

TRADEMARK HOLDERS BEWARE: SOURCE-INDICATING gTLDs ARE HERE

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ABSTRACT

The Internet Corporation for Assigned Names and Numbers (ICANN) has released over 1,000 new gTLDs into the market and counting. Although on its face this development seems potentially catastrophic for trademark holders, hardly anyone in North America seems to know that these new releases are occurring.

Until then, the interplay between trademark law and these new gTLDs can merely be hypothesized. When the general public becomes aware of strings like .sucks, .pink, and .guru, trademark holders may be faced with legal changes in trademark registration and trademark enforcement regimes. In the past, top-level domains like .edu and .com have generally been considered generic, and have not, standing alone or as part of an otherwise non-distinctive mark, been recognized as “source indicating” or distinctive for trademark registration or enforcement purposes.

However, some of the new gTLDs are unique identifiers, and many of them comprise famous brands. The Trademark Manual of Examining Procedure has already been updated to account for this development, and it now states that unique gTLDs may serve a source-indicating

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function in certain circumstances. Thus, the new gTLDs are already being recognized as potential source indicators for trademark registration purposes.

It is only a matter of time before tribunals start to weigh these source-indicating gTLDs in trademark enforcement proceedings. This paper argues that source-indicating gTLDs should be taken into account by courts applying the likelihood of consumer confusion and trademark dilution analyses employed in traditional trademark proceedings, particularly as consumers become more aware of the new gTLDs. Moreover, it also argues that domain name dispute resolution panelists should all be considering source-indicating gTLDs in the confusing similarity analysis required in ICANN domain name proceedings.

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INTRODUCTION

The role of the generic top-level domain (gTLD) is changing, on the Internet and in trademark law. Since 2013, ICANN has released more than 1,000 new gTLDs into the marketplace.² Gone are the days when pickings were limited to 22 strings, and *.com* was the only real contender for a corporate domain name.³ As the gTLD marketplace expands, trademark law's relationship with domain names grows increasingly rocky. It has long been settled in trademark law that gTLDs generally do not serve a source-

² *ICANN Program Statistics*, ICANN, <https://newgtlds.icann.org/en/program-status/statistics> [<https://perma.cc/5QVD-JEV4>] (last visited Oct. 17, 2016).

³ Trevor Little, *Domain experts on the slow start for new gTLDs, and what may turn the tide*, WORLD TRADEMARK REVIEW, (Jan. 18, 2016), <http://www.worldtrademarkreview.com/blog/detail.aspx?g=1c2d3016-3b1b-4f2f-8cfc-45069567145b> [<https://perma.cc/VA8R-HNUF>]. The gTLDs have not been accepted yet, and *.com* still truly does reign supreme.

indicating function for purposes of trademark registration.⁴ However, with the emergence of new gTLDs, this generalization no longer holds true. Hundreds of new, unique, source-indicating gTLDs have been released into the marketplace, and the Trademark Manual of Examining Procedure (TMEP) has already acknowledged that in certain circumstances these unique gTLDs are capable of being source indicating.⁵

On its face, source-indicating gTLDs do not seem overly important for brand owners beyond the possibility of registering *brand* as a gTLD and as a trademark.⁶ However, the implications of source-indicating gTLDs reach far beyond trademark registration and will likely eventually affect trademark enforcement as well. As of yet, no court has had the opportunity to determine what affect source-indicating gTLDs may have on the likelihood of confusion and trademark dilution analyses traditionally employed in trademark enforcement actions offered under the Lanham Act. Moreover, although panelists presiding over Uniform Domain-Name Dispute-Resolution Policy (UDRP) and Uniform Rapid Suspension System (URS) procedures are currently grappling with the new gTLDs on a daily basis, recent decisions show source-indicating gTLDs may be being treated inconsistently among panelists applying the confusing similarity analysis required in these ICANN-created procedures.

This paper argues that source-indicating gTLDs should be taken into account by courts applying the likelihood of consumer confusion analysis and the trademark dilution analysis, particularly as consumers become more

⁴ TMEP § 1209.03(m) (Oct. 2015).

⁵ *Id.*

⁶ See Christopher Hofman Laursen, *Dot Brand – the “monster truck” of domain names*, EUROPEAN DOMAIN CENTRE, (July 7, 2014), <http://blog.europeandomaincentre.com/dot-brand-preparing-the-domain-monster-truck/> [<https://perma.cc/Q54D-SN2V>].

aware of the new gTLDs. Moreover, it also argues that domain name dispute resolution panelists should all be considering source-indicating gTLDs in their confusing similarity analysis. Part I of this paper discusses ICANN, the release of the new gTLDs, and the rights protection mechanisms offered by ICANN. Part II gives a high-level overview of trademark law and trademark distinctiveness. Part III discusses the history of gTLDs in trademark registration. Part IV details how gTLDs are currently taken into account in traditional trademark enforcement proceedings, and it argues that source-indicating gTLDs should impact the likelihood of confusion and dilution analyses. Moreover, it also highlights the specific factors in these analyses that should be most affected by source-indicating gTLDs. Part V details how the new gTLDs are currently being analyzed in domain name dispute resolution procedures, and it argues that all panelists should consider source-indicating gTLDs in their confusing similarity analysis. Part VI details why trademark owners should potentially be wary of applying for *.brand* gTLDs and it provides a conclusion with an overview of why source-indicating gTLDs need to be considered in trademark enforcement from a policy perspective.

I. BACKGROUND ON ICANN & NEW GTLDS

A. *What is ICANN?*

The International Association of Names and Numbers (ICANN) is a non-profit organization that is tasked with managing the intricacies of the worldwide web.⁷ ICANN was founded in 1998 and its mission is to

⁷ ICANN, <https://www.icann.org/get-started> (last visited Feb. 1, 2016); see also Joseph P. Smith III, *The Tangled Web: A Case Against New Generic Top-Level Domains*, 20 RICH. J.L. & TECH. 10, at 1 (June, 2014).

