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## Who Are You? Difficulties in Obtaining Trademark Protection for Domain Names

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WHO ARE YOU?  
DIFFICULTIES IN OBTAINING TRADEMARK PROTECTION  
FOR DOMAIN NAMES

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ABSTRACT

*Three appellate decisions illustrate the difficulty of acquiring trademark protection for domain names that include a top-level domain (“TLD”), such as “.com.” Courts have characterized these marks as generic or merely descriptive, which carries implications for the party seeking registration: generic marks cannot be protected, while descriptive marks can, assuming they possess a secondary meaning that makes the mark distinctive. Generic and descriptive domain names often indicate the services a company provides, with the addition of the “.com” TLD to indicate online services. One key test of genericness is whether the public identifies the mark with a service generally or with a company specifically. This Article examines the rationales supporting the generic-descriptive distinction for domain names with TLDs. When a website does more than merely sell a product online that could be obtained in a brick and mortar store—such as providing additional consumer tools and flexibility unique to the online medium—the domain name has an increased chance of being viewed as descriptive and potentially protectable.*

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## INTRODUCTION

Several recent federal appeals court opinions have denied federal trademark protection to online domain names such as “STEELBUILDING.COM,” “MATTRESS.COM,” and “ADVERTISE.COM,” citing their generic nature or lack of descriptiveness.<sup>1</sup> In the process, the courts have blurred the distinction between generic and merely descriptive marks. Generic terms that describe what the service is, instead of who provides the service, rarely gain protection through the addition of the top-level domain (“TLD”) “.com” as part of a domain name. Generic marks cannot be registered under trademark law. Descriptive marks must

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<sup>1</sup> See *In re Steelbuilding.com*, 415 F.3d 1293, 1301 (Fed. Cir. 2005); *In re 1800MATTRESS.COM IP, LLC*, 586 F.3d 1359, 1364 (Fed. Cir. 2009); *Advertise.com, Inc. v. AOL Advertising, Inc.*, 616 F.3d 974, 982 (9th Cir. 2010).

have a secondary meaning that identifies the source of the service, as recognized by the consuming public, for possible federal trademark protection. The addition of a TLD does not enhance the potential trademark protection of generic or descriptive domain names, but the possibility of new TLDs such as “.sports” or “.law” will present new frontiers for possible trademark registration.

This Article provides a brief overview of trademark distinctiveness and standards of review, and then examines the rationales behind three federal appellate court decisions, including two registration appeals and one trademark infringement appeal. Next, the Article attempts to synthesize what factors a court might consider when categorizing a domain name as generic or descriptive. Finally, the Article considers the recent announcement that the universe of TLDs will soon be expanded significantly.

## I. TRADEMARK DISTINCTIVENESS OVERVIEW

Marks are generally classified in one of four categories: generic, descriptive, suggestive, or arbitrary/fanciful.<sup>2</sup> These “lines of demarcation, however, are not always bright,” and a “term may shift from one category to another in light of differences in usage through time.”<sup>3</sup>

A generic term is one that “refers, or has come to be understood as referring, to the genus of which the particular product is a species.”<sup>4</sup> A generic term, by definition, identifies a type of product, not the source of the product.<sup>5</sup> Generic terms are not entitled to legal protection.<sup>6</sup> A generic term “cannot function as an indicator of the source of a product . . . because the relevant

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

<sup>3</sup> *Id.*

<sup>4</sup> *Id.*

<sup>5</sup> *In re Gould Paper Corp.*, 834 F.2d 1017, 1018 (Fed. Cir. 1987); see also Thomas L. Casagrande, *Of Lawyers, Hotels, and Mattresses: The Federal Circuit's Ever-expanding Genericness Test for [Thing].com Marks*, 3.1 LANDSLIDE, Sept./Oct. 2010, [http://www.americanbar.org/content/dam/aba/migrated/intelprop/magazine/LANDSLIDE\\_Sept2010\\_Casagrande.authcheckdam.pdf](http://www.americanbar.org/content/dam/aba/migrated/intelprop/magazine/LANDSLIDE_Sept2010_Casagrande.authcheckdam.pdf).

