

August 19, 2013

USPTO Publishes Draft Trademark Examination Guide Update Regarding Applications for Marks Comprised of gTLDs

The Internet Corporation for Assigned Names and Numbers (ICANN) is currently considering applications to add up to 1,400 new generic Top-Level Domains (gTLDs) to the Internet landscape, with some gTLDs opening for domain-name registrations beginning as early as late 2013. In response, the United States Patent and Trademark Office (USPTO) has prepared an update to the policy and procedures related to the USPTO's handling of trademark applications for marks comprised of gTLDs, and has set forth the circumstances under which a mark consisting of a gTLD for domain-name registration or registry services may be registered. A draft version of the examination guide is available now for public comment [here](#).

This advisory provides a comprehensive summary of the USPTO's updated examination guide, on which public comments will be accepted through **September 8, 2013**.

Executive Summary

The USPTO's previous policy stated in part that "if a mark is composed solely of a TLD for 'domain name registry services' (e.g., the services of registering .com domain names), registration generally must be refused... on the ground that the TLD would not be perceived as a mark." The policy relied, in part, on the premise that a gTLD typically was merely an abbreviation of the class of intended users of the gTLD (e.g., ".com" for commercial entities, ".gov" for government agencies, etc.) or subject matter of the domain space (e.g., ".edu" for educational institutions). The USPTO's revised policy recognizes that some of the new gTLDs under consideration may have significance as source identifiers; accordingly, the USPTO is amending its gTLD policy to allow, in some circumstances, for the registration of a mark consisting of a gTLD for domain-name registration or registry services. The circumstances under which the USPTO will allow such a mark to be registered are discussed below in greater detail.

Requirements for Registration

The USPTO's policy with respect to an application seeking to register a mark composed solely of a gTLD for domain-name registration or registry services remains that the applied-for mark fails to function as a trademark and therefore registration of such marks must initially be refused on the ground that the gTLD would not be perceived as a mark. However, the revised policy recognizes that in certain circumstances the applied-for mark may function as a trademark (i.e., as a source identifier) and as such provides requirements that an applicant must meet in order to avoid or overcome the initial refusal to register. The requirements are as follows:

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- 1) Applicant must provide evidence that the applied-for mark will be perceived as a source identifier;
 - 2) Applicant has entered into a currently valid agreement with ICANN (a “Registry Agreement”) designating the applicant as the entity responsible for operation of the registry, i.e., maintaining the database and generating the zone file (the “Registry Operator”) for the gTLD identified by the mark; and
 - 3) The identified services will be primarily for the benefit of others.

The refusal to register the applied-for mark will be maintained unless the applicant successfully satisfies each of the above requirements.

1) Applicant Must Provide Evidence that the Applied-For Mark Will Be Perceived as a Source Identifier

An applicant must provide evidence that the applied-for mark will be perceived as a source identifier. The USPTO’s policy indicates that an applicant can establish this factor by submitting a) proof of prior US trademark registration(s) for the same mark for goods and services in the same field of use as the domain-name registration/registry services and b) additional proof that the mark used as a gTLD will be perceived as a mark.

The revised policy states that the submitted prior US registration must show the same mark as shown in the applied-for mark. However, the lack of a “.” or “dot” in the submitted prior US registration is not determinative as to whether or not the mark in the prior US registration is the same as the mark in the application. In addition, the submitted prior US registration must contain only the wording that makes up the gTLD, and must not include a disclaimer of such wording.

Furthermore, the applicant must limit the “field of use” for the identified domain-name registration or registry services to fields that are related to the goods/services listed in the submitted prior registration(s). For example, if the applicant submits prior registrations identifying its goods as “automobiles” and its services as “automobile dealerships,” the services in the application may be identified as “domain-name registration services for websites featuring automobiles and information about automobiles.” However, the applicant may not identify its services as either “domain-name registration services for websites featuring information about restaurants” or merely as “domain name registration services.”

2) Applicant Has Entered into a Valid Registry Agreement/ICANN Contract

The USPTO has recognized that if the applicant has not entered into a Registry Agreement with ICANN designating the applicant as the Registry Operator for the gTLD identified by the mark, consumers may be deceived by the use of a particular gTLD as a mark. Consumers generally would believe that the applicant’s domain-name registration or registry services feature the gTLD in the proposed mark and would consider its availability material in the purchase of these services. Therefore, to avoid a deceptiveness refusal an applicant must (i) submit evidence that it has entered into a currently valid Registry Agreement with ICANN designating the applicant as the Registry Operator for the gTLD identified by the applied-for mark prior to registration and (ii) indicate in the identification of services that the domain registration or domain registry services feature the gTLD shown in the mark.

Ultimately, in order to prevent consumers from being deceived by the use of a particular gTLD as a mark the USPTO will not approve the trademark application for publication without proof of the award of the Registry Agreement.

3) Legitimate Service for the Benefit of Others

The final requirement an applicant must satisfy is that the applicant establishes that the domain-name registration or registry services will be primarily for the benefit of others. Accordingly, the examining attorney will issue an information request with the following inquiries:

- Does the applicant intend to use the applied-for mark as a gTLD?
- Does the applicant intend to operate a registry for the applied-for mark as a new gTLD and sign a Registry Agreement with ICANN for such gTLD?

- To what entities and industries will the applicant's domain-name registration or registry services be targeted?
- Does the applicant intend to register domain names for others using the gTLD identified by the applied-for mark and will there be any restrictions on to whom it will be available?

The USPTO has indicated that while 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 for the benefit of others, registration for use by the applicant's affiliated distributors typically would.

For more detailed information and analysis regarding this update to the USPTO guidelines, to discuss how our team can assist in developing a trademark application filing strategy with respect to your .BRAND gTLD(s) or for assistance with preparing and submitting a comment on the draft examination guide, please contact Brian Winterfeldt at brian.winterfeldt@kattenlaw.com.

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