“ensure a stable and global Internet.”⁸ It has a multi-stakeholder model that includes “registries, registrars, Internet Service Providers (ISPs), intellectual property advocates, commercial and business interests, non-commercial and non-profit interests, representation from more than 100 governments, and a global array of individual Internet users.”⁹ ICANN prides itself on being a transparent organization that includes all of its stakeholders in its decisions.¹⁰ ICANN’s policies are reviewed by its stakeholders and extensively commented on by the public.¹¹ ICANN also hosts free public meetings in different locations around the world three times a year that feature talks and presentations by stakeholders and guest presenters.¹²

ICANN contracts with approved generic Top Level Domain registries, which in turn contract with approved registrars, to distribute domain names to buyers around the world.¹³ Agreements with registries require compliance with the ICANN code of conduct standards, consensus policies, and temporary policies.¹⁴ Moreover, these agreements require compliance with Rights Protection Mechanisms (detailed below), pricing guidelines, and

⁸ ICANN, <http://newgtlds.icann.org/en/about/program> [<https://web.archive.org/web/20161202080047/http://newgtlds.icann.org/en/about/program>] (last visited Feb. 1, 2016).

⁹ ICANN, *supra* note 7; *see also* Smith, *supra* note 7.

¹⁰ ICANN, *supra* note 8.

¹¹ *Id.*

¹² ICANN, <https://meetings.icann.org/en/about> [<https://perma.cc/42FU-73QG>] (last visited Feb. 1, 2016). However, there are critics of ICANN, especially since the implementation of the new gTLDs. Smith III, *supra* note 7.

¹³ ICANN, <https://www.icann.org/resources/pages/registries/registries-agreements-en> [<https://perma.cc/C5C7-EFHF>] (last visited Feb. 1, 2016).

¹⁴ *Id.*

privacy policies.¹⁵ ICANN truly rules the domain name space.

B. *New gTLD Release & Public Perception*

In 2012, ICANN officially opened the application process for registries seeking to host new generic Top Level Domains (gTLDs).¹⁶ The application process started after the Generic Names Supporting Organization conducted an extensive policy review process that began in 2005, and was based on trial rounds held in 2000 and 2003.¹⁷ The decision to release new gTLDs was not made lightly.¹⁸ The new gTLD program was developed “to increase competition and choice in the domain name space.”¹⁹ Prior to 2012, only 22 gTLDs were available; as of October 2016, there are more than 1000 available gTLDs and counting.²⁰

Organizations have registered their own *.brand* gTLDs, like *.volkswagen*, *.clinique*, and *.statefarm*, which most likely will not be delegated for public use.²¹ However,

¹⁵ *Id.*

¹⁶ ICANN, [http://newgtlds.icann.org/en/http://newgtlds.icann.org/en/\[https://web.archive.org/web/20120108181603/http://newgtlds.icann.org/g/en\]](http://newgtlds.icann.org/en/http://newgtlds.icann.org/en/[https://web.archive.org/web/20120108181603/http://newgtlds.icann.org/g/en]) (last visited Feb. 1, 2016).

¹⁷ ICANN, *supra* note 8.

¹⁸ *Id.*

¹⁹ *Id.*

²⁰ *Delegated Strings*, ICANN, <https://newgtlds.icann.org/en/program-status/delegated-strings> [<https://web.archive.org/web/20160823014403/http://newgtlds.icann.org/g/en/program-status/delegated-strings>] (last visited Oct. 1, 2016).

²¹ *Id.*; Laursen, *supra* note 6; *see also Domains Help*, GO DADDY, <https://www.godaddy.com/help/what-are-second-level-domains-sld-and-country-code-second-level-domains-ccsld-335>

[<https://perma.cc/D4WL-SVSF>] (last visited April 10, 2016) (“A second-level domain (SLD) is the portion of the domain name that is located immediately to the left of the dot and domain name extension. Example 1: The SLD in coolexample.com is **coolexample**. Example 2: The SLD in coolexample.co.uk is still **coolexample**. You define the SLD when you register a domain name.”).

multiple registries host community gTLDs like *.sucks* and *.music* that are currently being registered by the public for use as second level domains (SLDs).²² Thus, members of the public have the opportunity to register a second level domain of their choice with these new community gTLDs. The *.sucks* registry actively markets its gTLD to the public, has a Twitter account, and hosts sites like *Batman.sucks* and *Superman.sucks* to garner public interest in registering SLDs with its *.sucks* string.²³

The application process for hosting a new gTLD is extensive. The initial cost to submit an application to host a gTLD is \$185,000, and there is no guarantee that an application will be approved.²⁴ Applying for a gTLD can be a high-stakes gamble, and if an application is not approved a lot of time and money is on the line. As of October 2016, of the 1930 applications that were submitted in 2012, only 1186 gTLDs had been approved.²⁵ There are significant risks and responsibilities involved in hosting a gTLD, including the substantial investment involved in running a registry, responsibility for registrars, staffing costs, and most notably,

²² *Delegated Strings*, *supra* note 20 ; *.SUCKS*, <https://www.registry.sucks> [<https://perma.cc/DR8F-TCLU>] (last visited Feb. 1, 2016); *.MUSIC*, <http://music.us> [<https://perma.cc/U5YH-J7UG>] (last visited Feb. 1, 2016).

²³ *.SUCKS*, <https://www.registry.sucks/media> [<https://perma.cc/CL9C-8DZ8>] (last visited Feb. 1, 2016); <http://batman.sucks> [<https://perma.cc/3HBD-5XD6>] (last visited Feb. 1, 2016); <http://superman.sucks> [<https://perma.cc/2H2E-JDWJ>] (last visited Feb. 1, 2016).

²⁴ *Frequently Asked Questions*, ICANN, <https://newgtlds.icann.org/en/applicants/global-support/faqs/faqs-en> [<https://perma.cc/T8Y8-5MT2>] (last visited Feb. 1, 2016).

²⁵ *Program Statistics*, ICANN, <https://newgtlds.icann.org/en/program-status/statistics> [<https://web.archive.org/web/20161028000936/http://newgtlds.icann.org/en/program-status/statistics>] (last visited October 17, 2016). Four years later, many applicants are still awaiting delegation. *Id.*

the risk of entering into gTLD uncharted territory.²⁶ According to a recent ICANN review, a majority of the public does not know that these new gTLDs even exist, and there are many consumer skeptics who believe the gTLDs will never catch on.²⁷ However, gTLDs are still being released into the market, and another application round could open in the near future.²⁸

C. *Rights Protection Mechanisms*

With the implementation of the new gTLD program, ICANN also introduced new rights protection mechanisms for trademark holders.²⁹ Prior to the release of the new gTLDs, the Uniform Domain-Name Dispute Resolution Policy (UDRP) was the only avenue ICANN provided for cybersquatting redress.³⁰ The UDRP has been in place since 1991, and it provides an avenue for trademark holders to petition for cancellation, transfer, or make changes to domain names if the trademark holder can prove confusing similarity, an absence of legitimate rights in the domain

²⁶ *Benefits and Risks of Operating a New gTLD*, ICANN, <https://newgtlds.icann.org/en/about/benefits-risks> [https://perma.cc/Y532-XRY7] (last visited Feb. 1, 2016).