<sup>6</sup> *Abercrombie*, 537 F.2d at 9.

public understands the term primarily as the common name for the product.”<sup>7</sup> As distinguished from descriptive marks, generic terms cannot be saved even by proof of secondary meaning.<sup>8</sup> Courts deny trademark protection for generic marks because a trademark cannot deprive competing manufacturers of “the right to call an article by its name.”<sup>9</sup>

A non-generic mark that is deemed “merely descriptive,” because it describes a good or service, will likewise not receive trademark protection.<sup>10</sup> Protecting merely descriptive marks would “confer a monopoly not only of the mark but of the product by rendering a competitor unable effectively to name what it was endeavoring to sell.”<sup>11</sup> Yet descriptive marks may qualify for registration if they acquire “secondary meaning,” or distinctiveness.<sup>12</sup> To show that a mark has acquired distinctiveness, the applicant must demonstrate that “the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or service itself.”<sup>13</sup>

The third category, “suggestive” marks, is difficult to define. One court observed that a term is suggestive if it requires “imagination, thought, and perception to reach a conclusion as to the nature of the goods.”<sup>14</sup> Judge Learned Hand remarked, “the validity of the mark ends where suggestion ends and description begins.”<sup>15</sup> “If a term is suggestive, it is entitled to trademark

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<sup>7</sup> *In re Steelbuilding.com*, 415 F.3d 1293, 1296 (Fed. Cir. 2005) (citing *In re Dial-A-Mattress*, 240 F.3d 1341, 1344 (Fed. Cir. 2001)).

<sup>8</sup> *Abercrombie*, 537 F.2d at 9.

<sup>9</sup> *Id.* (citing *J. Kohnstam, Ltd. v. Louis Marx and Co.*, 280 F.2d 437 (C.C.P.A. 1960)).

<sup>10</sup> *Abercrombie*, 537 F.2d at 10.

<sup>11</sup> *Id.*

<sup>12</sup> 15 U.S.C. § 1052(f) (2006); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).

<sup>13</sup> *In re Steelbuilding.com*, 415 F.3d 1293, 1297 (Fed. Cir. 2005) (citing *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 163 (1995)).

<sup>14</sup> *Stix Products, Inc. v. United Merchants & Manufacturers Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968).

<sup>15</sup> *Franklin Knitting Mills, Inc. v. Fashionit Sweater Mills, Inc.*, 297 F. 247, 248 (2d Cir. 1923), *aff’d per curiam*, 4 F.2d 1018 (2d Cir. 1925).

protection without proof of secondary meaning.”<sup>16</sup> If the U.S. Patent and Trademark Office (“USPTO”) registers a mark without requiring proof of secondary meaning, there is “a rebuttable presumption that the mark is suggestive or arbitrary/fanciful, instead of merely descriptive.”<sup>17</sup>

“Arbitrary” or “fanciful” terms enjoy the trademark protection of suggestive terms, but are not subject to a “merely descriptive” analysis.<sup>18</sup> Fanciful, as a “classifying concept,” is “usually applied to words invented solely for their use as trademarks.”<sup>19</sup> Arbitrary categorization can apply to common words used in an unfamiliar way.<sup>20</sup> For example, “Apple” is an arbitrary mark for a company that makes computers.<sup>21</sup>

## II. REGISTRATION/APEALS PROCESS AND STANDARD OF REVIEW

### A. Trademark Registration Appeals

The Trademark Trial and Appeal Board (“TTAB”) makes factual determinations of whether an asserted mark is generic.<sup>22</sup> The TTAB is an administrative adjudicative body that hears appeals from final registration decisions of trademark examiners.<sup>23</sup> To deny the registration of a mark as generic, the USPTO has the burden of “substantially showing . . . that the matter is in fact generic . . . based on clear evidence of generic use.”<sup>24</sup>

When a plaintiff receives a federal trademark registration from the USPTO, she is entitled to a presumption that the mark is

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<sup>16</sup> *Abercrombie & Fitch, Co., v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976).

<sup>17</sup> *Id.*

<sup>18</sup> *Id.*

<sup>19</sup> *Id.* at n.12.

