

Litigating Trademark Infringement Claims Related to Domain Name & Meta Data Disputes

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I. INTRODUCTION

Assembling a paper involving legal issues and the Internet is not entirely unlike assembling a pre-season Top 25 list for college football. A lot can happen in a short period of time and before you know it, those words of wisdom you put down on paper back in August will start to look really dated and really stupid. As such, you will find that this particular paper is, at best, an overview of issues you should consider when advising your clients on trademarks matters. Whenever possible, this paper will direct your attention to online sources whose rules, regulations and other bits of information are likely to change over time. Please consult these sources for the most up to date information.

II. TRADEMARKS

A trademark is any word, name, symbol, or device, or combination thereof, that is used by a person to identify and distinguish his goods from the goods of others and to indicate the source of the goods, even if that source is unknown.¹ A service mark is any word, name, symbol, or device, or combination thereof, that is used by a person to identify and distinguish his services from the services of others and to indicate the source of the services, even if that source is unknown.² Despite the technical differences between a trademark and a service mark, the word “trademark” is commonly used to refer to both and will be used as such throughout this paper.

Only distinctive trademarks are entitled to protection. In determining whether a trademark is entitled to protection, courts have employed several approaches, including the categorization of the mark as either generic, descriptive, suggestive, or arbitrary.³ A generic trademark is one that refers to the common name or the nature of an article, and most courts hold that it is not entitled to trademark protection.⁴ A descriptive trademark designates the characteristics, qualities, effects, or other features of the product and is protectable only if shown to have become distinctive, that is, shown to have acquired “secondary meaning”.⁵ Suggestive trademarks, which require imagination to reach a conclusion as to the nature of the goods, and arbitrary or fanciful trademarks, which are inherently distinctive, are entitled to immediate protection, without establishing secondary meaning.⁶

Secondary meaning is an association formed in the minds of consumers between the mark and the source or origin of the product.⁷ Although the test as to whether secondary meaning has been established is apparently not uniform among the circuits, the ultimate inquiry is whether in the consumer’s mind the mark denotes a “single thing coming from a single source.”⁸

¹ 15 U.S.C. § 1127.

² Id.

³ Co-Rect Products, Inc. v. Marvy! Advertising Photography, Inc., 780 F.2d 1324, 1329 (8th Cir. 1985).

⁴ Id.

⁵ Id.

⁶ Id.

⁷ Co-Rect Products, 780 F.2d at 1330.

⁸ Id.

III. DOMAIN NAMES

Internet web sites are identified by a long string of numbers that most of us would find difficult to remember. Fortunately, some very smart people came up with the Domain Name System (“DNS”) which allows these difficult to remember numbers to be converted into easier to remember words known as domain names. When an Internet user types these easier to remember domain names into a web browser, the DNS, through a process too complicated to explain in this short paper, converts the words back into the difficult to remember numbers and connects the user to the desired web site. For lack of a better example, think of a domain name as the Internet equivalent of remembering the telephone number 1-800-CALL-ATT rather than 1-800-225-5288.

A domain name consists of two primary levels. The first level, also called the top level, is intended to identify the type of entity that is operating the web site. The most widely recognized top level domains, and their intended uses, are as follows:

- .com (commercial, for profit organizations)
- .edu (four 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)

The following top level domains were approved on November 16, 2000, and should be in active use in the foreseeable future:

- .aero (members of the air transport industry and civil aviation sector)
- .biz (businesses)
- .coop (business cooperatives)
- .info (unrestricted)
- .museum (museums)
- .name (individuals for personal use)
- .pro (professionals such as doctors, lawyers and accountants)

The second level of a domain name is the portion immediately to the left of the top level domain. The second level domain is often comprised of one or more words which describe the purpose or subject matter of the web site. By way of example, in the domain name www.travel.com, the second level domain “travel” allows the user to immediately guess that the web site would be a logical place to find travel related information or services. As you might imagine, some of the most valuable domain names are comprised of words that would not qualify for trademark protection because they are generic or descriptive and lacking secondary meaning. By way of example, and at the risk of causing you to pound your head against your desk while quietly muttering “stupid, stupid, stupid” over and over again, Bank of America

purchased the domain name www.loans.com at an online auction on January 28, 2000, for the modest sum of \$3 million.⁹

The second level domain name is also the place where trademark owners often desire to insert their trademarks so that Internet users can readily access their web site to find information about their well known goods or services. By way of example, in the domain name www.nike.com, the second level domain is comprised of the famous trademark NIKE. The use of trademarks as second level domains is a common source of conflict on the Internet. To understand the problem, bear in mind that each domain name is unique and can be used by only one owner – just like a telephone number can be used by only one owner.

By contrast, trademarks can be owned and used by multiple owners on a wide range of different goods and services, provided that the multiple uses do not create a likelihood of consumer confusion or dilute a famous trademark. A problem arises when more than one owner wants to use “their” trademark as a second level domain in combination with the same first level domain. Unfortunately, trademark rights acquired through years of use, a mountain of goodwill, and even federal registration, do not necessarily entitle the trademark owner to use his trademark as a second level domain if someone else with a valid interest in the same trademark has beat him to the punch.

IV. ICANN

The Internet Corporation for Assigned Names and Numbers (“ICANN”) is a nonprofit, private sector corporation formed by a broad coalition of the Internet’s business, technical, academic and user communities. ICANN was created in response to a June 1998 white paper (“White Paper”), issued by the United States Department of Commerce (“DOC”). The White Paper “provides the U.S. Government's policy regarding the privatization of the domain name system in a manner that allows for the development of robust competition and that facilitates global participation in the management of Internet names and addresses.”¹⁰ The White Paper identified four guiding principles for transferring U.S. Government management of the DNS to a new entity:

1. **Stability.** The U.S. Government should end its role in the Internet number and name address system in a manner that ensures the stability of the Internet. The introduction of a new management system should not disrupt current operations or create competing root systems. During the transition and thereafter, the stability of the Internet should be the first priority of any DNS management system. Security and reliability of the DNS are important aspects of stability, and as a new DNS management system is introduced, a comprehensive security strategy should be developed.

⁹The Bank of America press release can currently be viewed through the Bank of America web site at www.bankofamerica.com/newsroom/press/press.cfm?PressID=press.20000208.01.htm.

¹⁰ The White Paper can currently be found at www.ntia.doc.gov/ntiahome/domainname/6_5_98dns.htm

2. Competition. The Internet succeeds in great measure because it is a decentralized system that encourages innovation and maximizes individual freedom. Where possible, market mechanisms that support competition and consumer choice should drive the management of the Internet because they will lower costs, promote innovation, encourage diversity, and enhance user choice and satisfaction.

3. Private, Bottom-Up Coordination. Certain management functions require coordination. In these cases, responsible, private-sector action is preferable to government control. A private coordinating process is likely to be more flexible than government and to move rapidly enough to meet the changing needs of the Internet and of Internet users. The private process should, as far as possible, reflect the bottom-up governance that has characterized development of the Internet to date.

4. Representation. The new corporation should operate as a private entity for the benefit of the Internet community as a whole. The development of sound, fair, and widely accepted policies for the management of DNS will depend on input from the broad and growing community of Internet users. Management structures should reflect the functional and geographic diversity of the Internet and its users. Mechanisms should be established to ensure international participation in decision making.¹¹

These guiding principles were subsequently adopted in a Memorandum of Understanding (“MOU”) entered into between the DOC and ICANN on November 25, 1998.¹² The MOU also states that the business purpose of ICANN is to:

- (i) coordinate the assignment of Internet technical parameters as needed to maintain universal connectivity on the Internet;
- (ii) perform and oversee functions related to the coordination of the Internet Protocol (IP) address space;
- (iii) perform and oversee functions related to the coordination of the Internet domain name system, including the development of policies for determining the circumstances under which new top-level domains are added to the DNS root system;
- (iv) oversee operation of the authoritative Internet DNS root server system; and
- (v) engage in any other related lawful activity in furtherance of Items (i) through (iv).¹³

¹¹ Id.

¹² The MOU can currently be found at www.ntia.doc.gov/ntiahome/domainname/icann-memorandum.htm.

¹³ Id.

To be clear, ICANN does not “run” the Internet. It has been assigned specific managerial and policy development task related to the assignment of the Internet’s unique name and number identifiers. Further information regarding the purpose and organizational structure of ICANN can be accessed through its web site www.icann.org.

V. REGISTERING A TRADEMARK

Not every use of a word, name, symbol or device qualifies the would-be trademark for registration with the United States Patent and Trademark Office. The Lanham Act provides the following guidance:

The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce –

(1) on goods when -

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.¹⁴

These limitations apply regardless of whether the word, name, symbol or device is used in the real world of tags, labels and magazine advertisements or the electronic world of the Internet. A trademark composed of a domain name will qualify for registration only if it functions as a source identifier. The trademark as depicted on the specimens of use 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.¹⁵

When examining an application to register a trademark for use on goods, the USPTO will generally expect the applicant to submit tags, labels, wrappers or other materials used to package the goods. Advertisement and other promotional materials are generally not acceptable as specimens of use for trademark applications covering goods. However, some wiggle room can be found in the words “or the displays associated therewith”. This language has been interpreted to include banners, window displays, menus and similar materials, provided that the materials are designated to catch the attention of purchaser and prospective purchasers as an inducement to

¹⁴ 15 U.S.C. § 1127.