²⁷ *Domain experts on the slow start for new gTLDs, and what may turn the tide*, WORLD TRADEMARK REVIEW, (Jan. 18, 2016), <http://www.worldtrademarkreview.com/blog/detail.aspx?g=1c2d3016-3b1b-4f2f-8cfc-45069567145b> [https://perma.cc/E9YS-WT3J].

²⁸ *ICANN reveals expected gTLDs round two timings*, WORLD TRADEMARK REVIEW, (Sept. 24, 2014), <http://www.worldtrademarkreview.com/blog/detail.aspx?g=95b49fc7-466d-472c-b330-7efe3f7086f0> [https://perma.cc/2SHR-CZLNQ].

²⁹ *Rights Protection Mechanism Requirement Published*, ICANN, (Sept. 30, 2013), <https://newgtlds.icann.org/en/announcements-and-media/announcement-30sep13-en> [https://perma.cc/4NCF-92LS].

³⁰ Jessica Sganga, *Trademark Owner's Strategy: Litigation Versus the UDRP*, 13 PEPP. DISP. RESOL. L.J. 301, 307–09 (2013); *UDRP Policy*, ICANN, (Feb. 25, 2012), <https://www.icann.org/resources/pages/policy-2012-02-25-en> [https://perma.cc/SH2A-PTV5].

name, and bad faith by a preponderance of the evidence.³¹ The UDRP is a non-binding alternative dispute resolution process that is presided over by three panelists, and it is a relatively cheap resolution method that is used in cybersquatting disputes when bad faith is evident.³²

However, beyond UDRP, with the release of the new gTLDs, ICANN now offers three new rights protection mechanisms. First, ICANN offers brand owners the opportunity to participate in the Trademark Clearinghouse.³³ Second, ICANN provides Trademark Clearinghouse registrants with the ability to participate in Sunrise periods,

³¹ *UDRP Policy*, ICANN, *supra* note 30. 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. *Id.*

³² *Id.*

³³ *Trademark Clearinghouse*, ICANN, <https://newgtlds.icann.org/en/about/trademark-clearinghouse> [<https://perma.cc/7BYZ-32PU>] (last visited Jan. 7, 2017); *see also* Sheri Lyn Falco, Esq., *Trademarks, Domain Names, and ICANN: an Evolving Dance*, 626 ST. THOMAS L. REV. 191, 207–08 (Winter 2014) (stating that the Clearinghouse is a repository that is limited to actively registered trademarks and trademarks that are validated by court order or treaty. Marks registered with the Trademark Clearinghouse (TMCH) have the benefit of the TMCH Claims Service, the Sunrise Service, and validation for URS disputes. The TMCH Claims Service notifies unauthorized parties seeking to register domain names utilizing a new gTLD in conjunction with an SLD that has a TMCH registered mark or the valid owners TMCH registration. If the party moves ahead with registering the domain name despite the notice, the TMCH will notify the trademark holder of the domain registration).

as new gTLDs are delegated and made available.³⁴ Finally, the third and potentially most important rights mechanism ICANN has implemented in conjunction with the new gTLD program is the Uniform Rapid Suspension System (URS) to combat cybersquatting.³⁵

URS is the quicker, cheaper cousin to the UDRP procedure that has been in place for decades.³⁶ URS is intended for use in “clear and convincing” cases of trademark infringement in domain names utilizing new gTLDs.³⁷ The process is relatively quick and easy.³⁸ Trademark holders submit a complaint to an ICANN approved URS provider with a short statement alleging that a new gTLD is infringing his/her mark.³⁹ One examiner

³⁴ Sheri Lyn Falco, Esq., *supra* note 33 at 210 (stating the Sunrise Service allows TMCH registrants the first opportunity to register domain names with new gTLD strings before the public has the opportunity); *see also* Lee Hutchinson, “.sucks” registrations begin soon—at up to \$2,500 per domain, ARSTECHNICA (Mar. 16, 2015, 8:05 AM), <http://arstechnica.com/information-technology/2015/03/sucks-tld-to-accept-sunrise-registrations-soon-but-theyll-be-pricey/> [<https://perma.cc/GXW4-QGKU>] (stating there has already been controversy surrounding the sunrise service, as oftentimes operators will charge an exorbitant price during sunrise periods).

³⁵ *Uniform Rapid Suspension System*, ICANN, <http://newgtlds.icann.org/en/applicants/urs> [<https://perma.cc/MAH5-G5G4>] (last visited Feb. 1, 2016).

³⁶ *Id.*

³⁷ *Id.*; *URS Procedure*, 8.1–8.6, ICANN, (Mar. 1, 2013), <https://newgtlds.icann.org/en/announcements-and-media/announcement-05mar13-en.pdf> [<https://perma.cc/SBE9-26NP>]. To restate in another way, if the Examiner finds that all three standards are satisfied by clear and convincing evidence and that there is no genuine contestable issue, then the Examiner shall issue a Determination in favor of the Complainant. If the Examiner finds that any of the standards have not been satisfied, then the Examiner shall deny the relief requested, thereby terminating the URS proceeding without prejudice to the Complainant to proceed with an action in court of competent jurisdiction or under the UDRP. *Id.*

³⁸ *Id.*

³⁹ *Id.*

reviews the allegation, and even with no response, the examiner may turn around a quick default decision that suspends but does not transfer the domain name.⁴⁰ At this point the procedure is still in its early stages, and has not yet been formalized into an ICANN policy.⁴¹

ICANN protection mechanisms are well equipped to deal with the implementation of the new gTLDs. However, the court system may have a more difficult time adapting to the new gTLDs. Where trademark law has long recognized that gTLDs generally do not serve a source-indicative purpose, the source-indicative function of the new gTLDs presents a novel issue.⁴²

II. BACKGROUND ON TRADEMARK LAW & DISTINCTIVENESS

A. *Brief History of Distinctiveness in Trademark Law*

In order for a term or name to function as a trademark, it must be inherently distinctive or it must have acquired distinctiveness.⁴³ The inherent distinctiveness of a

⁴⁰ *Id.* at 6.1–6.5; see also, *Brand owner prevails in first ever URS decision*, WORLD TRADEMARK REVIEW, (Oct. 25, 2013), <http://www.worldtrademarkreview.com/blog/detail.aspx?g=E2121999-2D30-4CD1-B618-1E3552E2388A> [<https://perma.cc/KVZ7-LHYU>].

