 2003) ("The registrant selects the domain name and provides any content associated with that domain name; all that [the registrar] does is 'translate' the domain name into the registrant's IP address and

function is similar “to the passive messenger service provided by the United States Postal Service.”⁶⁵

II. BASICS OF TRADEMARK LAW

A. *What Is a Trademark?*

A trademark is “any word, name, symbol, or device . . . used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”⁶⁶ As explained by Justice Frankfurter in *Mishawaka Rubber & Woolen Manufacturing Co. v. S. S. Kresge Co.*:

A trade-mark is a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every human effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears.⁶⁷

Trademarks serve several important functions, including: (1) informing consumers of the source of the goods or services offered in conjunction with the trademark; (2) enabling consumers to distinguish different sources of goods and services; (3) signifying that all goods bearing the trademark come from or are controlled by a single source; (4) signifying that all goods bearing the trademark are of equal quality; and (5) acting as a prime instrument in advertising and selling the goods.⁶⁸

In order for a term to function and be protected as a trademark, it must either be *inherently distinctive* or have *acquired distinctiveness*.⁶⁹ To determine whether a trademark is distinctive, terms first are placed

route users to that address.”).

⁶⁵ *Id.*

⁶⁶ 15 U.S.C. § 1127 (2012).

⁶⁷ *Mishawaka Rubber & Woolen Mfg. Co. v. S. S. Kresge Co.*, 316 U.S. 203, 205 (1942).

⁶⁸ *See* 1 MCCARTHY, *supra* note 42, at §§ 3:2. *See also id.* § 2:1 (“Brand names and trademarks become associated with expectations of a particular quality. Reputations based on consistent past performance economize on the costs of information about the anticipated performance of a good. Thus consumers will sensibly use the brand name or reputation of the maker as a basis for choice. The greater are the possible losses from poor performance of a good, the greater is the value of that brand name as a predictor of quality of performance. Without brand names or other means of identifying makers, consumers would face larger risks and incur greater costs of information.” (quoting A. Alchian & W.R. Allen, EXCHANGE AND PRODUCTION: COMPETITION, COORDINATION, AND CONTROL 193 (2d ed. 1977))).

⁶⁹ *See* 2 MCCARTHY, *supra* note 42, at § 11:1.

into one of five categories: (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; and (5) fanciful.⁷⁰

A “generic” term is the common name for a good or service when used in conjunction *with* that good or service, *e.g.*, APPLE for apples and MARKETING for marketing services.⁷¹ A generic term, which really is the name of the product or service itself, cannot function as a trademark; indeed, a generic term is the very “antithesis” of a trademark.⁷²

In determining whether a term is generic, some courts have relied on the “who-are-you/what-are-you” test.⁷³ A trademark answers the consumer’s questions, “Who are you?” “Where do you come from?” “Who vouches for you?” But the generic name of a product answers the question “What are you?”⁷⁴ Under this test, “[i]f the primary significance of the trademark is to describe the type of product rather than the producer, the trademark [is] a generic term and [cannot be] a valid trademark.”⁷⁵

However, when two generic terms are combined, the composite phrase *may* be distinctive and function as a trademark in its own right.⁷⁶ For example, in *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, the court found that, although the terms “park” and “fly” individually were generic, the combined phrase PARK ‘N FLY was *not* the common name for the plaintiff’s airport parking services and thus was not generic.⁷⁷

A “descriptive” term immediately conveys a characteristic, quality or ingredient of the good or service offered in conjunction with that term, *e.g.*, RED for apples and HONEY ROAST for nuts.⁷⁸ Descriptive terms are not inherently distinctive and can serve as trademarks only if they have acquired distinctiveness through *secondary meaning*.⁷⁹ Secondary meaning exists when “the primary significance of the term in

⁷⁰ *See id.*

⁷¹ *See id.*

⁷² *See id.* at § 12:58; *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 1569 (Fed. Cir. 1995) (“A generic term cannot be registered as a trademark because such a term cannot function as an indication of source.”); *Roux Labs., Inc. v. Clairol, Inc.*, 427 F.2d 823, 829 (C.C.P.A. 1970) (“It is true, of course, that mere advertising or other evidence of supposed secondary meaning cannot convert something unregistrable by reason of its being the common descriptive name or generic name for the goods—the antithesis of a trademark—into a registerable mark”).

⁷³ *See, e.g.*, *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1391 (9th Cir.1993).

⁷⁴ *See id.*

⁷⁵ *Anti-Monopoly, Inc. v. Gen. Mills Fun Grp.*, 611 F.2d 296, 304 (9th Cir. 1979).

⁷⁶ *See 2 MCCARTHY, supra* note 42, at §§ 11:26, 12:39.

⁷⁷ *Compare* *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 718 F.2d 327, 330-31 (9th Cir. 1983) (combination of generic terms “park” and “fly” resulted in non-generic compound phrase), *rev’d on other grounds*, 469 U.S. 189 (1985), *with* *Surgicenters of Am., Inc. v. Med. Dental Surgeries Co.*, 601 F.2d 1011, 1015-18 (9th Cir. 1979) (finding term “surgicenter,” created by combining generic terms “surgery” and “center,” retained generic quality of its individual components).

⁷⁸ *See 2 MCCARTHY, supra* note 42, at § 11:16.

⁷⁹ *See id.* at § 11:1.

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the minds of the consuming public is not the product but the producer.”⁸⁰ As Judge Denison explained in *G. & C. Merriam Co. v. Saalfield*:

[Secondary meaning] contemplates that a word or phrase originally, and in that sense primarily, incapable of exclusive appropriation with reference to an article on the market . . . might nevertheless have been used so long and so exclusively by one producer with reference to his article that, in that trade and to that branch of the purchasing public, the word or phrase had come to mean that the article was his product; in other words, had come to be, to them, his trade-mark.⁸¹

Secondary meaning may be shown by direct evidence, in the form of a customer survey, or circumstantial evidence, in the form of sales volume, length of time used and the quantity and quality of advertising and promotion exposing customers to the trademark.⁸² Thus, while the trademark BANK OF AMERICA began as a merely descriptive term, through long-term and widespread substantially exclusive use, the public now understands the term primarily as identifying a single source of financial services, and not merely as describing a bank located in the United States.⁸³ In today’s age of mass media and constant advertising, companies can develop secondary meaning in their descriptive trademarks quite quickly, even in as little time as a matter of weeks.⁸⁴

A “suggestive” term *implies*, but does not immediately describe, a characteristic, quality or ingredient of the good or service offered in conjunction with that term—some sense of imagination is required to make the connection from the suggestive term to the good or service, *e.g.*, COPPERTONE for suntan lotion and WRANGLER for western boots and jeans.⁸⁵ An “arbitrary” term is a common word used in a context wholly unrelated to that meaning, *e.g.*, APPLE for computers and MARS for candy.⁸⁶ Whereas, a “fanciful” term (also referred to as a “coined” term), is a wholly invented term that has no prior meaning and was created solely for use as a trademark, *e.g.*, VIAGRA for pharmaceuticals and VERIZON for telecommunication services.⁸⁷ Unlike generic and descriptive terms, suggestive, arbitrary and fanciful

⁸⁰ *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 118 (1938).

⁸¹ *G. & C. Merriam Co. v. Saalfield*, 198 F. 369, 373 (6th Cir. 1912).

⁸² See 2 MCCARTHY, *supra* note 42, at § 15:1.

⁸³ See *In re BankAmerica Corp.*, 231 U.S.P.Q. 873 (T.T.A.B. 1986) (refusing to register BANK OF AMERICA as a primarily descriptive mark except upon a showing of secondary meaning).

⁸⁴ See 2 MCCARTHY, *supra* note 42, at § 15:56.

⁸⁵ See *id.* at § 11:67.

⁸⁶ See *id.* at § 11:11.

⁸⁷ See *id.* at § 11:5.

terms are inherently distinctive and automatically function as trademarks upon use.⁸⁸

B. *What Do Trademark Laws Protect?*

A trademark does not confer upon its owner a “right in gross. . . . There is no such thing as property in a trade-mark except as a right appurtenant to an established business or trade in connection with which the mark is employed.”⁸⁹ Trademark law generally protects against a junior user’s subsequent use of a name, word, symbol or device only to the extent such use is *likely to cause consumer confusion* as to the source, sponsorship or affiliation of the parties’ goods.⁹⁰ As Justice Holmes remarked nearly ninety years ago in *Prestonettes, Inc. v. Coty*:

Then what new rights does the trade-mark confer? It does not confer a right to prohibit the use of the word or words. It is not a copyright. . . . A trade-mark only gives the right to prohibit the use of it so far as to protect the owner’s good will against the sale of another’s product as his. . . . When the mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth. It is not taboo.⁹¹

In the United States, the primary source of trademark protection stems from the federal Lanham Act of 1946.⁹² Sections 32(1) and 43(a) of the Lanham Act provide causes of action for infringement of a registered trademark and unfair competition (also known as false designation of origin), respectively.⁹³ These provisions prohibit a junior party from using a trademark that is likely to cause consumer confusion as to source, sponsorship or affiliation, in light of a senior party’s use of its trademark.⁹⁴

⁸⁸ See *id.* at § 11:1.

⁸⁹ *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918) (“The asserted doctrine is based upon the fundamental error of supposing that a trade-mark right is a right in gross or at large, like a statutory copyright or a patent for an invention, to either of which, in truth, it has little or no analogy.”).

⁹⁰ See 4 MCCARTHY, *supra* note 42, at § 23:1; *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1149 (9th Cir. 2011) (“[T]he *sine qua non* of trademark infringement is consumer confusion.”).

⁹¹ 264 U.S. 359, 368 (1924).

