

What You Really Should Know About Trademarks & Domain Names



Susan Anthony, Esquire

Global Intellectual Property Academy

Office of Policy and International Affairs

Susan.Anthony@uspto.gov - (571) 272-1500



What is a DOMAIN NAME?

- **TRADEMARK** -> a word, phrase, symbol or design, or a combination of words, phrases, symbols or designs, that identifies and distinguishes the source of the goods (or services) of one party from those of others.
- **DOMAIN NAME** -> 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”).



What is a DOMAIN NAME?

- *Example:* If the domain name is “ABC.com,” the term “ABC” 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.



What is the Relationship between Domain Names and Trademarks?

A mark comprised of an Internet domain name is registrable as a trademark or service mark only if it functions as an identifier of the source of goods or services.

USPTO Trademark Manual of Examining Procedure (TMEP), Section 1209.03(m) Domain Names

http://tess2.uspto.gov/tmdb/tmep/1200.htm#_T120903m



Where are Domain Names Registered?

- Generic Top-Level Domains (gTLDs)
 - For example, .com, .org, .biz, .info
 - Administered by the Internet Corporation of Assigned Names and Numbers (ICANN)
 - Registration information:
<https://www.icann.org/resources/pages/registrars-0d-2012-02-25-en>
- Country-Code Top-Level Domains (ccTLDs)
 - For example, .us, .ca, .de, .cn,
 - Administered independently by nationally designated registration authorities; >250 ccTLDs
 - Registration information is available through the ccTLD registry operator: <http://www.iana.org/domains/root/db/>



Basic IP Protection in gTLDs

- WHOIS (domain name registration record)
- Uniform Domain Name Dispute Resolution Policy (UDRP)



Basic IP Protection in gTLDs

- WHOIS (domain name registration record)
<http://www.uwhois.com/> provides an availability search
- Record includes information on, e.g.,
 - Owner contact information
 - Administrative Contact
 - Created on and Expired on
- Back-order services



Basic IP Protection in gTLDs

- WHOIS Policy Review Team Final Report
<http://www.icann.org/en/news/announcements/announcement-11may12-en.htm> (May 11, 2012)
 - And, Current Issues in WHOIS:
<https://whois.icann.org/en/current-issues>
- Some IP Constituency concerns:
 - WHOIS accuracy
 - Proxy/privacy registrations
 - Compliance (“critical”)



gTLDs: The Uniform Domain Name Dispute Resolution Policy (UDRP)

- The Uniform Domain Name Dispute Resolution Policy (UDRP) was designed to discourage and resolve abusive registration of trademarks as domain names in gTLDs.
- Three-prong test:
 - *Domain identical or confusingly similar to mark;*
 - *Respondent has no right or legitimate interest in domain name; and*
 - *Respondent has registered and used domain name in bad faith.*



gTLDs: The Uniform Domain Name Dispute Resolution Policy (UDRP)

- Information about the UDRP may be found at:

<http://www.icann.org/udrp>

<http://www.wipo.int/amc/en/domains/> and

- WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0") (WIPO, 2011)

<http://www.wipo.int/amc/en/domains/search/overview2.0/>



ccTLDs: WHOIS and Dispute Resolution

- The WIPO ccTLD Database contains links to the websites of 252 ccTLDs allowing the user to determine
 - the availability of a registration agreement,
 - the existence of a WHOIS service, and
 - the adoption of alternative dispute resolution (ADR) procedures
- The Trademark Database Portal

<http://www.wipo.int/amc/en/domains/cctld/index.html>



Domain Name Disputes

What happens if a third-party registers a right holder's mark as a domain name? It depends –

- gTLDs – Uniform Domain Name Dispute Resolution Policy

<http://www.icann.org/en/udrp/udrp-policy-24oct99.htm>

- New gTLDs – Uniform Rapid Suspension System (complement to UDRP for “most clear-cut cases”)

<http://newgtlds.icann.org/en/applicants/urs>

- ccTLDs – UDRP? Or other? (UDRP, UDRP-like, mediation, arbitration or if no alternatives, then, court)

http://www.wipo.int/amc/en/domains/cctld_db/index.html

<http://www.wipo.int/amc/en/center/faq/domains.html>

(WIPO FAQs on Domain Names)



