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Top-Level Domain Names as Trademarks

December 9, 2011 by Dan Kelly

The Trademark Trial and Appeal Board recently issued a precedential decision upholding the Trademark Office's refusal to register five applications for the mark .MUSIC in connection with a variety of goods and services, holding that .MUSIC is merely descriptive of the goods and services. A PDF copy of the decision is [here](#). A company called theDot Communications Network filed these five intent-to-use applications in November 2008. It has no other applications pending that I can find.

This decision is among the first paragraphs in a new chapter of domain-related trademark issues that are arising in light of ICANN's roll out of [new generic top-level domains](#) next year. It is unsurprising that companies are attempting to secure trademark rights in top-level domains, since the new gTLD scheme is seemingly set up to encourage the Balkanization and proprietization of gTLDs. Verisign, the longtime "owner" of the .com gTLD, among others, used to own [this registration](#) for ".COM .NET THE WORLD'S MOST TRUSTED NAMES." Verisign now has [an application pending](#) to register the tag line "THE WORLD IS CONNECTING BETWEEN THE DOTS," which it is using in connection with a rotating banner on its [home page](#) to promote its gTLDs-- .com, .net, .gov, .name, and .tv.

Other groundwork for this has been under construction for some time:

- Neustar owns two registrations for .BIZ (and Design, ".biz" disclaimed)
- The Cooperative League of the USA owns a registration for DOTCOOP (i.e. ".coop")
- The Public Interest Registry owns registrations for .ORG (and Design, ".org" disclaimed)
- Telnic Limited owns registrations for .TEL (and Designs, ".tel" *not* disclaimed)

There are numerous implications for viewing a TLD as a trademark. For companies that do, do they intend to license every second level domain registered in the domain space? If not, how do they plan to maintain the association of the TLD with a single source? The .MUSIC decision makes clear that merely placing a "." in front of a descriptive term is not distinguishing for a TLD directed at goods and services described by the term. Would applications for .QUARTERNOTE for the same goods and services be registrable? Is a three-syllable TLD too long to be an effective TLD?



[This site](#) appears to be maintaining a list of announced new TLD initiatives. As I peruse it, I do not see much in the way of creativity. I think that the most successful new gTLDs will be ones that have at least a dash of creativity and a good marketing plan. Internet users--both content providers and consumers--will need incentives to break out of the .com paradigm, and descriptive TLDs offer few incentives. The new gTLD initiative may eventually take off, but it will need some more creative offerings to do so.