⁹² Pub. L. 113-36, 60 Stat. 427 (July 5, 1946) (codified at 15 U.S.C. § 1051). State laws also protect trademarks, but most are deemed congruent with federal protections. See, e.g., *Grupo Gigante S.A. de C.V. v. Dallo & Co.*, 391 F.3d 1088, 1100 (9th Cir. 2004) (“As a general matter, trademark claims under California law are ‘substantially congruent’ with federal claims and thus lend themselves to the same analysis.”).

⁹³ See 15 U.S.C. § 1114(1) (2012) (infringement of a registered trademark); 15 U.S.C. § 1125(a) (2012) (unfair competition/false designation of origin).

⁹⁴ See *id.* § 1114(1) (trademark infringement defined as unauthorized “use in commerce [of] any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the

Each Circuit has a similar multi-factor test for determining whether consumer confusion is likely under the Lanham Act, which generally examines: (1) the inherent and commercial strength of the senior user's trademark; (2) the degree of similarity between the two trademarks, with respect to sight, sound, connotation and how the trademarks appear and are presented in the marketplace; (3) the degree of similarity between the nature of the goods; (4) the proximity of the products in the marketplace, including whether they are advertised and sold through the same marketing channels; (5) whether there have been instances of actual confusion (including through a consumer survey); (6) the junior user's intent in adopting its own trademark; (7) the sophistication of buyers, including the degree of care such buyers would exercise when making purchasing decisions; and (8) any other factors that may affect likely confusion.⁹⁵ No single factor is determinative; each factor must be weighed and balanced against one another to determine whether confusion is likely.⁹⁶

Thus, trademark law recognizes that, while Delta Airlines, Delta Faucet Company and Delta Dental Plans Association each use the trademark DELTA, consumers are not likely to be confused as to source, sponsorship or affiliation when each company uses its trademark in connection with its own distinct goods and services.⁹⁷

The Lanham Act also protects *famous* trademarks against dilution.⁹⁸ Dilution can occur by *blurring* or *tarnishment*.⁹⁹ Dilution by tarnishment "is association arising from the similarity between a mark

sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive"); *id.* § 1125(a) (creating liability for unfair competition/false designation of origin for "[a]ny person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person").

⁹⁵ See, e.g., *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961); *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1229 (3d Cir. 1978); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979).

⁹⁶ See, e.g., *Plus Prods. v. Plus Discount Foods, Inc.*, 722 F.2d 999, 1004 (2d Cir. 1983).

⁹⁷ See *Delta Airlines*, DELTA.COM, <http://www.delta.com/> (last visited Oct. 11, 2013); *Delta Dental Plans Association*, DELTADENTAL.COM, <http://www.deltadental.com/Public/index.jsp> (last visited Oct. 11, 2013); *Delta Faucet Company*, DELTAFAUCET.COM, <http://www.deltafaucet.com/index.html> (last visited Oct. 11, 2013). See also 4 MCCARTHY, *supra* note 42, at § 24:11 (noting, *inter alia*, the lack of confusion between the following: UNITED airlines and UNITED van lines; among EAGLE shirts, EAGLE pencils, EAGLE pretzels and EAGLE condensed milk; and between CHAMPION spark plugs and CHAMPION sportswear).

⁹⁸ See 15 U.S.C. § 1125(c) (2012); see also 4 MCCARTHY, *supra* note 42, at §§ 24:67, 24:104 (noting that Congress provided the following examples of famous marks for dilution purposes: DUPONT on shoes, BUICK on aspirin and KODAK on pianos).

⁹⁹ See 15 U.S.C. § 1125(c) (2012); see also 4 MCCARTHY, *supra* note 42, at § 24:67.

or trade name and a famous mark that harms the reputation of the famous mark.”¹⁰⁰ Dilution by tarnishment arises when the defendant has used the plaintiff’s mark for clearly unwholesome or degrading purposes, thereby harming the brand.¹⁰¹

However, most dilution claims are brought based on blurring, which “is association arising from the similarity between a mark or trade name and a famous mark that *impairs the distinctiveness* of the famous mark.”¹⁰²

The theory says that if customers or prospective customers see the plaintiff’s famous mark used by other persons to identify other sources for many different goods and services, then the ability of the famous mark to clearly identify and distinguish only one source might be “diluted” or weakened.¹⁰³

Because trademark rights only exist appurtenant to specific goods and services, trademark rights may be abandoned through lack of use in connection with those goods and services.¹⁰⁴ Similarly, trademark rights can be abandoned though *lack of control* over the goods and services offered in conjunction with the trademark.¹⁰⁵ Thus, in *Barcamerica International USA Trust v. Tyfield Importers, Inc.*, the owner of the DAVINCI trademark for wine lost its trademark rights when it licensed the trademark to a third party and made no efforts to maintain any

¹⁰⁰ See 15 U.S.C. § 1125(c) (2012); see also 4 MCCARTHY, *supra* note 42, at § 24:70.

¹⁰¹ See *id.* at § 24:70. For example, in *Coca-Cola Co. v. Alma-Leo U.S.A., Inc.*, 719 F. Supp. 725 (N.D. Ill. 1989), the court found the defendant’s posters, which contained the phrase ENJOY COCAINE in a Spenserian script and red and white colors identical to that used in COCA-COLA advertisements, diluted by tarnishment the good will established by Coca-Cola in its brand.

¹⁰² See 15 U.S.C. § 1125(c) (2012) (emphasis added); see also 4 MCCARTHY, *supra* note 42, at § 24:69.

¹⁰³ 4 MCCARTHY, *supra* note 42, at § 24:69. In determining whether a junior user’s trademark is likely to cause dilution by blurring under the Lanham Act, courts should consider: (1) the degree of similarity between the junior user’s trademark and the famous mark; (2) the degree of inherent or acquired distinctiveness of the famous trademark; (3) the extent to which the owner of the famous trademark is engaging in substantially exclusive use of the trademark; (4) the degree of recognition of the famous trademark; (5) whether the junior user of the trademark intended to create an association with the famous trademark; and (6) any actual association between the junior user’s trademark and the famous trademark. See 15 U.S.C. § 1125(c) (2012).

¹⁰⁴ See 3 MCCARTHY, *supra* note 42, at § 17:9. Trademarks that have not been used for at least three years are presumptively deemed abandoned. See *id.* at § 17:18; see also 15 U.S.C. § 1127 (2012) (defining the term “abandoned”).

¹⁰⁵ See *Eva’s Bridal Ltd. v. Halanick Enters.*, 639 F.3d 788, 791 (7th Cir. 2011) (finding case to be “paradigm of a naked license” where plaintiffs had exercised “no authority over the appearance and operations of defendants’ business.”); *Dawn Donut Co. v. Hart’s Food Stores, Inc.*, 267 F.2d 358, 367 (2d Cir. 1959) (without control, “the risk that the public will be unwittingly deceived will be increased . . . [and] the only effective way to protect the public . . . is to place on the licensor the affirmative duty of policing in a reasonable manner the activities of his licensees.”).

control over the nature and quality of the wine produced by the licensor under the trademark.¹⁰⁶

C. *The United States Patent and Trademark Office (USPTO)*

In the United States, trademark rights are established through use, not registration.¹⁰⁷ However, trademark owners who register their trademarks with the United States Patent and Trademark Office (“USPTO”) enjoy certain advantages, including notice to the public of the registrant’s claim of ownership of the mark and a legal presumption of exclusive nationwide trademark rights.¹⁰⁸

The USPTO thoroughly reviews trademark applications and may refuse registration for a variety of reasons, including that the applicant’s proposed trademark is not distinctive or is likely to cause consumer confusion in light of a previously registered trademark.¹⁰⁹ Applicants who are denied registration can appeal that determination to the USPTO’s Trademark Trial and Appeal Board (“TTAB”).¹¹⁰ The TTAB also hears and decides challenges to trademark applications and registrations brought by third parties.¹¹¹ The TTAB decides only issues of trademark registrability and cannot preclude another party from *using* a trademark in commerce.¹¹²

III. THE USE OF TRADEMARKS AS SLDs IN DOMAIN NAMES

As the Internet rose in popularity during the mid-1990s, businesses rapidly began establishing websites to promote and sell their goods and services.¹¹³ Just as merchants had displayed their names and brands on the signage of their brick and mortar stores in order to distinguish themselves from their competitors, they quickly realized the value of incorporating their trademarks into domain names that would direct Internet users to their websites.¹¹⁴ Consumers already were

¹⁰⁶ *Barcamerica Int’l USA Trust v. Tyfield Importers, Inc.*, 289 F.3d 589 (9th Cir. 2002).

¹⁰⁷ See 2 MCCARTHY, *supra* note 42, at § 16:4; *Sengoku Works Ltd. v. RMC Intern., Ltd.*, 96 F.3d 1217, 1219 (9th Cir. 1996); *Miller v. Glenn Miller Productions*, 454 F.3d 975, 979 (9th Cir. 2006).

¹⁰⁸ See 3 MCCARTHY, *supra* note 42, at § 19:9.

¹⁰⁹ See *Trademark Process*, USPTO, <http://www.uspto.gov/trademarks/process/> (Sept. 6, 2012 5:25 PM); 15 U.S.C. § 1052 (2006) (setting forth restrictions on federal registrations).

¹¹⁰ See 3 MCCARTHY, *supra* note 42, at § 19:127.

¹¹¹ See *id.* at § 20:2.

¹¹² See *id.* at § 20:99. Decisions of the TTAB may be appealed to a United States District Court or the United States Court of Appeals for the Federal Circuit. See *id.* at § 21:20.

¹¹³ See Xuan-Thao N. Nguyen, *Shifting the Paradigm in E-Commerce: Move Over Inherently Distinctive Trademarks – The E-Brand, I-Brand and Generic Domain Names Ascending to Power?*, 50 AM. U.L. REV. 937, 948–50 (2001); Robert H. Zakon, HOBBS’ INTERNET TIMELINE #11, <http://www.zakon.org/robert/internet/timeline> (last visited Dec. 21, 2013) (tracing development of Internet from 1950s through present).

