

EXAMINATION GUIDE NO. 2-99

September 29, 1999

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

- I. Introduction And Background *
- II. Use as a Mark *
- III. Surnames *
- IV. Descriptiveness *
- V. Generic Refusals *
- VI. Marks Containing Geographical Matter *
- VII. Disclaimers *
- VIII. Material Alteration *
- IX. Likelihood of Confusion *
- X. Marks Containing The Phonetic Equivalent of A Top Level Domain *

I. Introduction And Background

A domain name is part of a Uniform Resource Locator (URL), which is the address of a site or document on the Internet. In general, a domain name is comprised of a second-level domain, a "dot," and a top-level domain (TLD). The wording to the left of the "dot" is the second-level domain, and the wording to the right of the "dot" is the TLD.

Example: If the domain name is "XYZ.COM," the term "XYZ" is a second-level domain and the term "COM" is a TLD.

A domain name is usually preceded in a URL by "http://www." The "http://" refers to the protocol used to transfer information, and the "www" refers to World Wide Web, a graphical hypermedia interface for viewing and exchanging information. There are two types of TLDs: generic and country code.

Generic TLDs

Generic TLDs are designated for use by the public. Each generic TLD is intended for use by a certain type of organization. For example, the TLD ".com" is for use by commercial, for profit organizations. However, the administrator of the .com, .net, .org and .edu TLDs does not check the requests of parties seeking domain names to ensure that such parties are a type of organization that should be using those TLDs. On the other hand, .mil, .gov, and .int TLD applications are checked, and only the U.S. military, the U.S. government, or

international organizations are allowed in the domain space. The following is a list of the current generic TLDs and the intended users:

.com	commercial, for profit organizations
.edu	4 year, degree granting colleges/universities
.gov	U.S. federal government agencies
.int	international organizations
.mil	U.S. military organizations, even if located outside the U.S.
.net	network infrastructure machines and organizations
.org	miscellaneous, usually non-profit organizations and individuals

Country Code TLDs

Country code TLDs are for use by each individual country. Each country determines who may use their code. For example, some countries require that users of their code be citizens or have some association with the country, while other countries do not. The following are examples of some of the country code TLDs currently in use:

.jp	for use by Japan
.tm	for use by Turkmenistan
.tv	for use by Tuvalu
.uk	for use by the United Kingdom

Proposed TLDs

Due to growing space limitations, several new TLDs have been proposed, including the following:

.arts	cultural and entertainment activities
.firm	businesses
.info	entities providing information services
.nom	individual or personal nomenclature
.rec	recreation or entertainment activities
.store	businesses offering goods to purchase
.web	entities emphasizing activities related to the web

While these proposed TLDs are not currently used on the Internet as TLDs, applicants may include them in their marks.

Applications for registration of marks composed of domain names

Since the implementation of the domain name system, the Patent and Trademark Office (Office) has received a growing number of applications for marks composed of domain names. While the majority of domain name applications are for computer services such as Internet content providers (organizations that provide web sites with information about a particular topic or field) and online ordering services, a substantial number are for marks used on other types of services or goods.

When a trademark, service mark, collective mark or certification mark is composed, in whole or in part, of a domain name, neither the beginning of the URL (<http://www>.) nor the TLD have any source indicating significance. Instead, those designations are merely devices that every Internet site provider must use as part of its address. Today, advertisements for all types of products and services routinely include a URL for the web site of the advertiser. Just as the average person with no special knowledge recognizes "800" or "1-800" followed by seven digits or letters as one of the prefixes used for every toll-free phone number, the average person familiar with the Internet recognizes the format for a domain name and understands that "http," "www," and a TLD are a part of every URL.

Applications for registration of marks consisting of domain names are subject to the same requirements as all other applications for federal trademark registration. This Examination Guide identifies and discusses some of the issues that commonly arise in the examination of domain name mark applications.

