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Was $7.5 Million a Good Deal for Business.com: The Difficulties of Obtaining Trademark Protection and Registration for Generic and Descriptive Domain Names

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COMMENTS

Was $7.5 Million a Good Deal for Business.com?¹
The Difficulties of Obtaining Trademark Protection and Registration for Generic and Descriptive Domain Names

Christie L. Branson†

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¹ eCompanies, LLC, a company providing services to new businesses on the Web, purchased the domain name <business.com> for $7.5 million in December 1999. See Peter Loftus, ECompanies Pays $7.5m For Domain Name 'Business.com,' THE FINANCIAL EXPRESS, at http://www.expressindia.com/fe/daily/19991212/fco11064.html (Dec. 12, 1999).

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I. INTRODUCTION

There are approximately 83.3 million users of the Internet in the 
United States. By 2002 that number is expected to exceed 165 
million Internet users in the United States alone. As a result of this 
increasing use of the Internet by Americans, many business 
enrepreneurs are moving all or part of their endeavors to an Internet 
web site. With the number of web sites growing exponentially, dot-
commers seeking a name for their business web site that is both 
catchy and memorable are finding such domain names increasingly 
limited. Even if a dot-commer is lucky enough to register a catchy 
domain name, there is no guarantee that trademark and unfair 
competition laws will provide protection against another party 
choosing a confusingly similar mark or dilutive domain name. The 
controversy surrounding the domain name <business.com> illustrates 
this dilemma.

eCompanies bought the domain name <business.com> for $7.5 
million from a Houston media entrepreneur who paid $150,000 for 
the domain name in 1996. The co-founder of eCompanies, Jake

2 See WORLDWIDE INTERNET POPULATION at http://www.commerce.net/research/stats/
   wswstats.html#uscanda (last visited Jan. 21, 2001).
3 See id.
4 A Silicon Valley slang term used to describe those working for an Internet company. See 
   generally Joanna Glasner & Katie Dean, 'Dot-Commers Go Home,' WIRED NEWS at 
5 Domain name registrations have grown from just over five million in the second quarter of 
   1999 to nearly twenty million in the second quarter of 2000. See QUICK FACTS at 
6 See Loftus, supra note 1 (seven and one-half million dollars is believed to be the highest price 
   paid for a domain name).
Winebaum, indicated that the purchase of <business.com> was not rash because <business.com> requires much less marketing than other domain names.\(^7\) What Jake Winebaum did not realize is that generic or descriptive domain names like <business.com> are not entitled to trademark protection or registration in the United States. While <business.com> may be an easy name to remember, other companies offering similar business-to-business services could create a company with the domain name <business.net> or <business.org> and compete directly with eCompanies. Customers of eCompanies could easily be led to the other competing sites and become confused as to which is the original.

Due to recent policies regarding trademark protection and registration for domain names implemented by the United States Patent and Trademark Office (USPTO),\(^8\) it is unlikely that eCompanies can prevent this scenario: the operation of competing businesses with confusingly similar domain names. This comment seeks to explore the challenges, under current policies and case law, of registering generic and descriptive domain names on the USPTO's Principal Register and to examine how unfair competition laws apply to the protection of generic and descriptive domain names.

II. BACKGROUND

A. What is the Internet?

In the late 1960s the United States Defense Department's Advanced Research Projects Agency began networking computers together to transfer information.\(^9\) After many years of research, the result was the ARPANET, a system created to tie incompatible networks together.\(^10\) This system became the backbone for the modern day Internet.\(^11\)

Each computer on the Internet is assigned a unique Internet Protocol (IP) address.\(^12\) When information is distributed over the

\(^7\) See id.
\(^8\) The United States Patent and Trademark Office is the American government agency assigning rights and privileges to trademarks and patents.
\(^9\) The ARPANET was created so that in the event of the destruction of one computer, the information stored on that computer would not be destroyed because all the computers were linked via a network. See generally DOUGLAS E. COMER, THE INTERNET BOOK 54 (1994).
\(^10\) See id.
\(^11\) See id.
\(^12\) An IP address is a number assigned by a domain registration service to a particular computer on the Internet. See id. at 127.
Internet, it is split into packets containing the IP address of the computer to which it is sent. In the mid-1980s the domain name system (DNS) was created to manage the IP addresses of computers and networks. As a result of continued development of the DNS, IP addresses can now correspond to alphabetic addresses making human memorization of computer domain names much easier.

For example, instead of remembering the numerical IP address 128.10.2.1, one merely needs to recall the domain name <arthur.cs.purdue.edu>—the alphabetic equivalent of the computer with the IP address of 128.10.2.1. Unfortunately, because there is no obvious correlation between the IP address and the words in a domain name, confusion often arises. The number '128' in the above mentioned IP address has no correlation to the word 'arthur' in the domain name. This makes it difficult for users to remember the IP address which is why most users choose to use the domain name to locate a particular computer on the Internet.

The World Wide Web (the Web) is probably the fastest growing part of the Internet. Accordingly, it is becoming an important mechanism for commerce. Each computer providing information on the Web does so in the format of a web site consisting of a series of web pages that include text, pictures, sounds and links to other web sites or pages. Using programs like Microsoft's Internet Explorer or Netscape, Internet users can browse the Web to view different web sites. To find a particular web site, users have several options: they

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13 See id.
15 See id.
16 See COMER, supra note 9, at 134.
17 See id. at 133.
18 See id.
19 See id. at 134.
20 See id.
21 The Web is a collection of information contained in individual computers all over the world.
22 The Web is only one part of the entire Internet.
23 See Brookfield Communications, Inc. v. West Coast Entm't, Corp., 174 F.3d 1036, 1044 (9th Cir. 1999).
24 See generally Panavision Int'l v. Toeppen, 141 F.3d 1316, 1318 (9th Cir. 1998).
25 See id.
26 Web Browsers such as Microsoft's Internet Explorer or Netscape are computer programs translating the web site's computer code into a readable format for the user to browse. MICROSOFT CORP., Browser Basics Part I: Getting Started Browsing the Web, at http://www.microsoft.com/insider/internet/articles/browse.htm (last visited Mar. 9, 2001).
27 See Brookfield Communications, 174 F.3d at 1044.
can either guess at the domain name, type in the IP address or use a search engine. To be effective when guessing at a domain name, users need to have a basic understanding of the DNS.

The DNS structure requires that domain names contain a top level domain (TLD) and second level domain. In a domain name the TLD is the last set of letters, comprised of two or three letters after the last period, representing the source or country designation. The second level domain name is longer and more specific than the TLD and usually describes the web site. For instance, in the domain name <cars.com>, 'cars' is the second level domain while <.com> is the TLD. Since there cannot be duplicate domain names, the Internet Corporation for Assigned Names and Numbers (ICANN) administers the assignment of domain names. Web site owners must choose a TLD to add to their chosen second-level domain name.

Currently the generic TLDs are: <.com> for commercial organizations; <.edu> for education entities; <.gov> for government agencies and departments; <.net> for networks; <.org> for non-profit organizations; <.mil> for the military and <.int> for organizations established by international treaties. Individual countries also have non-generic or geographic TLDs such as <.fr> for France. Due to the abundant use of the Internet and the growing need for new domain names, TLDs such as <.aero>, <.biz>, <.coop>, <.info> and <.museum> have been announced by ICANN, but not yet implemented.