¹¹⁴ See Nguyen, *supra* note 113, at 948–50; Michael S. Denniston and Margaret Smith Kubiszyn, *www.yourclient.com: Choosing Domain Names and Protecting Trademarks on the Internet*, 61

familiar with these trademarks, which had amassed significant goodwill that inured to the benefit of their owners in the non-virtual world.¹¹⁵ It logically made sense for businesses to utilize the same trademarks, which already carried goodwill, in their domain names to establish a web presence and expand their reputation to the Internet.¹¹⁶

For many businesses, the obvious choice was to register their trademark followed by *.com*, which quickly had established itself as the most popular gTLD.¹¹⁷ As the court noted in one of the earliest domain name cases:

Because users may have difficulty accessing web sites or may not be able to access web sites at all when they do not know (or cannot deduce) the proper domain name, businesses frequently register their names and trademarks as domain names. Therefore, having a known or deducible domain name is important to companies seeking to do business on the Internet, as well as important to consumers who want to locate those businesses' web sites.¹¹⁸

By the late-1990s, consumers generally were conditioned to the fact that the website of their favorite brands likely could be found by typing in the names of the companies followed by *.com*.¹¹⁹ Domain names had

ALA. LAW. 40, 41–42 (2000).

¹¹⁵ See *Denniston & Kubiszyn*, *supra* note 114, at 41–42.

¹¹⁶ See *Harrods Ltd. v. Sixty Internet Domain Names*, 302 F.3d 214, 222 (4th Cir. 2002) (“For obvious reasons, most companies want their primary trademark to serve as their second-level domain, as in *vw.com* for Volkswagen of America.”).

¹¹⁷ See also 4 MCCARTHY, *supra* note 42, at § 25:73 (“Because of custom and usage, many business and professional entities companies around the world want their domain name to be in the ‘.com’ domain. . . . ‘.com’ . . . is, at the present time, the most desirable business address to have in cyberspace. . . . [T]hrough habit and convention, Internet users have come to expect that to reach the Web site of a company they should be able to type in the name of the company or its major trademark, along with the ‘.com’ designation.”).

¹¹⁸ *Panavision Int’l L.P. v. Toepfen*, 945 F. Supp. 1296, 1299 (C.D. Cal. 1996). See also Joshua M. Borson, Note, *A World of Infinite Domain Names: Why ICANN’s New gTLD Policy Inadequately Addresses Consumer Protection and Legitimate Trademark Concerns*, 58 WAYNE L. REV. 481, 485 (2012) (“Registering a desired name or mark is a valuable asset for both the marketability of a business and the convenience of consumers. Locating a desired web page, for example, is much simpler when a web user knows the domain name beforehand or is able to deduce it with relative ease”).

¹¹⁹ See *Sporty’s Farm LLC v. Sportsman’s Mkt., Inc.*, 202 F.3d 489, 499 (2d Cir. 2000) (“The most common method of locating an unknown domain name is simply to type in the company name or logo with the suffix *.com*.”); *Brookfield Commc’ns. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1045 (9th Cir. 1999) (“Web users often assume, as a rule of thumb, that the domain name of a particular company will be the company name followed by ‘.com.’”); *Lockheed Martin Corp. v. Network Solutions*, 985 F. Supp. 949, 952 (C.D. Cal. 1997) (“Internet users intuitively try to find businesses by typing in the corporate or trade name as the second-level domain name, as in ‘*acme.com*’”). See also 4 MCCARTHY, *supra* note 42, at § 25:73 (“through habit and convention, Internet users have come to expect that to reach the Web site of a company they should be able to type in the name of the company or its major trademark, along with the ‘.com’ designation.”).

become more than mere addresses on the Internet; they were functioning as indicators of source.¹²⁰

IV. NEW GENERIC TOP LEVEL DOMAINS (gTLDs)

When ICANN was first established in 1998, the following seven gTLDs already existed: *.com*, *.net*, *.edu*, *.gov*, *.mil*, *.org* and *.int*.¹²¹ In furtherance of its goal to create additional gTLDs and provide competitive marketplaces for domain name registrars, by 2000, ICANN had approved the introduction of *.aero*, *.biz*, *.coop*, *.info*, *.museum*, *.name* and *.pro*.¹²² And by 2004, *.asia*, *.cat*, *.jobs*, *.mobi*, *.tel*, *.travel*, *.post* and *.xxx* had been added to the roster of approved gTLDs, bringing the total number to twenty-two.¹²³

Despite these expansions, by the mid-2000s, ICANN became concerned that the current gTLDs would not support the increasing demands of the marketplace for new domain names.¹²⁴ Indeed, almost every word in the English language already has been registered as a SLD in connection with *.com*, the most popular gTLD.¹²⁵ And many of the other current gTLDs are not appealing to Internet users, given their perceived secondary status to *.com*. “In the same way that businesses sometimes desire to have a prestige business address, the ‘.com’ address has become the prestige locale.”¹²⁶

Thus, in June 2011, ICANN instituted a plan to dramatically increase the number of gTLDs.¹²⁷ ICANN’s “New gTLD Program” allowed any public or private entity to apply to register nearly any word in nearly any language as a gTLD, provided the entity could

¹²⁰ See *Brookfield Commcn’s.*, 174 F.3d at 1045. See also 4 MCCARTHY, *supra* note 42, at § 25:73 (“For example, if the hypothetical construction equipment manufacturer ‘The Jupiter Company’ were to open a web page to advertise its wares, it would probably want the domain name ‘jupiter.com’ in order to make it as easy as possible for a prospective customer to find the Web site.”).

¹²¹ See *About the Program*, ICANN, <http://newgtlds.icann.org/en/program-status/statistics> (last visited Feb. 12, 2014).

¹²² See *id.*

¹²³ See *id.*

¹²⁴ See *New gTLD Program Explanatory Memorandum*, ICANN 1 (May 30, 2009), <http://www.icann.org/en/topics/new-gtlds/three-character-30may09-en.pdf> (explaining additional gTLDs will enhance competition for domain names, allowing Internet users to benefit from increased creativity and choice).

¹²⁵ As early as 1999, out of 25,500 standard dictionary words, only 1,760 remained unregistered as domain names. See Declan McCullagh, *Domain Name List is Dwindling*, WIRED (Apr. 14, 1999), <http://www.wired.com/news/technology/0,1282,19117,00.html>.

¹²⁶ 4 MCCARTHY, *supra* note 42, at § 25:73. See also *id.* (“Because of custom and usage, many business and professional entities companies around the world want their domain name to be in the “.com” domaincom . . . is, at the present time, the most desirable business address to have in cyberspace.”).

¹²⁷ See *ICANN Approves Historic Change to Internet’s Domain Name System: Board Votes to Launch New Generic Top-Level Domains*, ICANN (June 20, 2011), <http://www.icann.org/en/announcements/announcement-20jun11-en.htm>.

demonstrate the ability to meet certain technical, operational, financial and other criteria.¹²⁸

Significantly, for the first time ever, ICANN invited companies and brand owners to register their *names* and *trademarks* as gTLDs.¹²⁹ The New gTLD Program presented numerous opportunities for trademark owners to maximize their brand value on the Internet and create new revenue sources.¹³⁰ As Mark Pilipczuk, Vice President of Marketing for the domain name registry Neustar, Inc., one of the first companies to announce it would apply for its brand as a new gTLD, stated:

Having a brand-specific gTLD gives companies an infinite universe of branded domains that can be used to promote products and services. . . . One of the many benefits of owning the .NEUSTAR gTLD is the flexibility it provides in creating shorter, more intuitive and easy to remember domains for our marketing campaigns.¹³¹

Owning a “dot brand” enables brand owners to provide certain assurances to the public. A “dot brand” gTLD represents a secure online space that is devoid of third party infringing, counterfeiting and phishing sites.¹³² These branded gTLDs have great potential to “result in a trusted space where consumers can rely on the notion that, ‘if it doesn’t end in .ourbrand, it’s not a genuine ‘our brand’ website.’”¹³³

Alexa Raad, a domain name consultant and the former CEO of the Public Interest Registry, offers the following explanation for why new gTLDs will benefit brand owners:

To understand the possibilities of new TLDs, think of an apartment building. A website (*i.e.*, a domain name) is like an apartment. You rent it, conduct a good portion of your life there, entertain folks and get an address so people can find you and send things. You can paint the walls, but you can’t upgrade the plumbing or replace the cabinets.

¹²⁸ *See id.*

¹²⁹ *See id.*

¹³⁰ Mark V.B. Partridge & Jordan A. Arnot, *Lead Article: Expansion of the Domain Name System: Advantages, Objections and Contentions*, 22 DEPAUL J. ART TECH. & INTELL. PROP. L. 317, 319 (2012) (“Owning both sides of the ‘dot’ in a web address allows the company to strengthen its online presence in its brand, products, and services.”).

¹³¹ *Neustar to Establish its Own Brand-Specific Generic Top-Level Domain*, NEUSTAR (June 20, 2011), <http://www.neustar.biz/about-us/news-room/press-releases/2011/neustar-to-establish-its-own-brand-specific-generic-top-level-domain>.

¹³² *See* Partridge & Arnot, *supra* note 130, at 321.

¹³³ *Id.*

The owner of the apartment building is the TLD. She decides who can live there, charges rent, makes the rules and determines whether you'll have granite tops or laminates in the kitchen, burpee or shag carpet in the den.