II. Use as a Mark

A. Use Applications

A mark composed of a domain name is registrable as a trademark or service mark only if it functions as a source identifier. The mark as depicted on the specimens must be presented in a manner that will be perceived by potential purchasers as indicating source and not as merely an informational indication of the domain name address used to access a web site. *See In re Eilberg*, 49 USPQ2d 1955 (TTAB 1998).

In *Eilberg*, the Trademark Trial and Appeal Board (Board) held that a term that only serves to identify the applicant's domain name or the location on the Internet where the applicant's web site appears, and does not separately identify applicant's services, does not function as a service mark. The applicant's proposed mark was WWW.EILBERG.COM, and the specimens showed that the mark was used on letterhead and business cards in the following manner:

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PATENTS TRADEMARKS
AND COPYRIGHTS WWW.EILBERG.COM

The Board affirmed the examining attorney's refusal of registration on the ground that the matter presented for registration did not function as a mark, stating that:

[T]he asserted mark, as displayed on applicant's letterhead, does not function as a service mark identifying and distinguishing applicant's legal services and, as presented, is not capable of doing so. As shown, the asserted mark identifies applicant's Internet domain name, by use of which one can access applicant's Web site. In other words, the asserted mark WWW.EILBERG.COM merely indicates the location on the Internet where applicant's Web site appears. It does not separately identify applicant's legal services as such. *Cf. In re The Signal Companies, Inc.*, 228 USPQ 956 (TTAB 1986).

This is not to say that, if used appropriately, the asserted mark or portions thereof may not be trademarks or [service marks]. For example, if applicant's law firm name were, say,

EILBERG.COM and were presented prominently on applicant's letterheads and business cards as the name under which applicant was rendering its legal services, then that mark may well be registrable.

Id. at 1956.

The examining attorney must review the specimens in order to determine how the proposed mark is actually used. It is the perception of the ordinary customer that determines whether the asserted mark functions as a mark, not the applicant's intent, hope or expectation that it do so. *See In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (C.C.P.A. 1960).

If the proposed mark is used in a way that would be perceived as nothing more than an address at which the applicant can be contacted, registration must be refused. Examples of a domain name used only as an Internet address include a domain name used in close proximity to language referring to the domain name as an address, or a domain name displayed merely as part of the information on how to contact the applicant.

Example: The mark is WWW.XYZ.COM for on-line ordering services in the field of clothing. Specimens of use consisting of an advertisement that states "visit us on the web at www.xyz.com" do not show service mark use of the proposed mark.

Example: The mark is XYZ.COM for financial consulting services. Specimens of use consisting of a business card that refers to the service and lists a phone number, fax number, and the domain name sought to be registered do not show service mark use of the proposed mark.

Refusal of registration

If the specimens of use fail to show the domain name used as a mark and the applicant seeks registration on the Principal Register, the examining attorney must refuse registration on the ground that the matter presented for registration does not function as a mark. The statutory bases for the refusals are:

For trademarks: Trademark Act §§1, 2 and 45, 15 U.S.C. §§1051, 1052, and 1127

For service marks: Trademark Act §§1, 2, 3 and 45, 15 U.S.C. §§1051, 1052, 1053 and 1127

If the applicant seeks registration on the Supplemental Register, the examining attorney must refuse registration under Trademark Act §23, 15 U.S.C. §1091.

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

Advertising one's own products or services is not a service. *See In re Reichhold Chemicals, Inc.*, 167 USPQ 376 (TTAB 1970); TMEP §1301.01(a)(ii). Therefore, businesses that create a web site for the sole purpose of advertising their own products or services cannot register a domain name used to identify that activity. In examination, the issue usually arises when the applicant describes the activity as a registrable service, e.g., "providing information about [a particular field]," but the specimens of use make it clear that the web site merely advertises the applicant's own products or services. In this situation, the examining attorney must refuse registration because the mark is used to identify an activity that does not constitute a "service" within the meaning of the Trademark Act. Trademark Act §§1, 2, 3 and 45, 15 U.S.C. §§1051, 1052, 1053 and 1127.