<sup>20</sup> *Id.*

<sup>21</sup> *See Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1041 (2d Cir. 1992) (citing 1 J.T. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 11:22, at 498-99 (2d ed. 1984)).

<sup>22</sup> *In re Pennington Seed, Inc.*, 466 F.3d 1053, 1056 (Fed. Cir. 2006).

<sup>23</sup> 15 U.S.C. § 1070 (West 2010); *see also* Casagrande, *supra* note 5.

<sup>24</sup> *In re Am. Fertility Soc’y*, 188 F.3d 1341, 1346 (Fed. Cir. 1999) (quoting *In re Merrill Lynch, Fenner and Smith, Inc.*, 828 F.2d 1567 (Fed. Cir. 1987)).

valid.<sup>25</sup> Once registered, the trademark owner has the exclusive right to use the mark in commerce in connection with the goods or services specified in registration.<sup>26</sup> This presumption of validity can be rebutted with a showing by a preponderance of the evidence that the mark is not protectable.<sup>27</sup>

The Federal Circuit has appellate jurisdiction over TTAB's registration decisions.<sup>28</sup> The Federal Circuit reviews the TTAB's legal conclusions *de novo* and its factual findings for substantial evidence.<sup>29</sup> Substantial evidence is defined as "more than a mere scintilla" and "such relevant evidence as a reasonable mind would accept as adequate" to support a conclusion.<sup>30</sup>

### B. Trademark Infringement Appeal

A federal court of appeals reviews a district court's ruling on a matter of law under the *de novo* standard.<sup>31</sup> Whether "secondary meaning" exists is reviewed under the "clearly erroneous" standard.<sup>32</sup> To prevail on an infringement claim, the plaintiff must demonstrate (1) rights in a mark, (2) priority in the mark over the defendant's rights, and (3) a "likelihood of confusion" as a result of the offending mark. "Likelihood of confusion" is a mixed question of law and fact, which is reviewed under the "clearly erroneous" standard.<sup>33</sup>

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<sup>25</sup> *555-1212.com, Inc. v. Comm. House Int'l, Inc.*, 157 F. Supp. 2d 1084, 1088 (N.D. Cal. 2001); *see* 15 U.S.C. § 1057(b) (West 2010).

<sup>26</sup> *555-1212.com*, 157 F. Supp. 2d at 1088.

<sup>27</sup> *See Vuitton Et Fils S.A. v. J. Young Enterprises, Inc.*, 644 F.2d 769, 776 (9th Cir. 1981).

<sup>28</sup> 15 U.S.C. § 1071(a)(1) (2010).

<sup>29</sup> *In re Pacer Tech.*, 338 F.3d 1348, 1349 (Fed. Cir. 2003).

<sup>30</sup> *Id.* (quoting *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938)).

<sup>31</sup> *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1355 (9th Cir. 1985).

<sup>32</sup> *Id.*

<sup>33</sup> *Id.* ("Likelihood of confusion is the type of mixed question which fits within the categories suggested in *McConney* as suited to clearly erroneous review—cases not implicating constitutional rights and those 'in which the applicable legal standard provides for a strictly factual test, such as state of mind.'") (citing *United States v. McConney*, 728 F.2d 1195 (9th Cir.) (en banc), *cert. denied*, 469 U.S. 824 (1984)).

### III. *STEELBUILDING.COM*: DESCRIPTIVE, BUT LACKING SECONDARY MEANING

Businesses operating online face significant challenges when trying to gain trademark protection for their domain names. Many commercial websites allow consumers to access inventory or services available in brick and mortar stores. Some businesses, however, use the Internet as a vehicle to offer additional services unique to the online forum. The *Steelbuilding* court confronted whether a domain name could be trademarked for a business that involved the development and construction of steel buildings, but also allowed its customers to design and view their buildings in an online environment.<sup>34</sup> The Federal Circuit vacated the TTAB determination that the mark “STEELBUILDING.COM” was generic, but affirmed the TTAB’s finding that the mark is merely descriptive without secondary meaning, and thereby denied trademark protection.<sup>35</sup>