28 Search engines such as <google.com> allow a user to type in desired topics and the result will list several web sites containing information they desire. Google, Google, at http://www.google.com (last visited Mar. 9, 2001).
29 See generally MAMBRETTI & SCHMIDT, supra note 14.
30 Each computer on the Internet is assigned a unique IP address corresponding to a particular domain name; domain names are not repeated. See generally COMER, supra note 9, at 129-34.
33 The United States has the geographic TLD <.us>. It has been underused because Americans generally choose to use generic TLDs for their web sites. Users wanting to use a geographic TLD need to contact the appropriate country’s domain name administrator. See generally Heather N. Mewes, Memorandum of Understanding on the Generic Top-Level Domain Name Space of the Internet Domain Name System, 13 BERKELEY TECH. L.J. 235, 237 & n.8 (1998) (addressing a proposal to enhance and expand the domain name system).
ICANN, in its role as domain name administrator, approves domain registry services such as Network Solutions to assign domain names on a first come, first serve basis.\textsuperscript{35} Currently, only domain names with the TLD of <.gov>, <.mil> and <.int> are scrutinized by registration entities to confirm that the web site belongs to the appropriate type entity.\textsuperscript{36} This limits the number of available generic TLDs that the public can potentially register. As a result, a business can choose the same second level domain as a competitor and obtain one of the other generic TLDs available. As mentioned earlier, someone competing with <business.com> could obtain the domain name <business.net>.

\textbf{B. What is a Trademark?}

The Lanham Act serves as the modern day American law governing trademarks and unfair competition.\textsuperscript{37} The Lanham Act provides protection from unfair competition and trademark infringement and also allows for registration of three different types of marks: trademarks, service marks and certification marks.\textsuperscript{38} A trademark includes “any word, name, symbol, or device \ldots to identify and distinguish his or her goods \ldots [and] to indicate the source of the goods.”\textsuperscript{39} Conversely, service marks are words, names, symbols or devices used to identify and distinguish the source of services.\textsuperscript{40}

\textbf{C. Registration of Trademarks}

The Lanham Act provides for registration of marks on either the Principal or Supplemental Register. Marks on the Principal Register arguably receive more protection. For instance, registration on the Principal Register provides, \textit{inter alia}, prima facie evidence that the mark is valid, priority to use the mark exclusively, incontestability after five years, nationwide constructive notice of use and exclusion of infringing imports.\textsuperscript{41} The Supplemental Register’s primary

\textsuperscript{35} See id.
\textsuperscript{36} Allyn Taylor, \textit{Domain Names: The Challenge They Present to Trademark Law}, Presentation at the Santa Clara University School of Law Intellectual Property CLE Series (Dec. 3, 1999). For example, the TLD <.org> and <.net> are routinely assigned to commercial entities despite the not-for-profit and network identification of the TLD.
\textsuperscript{38} See id. § 1053.
\textsuperscript{39} See id. § 1127.
\textsuperscript{40} See id. This comment will only explore domain names used as service marks.
\textsuperscript{41} See id. § 1094.
purpose is to assist mark owners in registering their marks in other countries. Moreover, marks on the Supplemental Register usually have not met the same requirements needed for the Principal Register. A mark on the Supplemental Register can migrate to the Principal Register once it has met the requirements for the Principal Register. Generally, most owners want their mark to be on the Principal Register because of the additional benefits provided. Incidentally, the Lanham Act also provides for protection of marks not listed on either register, so long as the mark meets the minimum requirements of a valid mark.

D. Requirements for a Valid Trademark

For a mark to receive protection, several requirements must be fulfilled. First, the mark must be used in interstate commerce. This requirement is necessary because federal trademark law stems from the Commerce Clause of the United States Constitution. Use in commerce is defined as the "bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark." Second, a mark must serve to identify and distinguish the source of the services or goods. The appropriate standard focuses on whether an ordinary customer would determine that the asserted mark functions to identify or distinguish the product or service, regardless of the applicant’s intent, expectation or hope that it does so. In other

42 The Paris Convention provides, in Article 4, that if a person files an application in his or her home country they will receive priority of use for that mark abroad as of the date filed in their own country. Registration or application to the Supplemental Register provides an avenue for United States marks that do not meet the requirements of the Principal Register but do meet other countries' requirements to be registered abroad. See generally Convention for the Protection of Industrial Property, July 14, 1967, art. IV, 6 ILM. 806.

43 As will be discussed later, marks on the Supplemental Register have not acquired the distinctiveness necessary for the Principal Register. See 15 U.S.C.A. § 1091(a) (West 1997 & Supp. 2000).


45 See id. § 1125.

46 See id. § 1051. Owners wishing to register marks that have not been used in commerce may file an intent to use application. Once the mark is used in commerce, then a statement of use can be filed.


49 See id.

50 See In Re Standard Oil Co., 275 F.2d 945, 947 (C.C.P.A. 1960) (denying registration for the mark "Guaranteed Starting" because it did not serve to identify and distinguish services for auto service).
words, a mark must represent the origin of the goods or services and not merely serve as a way to contact the source.

Third, marks must also be inherently distinctive. Inherently distinctive marks are those that “immediately serve as an identifier of source from the very first moment it is used.” For example, consumers automatically perceive the mark ‘McDonald’s’ as indicative of fast food restaurants. To determine if a mark is inherently distinctive, marks are categorized as (1) suggestive, (2) arbitrary or fanciful, (3) generic or (4) descriptive. While each category is distinct, it is possible for a given mark to belong to different categories for different uses.

Marks categorized as suggestive, arbitrary or fanciful are inherently distinctive. These marks receive trademark protection and can be registered on the Principal Register so long as they meet other requirements discussed above. Suggestive marks are those that “require . . . imagination, thought and perception to reach a conclusion as to the nature of the goods.” An example of a suggestive mark would be ‘Brown-in-Bag’ for transparent cooking bags. The term ‘Brown-in-Bag’ suggests that the product cooks in a bag, yet it does not describe the bag’s use. Arbitrary marks are common terms that have no immediate connection to the product or services upon which they are associated. The word ‘Apple’ for Apple Computers is an example of an arbitrary mark because ‘apple’ does not describe the characteristics of the computer. Fanciful or coined marks are terms that are invented or created for the particular product. Examples of fanciful marks include ‘Xerox’ for copy machines and ‘Kodak’ for film.

Generic terms are those that “refer . . . or [have] . . . come to be

51 2 MCCARTHY, supra note 47, § 11:4, at 11-10.
52 See id.
53 See id. at 10-11.
54 See id. at 10.
55 See id. at 904.
56 See id. § 11:8, at 11-14.
58 See id. § 11:11, at 11-17.
TRADEMARKABILITY OF DOMAIN NAMES

understood as referring, to the genus of which the particular product is a species. While the term ‘aspirin’ was originally intended as a trademark, it has since become generic for the drug acetylsalicylic acid. Today, the only term that the public uses for the drug acetylsalicylic acid is the generic term ‘aspirin.’ Other generic terms include shredded wheat, raisin bran, yo-yo and escalator. Generic terms are not inherently distinctive and, therefore, cannot be registered on either the Principal or Secondary Registers or receive trademark protection.