¹⁵ See In re Eilberg, 49 USPQ2d 1955 (TTAB 1998). See also, USPTO Examination Guide No. 2-99, Marks Comprised, in Whole or in Part, of Domain Names (September 29, 1999), attached hereto as Appendix 1.

consummate a sale, the materials prominently display the trademark and associate it with the goods, and the materials are related to the sale of the goods in such a way that an association with the two is inevitable.¹⁶

Close to hitting the target of this paper, the Trademark Trial and Appeal Board has held that the use of a trademark during a television infomercial may under some circumstances constitute a display associated with the sale of the goods.¹⁷ This holding could be viewed to support the position that the use of a trademark on a web site, in connection with the sale of goods via that web site, could constitute a display associated with the goods, thereby qualifying the trademark for federal registration. To the extent that alternative specimens of use are available for submission by the applicant, there would seem to be no compelling reason to push the envelope with the USPTO and the more traditional specimens should probably be submitted. However, if use of the trademark on the applicant's web site is the applicant's only current and anticipated future use of the trademark, then there would appear to be at least a good faith argument of use in commerce available to the applicant.

Since services are obviously not tangible items to which labels or tags may be affixed, the specimen requirements to support a trademark registration covering services are different than those required to support a trademark registration covering goods.¹⁸ Generally, the applicant is allowed to submit a wide range of advertising materials such as newspaper advertisements, magazine advertisements, brochures, billboards, handbills, direct mail leaflets and the like.¹⁹ In theory, use of a trademark on the applicant's web site to promote the applicant's services should be equivalent to use of the trademark on other forms of promotional materials and should support an application to register the trademark..

The bigger issue would appear to be whether or not the application recites a bona fide service being offered by the applicant. To qualify as a bona fide service, an activity must be for the benefit of someone other than the trademark applicant.²⁰ A company which promotes the sale of its own goods or services is doing so for its own benefit and is not rendering a service for others.²¹ For example, an applicant that maintains a web site for the purpose of promoting the sale of its lawn care products will most likely be unsuccessful in registering its trademark for use in connection with the service of "providing information regarding lawn care products via a web site."

However, to the extent that the web site at issue also provides information regarding topics other than the applicant's goods, then the trademark may qualify for registration in connection with the service of providing the additional information. For example, if the same applicant maintains a web site which contains information regarding the proper time of year to plant flowers and apply chemicals, then the applicant may have success in registering its

¹⁶ Trademark Manual of Examining Procedure (TMEP) § 905.06. The full text of the TMEP is currently available via the USPTO web site at www.uspto.gov/web/offices/tac/tmep.

¹⁷ In re Hydron Technologies Inc., 51 USPQ2d 1531 (TTAB 1999).

¹⁸ TMEP § 1301.04

¹⁹ Id.

²⁰ TMEP § 1301.01(a)(ii).

²¹ Id.

trademark for use in connection with the service of “providing information regarding gardening and lawn care via a web site.”²²

Even assuming that the applicant can meet the use in commerce criteria, the trademark at issue will still need to meet the standard criteria of a trademark that is either arbitrary, suggestive or descriptive with secondary meaning in order to qualify for federal registration. To that end, it should be noted that a generic or descriptive trademark will not qualify for federal registration simply because it has been combined with a top level domain. In other words, if a trademark consists of a generic or descriptive word combined with the top level domain, the addition of the top level domain will be viewed as bringing nothing to the party, and the application will be rejected on the grounds that the trademark is generic or merely descriptive. To that end, the USPTO has indicated that the would-be trademarks TURKEY.COM for use on turkeys and BANK.COM for use on banking services would be refused registration.²³ In short, although the owner of a descriptive trademark used on a web site will remain free to argue against a descriptiveness refusal by seeking to establish secondary meaning, he will not avoid that refusal simply by tacking a top level domain onto his otherwise descriptive trademark.

Similarly, when reviewing a trademark application, the USPTO will generally disregard the use of a top level domain in the specimens and will allow registration of the second level domain regardless of whether it is actually used with the top level domain²⁴. By way of example, if the drawing page of the application depicts the trademark as XYZ, but the specimen depicts the mark as XYZ.COM, the USPTO will ignore the .COM component depicted on the specimen and accept the specimen as supporting registration of XYZ trademark.²⁵ It should be noted, however, that the reverse is not true. If the drawing page depicts the trademark as XYZ.COM, but the specimen depicts the trademark as XYZ, then the USPTO will reject the specimen on the basis that it does not reflect the XYZ.COM trademark depicted on the drawing page of the application.²⁶ In this situation, the applicant will remain free to amend the application by deleting the non-material .COM component of the trademark, but he will not be allowed to obtain a registration for XYZ.COM unless substitute specimens are available.²⁷

VI. REGISTERING A DOMAIN NAME

Domain name applications are filed electronically and do not involve a detailed examination process, publication, an opposition period or the issuance of a nice little certificate that your client can hang on the wall. The domain name is checked for availability, a form is filled out online, an online agreement is accepted, a credit card number is given and the applicant receives an e-mail confirming his registration.

²² Consult the USPTO Trademark Acceptable Description of Goods and Services Manual for guidance in drafting an appropriate description of services. The manual can currently be found at www.uspto.gov/web/offices/tac/doc/gsmmanual/manual.html#services

²³ USPTO Examination Guide No. 2-99.

²⁴ Id.

²⁵ Id.

²⁶ Id.

²⁷ Id.

A. Registries

A domain name “registry” is an entity that maintains the database of domain name information for a particular top level domain. The registry receives this information from registrars (see below) who accept online applications from domain name applicants.

Network Solutions, Inc. (“NSI”) has been designated as the exclusive registry for the .com, .net and .org top level domains pursuant to an agreement with ICANN dated November 10, 1999. NSI is a domain name registrar and Internet service provider located in Herndon, Virginia. NSI has previously acted as both the exclusive registry and the exclusive registrar for the .com, .net and .org top level domains. Further information regarding NSI and the .com, .net and .org registration process can be found at www.networksolutions.com.

NeuLevel, Inc. (“NeuLevel”) has been designated as the exclusive registry for the .biz top level domain pursuant to an agreement with ICANN dated May 11, 2001. NeuLevel is a joint venture between NeuStar, Inc. and Melbourne IT, Ltd., formed for the purpose of providing domain name registry services, that is located in Washington, D.C. NeuLevel is currently in the process of allocating .biz domain names to early trademark claimants. Domain names using the .biz top level domain are expected to become live and accessible on or about October 1, 2001. Further information regarding NeuLevel and the .biz registration process can be found at www.nic.biz.

Afilias Limited (“Afilias”) has been designated as the exclusive registry for the .info top level domain pursuant to an agreement with ICANN dated May 11, 2001. Afilias is an Irish limited company with offices located in Newton, Pennsylvania, whose shareholders consist of eighteen domain name registrars (including NSI) located throughout the world. Afilias is currently in the process of allocating .info domain names to early trademark claimants. Domain names using the .info top level domain are expected to become live and accessible on or about September 19, 2001. Further information regarding Afilias and the .info registration process can be found at www.afilias.info.

Global Name Registry, a technology infrastructure company located in London, has been designated as the exclusive registry for the .name top level domain pursuant to an agreement with ICANN dated August 1, 2001. As of the date of this paper, ICANN has not yet accepted any .name domain name applications but it hopes to do so yet this year. Further information regarding Global Name Registry and the .name registration process can be found at www.theglobalname.org.

Information available as of the date of this paper suggests that operators or sponsors for the .aero, .coop, .museum and .pro top level domains have been selected but have not yet entered into formal agreements with ICANN. Further information will be made available on the operator or sponsor web sites located at www.sita.int (.aero), www.ncba.org (.coop), www.musedoma.org (.museum) and www.registrypro.com (.pro).

B. Registrars

A domain name “registrar” is an entity that accepts online applications from domain name applicants and forwards this information to domain name registries for inclusion in the applicable domain name registry. Domain name registrars offer a wide range of fees and ancillary services. As of the date of this paper, the ICANN web site lists 82 operational registrars that have been accredited by ICANN to accept applications for the .com, .net and .org top level domains and another 71 registrars that have been accredited but that are not yet operational.²⁸ Registrars that have been accredited by ICANN will not be allowed to accept applications for the new top level domains until they enter into a new registrar accreditation agreement with ICANN.²⁹

VII. TRADEMARK INFRINGEMENT AND DILUTION

In many respects, familiar rules regarding trademark infringement and dilution claims will apply with respect to the use of trademarks on the Internet. For claims arising under federal law, the focus will continue to remain on Sections 32 and 43 of the Lanham Act.³⁰

A. Infringement

The plaintiff in a trademark infringement litigation is not required to demonstrate that the defendant’s use of a similar trademark has created actual confusion. Instead, the cornerstone issue is whether or not a “likelihood of confusion” exists between the plaintiff’s trademark and the defendant’s trademark. In the context of trademarks protected by a federal registration, Section 32 provides that the issue is whether or not the defendant’s use of its trademark “is likely to cause confusion, or to cause mistake, or to deceive”.³¹ In the context of unregistered trademarks, Section 45 provides that the issue is whether or not the defendant’s use of its trademark “is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person”.³²

In evaluating whether or not a likelihood of confusion exists, no one factor is determinative of the issue. Instead, the court will evaluate a variety of factors which can generally be categorized as follows: (1) the strength of the plaintiff’s trademark, (2) the degree of similarity between the plaintiff’s trademark and the defendant’s trademark, (3) the degree of competition between the plaintiff’s goods or services and the defendant’s goods or services, (4) whether or not the defendant intended to pass off its goods or services as the goods or services of the plaintiff, (5) whether or not any actual confusion has been found to exist between the

²⁸ A list of ICANN accredited registrars, including links to their respective web sites, is currently available on the ICANN web site at www.icann.org/registrars/accredited-list.html.

²⁹ Further information is currently available on the ICANN web site at www.icann.org/registrars/accreditation.htm

³⁰ 15 U.S.C. §§ 1114 and 1125; the current text of Sections 32 and 43 are attached to this paper as Appendix 2.

³¹ 15 U.S.C. § 1114(1)(a).