Think of what eBay might do. With .eBay, the company becomes a registry that, like an apartment building owner, decides who gets an .eBay address and manages all the website names it signs up. Maybe that's anyone who wants to sell occasionally on the site. So instead of a convoluted website address such as <http://myworld.ebay.com/abestshop4u/?trksid=p4340.12569>, which only a mental contortionist could remember and would be useless to use in print material, you get OldBooks.eBay. Not only can you put it on printed material, but it can appear where those who might see it can still remember it, say, the side of a bus.¹³⁴

As Ms. Raad suggests, companies that register their brands as gTLDs essentially will become their own domain name registries and can open up their "dot brand" to qualified and approved parties who will pay to register SLDs at the "dot brand." Thus, in Ms. Raad's example, eBay can charge "Old Books" a fee to register the domain name OldBooks.eBay, resulting in increased revenue to the company based solely on the ability to control a gTLD.

However, not everyone perceives "dot brand" and the new gTLDs as beneficial for either consumers or brand owners.¹³⁵ Unlike SLDs, which can be identical and owned by different parties (including co-existing trademark holders) across various TLDs, no two new TLDs can be exactly the same.¹³⁶ Thus, if two companies that own identical trademarks—but for different goods and services—both want to register their brand as a gTLD, only one can obtain the registration.¹³⁷ Some argue that the winner of the gTLD registration will obtain inflated and unsupported strength and fame in their trademark, solely by virtue of their ability to control the gTLD, at the expense of the other party.¹³⁸

¹³⁴ Alexa Raad, *Why ICANN's New Domain-Name System Could Benefit Brands*, AD AGE (Aug. 16, 2011), <http://adage.com/article/cmo-strategy/icann-s-domain-system-benefit-brands/229278/>.

¹³⁵ See, e.g., Alexandra Morgan Joseph, *I CANN'T Believe It's Not Better: Why New gTLDs Are Bad for Brand Owners and Trademark Law*, 20 J. INTELL. PROP. L. 149 (2012).

¹³⁶ See *New gTLD Program*, ICANN 3 (2009), <http://archive.icann.org/en/topics/new-gtlds/factsheet-new-gtld-program-oct09-en.pdf>.

¹³⁷ See Partridge & Arnot, *supra* note 130, at 322 ("For instance, there is a United Airlines and multiple United Banks, but only one company [can] get .united.").

¹³⁸ See Joseph, *supra* note 135, at 172–73 ("Another hypothetical situation, aside from companies and organizations boiling down their longer brands into one-word TLDs, is two trademark owners 'fighting' over a new gTLD [A] 'fight' occurs when two entities use the exact same brand (example: Domino Sugar and Domino's Pizza). In a 'fight' situation, only one entity can successfully acquire the gTLD that corresponds to its mark. When this occurs, it will create a 'dominant' trademark holder where there was not one before. What would happen, for example, if

Some critics of the program complain that this fixed property right will lead to increased consumer confusion.¹³⁹ Other critics have argued that the new gTLDs will lead to increased cybersquatting, which will force companies to spend more money on trademark enforcement by filing more proceedings against cybersquatters and also defensively registering their trademarks across as many new gTLDs as possible, as a preventative measure, before cybersquatters can attack.¹⁴⁰

Despite the cultural debate over their benefits, on January 12, 2012, ICANN began accepting applications for the new gTLDs.¹⁴¹ On June 13, 2012, known as “Reveal Day,” ICANN disclosed that it had received nearly 2,000 applications for approximately 1,200 different gTLDs.¹⁴² The following represents merely a small sampling of the new gTLDs for which numerous brand owners, community and professional organizations, Internet companies, venture capitalists, local governments and other interested parties have applied:

.google, .spa, .site, .menu, .café, .bing, .ski, .video, .sydney, .fish, .app, .boston, .bike, .music, .dating, .nyc, .beer, .expert, .poker, .sport, .home, .shop, .chevy, .green, .nokia, .diet, .swiss, .vegas, .pizza, .accountant, .wine, .boutique, .baby, .london, .life, .fit, .cooking, .web, .eco, .food, .casino, .volvo, .legal, .scot, .barclays, .give, .target, .cafe, .beer, .recipes, .engineer, .win, .supply, .thai, .online, .doctor, .pets, .music, .deals, .walmart, .fashion, .cool, .gucci, .toys, .buy, .paris, .beauty, .tokyo, .citi, .kinder, .media, .earth, .prof, .sony, .berlin, .deals, .villa, .run, .ericsson, .games, .mcdonalds, .canon, .cadillac, .gap, .macys, .law, .news, .insurance, .hair, .sports, .financial,

the less well-known Delta Faucets gains control over ‘.delta’ rather than the more prominent brand Delta Airlines? This situation could produce very real consequences in the non-virtual marketplace, as some marks gain unearned prominence and fame. This, in turn, would inflate the value of some brands, especially for brands that ‘win’ in ‘fight’ situations.”)

¹³⁹ See *id.* at 171–74.

¹⁴⁰ See Borson, *supra* note 118, at 499–506. To alleviate some concerns raised by brand owners, ICANN introduced several new rights protections mechanisms, including: permitting early third party challenges to proposed gTLDs, such as objections based on likelihood of confusion with existing trademarks; the Post-Delegation Dispute Resolution Procedure, which allows arbitration claims against owners of gTLDs who engage in abusive practices; the Trademark Clearinghouse, which is a centralized repository of data on trademark ownership that will give brand owners “first dibs” at registering their brand names as SLDs with the new gTLDs; and the Uniform Rapid Suspension procedure, which is a cheaper version of the UDRP reserved only for clear-cut cases of cybersquatting. For a detailed overview of each of these mechanisms, see generally Dennis S. Prah & Eric Null, *The New Generic Top-Level Domain Program: A New Era of Risk for Trademark Owners and the Internet*, 101 TRADEMARK REP. 1757 (2011).

¹⁴¹ See *New gTLDs: What to Expect in 2012*, ICANN (Jan. 23, 2012), <http://newgtlds.icann.org/en/announcements-and-media/announcement-23jan12-en>.

¹⁴² See *New gTLD Reveal Day—Applied-for Strings*, ICANN (June 13, 2012), <http://newgtlds.icann.org/en/announcements-and-media/announcement-13jun12-en>.

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*.charity, .books, .makeup, .tickets, .movie, .art, .golf, .flowers, .dubai, .istanbul and .amsterdam.*¹⁴³

Several parties each applied for numerous gTLDs. For example, Google Inc. applied for 101 gTLDs; Amazon.com, Inc. applied for 76 gTLDs; and Donuts Inc., a company formed by venture capitalists solely for the purpose of registering and maintaining gTLDs, applied to register 307 gTLDs.¹⁴⁴ Multiple parties also applied for many of the same gTLDs, including: *.app* (13); *.home* (11); *.inc* (11); *.art* (10); *.blog* (9); *.book* (9); *.llc* (9); *.shop* (9); *.design* (8); *.cloud* (7); *.hotel* (7); *.love* (7); *.ltd* (7); *.mail* (7); *.news* (7); *.store* (7); and *.web* (7).¹⁴⁵

As of September 2013, ICANN had approved over five hundred new gTLDs and signed nearly fifty final agreements with applicants to begin the process of launching gTLDs.¹⁴⁶ The first new gTLDs launched in October and November 2013.¹⁴⁷

V. HOW NEW GTLDS LIKELY WILL ALTER PRESENT NOTIONS OF CONSUMER PERCEPTION CONCERNING DOMAIN NAMES AND THE INTERNET

Although consumers today access the Internet through many different types of devices and portals than were available twenty years ago, since the DNS was established, the structure and purpose of domain names essentially have not changed. During this time, courts have developed certain maxims about consumer perception relating to domain names upon which they have relied when developing and applying trademark laws with respect to the Internet. However, with the onset of new gTLDs, consumer attitudes toward domain names likely

¹⁴³ For a full list of applied-for new gTLDs and their applicants, see *List of Proposed New Top-Level Domains*, CNN MONEY, <http://money.cnn.com/infographic/technology/new-gtld-list/> (last visited Oct. 7, 2013).

¹⁴⁴ See *Here Comes .NETFLIX: New Web domain Applications Revealed*, CNN MONEY (June 13, 2012), <http://money.cnn.com/2012/06/13/technology/new-domain-expansion-gtlds/index.htm>; Danny Goodwin, *Google Pays \$18.6 Million Applying for 101 New gTLDs*, SEARCH ENGINE WATCH (June 13, 2012), <http://searchenginewatch.com/article/2184179/Google-Pays-18.6-Million-Applying-for-101-New-gTLDs>; Michael Berkens, *Here Are the 307 New gTLD's That Donuts Applied For*, THE DOMAINS (June 13, 2012), <http://www.thedomains.com/2012/06/13/here-are-the-307-new-gtlds-that-donuts-applied-for/>.

¹⁴⁵ See *Program Statistics*, ICANN (Aug. 21, 2013), <http://newgtlds.icann.org/en/program-status/statistics>. Each contested gTLD will have to be resolved through ICANN's resolution procedures, and the gTLD likely will be awarded to the highest bidder among the approved applicants. See *Auction Rules for New gTLDs*, ICANN (Dec. 12, 2013), <http://newgtlds.icann.org/en/applicants/auctions/rules-12dec13-en.pdf>.

¹⁴⁶ See *New Contracting Statistics Released—CIRS Sent through Priority 1000*, ICANN (Oct. 1, 2011), <http://newgtlds.icann.org/en/announcements-and-media/announcement-01oct13-en>.

¹⁴⁷ See *New gTLD Launch Dates*, KEY-SYSTEMS, <http://www.key-systems.net/english/news/new-gtlds/new-gtld-launch-dates.html> (last visited Dec. 21, 2013).

will change, and many well-established legal principles likely no longer will be appropriate in the new gTLD landscape.