⁴¹ See URS Procedure, *supra* note 37 at 1.2.6 (stating that in order to prevail on a claim, the claimant must prove three elements: (1) the domain name is identical or confusingly similar to a word mark in which the complainant holds national or regional registration rights and which is in current use; (2) the respondent has no legitimate rights or interest in the domain name; and (3) the domain name was registered and is being used in bad faith).

⁴² See *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1175 (Fed. Cir. 2004).

⁴³ Eric J. Shimanoff, *The “DOT” Times They are A-Changin’*: *How New Generic Top Level Domains (gTLDs) Will Change Consumer Perception About The Internet*, 32 CARDOZO ARTS & ENT. L.J. 891, 899 (2014).

word mark is generally governed by the four categories outlined in the landmark *Abercrombie & Fitch Co. v. Hunting World, Inc.* case.⁴⁴ The categories are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.⁴⁵ When a mark is deemed suggestive, arbitrary, or fanciful, it has inherent distinctiveness and is protectable as a trademark.⁴⁶ Descriptive marks are not protectable unless they garner secondary meaning, and generic terms are not ever protectable as trademarks and cannot be registered as such.⁴⁷

This hierarchy is in place in order to promote market competition while still maintaining one of the main goals of trademark law, protecting against consumer confusion.⁴⁸ When a mark is generic, like the term “elevator,” for example, the term does not indicate a source to the consumer, it merely indicates the thing. Furthermore, a descriptive term without secondary meaning, like “Scented Candles Galore” for a newly opened candle shop, does not indicate the source making the product; it indicates what is being sold in the store. However, if “Scented Candles Galore” proceeds to make a name for itself in the community, or maybe starts to franchise, and people come to recognize the phrase as an indicator of who makes the candles, instead of what is being offered, trademark rights may be recognized upon a showing of that “secondary meaning.”⁴⁹ Trademark law only protects source-indicating

⁴⁴ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

⁴⁵ *Id.*

⁴⁶ *Id.* at 17.

⁴⁷ *Id.* at 12–14.

⁴⁸ *Ameritech, Inc. v. American Information Technologies Corp.*, 811 F.2d 960, 964 (6th Cir.1987).

⁴⁹ Shimanoff, *supra* note 43 at 901 (“Secondary meaning may be shown by direct evidence, in the form of a customer survey, or circumstantial evidence, in the form of sales volume, length of time used and the

terms, in order to prevent businesses from monopolizing commonly used descriptive terms and generic words.⁵⁰ Until recently, it has been generally accepted that gTLDs do not indicate source, and that they do not add any distinctiveness to an otherwise descriptive or generic term.⁵¹ For instance, bubblebath.com would be considered merely descriptive, if not generic, for a website that sells bubble bath. In this scenario the .com is not adding any indication of source to the consumer; it is merely portraying to the consumer that it is a “commercial” site.

B. Types of Trademark Claims

If a term has either inherent distinctiveness or acquired distinctiveness, it is eligible for trademark protection.⁵² In the United States trademarks are federally protectable upon first use of an inherently distinctive term, or upon a later showing of acquired distinctiveness.⁵³ The Lanham Act gives mark owners the ability to enforce their marks against others using terms that are confusingly similar to the owners’, suggesting a false designation of origin.⁵⁴ Each circuit has a different test for determining “likelihood of confusion” among consumers; however, many of them are similar in practice. The second circuit uses the “Polaroid Test,”⁵⁵ and assesses eight factors, including (1) the strength of the plaintiff’s mark, (2) the degree of similarity between the marks in question, (3) the proximity of the products or services associated with the mark, (4) the likelihood that the

quantity and quality of advertising and promotion exposing customers to the trademark.”).

⁵⁰ *Abercrombie & Fitch Co.*, 537 F.2d at 9–11.

⁵¹ *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1175 (Fed. Cir. 2004).

⁵² *Abercrombie & Fitch Co.*, 537 F.2d at 9–11.

⁵³ 15 U.S.C. § 1125 (2012 & supp. 2015).

⁵⁴ *Id.*

⁵⁵ *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir.1961).

plaintiff will bridge the gap, (5) evidence of actual consumer confusion, (6) the defendant's good faith, (7) the quality of the defendant's product, and (8) consumer sophistication.⁵⁶

The Lanham Act also provides redress for non-confusion-based trademark theories.⁵⁷ If consumers are not likely to be confused by the use of a similar mark (likely because of a difference in products or services), famous mark owners can bring a claim for dilution.⁵⁸ The initial qualifier for a dilution claim is that a mark must be famous across the country, and a claim can be brought for either tarnishment or blurring of a mark, as outlined in the statute.⁵⁹ Furthermore, the statute specifically articulates fair use exceptions to dilution, including nominative fair use and descriptive fair use.⁶⁰

Moreover, a more recent addition to the Lanham Act is the Anti-Cybersquatting Consumer Protection Act (ACPA), passed in 1999.⁶¹ The ACPA was passed specifically to address cybersquatting, as many domain name disputes at the time were not covered by general Lanham Act claims, and many of the disputes centered on domain names that were warehoused or reserved, rather than actually being used in commerce in conjunction with goods or services.⁶² In order to prevail in an ACPA claim, the plaintiff must show that the defendant registers, traffics in, or uses the plaintiff's mark in a domain name that is likely to cause confusion or dilution, and does so with a bad faith intent to profit from use of the mark.⁶³

⁵⁶ *Id.*

⁵⁷ 15 U.S.C. § 1125 (2012 & supp. 2015).

⁵⁸ *Id.* at § 1125(c).

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ 15 U.S.C.A. § 1125(d) (2012).