³² 15 U.S.C. § 1125(a)(1)(A).

plaintiff's trademark and the defendant's trademark, and (6) the degree of consumer care exercising in purchasing the goods or services at issue.³³

B. Dilution

The concept of dilution acknowledges that the owner of a famous trademark may be damaged by a third party use of that trademark even if consumers are not confused as to the origin, sponsorship or approval of the third party goods or services. To protect the owners of famous trademarks against dilution, Section 43 of the Lanham Act was amended by the Federal Trademark Dilution Act in 1996 to specifically include a cause of action for trademark dilution.³⁴

The term "dilution" is defined as the lessening of the capacity of a famous trademark to identify and distinguish goods or services, regardless of the presence of competition between the owner of the famous trademark and the other party or the likelihood of confusion, mistake or deception.³⁵ In determining whether or not a trademark is distinctive and famous, the court may consider the following non-exclusive factors:

- (i) the degree of inherent or acquired distinctiveness of the trademark;
- (ii) the duration and extent of use of the trademark in connection with the goods or services with which the trademark is used;
- (iii) the duration and extent of advertising and publicity of the trademark;
- (iv) the geographical extent of the trading area in which the trademark is used;
- (v) the channels of trade for the goods or services with which the trademark is used;
- (vi) the degree of recognition of the trademark in the trading areas and channels of trade used by the trademark's owner and the person against whom the injunction is sought;
- (vii) the nature and extent of use of the same or similar trademarks by third parties; and
- (vii) whether the trademark has been registered on the principal register of the United States Patent and Trademark Office.³⁶

Although the Federal Trademark Dilution Act provides a powerful weapon to the owner of famous trademarks, it should be noted that a federal dilution plaintiff is entitled only to

³³ Squirtco v. Seven-Up Co., 628 F.2d 1086, 1091 (8th Cir. 1980).

³⁴ 15 U.S.C. § 1125(c).

³⁵ 15 U.S.C. § 1127.

³⁶ 15 U.S.C. § 1125(c)(1).

injunctive relief unless the defendant is found to have willfully intended to trade on the trademark owner's reputation or to cause dilution of the famous trademark.

VIII. ANTICYBERSQUATTING CONSUMER PROTECTION ACT

Principles of trademark infringement and dilution fail to neatly wrap themselves around the concept of cybersquatting because the cybersquatter generally does not register the offending domain name for the purpose of engaging in use in commerce, creating a likelihood of confusion or diluting the distinctiveness of a famous trademark. Instead, the cybersquatter generally registers the domain name for the purpose of selling it to a valid trademark owner or simply sitting on it to the detriment of a valid trademark owner. In addition, the anonymity that often surrounds Internet activity can inhibit the ability of trademark owners to locate and exercise their legal rights against the cybersquatter.

To protect trademark owners against cybersquatting, Section 43 of the Lanham Act was amended in 1999 by the Anticybersquatting Consumer Protection Act ("ACPA") to specifically include a cause of action for cybersquatting. The ACPA provides that a person shall be liable to the owner of a trademark, including a personal name which is protected as a trademark, if that person has a bad faith intent to profit from the trademark and "registers, traffics in, or uses a domain name" that (1) is identical or confusingly similar to a distinctive trademark or (2) is identical, confusingly similar or dilutive of a famous trademark.³⁷ The term "traffics in" is defined to include, but not be limited to, "sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration."³⁸

In determining whether a person has a "bad faith intent", the court may consider the following non-exclusive factors:

- (i) the trademark or other intellectual property rights of the person, if any, in the domain name;
- (ii) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;
- (iii) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;
- (iv) the person's bona fide noncommercial or fair use of the trademark in a site accessible under the domain name;
- (v) the person's intent to divert consumers from the trademark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the trademark, either for commercial gain or with the intent to

³⁷ 15 U.S.C. § 1125(d)(1)(A).

³⁸ 15 U.S.C. § 1125(d)(1)(E).

tarnish or disparage the trademark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(vi) the person's offer to transfer, sell, or otherwise assign the domain name to the trademark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(vii) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(viii) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to trademarks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(ix) the extent to which the trademark incorporated in the person's domain name registration is or is not distinctive and famous.³⁹

The ACPA expressly states that bad faith intent shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.⁴⁰

In an effort to protect trademark owners against the actions of anonymous third parties, the ACPA provides for an in rem action against a domain name in the event that the trademark owner is unable to obtain personal jurisdiction over a proper defendant or the trademark owner is unable to locate a person who would be a defendant.⁴¹ In an in rem action under the ACPA, the domain name is deemed to have its situs in the judicial district in which (1) the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located, or (2) documents sufficient to establish control and authority regarding the disposition of the registration and use of the domain name are deposited with the court.⁴² The ACPA provides that service of process may be performed by (1) sending a notice of the alleged violation and intent to proceed under the ACPA to the postal address and e-mail address provided by the domain name registrant to the registrar, and (2) publishing notice of the action as directed by the court.⁴³

The ACPA specifically authorizes the court to order the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the trademark at issue.⁴⁴ In the

³⁹ 15 U.S.C. § 1125(d)(1)(B)(i).

⁴⁰ 15 U.S.C. § 1125(d)(1)(B)(ii).

⁴¹ 15 U.S.C. § 1125(d)(2)(A).

⁴² 15 U.S.C. § 1125(d)(2)(C).

⁴³ 15 U.S.C. § 1125(d)(2)(B).

⁴⁴ 15 U.S.C. § 1125(d)(1)(C).

case of in rem actions, it should be noted that remedies are expressly limited to forfeiture, cancellation or transfer of the domain name.⁴⁵

IX. UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY

In an effort to provide an alternative to federal litigation, ICANN has adopted the Uniform Domain Name Dispute Resolution Policy (“UDRP”).⁴⁶ The UDRP provides a mechanism through which a trademark owner can secure a relatively quick and cost effective transfer of a domain name that is being held by a party that does not hold a legitimate interest in the domain name. ICANN is not directly involved in the administration of disputes under the UDRP. Instead, proceedings brought under the UDRP are decided by approved dispute resolution service providers (“Providers”) in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (“Rules”)⁴⁷ and the supplemental rules of the applicable Provider. As of the date of this paper, there are four approved Providers. The supplemental rules and fee schedules for each of the Providers can be accessed via their web sites:

- CPR Institute for Dispute Resolution (www.cpradr.org)
- eResolution (www.eresolution.ca)
- The National Arbitration Forum (www.arbforum.com)
- World Intellectual Property Organization (www.wipo.int)

The proceeding is initiated by the trademark owner (“Complainant”) sending a complaint to one of the Providers together with the required fee. The complaint must state that a copy of the complaint, together with the cover sheet prescribed by the Provider’s supplemental rules, has been sent or transmitted to the domain name holder (“Respondent”).

A. Complaint

The complaint must be submitted both electronically and in hard copy. The complaint may relate to more than one domain name, provided that the domain names are registered by the same Respondent.⁴⁸ Section 3 of the Rules sets forth the required content of the complaint, but the key elements that must be established by the Complainant are:

- (i) the domain name(s) at issue are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in the domain name(s) at issue; and

⁴⁵ 15 U.S.C. § 1125(d)(1)(D)(i).

⁴⁶ The full text of the UDRP is currently available online at www.icann.org/udrp/udrp-policy-24oct99.htm and is attached to this paper as Appendix 3.

⁴⁷ The full text of the UDRP Rules is currently available online at www.icann.org/udrp/udrp-rules-24oct99.htm and is attached to this paper as Appendix 4.

⁴⁸ UDRP Rules § 3(c).

(iii) the domain name(s) at issue have been registered and are being used in bad faith.

In order to prevail under the UDRP, the Complainant must prove that all three of these elements are present.⁴⁹ The following circumstances, without limitation, are expressly identified in the UDRP as evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that Respondent has registered or acquired 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 or to a competitor of that Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name;
- (ii) the Respondent has registered the domain name in order to prevent the Respondent from reflecting the trademark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business of the Complainant; or
- (iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's web site or other on-line location, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on the Respondent's web site or location.⁵⁰

In the event that the Provider finds the compliant to be administratively deficient, it will notify the Complainant and the Respondent of the nature of the deficiencies, and the Complainant will have five (5) calendar days within which to correct the deficiencies, after which the proceeding will be withdrawn without prejudice to submit a different complaint.⁵¹ The date of commencement of the proceeding is the date on which the Provider fulfills its obligation to serve a copy of the complaint on the Respondent.⁵² The Provider is required to achieve actual notice or to employ reasonably available means calculated to achieve actual notice.⁵³ The Provider will immediately notify the Complainant, the Respondent, the applicable Registrar(s) and ICANN of the date of the commencement of the proceeding.

B. Response

⁴⁹ UDRP § 4(a).

⁵⁰ UDRP § 4(b).

⁵¹ UDRP Rules § 4(b).

⁵² UDRP Rules § 4(c).

⁵³ UDRP Rules § 2(a).

The Respondent is required to respond to the complaint within twenty (20) days after the commencement of the proceeding. Section 5 of the Rules sets forth the required content of the response, but the key obligation of the Respondent is to respond specifically to the statements and allegations contained in the complaint and to include any and all bases for the Respondent to retain registration of the disputed domain name.⁵⁴ If drafting a response, it should be kept in mind that the following circumstances, without limitation, are expressly identified in the UDRP as demonstrating the Respondent's right or legitimate interests in a domain name:

- (i) prior to receiving notice of the dispute, the Respondent made use of, or made demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;
- (ii) the Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) The Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.⁵⁵

At the request of the Respondent, the Provider may, in exceptional circumstances, extend the period of time for filing of the response.⁵⁶ The response period may also be extended by written stipulation between the parties, provided the stipulation is approved by the Provider.⁵⁷ If the Respondent does not file a response, in the absence of exceptional circumstances, the proceeding will be determined based upon the complaint.⁵⁸

C. Panel Proceedings

The decision on the complaint is made by a panel ("Panel") consisting of a single panelist or, if requested by either party, a Panel consisting of three panelists. All fees charged by the Provider are paid by the Complainant unless the Respondent requests to expand the Panel from one to three panelists, in which case all fees are split evenly between the Complainant and the Respondent.⁵⁹ Each Provider is required to maintain and publish a list of panelists and their qualifications.⁶⁰ If neither party has elected a three member Panel, the provider is required to appoint a single panelist within five (5) calendar days after receiving the response from the Respondent.⁶¹

If the Complainant elects a three member Panel, then the Complainant is required to include with the complaint a list of three panelist candidates to serve on the Panel and the

⁵⁴ UDRP Rules § 5(b)(i).

