



Newsletter

OCTOBER 2005

Professional Legal Assistors

22647 Ventura Blvd.

363

Woodland Hills, CA 91364-1416

(818)347-0101 / (800)621-7008

Toll Free Fax (888)232-9022

Email: dottie@biz-usa.com

Visit us at

<http://www.biz-usa.com>

Our office will be closed for the following holidays:

October 10th, 2005 – Columbus Day

November 24th – 25th, 2005 – Thanksgiving

Our next newsletter will be mailed out the beginning of January 2006.

Remember if you have an article that you would like to contribute to our newsletter just fax it to us for our review. We must receive the article no later than December 15th for our January newsletter.

INSIDE THIS ISSUE

- 1 **Help Katrina Victims Directly – Trademarks
Composed, in Whole or in Part, of Domain Names**

HELP KATRINA VICTIMS DIRECTLY

www.nickmancini.com/katrina

We have received a lot of emails from all over the United States everyone is having a fund raiser to benefit the victims. I cannot get the question answered "Where do the victims go to get assistance from these fund raisers"? No one knows. The Los Angeles Times featured an article on September 25, 2005 entitled The Red Cross Money Pit. Money goes in but it doesn't get distributed.

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

Introduction and Background

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



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

A domain name is usually preceded in a URL

"http://www." The "http://" refers to the protocol used to transfer information, and the "www" refers to World Wide Web, a graphical hypermedia interface for viewing and exchanging information. There are two types of TLDs: generic and country code.

Generic TLDs

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

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

Country Code TLDs

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

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

Proposed TLDs

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

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

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

Applications for registration of marks composed of domain names

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

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

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

Use as a Mark

A mark composed of a domain name is registrable as a trademark or service mark only if it functions as a

a source identifier. The mark as depicted on the specimens must be presented in a manner that will be perceived by potential purchasers as indicating source and not as merely an informational indication of the domain name address used to access a web site.

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

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

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

This is not to say that, if used appropriately, the asserted mark or portions thereof may not be trademarks or [service marks]. For example, if applicant's law firm name were, say, EILBERG.COM and were presented prominently on applicant's letterheads and business cards as the name under which applicant was rendering its legal services, then that mark may well be registrable.

The examining attorney must review the specimens in order to determine how the proposed mark is actually used. It is the perception of the ordinary customer that determines whether the asserted mark functions as a mark, not the applicant's intent, hope or expectation that it do so.

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

language referring to the domain name as an address, or a domain name displayed merely as part of the information on how to contact the applicant.

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

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

Refusal of registration

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

If the applicant seeks registration on the Supplemental Register, the examining attorney must refuse registration.

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

Advertising one's own products or services is not a service. Therefore, businesses that create a web site for the sole purpose of advertising their own products or services cannot register a domain name used to identify that activity. In examination, the issue usually arises when the applicant describes the activity as a registrable service, e.g., "providing information about [a particular field]," but the specimens of use make it clear that the web site merely advertises the applicant's own products or services. In this situation, the examining attorney must refuse registration because the mark is used to identify an activity that does not constitute a "service" within the meaning of the Trademark Act.

Marks Comprised Solely of TLDs for Domain Name Registry Services

If a mark is composed solely of a TLD for "domain name registry services" (e.g., the services currently provided by Network Solutions, Inc. of registering .com domain names), registration should be refused on the ground that the TLD would not be perceived as a mark. The

examining attorney should include evidence from the NEXIS® database, the Internet, or other sources to show that the proposed mark is currently used as a TLD or is under consideration as a new TLD.

If the TLD merely describes the subject or user of the domain space, registration should be refused on the ground that the TLD is merely descriptive of the registry services.

Descriptiveness

If a proposed mark is composed of a merely descriptive term(s) combined with a TLD, the examining attorney should refuse registration on the ground that the mark is merely descriptive. This applies to trademarks, service marks, collective marks and certification marks.

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

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

The TLD will be perceived as part of an Internet address, and does not add source identifying significance to the composite mark.

Generic Refusals

If a mark is composed of a generic term(s) for applicant's goods or services and a TLD, the examining attorney must refuse registration on the ground that the mark is generic and the TLD has no trademark

significance.

Marks comprised of generic terms combined with TLDs are not eligible for registration on the Supplemental Register, or on the Principal Register.

This applies to trademarks, service marks, collective marks and certification marks.

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

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

The examining attorney generally should not issue a refusal in an application for registration on the Principal Register on the ground that a mark is a generic name for the goods or services unless the applicant asserts that the mark has acquired distinctiveness. Absent such a claim, the examining attorney should issue a refusal on the ground that the mark is merely descriptive of the goods or services and provide an advisory statement that the matter sought to be registered appears to be a generic name for the goods or services.



There is, and always has been, one tremendous ruler of the human race – and that ruler is that combination of the opinions of all, the leveling up of universal sense which is called public sentiment. That is the ever-present regulator and police of humanity.

Thomas B. Reed

Professional Legal Assistors
22647 Ventura Blvd.
363
Woodland Hills, CA 91364-1416

ADDRESS SERVICE REQUESTED

FIRST-CLASS
MAIL
U.S. POSTAGE
PAID
CANOGA PARK
91304
PERMIT No. 490