

TRADEMARKS, DOMAIN NAMES, AND ICANN: AN EVOLVING DANCE

BY SHERI LYN FALCO, ESQ.*

The aim of this article is to provide insight into the various policies trademark owners can utilize to ensure protection of their domain name-related trademarks on the United States Patent and Trademark Office (“USPTO”)¹ Principal Register² as well as the various mechanisms trademark owners can use to protect their registered or non-registered marks against third party activities within the domain name system. The article will examine the USPTO’s policies regarding trademark registration on the Principal Register for marks that *contain* top-level domains (“TLDs”)³ as a part of the domain name in the applied for mark as well as for marks that consist *solely* of a TLD.

In reviewing the dynamic evolution that has occurred in the relationship between trademarks and domain names, the role that the Internet Corporation for Assigned Names and Numbers (“ICANN”)⁴ has

* Ms. Falco is an intellectual property attorney who has worked in and around trademarks and domain names for almost twenty (20) years. Ms. Falco served as plaintiff’s initial counsel in the watershed *Sex.com* litigation that established domain names as intellectual property. Ms. Falco currently works as the general counsel for a top-level registry operator and develops and manages domain name-related policies.

1. Jurisdictions around the globe provide a variety of trademark protection mechanisms and litigation options; this article will focus specifically on the United States’ protection of trademarks both in its courts and with regard to policies and practices of its federal trademark registration system at the USPTO.

2. Daniel M. Gurfinkel, *The U.S. Trademark Registers: Supplemental vs. Principal*, INTABULLETIN (May 1, 2012), <http://www.inta.org/INTABulletin/Pages/TheUSTrademarkRegistersSupplementalvsPrincipal.aspx>, [<http://perma.cc/7RV3-Y4JN>].

Registration [of a mark] on the Principal Register provides the registrant with, among other things, the presumption of the validity of the mark, prima facie evidence of ownership of the mark and acknowledgment of its continuous and exclusive use. Further, there is the possibility, after five years of continuous, uninterrupted use from the date of registration, of achieving incontestable status (limiting the grounds of third-party attacks to cancel the mark).

Id.

3. A TLD is the characters located to the “right of the dot” in a domain name, *e.g.*, in the domain name “www.uspto.gov” the “.gov” is the TLD. The characters located to the “left of the dot” in a domain name are referred to as either the second level domain name, or the third level domain name, as applicable, *e.g.*, in the domain name www.registration.uspto.gov, “registration” is the third level domain name, “uspto” is the second level domain name and “gov” is the TLD.

4. *See generally ICANN’s Major Agreements and Related Reports*, INTERNET CORP. FOR ASSIGNED NAMES & NUMBERS, <http://www.icann.org/en/about/agreements>, [<http://perma.cc/L4F2-J8G2>] (last visited Feb. 16, 2014); *Welcome to ICANN!*, INTERNET CORP. FOR ASSIGNED NAMES & NUMBERS, <http://www.icann.org/en/about/welcome>, [<http://perma.cc/KCU6-GJ9P>]

had, and continues to have, in shaping and framing global trademark protections is of great significance. This overview will also present the options all trademark owners have to protect their marks that are used as domain names or as TLDs by third parties without their authorization. In doing so, this article will highlight key trademark protection initiatives developed by ICANN historically, as well as recent initiatives developed as a part of ICANN's 2012 new gTLD⁵ program. This article will also provide an introduction to independent initiatives by certain TLD registry operators⁶ who strive to further enhance the trademark protections within their specific TLDs.

THE USPTO'S POLICIES REGARDING DOMAIN NAMES AND TLDs

A few years after the emergence of the commercial Internet the USPTO established policies that require trademark examiners to, in large measure, discount the TLD in their assessment of a potential mark's trademark registerability.⁷ In its Trademark Manual of Examining Procedure ("TMEP"),⁸ the USPTO states:

[W]hen 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 [uniform resource locator ("URL")] ("http://www.") nor the TLD has any source-indicating significance. Instead, those

(last visited Feb. 16, 2014) (providing more information about ICANN and its role and relationship regarding the domain name system). ICANN is the organization responsible for coordinating and administering TLDs. *Welcome to ICANN!*, *supra*.

In its 5 June 1998 "Statement of Policy, Management of Internet Names and Addresses," 63 Fed. Reg. 31741(1998) (commonly known as the White Paper) . . . , the United States Government declared its willingness to recognize a new, not-for-profit corporation formed by private sector Internet stakeholders to administer policy for the Internet name and address system.

ICANN's Major Agreements and Related Reports, *supra*.

5. The terms "gTLD" and "TLD" will be used interchangeably. The author apologizes in advance for the prolific use of acronyms throughout this article (and within the ICANN and domain name community generally).

6. See generally *Domain Glossary*, ARCHITELOS (last visited Mar. 16, 2014), <http://architeilos.com/tld-news-resources/resources/domain-glossary/>, [<http://perma.cc/B8YR-S5BS>]. Registry operators are the entities that enter into a direct contract with ICANN and are responsible for the allocation of domain names within a given TLD. VeriSign, Inc. is the registry operator for the .com and the .net TLDs and Public Interest Registry is the registry operator for the .org TLD.

7. See U.S. DEP'T OF COMMERCE, PATENT AND TRADEMARK OFFICE, EXAMINATION GUIDE NO. 2-99, MARKS COMPOSED, IN WHOLE OR IN PART, OF DOMAIN NAMES (1999), http://www.domainsherpa.com/wp-content/uploads/2011/01/USPTO_Examination_Guide_2-99_Domain-Names.pdf, [<http://perma.cc/SJN9-LNWF>] [hereinafter EXAMINATION GUIDE NO. 2-99].

8. TMEP (8th ed. Oct. 2013), available at <http://tmep.uspto.gov/RDMS/detail/manual/TMEP/current/d1e2.xml>, [<http://perma.cc/8N92-BSPG>]. The TMEP is the USPTO's manual that contains guidelines for its examining attorneys, as it "outlines the procedures which Examining Attorneys are required or authorized to follow in the examination of trademark applications." *Id.*

designations are merely devices that every Internet site provider must use as part of its address. Advertisements for all types of products and services routinely include a URL for the website of the advertiser, and 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.⁹

The USPTO has indicated, when “viewing a domain name mark (e.g., ABC.COM or HTTP://WWW.ABC.COM), consumers look to the second-level domain name for source identification, not to the top-level domain (TLD) or the terms ‘http://www.’ or ‘www.’”¹⁰

The USPTO further states, “If a proposed mark is composed of a merely descriptive term(s) combined with a non-source-identifying TLD, in general, the examining attorney must refuse registration . . . on the ground that the mark is merely descriptive.”¹¹ With respect to generic marks the USPTO states, “[A] mark comprised of a generic term(s) combined with a non-source-identifying TLD is generic and without trademark or service mark significance.”¹² In light of these USPTO policies, obtaining federal trademark registration on the Principal Register for a domain name mark has been challenging.

The USPTO accepts the concept that a domain name can serve as a source identifier but indicates that it is possible only if “[t]he mark . . . [is] presented in a manner that will be perceived by potential purchasers to indicate source and not as merely an informational indication of the domain name address used to access a website.”¹³ The TMEP states:

Only in rare instances will the addition of a TLD indicator to a descriptive term operate to create a distinctive mark. There is no bright-line, per se rule that the addition of a TLD to an otherwise descriptive mark will never, under any circumstances, operate to create a registrable mark. If the TLD is capable of indicating a source, the addition of the source-indicating TLD to an otherwise unregistrable mark may render it registrable Thus, when examining domain name marks, it is important to evaluate the commercial impression of the mark as a whole to determine whether the composite mark conveys any distinctive source-identifying impression apart from its individual

9. TMEP §1215.02.

10. §1215.02(c).

11. §1215.04.

12. §1215.05.

13. See TMEP § 1215.02(a) (citing *In re Roberts*, 87 U.S.P.Q.2d 1474, 1479 (T.T.A.B. 2008) (“finding that irestmycase did not function as a mark for legal services where it is used only as part of an address by means of which one may reach applicant’s website or along with applicant’s other contact information on letterhead.”); see also *In re Eilberg*, 49 U.S.P.Q.2d 1955, 1957 (T.T.A.B. 1998) (explaining that the mark identifies the applicant’s Internet domain name).

components. The examining attorney must introduce evidence as to the significance of the individual components, including the TLD, but must also consider the significance of the composite to determine whether the addition of a TLD has resulted in a mark that conveys a source-identifying impression.¹⁴

Courts have also held that in rare, exceptional circumstances, a term that is not distinctive by itself may acquire additional meaning by including a TLD such as “.com” or “.net” and can render it “sufficiently distinctive for trademark registration.”¹⁵ While both the USPTO and the federal circuit have acknowledged that a mark composed of a domain name can serve as a source identifier, both have exercised restraint when applying this to marks that are domain names or TLDs.¹⁶

As early as 1995 the worldwide organization of trademark owners and trademark attorneys, the International Trademark Association (“INTA”), “endorse[d] the principle that domain names as addresses on the Internet are capable of functioning as trademarks.”¹⁷ Despite this acknowledgement by the trademark community, the USPTO has been cautious and somewhat inconsistent in their decisions when it comes to granting trademark owners registrations on the Principal register. The USPTO’s policy continues to reinforce the axiom that domain names are generally perceived as nothing more than an Internet address where the applicant can be contacted, and therefore, registration on the Principal register must be refused.¹⁸

TLDS AS TRADEMARKS ON THE PRINCIPAL REGISTER

Looking to TLDs themselves, as compared to domain names,¹⁹ the USPTO has historically espoused a very clear line.

If a mark is composed solely of a TLD for “domain name registry services” (e.g., the services of registering .com domain names), registration [should] be refused . . . on the ground that the TLD would

14. TMEP §1209.03(m).

15. *In re Steelbuilding.com*, 415 F.3d 1293, 1299 (Fed. Cir. 2005) (citing *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1177 (Fed. Cir. 2004)).

16. From the mid-1990’s until the early 2000’s, while these policies were first making their way through the USPTO, trademark owners were able to register domain names as trademarks on the Principal register. However, since the early 2000’s trademark examiners have generally enforced a consistent policy position not to approve registrations of word mark domain names as trademarks on the Principal register.