⁵⁵ UDRP § 4(c).

⁵⁶ UDRP Rules § 5(d).

⁵⁷ Id.

⁵⁸ UDRP Rules § 5(c).

⁵⁹ UDRP § 4(g); UDRP Rules § 6(b), 6(c) and 19.

⁶⁰ UDRP Rules § 6(a).

⁶¹ UDRP Rules § 6(b).

Respondent is required to include with the response its own list of three panelist candidates.⁶² If the Respondent elects a three member Panel, then the Respondent is required to include with the response a list of three panelist candidates and the Complainant is required to submit a list of three panelist candidates within five (5) days after receiving the response.⁶³

In appointing a three member Panel, the Provider will endeavor to appoint one panelist from each party's list of panelist candidates.⁶⁴ However, in the event that the Provider is unable to secure one of the panelist candidates within five (5) calendar days, the Provider will appoint a panelist from its own list of panelists.⁶⁵ The third panelist is appointed by the Provider from a list of five candidates submitted by the Provider to the parties, with the selection being made in a manner that reasonably balances the preferences of both parties as they may provide to the Provider within five (5) calendar days after receiving the list of candidates from the Provider.⁶⁶

Neither party, nor anyone acting on behalf of either party, may have any unilateral communications with the Panel.⁶⁷ All communications between a party and the Panel or the Provider must be made to a case administrator appointed by the Provider in the manner prescribed in the Provider's supplemental rules.⁶⁸ There is no in-person hearings (including hearings by teleconference, videoconference, and web conference), unless the Panel determines, in its sole discretion and as an exceptional matter, that such a hearing is necessary for deciding the complaint.⁶⁹

The Panel decides the complaint on the basis of the statements and documents submitted and in accordance with the UDRP, the Rules and any rules and principles of law that it deems applicable.⁷⁰ In the absence of exceptional circumstances, the Panel is required to forward its decision on the complaint to the Provider within fourteen (14) days of its appointment.⁷¹ In the case of a three-member Panel, the Panel's decision is made by a majority.⁷² The Panel's decision is made in writing, provides the reasons on which it is based, indicates the date on which it was rendered and identifies the name(s) of the Panelist(s).⁷³

⁶² UDRP Rules §§ 3(b)(iv) and 5(b)(v).

⁶³ UDRP Rules §§ 5(b)(v) and 6(d).

⁶⁴ UDRP Rules § 6(e).

⁶⁵ Id.

⁶⁶ Id.

⁶⁷ UDRP Rules § 8.

⁶⁸ Id.

⁶⁹ UDRP Rules § 13.

⁷⁰ UDRP Rules § 15(a).

⁷¹ UDRP Rules § 15(b).

⁷² UDRP Rules § 15(c).

⁷³ UDRP Rules § 15(d). Panel decisions are currently published on ICANN's web site at www.icann.org and are also available on Lexis.⁷³ (select "Area of Law – By Topic", select either "Cyberlaw" or "E-Commerce", and then select "Domain Disputes").

D. Remedies

The remedies available under the UDRP are limited to cancellation or transfer of the domain name from the Respondent to the Complainant.⁷⁴ The availability of administrative relief under the UDRP does not prevent either party from submitting the dispute to a court of competent jurisdiction.⁷⁵ In the event that either party initiates legal proceedings prior to or during the administrative proceeding, the Panel has the discretion to decide whether to suspend or terminate the administrative proceeding or to proceed to a decision.⁷⁶ If the Panel decides that the disputed domain name should be cancelled or transferred, ICANN will wait ten (10) business days after it is informed of the Panel's decision before implementing that decision.⁷⁷ During that ten (10) day period, the Respondent will have an opportunity to submit documentation that it has filed a lawsuit in a jurisdiction to which the Complainant has submitted to jurisdiction pursuant to the Rules.⁷⁸ If the Respondent submits documentation that it has filed a lawsuit, the Panel's decision will not be implemented and ICANN will take no further action until it receives evidence that the dispute has been resolved by the parties, evidence that the lawsuit has been dismissed or withdrawn, or a copy of a court order.⁷⁹ In the event that the respondent does not submit documentation that it has filed a lawsuit, the Panel's decision to cancel or transfer the domain name will be implemented.⁸⁰

X. DISPUTES ON THE FRINGE

The Internet has opened the door for unanticipated forms of trademark use and misuse that does not clearly and conveniently fall within the four corners of current trademark law. The following is by no means an all-inclusive discussion of potential problem areas, but it does outline some fundamental issues that trademark attorneys should consider when advising clients who are seeking to establish a presence on the Internet.

A. Linking

Linking is the process by which an Internet user jumps from one web page or web site to another web page or web site by clicking a word, logo, picture or other graphic element. There is no per se prohibition against linking an Internet user from one web site to another web site. In fact, the ability to rapidly jump from one web page or web site to another web page or web site is one of the fundamental appeals of the Internet itself. As such, many web site operators seem to assume that they are free to link wherever and however they please.

Notwithstanding the common perception that the freedom to link is a God given right, clients should be cautioned to link their web sites to third party web sites in a manner that is clear and unambiguous. In other words, a reasonable Internet user who links from your client's web

⁷⁴ UDRP § 4(i).

⁷⁵ UDRP § 4(k).

⁷⁶ UDRP Rules § 18.

⁷⁷ UDRP § 4(k).

⁷⁸ UDRP § 4(k); UDRP Rules § 3(b)(xiii).

⁷⁹ UDRP § 4(k).

⁸⁰ UDRP § 4(k).

site to another web site should be left with the clear impression that he is leaving your client's web site and going to a third party web site that is unrelated to your client's site.

B. Deep Linking

Deep linking is the process by which an Internet user jumps from one web site "deep" into another web site, bypassing the home page of the newly visited web site. Again, as of the date of this paper, there does not appear to be any per se prohibition against deep linking. However, by skipping past the home page of the new site, the likelihood of user confusion is likely to be increased because the user may not realize that they have actually left the original site (they may believe that they have simply linked to a new web page within the original site). Again, if a client wants to deep link, they should be cautioned to do so in a clear and unambiguous manner.

C. Framing

Framing is the process by which content from a third party site is displayed through the originating site and "framed" with content from the originating site. This process differs from linking in that the user never leaves the originating site. Again, as of the date of this paper, there is no per se prohibition against framing. Nonetheless, the potential for trademark confusion is obviously quite high insofar as the user will often find his computer screen filled with trademarks belonging to the originating site as well as trademarks from the third party site. In this environment, the potential for consumer confusion as to source, origin or sponsorship would seem to be quite high.

D. Metatags

A metatag is essentially hidden code on a web site that contains information about the web site. This information is not visible during normal use of the web site but can be viewed by selecting "Source" from the "View" menu using Microsoft Explorer. Internet search engines periodically rummage through metatags and use the information in the metatags to categorize web sites by subject matter. By way of example, if a web site contained information about cooking, the metatag might contain words such as "cooking", "breakfast", "lunch", "dinner", "recipe", etc. These terms are then downloaded into the search engine databases so that Internet users who subsequently search for web sites about "cooking", "breakfast", "lunch" or "dinner" can find the relevant web site.

Trademark disputes arise when a company inserts the trademark of a competitor into the metatag of its company web site. Why would a company do this? Here's a simple example: Company A sells goods under the trademark ABC and Company X sells goods under the trademark XYZ. Both companies operate web sites on the Internet through which they promote their respective and competitive goods. Company A inserts the competitive trademark XYZ into the metatag of the Company A web site. An Internet user who sees XYZ goods advertised on television types XYZ into an Internet search engine in an effort to find web sites involving XYZ goods. Instead, the search results include the Company A web site which contains information about ABC goods. The Internet user links to the Company A web site and finds information

about ABC goods. In short, Company A gets a free ride from the publicity and goodwill generated by Company X through its advertisement of XYZ goods on television.

E. Cyberstuffing

Cyberstuffing is the act of repeatedly “stuffing” a web page with a competitor’s trademark. This is often done by repeatedly inserting the trademark into the background of a web page in the same color as the background. When stuffed as such, the trademark is invisible to the user but visible to search engines which scan the page for relevant information about the web page. Again, the motivation for this practice is to misdirect Internet traffic from a competitor’s web site to your own web site by fooling the search engine into believing that your web site contains information regarding the goods or services sold under your competitor’s trademark.

F. Keywords

The operators of some Internet search engines sell advertising space that is triggered when a user conducts a search involving one or more keywords. For example, the search engine might sell a package of keywords to Nike Inc. so that an advertisement featuring NIKE branded products would appear on the user’s computer screen whenever the user conducts a search using sports related words such as “football”, “soccer”, “running” or “basketball”. The problem arises when the search engine sells advertising space that is triggered when the Internet user conducts a search that includes a competitor’s trademark. For example, a search engine might sell a package to Nike Inc. that would cause an advertisement featuring NIKE branded products to appear on the user’s computer screen whenever the user conducts a search using competitor’s trademarks such as NEW BALANCE, ADIDAS or REEBOK.