The rationale for not allowing generic terms registration or trademark protection is that registration would improperly grant the owner of the term a monopoly. As such, competitors could never use the term to describe his or her goods. If one were allowed to register or receive trademark protection for the generic term ‘aspirin,’ competitors would be unable to use the word ‘aspirin’ to describe competing products that also contain acetylsalicylic acid. This would be damaging to competitors since the public only knows the product as ‘aspirin.’

Descriptive terms are those that describe the ingredients, qualities or characteristics of the product or good. The Lanham Act does not allow initial registration on the Principal Register or extend protection to marks that are merely descriptive. Examples of marks that the USPTO has deemed descriptive include ‘Bed & Bath’ for a store selling bed and bath products and ‘Pudding Treats’ for a pudding dessert.

According to Professor J. Thomas McCarthy, there are two main reasons for not allowing merely descriptive terms to attain trademark

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64 See Bayer Co. v. United Drug Co., 272 F. 505 (S.D.N.Y. 1921) (finding the mark ‘aspirin’ generic for the drug acetylsalicylic acid).
68 See CES Publ’g Corp. v. St. Regis Publ’ns, 531 F.2d 11, 13 (2d Cir. 1975) (holding the mark 'Consumer Electronics' for a magazine generic and denying registration).
69 See id.
70 See Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 10 (2d Cir. 1976).
First, since descriptive terms can be applied to a whole range of products and services, one term cannot function to identify and distinguish these goods and services. Second, because descriptive terms are so commonly used by the public, granting one person the right to use a particular term will “deplete the general vocabulary available to all for description.”

Despite the fact that descriptive marks are not initially registerable on the Principal Register, the Lanham Act does allow such marks to receive protection or proceed to registration on the Principal Register if they later acquire secondary meaning. Descriptive marks are deemed to have become inherently distinctive after attaining secondary meaning. Secondary meaning is acquired if the public has come to identify the term with the owner’s product or service. The descriptive mark ‘Coca-Cola’ has acquired secondary meaning because ‘Coca-Cola’ means, to most people, the familiar soda product available everywhere rather than a compound of particular substances. Descriptive marks that have not attained secondary meaning may be registered on the Supplemental Register until secondary meaning is attained. Subsequent to obtaining secondary meaning, the mark may then be moved to the Principal Register.

E. What is Trademark Protection?

In addition to providing a mechanism where mark owners can register their marks, the Lanham Act also protects valid marks by preventing others from using marks that are confusingly similar. More specifically, the registrant of a mark on the Principal Register can prevent others from using a reproduction, copy, counterfeit or colorable imitation of a mark in commerce that “is likely to cause confusion, mistake, or . . . to deceive as to the source of the original mark.” Further, owners of marks may obtain injunctions and

74 See 2 MCCARTY, supra note 47, §11:18, at 11-25.
75 See id.
76 Id.
77 Id.
78 Descriptive marks that are not inherently distinctive are still registerable on the Supplemental Register. See 15 U.S.C.A. §§ 1052 (f), 1091(a) (West 1997 & Supp. 2000).
81 See Coca-Cola Co. v. Koke Co. of Am., 254 U.S. 143, 146 (1920).
83 See id.
monetary damages against the infringer.  

One of the more recent amendments to the Lanham Act provides for protection of famous marks against dilution. Trademark dilution is the "lessening of the capacity of a famous mark to identify and distinguish goods or services." Trademark dilution claims have become more prevalent because of the Internet and the Web. People will obtain or register domain names consisting of famous marks and create web sites that dilute or tarnish the fame of actual marks.

F. What Trademark Protection is Given to Unregistered Marks?

Section 1125 of the Lanham Act allows protection of unregistered marks from other marks causing a likelihood of confusion or a misrepresentation of the nature, quality or characteristic of the services or goods. Those found in violation of Section 1125 can be enjoined from using the mark and fined. Although this section applies to all unregistered marks, most courts have been reluctant to grant trademark protection to generic and merely descriptive unregistered marks. However, some courts have given protection to generic and descriptive marks that otherwise could not be registered on the Principal Register.

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83 See id.
84 See id. § 1125(c)(1).
85 See id. § 1127.
86 Since there is little restriction on who can and what domain names can be registered, it is relatively easy to obtain any domain name. Network Solutions, Domain Name Registration Services from the Dot Com People, at http://www.netsol.com (last visited Mar. 9, 2000). As such, people have obtained domain names of entities that they have no relation to hoping that it will attract a lot of attention to their web site.
87 See Hasbro, Inc. v. Internet Entm't Group, Ltd., 40 U.S.P.Q.2d 1479 (W.D. Wash. 1996) (finding a preliminary injunction against Internet Entertainment's use of Hasbro's trademark 'candyland' in the domain name <candyland.com> for a sexually explicit web site). See also Intermatic Inc. v. Toeppen, 947 F. Supp. 1227 (N.D. Ill. 1996) (granting summary judgment because registration of the mark 'intermatic' in a domain name diluted Intermatic's mark); see also Panavision Int'l v. Toeppen, 141 F.3d 1316 (9th Cir. 1998).
88 See id. § 1125(a)(1).
89 See id. § 1116-17.
90 See Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc., 781 F.2d 604, 610 (7th Cir. 1986) (finding that a schematic 'location box' in company's yellow pages is descriptive and not subject to trademark protection).
III. ISSUES PRESENTED

In order to facilitate communication with a customer base, brick and mortar companies existing independently of the Internet will want to own or register a domain name that corresponds to the name of their brick and mortar company.92 For example, The Gap, Inc. has the domain name <gap.com>. Moreover, many businesses strive to acquire names that are easy to remember, like <business.com> for a web site providing information about the best business-to-business services on the Web. Unfortunately, pursuing these goals often requires traveling down a path fraught with disaster and disappointment.

Owners of <business.com> may want to provide consumers with an easy name to remember but also want to prevent a web site like <business.net> or <business.org> from benefiting from their goodwill. Unfortunately for <business.com>, strict application of traditional trademark and unfair competition law will not provide protection against marks like <business.net> or <business.org> since they are merely descriptive or generic for their services.93 In addressing these issues, the USPTO released an Examination Guide for applicants seeking to register domain names on either the Principal or Secondary Register.94 The Examination Guide seeks to clarify which domain names are considered generic and descriptive and therefore undeserving of trademark protection.95

This comment will address the general challenges presented by trademark law in registering or receiving protection for all domain names. An evaluation of the USPTO Examination Guide's policies regarding generic or descriptive domain names will be undertaken by showing analogies between domain names, vanity phone numbers, and radio stations. A detailed analogy of domain names to vanity phone numbers shows that while traditional trademark law does not allow for protection, it might be possible, although unlikely, for

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93 In late December 1999, owner of the domain name <home-market.com> lost an action for a preliminary injunction against the owner of the domain name <home-market.net>. The court found <home-market.com> descriptive without secondary meaning and denied trademark protection. See Shade's Landing, Inc., v. Williams, 76 F. Supp. 2d 983, 991 (D. Minn. 1999).
95 See id. Domain names that are comprised of generic or descriptive terms will not be registrable or entitled to protection. Examples are <bank.com> for banking services and <soft.com> for facial tissues.
generic or descriptive domain names to attain some protection. Further, an analogy to radio station frequencies shows additional difficulties posed to affording protection to domain names.