17. See *Board Resolutions Assignment of Domain Names on the Internet*, POLICY & ADVOCACY (Sept. 19, 1995), <http://www.inta.org/Advocacy/Pages/AssignmentofDomainNamesontheInternet.aspx>, [<http://perma.cc/P23C-G588>].

18. See TMEP §1215.02(a).

19. Domain names include TLDs but are not *only* comprised of TLDs, (e.g., amazon.com is the domain name and .com is the TLD).

not be perceived as a mark. The examining attorney must include evidence from the [LEXIS(r)] 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 . . . on the ground that the TLD is merely descriptive of the registry services.²⁰

Like the USPTO, most U.S. courts have not yet extended trademark protection to TLDs because they have held that the TLD is not a source indicator.²¹

However, the USPTO has recently acknowledged, “[a]s the number of available TLDs is increased by the Internet Corporation for Assigned Names and Numbers (“ICANN”), or if the nature of new TLDs changes, the examining attorney must consider any potential source-indicating function of the TLD and introduce evidence as to the significance of the TLD.”²² Several trademark experts and the author believe that when TLDs like .bank, .wine, .kids, .amex, and .bloomberg, exist, the TLD has emerged to serve as a source identifier.²³ Notwithstanding the above, the USPTO continues to generally reiterate its long-standing position stating, “consumers are predisposed to view gTLDs as merely a portion of a web address rather than as an indicator of the source of domain-name registration or registry services. Therefore, registration of such marks must initially be refused.”²⁴

20. TMEP §1215.02(d).

21. See *Image Online Design, Inc. v. Internet Corp. for Assigned Names & Nos.*, No. 12-08968, 2013 U.S. Dist. LEXIS 16896, at *21 (C.D. Cal. Feb. 7, 2013) (“The proposition that TLDs are not generally source indicators has been adopted by courts, legal scholars, and other authorities.”) (citing MCCARTHY ON TRADEMARKS § 7:17.50 (4th ed. 2013) (“[A] top level domain indicator has no source indicating significance and cannot serve any trademark purpose. . . . [T]he TLD ‘.com’ functions in the world of cyberspace much like the generic indicators ‘Inc.’, ‘Co.’, or ‘Ltd.’ placed after the name of a company.”))

22. TMEP §1209.03(m); cf. *In re theDot Commc’ns Network LLC*, 101 U.S.P.Q.2d 1062, 1067 (T.T.A.B. 2011) (“finding ‘.music conveys the commercial impression of a top-level domain name similar to .com, .net, etc.’ and that consumers would understand it to be a TLD in the field of music based on the current marketing environment which included evidence of a concerted effort to obtain TLD status for.music.”).

23. See Thomas Barrett, *The Role of Trust in Determining a New TLD’s Business Success*, CIRCLEID (May 30, 2013, 1:25 PM), http://www.circleid.com/posts/20130530_role_of_trust_in_determining_a_new_tlds_business_success/, [<http://perma.cc/Q6SY-UJ97>]; see also EXAMINATION GUIDE: APPLICATION FOR MARKS COMPRISED OF gTLDs FOR DOMAIN NAME REGISTRATION OR REGISTRY SERVICE, UNITED STATES PATENT & TRADEMARK OFFICE 1 (2013), http://www.uspto.gov/trademarks/notices/gTLDExamGuideDraft_8_7_13_public.doc, [<http://perma.cc/8Y8N-RJ4N>] (stating that new gTLDs under consideration may have significance as source identifiers) [hereinafter EXAMINATION GUIDE]. There is a contingency of ICANN and trademark experts that suggest that TLDs are becoming source identifiers. Barrett, *supra*.

24. See EXAMINATION GUIDE, *supra* note 23, at 2.

While the USPTO's assessment of TLDs as non-source identifiers may have been appropriate historically,²⁵ it is no longer an accurate reflection of the significance TLDs now have and will continue to have moving forward. With the advent of ICANN's sponsored TLDs ("sTLDs")²⁶ in 2003–2004 and ICANN's new gTLD program in 2012, consumers have become and will continue to become increasingly aware that the TLD itself has a source identifying function. In turn, the consumer expectations associated with a TLD are changing and will continue to change. The USPTO acknowledges this shift and, in response to ICANN's 2012 new gTLD program, proposed revised rules for ascertaining the registerability of marks that are TLDs.²⁷

In 2013 the USPTO published draft rules for examining trademark applications of gTLDs.²⁸ In the proposed draft rules the USPTO states,

[t]he Internet Corporation for Assigned Names and Numbers . . . has begun a program to introduce new gTLDs. Some of the new gTLDs under consideration may have significance as source identifiers. To the extent that some of the new gTLDs under consideration are comprised of existing registered trademarks or service marks that are already strong source identifiers in other fields of use, some of the premises underlying existing USPTO policy regarding the registration of gTLDs may no longer hold true for such gTLDs Where the wording following the "." or "dot" is already used as a trademark or service mark, the appearance of such marks as a gTLD may not negate

25. See generally Sarah E. Akhtar & Robert C. Cumbow, *Why Domain Names Are Not Generic: An Analysis of Why Domain Names Incorporating Generic Terms Are Entitled to Trademark Protection*, 1 Chi.-Kent J. Intell. Prop. 226 (1999) (suggesting that it is arguable that even the first TLDs had clearly delineating source-identifying characteristics e.g., .com versus .gov, versus .edu, versus .mil, etc.; each connote a different commercial impression; trademark commentators at the time have suggested as much). Nonetheless, as otherwise stated herein, the USPTO's historical registration policies did not generally interpret the TLD as a source-identifier. *Id.*

26. See generally *ICANN Announces Plans for Conclusion of sTLD Application Process*, INTERNET CORP. FOR ASSIGNED NAMES & NUMBERS, (Jan. 4, 2007), <http://www.icann.org/en/news/announcements/announcement-04jan07-en.htm>, [<http://perma.cc/ZG9R-EU4A>]. Sponsored TLDs are TLDs that are associated with a particular community, trade or industry. Additionally, many sponsored TLDs have an established code of conduct or a set of policies or principles that must be adhered to by websites operating with their TLDs and as such, their heightened standards have created a TLD eco-space whereby consumers have come to associate certain characteristics from the websites who operate within that space, e.g., .jobs, .xxx, .aero, .coop, etc.

27. See *USPTO Reveals gTLD Trademark Rules*, WORLD INTELL. PROP. REV. (Aug. 13, 2013), <http://www.worldipreview.com/news/uspto-reveals-gtld-trademark-rules>, [<http://perma.cc/DYZ2-GSAC>] (outlining gTLD trademark rules). As of the time of writing this article the USPTO comment period on the proposed rules has closed. *Id.* The USPTO is anticipated to incorporate a final version of its proposed draft rule into the next version of the TMEP, upon review of the comments received during the comment period.

28. See EXAMINATION GUIDE, *supra* note 23, at 1.

the consumer perception of them as source indicators. “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.”²⁹

In its proposed rule the USPTO clearly states that a TLD can be a source-identifier and prescribes specific pre-requisites for finding such source-identifying characteristics. According to the USPTO, a TLD can be a source-identifier if the gTLD matches an active U.S. trademark registration covering the same subject matter as the websites that will be registered under the gTLD. For example, if a registry operator has a prior trademark registration for the word “automobile” and “identifies its goods and services as ‘automobile dealerships,’ and the services in the [gTLD] application are identified as ‘domain-name registration services for websites featuring automobiles and information about automobiles,’”³⁰ in such case, if all other delineated factors are satisfied, pursuant to the proposed rules the USPTO will grant the trademark registration for the “.automobile” TLD. As a part of its delineated factors, the USPTO will require all trademark applicants to provide evidence of a mutually executed contract with ICANN regarding the applicant’s right to become the registry operator of the applied-for gTLD. The USPTO will also require applicants to show that the gTLD will provide a “legitimate service for the benefit of others,” noting that, operating a gTLD registry for its employees or its own marketing activities would not generally be regarded as a service for the benefit of others but registration for use by the applicant’s affiliated distributors would typically qualify.³¹

29. *Id.* at 2; See also *INTA Internet Committee Comments*, TRADEMARK POLICY COLLABORATION, <http://uspto-tmep.ideascale.com/a/dtd/INTA-Internet-Committee-Comments/447388-9340>, [<http://perma.cc/62MA-E52Y>] (last visited Feb. 9, 2014) (“The European Union’s Office for Harmonization in the Internal Market (OHIM), without issuing an official statement on the issue . . . [has] recognized the protectability of marks comprised solely of gTLDs that serve as an indication of source for the relevant goods or services. Its registrability decisions on these marks, however, have been inconsistent.”).

30. *Id.*

31. EXAMINATION GUIDE, *supra* note 23, at 5; see TMEP § 1715; *TTAB Facts and Questions*, USPTO.GOV, <http://www.uspto.gov/trademarks/process/appeal/guidelines/ttabfaq.jsp#fiq1>, [<http://perma.cc/V26L-L66U>] (last visited Feb. 17, 2014). As with all USPTO registrations on the Principal register, if there is a party who believes they will be damaged by another party’s registration of the mark, the alleged damaged party can file a Letter of Protest with the USPTO or an Opposition or Cancellation with the Trademark Trial and Appeal Board (“TTAB”). TMEP § 1715; *TTAB Facts and Questions*, *supra*. This recourse exists as an additional protection that can be utilized by trademark owners who wish to prevent or cancel federal registrations of their marks that are contained in a third parties’ TLD. *TTAB Facts and Questions*, *supra*.

The USPTO's proposed policy change clearly reflects a paradigm shift from perceiving TLDs as non-source identifying to understanding that TLDs can, and often do, serve as source identifiers worthy of registration on the Principal register. While this policy change provides an explicit indication that the USPTO will now approve registration on the Principal register for marks that *are* TLDs (subject to its delineated requirements), it is not an express policy change indicating that all marks that *contain* domain names or TLDs will be registerable on the Principal register. Nonetheless, it is a confirmation of the growing significance of TLDs as source identifiers in the minds of consumers and reflects the USPTO's awareness of the importance that TLDs as source-identifiers play in our commercial world, both now and in the future.