XI. CONCLUSION

As Internet technology expands, the ability to ride the coattails of a competitor’s trademark will continue to grow in ways that will no doubt cause the adequacy of current trademark law to be stretched to its limits. Some of this coattail riding may be deemed actionable while some of it will no doubt fall between the legal cracks. As technology and legal theories continue to evolve, the amount of dedication and self education required to practice in the field of trademark law will continue to grow. Although this paper has merely scratched the surface, it has hopefully pointed you in the right direction and given you an understanding as to the scope and complexity of issues that arise when traditional concepts of trademark law collide with the rapidly changing landscape of the Internet.

USPTO EXAMINATION GUIDE NO. 2-99
September 29, 1999
MARKS COMPOSED, IN WHOLE OR IN PART, OF DOMAIN NAMES

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

I. Introduction And Background

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

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

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

Generic TLDs

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

- .com commercial, for profit organizations
- .edu 4 year, degree granting colleges/universities
- .gov U.S. federal government agencies
- .int international organizations
- .mil U.S. military organizations, even if located outside the U.S.

- .net network infrastructure machines and organizations
- .org miscellaneous, usually non-profit organizations and individuals

Country Code TLDs

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

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

Proposed TLDs

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

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

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

Applications for registration of marks composed of domain names

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

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

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

II. Use as a Mark

A. Use Applications

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

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

WILLIAM H. EILBERG
ATTORNEY AT LAW
820 HOMESTEAD ROAD, PO BOX 7
JENKINTOWN, PENNSYLVANIA 19046
215-885-4600
FAX: 215-885-4603
EMAIL: WHE@EILBERG.COM

PATENTS TRADEMARKS
AND COPYRIGHTS WWW.EILBERG.COM

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

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

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

Id. at 1956.

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

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

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

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

Refusal of registration

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

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

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

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

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

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

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

In a domain name mark (e.g., XYZ.COM or HTTP://WWW.XYZ.COM), consumers look to the second level domain name for source identification, not to the TLD or the terms "http://www." or "www." Therefore, it is usually acceptable to depict only the second level domain name on the drawing page, even if the specimens of use show a mark that includes the TLD or the terms "http://www." or "www." Cf. *Institut National des Appellations D'Origine v. Vintners Int'l Co., Inc.*, 954 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992) (CHABLIS WITH A TWIST held to be registrable separately from CALIFORNIA CHABLIS WITH A TWIST); *In re Raychem Corporation*, 12 USPQ2d 1399 (TTAB 1989) (refusal to register "TINEL-LOCK" based on specimens showing "TRO6AI-TINEL-LOCK-RING" reversed). See also 37 C.F.R. §2.51(a)(1) and TMEP §807.14 et. seq.

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

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

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

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

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

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

E. Intent-to-Use Applications

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

III. Surnames

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

IV. Descriptiveness

If a proposed mark is composed of a merely descriptive term(s) combined with a TLD, the examining attorney should refuse registration under Trademark Act §2(e)(1), 15 U.S.C.

§1052(e)(1), on the ground that the mark is merely descriptive. This applies to trademarks, service marks, collective marks and certification marks.

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

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

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

V. Generic Refusals

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

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

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

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

VI. Marks Containing Geographical Matter

The examining attorney should examine marks containing geographic matter in the same manner that any mark containing geographic matter is examined. See generally TMEP §§1210.05 and 1210.06. Depending on the manner in which it is used on or in connection with the goods or

services, a proposed domain name mark containing a geographic term may be primarily geographically descriptive under §2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2), or primarily geographically deceptively misdescriptive under §2(e)(3) of the Trademark Act, 15 U.S.C. §1052(e)(3), and/or merely descriptive or deceptively misdescriptive under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

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

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

VII. Disclaimers

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

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

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

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

Mark Disclaimer

XYZ BANK.COM BANK.COM
XYZ FEDERALBANK.COM FEDERAL BANK.COM
XYZ GROCERI STOR.COM GROCERY STORE.COM
XYZ.COM no disclaimer
XYZ.BANK.COM no disclaimer
XYZBANK.COM no disclaimer

VIII. Material Alteration

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

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

Id. at 743-44.

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

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

Adding or deleting TLDs in domain name marks

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

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

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

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

Adding or deleting TLDs in other marks

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

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

IX. Likelihood of Confusion

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

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

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

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

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

Sections 32 and 43 of the Lanham Act
(15 U.S.C. §§ 1114 and 1125)

§32 (15 U.S.C. §1114). Remedies; infringement; innocent infringers

(1) Any person who shall, without the consent of the registrant--

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy or colorably imitate a registered mark and apply such reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,

shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

As used in this paragraph, the term "any person" includes the United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, or other persons acting for the United States and with the authorization and consent of the United States, and any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. The United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, and any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this Act in the same manner and to the same extent as any nongovernmental entity.

(2) Notwithstanding any other provision of this Act, the remedies given to the owner of a right infringed under this Act or to a person bringing an action under section 43(a) or (d) shall be limited as follows:

(A) Where an infringer or violator is engaged solely in the business of printing the mark or violating matter for others and establishes that he or she was an innocent infringer or innocent violator, the owner of the right infringed or person bringing the action under section 43(a) shall be entitled as against such infringer or violator only to an injunction against future printing.

(B) Where the infringement or violation complained of is contained in or is part of paid advertising matter in a newspaper, magazine, or other similar periodical or in an electronic communication as defined in section 2510(12) of title 18, United States Code, the remedies of the owner of the right infringed or person bringing the action under section 43(a) as against the publisher or distributor of such newspaper, magazine, or other similar periodical or electronic communication shall be limited to an injunction against the presentation of such

advertising matter in future issues of such newspapers, magazines, or other similar periodicals or in future transmissions of such electronic communications. The limitations of this subparagraph shall apply only to innocent infringers and innocent violators.

(C) Injunctive relief shall not be available to the owner of the right infringed or person bringing the action under section 43(a) with respect to an issue of a newspaper, magazine, or other similar periodical or an electronic communication containing infringing matter or violating matter where restraining the dissemination of such infringing matter or violating matter in any particular issue of such periodical or in an electronic communication would delay the delivery of such issue or transmission of such electronic communication after the regular time for such delivery or transmission, and such delay would be due to the method by which publication and distribution of such periodical or transmission of such electronic communication is customarily conducted in accordance with sound business practice, and not due to any method or device adopted to evade this section or to prevent or delay the issuance of an injunction or restraining order with respect to such infringing matter or violating matter.

(D)(i)(I) A domain name registrar, a domain name registry, or other domain name registration authority that takes any action described under clause (ii) affecting a domain name shall not be liable for monetary relief or, except as provided in subclause (II), for injunctive relief, to any person for such action, regardless of whether the domain name is finally determined to infringe or dilute the mark.

(II) A domain name registrar, domain name registry, or other domain name registration authority described in subclause (I) may be subject to injunctive relief only if such registrar, registry, or other registration authority has--

(aa) not expeditiously deposited with a court, in which an action has been filed regarding the disposition of the domain name, documents sufficient for the court to establish the court's control and authority regarding the disposition of the registration and use of the domain name;

(bb) transferred, suspended, or otherwise modified the domain name during the pendency of the action, except upon order of the court; or

(cc) willfully failed to comply with any such court order.

(ii) An action referred to under clause (i)(I) is any action of refusing to register, removing from registration, transferring, temporarily disabling, or permanently canceling a domain name--

(I) in compliance with a court order under section 43(d); or

(II) in the implementation of a reasonable policy by such registrar, registry, or authority prohibiting the registration of a domain name that is identical to, confusingly similar to, or dilutive of another's mark.

(iii) A domain name registrar, a domain name registry, or other domain name registration authority shall not be liable for damages under this section for the registration or maintenance of a domain name for another absent a showing of bad faith intent to profit from such registration or maintenance of the domain name.

(iv) If a registrar, registry, or other registration authority takes an action described under clause (ii) based on a knowing and material misrepresentation by any other person that a domain name is identical to, confusingly similar to, or dilutive of a mark, the person making the knowing and material misrepresentation shall be liable for any damages, including costs and attorney's fees, incurred by the domain name registrant as a result of such action. The

court may also grant injunctive relief to the domain name registrant, including the reactivation of the domain name or the transfer of the domain name to the domain name registrant.

(v) A domain name registrant whose domain name has been suspended, disabled, or transferred under a policy described under clause (ii)(II) may, upon notice to the mark owner, file a civil action to establish that the registration or use of the domain name by such registrant is not unlawful under this Act. The court may grant injunctive relief to the domain name registrant, including the reactivation of the domain name or transfer of the domain name to the domain name registrant.

(E) As used in this paragraph--

(i) the term "violator" means a person who violates section 43(a); and

(ii) the term "violating matter" means matter that is the subject of a violation under section 43(a).

§ 43 (15 U.S.C. § 1125). False designations of origin; false description or representation

(a) (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which--

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term "any person" includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this Act in the same manner and to the same extent as any nongovernmental entity.

(3) In a civil action for trade dress infringement under this Act for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

(b) Any goods marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of goods refused entry at any customhouse under this section may have any recourse by protest or appeal that is given under the customs revenue laws or may have the remedy given by this Act in cases involving goods refused entry or seized.

(c) (1) The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial

use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection. In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to--

- (A) the degree of inherent or acquired distinctiveness of the mark;
- (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- (C) the duration and extent of advertising and publicity of the mark;
- (D) the geographical extent of the trading area in which the mark is used;
- (E) the channels of trade for the goods or services with which the mark is used;
- (F) the degree of recognition of the mark in the trading areas and channels of trade used by the mark's owner and the person against whom the injunction is sought;
- (G) the nature and extent of use of the same or similar marks by third parties; and
- (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(2) In an action brought under this subsection, the owner of the famous mark shall be entitled only to injunctive relief as set forth in section 34 unless the person against whom the injunction is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark. If such willful intent is proven, the owner of the famous mark shall also be entitled to the remedies set forth in sections 35(a) and 36, subject to the discretion of the court and the principles of equity.