⁶² *Id.*

⁶³ *Id.*

III. TRADEMARK REGISTRATION & gTLDs

A. *Historic gTLD Registration Decisions*

Until recently, it had been relatively settled that gTLDs generally do not serve a source-indicating function for trademark registration purposes.⁶⁴ In 2004 the Federal Circuit affirmed a Trademark Trial and Appeal Board (TTAB) decision denying registration for patents.com because it was merely descriptive for tracking patent status online.⁶⁵ The Court stated, “[b]ecause TLDs generally serve no source-indicating function, their addition to an otherwise unregistrable mark typically cannot render it registrable.”⁶⁶ “The addition of a TLD such as ‘.com’ or ‘.org’ to an otherwise unregistrable mark will typically not add any source-identifying significance, similar to the analysis of ‘Corp’ and ‘Inc.’”⁶⁷ However, although the Court ultimately decided the gTLD in patents.com was unhelpful in that particular case, it also made a point to specifically note that the possibility of source-indicating gTLDs was not foreclosed.⁶⁸ Moreover, it reaffirmed the fact that the PTO must look at a trademark in its entirety when assessing distinctiveness for registrability.⁶⁹ Besides a few outlier decisions, courts have historically set aside gTLDs as unhelpful generic or descriptive terms that do not contribute

⁶⁴ *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1175 (Fed. Cir. 2004).

⁶⁵ *Id.* at 1172.

⁶⁶ *Id.* (citing *In re CyberFinancial.Net, Inc.*, 65 U.S.P.Q.2d (BNA) 1789, 1792 (T.T.A.B. 2002)).

⁶⁷ *Id.* at 1177.

⁶⁸ *Id.* at 1174 (“The PTO has not applied a bright-line rule that the addition of a TLD to an otherwise descriptive term will never under any circumstances affect the registrability of a mark. Such a rule would be a legal error.”).

⁶⁹ *Id.*

to the distinctiveness of a mark for trademark registration purposes.⁷⁰

B. Recent gTLD Registration Developments

Recently, the TMEP has been updated to account for the release of the new gTLDs.⁷¹ The TMEP is a manual relied on by USPTO examining attorneys, applicants, and representatives in all stages of trademark registration.⁷² Although the manual still states that gTLDs should generally not be considered source indicating for trademark registration, new provisions have been added.⁷³ As a catch-all, the manual states, “[b]ecause gTLDs generally indicate the type of entity using a given domain name, and therefore serve no source-indicating function, their addition to an otherwise unregistrable mark typically cannot render it registrable.”⁷⁴ However, the TMEP also now states that gTLDs can add distinctiveness to an otherwise unregistrable mark in certain circumstances.⁷⁵ Moreover, it states “as the number of available gTLDs is increased by ICANN, or if the

⁷⁰ See, e.g., *In re Steelbuilding.com*, 415 F.3d 1293, 1296 (Fed. Cir. 2005) (“This court vacates the Board’s determination that the mark is generic, but affirms its findings on descriptiveness and the absence of secondary meaning, and therefore affirms the denial of the application.”).

⁷¹ TMEP § 1209.03(m) (Oct. 2015).

⁷² *Id.* at Foreword (Oct. 2016).

⁷³ *Id.* § 1209.03(m).

⁷⁴ *Id.* (citing *In re 1800Mattress.com IP LLC*, 586 F.3d 1359 (Fed. Cir. 2009)).

⁷⁵ *Id.* However, there is no bright-line, per se rule that the addition of a gTLD to an otherwise descriptive mark will never, under any circumstances, operate to create a registrable mark. See *Oppedahl & Larson LLP*, 373 F.3d at 1175, 71 USPQ2d 1374. In rare instances, if the gTLD is capable of indicating a source, the addition of the source-indicating gTLD to an otherwise unregistrable mark may render it registrable.

Example: The addition of the TLD “.PETER” to CLOTHES to form the mark CLOTHES.PETER *would* create a registrable mark. *Id.*

nature of new gTLDs changes, the examining attorney must consider any potential source-indicating function of the gTLD and introduce evidence as to the significance of the gTLD.”⁷⁶ It appears that examiners are currently relying on these recent changes, as USPTO examiners have approved registrations for trademarks that are comprised of new gTLDs.⁷⁷

IV. CURRENT STATE OF TRADEMARK LAW IN RELATION TO DOMAIN NAMES & HOW IT MIGHT CHANGE

A. *How Courts Currently View gTLDs*

Domain names have an interesting history in trademark enforcement. Because of the limited number of domain names that have been available in the past, courts have been hesitant to allow third-party trademark use in domain names.⁷⁸ “Given their perceived generic status,

⁷⁶ *Id.*; see also TMEP § 1215.08(a). Thus, the commercial impression created by the second-level domain name usually remains the same whether the non-source-identifying gTLD is present or not. If the gTLD does function as a source indicator, its deletion from the domain name mark may constitute a material alteration of the mark.

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.

Example: Amending a mark from ABC.PETER to ABC would materially change the mark because the essence of the original mark is created by both the second-level domain and the gTLD. *Id.*

⁷⁷ Roberto Ledesma, *TLDs and the USPTO (Case Brief: In re energy.me)*, EVERYTHINGTRADEMARKS.COM (OCT. 23, 2014), <https://everythingtrademarks.com/2014/10/23/tlds-and-the-uspto-case-brief-in-re-energy-me/> [<https://perma.cc/84XF-R2TA>] (stating that blinds.guru, studentloan.guru, and republic.bike were approved and added to the principal register).

⁷⁸ Peter M. Brody & Alexandra J. Roberts, *What's in A Domain Name? Nominative Fair Use Online After Toyota v. Tabari*, 100 TRADEMARK REP. 1290, 1291 (2010) (stating “case law suggests that an entity that

when analyzing the similarity of the parties' trademarks in claims of trademark infringement, unfair competition, dilution or cybersquatting, tribunals have ignored gTLDs, finding that the presence of a gTLD adds nothing distinctive to alleviate or enhance the similarities of the trademarks."⁷⁹ However, since the release of the new gTLDs, no federal court has had the opportunity to make a decision on whether these new gTLDs are source

incorporates the trademark of another in a domain name is far more likely than not to be enjoined. With rare exception, commercial sites housed at such addresses have repeatedly been held to infringe the rights of the trademark's owner.”)