C. Agreement of Mark on Drawing with Mark on Specimens of Use

In a domain name mark (e.g., XYZ.COM or HTTP://WWW.XYZ.COM), consumers look to the second level domain name for source identification, not to the TLD or the terms "http://www." or "www." Therefore, it is usually acceptable to depict only the second level domain name on the drawing page, even if the specimens of use show a mark that includes the TLD or the terms "http://www." or "www." *Cf. Institut National des*

Appellations D'Origine v. Vintners Int'l Co., Inc., 954 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992) (CHABLIS WITH A TWIST held to be registrable separately from CALIFORNIA CHABLIS WITH A TWIST); *In re Raychem Corporation*, 12 USPQ2d 1399 (TTAB 1989) (refusal to register "TINEL-LOCK" based on specimens showing "TRO6AI-TINEL-LOCK-RING" reversed). *See also* 37 C.F.R. §2.51(a)(1) and TMEP §807.14 *et. seq.*

Example: The specimens of use show the mark HTTP://WWW.XYZ.COM. The applicant may elect to depict only the term "XYZ" on the drawing page.

Sometimes the specimens of use fail to show the entire mark sought to be registered (e.g., the drawing of the mark is HTTP://WWW.XYZ.COM, but the specimens only show XYZ). If the drawing of the mark includes a TLD, or the terms "http://www.," or "www.," the specimens of use must also show the mark used with those terms. Trademark Act §1(a)(1)(C), 15 U.S.C. §1051(a)(1)(C).

Example: If the drawing of the mark is XYZ.COM, specimens of use that only show the term XYZ are unacceptable.

D. Marks Comprised Solely of TLDs for Domain Name Registry Services

If a mark is composed solely of a TLD for "domain name registry services" (e.g., the services currently provided by Network Solutions, Inc. of registering .com domain names), registration should be refused under Trademark Act §§1, 2, 3 and 45, 15 U.S.C. §§1051, 1052, 1053 and 1127, on the ground that the TLD would not be perceived as a mark. The examining attorney should include evidence from the NEXIS® database, the Internet, or other sources to show that the proposed mark is currently used as a TLD or is under consideration as a new TLD.

If the TLD merely describes the subject or user of the domain space, registration should be refused under Trademark Act §2(e)(1), 15 U.S.C. §2(e)(1), on the ground that the TLD is merely descriptive of the registry services.

E. Intent-to-Use Applications

A refusal of registration on the ground that the matter presented for registration does not function as a mark relates to the manner in which the asserted mark is used. Therefore, generally, in an intent-to-use application, a mark that includes a domain name will not be refused on this ground until the applicant has submitted specimens of use with either an amendment to allege use under Trademark Act §1(c), or a statement of use under Trademark Act §1(d), 15 U.S.C. §1051(c) or (d). However, the examining attorney should include an advisory note in the first Office Action that registration may be refused if the proposed mark, as used on the specimens, identifies only an Internet address. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided to the applicant prior to the filing of the allegation of use, the Office is in no way precluded from refusing registration on this basis.

III. Surnames

If a mark is composed of a surname and a TLD, the examining attorney must refuse registration because the mark is primarily merely a surname under Trademark Act §2(e)(4), 15 U.S.C. §1052(e)(4). A TLD has no trademark significance. If the primary significance of a term is that of a surname, adding a TLD to the surname does not alter the primary significance of the mark as a surname. *Cf. In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 98 USPQ 265 (C.C.P.A. 1953) (S. SEIDENBERG & CO'S. held primarily merely a surname); *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993) (HAMILTON PHARMACEUTICALS for pharmaceutical products held primarily merely a surname); *In re Cazes*, 21 USPQ2d 1796 (TTAB 1991) (BRASSERIE LIPP held primarily merely a surname where "brasserie" is a generic term for applicant's restaurant services). *See also* TMEP §1211.01(b).