IV. ANALYSIS

A. Can a Domain Name be Registered or Receive Trademark Protection?

1. What Type of Mark is a Domain Name?

With respect to domain names as protected marks, most owners are concerned with using domain names as service marks instead of trademarks. Domain names usually represent the services associated with the web site instead of the domain name representing a good. For example, <carsdirect.com> would be a web site used to identify and distinguish an entity where one could purchase or learn about cars. Conversely, the web site at <ford.com> merely advertises the cars Ford Motor Company produces. Advertising one's goods, however, is not a service according to the Lanham Act. Accordingly, the domain name <ford.com> does not serve to identify and distinguish the cars and products made by Ford but serves as a forum to learn about the cars and where to buy them. If Ford were to provide the service of selling their products from their web site, then the domain name <ford.com> would be entitled to trademark protection as a service mark. From this example, it is clear that most domain names will be considered service marks and are more apt to receive protection if the web site provides newsletters, information on services to be obtained, downloadable software or sells products.

2. Use in Commerce Requirement

As discussed above, marks must meet the use in commerce requirement in order to receive trademark protection or to be registered on either register. It is difficult to ascertain when a domain name is used in commerce as required by the Lanham Act. Two principal cases have differing opinions determining when a

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96 See generally 1 MCCARTHY, supra note 47, § 7:17.1, at 7-24.
98 Also referred to as the 'commercial use' requirement.
domain name is used in commerce for purposes of the Lanham Act.  

In Brookfield Communications Inc. v. West Coast Entertainment Corp., the plaintiff alleged likelihood of confusion and ownership of the domain name <moviebuff.com>. The Ninth Circuit Court of Appeals determined that whoever first used the mark in commerce was also entitled to ownership. Along these lines, the plaintiff used the mark ‘moviebuff’ in commerce in association with Internet-based products while the defendant claimed that registration of the domain name <moviebuff.com> with Network Solutions was the initial commercial use of the mark.  

The court disagreed with the defendant and stated that registration of a mark with Network Solutions, a domain name registry service, was essentially just a means to reserve a domain name and does not fulfill the use in commerce requirement of the Lanham Act. The court also dismissed the defendant’s argument that use of <moviebuff.com> in e-mail communication with customers and lawyers was commercial use.  

In order for use of a domain name to satisfy the commercial use requirement of the Lanham Act, the mark must be used in conjunction with the actual sale or disbursement of goods or services. In this case, commercial use for the defendant was established when the defendant made a widespread and public announcement about the imminent launch of its web site.  

Such a decision, however, was in direct contradiction to the Ninth Circuit’s holding, one year earlier, in Panavision International L.P. v. Toeppen. In Panavision, the Ninth Circuit found that use in commerce was established on the date that the defendant registered...
the domain name <panavision.com> with Network Solutions. Toeppen involved a claim by Panavision against Toeppen for trademark dilution because of Toeppen's use of the domain name <panavision.com>. The defendant made a business of registering popular trademarks as domain names with Network Solutions and then selling or licensing the domain name to the trademark owner.

The Ninth Circuit reasoned that since Toeppen was acting as a "spoiler" by preventing others from doing business on the Internet with their own trademark, registration with Network Solutions was commercial use. It is likely that the Ninth Circuit reached this conclusion simply to allow the case against Toeppen to be decided with respect to the dilution claim.

These two decisions create complications for domain names that are incapable of being registered or have not been registered on the Principal or Secondary Register. If there is a lawsuit regarding trademark ownership, infringement or unfair competition, the courts might determine fulfillment of the commercial use requirement based on the cause of action instead of how commercial use is articulated in Section 1127 of the Lanham Act.

For example, if the owner of the mark 'Kodak' sues the owner of the domain name <kodak.com>, a court may determine that the commercial use requirement for trademark protection has been satisfied based on whether the cause of action alleged is likelihood of confusion as in Brookfield Communications or trademark dilution as in Toeppen. If the cause of action is likelihood of confusion, then the use in commerce requirement is fulfilled depending on how the owner used the domain name in commerce. If the cause of action is trademark dilution, then the use in commerce requirement is fulfilled automatically because the defendant must have registered with a domain registry service in order to receive the domain name.

This method of deciding the commercial use requirement for varying types of trademark protection is irrational. Instead, the commercial use requirement for trademark protection should depend strictly on how the mark is used in the course of trade as reasoned in

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111 See id. at 1324-26.
112 See id. at 1327.
113 See id. at 1319.
114 See id. at 1325.
115 To state a cause of action under the Trademark Dilution Act, the defendant must use the diluting mark in commerce. See 15 U.S.C.A. § 1125(c)(1) (West 1997). The Ninth Circuit affirmed the decision of the lower court against Toeppen on the dilution claims. See Panavision Int'l, 141 F.3d 1316.
Brookfield Communications. The Toeppen decision directly contradicts Congress’s intent regarding the commercial use requirement. The Lanham Act states commercial use must not be “merely to reserve a right in the mark.”\footnote{16} A domain name registry service functions merely to reserve the rights to a specific domain name, thus making the Toeppen standard bad law.

One reason the Toeppen court may have characterized the commercial use requirement as it did was simply to prevent cybersquatting. Cybersquatting is the unauthorized registration or use of trademarks as Internet domain names or other identifiers of on-line locations.\footnote{17} When the Toeppen case was filed, the Trademark Dilution Act was the only promising means for trademark owners to prevent others from making a business out of registering famous trademarks as domain names with domain registry entities.\footnote{18} In order to have a valid cause of action under the Trademark Dilution Act, the use in commerce requirement must be met. To meet this hurdle, the Toeppen court may have exhibited an element of judicial activism and characterized the use in commerce test to its advantage to proceed with the dilution claim.

In 1999 the Anticybersquatting Consumer Protection Act was enacted to address cases like Toeppen involving cybersquatting.\footnote{19} Therefore the use in commerce test enunciated by the Toeppen court should be given little weight. Consequently, the Brookfield precedent is the appropriate test to determine use in commerce for domain names.\footnote{20} For a domain name to establish use in commerce, it must do so in conjunction with the sale of or disbursement of services.

3. The Domain Name as an Identifier and Distinguisher of Services

To gain trademark protection or registration, the domain name must also serve as an identifier and distinguisher of the source of business services. Application of this requirement to domain names

\footnote{See Panavision Int'l, 141 F.3d 1316.}
\footnote{See Robert D. Gilbert, Cybersquatters Beware: There Are Two New Ways to Get You, NEW YORK LAW JOURNAL, Jan. 24, 2000, at 1 (explaining that 'use in commerce' was a hurdle for trademark litigators trying to obtain a judgment under the Lanham Act against businesses using marks without their permission as domain names).}
\footnote{See 15 U.S.C.A. § 1125(d) (West Supp. 2000).}
\footnote{Brookfield is the more appropriate precedent because the Anticybersquatting Consumer Protection Act addresses the problem of cybersquatting while Toeppen is applicable to cases involving the legal theory of dilution as a means for preventing cybersquatting.}
is difficult because the name of the business is also a location on the Internet. The USPTO has been strict in applying this requirement to domain names. In the case of In re William H. Eilberg, the applicant tried to register <www.eilberg.com> as a service mark for his legal services. However, the name Eilberg used to identify his services was 'William H. Eilberg, Attorney at Law.' Eilberg used the domain name <www.eilberg.com> on his stationary only.