⁷⁹ Shimanoff, *supra* note 43 at 913 (citing *Omega S.A. v. Omega Eng'g*, 228 F. Supp. 2d 112, 126 n.36 (D. Conn. 2002) (“When evaluating whether a domain name is confusingly similar to a trademark, a district court disregards the top-level domain name (e.g. ‘.com’, ‘.org’, ‘.net’ etc.)”)); *Image Online Design v. Core Ass’n*, 120 F. Supp. 2d 870, 878 (C.D. Cal. 2000) (showing that courts “ignore the TLD as though it were invisible next to the second level domain name in an infringement action”); 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 25:76 (4th ed. 2009) (noting “[t]he presence in two domain names of the same TLD such as the ‘.com’ top level domain indicator cannot itself be evidence of likely confusion”); *see, e.g.*, *TCPIP Holding Co., Inc. v. Haar Communications, Inc.*, 244 F.3d 88, 101 (2d Cir. 2001) (explaining that the fact that accused domain names have separate words run together without punctuation and are followed by top-level domain identifier, such as “.com,” is “of little or no significance” in adjudging likelihood of confusion); *CCBN.com, Inc. v. c-call.com Inc.*, 73 F. Supp. 2d 106, 112 (D. Mass. 1999) (explaining that the fact that conflicting marks share “.com” suffix is irrelevant “because ‘.com’ is a generic locator for domain names of Web sites dedicated to commercial use”); *Morgan Stanley v. Morgan Stanley*, FA 1169733 (Forum May 3, 2008) (Franklin, Arb.), <http://www.adrforum.com/domaindecisions/1169733.htm> [<https://perma.cc/AFW5-VMWX>] (finding the addition of gTLD “.com” irrelevant for purposes of distinguishing disputed domain name from established mark because every domain must contain top level domain name).

indicating, and what that may mean for trademark holders enforcing their marks.⁸⁰

B. How Courts Should View gTLDs

When consumers catch on to the new gTLDs as they start to become more widespread, it is likely that courts will begin to hear cases alleging trademark infringement in domain names utilizing new gTLDs. When that time comes, I propose that courts should start including source-indicating gTLDs in their trademark infringement analysis, in the context of a general trademark infringement claim, dilution claim, or ACPA claim. In all three of these claims, regardless of the products being sold or the jurisdiction in which the case is brought, similarity of the trademarks at issue must be assessed.⁸¹ If the domain name in question uses a new source-indicating gTLD, that part of the domain name should be included in the analysis, not discounted as gTLDs have been in the past. Courts should consider the entire domain name at issue, not just the SLD. For instance, if the registered mark is Nike and the allegedly infringing domain name is *wesellnike.resale*, the court should look at the entire domain name in its analysis. In this instance, “resale” would actually signal to the consumer that Nike was not the entity selling the shoes. The recent changes to the TMEP acknowledging the potential source-indicative nature of the new gTLDs sets

⁸⁰ It is worth noting that a few courts have dismissed claims against ICANN in relation to the new gTLDs on ripeness grounds. *See name.space, Inc. v. Internet Corp. for Assigned Names & Numbers*, 795 F.3d 1124 (9th Cir. 2015); *Image Online Design, Inc. v. Internet Corp. for Assigned Names & Numbers*, No. CV 12–08968 DDP (JCx), 2013 U.S. Dist. LEXIS 16896, at *15–16 (C.D. Cal. Feb. 7, 2013). Thus, a decision on gTLD distinctiveness may be on the horizon as more gTLDs are delegated.

⁸¹ Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CAL. L. REV. 1581, 1589 (2006).

the stage for this change in trademark enforcement jurisprudence.⁸² When a court assesses likelihood of consumer confusion and trademark dilution there are multiple factors that come into play and the weight given to each factor varies with each case and circuit.⁸³ Thus, assessing source-indicative gTLDs in determining similarity of the marks at issue as just one step in the analysis will not be the end all be all.

Moreover, as consumers become more accustomed to the new gTLDs, and as they start to see them as indicators of source, I propose that courts take “consumer sophistication” into account as they hear general Lanham Act claims, ACPA claims, and even nominative fair use defenses where source-indicating gTLDs are at issue. “Consumer sophistication” is a factor utilized in multiple circuits’ likelihood of consumer confusion tests.⁸⁴ As consumers become more aware of the new gTLDs, and start to see them as indicators of source, they will be less likely to be confused as to what they are clicking on because the overall domain name provides additional clues as to the identity of the owner. This may be especially true if the gTLD in question points towards a different product, for instance with a domain name like *delta.fashion*. I propose that courts include the new gTLDs and consider consumer perception and sophistication in relation to these gTLDs in their analysis, much like the Ninth Circuit

⁸² See also, Shimanoff, *supra* note 43 at 925.

⁸³ *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1538 (11th Cir. 1986) (“The issue of likelihood of confusion is not determined by merely analyzing whether a majority of the subsidiary factors indicates that such a likelihood exists. Rather, a court must evaluate the weight to be accorded the individual factors and then make its ultimate decision. The appropriate weight to be given to each of these factors varies with the circumstances of the case.”)

⁸⁴ *Georgia Pac. Consumer Products, LP v. Von Drehle Corp.*, 618 F.3d 441, 454 (4th Cir. 2010); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir.1961).

considered all of the words in the domain names at issue in the trademark nominative fair use case, *Toyota Motor Sales, U.S.A., Inc. v. Tabari*.⁸⁵

In *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, Toyota sued the Tabaris, owners of an auto broker business, for trademark infringement.⁸⁶ Toyota objected to the Tabaris’ use of the word “Lexus” in their domain names buy-a-lexus.com and buyorleaselexus.com.⁸⁷ Ultimately the Court allowed the Tabaris to keep their domain names based on the nominative fair use doctrine, which—in the Ninth Circuit—relies on a three-part test.⁸⁸ Using the test, the Court found that the “reasonably prudent consumer” would not be misled or confused by the Tabaris’ domain names.⁸⁹

Consumers who use the internet for shopping are generally quite sophisticated about such matters and won’t be fooled into thinking that the prestigious German car manufacturer sells boots at mercedesboots.com, or homes at mercedeshomes.com, or that comcastsucks.org is sponsored or endorsed by the TV cable company just because the string of letters making up its trademark appears in the domain.⁹⁰

⁸⁵ 610 F.3d 1171 (9th Cir. 2010).

⁸⁶ *Id.* at 1175.

⁸⁷ *Id.*

⁸⁸ *Id.* at 1175–76 (citing *Welles*, 279 F.3d 796, 801 (9th Cir. 2002) (quoting *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 308–09 (9th Cir. 1992))) (applying the doctrine the Court asked if “(1) the product was “readily identifiable” without use of the mark; (2) defendant used more of the mark than necessary; or (3) defendant falsely suggested he was sponsored or endorsed by the trademark holder.”).