IV. Descriptiveness

If a proposed mark is composed of a merely descriptive term(s) combined with a TLD, the examining attorney should refuse registration under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the mark is merely descriptive. This applies to trademarks, service marks, collective marks and certification marks.

Example: The mark is SOFT.COM for facial tissues. The examining attorney must refuse registration under §2(e)(1).

Example: The mark is NATIONAL BOOK OUTLET.COM for retail book store services. The examining attorney must refuse registration under §2(e)(1).

The TLD will be perceived as part of an Internet address, and does not add source identifying significance to the composite mark. *Cf. In re Page*, 51 USPQ2d 1660 (TTAB 1999) (addition of a telephone prefix such as "800" or "888" to a descriptive term is insufficient, by itself, to render the mark inherently distinctive); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998) (PATENT & TRADEMARK SERVICES INC. is merely descriptive of legal services in the field of intellectual property; the term "Inc." merely indicates the type of entity that performs the services and has no significance as a mark); *In re The Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988) (PAINT PRODUCTS CO. is no more registrable as a trademark for goods emanating from a company that sells paint products than it would be as a service mark for retail paint store services offered by such a company); *In re E.I. Kane, Inc.*, 221 USPQ 1203 (TTAB 1984) (OFFICE MOVERS, INC. incapable of functioning as a mark for moving services; addition of the term "Inc." does not add any trademark significance to matter sought to be registered). *See also* TMEP §1209.01(b)(12) regarding marks comprising in part "1-800," "888," or other telephone numbers.

V. Generic Refusals

If a mark is composed of a generic term(s) for applicant's goods or services and a TLD, the examining attorney must refuse registration on the ground that the mark is generic and the TLD has no trademark significance. *See* TMEP §1209.01(b)(12) regarding marks comprised in part of "1-800" or other telephone numbers. Marks comprised of generic terms combined with TLDs are not eligible for registration on the Supplemental Register, or on the Principal Register under Trademark Act §2(f), 15 U.S.C. §1052(f). This applies to trademarks, service marks, collective marks and certification marks.

Example: TURKEY.COM for frozen turkeys is unregistrable on either the Principal or Supplemental Register.

Example: BANK.COM for banking services is unregistrable on either the Principal or Supplemental Register.

The examining attorney generally should not issue a refusal in an application for registration on the Principal Register on the ground that a mark is a generic name for the goods or services unless the applicant asserts that the mark has acquired distinctiveness under §2(f) of the Trademark Act, 15 U.S.C. §1052(f). Absent such a claim, the examining attorney should issue a refusal on the ground that the mark is merely descriptive of the goods or services under §2(e)(1), and provide an advisory statement that the matter sought to be registered appears to be a generic name for the goods or services. TMEP §1209.02.

VI. Marks Containing Geographical Matter

The examining attorney should examine marks containing geographic matter in the same manner that any mark containing geographic matter is examined. *See generally* TMEP §§1210.05 and 1210.06. Depending on the manner in which it is used on or in connection with the goods or services, a proposed domain name mark containing a geographic term may be primarily geographically descriptive under §2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2), or primarily geographically deceptively misdescriptive under §2(e)(3) of the Trademark Act, 15 U.S.C. §1052(e)(3), and/or merely descriptive or deceptively misdescriptive under

§2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

Geographic matter may be merely descriptive of services provided on the Internet

When a geographic term is used as a mark for services that are provided on the Internet, sometimes the geographic term describes the subject of the service rather than the geographic origin of the service. Usually this occurs when the mark is composed of a geographic term that describes the subject matter of information services (e.g., NEW ORLEANS.COM for "providing vacation planning information about New Orleans, Louisiana by means of the global computer network"). In these cases, the examining attorney should refuse registration under Trademark Act §2(e)(1) because the mark is merely descriptive of the services.