A. *Current Jurisprudence Generally Views gTLDs as Generic*

Current jurisprudence generally views gTLDs just as their name classification states: *generic*, and thus incapable of conveying source indicative information.¹⁴⁸ The USPTO takes the position that, “[g]enerally, when a trademark . . . is composed, in whole or in part, of a domain name . . . the TLD [does not have] any source-indicating significance.”¹⁴⁹ Similarly, “[i]f a mark is composed solely of a TLD for ‘domain name registry services’ (e.g., the services of registering .com domain names), registration must be refused . . . on the ground that the TLD would not be perceived as a mark.”¹⁵⁰ Tribunals also consistently have held that gTLDs merely are generic and cannot serve as trademarks.¹⁵¹

As Professor McCarthy opines:

A top level domain indicator has no source indicating significance and cannot serve any trademark purpose. The same is true of other nondistinctive modifiers used in domain names, such as ‘http://www’ and ‘html.’ . . . The average person that uses the Internet is aware of the standard format for a domain name and knows that the designations ‘http,’ ‘www,’ and a TLD like ‘.com’ are a part of every Internet domain name and identifier. Thus, the TLD ‘.com’ functions in the world of cyberspace much like the generic indicators ‘Inc.,’ ‘Co.,’ or ‘Ltd.’ placed after the name of a company.¹⁵²

¹⁴⁸ See *Image Online Design, Inc. v. Internet Corp. for Assigned Names & Numbers*, 2013 U.S. Dist. LEXIS 16896, *23 (C.D. Cal. Feb. 7, 2013) (“The proposition that TLDs are not generally source indicators has been adopted by courts, legal scholars, and other authorities.”).

¹⁴⁹ USPTO, TRADEMARK MANUAL OF EXAMINATION PROCEDURE § 1215.02 (Apr. 2013 ed.) [hereinafter T.M.E.P.]. See also *id.* at § 1209.03(m) (“[T]op-level Internet domain name[s] . . . generally serve no source-indicating function.”).

¹⁵⁰ *Id.* at § 1215.02(d).

¹⁵¹ See, e.g., *Advertise.com, Inc. v. AOL Advertising, Inc.*, 616 F.3d 974, 981–82 (9th Cir. 2010) (explaining that in mark ADVERTISING.COM, “the use of ‘.com’ . . . only conveys the genus of the services offered under AOL’s mark,” not source of services.); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173 (Fed. Cir. 2004) (“[T]he term ‘.com’ is a top level domain indicator (TLD) without any trademark significance” and “‘.com’ has no source-identifying significance.”).

¹⁵² 1 MCCARTHY, *supra* note 42, at § 7:17.50. See also *In re Oppedahl & Larson LLP*, 373 F.3d at 1175 (“The commercial impression created by ‘.com’ is similar to the impression created by ‘Corp.’ and ‘Co.’, that is, the association of a commercial entity with the mark”); T.M.E.P., *supra* note 149, at § 1215.02 (Apr. 2013 ed.) (“Advertisements for all types of products and services routinely include a URL for the website of the advertiser, and 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.”).

Given their perceived generic status, when analyzing the similarity of the parties' trademarks in claims of trademark infringement, unfair competition, dilution or cybersquatting, tribunals have ignored gTLDs, finding that the presence of a gTLD adds nothing distinctive to alleviate or enhance the similarities of the trademarks.¹⁵³ For example, in *Brookfield Communications v. West Coast Entertainment Corp.*, the court found that the defendant's domain name <moviebuff.com> for intended use in conjunction with a website offering a searchable entertainment database was confusingly similar to the plaintiff's MOVIEBUFF trademark used for software containing databases for the film and entertainment industry.¹⁵⁴ The court reasoned:

In terms of appearance, there are differences in capitalization and the addition of '.com' in West Coast's complete domain name, but these differences are inconsequential in light of the fact that Web addresses are not caps-sensitive and that the '.com' top-level domain signifies the site's commercial nature

Because many companies use domain names comprised of '.com' as the top-level domain with their corporate name or trademark as the second-level domain, the addition of '.com' is of diminished importance in distinguishing the mark.¹⁵⁵

Moreover, given their generic nature, the addition of a gTLD to a SLD that contains a generic or descriptive term generally cannot turn

¹⁵³ See *Omega S.A. v. Omega Eng'g*, 228 F. Supp. 2d 112, 126 n.36 (D. Conn. 2002) ("When evaluating whether a domain name is confusingly similar to a trademark, a district court disregards the top-level domain name (e.g. '.com', '.org', '.net' etc.)"); *Image Online Design v. Core Ass'n*, 120 F. Supp. 2d 870, 878 (C.D. Cal. 2000) (showing that courts "ignore the TLD as though it were invisible next to the second level domain name in an infringement action"); 4 MCCARTHY, *supra* note 42, at § 25:76 ("[t]he presence in two domain names of the same TLD such as the '.com' top level domain indicator cannot itself be evidence of likely confusion"). See, e.g., *TCPIP Holding Co., Inc. v. Haar Communications, Inc.*, 244 F.3d 88, 101 (2d Cir. 2001) (explaining that the fact that accused domain names have separate words run together without punctuation and are followed by top-level domain identifier, such as ".com," is "of little or no significance" in adjudging likelihood of confusion); *CCBN.com, Inc. v. c-call.com Inc.*, 73 F. Supp. 2d 106, 112 (D. Mass. 1999) (explaining that the fact that conflicting marks share ".com" suffix is irrelevant "because '.com' is a generic locator for domain names of Web sites dedicated to commercial use"); *Morgan Stanley v. Morgan Stanley*, FA 1169733 (Nat. Arb. Forum May 3, 2008), available at <http://domains.adrforum.com/domains/decisions/1169733.htm> (finding the addition of gTLD ".com" irrelevant for purposes of distinguishing disputed domain name from established mark because every domain must contain top level domain name).

¹⁵⁴ *Brookfield Commc'ns, Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036 (9th Cir. 1999).

¹⁵⁵ *Id.* at 1055. See *Public Serv. Co. v. Nexus Energy Software, Inc.*, 36 F. Supp. 2d 436, 439 (D. Mass. 1999) (finding 'energyplace.com' and 'Energy Place' virtually identical); *Minnesota Mining & Mfg. Co. v. Taylor*, 21 F. Supp. 2d 1003, 1005 (D. Minn. 1998) (finding "post-it.com" and "Post-It" identical); *Interstellar Starship Servs. Ltd. v. Epix, Inc.*, 983 F. Supp. 1331, 1335 (D. Or. 1997) ("In the context of Internet use, ['epix.com'] is the same mark as ['EPIX']."); *Planned Parenthood Federation of America, Inc. v. Bucci*, No. 97 Civ. 0629, 1997 U.S. Dist. LEXIS 3338, at * 25 (S.D.N.Y. Mar. 24, 1997) (finding "plannedparenthood.com" and "Planned Parenthood" essentially identical).

that domain name into a trademark.¹⁵⁶ For example, in *Borescopes R U.S. v. 1800Endoscope.com, LLC*, the court found that the plaintiff did not have trademark rights in the domain name <borescopesrus.com> because adding the gTLD .com to the generic SLD “borescope” did not turn the domain name into an enforceable trademark for borescopes.¹⁵⁷ The Federal Circuit similarly has affirmed the USPTO’s refusal to register the domain names <hotels.com>,¹⁵⁸ <mattress.com>¹⁵⁹ and <lawyers.com>¹⁶⁰ as trademarks, finding the gTLD .com conveyed no source indicative information that would alter the inherently non-distinctive character of the SLD.

In re Steelbuilding.com represents the “rare instance” and “unusual case” where the addition of a gTLD to a generic SLD in a domain name created a composite trademark that was not generic.¹⁶¹ Reversing the USPTO’s determination that the domain name <steelbuilding.com> was generic, the Federal Circuit found that the addition of .com to the phrase “steelbuilding” conveyed a unique and unexpected character of the services related to the Internet: allowing the consumer to use an interactive online feature to design, determine the price of and then purchase buildings.¹⁶² The court, however, found that the domain name was merely descriptive and devoid of secondary meaning, and thus affirmed the USPTO’s refusal to register the domain name on those grounds.¹⁶³ Since the Federal Circuit’s decision in *In re*

¹⁵⁶ 1 MCCARTHY, *supra* note 42, at § 7:17.50. See *In re Oppedahl & Larson LLP*, 373 F.3d at 1175 (“TLDs will most often not add any significant source-identifying function to a mark.”).

¹⁵⁷ *Borescopes R U.S. v. 1800Endoscope.com, LLC*, 728 F. Supp. 2d 938, 951–52 (M.D. Tenn. 2010).

¹⁵⁸ *In re Hotels.com*, 573 F.3d 1300, 1304 (Fed. Cir. 2009) (“We agree with the T.T.A.B. that for the mark here at issue, the generic term ‘hotels’ did not lose its generic character by placement in the domain name HOTELS.COM.”) *Id.* at 1306 (holding that the designation HOTELS.COM unregisterable for providing information on Internet about lodging and making reservations because it was generic name for such service).

¹⁵⁹ *In re 1800MATTRESS.COM IP, LLC*, 586 F.3d 1359, 1361–62 (Fed. Cir. 2009) (TLD “.com” is a generic abbreviation designating a commercial organization in internet addresses) *Id.* at 1364 (holding the designation MATTRESS.COM unregisterable for online retail stores services selling mattresses, beds and bedding because it would be understood by public to refer to such services).

¹⁶⁰ *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 1378 (Fed. Cir. 2007) (holding the designation LAWYERS.COM generic and unregistrable for providing an online interactive database featuring information exchange in the fields of law, legal news and legal services).

¹⁶¹ *In re Steelbuilding.com*, 415 F.3d 1293 (Fed. Cir. 2005).

¹⁶² *Id.* at 1298–99.