(3) The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register shall be a complete bar to an action against that person, with respect to the mark, that is brought by another person under the common law or a statute of a State and that seeks to prevent dilution of the distinctiveness of a mark, label or form or advertisement.

(4) The following shall not be actionable under this section:

- (A) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.
- (B) Noncommercial use of a mark.
- (C) All forms of news reporting and news commentary.

(d)(1)(A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person--

- (i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and
- (ii) registers, traffics in, or uses a domain name that--
 - (I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;
 - (II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or
 - (III) is a trademark, word, or name protected by reason of section 706 of title 18, United States Code, or section 220506 of title 36, United States Code.

(B)(i) In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factors such as, but not limited to--

(I) the trademark or other intellectual property rights of the person, if any, in the domain name;

(II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(III) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

(IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

(V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(VI) the person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection (c)(1) of section 43.

(ii) Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.

(C) In any civil action involving the registration, trafficking, or use of a domain name under this paragraph, a court may order the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.

(D) A person shall be liable for using a domain name under subparagraph (A) only if that person is the domain name registrant or that registrant's authorized licensee.

(E) As used in this paragraph, the term "traffics in" refers to transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.

(2)(A) The owner of a mark may file an in rem civil action against a domain name in the judicial district in which the domain name registrar, domain name registry, or other domain name authority that registered or assigned the domain name is located if--

- (i) the domain name violates any right of the owner of a mark registered in the Patent and Trademark Office, or protected under subsection (a) or (c); and
 - (ii) the court finds that the owner--
 - (I) is not able to obtain in personam jurisdiction over a person who would have been a defendant in a civil action under paragraph (1); or
 - (II) through due diligence was not able to find a person who would have been a defendant in a civil action under paragraph (1) by--
 - (aa) sending a notice of the alleged violation and intent to proceed under this paragraph to the registrant of the domain name at the postal and e-mail address provided by the registrant to the registrar; and
 - (bb) publishing notice of the action as the court may direct promptly after filing the action.
- (B) The actions under subparagraph (A)(ii) shall constitute service of process.
- (C) In an in rem action under this paragraph, a domain name shall be deemed to have its situs in the judicial district in which--
- (i) the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located; or
 - (ii) documents sufficient to establish control and authority regarding the disposition of the registration and use of the domain name are deposited with the court.
- (D)(i) The remedies in an in rem action under this paragraph shall be limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark. Upon receipt of written notification of a filed, stamped copy of a complaint filed by the owner of a mark in a United States district court under this paragraph, the domain name registrar, domain name registry, or other domain name authority shall--
- (I) expeditiously deposit with the court documents sufficient to establish the court's control and authority regarding the disposition of the registration and use of the domain name to the court; and
 - (II) not transfer, suspend, or otherwise modify the domain name during the pendency of the action, except upon order of the court.
- (ii) The domain name registrar or registry or other domain name authority shall not be liable for injunctive or monetary relief under this paragraph except in the case of bad faith or reckless disregard, which includes a willful failure to comply with any such court order.
- (3) The civil action established under paragraph (1) and the in rem action established under paragraph (2), and any remedy available under either such action, shall be in addition to any other civil action or remedy otherwise applicable.
- (4) The in rem jurisdiction established under paragraph (2) shall be in addition to any other jurisdiction that otherwise exists, whether in rem or in personam.

Uniform Domain Name Dispute Resolution Policy
(As Approved by ICANN on October 24, 1999)

1. Purpose. This Uniform Domain Name Dispute Resolution Policy (the "Policy") has been adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN"), is incorporated by reference into your Registration Agreement, and sets forth the terms and conditions in connection with a dispute between you and any party other than us (the registrar) over the registration and use of an Internet domain name registered by you. Proceedings under Paragraph 4 of this Policy will be conducted according to the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules of Procedure"), which are available at www.icann.org/udrp/udrp-rules-24oct99.htm, and the selected administrative-dispute-resolution service provider's supplemental rules.

2. Your Representations. By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights.

3. Cancellations, Transfers, and Changes. We will cancel, transfer or otherwise make changes to domain name registrations under the following circumstances:

a. subject to the provisions of Paragraph 8, our receipt of written or appropriate electronic instructions from you or your authorized agent to take such action;

b. our receipt of an order from a court or arbitral tribunal, in each case of competent jurisdiction, requiring such action; and/or

c. our receipt of a decision of an Administrative Panel requiring such action in any administrative proceeding to which you were a party and which was conducted under this Policy or a later version of this Policy adopted by ICANN. (See Paragraph 4(i) and (k) below.)

We may also cancel, transfer or otherwise make changes to a domain name registration in accordance with the terms of your Registration Agreement or other legal requirements.

4. Mandatory Administrative Proceeding.

This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one of the administrative-dispute-resolution service providers listed at www.icann.org/udrp/approved-providers.htm (each, a "Provider").

a. Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that

- (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) you have no rights or legitimate interests in respect of the domain name; and
- (iii) your domain name has been registered and is being used in bad faith.

In the administrative proceeding, the complainant must prove that each of these three elements are present.

b. Evidence of Registration and Use in Bad Faith. For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that you have registered or you have acquired 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 or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have 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 that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

c. How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint. When you receive a complaint, you should refer to Paragraph 5 of the Rules of Procedure in determining how your response should be prepared. Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

d. Selection of Provider. The complainant shall select the Provider from among those approved by ICANN by submitting the complaint to that Provider. The selected Provider will administer the proceeding, except in cases of consolidation as described in Paragraph 4(f).

e. Initiation of Proceeding and Process and Appointment of Administrative Panel. The Rules of Procedure state the process for initiating and conducting a proceeding and for appointing the panel that will decide the dispute (the "Administrative Panel").

f. Consolidation. In the event of multiple disputes between you and a complainant, either you or the complainant may petition to consolidate the disputes before a single Administrative Panel. This petition shall be made to the first Administrative Panel appointed to hear a pending dispute between the parties. This Administrative Panel may consolidate before it any or all such disputes in its sole discretion, provided that the disputes being consolidated are governed by this Policy or a later version of this Policy adopted by ICANN.

g. Fees. All fees charged by a Provider in connection with any dispute before an Administrative Panel pursuant to this Policy shall be paid by the complainant, except in cases where you elect to expand the Administrative Panel from one to three panelists as provided in Paragraph 5(b)(iv) of the Rules of Procedure, in which case all fees will be split evenly by you and the complainant.

h. Our Involvement in Administrative Proceedings. We do not, and will not, participate in the administration or conduct of any proceeding before an Administrative Panel. In addition, we will not be liable as a result of any decisions rendered by the Administrative Panel.

i. Remedies. The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant.

j. Notification and Publication. The Provider shall notify us of any decision made by an Administrative Panel with respect to a domain name you have registered with us. All decisions under this Policy will be published in full over the Internet, except when an Administrative Panel determines in an exceptional case to redact portions of its decision.

k. Availability of Court Proceedings. The mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded. If an Administrative Panel decides that your domain name registration should be canceled or transferred, we will wait ten (10) business days (as observed in the location of our principal office) after we are informed by the applicable Provider of the Administrative Panel's decision before implementing that decision. We will then

implement the decision unless we have received from you during that ten (10) business day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the complainant in a jurisdiction to which the complainant has submitted under Paragraph 3(b)(xiii) of the Rules of Procedure. (In general, that jurisdiction is either the location of our principal office or of your address as shown in our Whois database. See Paragraphs 1 and 3(b)(xiii) of the Rules of Procedure for details.) If we receive such documentation within the ten (10) business day period, we will not implement the Administrative Panel's decision, and we will take no further action, until we receive (i) evidence satisfactory to us of a resolution between the parties; (ii) evidence satisfactory to us that your lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from such court dismissing your lawsuit or ordering that you do not have the right to continue to use your domain name.

5. All Other Disputes and Litigation. All other disputes between you and any party other than us regarding your domain name registration that are not brought pursuant to the mandatory administrative proceeding provisions of Paragraph 4 shall be resolved between you and such other party through any court, arbitration or other proceeding that may be available.

6. Our Involvement in Disputes. We will not participate in any way in any dispute between you and any party other than us regarding the registration and use of your domain name. You shall not name us as a party or otherwise include us in any such proceeding. In the event that we are named as a party in any such proceeding, we reserve the right to raise any and all defenses deemed appropriate, and to take any other action necessary to defend ourselves.

7. Maintaining the Status Quo. We will not cancel, transfer, activate, deactivate, or otherwise change the status of any domain name registration under this Policy except as provided in Paragraph 3 above.

8. Transfers During a Dispute.

a. Transfers of a Domain Name to a New Holder. You may not transfer your domain name registration to another holder (i) during a pending administrative proceeding brought pursuant to Paragraph 4 or for a period of fifteen (15) business days (as observed in the location of our principal place of business) after such proceeding is concluded; or (ii) during a pending court proceeding or arbitration commenced regarding your domain name unless the party to whom the domain name registration is being transferred agrees, in writing, to be bound by the decision of the court or arbitrator. We reserve the right to cancel any transfer of a domain name registration to another holder that is made in violation of this subparagraph.

b. Changing Registrars. You may not transfer your domain name registration to another registrar during a pending administrative proceeding brought pursuant to Paragraph 4 or for a period of fifteen (15) business days (as observed in the location of our principal place of business) after such proceeding is concluded. You may transfer administration of your domain name registration to another registrar during a pending court action or arbitration, provided that the domain name you have registered with us shall continue to be subject to the proceedings commenced against you in accordance with the terms of

this Policy. In the event that you transfer a domain name registration to us during the pendency of a court action or arbitration, such dispute shall remain subject to the domain name dispute policy of the registrar from which the domain name registration was transferred.