The Trademark Trial and Appeals Board (TTAB) subsequently refused to register the mark because the applicant used the domain name primarily as a contact device and not as a service mark to "identify . . . and distinguish . . . applicant's legal services." The TTAB speculated that if the applicant had also named his services <www.eilberg.com>, it is likely the mark could have been registered. Therefore, domain names that provide a mechanism for learning about a company are more difficult to establish as a valid mark. Therefore, it is best for companies that wish to do business on the Internet to use the same name for both the off-line business and the domain name.

4. Is the Domain Name Inherently Distinctive?

An additional dilemma associated with domain names is determining if a domain name is inherently distinctive. A domain name must be inherently distinctive to attain trademark protection or registration on the Principal Register. Domain names contain many different terms that can be categorized separately as descriptive, generic, arbitrary, suggestive or fanciful. In the example of the domain <goldendoorspa.com>, 'golden door spa' could be suggestive while the <.com> may only be descriptive of the entity. Marks such as these are called composite marks. More specifically, a composite mark consists of a generic or descriptive term combined with other generic or descriptive terms, inherently distinctive terms or suffixes. Adding 'ize' to 'Nylon' to make 'Nylonize' is an example of a composite mark.

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122 See id.
123 See id. at 1956.
124 See id. at 1957.
125 See id.
126 See id. at 1957.
127 McCarthy, supra note 47, § 11:4, at 11-10.
128 See id. § 12:39, at 12-78.
129 See McCarthy, supra note 47, § 11:4, at 11-10.
In examining registration of a composite mark, courts look at the mark as a whole to determine if the mark is inherently distinctive. But courts have had contrasting results in analyzing composite marks. For example, although the service mark ‘Committee for Idaho’s High Desert’ for environmental education was found not to be generic, the composite mark ‘Blinded Veterans Association’ was deemed generic.

When determining if a domain name can be registered or protected by the Lanham Act, domain names could be analyzed as composite marks. A domain name like <www.aspirin.com> could be considered a composite mark comprising the terms ‘www,’ ‘aspirin,’ and ‘.com.’ Taken individually, each of these words are generic; ‘aspirin’ is clearly a generic term and it is likely that the terms ‘www’ or ‘.com’ would be found generic as well. When analyzing the mark <www.aspirin.com> as a whole, however, a different conclusion might result.

In cases examining composite marks, courts examine the common words or phrases that the public recognizes as the good or service to be described. The common phrase that the public commonly attaches to ‘Committee for Idaho’s High Desert’ could be “environmental advocacy organization.” Since there is another term than can be attached to ‘Committee for Idaho’s High Desert,’ the mark is not generic because the public would recognize the service under a different name.

Applying this method to <www.aspirin.com>, the public could potentially expect the name of the goods or services provided to be an aspirin information newsletter or the services to be those of an aspirin maker. Under this line of analysis, it is likely that the composite mark <www.aspirin.com> is not generic because the public, when looking at the mark as a whole, could associate a different name for the services than that of the mark <www.aspirin.com>.

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129 See Comm. for Idaho’s High Desert v. Yost, 92 F.3d 814, 821 (9th Cir. 1996); see also Cal. Cooler, Inc. v. Loretto Winery, Ltd., 774 F.2d 1451, 1455 (9th Cir. 1985).

120 See Comm. for Idaho’s High Desert, 92 F.3d at 822.


122 See Bayer Co. v. United Drug Co., 272 F. 505 (S.D.N.Y. 1921).


124 See Magic Wand, Inc. v. RDB, Inc., 940 F.2d 638, 640 (Fed. Cir. 1991); see also Comm. for Idaho’s High Desert, 92 F.3d at 821; Cal. Cooler 774 F.2d at 1455-56.

125 Comm. for Idaho’s High Desert, 92 F.3d at 821-22.

126 See id. at 822.
Rather than analyzing a domain name as a composite mark, one could use court-enunciated tests to determine whether a term is generic. One example is the Ninth Circuit’s ‘who-are-you/what-are-you’ test whereby a term is generic if it fails to answer the question ‘who are you?’ Under this test, ‘[i]f the primary significance of the trademark is to describe the type of product rather than the producer, the trademark [is] ... a generic term and [cannot be] ... a valid trademark.’ In applying this test, Judge James Ware of the Northern District of California determined that the domain name <sex.com> was generic and not entitled to trademark protection because neither ‘sex’ nor <sex.com> reveals anything about the source of <sex.com>.

If the who-you-are/what-you-are test is used instead of analyzing domain names as composite marks, there will be near automatic loss of trademark protection to all domain names that border between the designation of generic and descriptive because no relatively new domain name has acquired secondary meaning.

An argument to prevent a domain name from being deemed generic is that the mark is an on-line version of what the public would otherwise deem a physical location. Because <grocerystore.com> is on-line and not located at a physical place, one could argue it is not really generic or what the public would associate with the term ‘grocery store.’ Conversely, it is possible that the public would associate any phrase (regardless of whether it is generic or not) combined with ‘www’ and <.com> as a way to indicate a source for services or goods on the Web. Clearly, since a substantial majority of domain names on the Internet start with ‘www,’ it is likely that the public knows that the TLD (whether it be <.com>, <.net> or <.org>) denotes what type of entity the domain name represents. For example, <grocerystore.com> is analogous to the generic term ‘grocery store’ because the public gives little significance to the terms ‘www’ and <.com>. This is logical because it would be unfair to give trademark significance to terms like ‘www’ and a TLD that every web site provider must use as part of his or her address.

Application of case law involving composite marks to domain names consisting of descriptive terms is even more damaging. For

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137 See Kremen v. Cohen, 2000 WL 1811403 (N.D. Cal. 2000); sce also Filipino Yellow Pages, Inc. v. Asian J. Publ’n., 198 F.3d 1143, 1147 (9th Cir. 1999).
139 See Kremen, 2000 WL 1811403.
140 See generally Taylor, supra note 36.
example, the domain name <www.88¢store.com> contains the mark ‘88¢store’ that was previously found to be descriptive. Yet the same issue is presented concerning the terms ‘www’ and the TLD. Since most website providers are forced to use ‘www’ and a TLD, it is unlikely that they can use them to prevent the mark from being descriptive.

Additionally, use of ‘www’ and a TLD may even make the mark more descriptive because the TLD usually describes the entity and thus hinders the ability to register on the Principal Register or to attain trademark protection. The ‘www’ and TLD show that the mark represents an on-line service. More specifically, the TLD is very specific in the type of entity the mark represents as its source, whether it be <.com> for commercial or <.org> for organization. However, one is forced to defer to the USPTO’s theory that the TLD and ‘www’ have no trademark significance. As a result, the only hope for marks consisting of descriptive terms is to obtain trademark protection or registration on the Principal Register by acquiring a secondary meaning.