Traditional Principles of Trademark Law

- Traditional trademark infringement under Section 32 of the federal Lanham (Trademark) Act
- Unfair competition under Section 43(a) of the federal Lanham (Trademark) Act
- Federal dilution law under Section 43(c) of the Lanham (Trademark) Act
- State laws against trademark infringement, unfair competition, dilution



Trademark Law Principles for the Internet: The Anti-Cybersquatting Consumer Protection Act ("ACPA")

- The Anti-Cybersquatting Consumer Protection Act ("ACPA") was signed into law on November 29, 1999.
- It prohibits registration of, trafficking in, or use of a domain name with a bad faith intent to profit from the goodwill of another's trademark.
- The ACPA is codified in the federal Lanham (Trademark) Act at Section 43(d). 15 U.S.C. Section 1125(d).



ACPA - Elements

Elements of the ACPA (Section 43(d)):

- Bad faith intent to profit from another's trademark
- Registration of, trafficking in, or use of a domain name that is
 - Identical or confusingly similar to a mark that was distinctive at the time that the domain name was registered or
 - Identical, confusingly similar, or dilutive of a trademark that was famous at the time that the domain name was registered or
 - A trademark protected by 18 U.S.C. Section 706 (RED CROSS) or 36 U.S.C. Section 220506 (OLYMPICS).



ACPA – *In Rem* Jurisdiction

- *In rem* jurisdiction: a suit against the domain name itself
- Addresses common problems of cyberpiracy:
 - Difficult to obtain *in personam* jurisdiction
 - Contact information frequently false



ACPA – *In Rem* Jurisdiction

An *in rem* action is available where –

1. The domain name violates any right of the owner of a trademark registered with the USPTO or protected under Section 43(a) [federal unfair competition] or Section 43(c) [federal dilution]; **and**
2. The trademark owner is unable to obtain *in personam* jurisdiction over the defendant **or**, through due diligence, is unable to locate the defendant (by sending notice and intent to proceed and by publishing notice of action).

15 U.S.C. Section 1125(d)(2)(A)(i-ii).



ACPA – *In Rem* Jurisdiction

An *in rem* action is brought where “the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located.”

15 U.S.C. Section 1125(d)(2)(C).



ACPA - Remedies

Remedies available under the ACPA include:

- Forfeiture or cancellation of domain name or transfer of domain name to owner of mark. 15 U.S.C. Section 1125(d)(1)(C).
- Actual damages and defendant's profits or, at plaintiff's election at any time prior to final judgment, statutory damages of \$1,000 - \$100,000 (USD) per domain name. 15 U.S.C. Section 1117(a), (d).
- Attorneys' fees are available only in "exceptional" cases. 15 U.S.C. Section 1117(a).
- In rem actions: remedies limited to forfeiture or cancellation or transfer. 15 U.S.C. Section 1125(d)(1)(D)(i).



ACPA vs. UDRP

- Remedies –
 - damages (unless “in rem”) vs. no damages
 - ACPA: attorneys’ fees in “exceptional” cases vs. no attorneys’ fees
- Discovery – discovery vs. no discovery
- Cost – very costly vs. relatively inexpensive
- Time – lengthy vs. relatively expedient



The Internet Corporation for Assigned Names and Numbers (ICANN)

<http://icann.org/>

Governmental Advisory Committee (GAC)

<http://gac.icann.org/>

Generic Names Supporting Organization (GNSO)

<http://gnso.icann.org/>

In the GNSO, the Commercial Stakeholder Group, including IP

<http://gnso.icann.org/en/about/stakeholders-constituencies/csg>

ICANN Policy Information Area

<https://www.icann.org/policy>



ICANN: The Roll-out of New gTLDs

ICANN New gTLD Program --

<http://newgtlds.icann.org/about/program>

ICANN Fact Sheet on new gTLDs –

[ICANN Fact Sheet on Rights Protection Mechanisms in new gTLDs --](#)

<http://archive.icann.org/en/topics/new-gtlds/trademark-factsheet-insert-02sep11-en.pdf>

-- On the Trademark Clearing House:

<http://newgtlds.icann.org/en/about/trademark-clearinghouse>

-- On the Uniform Rapid Suspension System:

<http://newgtlds.icann.org/en/applicants/urs>



Basic IP Protection in (new) gTLDs

- “Thick” WHOIS (domain name registration record)
- Trademark Clearinghouse
 - For use in Sunrise
 - For use in Trademark Claims
- Uniform Rapid Suspension System (URS): where infringement is clear and an expedited suspension of domain name is sought
- Uniform Domain Name Dispute Resolution Policy (UDRP): where 3-part test is met and transfer of domain name is sought
- Post-Delegation Dispute Resolution Procedure (PDDRP): where the registry is believed to be causing the infringing activity



Basic IP Protection in (new) gTLDs

Handy Reference at [STOPfakes.gov](http://www.stopfakes.gov) on “Protecting Trademarks in Domain Names: Rights Protection Mechanisms for Small Business”

<http://www.stopfakes.gov/business-tools/trademarks-domain-names>

(Flow Chart and Fact Sheet formats)

Over 1,300 new domains could become available over the next few years. Of the 1,930 applications filed, 948 new gTLDs have been introduced into the Internet as of March 25, 2016.

Information on delegated strings at:

<https://newgtlds.icann.org/en/program-status/delegated-strings>



Right Holder Protection of Trademark Portfolios

- Defensive Registration in New and Existing Domains
- Watching Services
 - New gTLDs: 90-day TM Clearinghouse “TM Claims Services” (+ ongoing notifications thereafter) (for new gTLDs)
 - Also, in new gTLDs: Limited number of domains (up to 50 strings) previously found to have been abused via UDRP or court proceedings can be added to a Trademark Clearinghouse record to broaden the scope of the Trademark Claims service.
 - There also will be the “traditional” watching services that may be hired for infringing or other problematic use.



Right Holder Protection of Trademark Portfolios (cont'd)

- Actions
 - (“old”) gTLD, new gTLD, or ccTLD
 - UDRP or ccTLD dispute resolution policy
 - Rights Protection Mechanisms in the new gTLDs
 - Court action (e.g., in US, the Anti-Cybersquatting Consumer Protection Act or ACPA)



What about “Special” Protection for IP?

- The fate of the Globally Protected Marks List (GPML)
<http://archive.icann.org/en/topics/new-gtlds/irt-final-report-trademark-protection-29may09-en.pdf>
- Should protection be extended to RED CROSS and to OLYMPICS at top-level domain? At second-level domain?
<http://newgtlds.icann.org/en/applicants/agb> (the New gTLDs Applicant Guidebook, see Module 2, 2.2.1.2.3.)
<https://features.icann.org/gac-advice-regarding-protections-red-cross-and-red-crescent-%E2%80%93-singapore-communicu%C3%A9>



What about “Special” Protection for IP?

- The question: Should protection be extended to intergovernmental government organizations (IGOs)?
- The U.S. position: 6ter of the Paris Convention is not a basis for protection
- The approach: The Governmental Advisory Committee (GAC) initiative, where .int registrants provide “a starting point” for providing protection
- A recent summary of where things stand now:
<https://gacweb.icann.org/display/GACADV/2015-10-21+Protection+for+IGOs>
- This matter is expected to be resolved in 2016, providing at least some protection.



Right Holder Protection of Trademark Portfolios: AND AT LAST...

DRAFT REPORT: Rights Protection Mechanisms Review

- <https://www.icann.org/news/announcement-3-2015-02-02-en>
- Purpose: This paper is intended to provide an outline for an initial review of the effectiveness of the rights protection mechanisms. Particularly, this paper reviews the data and input collected in many of the key areas relating to rights protection mechanism, including the Trademark Clearinghouse, Uniform Rapid Suspension system, and Post-Delegation Dispute Resolution Procedures.
- Issued for Public Comment, Feb. 5, 2015



Right Holder Protection of Trademark Portfolios: AND AT LAST...

Revised Report: Rights Protection Mechanisms Review

- <https://newgtlds.icann.org/en/reviews/rpm> (Sept. 11, 2015)
- Purpose: This paper is intended to provide an outline for an initial review of the effectiveness of the rights protection mechanisms. Particularly, this paper reviews the data and input collected in many of the key areas relating to rights protection mechanism, including the Trademark Clearinghouse, Uniform Rapid Suspension system, and Post-Delegation Dispute Resolution Procedures.



THANK YOU!