9. Policy Modifications. We reserve the right to modify this Policy at any time with the permission of ICANN. We will post our revised Policy at <URL> at least thirty (30) calendar days before it becomes effective. Unless this Policy has already been invoked by the submission of a complaint to a Provider, in which event the version of the Policy in effect at the time it was invoked will apply to you until the dispute is over, all such changes will be binding upon you with respect to any domain name registration dispute, whether the dispute arose before, on or after the effective date of our change. In the event that you object to a change in this Policy, your sole remedy is to cancel your domain name registration with us, provided that you will not be entitled to a refund of any fees you paid to us. The revised Policy will apply to you until you cancel your domain name registration.

Rules for Uniform Domain Name Dispute Resolution Policy
(the "Rules")

(As Approved by ICANN on October 24, 1999)

Administrative proceedings for the resolution of disputes under the Uniform Dispute Resolution Policy adopted by ICANN shall be governed by these Rules and also the Supplemental Rules of the Provider administering the proceedings, as posted on its web site.

1. Definitions

In these Rules:

Complainant means the party initiating a complaint concerning a domain-name registration.

ICANN refers to the Internet Corporation for Assigned Names and Numbers.

Mutual Jurisdiction means a court jurisdiction at the location of either (a) the principal office of the Registrar (provided the domain-name holder has submitted in its Registration Agreement to that jurisdiction for court adjudication of disputes concerning or arising from the use of the domain name) or (b) the domain-name holder's address as shown for the registration of the domain name in Registrar's Whois database at the time the complaint is submitted to the Provider.

Panel means an administrative panel appointed by a Provider to decide a complaint concerning a domain-name registration.

Panelist means an individual appointed by a Provider to be a member of a Panel.

Party means a Complainant or a Respondent.

Policy means the Uniform Domain Name Dispute Resolution Policy that is incorporated by reference and made a part of the Registration Agreement.

Provider means a dispute-resolution service provider approved by ICANN. A list of such Providers appears at www.icann.org/udrp/approved-providers.htm.

Registrar means the entity with which the Respondent has registered a domain name that is the subject of a complaint.

Registration Agreement means the agreement between a Registrar and a domain-name holder.

Respondent means the holder of a domain-name registration against which a complaint is initiated.

Reverse Domain Name Hijacking means using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.

Supplemental Rules means the rules adopted by the Provider administering a proceeding to supplement these Rules. Supplemental Rules shall not be inconsistent with the Policy or these Rules and shall cover such topics as fees, word and page limits and guidelines, the means for communicating with the Provider and the Panel, and the form of cover sheets.

2. Communications

(a) When forwarding a complaint to the Respondent, it shall be the Provider's responsibility to employ reasonably available means calculated to achieve actual notice to Respondent. Achieving actual notice, or employing the following measures to do so, shall discharge this responsibility:

(i) sending the complaint to all postal-mail and facsimile addresses (A) shown in the domain name's registration data in Registrar's Whois database for the registered domain-name holder, the technical contact, and the administrative contact and (B) supplied by Registrar to the Provider for the registration's billing contact; and

(ii) sending the complaint in electronic form (including annexes to the extent available in that form) by e-mail to:

(A) the e-mail addresses for those technical, administrative, and billing contacts;

(B) postmaster@<the contested domain name>; and

(C) if the domain name (or "www." followed by the domain name) resolves to an active web page (other than a generic page the Provider concludes is maintained by a registrar or ISP for parking domain-names registered by multiple domain-name holders), any e-mail address shown or e-mail links on that web page; and

(iii) sending the complaint to any address the Respondent has notified the Provider it prefers and, to the extent practicable, to all other addresses provided to the Provider by Complainant under Paragraph 3(b)(v).

(b) Except as provided in Paragraph 2(a), any written communication to Complainant or Respondent provided for under these Rules shall be made by the preferred means stated by the Complainant or Respondent, respectively (see Paragraphs 3(b)(iii) and 5(b)(iii)), or in the absence of such specification

(i) by telecopy or facsimile transmission, with a confirmation of transmission; or

(ii) by postal or courier service, postage pre-paid and return receipt requested; or

(iii) electronically via the Internet, provided a record of its transmission is available.

(c) Any communication to the Provider or the Panel shall be made by the means and in the manner (including number of copies) stated in the Provider's Supplemental Rules.

(d) Communications shall be made in the language prescribed in Paragraph 11. E-mail communications should, if practicable, be sent in plaintext.

(e) Either Party may update its contact details by notifying the Provider and the Registrar.

(f) Except as otherwise provided in these Rules, or decided by a Panel, all communications provided for under these Rules shall be deemed to have been made:

(i) if delivered by telecopy or facsimile transmission, on the date shown on the confirmation of transmission; or

(ii) if by postal or courier service, on the date marked on the receipt; or

(iii) if via the Internet, on the date that the communication was transmitted, provided that the date of transmission is verifiable.

(g) Except as otherwise provided in these Rules, all time periods calculated under these Rules to begin when a communication is made shall begin to run on the earliest date that the communication is deemed to have been made in accordance with Paragraph 2(f).

(h) Any communication by

(i) a Panel to any Party shall be copied to the Provider and to the other Party;

(ii) the Provider to any Party shall be copied to the other Party; and

(iii) a Party shall be copied to the other Party, the Panel and the Provider, as the case may be.

(i) It shall be the responsibility of the sender to retain records of the fact and circumstances of sending, which shall be available for inspection by affected parties and for reporting purposes.

(j) In the event a Party sending a communication receives notification of non-delivery of the communication, the Party shall promptly notify the Panel (or, if no Panel is yet appointed, the Provider) of the circumstances of the notification. Further proceedings concerning the communication and any response shall be as directed by the Panel (or the Provider).

3. The Complaint

(a) Any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules to any Provider approved by ICANN. (Due to capacity constraints or for other reasons, a Provider's ability to accept complaints may be suspended at times. In that event, the Provider shall refuse the submission. The person or entity may submit the complaint to another Provider.)

(b) The complaint shall be submitted in hard copy and (except to the extent not available for annexes) in electronic form and shall:

(i) Request that the complaint be submitted for decision in accordance with the Policy and these Rules;

(ii) Provide the name, postal and e-mail addresses, and the telephone and telefax numbers of the Complainant and of any representative authorized to act for the Complainant in the administrative proceeding;

(iii) Specify a preferred method for communications directed to the Complainant in the administrative proceeding (including person to be contacted, medium, and address information) for each of (A) electronic-only material and (B) material including hard copy;

(iv) Designate whether Complainant elects to have the dispute decided by a single-member or a three-member Panel and, in the event Complainant elects a three-member Panel, provide the names and contact details of three candidates to serve as one of the Panelists (these candidates may be drawn from any ICANN-approved Provider's list of panelists);

(v) Provide the name of the Respondent (domain-name holder) and all information (including any postal and e-mail addresses and telephone and telefax numbers) known to Complainant regarding how to contact Respondent or any representative of Respondent, including contact information based on pre-complaint dealings, in sufficient detail to allow the Provider to send the complaint as described in Paragraph 2(a);

(vi) Specify the domain name(s) that is/are the subject of the complaint;

(vii) Identify the Registrar(s) with whom the domain name(s) is/are registered at the time the complaint is filed;

(viii) Specify the trademark(s) or service mark(s) on which the complaint is based and, for each mark, describe the goods or services, if any, with which the mark is used (Complainant may also separately describe other goods and services with which it intends, at the time the complaint is submitted, to use the mark in the future.);

(ix) Describe, in accordance with the Policy, the grounds on which the complaint is made including, in particular,

(1) the manner in which the domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(2) why the Respondent (domain-name holder) should be considered as having no rights or legitimate interests in respect of the domain name(s) that is/are the subject of the complaint; and

(3) why the domain name(s) should be considered as having been registered and being used in bad faith

(The description should, for elements (2) and (3), discuss any aspects of Paragraphs 4(b) and 4(c) of the Policy that are applicable. The description shall

comply with any word or page limit set forth in the Provider's Supplemental Rules.);

(x) Specify, in accordance with the Policy, the remedies sought;

(xi) Identify any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint;

(xii) State that a copy of the complaint, together with the cover sheet as prescribed by the Provider's Supplemental Rules, has been sent or transmitted to the Respondent (domain-name holder), in accordance with Paragraph 2(b);

(xiii) State that Complainant will submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to the jurisdiction of the courts in at least one specified Mutual Jurisdiction;

(xiv) Conclude with the following statement followed by the signature of the Complainant or its authorized representative:

"Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain-name holder and waives all such claims and remedies against (a) the dispute-resolution provider and panelists, except in the case of deliberate wrongdoing, (b) the registrar, (c) the registry administrator, and (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents."

"Complainant certifies that the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument."; and

(xv) Annex any documentary or other evidence, including a copy of the Policy applicable to the domain name(s) in dispute and any trademark or service mark registration upon which the complaint relies, together with a schedule indexing such evidence.

(c) The complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

4. Notification of Complaint

(a) The Provider shall review the complaint for administrative compliance with the Policy and these Rules and, if in compliance, shall forward the complaint (together with the explanatory cover sheet prescribed by the Provider's Supplemental Rules) to the Respondent, in the manner prescribed by Paragraph 2(a), within three (3) calendar days

following receipt of the fees to be paid by the Complainant in accordance with Paragraph 19.

(b) If the Provider finds the complaint to be administratively deficient, it shall promptly notify the Complainant and the Respondent of the nature of the deficiencies identified. The Complainant shall have five (5) calendar days within which to correct any such deficiencies, after which the administrative proceeding will be deemed withdrawn without prejudice to submission of a different complaint by Complainant.