PROTECTIONS FOR TRADEMARKS IN THE DOMAIN NAME SYSTEM

One of the purposes of trademark law is to promote the orderly functioning of the market through avoidance of confusion and deception.³² However, because the trademark system is divided territorially and by industry, many parties can use the same word as a trademark without causing infringement. A frequent source of conflict on the Internet results from the registration and use of domain names that contain other parties' trademarks. In seeking to protect their trademarks that are contained in a third parties' domain name, trademark holders have two paths of dispute resolution available to them.³³ One path was created by ICANN and the other was established by the U.S. court system. The tried-and-true dispute resolution method for all existing TLDs allocated by ICANN is the Uniform Domain Name Dispute Resolution Policy ("UDRP"). Since 1999, trademark owners have been able to seek relief against infringement of their marks contained in third party domain names under the UDRP. In addition to the UDRP, and as a part of ICANN's new gTLD program, ICANN recently created additional dispute resolution options, as well as, a variety of pro-active options that allow trademark owners to protect their marks within domain names and TLDs acquired by others under ICANN's new gTLD program. The overview below briefly describes the UDRP and compares it to federal litigation; it then introduces additional trademark protections made available under ICANN's new gTLD program.

32. Ian Botnick, Comment, *Honoring Trademarks: The Battle to Preserve Native American Imagery in the National Collegiate Athletic Association*, 7 J. MARSHALL REV. INTELL. PROP. L. 735, 741 (2008).

33. In addition to these more formalized dispute resolution paths, trademark owners also have private settlement options available.

UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP)

Shortly after ICANN's formation in 1998, the World Intellectual Property Organization ("WIPO") was commissioned to conduct a study on the relationship between trademarks and domain names. WIPO's final report recommended the institution of a dispute resolution policy that would work uniformly across the TLDs that ICANN administered at the time (e.g., .com, .net, and .org).³⁴ WIPO's proposal worked its way through the ICANN policymaking process, and in 1999 the UDRP was established.³⁵ The UDRP gives trademark owners a cost-effective and expedited venue for obtaining domain names that were registered against them by third parties in bad faith.³⁶ The UDRP permits parties to challenge domain name registrations that contain terms that are identical or confusingly similar to their trademarks and provides remedies that include the transfer or cancellation of those domain names (damages and injunctions are not available).³⁷ The UDRP allows trademark owners to proceed against bad actors even if the trademark is not registered.³⁸ It provides an inexpensive, fast, and accessible path that trademark owners can use to obtain names that they believe were obtained by cyber squatters.³⁹

34. See WORLD INTELLECTUAL PROP. ORG., THE MANAGEMENT OF INTERNET NAMES AND ADDRESSES: INTELLECTUAL PROPERTY ISSUES 44 (1999), <http://www.wipo.int/export/sites/www/amc/en/docs/report-final1.pdf>, [<http://perma.cc/BE5D-4827>] (explaining the support that exists for the development of "a single means of resolving a dispute with multiple jurisdictional manifestations.").

35. See *Uniform Domain Name Dispute Resolution Policy*, INTERNET CORP. FOR ASSIGNED NAMES & NOS., (Aug. 26, 1999), <http://www.icann.org/en/help/dndr/udrp/policy>, [<http://perma.cc/3ZTW-FDYK>] (last visited Feb. 18, 2014).

36. See Jasin M. Osborn, *Effective and Complementary Solutions to Domain Name Disputes: Icann's Uniform Domain Name Dispute Resolution Policy and the Federal Anticybersquatting Consumer Protection Act of 1999*, 76 NOTRE DAME L. REV. 209, 238–39 (2000) (discussing the process of a UDRP proceeding, and explaining that an average UDRP proceeding costs a few thousand dollars and takes approximately forty-five days to complete).

37. Wendi S. Temkin & Sarah L. Rector, *Trademark-Related Domain Name Disputes Under the Uniform Domain Name Dispute Resolution Policy*, 42 COLO. LAW. 37, 39, 45 (2013).

38. See *Trademarks*, BERKMAN CENTER FOR INTERNET & SOC'Y, <http://cyber.law.harvard.edu/udrp/opinion/ttext.html>, [<http://perma.cc/5YLB-ZTG5>] (last visited Feb. 18, 2014).

39. See *Cybersquatting*, OXFORD DICTIONARIES, <http://www.oxforddictionaries.com/definition/english/cybersquatting?q=cybersquatting>, [<http://perma.cc/R9ZP-U4DC>] (last visited Feb. 18, 2014) (defining the term "cybersquatting"); see also Temkin & Rector, *supra* note 37, at 37 (explaining "cybersquatting" as the practice of registering names, especially well-known company or brand names, as internet domain names in the hope of reselling them to the trademark or brand owner at a profit).

The UDRP is a contractually bound right mandated by ICANN that exists between domain name registrants,⁴⁰ their registrars,⁴¹ and the registry operator;⁴² it is a contractually agreed-to procedure that eradicates the jurisdictional issues otherwise inherent in global trademark enforcement. Even with the efficiency created by the UDRP there are limits to it as well. It was not designed to handle complex disputes, such as determining which of two users has superior rights to the mark contained in a domain name.⁴³ Other draw backs of the UDRP are that the rulings are unpredictable and inconsistent; there is no built-in appeal process nor is there a guarantee that a UDRP ruling will be the final determination of the rights at issue because a disappointed party can file a court action to prevent the UDRP panel's decision from being implemented.⁴⁴ For trademark owners to succeed the UDRP panel must find that the domain name at issue is (i) "identical or confusingly similar to a trademark or service mark in which the complainant has rights; and (ii) [the domain owner has] no rights or legitimate interest in respect of the domain name; and (iii) [the] domain name has been registered and is being used in bad faith."⁴⁵

The UDRP panel can use any of the following as evidence of bad faith:

(i) circumstances indicating [the domain name holder has] registered the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark . . . for valuable consideration in excess of [the domain name owner's] documented out-of-pocket costs . . . [for] the domain name; or (ii) [the domain name owner has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided . . . [the domain name owner has] engaged in a pattern of such conduct; or (iii) [the domain name holder has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, [the domain holder] intentionally attempted to attract, for commercial gain, Internet users to [their] website . . . by creating a

40. *Domain Name Registrant*, WEBOPEDIA, http://www.webopedia.com/TERM/D/domain_name_registrant.html, [<http://perma.cc/95L6-BDXU>] (last visited Feb. 18 2014).

41. See Temkin & Rector, *supra* note 37, at 37 (explaining the nature of a domain name registrar); see also *Glossary*, *supra* note 6 (defining ICANN-accredited registrar as "A company that registers domain names for Internet users"). The domain name registrar offers these services directly to the public, e.g., GoDaddy, Tucows, Network Solutions, etc.

42. See EXAMINATION GUIDE NO. 2-99, *supra* note 7.

43. See Temkin & Rector, *supra* note 37, at 44, 46 (analyzing the limits of the UDRP).

44. See *id.* at 40 (showing that panels are divided when making right in the mark determinations).

45. See *Uniform Domain Name Dispute Resolution Policy*, *supra* note 35, § 4(a).

likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the domain owners] web site.⁴⁶

Since its inception the UDRP has been tremendously useful to trademark owners and is often utilized as an effective solution against cyber squatters and others.

TRADEMARK LITIGATION

Trademark litigation is another dispute resolution option available to trademark owners whose marks are being used in domain names by unauthorized third parties. Trademark litigation can be pursued by trademark owners as a first measure or in response to a UDRP decision that did not provide a successful result. The elements for a successful trademark infringement claim have been well established. A plaintiff in a trademark case has the burden of proving that the defendant's use of a mark has created a likelihood of confusion about the origin of the defendant's goods or services.⁴⁷ To do this, the plaintiff must first show that it has developed a protectable trademark right,⁴⁸ and then must show that the defendant is using a confusingly similar mark in such a way that it creates a likelihood of confusion, mistake, and/or deception with the consuming public.⁴⁹

46. *Id.* at § 4(b).

47. *See* Int'l Ass'n of Machinists & Aerospace Workers, AFL-CIO v. Winship Green Nursing Ctr., 103 F.3d 196, 200–01 (1st Cir. 1996).

48. *See* 15 U.S.C. §1065 (2012); Thomas Zuber, *Trademark Infringement: The Basics*, ARTICLESNATCH.COM, <http://www.articlesnatch.com/Article/Trademark-Infringement--The-Basics/167611#ixzz2nluG8G9U>, [<http://perma.cc/66YU-S4VW>] (last visited Feb. 19, 2014); *see, e.g.*, *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (defining trademark as “any word, name, symbol, or devise or any combination thereof” used by any person “to identify . . . his or her goods . . .”). The Lanham Act protects marks that are registered with the USPTO as well as those that are in use in interstate commerce but never registered, but registration of a mark with the USPTO creates a presumption that it is legitimate and eligible for protection under the Lanham Act. *Trademark Infringement, supra*. A plaintiff seeking to establish that an unregistered mark is not given the benefit of a presumption and “must first prove, by a preponderance of the evidence, (1) that the mark was actually ‘used’ in commerce and (2) that it meets the general requirements of being a trademark under Section 2 of the Lanham Act.” *Id.*

49. 15 U.S.C. § 1125 (2012); *see also* *Intermatic Inc. v. Toeppe*, 947 F. Supp. 1227, 1233, 1239–41 (N.D. Ill. 1996). The Lanham Act requires that the use be “on or in connection with any goods or services” and be a mark that is likely to cause confusion, mistake or deception as to the affiliation, connection or association of the accused person or as to the origin of the “goods, services or commercial activities” of the accused person. §1125(a)(1)(A). The defendant must use the domain name in some commercial sense, and reservation of a domain name, by itself and without use in connection with a commercial enterprise, does not constitute infringement by confusion or dilution under the Lanham Act. § 1125(a)(1)(B). In cases where a third party reserves a domain name with the intent to ransom or extort money from the trademark holder,

To analyze whether a particular situation has developed into the requisite “likelihood of confusion” courts have generally referenced the following factors:

(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression, (2) The [relatedness] of the goods or services as described in an application or registration or in connection with which a prior mark is in use, (3) the similarity or dissimilarity of established, likely-to-continue trade channels, (4) the conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing . . . [(5)] the number and nature of similar marks in use on similar goods.⁵⁰

Of these factors the first two are arguably the most important. When assessing the likelihood of confusion with respect to Internet issues, courts have become increasingly sophisticated and may also take the unique characteristics of the Internet into account.⁵¹

The most common form of relief granted to a successful plaintiff in a trademark infringement lawsuit is an injunction against the domain name holder from further infringement. Monetary damages and punitive damages are also available in federal litigation but are rarely rewarded. A large percentage of the cases involve preliminary injunctions and often damages have not had time to develop. But even cases that go to full trial generally do not result in monetary recovery except in cases of counterfeiting or bad faith. An injunction is usually the only relief granted. The litigation costs can easily exceed one hundred thousand dollars (\$100,000), which is prohibitive for smaller online businesses. In light of the fact that injunctive relief is the predominate outcome, in most cases the underlying business does not warrant the expense of litigation. As such, it is not as well utilized as the UDRP for most domain name related trademark infringement matters.

courts have recognized such activities as commercial use sufficient to trigger the Lanham Act (such activities are referred to as “cybersquatting” and the individuals who participate in those activities are referred to as “cyber squatters”). *Intermatic, Inc.*, 947 F. Supp. at 1233, 1239–41.