¹⁶³ *Id.* at 1301. Professor McCarthy criticized that, “[u]nfortunately, the Federal Circuit muddled the waters by characterizing ‘steelbuilding.com’ as an example of the ‘rare instance’ and ‘unusual case’ where addition of the TLD indicator to a generic name creates a nongeneric composite. The court held that the addition of the dot-com TLD to the word ‘steelbuilding’ expanded the meaning of the word beyond its normal meaning to ‘include goods and services beyond the mere sale of steel buildings.’ That is, the TLD ‘expanded’ the mark to convey its use on Internet services of ‘building’ steel structures I believe that the court’s characterization is erroneous. I cannot comprehend how the addition of the dot-com TLD ‘expands’ the meaning of the generic name ‘steelbuilding’ beyond its normal generic significance naming both the sale and design and

Steelbuilding.com, other parties unsuccessfully have attempted to argue that the additional of a gTLD to a generic or descriptive term resulted in a domain name worthy of trademark protection.¹⁶⁴

Because gTLDs generally are deemed generic, conventional wisdom states that consumers look to the SLD to determine the source of the website to which the domain name resolves.¹⁶⁵ As a result of the demand for intuitive domain names, the Ninth Circuit has observed: “Web users often assume, as a rule of thumb, that the domain name of a particular company will be the company name followed by ‘.com’.”¹⁶⁶ Thus, when analyzing the similarity of the parties’ marks in claims for trademark infringement, unfair competition, dilution or cybersquatting, tribunals have focused almost exclusively on the SLD.¹⁶⁷

B. *New gTLDs Will Have Significant Capacity to Indicate Source*

The wide variety and number of potential new gTLDs, which may be comprised of brand names or descriptive terms that relate to specific goods and services, should alter the established notion that gTLDs generally lack the capacity to indicate source.

building of steel structures.” 1 MCCARTHY, *supra* note 42, at § 7:17.50 (2013). Moreover, “[t]he discussion of genericness may be mere *dictum* because the court ultimately held that the mark was not registerable because it was descriptive and devoid of secondary meaning.” *Id.* at n.30 (emphasis added).

¹⁶⁴ See, e.g., *Advertise.com, Inc. v. AOL Advertising, Inc.*, 616 F.3d 974, 979 (9th Cir. 2010) (“AOL uses a mark [ADVERTISING.COM] incorporating a TLD in connection with offering a service related to and commonly provided on the internet—the use of the internet comprising, in this case, an element of the genus of the service—renders this a very different set of facts [from *In re Steelcase.com*]”).

¹⁶⁵ See *Coca-Cola Co. v. Purdy*, 382 F.3d 774, 783–84 (8th Cir. 2004) (“Because all domain names end with a top level domain suffix like .com or .org, and domain registrars no longer enforce distinctions between the types of entities that may register names with these extensions, courts generally look to the second level domain name to determine whether it is identical or confusingly similar to a given mark.”); *Brookfield Commc’ns v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1055 (9th Cir. 1999) (“The domain name is more than a mere address: like trademarks, second-level domain names communicate information as to source.”); *Image Online Design v. Core Ass’n*, 120 F. Supp. 2d 870, 877 (C.D. Cal. 2000) (“A consumer understands source as it relates to web sites through the second-level domain name. Only second level domains indicate source.”). See also T.M.E.P., *supra* note 149, at § 1215.02(c) (“consumers look to the second-level domain name for source identification, not to the top-level domain (TLD)”).

¹⁶⁶ *Brookfield Commc’ns.*, 174 F.3d at 1045. See also *Sporty’s Farm LLC v. Sportsman’s Mkt., Inc.*, 202 F.3d 489, 499 (2d Cir. 2000) (“The most common method of locating an unknown domain name is simply to type in the company name or logo with the suffix .com.”); *Lockheed Martin Corp. v. Network Solutions*, 985 F. Supp. 949, 952 (C.D. Cal. 1997) (“Internet users intuitively try to find businesses by typing in the corporate or trade name as the second-level domain name, as in ‘acme.com.’”). See also 4 MCCARTHY, *supra* note 42, at § 25:73 (2013) (“[T]hrough habit and convention, Internet users have come to expect that to reach the Web site of a company they should be able to type in the name of the company or its major trademark, along with the ‘.com’ designation.”).

¹⁶⁷ See, e.g., *Brookfield Commc’ns*, 174 F.3d at 1055.

1. “Dot Brand” gTLDs Will Directly Indicate Source

Now that companies can register their brands as gTLDs, many new gTLDs should directly indicate source and function as trademarks.¹⁶⁸ Just as consumers have become conditioned to expect that their favorite brand will appear as a SLD followed by *.com*, through use, marketing and exposure, consumers also will come to understand that source indicative trademarks can appear “to the right of the dot.”¹⁶⁹

For example, the Italian fashion company Guccio Gucci S.p.A. (“Gucci”) applied and was granted preliminary approval to register its famous GUCCI trademark as a gTLD.¹⁷⁰ In its application, Gucci stated that owning and using *.gucci* likely will increase its brand equity and expand the company’s current goodwill.¹⁷¹

We will use *.gucci*, first and foremost, to reinforce the authenticity of our website and trust in engaging with the brand. We will also explore the potential for tailored experiences that visitors and customers view content and products that are most relevant to them. In addition, we will use *.gucci* to promote, support, protect and enhance the well-known character and the customer recognition and appreciation of the Gucci brand; to reach new consumers and strengthen the relationship with existing clients; to develop e-Business initiatives and global penetration; to offer the potential for innovative means of digital communication and marketing in the future . . .

We hope that a new gTLD for *.GUCCI* will provide a clear and direct pointer to Gucci online and Gucci digital Flagship Store content, giving internet users the peace of mind that they are being directed to a trustworthy and genuine Gucci destination . . .

We would like *.GUCCI* domain names to become directly and immediately identifiable with the Gucci brand itself, to be an extension of the brand so that internet users know what they can expect under a *.GUCCI* domain: the same quality and excellence that they associate with the brand.¹⁷²

¹⁶⁸ See Prahll & Null, *supra* note 140, at 1796–97.

¹⁶⁹ See *id.* (“As gTLDs become more numerous, it is probable that consumer perception will change, and at least some new gTLDs will be seen as source identifiers, although that process may not be quick and the change in perception will be incumbent upon the few new *.[brand]* owners to educate consumers that a gTLD can indicate source rather than simply indicating the ‘type of entity using the domain name’”).

¹⁷⁰ See *Application Details, Application ID: 1-951-28008*, ICANN, <https://gtdresult.icann.org/application-result/applicationstatus/applicationdetails/1671> (last visited Feb. 13, 2014).

¹⁷¹ See *New gTLD Application Submitted to ICANN by: Guccio Gucci S.p.A.*, ICANN, <https://gtdresult.icann.org/application-result/applicationstatus/applicationdetails/downloadapplication/1671?t:ac=1671> (last visited Feb. 13, 2014) [hereinafter Gucci Application].

¹⁷² See *id.*

Although Gucci has not indicated what specific SLDs it will create “to the left of the dot” in the *.gucci* name space, it may choose to utilize easy to recall standard terms as SLDs, which will direct consumers to various places in Gucci’s domain space. For example, Gucci may choose to utilize the SLD “women” and create a unique space at <women.gucci>, which could act as a portal to Gucci’s on line retail website for women’s clothing and accessories. Gucci then could segregate from that retail space separate portals at the SLDs’ “stores” and “careers,” which could provide information, respectively, about brick and mortar store locations and job opportunities at the company. Indeed, Gucci, like many other retailers, already uses these and other similarly-functioning terms as portals to hyperlinks on its main webpage, which makes their translation to SLDs in the new *.gucci* gTLD name space natural.¹⁷³ Gucci also could utilize its eponymous gTLD to launch new marketing campaigns with short and intuitive domain names in the *.gucci* name space, such as <newshoes.gucci> or <fallfashions.gucci>.

Gucci also may allow third parties to use SLDs with the *.gucci* gTLD. For example, Gucci may license SLDs in the *.gucci* name space to its retailers, potentially for a fee, allowing the domain names to resolve to the retailers’ Internet shopping portals for the GUCCI brand, resulting in potential domain names such as <bloomingdales.gucci>, <saks.gucci> and <nordstrom.gucci>.¹⁷⁴ Even if consumers read the domains from left to right and believe the retailer is the ultimate owner of the domain name, they still likely would understand that the domain name is sponsored by, approved by or affiliated with Gucci.

Outside of its distribution chain, Gucci may allow select consumers to register their own names or Internet handles as SLDs with the *.gucci* gTLD, creating personal websites that provide “tailored experiences [for] customers.”¹⁷⁵ Similarly, consumers likely would believe that these domain names are affiliated with or approved by Gucci.

Thus, in the near future, a sampling of the *.gucci* names space could look something like this:

¹⁷³ See GUCCI, <http://www.gucci.com/us/home> (last visited Feb. 13, 2014).

¹⁷⁴ See Gucci Application, *supra* note 171.