(c) The date of commencement of the administrative proceeding shall be the date on which the Provider completes its responsibilities under Paragraph 2(a) in connection with forwarding the Complaint to the Respondent.

(d) The Provider shall immediately notify the Complainant, the Respondent, the concerned Registrar(s), and ICANN of the date of commencement of the administrative proceeding.

5. The Response

(a) Within twenty (20) days of the date of commencement of the administrative proceeding the Respondent shall submit a response to the Provider.

(b) The response shall be submitted in hard copy and (except to the extent not available for annexes) in electronic form and shall:

(i) Respond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain-name holder) to retain registration and use of the disputed domain name (This portion of the response shall comply with any word or page limit set forth in the Provider's Supplemental Rules.);

(ii) Provide the name, postal and e-mail addresses, and the telephone and telefax numbers of the Respondent (domain-name holder) and of any representative authorized to act for the Respondent in the administrative proceeding;

(iii) Specify a preferred method for communications directed to the Respondent in the administrative proceeding (including person to be contacted, medium, and address information) for each of (A) electronic-only material and (B) material including hard copy;

(iv) If Complainant has elected a single-member panel in the Complaint (see Paragraph 3(b)(iv)), state whether Respondent elects instead to have the dispute decided by a three-member panel;

(v) If either Complainant or Respondent elects a three-member Panel, provide the names and contact details of three candidates to serve as one of the Panelists (these candidates may be drawn from any ICANN-approved Provider's list of panelists);

(vi) Identify any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint;

(vii) State that a copy of the response has been sent or transmitted to the Complainant, in accordance with Paragraph 2(b); and

(viii) Conclude with the following statement followed by the signature of the Respondent or its authorized representative:

"Respondent certifies that the information contained in this Response is to the best of Respondent's knowledge complete and accurate, that this Response is not being presented for any improper purpose, such as to harass, and that the assertions in this Response are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument."; and

(ix) Annex any documentary or other evidence upon which the Respondent relies, together with a schedule indexing such documents.

(c) If Complainant has elected to have the dispute decided by a single-member Panel and Respondent elects a three-member Panel, Respondent shall be required to pay one-half of the applicable fee for a three-member Panel as set forth in the Provider's Supplemental Rules. This payment shall be made together with the submission of the response to the Provider. In the event that the required payment is not made, the dispute shall be decided by a single-member Panel.

(d) At the request of the Respondent, the Provider may, in exceptional cases, extend the period of time for the filing of the response. The period may also be extended by written stipulation between the Parties, provided the stipulation is approved by the Provider.

(e) If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint.

6. Appointment of the Panel and Timing of Decision

(a) Each Provider shall maintain and publish a publicly available list of panelists and their qualifications.

(b) If neither the Complainant nor the Respondent has elected a three-member Panel (Paragraphs 3(b)(iv) and 5(b)(iv)), the Provider shall appoint, within five (5) calendar days following receipt of the response by the Provider, or the lapse of the time period for the submission thereof, a single Panelist from its list of panelists. The fees for a single-member Panel shall be paid entirely by the Complainant.

(c) If either the Complainant or the Respondent elects to have the dispute decided by a three-member Panel, the Provider shall appoint three Panelists in accordance with the procedures identified in Paragraph 6(e). The fees for a three-member Panel shall be paid in their entirety by the Complainant, except where the election for a three-member Panel

was made by the Respondent, in which case the applicable fees shall be shared equally between the Parties.

(d) Unless it has already elected a three-member Panel, the Complainant shall submit to the Provider, within five (5) calendar days of communication of a response in which the Respondent elects a three-member Panel, the names and contact details of three candidates to serve as one of the Panelists. These candidates may be drawn from any ICANN-approved Provider's list of panelists.

(e) In the event that either the Complainant or the Respondent elects a three-member Panel, the Provider shall endeavor to appoint one Panelist from the list of candidates provided by each of the Complainant and the Respondent. In the event the Provider is unable within five (5) calendar days to secure the appointment of a Panelist on its customary terms from either Party's list of candidates, the Provider shall make that appointment from its list of panelists. The third Panelist shall be appointed by the Provider from a list of five candidates submitted by the Provider to the Parties, the Provider's selection from among the five being made in a manner that reasonably balances the preferences of both Parties, as they may specify to the Provider within five (5) calendar days of the Provider's submission of the five-candidate list to the Parties.

(f) Once the entire Panel is appointed, the Provider shall notify the Parties of the Panelists appointed and the date by which, absent exceptional circumstances, the Panel shall forward its decision on the complaint to the Provider.

7. Impartiality and Independence

A Panelist shall be impartial and independent and shall have, before accepting appointment, disclosed to the Provider any circumstances giving rise to justifiable doubt as to the Panelist's impartiality or independence. If, at any stage during the administrative proceeding, new circumstances arise that could give rise to justifiable doubt as to the impartiality or independence of the Panelist, that Panelist shall promptly disclose such circumstances to the Provider. In such event, the Provider shall have the discretion to appoint a substitute Panelist.

8. Communication Between Parties and the Panel

No Party or anyone acting on its behalf may have any unilateral communication with the Panel. All communications between a Party and the Panel or the Provider shall be made to a case administrator appointed by the Provider in the manner prescribed in the Provider's Supplemental Rules.

9. Transmission of the File to the Panel

The Provider shall forward the file to the Panel as soon as the Panelist is appointed in the case of a Panel consisting of a single member, or as soon as the last Panelist is appointed in the case of a three-member Panel.

10. General Powers of the Panel

(a) The Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.

(b) In all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

(c) The Panel shall ensure that the administrative proceeding takes place with due expedition. It may, at the request of a Party or on its own motion, extend, in exceptional cases, a period of time fixed by these Rules or by the Panel.

(d) The Panel shall determine the admissibility, relevance, materiality and weight of the evidence.

(e) A Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.

11. Language of Proceedings

(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

(b) The Panel may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding.

12. Further Statements

In addition to the complaint and the response, the Panel may request, in its sole discretion, further statements or documents from either of the Parties.

13. In-Person Hearings

There shall be no in-person hearings (including hearings by teleconference, videoconference, and web conference), unless the Panel determines, in its sole discretion and as an exceptional matter, that such a hearing is necessary for deciding the complaint.

14. Default

(a) In the event that a Party, in the absence of exceptional circumstances, does not comply with any of the time periods established by these Rules or the Panel, the Panel shall proceed to a decision on the complaint.

(b) If a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, these Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

15. Panel Decisions

(a) A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

(b) In the absence of exceptional circumstances, the Panel shall forward its decision on the complaint to the Provider within fourteen (14) days of its appointment pursuant to Paragraph 6.

(c) In the case of a three-member Panel, the Panel's decision shall be made by a majority.

(d) The Panel's decision shall be in writing, provide the reasons on which it is based, indicate the date on which it was rendered and identify the name(s) of the Panelist(s).

(e) Panel decisions and dissenting opinions shall normally comply with the guidelines as to length set forth in the Provider's Supplemental Rules. Any dissenting opinion shall accompany the majority decision. If the Panel concludes that the dispute is not within the scope of Paragraph 4(a) of the Policy, it shall so state. If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

16. Communication of Decision to Parties

(a) Within three (3) calendar days after receiving the decision from the Panel, the Provider shall communicate the full text of the decision to each Party, the concerned Registrar(s), and ICANN. The concerned Registrar(s) shall immediately communicate to each Party, the Provider, and ICANN the date for the implementation of the decision in accordance with the Policy.

(b) Except if the Panel determines otherwise (see Paragraph 4(j) of the Policy), the Provider shall publish the full decision and the date of its implementation on a publicly accessible web site. In any event, the portion of any decision determining a complaint to have been brought in bad faith (see Paragraph 15(e) of these Rules) shall be published.

17. Settlement or Other Grounds for Termination

(a) If, before the Panel's decision, the Parties agree on a settlement, the Panel shall terminate the administrative proceeding.

(b) If, before the Panel's decision is made, it becomes unnecessary or impossible to continue the administrative proceeding for any reason, the Panel shall terminate the administrative proceeding, unless a Party raises justifiable grounds for objection within a period of time to be determined by the Panel.

18. Effect of Court Proceedings

(a) In the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision.

(b) In the event that a Party initiates any legal proceedings during the pendency of an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, it shall promptly notify the Panel and the Provider. See Paragraph 8 above.

19. Fees

(a) The Complainant shall pay to the Provider an initial fixed fee, in accordance with the Provider's Supplemental Rules, within the time and in the amount required. A Respondent electing under Paragraph 5(b)(iv) to have the dispute decided by a three-member Panel, rather than the single-member Panel elected by the Complainant, shall pay the Provider one-half the fixed fee for a three-member Panel. See Paragraph 5(c). In all other cases, the Complainant shall bear all of the Provider's fees, except as prescribed under Paragraph 19(d). Upon appointment of the Panel, the Provider shall refund the appropriate portion, if any, of the initial fee to the Complainant, as specified in the Provider's Supplemental Rules.

(b) No action shall be taken by the Provider on a complaint until it has received from Complainant the initial fee in accordance with Paragraph 19(a).

(c) If the Provider has not received the fee within ten (10) calendar days of receiving the complaint, the complaint shall be deemed withdrawn and the administrative proceeding terminated.

(d) In exceptional circumstances, for example in the event an in-person hearing is held, the Provider shall request the Parties for the payment of additional fees, which shall be established in agreement with the Parties and the Panel.

20. Exclusion of Liability

Except in the case of deliberate wrongdoing, neither the Provider nor a Panelist shall be liable to a Party for any act or omission in connection with any administrative proceeding under these Rules.

21. Amendments

The version of these Rules in effect at the time of the submission of the complaint to the Provider shall apply to the administrative proceeding commenced thereby. These Rules may not be amended without the express written approval of ICANN.