50. See Application of E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973); see also *In re Dixie Rest., Inc.*, 105 F.3d 1405, 1406–07 (Fed. Cir. 1997) (“not all of the *DuPont* factors are relevant or of similar weight in every case . . . [and] any one of the factors may control a particular case.”) (citations omitted).

51. See, e.g., *Interstellar Starship Servs., Ltd. v. Epix Inc.*, 184 F.3d 1107, 1110 (9th Cir. 1999) (recognizing the concept of “initial interest confusion”); *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1062 (9th Cir. 1999) (finding infringement where domain name causes “initial interest confusion”). The theory of “initial interest confusion” is that although web users will realize that they have reached the wrong site, they may be satisfied with the goods or services offered at the competitive site and not continue searching for the original site they had intended to visit and as such initial interest confusion has occurred. *Brookfield*, 476 F. 2d at 1062.

ANTICYBERSQUATTING CONSUMER PROTECTION ACT (ACPA)

In addition to the traditional causes of action available under the Lanham Act, trademark owners who wish to litigate in federal court against a domain name owner may also elect to bring a cause of action under the Anticybersquatting Consumer Protection Act (“ACPA”).⁵² The ACPA was enacted in 1999 and, in addition to the already-existing trademark infringement causes of action available, it established a cause of action for registering, trafficking in, or using a domain name that is confusingly similar to or dilutive of, a trademark or personal name.⁵³ Some trademark owners prefer to use the ACPA instead of the UDRP because it offers more remedies than the mere cancellation and transfer of the domain name (which are the only remedies available under the UDRP), and it allows for complex cases that involve evidentiary issues and serves as the final resolution of the matter (whereas the UDRP can be overturned by federal litigation).

The ACPA allows a trademark owner to bring a cause of action against a domain name registrant who: (i) has a bad faith intention to profit from the mark and (ii) registers, traffics in, or uses a domain name that is (a) identical or confusingly similar to a distinctive mark, (b) identical or confusingly similar to or dilutive of a famous mark,⁵⁴ or (c) is a trademark related to certain special marks that have been protected by statute.⁵⁵ The ACPA has enumerated a non-exhaustive list of nine factors that a court may consider when determining whether the domain name registrant has a bad faith intent to profit, including: (i) the domain name registrant’s trademark or other intellectual property rights in the domain name; (ii) whether the domain name contains the registrant’s legal or common name; (iii) the registrant’s prior use of the domain name in connection with the bona fide offering of goods or services; (iv) the registrant’s bona fide noncommercial or fair use of the mark in a site accessible by the domain name; (v) the registrant’s intent to divert customers from the trademark owner’s online location that could harm the goodwill represented by the trademark, for commercial gain or with the intent to tarnish or disparage

52. 15 U.S.C. § 1125(d) (2012) (incorporating the ACPA into the Lanham Act).

53. *See id.*

54. § 1125(d)(1)(A)(i)–(ii); *see also* § 1125(c)(2)(A) (explaining that a trademark is famous if the trademark owner can prove that the mark is “widely recognized by the general consuming public of the United States as a designation of a source of goods or services of the mark’s owner”).

55. § 1125(d)(1)(A)(ii); *see, e.g.*, 18 U.S.C. § 706 (2012) (providing special protections for marks involving the Red Cross); 36 U.S.C. § 220506 (2012) (providing special protections for marks relating to the Olympics).

the mark; (vi) the registrant's offer to transfer, sell or otherwise assign the domain name to the mark owner or a third party for financial gain, without having used the mark in a legitimate site; (vii) the registrant's providing misleading false contact information when applying for registration of the domain name; (viii) the registrant's registration or acquisition of multiple domain names that are identical or confusingly similar to the marks of others; and (ix) the extent to which the mark in the domain name is distinctive or famous.⁵⁶ The ACPA also includes a safe harbor for would-be defendants, providing that where the domain name registrant "believed and had reasonable grounds to believe that the use of a domain name was a fair use or otherwise lawful," the claim will fail.⁵⁷

One of the reasons a trademark owner might wish to proceed with an ACPA action, *as compared to an infringement action without an ACPA cause of action*, is because the "confusingly similar" standard under the ACPA is easier to satisfy than the more rigorous "likelihood of confusion" standard applied in traditional infringement actions.⁵⁸ The ACPA also provides for in rem actions, or actions against the domain itself, where the cyber squatter is beyond the personal jurisdiction of the court or cannot be located despite diligent efforts.⁵⁹

One of the reasons a trademark owner may wish to proceed with an ACPA action, *as compared to a UDRP*, is that the ACPA expressly provides protection for personal names, whereas the UDRP does not, absent a showing that the individual has developed service mark rights in their name. In addition, unlike the UDRP an ACPA judgment can provide not only temporary and permanent injunctions, but also between one thousand dollars (\$1,000) and one hundred thousand dollars (\$100,000) per domain registration.⁶⁰ The ACPA is an option when there are complex issues regarding competing rights to a domain name that can only be developed through circumstantial evidence; however because it is expensive and requires the filing and prosecution of a federal lawsuit it is not often utilized.⁶¹

56. See § 1125(d)(1)(B)(i).

57. § 1125(d)(1)(B)(ii).

58. See, e.g., *Shields v. Zuccarini*, 254 F.3d 476, 483 (3d Cir. 2001) ("[t]he domain names—joescartoon.com, joecarton.com, joescartons.com, joescartoons.com and cartoonjoe.com—closely resemble 'joecartoon.com,' with a few additional or deleted letters, or, in the last domain name, by rearranging the order of the words The strong similarity between these domain names and joecartoon.com persuades us that they are 'confusingly similar.'").

59. § 1125(d)(2).

60. 15 U.S.C. § 1117(d) (2012).

61. See Erin Mershon, *Congress Should Address Cybersquatting Issues in New GTLD Program, Business Groups Say*, COAL. AGAINST DOMAIN NAME ABUSE, <http://cadna.org/wid->

ICANN'S NEW GTLD TRADEMARK PROTECTIONS

As a part of its 2012 new gTLD program, ICANN approved over one thousand (1,000) new gTLDs for release into the consumer market place within the next few years.⁶² This is the first wave of what is anticipated to be additional massive influxes of TLDs in the years and decades to come. The ICANN Board of Directors has already approved a second round of new gTLD applications.⁶³ To date, ICANN has been responsible for allocating and regulating only twenty-two (22) TLDs; these twenty-two TLDs represent a mere fraction of the volume of TLDs that ICANN will soon be overseeing.⁶⁴ In response to concerns expressed by intellectual property rights communities regarding ICANN's new gTLD plans, ICANN created a variety of new trademark protections that apply to all of the TLDs operating under ICANN's new gTLD program. ICANN has mandated that each new gTLD registry operator and each registrar selling new gTLDs institute a range of new intellectual property protections that are collectively referred to as Rights Protection Mechanisms ("RPMs").⁶⁵ These new RPMs are in addition to and supplement the already existing recourse options elucidated above, namely the UDRP, trademark litigation, and the ACPA cause of action.⁶⁶

congress-should-address-cybersquatting-issues-in-new-gtld-program-business-groups-say, [<http://perma.cc/N3E3-45EC>] (last visited Feb. 19, 2014). The Coalition Against Domain Name Abuse ("CADNA") has called for revisions to the ACPA in light of new gTLDs. *Id.* CADNA requested stronger deterrence for all violators, such as "establishing liability against an affiliate, representative or other entity acting in concert with the registrant, including registrars and registries . . ." *Id.* CADNA also asked to amend the damages provision to award damages of "at least \$25,000 per domain name targeted by cyber squatters." *Id.* CADNA noted that the ACPA is not well utilized because of the expense involved in bringing an action under the ACPA. *Id.*

62. See *New gTLD Program*, ICANNWIKI, http://icannwiki.com/index.php/New_gTLD_Program, [<http://perma.cc/45W5-F3G5>] (last visited Feb. 19, 2014).

63. See *Approved Board Resolutions*, INTERNET CORP. FOR ASSIGNED NAMES & NOS. (Feb. 7, 2012), <http://www.icann.org/en/groups/board/documents/resolutions-07feb12-en.htm#4>, [<http://perma.cc/QDQ3-Q9M7>] (noting that an additional gTLD round has already been approved, without giving the actual date). It is likely ICANN will announce the timing of the next gTLD round once the 2012 new gTLD round is completed and assessed. *Approved Board Resolutions*, *supra*.

64. See Cyrus Namazi, *Three Ways to Protect Your Trademark During the Top-Level Domain Expansion*, ICANN BLOG (Oct. 14, 2013), <http://blog.icann.org/2013/10/three-ways-to-protect-your-trademark-during-the-top-level-domain-expansion>, [<http://perma.cc/ZBY8-3FB7>].