¹⁷⁵ See *id.*

<u>Owner Domains</u>	<u>Retailer Domains</u>	<u>Customer Domains</u>
women.gucci	bloomingdales.gucci	joesmith.gucci
men.gucci	saks.gucci	client1234.gucci
about.gucci	nordstrom.gucci	janedoe.gucci
stores.gucci	neimanmarcus.gucci	shoegirl67.gucci
careers.gucci	cindysboutique.gucci	italianmama84.gucci
fallfashions.gucci	lollybeverlyhills.gucci	beltlover12.gucci
milaninspired.gucci	barneys.gucci	bestdressednyc.gucci
newshoes.gucci	chucksfashions.gucci	lafashionqueen.gucci

While these are just some hypothetical examples of how Gucci may use its .gucci gTLD, consumers soon will be exposed to numerous .gucci domain names, all likely indicating that Gucci is the source of or associated with the new gTLD name space.¹⁷⁶

Recognizing these likely shifts in consumer protection with the release of the new gTLDs, on June 25, 2013, the USPTO released for public comment a draft examination guide entitled *Applications for Marks Comprised of gTLDs for Domain Name Registration or Registry Services*.¹⁷⁷ Moving away from its prior view that gTLDs almost never can function as trademarks, the current draft examination guide states:

Some of the new gTLDs under consideration may have significance as source identifiers. To the extent that some of the new gTLDs under consideration are comprised of existing registered trademarks or service marks that are already strong source identifiers in other fields of use, some of the premises underlying existing USPTO policy regarding the registration of gTLDs may no longer hold true for such gTLDs Where the wording following the ‘.’ or ‘dot’ is already used as a trademark or service mark, the appearance of such marks as a gTLD may not negate the consumer perception of them as source indicators. Accordingly, the USPTO is amending its

¹⁷⁶ Gucci also can program its DNS so that any time an Internet user types a non-registered .gucci domain name into a web browser, the domain name resolves to Gucci’s main webpage. See Jude A. Thomas, *Fifteen Years of Fame: The Declining Relevance of Domain Names in the Enduring Conflict Between Trademark and Free Speech Rights*, 11 J. MARSHALL REV. INTELL. PROP. L. 1, 53 (2011) (“In effect, a new TLD registrar could arrange to have any second level domain name used in combination with its TLD redirect users to a valid web page. For example, a user who types <[x].canon> into its browser address box, where ‘x’ is any combination of letters and numbers, could be redirected to an active Canon web page such as <home.canon>.”).

¹⁷⁷ See *Share Comments/Suggestions on Draft of Examination Guide: Applications for Marks Comprised of gTLDs for Domain Name Registration or Registry Services*, USPTO (June 25, 2013), http://www.uspto.gov/trademarks/notices/IdeaScale_gTLD.jsp; *USPTO Draft Examination Guide: Applications for Marks Comprised of gTLDs for Domain Name Registration or Registry Services*, USPTO (June 25, 2013), available at http://www.uspto.gov/trademarks/notices/gTLDExamGuideDraft_8_7_13_public.doc [hereinafter USPTO Draft Examination Guide].

gTLD policy to allow, in some circumstances, for the registration of a mark consisting of a gTLD for domain-name registration or registry services . . .

Because consumers are so highly conditioned and may be predisposed to view gTLDs as non-source indicating, the applicant must show that consumers already will be so familiar with the wording as a mark, that they will transfer the source recognition even to the domain name registration or registry services. Such relevant evidence may include, but is not limited to: examples of advertising and promotional materials that specifically promote the mark shown in the application, with or without the ‘.’ or ‘dot,’ as a trademark or service mark in the United States; dollar figures for advertising devoted to such promotion; and/or sworn consumer statements of recognition of the applied-for mark as a trademark or service mark.¹⁷⁸

As of yet, only one court has commented in a published opinion on the impact that new gTLDs may have on consumers. In *Image Online Design, Inc. v. Internet Corp. for Assigned Names & Numbers*,¹⁷⁹ Image Online Design (“IOD”) provided Internet registry services using the TLD *.web*, which only was available to consumers through an alternative non-ICANN DNS root system accessible through a modified web browser.¹⁸⁰ In 2000, IOD applied to ICANN to register *.web* as an ICANN-approved gTLD, but the extension was not selected for release.¹⁸¹ IOD did not apply again to register *.web* as a gTLD as part of ICANN’s New gTLD Program.¹⁸² However, seven other companies did apply to ICANN to register *.web* as a new gTLD.¹⁸³ IOD then sued ICANN for, *inter alia*, trademark infringement and unfair competition under the Lanham Act.¹⁸⁴

Rejecting IOD’s claim that *.web* had source indicative properties and thus could serve as a trademark, the court provided the following guidance:

IOD points out that the USPTO has recognized that ‘as the number of available TLDs is increased by [ICANN], or if the nature of new TLDs changes, the examining attorney must consider any potential source-indicating function of the TLD and introduce evidence as to the significance of the TLD.’ It asserts that ‘the function of TLDs as generally not being source indicating is a relic of an essentially

¹⁷⁸ USPTO Draft Examination Guide, *supra* note 177, at 1–4.

¹⁷⁹ *Image Online Design, Inc. v. Internet Corp. for Assigned Names and Numbers*, No. CV 12-08968, 2013 U.S. Dist. LEXIS 16896 (C.D. Cal. Feb. 7, 2013).

¹⁸⁰ *See id.* at *2–3.

¹⁸¹ *See id.* at *3–4.

¹⁸² *See id.* at *4–5.

¹⁸³ *See id.*

¹⁸⁴ *See id.* at *5.

exclusive ‘.com.’” This may be the case. For instance, if ICANN were to introduce the TLD .APPLE, the user would arguably expect that that TLD is administered by Apple Inc. In such a case, the TLD might be considered a source indicator. If Sony tried to administer the TLD .APPLE, Apple Inc. would likely argue and possibly prevail on a trademark infringement claim.

This said, it appears to the court that today *only the most famous of marks could have a source indicating function as a TLD*. Some marks, such as .WEB, might remain generic even if they were famous, since .WEB in connection with registry services for the World Wide Web appears to refer to the service offered, rather than to only a particular producer’s registry service.¹⁸⁵

Both the USPTO and the court in *Image Online Design* properly recognize that, in light of the forthcoming new gTLDs, the old notion that gTLDs generally cannot indicate source no longer likely will be applicable. When brand names begin to appear “to the right of the dot,” these new gTLDs likely will begin to function as source indicative trademarks.

However, both the USPTO and the *Image Online Design* court proffer that only *famous* trademarks already in use will transfer source recognition to the new gTLD. While there is little doubt that famous trademarks such as GUCCI, MCDONALDS and CADILLAC immediately will indicate source when they comprise new gTLDs, limiting such status only to famous marks ignores that, once consumers begin to see brand names to the right of the dot, they may begin to view *all* similarly situated non-generic and non-descriptive terms as source indicative trademarks. Restricting gTLD trademark status only to famous marks also ignores prior jurisprudence, which recognizes that even unknown trademarks can become strong quite quickly through intensive and widespread advertising and marketing.¹⁸⁶

Both the *Image Online Design* court and USPTO, however, are correct that, in order to transition their brands into the new name space, companies will need to educate consumers, not just about how their brands will appear to the right of the dot, but also what they can expect to see to the left of the dot, including whether and to what extent a company will allow third parties to register and use SLDs with the new gTLD.¹⁸⁷ Indeed, the less the owner of a new gTLD acts like a traditional registry or registrar, where domain names can be purchased freely by the general public and maintained without general oversight, the more consumers likely will identify domain names under the “dot

¹⁸⁵ *Id.* at *24–25 (citations omitted) (emphasis added).

¹⁸⁶ *See* 2 MCCARTHY, *supra* note 42, at § 15:56.

¹⁸⁷ *See* Borson, *supra* note 118, at 498.

brand” as emanating from or controlled by a single source. The owner of the gTLD, however, must maintain a certain level of control and oversight over the name space in order to avoid abandonment of their trademark rights.

2. Descriptive gTLDs Will Help Indicate Source

Even non-brand descriptive gTLDs may provide context to help inform consumers about the likely source behind a domain name. While a few industry specific gTLDs, such as *.travel*, *.museum* and *.aero*, have existed for years, they are not widely used and have had little to no effect on consumer perception.¹⁸⁸ One exception is *.edu*, which is restricted for use only by post-secondary institutions and organizations that are accredited by an agency approved by the U.S. Department of Education.¹⁸⁹ Thus, most consumers should know that when a trademark is followed by *.edu*, the domain name likely is used in connection with educational purposes. Nonetheless, the overwhelming majority of domain names are registered in connection with the gTLD *.com*, which is generic and conveys no information about the source or nature of the domain name owner’s goods and services.¹⁹⁰

But many new gTLDs will be comprised of descriptive terms denoting Internet spaces for various goods and services, such as *.fashion*, *.insurance*, *.music*, *.film*, *.books*, *.hotel* and *.cars*.¹⁹¹ When a brand owner combines her trademark with this type of descriptive gTLD, she provides an enhanced message through her domain name that conveys immediate information about her goods and services, thus increasing brand equity.¹⁹²

Moreover, in many circumstances, a descriptive gTLD will enable consumers to more readily identify the *source* of the goods and services offered in connection with the domain name. For example, at least four different major entities currently utilize the trademark COLUMBIA: Columbia Records, Columbia University, Columbia

¹⁸⁸ While over 110 million domain names currently are registered in the gTLD *.com*, not even 40,000 domain names are registered using the gTLDs *.aero*, *.museum* and *.travel* combined. See *TLD Domain Counts*, REGISTRAR STATS, <http://www.registrarstats.com/TLDDomainCounts.aspx> (last visited Feb. 13, 2014); Joe Alagna, *TLD Statistics – Numbers in Various gTLDs as of February 2011*, ALAGNA (July 12, 2011), http://alagna.com/2011/tld-statistics-numbers-in-various-gtlds-as-of-february-2011_110; Michael L. Katz, Gregory L. Rosston & Theresa Sullivan, *Economic Considerations in the Expansion of Generic Top-Level Domain Names Phase II Report: Case Studies*, ICANN 22–39 (2010), available at <http://archive.icann.org/en/topics/new-gtlds/phase-two-economic-considerations-03dec10-en.pdf>.

¹⁸⁹ See *.edu Eligibility*, EDUCAUSE, <http://net.educause.edu/edudomain/eligibility.asp> (last visited Feb. 13, 2014).

¹⁹⁰ See *supra* notes 48, 148–167 and accompanying text.

¹⁹¹ See *List of Proposed New Top-Level Domains*, CNN MONEY, <http://money.cnn.com/infographic/technology/new-gtld-list/> (last visited Oct. 7, 2013).

¹⁹² See Partridge and Arnot, *supra* note 130, at 322.

