

September 6, 2013

The Honorable Teresa Stanek Rea  
Acting Under Secretary of Commerce for Intellectual Property and  
Acting Director of the United States Patent and Trademark Office  
United States Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22314

*Via IdeaScale*

**Re: AIPLA Comments in Response to the USPTO announcement “Share  
Comments/Suggestions on Draft of Examination Guide: Applications for Marks  
Comprised of gTLDs for Domain Name Registration or Registry Services”**

Dear Acting Under Secretary Rea:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present its views with respect to the United States Patent and Trademark Office (“Office”) Notice entitled “Share Comments/Suggestions on Draft of Examination Guide: Applications for Marks Comprised of gTLDs for Domain Name Registration or Registry Services,” which was posted on the USPTO website at [http://www.uspto.gov/trademarks/notices/IdeaScale\\_gTLD.jsp](http://www.uspto.gov/trademarks/notices/IdeaScale_gTLD.jsp).

AIPLA is a national bar association with approximately 15,000 members who are primarily lawyers in private and corporate practice and government service and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law. Our members represent both owners and users of intellectual property.

AIPLA welcomes this opportunity to comment on the USPTO’s draft examination guide for examining trademark applications for marks comprised of generic top-level domains (gTLDs) for domain name registration or registry services.

**INTRODUCTION**

The Draft Examination Guide recognizes that current USPTO policy prevents registration of trademarks for gTLDs on the basis that the current gTLDs do not function as trademarks since they serve no source-identifying role. However, the introduction of new gTLDs, including gTLD applications corresponding to existing trademarks, has prompted the USPTO to propose revisions to its examination guidelines.

AIPLA agrees that the landscape may be evolving, but we believe there is no need to depart from traditional legal principles and there is no justification for treating gTLDs differently from any other mark. Therefore AIPLA believes that special rules are inappropriate.

Currently gTLDs may not be registered as trademarks on that independent basis; it is not that there is an outright prohibition on the registration of gTLDs, but rather it is a function of the fact that current gTLDs have been used in a generic manner in which they serve no source-identifying role.

By contrast, if new gTLDs are used in a manner where they function as an indicator of source or origin, then they should be entitled to trademark registration on the same basis as other trademarks, regardless of whether (1) there are pre-existing registrations for the term(s) included in the gTLD, (2) there is a registry agreement in place with ICANN or some other third-party that may enter the picture in the future, or (3) they provide supplemental information (beyond what other applicants are required to provide) demonstrating that the goods or services are provided primarily for the benefit of others.

Each of the proposed requirements for registration of a trademark for a gTLD is specifically addressed below.

## **ANALYSIS**

### **1. Requirement that gTLD Application (disregarding the “dot”) Must Match an Active US Trademark Registration Covering the Same Subject Matter of the Websites that will be Registered Under the gTLD.**

Under this proposed requirement, applicants for gTLD trademark applications would first have to secure a U.S. trademark registration in the underlying term(s). For example, an applicant for the trademark .DOMAIN, would have to first obtain a U.S. registration for the DOMAIN trademark in connection with the same goods/services which will be the subject matter of the .DOMAIN websites.

The requirement that the mark must be previously established in the field in order to obtain registration for gTLD is problematic. This requirement overlooks, and would ultimately exclude, entrepreneurs that seek to register a new gTLD where they have no prior trademark registration. It would unnecessarily delay and hinder those applicants’ ability to obtain trademark protection for their otherwise source-identifying gTLD. It would also preclude new players in the arena from protecting their rights as quickly and easily as others by making it a two-step process – first securing registration for underlying term, then having to wait until that registration issues before proceeding with an application to register a gTLD as a mark.

Presumably, this two-step requirement would also require foreign applicants to extend protection of registrations to the U.S. before they can apply for registration of a gTLD, making the process more burdensome for them.

Finally, an applicant for a mark based on a gTLD should be allowed registration if the mark is inherently distinctive or can show acquired distinctiveness under Section 2(f). The obligations for protection should be the same as for any other source-indicating device.