65. See *Id.*

66. See *Id.*; Mark Dugdale, *Association of National Advertisers Weighs into LPR Debate*, IPPROTHEINTERNET.COM (Feb. 14, 2013), http://www.ipprotheinternet.com/ipprotheinternetnews/article.php?article_id=2753, [<http://perma.cc/6MFW-MGB9>]; Kevin Murphy, *New gTLD "Strawman" Splits Community*, DOMAIN INCITE (Jan. 16, 2013, 2:42 PM), <http://domainincite.com/11619-new-gtld-strawman-splits-community>, [<http://perma.cc/MW9J-37AQ>]; *New gTLD Application Submitted to ICANN by: ICM Registry SX LLC*, INTERNET CORP.

The trademark-related protections that ICANN created in their new gTLD program are: (i) the Legal Rights Objections (“LRO”), geared towards allowing trademark owners to file a formal objection to a third parties’ application for a new gTLD even before the TLD is allocated; (ii) the Trademark Clearinghouse (“TMCH”), geared towards proactive trademark protection by trademark owners at the time of registration of a second level domain name; (iii) the Uniform Rapid Suspension (“URS”) dispute resolution intended for post-registration protection by trademark owners against second level domain name registrations; and (iv) the Trademark Post-Delegation Dispute Resolution Procedure (“Trademark PDDRP”) that allows trademark owners to proceed against the TLD registry operator directly in the event a registry operator is engaging in a pattern of bad behavior with respect to the domain names registered in their TLD or the TLD itself.⁶⁷

LEGAL RIGHTS OBJECTIONS (LRO)

In recognizing the risk that new gTLDs pose to existing trademark holders, ICANN created a new proactive dispute resolution option designed to allow both registered and unregistered trademark owners an opportunity to prevent the gTLD from existing.⁶⁸ Although the LRO period closed on March 13, 2013, and no additional LROs can be filed against gTLDs applied for under the 2012 new gTLD round, this new pro-active trademark objection opportunity may be a legal recourse option for trademark owners

FOR ASSIGNED NAMES & NOS. (June 13, 2012), <https://gtldresult.icann.org/applicationstatus/applicationdetails:downloadapplication/1418?t:ac=1418>, [<http://perma.cc/M3H9-RTV5>] [hereinafter NEW GTLD APPLICATION]. While ICANN undoubtedly created unprecedented recourse options for trademark owners there are some intellectual property advocates who have expressed that ICANN could have done even more with the new gTLD protections to protect trademark owners from unnecessary costs and resource expenditures. See Murphy, *supra*. For example, the registry operator of the .xxx TLD pioneered a trademark protection program referred to as its “Sunrise B” program. *Id.* In the Sunrise B program trademark owners were able to place the exact match of their trademark on a reserve list; the registry operator and not the trademark owner maintained this reserve list. NEW GTLD APPLICATION, *supra*. Once a name was placed on the Sunrise B reserve list, that name was essentially “blocked” from being used by any party as a domain name in the .xxx TLD. *Id.* This “block” service was offered to trademark owners for a one-time fee and minimized the need for ongoing, annual domain name registrations. *Id.* Many intellectual property advocates and brand owners petitioned ICANN to adopt a similar “blocking” program for all new gTLDs, this proposal was referred to by ICANN as the “Limited Preventative Registrations” program. Dugdale, *supra*. However, this program was ultimately rejected as an option by ICANN.

67. See *Rights Protection Mechanisms for New Top-Level Domains (TLDs)*, WORLD INTELL. PROP. ORG., <http://www.wipo.int/amc/en/domains/rpm/#c>, [<http://perma.cc/HK2X-AHLF>] (last visited Feb. 19, 2014) [hereinafter *Rights Protection Mechanisms*].

68. See *id.*

to consider in future gTLD rounds. Under the 2012 new gTLD process, when an objection was filed against a TLD applicant, an independent WIPO panel was established to determine “whether the gTLD applicant’s potential use of the applied-for gTLD would be likely to infringe the objector’s existing trademark.”⁶⁹ In making their determinations the independent panels ascertained whether the potential use of the applied-for gTLD

- (i) [took] unfair advantage of the distinctive character or reputation of the objector’s registered or unregistered trademark or service mark . . .
- , (ii) unjustifiably impair[ed] the distinctive character or reputation of the objector’s mark . . . , or (iii) otherwise create[d] an impermissible likelihood of confusion between the applied-for gTLD and the objector’s mark. . . .⁷⁰

It is important to note that the LRO does not include a built-in appeals process and has been perceived by some as a risky option.⁷¹ As of the time of writing this article, ICANN has not conclusively determined what it intends to do with the LRO panel inconsistencies and how such inconsistencies will impact awarding the new gTLD(s) at issue. In light of this ambiguity some trademark owners have elected to pursue relief through ICANN’s Reconsideration Process and others through litigation; no streamlined route to challenge the LRO results has yet been elucidated.⁷²

TRADEMARK CLEARINGHOUSE (TMCH)

The TMCH was designed as a central repository on behalf of ICANN’s new gTLD program and serves to provide rights holders across the globe the ability to protect their trademarks in all new gTLDs.⁷³

69. See WIPO ARBITRATION AND MEDIA CENTER, WIPO ARBITRATION AND MEDIATION CENTER END REPORT ON LEGAL RIGHTS OBJECTION PROCEDURE 2013 5 (2013), <http://www.wipo.int/export/sites/www/amc/en/docs/lroreport.pdf>, [<http://perma.cc/BQ89-6WTH>].

70. *Id.*

71. See *id.* at 7; *Legal Rights Objections under ICANN’s New gTLD Program*, WORLD INTELL. PROP. ORG. (last visited Feb. 19, 2014), <http://www.wipo.int/amc/en/domains/lro/cases/>, [<http://perma.cc/MY9F-CRB6>] [hereinafter *Legal Rights Objections*]. There have been critiques of the LRO by members of the ICANN community due to the fact that different panelists determine the LRO objections and there have been inconsistencies in the panel rulings as a result. WIPO ARBITRATION AND MEDIA CENTER, *supra* at 9 (discussing LRO panel appointment). A full list of new gTLDs objected to pursuant to the LRO and their results was published. *Legal Rights Objections, supra*.

72. See Amy E. Bivins, *Lessons From New TLDs Legal Objections: Dictionary-Word Brand LRO Won’t Block TLDs*, BLOOMBERG BNA (Oct. 2, 2013), <http://www.bna.com/lessons-new-tlds-n17179877493/>, [<http://perma.cc/DE6E-BY86>].

73. See *Rights Protection Mechanisms, supra* note 67; CLEARINGHOUSE, TRADEMARK CLEARINGHOUSE GUIDELINES 21 (2013), <http://trademark-clearinghouse.com/sites/default/files/ff>

Eligibility in the TMCH is limited to active registered trademarks from a national or multi-national jurisdiction, as well as trademarks that are validated by a court order or treaty.⁷⁴ The goal of the TMCH is to support rights protection mechanisms in the gTLD program and operate cost-effective services that do not place undue financial or administrative burdens on trademark holders, registrars, and registries.⁷⁵ To obtain the benefits related to the TMCH, trademark owners must file their marks and submit their registration fees directly to the TMCH.⁷⁶ Trademark owners can file more than one trademark with the TMCH. As an additional protection, if the trademark owner has previously won a UDRP or a court decision on the trademark it is filing with the TMCH, the trademark owner can elect to file both a verified trademark and up to fifty (50) names similar to that trademark; this is referred to as the “Abused Doman Name Label Service.”⁷⁷

les/downloads/TMCH%20guidelines%20v1.2%20comm_0.pdf, [http://perma.cc/4WP-SY3G] [hereinafter TRADEMARK CLEARINGHOUSE GUIDELINES]. There are rules for replacing special characters in a trademarks into the more limited set of characters allowed for domain names, e.g. the word “and” is possible in a domain name but the symbol “&” is not possible in a domain name, if the trademark included the symbol “&”, the TMCH has rules for replacing that symbol when it comes to a domain name for that trademark. TRADEMARK CLEARINGHOUSE GUIDELINES, *supra*. The Trademark Clearinghouse Guidelines provide the complete TMCH rules.

74. See *Registered Trademarks*, CLEARINGHOUSE (last visited Feb. 19, 2014), <http://trademark-clearinghouse.com/content/registered-trademarks>, [http://perma.cc/GA4R-GCN5].

75. *Protecting Trademark Rights for New gTLDs: ICANN Seeks Service Providers for Trademark Clearinghouse Operation*, INTERNET CORP. FOR ASSIGNED NAMES & NOS. (Oct. 3, 2011), <http://www.icann.org/en/news/announcements/announcement-5-03oct11-en.htm>, [http://perma.cc/BKE2-5Q2W]; see *Accepted Trademarks*, CLEARINGHOUSE (last visited Feb. 19, 2014), <http://trademark-clearinghouse.com/content/accepted-trademarks>, [http://perma.cc/YU6M-T2BE].

76. See *The Trademark Clearinghouse: Protect your trademark online*, CLEARINGHOUSE (last visited Feb. 19, 2014), <http://trademark-clearinghouse.com>, [http://perma.cc/G9YP-DADC]; *Trademark Clearinghouse Fees*, CLEARINGHOUSE (last visited Feb. 19, 2014), <http://trademark-clearinghouse.com/content/trademark-clearinghouse-fees>, [http://perma.cc/8NLU-ZNL6]. The current fees and requirements of the TMCH filing can be found in the Clearinghouse website. *Trademark clearinghouse fees, supra*.