A more complicated issue arises when an owner adds words to the domain name to contrast the effects of disclaiming ‘www’ and the TLD. An example of this situation is the mark <www.food&beverageonline.com> for an on-line newsletter. A court held that ‘food&beverageonline’ was merely descriptive regardless of whether the term ‘online’ was used. Since the applicant was forced to disclaim the TLD and ‘www,’ the domain name was treated exactly as a regular mark. This decision presents a problem because web sites which provide a nontraditional form of goods and services cannot indicate this feature in their mark by using the term ‘online’ out of fear that that their mark will be considered descriptive. If this occurs, marks such as ‘food&beverageonline’ may only proceed to registration on the Principal Register and attain trademark protection after acquiring a secondary meaning.

141 88¢ Stores, Inc. v. Martinez, 361 P.2d 809, 811 (Or. 1961) (finding no secondary meaning).
142 See Examination Guide, supra note 94.
144 See id.
145 It is also possible that descriptive terms with other variants indicating association with commerce or the Internet will be considered descriptive. Examples include <ebusiness.com> or <idrugstore.com>.
5. The USPTO’s Approach to Registering and Providing Trademark Protection to Domain Names

The USPTO released an Examination Guide to guide the public through the rules and policies regarding registration of domain names on the Principal and Secondary Registers. The Examination Guide requires that some domain names consisting of only generic or merely descriptive components disclaim these components in addition to ‘www’ and the TLD. This prevents the entire mark from registration on the Principal Register. Yet, a domain name with merely descriptive or generic components can avoid disclaimer if it is considered a unitary mark. A mark is unitary if it creates “a commercial impression separate and apart from any unregistrable component.”

According to the Examination Guide, a second level domain containing a dot as in <xyz.bank.com>, or no spaces as in <xyzbank.com>, will be considered unitary and not require a disclaimer even though the portion <bank.com> is probably merely descriptive or generic. Conversely, <xyz_bank.com> is not a unitary mark because there is a space between ‘xyz’ and ‘bank.com.’ Therefore, the generic or merely descriptive portion, ‘bank.com,’ must be disclaimed, leaving only the mark ‘xyz’ eligible for registration. Essentially, the USPTO is not giving any trademark significance to the TLD and is instead considering the components of the second-level domain as the essence of the mark.

However, the distinction between unitary and non-unitary marks in this manner is illogical because a space or a dot in a second level domain does not create a different commercial impression on the consumer. These domain names are usually perceived as a whole because the domain name mirrors the company name as in <business.com>. Therefore, the distinction between marks that are unitary and non-unitary provides an arbitrary basis for granting

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147 See TMEP, supra note 97, § 1213.07 (1999). An entire mark may not be disclaimed. If a mark is not registrable as a whole, a disclaimer will not make it registerable.

148 See TMEP, supra note 97, § 1213.06(a) (1999); see also Examination Guide, supra note 94.

149 See TMEP, supra note 97, § 1213.06(a) (1999).

150 See Examination Guide, supra note 94.

151 Although domain names cannot contain spaces, many try to register their company mark with <.com> added to it with the USPTO.

152 See Examination Guide, supra note 94.
protection and registration to marks.

Additionally, the USPTO requires that domain name marks that have misspellings disclaim the correct spelling of the mark. For example, <groceristore.com>, with an 'i' in place of the 'y,' would have to disclaim the mark <grocerystore.com>. The end result is that marks that are merely descriptive or generic cannot avoid refusal of registration on the Principal Register simply because they are misspelled. A mark owner could argue that the misspelled mark is not generic or descriptive because it is not exactly the same as the generic or descriptive term.

With descriptive terms, a misspelling could also mean that the mark is not truly descriptive of the services or goods. This argument fails because the public recognizes the misspelling and knows that the owner's intention is to convey the meaning of the correctly spelled term. This observation is particularly relevant with respect to domain names because use of a misspelled name is usually the result of the correctly spelled domain name being taken by another.

One would think that based on the Examination Guide, the USPTO would adhere to the principles enumerated therein regarding the ability to register generic or descriptive domain names. However, the mark <dogtoys.com> is registered on the Principal Register. <dogtoys.com> is a generic, or at best, descriptive mark. If <dogtoys.com> is descriptive, it is unlikely that the mark has already attained a secondary meaning because the mark has only been in existence for a short time. <dogtoys.com> has only been registered since 1999 and the <www.dogtoys.com> web site has only existed since 1997. Other examples of merely descriptive or generic marks on the Principal Register include <books.com> and <attorney.com>. One possible reason for these seemingly impermissible registrations is that the USPTO released the Examination Guide in September 1999 and it may take time for the

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153 Id.
154 Mark is registered as a trademark for 'dog toys.' Registration Number 2,280,914; Serial Number 75,460,980.
155 Mark is registered as a service mark for "computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics on books; ... computerized on-line ordering services in the field of books ... providing information about books, authors, and new book releases via a global computer network." Registration Number 2,223,338; Serial Number 75,224,119.
156 Mark is registered as a service mark for "electronic transmission and reception of data, messages and documents via computer terminals; telecommunication services, namely, establishing a gateway link between companies and individuals to various global computer networks." Registration Number 2,401,116; Serial Number is 75,799,836.
guidelines to become established practice for trademark examiners.

B. Domain Names and Phone Numbers

There is little case law on trademark protection of generic or descriptive domain names. The most logical analogy to resolve the dilemma of generic and descriptive domain names is to compare how trademark law has been applied to vanity phone numbers. A vanity phone number is one in which a combination of letters spell a word corresponding to one's telephone number on the phone touch pad. An example is 1-800-L-A-W-Y-E-R-S, which corresponds to the phone number 1-800-529-9377. Vanity phone numbers are similar to domain names because they serve as a locator but also can function as a mark to identify services, just as a domain name serves as a locator on the Web and as a mark to identify services.

1. Registration of Vanity Phone Numbers as Applied to Domain Names

The USPTO does not give any trademark significance to the toll free dialing prefix, that is, phone numbers beginning with 800, 888 or 877. Thus, generic or descriptive marks added to a toll-free dialing prefix cannot obtain trademark protection or registration on the Principal Register. In the above example, 1-800-L-A-W-Y-E-R-S would only become registerable after acquiring secondary meaning because the 1-800 portion has no trademark significance and L-A-W-Y-E-R-S is merely descriptive. The courts justify this approach because it is a functional requirement to have the prefix for the mark to also exist as a toll free phone number.