Sportswear Company and Columbia Pictures Industries, Inc.¹⁹³ While the domain name <columbia.com> is owned by Columbia Sportswear Company,¹⁹⁴ Internet users have little way of knowing which Columbia entity is the source of the domain name until they actually type the domain name into a web browser and it resolves to the home page for the clothing manufacturer. By utilizing, respectively, the new gTLDs *.music*, *.college*, *.clothing* and *.film*, each of these entities can register their primary COLUMBIA trademark as a short intuitive SLD that will help consumers immediately determine which Columbia owns the respective domain name.¹⁹⁵

Indeed, many applicants for gTLDs that are descriptive monikers that connote goods and services specifically have expressed their desire to increase domain name source strength and avoid consumer confusion through these new gTLDs. As Costa Giorgio Roussos, the founder of DotMusic/CGR E-Commerce Ltd., one of the applicants seeking to register the *.music* gTLD, stated:

.music is the web domain extension representing the global music community, giving music entities a unique identity online. Not only does it increase a brand's visibility on the net, *.music* removes second-guessing & confusion by immediately associating a brand's line of business with a memorable identity: music.¹⁹⁶

Because of the very nature of descriptive gTLDs, consumers likely will expect that companies that use their trademarks as SLDs in these name spaces actually will offer the goods or services denoted by the gTLD. However, given their past experiences with cybersquatters, many companies may defensively register their brands as SLDs across many new gTLDs, even those unrelated to their particular field. These defensive registrations have the capacity to defeat the desired goals of many of these descriptive gTLDs, which include increasing brand strength and reducing consumer confusion. For example, if Columbia Sportswear decides to register the domain name <columbia.music>, it may cause consumer confusion, or at least initial interest confusion, as to the source of the goods offered in conjunction with the domain

¹⁹³ See COLUMBIA RECORDS, <http://www.columbiarecords.com/> (last visited Dec. 21, 2013); COLUMBIA UNIVERSITY, <http://www.columbia.edu/> (last visited Dec. 21, 2013); COLUMBIA SPORTSWEAR COMPANY, <http://www.columbia.com/> (last visited Dec. 21, 2013); COLUMBIA PICTURES INDUSTRIES, INC., <http://www.sonypictures.com/corp/divisions.html> (last visited Dec. 21, 2013).

¹⁹⁴ See *supra* note 193.

¹⁹⁵ See *id.*

¹⁹⁶ Costa Giorgio Roussos – *MUSIC TLD*, GR.COM, <http://www.domain.gr.com/about/comments-testimonials/costa-giorgio-roussos-music-tld> (last visited Mar. 5, 2014).

name.¹⁹⁷ And if many companies register their brands as SLDs in descriptive gTLDs that connote unrelated fields, consumers eventually may ignore these gTLDs, viewing them merely as if they were equivalent to *.com*, which conveys no descriptive or source indicative properties whatsoever. Nonetheless, these new descriptive gTLDs have great potential to increase brand equity and provide some context as to the source of a domain name.

3. Some Descriptive gTLDs May Come to Indicate a Single Source through Secondary Meaning

In some instances, a descriptive gTLD itself may come to indicate a single source of goods and services and function as a trademark.

If a descriptive gTLD is unrestricted and open to the public, and numerous unrelated brand owners are able to register their trademarks as SLDs under the new gTLD, then that gTLD, like *.com* and *.net*, likely cannot function as a trademark *on its own*. While likely generic, at most the gTLD would be merely descriptive of domain name registration services and incapable of obtaining secondary meaning. The gTLD owner's complete lack of control over the domain names and content within that name space likely would destroy any possibility of maintaining, let alone acquiring, trademark rights.

For example, in *In re theDOT Communications Network LLC*,¹⁹⁸ the applicant sought to register with the USPTO, on an intent-to-use basis, the trademark *.MUSIC* for various digital media services, including social networking websites.¹⁹⁹ While the applicant did *not* intend to apply to ICANN to register its proposed trademark, *.MUSIC*, as a new gTLD, other companies, such as the aforementioned DotMusic/CGR E-Commerce Ltd., publicly had stated that they intended to apply for *.music* as a new gTLD.²⁰⁰ Moreover, these other companies touted that they intended to allow numerous *unrelated* third parties in the music industry to utilize and register SLDs with the *.music* gTLD.²⁰¹ In light of the “concerted public effort to build support for [*.music*’s] use as a top-level domain,” the TTAB found that the public

¹⁹⁷ “Infringement can be based upon confusion that creates initial customer interest, even though no actual sale is finally completed as a result of the confusion.” 4 MCCARTHY, *supra* note 42, at § 23:6. In the above hypothetical example, even if an Internet user eventually realized that the <columbia.music> domain name did not resolve to the website of the music company, the initial interest confusion caused by Columbia Sportswear’s use of the domain name would have caused “Internet users who seek [the music company’s] web site to expend time and energy accessing [the sportswear company’s] web site.” N.Y. State Soc’y of CPA’s v. Eric Louis Assocs., 79 F. Supp. 2d 331, 342 (S.D.N.Y. 1999).

¹⁹⁸ *In re theDOT Commc’n Network LLC*, 101 U.S.P.Q.2d 1062 (T.T.A.B. 2011).

¹⁹⁹ *Id.* at 1062.

²⁰⁰ *Id.* at 1066.

²⁰¹ *Id.*

likely would perceive the applicant's use of ".music as a top-level domain associated with the field of music."²⁰²

The TTAB also rejected the applicant's argument that other "." or "dot" marks had been registered with the USPTO, finding those registrations were granted before ICANN announced the dramatic expansion of new gTLDs, which had altered consumer perception:

This finding is based on the current marketing environment which is different than the marketing environment when many of the third-party registrations relied upon by applicant were issued. When many of the third-party registrations were issued, ICANN was not considering expansion of the roster of domain name extensions. Nor does the record reveal active campaigns to obtain TLD status for the marks in those registrations as there is for the .music top-level domain.²⁰³

The TTAB thus found that consumers would perceive the proposed trademark .MUSIC as merely descriptive of the applicant's services and refused to register the term.²⁰⁴

Unlike the many of the applicants for the .music gTLD, some applicants for descriptive gTLDs do not intend to allow unsponsored or unaffiliated parties to register SLDs under the new extension. For example, one of the several parties who applied for the gTLD .home is the National Association of REALTORS[®] ("NAR"), which touts itself as "the world's largest professional association, representing greater than one million members over approximately 1,400 local associations/boards."²⁰⁵ If NAR's application is approved, it intends to *restrict* third party registration of domain names within the .home name space solely to NAR members and affiliates.²⁰⁶ As NAR stated in its application:

NAR believes that the .HOME gTLD can provide a trusted and valued space similar to current consumer perception of the trust and value associated with REALTORS[®], and that such trust and value is created in no small part by NAR's ability and willingness to protect the value and trust associated with REALTORS[®] both

²⁰² *Id.* at 1067–68 ("In view of the foregoing, we find that applicant's proposed mark .music conveys the commercial impression of a top-level domain name similar to .com, .net, etc., and not merely the word 'Music' featuring nondistinctive punctuation. Moreover, consumers would understand it to be a top-level domain in the field of music.")

²⁰³ *Id.*

²⁰⁴ *Id.* at 1069. Moreover, because the applicant had not made active use of the trademark, it could not claim acquired distinctiveness through secondary meaning.

²⁰⁵ See *New gTLD Application Submitted to ICANN by: Dot Home LLC*, ICANN, <https://gtdresult.icann.org/applicationstatus/applicationdetails/downloadapplication/238?t:ac=238> (last visited Oct. 7, 2013).

²⁰⁶ See *id.*

through the registration limitations set forth above and compliance with NAR's Vision. When a consumer visits a .HOME domain, she can be assured that the registrant is associated with NAR as a member, affiliate or contracted party as set forth above. . . .

Users can be confident that a domain in the .HOME gTLD is associated with NAR, a REALTOR[®], an NAR member, an NAR affiliate, NAR licensees and other NAR-contracted parties. . . .

NAR and NAR members are associated in a consumer's mind with NAR's Vision, NAR's reputation and the provision of professional home buying and home selling services by those members. Use of a .HOME second level domain, under the stewardship of NAR, should bring forth the same association in the mind of the consumer.²⁰⁷

In no uncertain terms, NAR is seeking to create a name space where all domains emanate from or are sponsored or approved by a single source, and into which its current goodwill can be transferred. Essentially, it is seeking to convert the otherwise descriptive gTLD *.home* into a source indicative trademark through secondary meaning. How quickly this can occur is up to NAR. The more NAR adheres to third party registration restrictions and educates consumers about the new gTLD, the more likely and quickly the gTLD will develop trademark status through secondary meaning.

Thus, "dot brand" gTLDs are not the only new domain name extensions likely to indicate a single source. Through secondary meaning, many gTLDs containing terms that describe goods and services also may function as valid trademarks.

CONCLUSION

While the New gTLD Program has its proponents and critics, the program is moving forward and very soon the landscape of domain names and the Internet will look dramatically different than it does today. These new gTLDs have great potential to alter consumer perception about what appears "to the right of the dot." Not only will "dot brand" gTLDs have the capacity to immediately convey source indicative information, but descriptive gTLDs likely will increase brand equity and, in some instances, may become source indicative trademarks in their own right through secondary meaning.

In light of these likely changes in consumer perception, tribunals will need to reevaluate trademark jurisprudence. The USPTO and at least one court already have recognized potential necessary changes to trademark law, but tribunals have yet to examine the full scope of how consumer perception will change in light of the new gTLDs. However,

²⁰⁷ *Id.*

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if history is any lesson, once arbiters of trademark rights and claims recognize these changes, they will adapt trademark law in due course, just as they developed appropriate jurisprudence concerning consumer perception of domain names during the Internet boom of the 1990s.