77. See Robin Gross, *Noncommercial Users Ask ICANN Board to Review Decision to Expand Trademark Rights in New Domains*, CIRCLEID (Mar. 1, 2013, 8:38 PM), http://www.circleid.com/posts/20130501_icann_board_asked_to_review_decision_to_expand_trademark_rights, [http://perma.cc/XC3B-8T9P]. While many in the intellectual property community herald the Abused Doman Name Label (DNL) Service (often referred to as the “Trademark +50” program) as a pro-active consumer protection program because it is intended to help rights owners protect trademarks that have a history of being abusively used or registered as domain names, some commentators have indicated that this program provides an unfair advantage to large trademark holders since each separate country’s registration of the same trademark provides the brand owner with an additional fifty (50) entries in the TMCH. *Id.*

There is likely a misunderstanding amongst some trademark owners regarding what registering a mark with the TMCH actually does and does not provide. Registering a trademark with the TMCH does not prevent others from registering a “confusingly similar” domain name in a given TLD nor does it secure the trademark owners automatic right to obtain the desired name in a given TLD. Registering a trademark with the TMCH is, however, a pre-requisite for obtaining certain elements of trademark protection available in ICANN’s new gTLD program. The two primary services offered by the TMCH for trademark owners who register their marks are the Trademark Claims Service and the Sunrise Service.⁷⁸ As an additional benefit to trademark owners, registering a trademark in the TMCH also serves to validate the trademark in the event the trademark holder wishes to participate in the URS dispute resolution procedure. As further described below, the URS is a new procedure available to trademark holders when their trademarks are being infringed in domain names created in a new gTLD; registering the mark with the TMCH helps streamline the trademark owner’s pursuit of that dispute resolution.⁷⁹

TRADEMARK CLEARINGHOUSE (TMCH) CLAIMS SERVICE

Once a trademark is verified by the TMCH and the appropriate fee has been paid to the TMCH, the trademark will automatically become enrolled in the Trademark Claims Service applicable to all new TLDs. The Trademark Claims Service ensures that whenever a potential registrant in a new gTLD applies for a domain name that matches a trademark filed in the TMCH, the potential domain name registrant receives a notification message informing them of the existence of the TMCH mark (essentially letting the potential domain name buyer know that someone has a trademark that may be associated with the domain name they are seeking to acquire). If the potential domain name registrant continues with the registration and acquires the domain name, the TMCH will then send email notices to the trademark holder(s) that have filed with the TMCH indicating that the relevant domain name has been registered. The Claims Service

78. See, *Previously Abused Labels Integrated into Trademark Clearinghouse Claims Service*, INTERNET CORP. FOR ASSIGNED NAMES & NOS. (Oct. 18, 2013), <http://newgtlds.icann.org/en/announcements-and-media/announcement-18oct13-en>, [<http://perma.cc/5KVB-28HR>]. Unregistered marks that are filed with the TMCH along with the required registered mark pursuant to the “Trademark +50” program are not entitled to participate in the TMCH Sunrise Service but are eligible for the TMCH Claims Service; registered marks filed with the TMCH are eligible for both services.

79. See *infra* text accompanying notes 86–91.

does not inherently prevent trademark infringement since the domain name registrant may still elect to register the potentially infringing domain name. It will, however, be easier to establish bad faith of the party registering the domain name since they proceeded after receiving notice of the prior trademark rights and as such, it is intended to serve as a powerful deterrent against infringement and cybersquatting.

TRADEMARK CLEARINGHOUSE (TMCH) SUNRISE SERVICE

ICANN requires that each new gTLD registry operator offer a Sunrise Period before registration is made available to the general public for that TLD.⁸⁰ A TLD's Sunrise Period is generally the first opportunity a trademark owner has to purchase a domain name in a given TLD. The trademark owner must file their trademark with the TMCH to participate in a new gTLD's Sunrise Period so that the trademark owner can have the option to take advantage of the first opportunity to purchase a domain name in a specific TLD. Essentially in a TLD's Sunrise Period a trademark owner will have the option to purchase domain names that correspond to their trademarks before the general public (including before cyber squatters) have an opportunity to do so.⁸¹ This opportunity is a TLD by TLD specific opportunity, so trademark owners may elect to participate in some Sunrise Periods and not others. Moreover, TLDs launch at different times and as such, to participate in a TLD Sunrise Period, TMCH trademark holders have to ascertain when those launch dates are and when the Sunrise Period starts and ends.

The new gTLD program requires trademark owners to make difficult strategic decisions on how to protect their marks while maximizing their protection resources. Given that each TLD charges its own annual domain name registration fee per domain name, and often also charges higher-priced Sunrise fees per domain name, the assessments trademark owners face about which TLD Sunrise Periods to participate in and which to ignore have substantial cost implications in addition to the historical trademark and brand confusion implications already inherent in the domain name system. If the given TLD is applicable to a certain mark's goods and services, the trademark owner will likely want to ensure that its mark is

80. See *Trademark Clearinghouse Rights Protection Mechanism Requirements*, INTERNET CORP. FOR ASSIGNED NAMES & NOS., newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-30sep13-en.pdf, [http://perma.cc/9X92-UGG9] (last visited Feb. 19, 2014).

81. See *The New GTLD Program: Latest Updates on Brand Protection and the Trademark Clearinghouse*, KATTEN MUCHIN ROSENMAN LLP (Jan. 15, 2014), <http://www.kattenlaw.com/The-New-gTLD-Program>, [http://perma.cc/HY2W-QYLF].

registered as a domain name in that related TLD. The most expeditious method to securing this is to participate in the given TLD's Sunrise Period. Even if the trademark owner does not wish to use the domain name in the TLD, it may be more cost effective to obtain the domain name in that TLD's Sunrise Period, rather than risk allowing a third party without the trademark to obtain that domain name in the TLD's general registration period. If the trademark owner successfully registers the desired domain name it can either use the name for its own business purposes or simply "park" the domain name to prevent cyber squatters from doing so.⁸²

To take advantage of a TLD Sunrise Period, trademark owners must register their trademarks with the TMCH prior to the desired TLD Sunrise Period, submit a Declaration, Proof-of-Use, and an additional fee to the TMCH (a Declaration and Proof-of-Use is not needed if the trademark owner wishes only to utilize the Claims Service referenced above).⁸³ Once the Declaration and Proof-of-Use is accepted by the TMCH, the trademark holder will be able to participate in all TLD Sunrise Periods for which its mark is eligible,⁸⁴ as long as the trademark owner maintains its TMCH registration.⁸⁵

82. See *Defensive Registration*, ICANNWIKI.COM (last modified Oct. 4, 2012), http://icannwiki.com/index.php/Defensive_Registration, [<http://perma.cc/RTM7-P76L>]. The practice of a trademark or brand owner registering a domain name without the intention to use it is often referred to as a "defensive registration." *Id.* "Defensive [r]egistration refers to registering domain names, often across multiple TLDs and in varied grammatical formats, for the primary purpose of protecting intellectual property or trademark[s] from abuse, such as cybersquatting." *Id.* Defensive registrations are typically "registration that is not unique, does not resolve, [and instead] redirects traffic back [to a flagship domain name]." *Id.*

83. See *New GLTD Updates, Important Information for All Trademark Owners*, KELLEY DRYE (Mar. 6, 2013), http://www.kelleydrye.com/publications/client_advisories/0803, [<http://perma.cc/789G-7H4N>].

84. See *The Trademark Clearinghouse*, ENCIRCA, <http://www.encirca.com/html/tmch-registration.shtml>, [<http://perma.cc/G97H-YUR9>] (last visited Feb. 19, 2014); see also, INTERNET CORP. FOR ASSIGNED NAMES & NOS., GTLD APPLICANT GUIDEBOOK (2012), <http://newgtlds.icann.org/en/applicants/agb>, [<http://perma.cc/HRN4-EK4L>]; *FAQs: Trademark Clearinghouse*, INTERNET CORP. FOR ASSIGNED NAMES & NOS. (Jan. 21, 2014), <http://newgtlds.icann.org/en/about/trademark-clearinghouse/faqs>, [<http://perma.cc/7HEZ-SCKX>]. Some registry operators have elected to limit eligibility for registering domain names in their TLD to ensure that only certain types of goods and services are eligible to obtain a domain name in their TLD. In these more limited TLDs not all trademark owners are eligible to participate in the Sunrise Period offered by such TLD, even if the mark is registered in the TMCH. In such cases, only certain types or classes of trademarks are eligible to participate in that specific TLDs Sunrise registration period. The ICANN website provides Sunrise eligibility information for all new gTLDs.

85. See *Sunrise Services*, CLEARINGHOUSE, <http://trademark-clearinghouse.com/content/sunrise-services>, [<http://perma.cc/9M55-2VSL>] (last visited Feb. 19, 2014).

UNIFORM RAPID SUSPENSION (URS)

The URS is an ICANN-created rights protection mechanism that was designed to provide an even quicker and lower-cost dispute resolution than the UDRP for trademark holders in pursuit of protecting their marks in new gTLD domain names.⁸⁶ When a trademark holder files a complaint with the URS dispute resolution provider, the registrar is contacted and immediately freezes the domain name at issue.⁸⁷ The registrar then notifies the domain name registrant that a complaint was filed.⁸⁸ If the domain name registrant does not respond within the fourteen days allotted, the complaint proceeds to default status that means a URS dispute resolution provider panelist will review the complaint filed by the trademark owner for a prima facie case. If the panelist determines the case has been made, the domain name will be suspended immediately by the registry operator.⁸⁹ Unlike the UDRP, the domain name at issue will not be cancelled or

86. See *Uniform Rapid Suspension System (URS)*, INTERNET CORP. FOR ASSIGNED NAMES & NOS., <http://newgtlds.icann.org/en/applicants/urs>, [http://perma.cc/H3HL-FX6X] (last visited Feb. 19, 2014); see also Kevin Murphy, *First URS case decided with Facebook the victor*, DOMAIN INCITE (Oct. 25, 2013), <http://domainincite.com/14868-first-urs-case-decided-with-facebook-the-victor>, [http://perma.cc/UKL9-VY2Z]; Radix Registry, *.pw - The First TLD to Adopt the Uniform Rapid Suspension Rights Protection Mechanism*, CIRCLEID (July 29, 2013), http://www.circleid.com/posts/20130729_pw_first_tld_to_adopt_uniform_rapid_suspension_rights_protection/, [http://perma.cc/S3F5-Q3CY]; *Trademark Clearinghouse*, ICANN, <http://newgtlds.icann.org/en/about/trademark-clearinghouse>, [http://perma.cc/XM32-X83M] (last visited Feb. 19, 2014); *Rapid Evaluation Service Policy*, ICMREGISTRY.COM, <http://www.icmregistry.com/about/policies/res-policy/>, [http://perma.cc/Z4XY-E8UX] (last visited Feb. 19, 2014). At least one registry operator that was a TLD operating prior to the 2012 new gTLD program, elected to offer the URS as a dispute resolution mechanism for domain names in its TLD (i.e. .pw). Radix Registry, *supra*. While writing this article, Facebook was the first URS complainant and prevailed in their URS case regarding the facebook.pw domain name. Murphy, *supra*. However, the URS is generally only used by registry operators that obtained their new gTLDs pursuant to ICANN's 2012 new gTLDs program. *Trademark Clearinghouse, supra*. It is notable that at least one registry operator that was launched prior to the new gTLD program offered a similar rapid resolution mechanism for domain names in its TLD, (i.e. .xxx's rapid dispute resolution process is considered a pre-cursor to the URS and is called the Rapid Evaluation Service ("RES")). *Rapid Evaluation Service Policy, supra*.