Further, the 800, 888 and 877 prefixes force consumers to look at the mark as a phone number and not as a way to distinguish the applicant's goods and services. Lastly, allowing businesses to preclude others from using a generic or descriptive term with 888, 877 or 800 would have an adverse affect on competition in the

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158 See TMEP, supra note 97, §1209.01(b)(12) (1999). Yet, even when marks look like phone numbers such as '800 spirits' and are not actually phone numbers, trademark significance is not given to the mark. See 800 Spirits Inc. v. Liquor By Wire, 14 F. Supp. 2d 675 (D. N.J. 1998).
159 See TMEP, supra note 97, § 1209.01(b)(12) (1999).
160 See 800 Spirits Inc., 14 F. Supp. 2d 675.
161 See In re Joseph Edward Page, 51 U.S.P.Q.2d 1660, 1664-65 (T.T.A.B. 1999). The sole dissenter refused to accept this analysis because the application for '888 Patents' was based on an intent to use and it would be unfair to ignore the 888 portion of the mark until specimens of use show that the mark was only used as a phone number. Id.
Other businesses would be unable to have a toll free number describing their similar services.\textsuperscript{163} In the\emph{ Examination Guide}, the USPTO applied the same rules concerning the registration of vanity phone numbers to the registration of domain names.\textsuperscript{164} When reviewing applications for marks comprised of generic or descriptive domain names, the USPTO will consider ‘www,’ the TLD and ‘http://’ to be equivalent to the toll free prefixes of phone numbers because they are all functional components.\textsuperscript{165} Therefore, these portions will not be given any trademark significance and must be disclaimed.\textsuperscript{166}

2. Trademark Protection of Vanity Phone Numbers as Applied to Domain Names

Despite USPTO policy that generic and merely descriptive vanity phone numbers and domain names may not be registered on the Principal Register, three courts have allowed for trademark protection of vanity phone numbers consisting of arguably generic terms.\textsuperscript{167} In\emph{ Dial-A-Mattress Franchise Corp. v. Page}, the Second Circuit affirmed a preliminary injunction preventing Page from advertising the 1-800-M-A-T-T-R-E-S-S vanity phone number in New York City where Dial-A-Mattress Franchise Corporation had been using and advertising the local vanity phone number 1-212-M-A-T-T-R-E-S.\textsuperscript{168}

Although M-A-T-T-R-E-S is arguably generic, the Second Circuit allowed protection of the term. The rationale for allowing trademark protection of the generic term was that trademark protection only affected telephone-based promotion and not other areas of advertising. Eight months later, Dial-A-Mattress Franchise

\textsuperscript{162} See\emph{ 800 Spirits Inc.}, 14 F. Supp. 2d at 680.
\textsuperscript{163} See id. at 680-81.
\textsuperscript{164} See\emph{ Examination Guide}, supra note 94.
\textsuperscript{165} See id.
\textsuperscript{166} An examiner can require unregisterable portions of marks to be disclaimed per 15 U.S.C.A. § 1056(a) (West 1997 & Supp. 2000). Yet if the mark comprises of an inherently distinctive term, the TLD, ‘www’ and ‘http://’ need not be disclaimed.
\textsuperscript{168} See\emph{ Dial-A-Mattress Franchise Corp.}, 880 F.2d 675. Although toll free numbers are comprised of eleven digits, the defendant advertised the twelve-digit number because dialing the extra number corresponding to the last ‘S’ in M-A-T-T-R-E-S-S does not affect completion of the call.\emph{ Id.}
Corporation registered the mark M-A-T-T-R-E-S on the USPTO’s Principal Register.\(^{169}\)

In a recent case on appeal from the Trademark Trial and Appeal Board, the Federal Circuit Court of Appeals determined that the vanity phone number 1-888-M-A-T-T-R-E-S, owned by Dial-A-Mattress Operating Corporation, was entitled to registration on the Principal Register.\(^{170}\) The Federal Circuit stressed that the test to determine whether a mark is generic is to look at the commercial impression of the mark as a whole.\(^{171}\) When applying this test, the court found that 1-888-M-A-T-T-R-E-S was not generic because the relevant public did not refer to shop at home telephone mattress retailers only as 1-888-M-A-T-T-R-E-S.\(^{172}\)

The Federal Circuit ultimately determined 1-888-M-A-T-T-R-E-S eligible for registration on the Principal Register because the mark was descriptive and had acquired secondary meaning.\(^{173}\) The court concluded that 1-888-M-A-T-T-R-E-S had acquired secondary meaning because it was the "legal equivalent" to the previously registered mark 1-212-M-A-T-T-R-E-S.\(^{174}\)

The 2001 Federal Circuit and 1989 Second Circuit decisions drastically conflict with USPTO policy and other case law. The Trademark Manual of Examining Procedure (TMEP) states that marks consisting of a merely descriptive or generic term with a numeral in the form of a telephone number should be refused registration.\(^{175}\) This rule in the TMEP seems to carve out a special test to determine if a vanity phone number is generic. Since this rule is targeted specifically for vanity phone numbers, it is inconsistent for

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\(^{172}\) In re Dial-A-Mattress Operating Corp. at *3-4. The court applied the same test that is applied to composite marks discussed above.

\(^{173}\) Id. at *5.

\(^{174}\) Marks that are the 'legal equivalent' or the 'same mark' as a previously registered trademark may rely on the formerly registered mark for prima facie evidence of distinctiveness. See 37 C.F.R. § 2.41(b) (2001). Trademark registration for the mark 212-M-A-T-T-R-E-S was obtained Mar. 27, 1990, and was assigned trademark registration number 1,589,453. It is likely that this trademark registration was granted simply because the Second Circuit had given trademark protection to the mark eight months earlier in Dial-A-Mattress Franchise Corp. v. Page.

\(^{175}\) See TMEP, supra note 97, § 1209.01(b)(12).
the court in *Dial-A-Mattress* to ignore it and apply a test for other types of marks.

Another example is *Dranoff-Perlstein Assoc. v. Sklar*, where personal injury attorneys tried to obtain trademark protection for a vanity phone number corresponding to the generic word 'INJURY'.176 The Third Circuit found that vanity phone numbers corresponding to generic terms did not warrant trademark protection because it would prevent competitors from calling a personal injury practice by its name.177 The court also stated that if the marks were descriptive with a secondary meaning, traditional trademark infringement analysis under the Lanham Act could be applied.178

The conflicting decisions regarding descriptive and generic vanity phone numbers as applied to domain names presents additional concerns. Since the 800, 877 or 888 portions of vanity phone numbers are equivalent to the 'http://' and 'www' portions of domain name marks, it is likely that these exact cases will be evaluated in a case involving trademark protection for a domain name.

If a case were filed in the Federal or Second Circuit where the *Dial-A-Mattress* decisions are followed, a court could determine that <business.com> infringes <business.net> under the Lanham Act, despite the fact that neither mark is capable of being registered on the Principal Register according to the TMEP. In fact, the court under the same reasoning, may enjoin the word 'business' for use in the domain name and advertising of the domain name just as courts enjoined use and advertising of the generic vanity phone number 1-800-M-A-T-T-R-E-S-S.179

This analogy, if ever utilized by the courts, would establish exclusive use of a series of domain names based on priority of obtaining the first generic or descriptive domain name. It is therefore possible that a court could enjoin use of the <business.net>, <business.org>, <businessonline.com> and <businessonline.net> domain names all in favor of <business.com> because it attained priority. This contemplated result would render a monopoly to those who use generic or descriptive domain names. Competitors would be forbidden from using the very words that the general public uses to

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177 See id. See also *Kellogg Co. v. Natl. Biscuit Co.*, 305 U.S. 111, 119 (1938) ("Like other members of the public, [defendant] . . . was . . . free . . . to call the product by its generic name.") (Brandeis, J).

178 See *Dranoff-Perlstein Assoc.*, 967 F.2d at 859-62.

describe products.