⁸⁹ *Id.* at 1176.

⁹⁰ *Id.* at 1178.

Moreover, dicta in the case suggested that the Court believed that only a small subset of domain names incorporating trademarks actually cause confusion.⁹¹

V. CURRENT STATE OF NEW gTLDs IN DOMAIN NAME DISPUTE RESOLUTION PROCEDURES & WHY IT SHOULD CHANGE

A. *How ICANN Dispute Resolution Panelists View gTLDs*

Although tribunals have not dealt with the source-indicative function of the new gTLDs in formal trademark lawsuits, ICANN dispute resolution panelists deal with the issue every day. However, it appears that panelists presiding over UDRP and URS procedures may not be in agreement over the necessity of assessing source-indicating gTLDs in determining if a domain name is identical or confusingly similar to a trademark.⁹²

For instance, a WIPO panel recently looked at *Volkswagen.guru* in a UDRP domain name dispute.⁹³ The panel held that *.guru* did not change the fact that the domain

⁹¹ *Id.* Because the official Lexus site is almost certain to be found at *lexus.com* (as, in fact, it is), it's far less likely to be found at other sites containing the word Lexus. On the other hand, a number of sites make nominative use of trademarks in their domains but are not sponsored or endorsed by the trademark holder: You can preen about your Mercedes at *mercedesforum.com* and *mercedestalk.net*, read the latest about your double-skim-no-whip latte at *starbucksgossip.com* and find out what goodies the world's greatest electronics store has on sale this week at *fryselectronics-ads.com*. *Id.*

⁹² The fact that they are divided is especially troubling for trademark holders, as it increases uncertainty in domain name disputes.

⁹³ *Volkswagen Aktiengesellschaft v. Robert Brodi*, Case No. D2015-0299 (UDRP, April 24, 2015) (Taylor, Arb.), <http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2015-0299> [<https://perma.cc/N9TB-HJYC>].

name was confusingly similar to the registered Volkswagen mark, as Volkswagen was the dominant term.⁹⁴ The panel noted that while generic top-level domain suffixes have typically been disregarded when comparing the mark to the disputed domain name for purposes of determining confusing similarity, the introduction of hundreds of new gTLDs has altered the analysis. The panel looked at *.guru* in its confusing similarity analysis, noting precedent stating that “panels may determine that it is appropriate to include consideration of the top-level suffix of a domain name for the purpose of the assessment of identity or similarity.”⁹⁵ However, even taking *.guru* into consideration, the panelist found for the complainant and stated that “guru” was just an additional descriptive term that would not prevent confusion, as the Volkswagen SLD was still the dominant term.⁹⁶

Conversely, in a recent UDRP dispute over the domain name *Honeywell.cloud*, the panel refused to consider the *.cloud* gTLD in its confusing similarity analysis.⁹⁷ The decision stated, “Panels have decided that the affixation of a gTLD is necessary to form a valid domain name and, therefore, is irrelevant to a Policy ¶ 4(a)(i) analysis.”⁹⁸ Although the aforementioned cases were UDRP decisions, the disparity on how to treat the new gTLDs in domain name disputes appears to run through URS and

⁹⁴ *Id.*

⁹⁵ *Id.* (quoting *Canyon Bicycles GmbH v. Domains By Proxy LLC/van Eck*, No. D2014-0206, 2014 WL 1005826 (WIPO Arb. 2014) (Lothian, Arb.), <http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2014-0206> [<https://perma.cc/692V-JYYT>]).

⁹⁶ *Id.*

⁹⁷ *Honeywell International Inc. v. Juphoon System Software Co., Ltd. / Bob Liu*, Case No. FA1605001676061 (Forum July 9, 2016) (Lappa, Arb.), <http://www.adrforum.com/domaindecisions/1676061.htm> [<https://perma.cc/CMC8-ZUZS>].

⁹⁸ *Id.*

UDRP ICANN dispute mechanisms.⁹⁹

B. How ICANN Dispute Resolution Panelists Should View gTLDs

I propose that URS and UDRP panelists should all take source-indicating gTLDs into account as they weigh confusing similarity in domain name disputes. As stated above, in URS and UDRP proceedings the petitioner must prove that the domain name at issue is identical or confusingly similar to the petitioner's trademark to prevail.¹⁰⁰ Because of the source-indicating function of many the new gTLDs, panelists should acknowledge these new gTLDs as they perform their analysis. In many cases, source-indicating gTLDs might lead to a finding of increased confusing similarity as they did in the *maxwell-house.coffee* and *dunkin.menu* decisions.¹⁰¹ However, I would argue that source-indicating gTLDs should also be considered when they have the opposite affect on confusing similarity.

Moreover, I would propose that ICANN amend its UDRP and URS procedures to note that the new source-indicating gTLDs can play a role in consumer perception and

⁹⁹ See Facebook Inc. v. Radoslav, Case No. FA1308001515825 (Forum Sept. 27, 2013) (Wilson, Arb.), <http://www.adrforum.com/domaindecisions/1515825D.htm> [<https://perma.cc/4N98-EFZ4>] (refusing to consider gTLD *.pw* in first ever URS decision where domain name “facebok.pw” was at issue, and only comparing “Facebook” to “Facebok” in assessing confusing similarity); Alexis Kramer, *New gTLDs and Higher Burden of Proof Distinguish URS Rulings*, BLOOMBERG BNA (Jan. 16, 2016), <http://www.bna.com/new-gtlds-higher-n17179923256/> [<https://perma.cc/3MYT-WVD6>] (“A URS panel held that the *.coffee* gTLD added meaning to the domain name, *maxwell-house.coffee*, to show that the registrant intended to mislead Internet users into believing that its website was affiliated with the well-known coffee company's trademark. Another panel ruled that *.menu* added meaning to *dunkin.menu* to confirm the registrant's intent to divert users from the Dunkin' Donuts official website for commercial gain.”).

¹⁰⁰ *UDRP Policy*, ICANN, *supra* note 30.

¹⁰¹ Kramer, *supra* note 99.

thus may influence a confusing similarity analysis.¹⁰² For many of the same reasons listed above in my traditional trademark enforcement argument, and for the added benefit of consistency, the new source-indicating gTLDs should be taken into account across all ICANN dispute resolution mechanisms.