87. See *Frequently Asked Questions (FAQs) – Trademark Clearinghouse Registration Services*, MELBOURNE IT, <http://www.melbourneit.com.au/trademark-clearinghouse-FAQ/>, [http://perma.cc/T2LC-PMMZ] (last visited Feb. 19, 2014).

88. See *Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules")*, INTERNET CORP. FOR ASSIGNED NAMES & NOS., <http://www.icann.org/en/help/dndr/udrp/rules>, [http://perma.cc/75CL-UDYY] (last visited Feb. 19, 2014).

89. See *UNIFORM RAPID SUSPENSION SYSTEM ("URS")*, INTERNET CORP. FOR ASSIGNED NAMES & NOS. (Mar. 1, 2013), <http://newgtlds.icann.org/en/applicants/urs/procedure-01mar13-en.pdf>, [http://perma.cc/9WR8-DX99]. In most cases the entire URS procedure is expected to take approximately twenty (20) days from the filing of the complaint to the resolution of the matter.

transferred to the complainant; instead, it will be pointed to a mandatory URS placeholder page for the remaining domain name registration period unless the decision is reversed.⁹⁰ As such, it is the responsibility of the trademark owner to register the domain name once it becomes available again (after the infringing party's domain name registration term expires). Unlike the UDRP, the URS does have an appeals process built into the system.⁹¹

TRADEMARK POST-DELEGATION DISPUTE RESOLUTION PROCEDURE (TRADEMARK PDDRP)

In recognizing that infringement can occur not only by a domain name registrant, but also by a registry operator's pattern of behavior, ICANN implemented a procedure that allows trademark owners to pursue the TLD registry operator directly. This newly created procedure, the Trademark PDDRP, provides a mechanism for trademark owners to target scenarios where a registry operator's policies, practices or use of a domain leads to or supports trademark infringement, either at the TLD level or at the second level of the domain.⁹² This new procedure allows trademark owners to potentially halt a new gTLD's ability to take more registrations and in extreme cases, could ultimately impact the new gTLD's ability to operate.

Due to the potential impact that can result from a PDDRP, there is a built-in initial "threshold" review panel which looks at the complaint even before proceeding to the merits of the dispute and even before the registry operator is required to submit a substantive response or pay any fees.⁹³ The "threshold" review panel is tasked with determining whether "[t]he [c]omplainant is a holder of a word mark that: (i) is nationally or regionally registered and that is in current use; or (ii) has been validated through court proceedings; or (iii) that is specifically protected by a statute or treaty at the

90. See *National Arbitration Forum Prepares for Uniform Rapid Suspension System as 2012 UDRP Filings Hold Steady*, NATIONAL ARBITRATION FORUM (Apr. 23, 2013), <http://www.adrforum.com/newsroom.aspx?itemID=1871>, [<http://perma.cc/AJL3-U3LP>]. The filing of a URS complaint has a fee of approximately \$375. *Id.*

91. See INTERNET CORP. FOR ASSIGNED NAMES & NOS., UNIFORM SUSPENSION SYSTEM ("URS") 10 (2010), <http://newgtlds.icann.org/en/applicants/urs/procedure-01mar13-en.pdf>, [<http://perma.cc/Z72V-RNBV>].

92. See *Post-Delegation Dispute Resolution Procedures Rules Updated*, INTERNET CORP. FOR ASSIGNED NAMES & NOS. (Oct. 15, 2013), <http://newgtlds.icann.org/en/announcements-and-media/announcement-15oct13-en>, [<http://perma.cc/4M99-ZUGS>].

93. See INTERNET CORP. FOR ASSIGNED NAMES & NOS., TRADEMARK POST-DELEGATION DISPUTE RESOLUTION PROCEDURE (TRADEMARK PDDRP) 2 (2012), <http://newgtlds.icann.org/en/applicants/agb/pddrp-04jun12-en.pdf>, [<http://perma.cc/U9F9-LB7N>].

time the PDDRP is filed.”⁹⁴ The “threshold” review panel will also ensure that the complainant has asserted material harm as well as facts that support a claim prescribed by the standards expressed in the PDDRP.⁹⁵ Moreover, the PDDRP “threshold” review panel will ensure that the complainant has notified the registry operator at least thirty (30) days prior to filing the complaint so that the parties can seek to work together in good faith to resolve the issue prior to initiating the PDDRP.⁹⁶ If the “threshold” review panel determines that the threshold matters have been satisfied, the matter will proceed to reviewing the merits of the complaint.⁹⁷

For disputes focused on whether the trademark is being used as a TLD,

a complainant must assert and prove, by clear and convincing evidence, that the registry operator’s affirmative conduct in its operation or use of its gTLD string that is identical or confusingly similar to the complainant’s mark, causes or materially contributes to the gTLD doing one of the following: (a) taking unfair advantage of the distinctive character or the reputation of the complainant’s mark; or (b) impairing the distinctive character or the reputation of the complainant’s mark; or (c) creating a likelihood of confusion with the complainant’s mark. An example of infringement at the top-level is where a TLD string is identical to a trademark and then the registry operator holds itself out as the beneficiary of the mark.⁹⁸

If the panel determines that the registry operator engaged in such behavior, it will recommend that ICANN’s Contractual Compliance team impose remedies.⁹⁹

Alternatively, if the dispute is related to second level domain name(s) (and not the TLD itself),

[c]omplainants are required to prove, by clear and convincing evidence that, through the registry operator’s affirmative conduct: (a) there is a substantial pattern or practice of specific bad faith intent by the registry operator to profit from the sale of trademark infringing names; and (b) the registry operator’s bad faith intent to profit from the systematic registration of domain names within the gTLD that are identical or confusingly similar to the complainant’s mark, which (i) takes unfair advantage of the distinctive character or the reputation of the complainant’s mark,

94. *Id.* at 5

95. *Id.* at 5–6.

96. *Id.* at 6.

97. *Id.*

98. *Id.* at 2.

99. *Post-Delegation Dispute Resolution Procedure (Trademark PDDRP)*, *supra* note 92, at 9.

or (ii) impairs the distinctive character or the reputation of the complainant's mark, or (iii) creates a likelihood of confusion with complainant's mark.¹⁰⁰

“An example of infringement at the second level is where a registry operator has a pattern or practice of actively and systematically encouraging registrants to register second level domain names and to take unfair advantage of the trademark to the extent and degree that bad faith is apparent.”¹⁰¹ “Another example of infringement is . . . where a registry operator has a pattern or practice of acting as the registrant or beneficial user of infringing registrations.”¹⁰² In those circumstances, the panel will recommend that ICANN's Contractual Compliance team impose remedies.¹⁰³

Since the domain name registrants themselves are typically not a party to a PDDRP action (because it is the registry operator and the trademark owner that are the parties), the remedies do not include deleting or transferring the domain name registration.¹⁰⁴ The remedies also do not include monetary damages or sanctions, although it is a “loser pays” model; that said, the remedies do include a variety of graduated enforcement tools against the registry operator that will be enforced by ICANN itself.¹⁰⁵ The enforcement tools include remedial measures that the registry operator can employ to ensure against future infringing registrations (however, registry operators will not be required to monitor registrations that are not related to the names at issue in the PDDRP proceeding). Another graduated enforcement tool could include suspending the registry operator's ability to accept new domain name registrations in their TLD until the violations have been cured, and in extraordinary cases where the registry operator acted with malice a graduated enforcement tool could include termination of the registry operator's agreement with ICANN for the new gTLD.¹⁰⁶ Given the potential implications the PDDRP can have on a registry operator's business, an appeals process is built into the PDDRP.¹⁰⁷

100. *Id.* at 2–3.

101. *Id.* at 3.

102. *Id.*

103. *Id.*

104. *Id.* at 9.

105. *Trademark Post-Delegation Dispute Resolution Procedure (Trademark PDDRP)*, *supra* note 92, at 9.

106. *Id.*

107. *See Trademark Post-Delegation Dispute Resolution Procedure (Trademark PDDRP)*, *supra* note 92, at 10. As of the time of writing this article no PDDRP's have been initiated.

SPECIFIC TLD REGISTRY OPERATOR INITIATIVES FOR GREATER TRADEMARK PROTECTIONS

In addition to the ICANN-mandated protections that are required of all new gTLDs, certain registry operators have elected to go above and beyond those RPMs and have created specialized programs to further enhance rights protections in their respective TLDs. Some new gTLD registry operators have elected to incorporate the TMCH into their additional protections, whereas others have elected to maximize protections for domain name registrants on the basis of pre-existing rights that the registry operator has granted to domain name registrants with domain names in other TLDs owned or operated by that registry operator.

Donuts, Inc. is a “Portfolio Applicant”¹⁰⁸ anticipated to operate over two hundred (200) out of the approximately three hundred (300) TLDs they applied for in the 2012 new gTLD round. In recognition of the immense resource allocation that a trademark owner would have to undergo to ensure that their trademarks are not being infringed by third parties in each of Donuts’ TLDs, Donuts created a program they refer to as the “Domains Protected Marks List” (“DPML”).¹⁰⁹ The DPML allows trademark owners who have registered their marks with the TMCH to “block” domain names that are related to their TMCH-filed trademarks from becoming registered as domain names by third parties in TLDs managed by Donuts. A domain name blocked by DPML means it is not a functional domain name and cannot be used as a website, e-mail address, or other type of domain-related functionality.