It can be argued that if an injunction is issued against a particular domain name, category of domain names or use of a word in a domain name, customers could still use the IP address to contact the service on the Internet. This is unlikely to yield the same result as prohibiting promotion of a word combination in vanity phone number advertisements because the public is unfamiliar with the concept of IP addresses as a means of locating a web site. The concept that the IP address is a complicated equivalent to the numeric version of a vanity phone number is not general knowledge. Also, IP addresses are hard to remember. For the reasons mentioned above, courts should apply the Sklar case and the appropriate TMEP rules to generic and descriptive domain name trademark disputes.

C. Radio Station Frequencies and Domain Names

Another domain name analogy is the application of trademark and unfair competition law to the use of radio station frequencies as service marks. This analogy is useful because radio frequencies are locations on the airwaves and serve to identify the source of the service on the airwaves. Radio stations are required to identify themselves at least once each hour by either their call letters or their frequency number. A station's call letters might be WYEN at a frequency of 106.7. Radio stations often prefer to identify themselves only by their frequency number and often round to the nearest whole number. In the above example, WYEN might identify itself on the radio as only '107.' As such, stations seek—and can—register and receive trademark protection for the frequency number.

In order to be protected as marks, radio station frequency numbers must adhere to the same requirements as other marks. The

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100 See 47 C.F.R. § 73.1201(a) (2000).
101 See Walt-West Enters., Inc. v. Gannett Co., 695 F.2d 1050 (7th Cir. 1982) (using 107 in its identification announcement, plaintiff alleged several unfair competition and infringement claims against the defendant using 107 as their identification frequency; both plaintiff and defendant had the actual frequencies of 106.7 and 107.5, respectively, and rounded to 107 when identifying themselves).
102 See id. See also Covenant Radio Corp. v. Ten Eighty Corp., 390 A.2d 949 (Conn. Super. Ct. 1977) (seeking temporary injunction against defendant for using the same number, 96, in promoting their radio station; plaintiff had the frequency of 95.7 and the defendant had the frequency of 96.5).
103 See Walt-West Enters., Inc., 695 F.2d 1050.
104 See id. at 1058.
105 These requirements were explained earlier: use in commerce, identify and distinguish the
most common obstacles for both radio station frequencies and domain names is to establish that the marks serve to identify and distinguish the source of the services and that the mark is inherently distinctive.

Terms, symbols or features performing utilitarian purposes are not entitled to protection as trademarks because these marks are usually categorized as merely descriptive. In *Covenant Radio Corp. v. Ten Eighty Corp.*, the plaintiff sought trademark protection against the defendant for advertising the same frequency of '96.' The court reasoned that the use of '96' was to facilitate listener access on the FM band instead of pointing to ownership or origin of the radio station. The use of '96' with the words 'FM Stereo' further connoted that the nature of the service found at 96 was a radio station instead of identifying the source of the radio service as WKSS radio station. Therefore, the court found the mark '96,' when used in conjunction with call letters and 'FM Stereo' was both descriptive and utilitarian. Ultimately, the court denied the plaintiff any trademark rights in the mark since it had yet to acquire secondary meaning.

This precedent, as it pertains to radio station frequencies, could be damaging if applied to domain names. An owner trying to register the descriptive mark <88¢store.com> might find that a court regards the <.com> or other TLD as purely utilitarian as the '96' in the above case. As discussed earlier, the TLD denotes what kind of entity owns the web site—a company, organization and so on. Additionally, since there are a limited number of TLDs, the strength of the court's argument that the TLD is utilitarian is enhanced. The limited number of TLDs cuts down on the availability of domain names and thus causes the TLD to serve as more of a locator or utilitarian device than a symbol or term chosen for the particular mark.

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source of the goods or services and be inherently distinctive.

186 See *Covenant Radio Corp.*, 390 A.2d 949, 953.
187 See id.
188 See id.
189 See id.
190 See id.
191 See id.
192 88¢ Stores, Inc. v. Martinez, 361 P.2d 809 (Or. 1961) (finding mark '88¢ Store' descriptive with no secondary meaning). As discussed above, adding <.com> to '88¢ Store' does not change its status as descriptive mark.
193 If more TLDs are approved by ICANN, then the mark as a whole will still appear utilitarian because the entity represented by the TLD is even more specific, despite the availability of additional TLDs.
This analogy is especially relevant to those marks that border between the categories of descriptive and suggestive such as <moneystore.com>. If the precedent regarding radio stations were applied, it would confuse matters as the term 'moneystore' alone may be considered suggestive and would therefore be allowed to keep the TLD as part of the mark. Yet, adding the TLD to the mark may enhance its descriptiveness and thus prevent it from attaining immediate trademark protection as in Covenant Radio Corp. Use of the descriptive number '96' with the call letters of the radio station, an arbitrary service mark, rendered the term '96' descriptive and not subject to trademark protection. With respect to domain names, the TLD would specify what type of entity the Money Store is, thereby increasing the chance that protection or registration will be withheld. In short, if an applicant is registering a domain name that borders between the descriptive or suggestive categories, it would be wise to disclaim the TLD to avoid a finding that the mark as a whole is descriptive.

It is possible that the analogy to radio station frequency numbers is misplaced. Unlike radio station frequencies, uniform resource locators have two identifying sources: the domain name and the IP address. As such, the IP address should only be regarded as the device serving as the locator on the Web. The domain name serves as the title for the web site and Internet business making it conceptually separate from the IP address or locator. This viewpoint would support the precedent regarding the inability to register or protect radio station frequencies because of their utilitarian characteristics inapplicable.

Radio frequencies are purely utilitarian when used in practice while domain names used in practice are titles for web sites and businesses; making them an indicator of source and not purely utilitarian. This distinguishes the precedent in radio frequency disallowing trademark protection and prevents it from applying to domain names in general. Although the analogy associated with radio station frequencies is distinguished, the Examination Guide still creates a hurdle for generic or merely descriptive domain names seeking registration on the Principal Register or trademark protection.

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194 See The Moneystore v. Harriscorp Fin., Inc., 689 F.2d 666, 673-74 (7th Cir. 1982).
195 See generally Examination Guide, supra note 94.
197 The uniform resource locator is equivalent to the term 'web address.'
V. CONCLUSION

When eCompanies purchased <business.com>, it sought a domain name that would stick in the consumer's mind and be easy to market. Although eCompanies accomplished the task of picking a memorable domain name for $7.5 million, it did not acquire a mark clearly capable of protection under the Lanham Act. Was $7.5 million a wise price to pay when a competitor could buy <business.net> for $30 from a domain registry service? For eCompanies, and other Internet businesses who make the mistake of choosing a domain name deemed descriptive or generic, there seems to be little that they can do to gain trademark protection for their domain name.

Traditional principles of trademark and unfair competition law as applied to generic and descriptive domain names afford little protection and only a slim chance at registration on the Principal Register. Drawing analogies to vanity phone numbers and radio station frequencies may seem promising in some areas, but overall the law seems to indicate a dismal future and an uphill battle for protection of descriptive and generic domain names. Based on the foregoing analysis, it is unlikely that the average dot-commer will have the ability to prevent others with similar generic or descriptive domain names from diverting customers away.