VI. CONCLUSION

A. *Businesses Should Think Twice Before Buying New gTLDs*

One of the offerings included in the new gTLD program is that businesses can go through the ICANN application process to register *.brand* as a top-level domain.¹⁰³ *.brand* applications accounted for roughly one third of the gTLD applications submitted in the 2012 round.¹⁰⁴ Brand gTLDs offer businesses a way to stand out

¹⁰² I recently had a conversation with Attorney Mark V.B. Partridge, a trademark litigator, WIPO panelist, and expert on ICANN domain name enforcement procedures. He stated that he believes source-indicating gTLDs should be taken into account in the identical or confusing similarity analysis employed in UDRP and URS proceedings. But instead of implementing changes to the policies, he thinks the system could eventually work itself out on its own. “Actually changing the procedures and policies would be very difficult,” said Partridge. “The UDRP has been able to evolve over time... the burden of proof evolved because panelists said that a preponderance of the evidence should be used.” Partridge talked about his involvement in the initial drafting of the UDRP, and the fact that since the policy was adopted in 1999 panelists have been able to shape the process by following court precedent, UDRP precedent, and basic trademark principals. However, he noted that the URS procedure might be more difficult to change through precedent, as decisions are typically much shorter. (*Notes with Author*). Although I still believe that the domain name dispute resolution procedures and policies should be amended, Attorney Partridge makes valid points on potential alternatives to a timely, costly, policy change.

¹⁰³ Laursen, *supra* note 6.

¹⁰⁴ *Brand Applications Account for One Third of All New gTLD*

from the crowd, build consumer trust in their brands, make their businesses more accessible, and ensure supply-chain safety and security.¹⁰⁵ Furthermore, brands that missed the first round of gTLD applications are gearing up for the next round (which is expected to occur between 2016–2019).¹⁰⁶ Twitter has already stated that it will apply to register gTLDs in the next round, and it hopes to see other social media companies apply as well.¹⁰⁷

However, businesses need to be aware of the fact that as they apply for and utilize *.brand* gTLDs, SLDs may start to become less important, and likely more generic. When businesses purchase *.brand* strings, they are increasing awareness of the new gTLDs and they are engaging in the process of strengthening gTLD source indication. Right now, because of low gTLD awareness, when consumers see a *.brand* gTLD they might be confused about source and wonder if the website is illegitimate. However, once powerhouse companies like Twitter start using *.brand* gTLDs, consumers will start to weigh gTLDs more heavily as indicators of source. As this metamorphosis occurs, gTLDs will likely start to play a large role in trademark infringement claims and domain name disputes, as discussed

Applications, MARK MONITOR (June 13, 2012), <https://www.markmonitor.com/mmblog/brand-applications-account-for-one-third-of-all-new-gtld-applications/> [https://perma.cc/UYA3-MAFK] (stating 664 of the gTLD applications submitted in 2012 were for *.brand* gTLDs).

¹⁰⁵ Jason Loyer, *Brand TLDs: Four Reasons To Move From .COM To Your .BRAND* (July 11, 2014), <https://www.neustar.biz/blog/four-reasons-to-move-from-com-to-your-brand> [https://perma.cc/78RD-7D5A].

¹⁰⁶ Stéphane Van Gelder, *Next gTLDs: 2016 or 2019?*, CIRCLEID (Sept. 30, 2014), http://www.circleid.com/posts/20140930_next_gtlds_2016_or_2019/ [https://perma.cc/3SZR-QCDF].

¹⁰⁷ *Twitter to seek gTLDs in second round*, TRADEMARKS & BRANDS ONLINE (Oct. 14, 2015), <http://www.trademarksandbrandsonline.com/news/twitter-to-seek-gtlds-in-second-round-4515> [https://perma.cc/ARH7-3KFM].

above. Furthermore, buying a *.brand* gTLD could hinder a business's ability to conduct its own trademark enforcement in third-party domain names. It might make it more difficult for Gucci to argue *Gucci.resale* is confusing if they themselves host the clothing *gucci* top-level domain.

B. gTLDs Should Affect Trademark Enforcement

The new gTLDs may never catch on. It has been more than three years since ICANN started delegating new gTLDs, and in North America, the rate of acceptance or even knowledge of these new gTLDs is very low.¹⁰⁸ Moreover, it appears that in many cases businesses are less than enthusiastic about using new gTLD strings.¹⁰⁹ Even when businesses have prevailed in URS cases, evidence shows that domain names that have been suspended through the URS procedure are not being picked up by brand owners at the end of the yearlong suspension period.¹¹⁰ At this point, with so little interest and awareness in the new gTLDs, it is difficult to make predictions about their future in trademark law.

However, with the increasing interest in *.brand* gTLDs, there is a possibility the new gTLDs will eventually catch on. Until that happens, trademark holders will need to vigilantly watch the status of gTLDs in trademark court proceedings and ICANN dispute resolution mechanisms. Trademark law largely depends on consumer perception and

¹⁰⁸ *ICANN Announces Phase One Results from Multiyear Consumer Study on the Domain Name Landscape*, ICANN (May 29, 2015), <https://www.icann.org/news/announcement-2015-05-29-en> [<https://perma.cc/28G8-JW46>].

¹⁰⁹ *What Happens to a Domain Name After the URS Suspension Expires?*, GIGA LAW (Aug. 12, 2015), <http://www.gigalaw.com/2015/08/25/what-happens-to-a-domain-name-after-the-urs-suspension-expires/> [<https://perma.cc/WR2H-EJEN>].

¹¹⁰ *Id.*

consumer confusion, and thus as consumers begin to recognize and understand the new source-indicating gTLDs, courts and ICANN panelists alike will likely be forced to adjust their approach to source-indicative gTLDs. Trademark law does not create un-checked property rights, and the new source-indicating gTLDs could actually potentially prevent consumer confusion by providing more information to consumers before they “click.”¹¹¹ Thus, it is highly important for courts, ICANN dispute mechanism panelists, and even trademark holders, to fully appreciate the significant role these new gTLDs can and should play in trademark enforcement proceedings.

¹¹¹ *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1176–77 (9th Cir. 2010) (“Prohibition of such truthful and non-misleading speech does not advance the Lanham Act’s purpose of protecting consumers and preventing unfair competition; in fact, it undermines that rationale by frustrating honest communication between the Tabaris and their customers.”).