Under the DPML, trademark owners can protect their directly matching TMCH-filed trademarks as well as domain names that simply include the TMCH-trademark somewhere in the domain name. For example, if the registered trademark filed with the TMCH is the word “blue,” the Donuts’ DPML allows the trademark holder to ensure that domain names that contain the word “blue” are also not registered in Donuts’ TLDs, e.g., “bluebird.TLD” can be blocked from registration in the TLDs operated by Donuts if that “blue” trademark owner elected to participate, and pay additional fees for, Donuts’ DPML program. To participate in Donuts’ DPML program, trademark holders must first register their mark with TMCH and the mark must be registered according

108. Registry operators that apply for multiple gTLDs have been referred to as “Portfolio Applicants” and often create programs that relate to their entire “portfolio” of new gTLDs.

109. See *DPML Overview*, DONUTS, <http://www.donuts.co/dpml/dpml-overview/>, [http://perma.cc/WUM9-EE9G] (last visited Feb. 19, 2014).

to the TMCH's "use" standard, which is the same standard for participation in a gTLD Sunrise Period. Under the DPML eligible terms can be blocked from registration in all Donuts TLDs for an initial period of five to ten years (at the trademark holder's discretion); a DPML subscription can be renewed in increments of one to ten years.¹¹⁰

It is important to note, however, that there are exclusions to this program. A term will not be blocked in any Donuts' TLD where that term is already registered as a domain name in that Donuts TLD. "If a domain [name] is initially excluded from DPML . . . a rights holder may still subscribe to DPML (and block the term in all other Donuts TLDs)."¹¹¹ If that previously registered domain expires or is deleted, DPML protection will then automatically apply to that term in that TLD. Moreover, there are a group of domain names often referred to in the domain name industry as "Premium Domains,"¹¹² these Premium Names are also excluded from the DPML service.¹¹³ Additionally, if there are competing trademark owners and one of them has registered a domain name under a Donut-TLD Sunrise Period, that domain name will not be available in the given TLD for a block under the DPML because the other trademark owner has applied to use it in a given TLD; this is known as an "override," and Donuts asserts that this is consistent with the purpose of the DPML which is to block cyber squatters and not to block legitimate trademark owners.¹¹⁴ The party requesting the "override" "must have an exact-match, Sunrise-eligible trademark for the domain [at issue]".¹¹⁵ Donuts contends that this new program is a way to protect against cybersquatting at a fraction of the costs

110. *Id.*

111. See *DPML FAQs*, DONUTS, <http://www.donuts.co/dpml/faq/>, [<http://perma.cc/JA6X-P66U>] (last visited Feb. 19, 2014).

112. See Syadm, *Premium Domain Names: What Makes a Domain Name Valuable?*, SYMBOLICS.COM (Mar. 20, 2013), <http://symbolics.com/premium-domain-names-what-makes-a-domain-name-valuable/>, [<http://perma.cc/W9AY-6394>]. Premium Domain Names are domain names that are higher-priced domain names which may be important to the specific industry that the TLD is related to and are generally more valuable because they are easier for consumers to remember and may often result in better search engine optimization ("SEO"). *Id.*

113. See *DPML Overview*, *supra* note 109.

114. See *DPML FAQs*, *supra* note 111.

115. See *id.*; see also *The Donuts Domain Protected Mark List (DPML)*, NETNAMES, http://www.gtld.com/UserFiles/EN_DPML_Factsheet_VGM_21102013_.pdf, [<http://perma.cc/3WGH-W7X6>] (last visited Feb. 19, 2014) (providing an example of a DPML "override" as a situation where "ACME Manufacturing subscribes to DPML to block its trademarked ACME term in all Donuts TLDs. ACME Plumbing, which owns a trademark that contains the ACME term and is eligible to register domain names during Sunrise, may override the DPML block and register acme.plumbing").

it would otherwise entail for trademark owners to defensively register domain names in each of the Donut's TLDs.¹¹⁶

Uniregistry, another Portfolio Applicant, is offering a service it refers to as "Spanning the Dot."¹¹⁷ Trademark owners who have filed their trademark registrations with the TMCH will be able to participate in a special Sunrise Registration period that will allow them to acquire domain names in Uniregistry's TLDs that are potentially even more reflective of their intent than the original Sunrise Registration itself.¹¹⁸ For example, if the trademark "example tattoo" was filed with the TMCH and the trademark owner wishes to participate in Uniregistry's Sunrise Period, they will have the opportunity to participate in this special Sunrise Registration and purchase example.tattoo, in addition to exampletattoo.tattoo (exampletattoo.tattoo is the domain name that they would generally be eligible to acquire via their TMCH trademark in the .tattoo TLD). Arguably this additional option to purchase their mark in a manner that more clearly describes their mark, instead of in a manner that creates a redundancy in the domain name and the TLD, is actually what the trademark owner ideally desires when purchasing domain names. Uniregistry will offer the standard TMCH Sunrise Period first and will then independently reach out to eligible Sunrise registrants directly if the Sunrise registrant's TMCH name in the specific TLD qualifies for its "Spanning the Dot" program.¹¹⁹

VeriSign, Inc., the registry operator for the .com and .net TLDs, has elected to provide transliterations of .com and .net domain names, e.g. the Hebrew, Arabic, Thai, etc. versions of a .com or .net name, only to the registrant of the corresponding Latin script-ASCII version of the .com or .net name.¹²⁰ VeriSign refers to this as their IDN.IDN¹²¹ implementation

116. See *DPML FAQs*, *supra* note 111.

117. See *Uniregistry Programs "Dot-Spanning" Sunrise Durations and Anti-Gaming Security*, DIGIINO.COM (Dec. 27, 2013), <http://www.digiinno.com/archives/16752>, [<http://perma.cc/YQ6H-RT7D>].

118. See *id.*

119. See Kevin Murphy, *Uniregistry Plans "Dot-Spanning" Sunrise Periods and Anti-Gaming Protection*, DOMAIN INCITE (Dec. 27, 2013), <http://domainincite.com/15422-uniregistry-plans-dot-spanning-sunrise-periods-and-anti-gaming-protection>, [<http://perma.cc/XQF7-W5DA>].

120. *Verisign Announces Participation in ICANN's New gTLD Program*, VERISIGN (June 13, 2012), <https://investor.verisign.com/releasedetail.cfm?releaseid=682756>, [<http://perma.cc/QU5G-4FG2>].

121. See Letter from Patrick S. Kane, Senior Vice President, Naming Services, VeriSign, Inc., to Christine Willett (July 11, 2013), available at <http://www.icann.org/en/news/correspondence/kane-to-willett-11jul13-en.pdf>, [<http://perma.cc/EMM9-ZTU2>] (detailing the IDN.IDN plans); see also *New gTLD IDC Applications*, ICANNWIKI, http://icannwiki.com/index.php/New_gTLD_IDN_Applications, [<http://perma.cc/3FSK-T3VK>] (last modified Feb. 25, 2014) (providing a full list

plan, and it is designed to provide domain name owners with greater protection for non-Latin script new gTLDs by ensuring that no other party is able to register that domain name in another language offered under VeriSign's IDN program.¹²² This is intended to reduce cybersquatting, as well as mitigate consumer confusion.

ICM Registry LLC, the owner and operator of the .xxx TLD, has applied for three additional new gTLDs and has created a program for its new gTLDs that it is referring to as its "Domain Matching" program.¹²³ Similar to VeriSign's IDN.IDN program, ICM's "Domain Matching" program strives to ensure that the .xxx registrants have the first opportunity to register their exact match domain names in any of the new gTLDs that ICM operates.¹²⁴ This initiative is designed to reduce the risk of cybersquatting, add additional value for .xxx domain name holders and mitigate consumer confusion in its TLDs.

Registering a mark with the TMCH is an important first step in obtaining trademark protection in new gTLDs. However, trademark holders may also wish to explore additional mechanisms available under the 2012 new gTLD program to ensure maximum protection, whether that is actually participating in a TLD's Sunrise Period, purchasing one of the various additional trademark protection programs offered by a TLD, pursuing the desired name in the URS, or obtaining the name through a UDRP action.

CONCLUSION

In light of the evolution of the USPTO's policies and ICANN's trademark protections, it is an exciting time to be involved with the protection of trademarks as they relate to domain names. ICANN's 2012 new gTLD program undoubtedly changed the mechanisms trademark owners have to protect their marks from third parties who would otherwise seek to obtain those domain names. With the launch of ICANN's new program, the complexity of how and when to protect a mark has, however,

of the IDN TLDs applied for). Some of the new gTLDs are "International Domain Names" ("IDNs"). IDNs use character sets such as Chinese, Arabic, Cyrillic, or any other characters outside US-ASCII, e.g., "大拿" is VeriSign's IDN for Chinese (Hans/Simplified) transliteration of "dot net".

122. See Pat Kane, *Update on Verisign's IDN Implementation Plans*, VERISIGN (July 12, 2013), http://blogs.verisigninc.com/blog/entry/update_on_verisign_s_idn, [<http://perma.cc/Y96L-T8LN>].

123. See *Domain Matching Program*, ICM REGISTRY, <http://icmregistry.com/about/policies/domain-matching-program/>, [<http://perma.cc/9SJF-RJZ5>] (last visited Feb. 19, 2014).

124. See *id.*

increased. The strategy many trademark owners have historically used, simply purchasing their corresponding domain names in each of the TLDs that existed and “parking” them or directing them to their flagship website, may no longer be economically feasible. Moreover, for the new gTLDs that are pertinent to a trademark holder’s industry it is likely less expensive to obtain the desired domain name(s) in a TLD’s Sunrise Period, or “block” the desired domain name(s) pursuant to programs offered in a particular TLD, rather than engage in the variety of post-registration legal pursuits. In any event, it will be interesting to observe how the USPTO’s growing awareness of the significance of new gTLDs as source-identifiers either mirrors or leads consumer awareness of the same. For better or for worse, the next wave of trademark protection online has officially begun and both the USPTO and ICANN are embracing and leading these endeavors, as are intellectual property communities, registry operators and soon, consumers themselves.