VII. Disclaimers

Trademark Act §6(a), 15 U.S.C. §1056(a), provides for the disclaimer of "an unregistrable component" of a mark. The guidelines on disclaimer set forth in TMEP §1213 *et. seq.* apply to domain name mark applications.

If a composite mark includes a domain name composed of unregistrable matter (e.g., a merely descriptive or generic term and a TLD), disclaimer is required. *See* examples below and TMEP §§1213.03.

If a disclaimer is required and the domain name includes a misspelled or telescoped word, the correct spelling must be disclaimed. *See* examples below and TMEP §§1213.04(a) and 1213.09(c).

A compound term composed of arbitrary or suggestive matter combined with a "dot" and a TLD is considered unitary, and therefore no disclaimer of the TLD is required. *See* examples below and TMEP §1213.04(b).

<u>Mark</u>	<u>Disclaimer</u>
XYZ BANK.COM	BANK.COM
XYZ FEDERALBANK.COM	FEDERAL BANK.COM
XYZ GROCERY STORE.COM	GROCERY STORE.COM
XYZ.COM	no disclaimer
XYZ.BANK.COM	no disclaimer
XYZBANK.COM	no disclaimer

VIII. Material Alteration

Amendments may not be made to the drawing of the mark if the character of the mark is materially altered. Trademark Rule 2.72, 37 C.F.R. §2.72. The test for determining whether an amendment is a material alteration was articulated in *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740 (TTAB 1983):

The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark. The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark appropriate for a new application.

Id. at 743-44.

Each case must be decided on its own facts. The controlling question is always whether the new and old form of the marks create essentially the same commercial impression. TMEP §807.14(a).

Example: Amending the mark PETER, used on kitchen pots and pans, from PETER to PETER PAN would materially change the mark because adding the generic word PAN dramatically changes the meaning of the mark – from a person's name, to a well known storybook character's

name.

Adding or deleting TLDs in domain name marks

Generally, for domain name marks (e.g., COPPER.COM), the applicant may add or delete a TLD to the drawing of the mark without materially altering the mark. A mark that includes a TLD will be perceived by the public as a domain name, while a mark without a TLD will not. However, the public recognizes that a TLD is a universally-used part of an Internet address. As a result, the essence of a domain name mark is created by the second level domain name, not the TLD. The commercial impression created by the second level domain name usually will remain the same whether the TLD is present or not.

Example: Amending a mark from PETER to PETER.COM would not materially change the mark because the essence of both marks is still PETER, a person's name.

Similarly, substituting one TLD for another in a domain name mark, or adding or deleting a "dot" or "http://www." or "www." to a domain name mark is generally permitted.

Example: Amending a mark from XYZ.ORG to XYZ.COM would not materially change the mark because the essence of both marks is still XYZ.

Adding or deleting TLDs in other marks

If a TLD is not used as part of a domain name, adding or deleting a TLD may be a material alteration. When used without a second level domain name, a TLD may have trademark significance. *See* TMEP §807.14(a).

Example: Deleting the term .COM from the mark .COM ? used on sports magazines would materially change the mark.

IX. Likelihood of Confusion

In analyzing whether a domain name mark is likely to cause confusion with another pending or registered mark, the examining attorney must consider the marks as a whole, but generally should accord little weight to the TLD portion of the mark. *See* TMEP §1207.01(b) *et. seq.*

X. Marks Containing The Phonetic Equivalent of A Top Level Domain

Marks containing the phonetic equivalent of a TLD (e.g., XYZ DOTCOM) are treated in the same manner as marks composed of a regular TLD. If a disclaimer is necessary, the disclaimer must be in the form of the regular TLD and not the phonetic equivalent. *See* TMEP §1213.09(c).

Example: The mark is INEXPENSIVE RESTAURANTS DOT COM for providing information about restaurants by means of a global computer network. Registration should be refused because the mark is merely descriptive of the services under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1).

Example: The mark is XYZ DOTCOM. The applicant must disclaim the TLD ".COM" rather than the phonetic equivalent "DOTCOM."