**2. Requirement that Applicant Submit a “Significant” Amount of Additional Evidence, such as Advertising or Promotional Materials, to Show that the gTLD Trademark will Immediately Function as a Source Identifier.**

The USPTO explains that this proposed requirement is necessary “because consumers are so highly conditioned and may be predisposed to view gTLDs as non-source indicating, [therefore] the applicant must show that consumers already will be familiar with the wording as a mark.”

We believe this requirement is unjustified and unduly burdensome. Just as applicants for “traditional” trademarks must submit a specimen demonstrating use as a trademark, no additional requirement need be imposed upon applicants for these trademarks. The rules currently in place regarding material already deemed appropriate as specimens adequately address any concerns relevant to both traditional trademarks and gTLD trademarks: A service mark specimen must show the mark as actually used in the sale or advertising of the services recited in the application. 37 C.F.R. §2.56(b)(2). The clarification provided in the TMEP Section 1301.04 regarding acceptable specimens of use for service marks is equally applicable to gTLDs and no further requirements should be imposed. However, if an applicant desires, it may submit additional information. See TMEP 1301.04(b) which states:

In determining whether a specimen is acceptable evidence of service mark use, the examining attorney may consider applicant’s explanations as to how the specimen is used, along with any other available evidence in the record that shows how the mark is actually used. *See In re International Environmental Corp.*, 230 USPQ 688 (TTAB 1986), in which a survey distributed to potential customers of applicant’s heating and air conditioning distributorship services was held to be an acceptable specimen even though it did not specifically refer to the services, where the applicant stated that the sale of its services involved ascertaining the needs of customers serviced, and the record showed that the surveys were directed to potential customers and were the means by which applicant offered its distributorship services to the public.

**3. Requirement that Applicants Have Signed a Registry Contract with ICANN to Operate the Applied-For gTLD.**

This proposed requirement would provide that an application will be rejected unless the applicant provides evidence that the applicant has a signed registry contract with ICANN to operate the applied-for gTLD.

This requirement contradicts the basic precept underlying intellectual property protection. The purpose of intellectual property law is ultimately to encourage new technologies, artistic expressions and inventions while promoting economic growth. While ICANN is currently the only entity for securing a gTLD, specifically requiring a contract with this sole entity may preclude and discourage other potential competitors from entering the market (or from creating a parallel market).

In addition, the specific requirement that “applicant” has a contract with ICANN (or any other potential competitor of ICANN) to be the Registry Operator does not account for the possibility that the “applicant” will provide its domain name registry services through an affiliated company or a third party licensee, which may be the contracting party.

Any concerns about the legitimacy of the registry operation can be overcome by the current use requirement or the bona-fide intention to do so. *See* 37 C.F.R. §2.34(a)(1)(i) and 37 C.F.R. §2.20 (the application must include a statement that the mark is in use in commerce, verified in an affidavit or declaration).

#### **4. Requirement that Applications Provide a “Legitimate Service for the Benefit of Others”**

Finally, the USPTO proposes requiring that applicants provide a “legitimate service for the benefit of others.” Examiners will be instructed to consider questions such as “to what entities and industries will the applicant’s domain-name registration or registry services be targeted?” The USPTO clarifies that “[w]hile operating a gTLD registry that is only available for the applicant’s employees or for the applicant’s marketing initiatives alone generally would not qualify as a service, registration for use by the applicant’s affiliated distributors typically would.”

The standard should be no different than any other trademark where goods and services must be sold or transported to others in interstate commerce. *See* 15 U.S.C. §1051(a) and (b). There is no need to expressly add this as a requirement, and doing so implies that gTLD applicants have some higher burden of proof in this regard than other applicants. The burden should be the same and decided on a case by case basis.

## **CONCLUSION**

In conclusion, traditional trademark principles account for the new scenario presented by the introduction of new gTLDs, and there is no justification or need to treat gTLDs differently from any other device. As such, special rules are unnecessary and inappropriate.

Thank you for allowing AIPLA to provide comments on this important initiative.  
AIPLA looks forward to further dialogues with the Office in finding solutions and defining  
programs to maintain and enhance the Office's mission.

Sincerely,

A handwritten signature in black ink, appearing to read "Jeffrey I.D. Lewis". The signature is written in a cursive style with a large, stylized initial "J".

Jeffrey I.D. Lewis  
President  
American Intellectual Property Law Association