#### A. *Generic Mark Test*

To determine whether the mark was generic, the court applied a two-prong test: first, the court determined the “genus” of goods or services at issue; second, the court analyzed whether the term sought to be registered is understood by the relevant public “primarily to refer to that genus of goods or services.”<sup>36</sup>

The court first determined what core services the business provided. The company sold steel building materials online, but it also provided services that extended beyond mere sales: users could design and purchase their own unique buildings online.<sup>37</sup> Its online catalogue permitted users to determine an appropriate price for their building designs, facilitating users’ construction of their buildings in a flexible and fluid online environment.<sup>38</sup> Importantly,

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<sup>34</sup> *In re Steelbuilding.com*, 415 F.3d 1293 (Fed. Cir. 2005).

<sup>35</sup> *Id.* at 1296.

<sup>36</sup> *Id.* at 1296-97 (citing *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs*, 782 F.2d 987, 990 (Fed. Cir. 1986)).

<sup>37</sup> *Id.* at 1298.

<sup>38</sup> *Id.*



the court noted that the website was more than a “shopping guide” that listed materials and prices.<sup>39</sup> As a “STEELBUILDING.COM” user developed a building design online, the program “recalculate[d] design elements as necessary to meet codes and other engineering requirements.”<sup>40</sup> What the website really offered was a software program that helped users meet economic, regulatory, and aesthetic constraints.<sup>41</sup> Potential purchasers could compare prices of different designs and decide which one best fit their needs.<sup>42</sup>

The Federal Circuit determined that the TTAB failed to acknowledge “the interactive design feature of the applicant’s goods and services.”<sup>43</sup> As such, the court concluded the TTAB misunderstood the proper genus for “STEELBUILDING.COM,” having defined it as “the sale of pre-engineered ‘steel buildings’ on the Internet.”<sup>44</sup> Sale of steel buildings was a significant component of the service, but so was the interactive design feature of the website.<sup>45</sup> This mischaracterization of the genus required the Federal Circuit to vacate the TTAB’s decision to deny registration on generic grounds.<sup>46</sup>

### *B. Examining the Entire Mark, Including the TLD*

The Federal Circuit also reviewed the TTAB’s analysis of the compound word “steelbuilding” and its bifurcation of “STEELBUILDING.COM” into two separate marks: the compound word “steelbuilding” and the TLD indicator “.com.” In a previous case, the Federal Circuit observed that trademark registration could be denied where there was substantial evidence of “separate words joined to form a compound [that has] a meaning identical to the meaning common usage would ascribe to

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<sup>39</sup> *Id.*

<sup>40</sup> *Id.* at 1298.

<sup>41</sup> *Id.*

<sup>42</sup> *Id.*

<sup>43</sup> *Id.* at 1297.

<sup>44</sup> *Id.* at 1298.

<sup>45</sup> *Id.*

<sup>46</sup> *Id.*

those words as a compound.”<sup>47</sup> The court referenced the attempted registration of “screenwipe” for a product defined by the applicant as a “wipe” for “screens”—the mark was rejected because the terms “remain[ed] as generic in compound as individually.”<sup>48</sup> Yet here, the record did not show that “steelbuilding,” as a compound word, meant the same thing as the generic words “steel” and “building.”<sup>49</sup> No dictionary definitions or other sources suggested that joining the separate words “steel” and “building” would create a generic word.<sup>50</sup> The Federal Circuit therefore held that the TTAB did not sufficiently weigh the ambiguities and multiple meanings of the composite word.<sup>51</sup> In other words, “steelbuilding” could be more than just a composite noun of the adjective “steel” and noun “building.” Instead, “steelbuilding” could function as a verb, fitting the unique services provided on the website: it allowed users to “steelbuild.”

Second, the court found the TTAB did not adequately consider the entire mark including the TLD indicator. The Federal Circuit acknowledged the general rule that only in “rare instances” will the addition of a TLD indicator to a descriptive term operate to create a distinctive mark.<sup>52</sup> The TLD must still be weighed, however, as the addition of “.com” added meaning to the mark because it showed “Internet-related distinctiveness, intimating some ‘Internet feature.’”<sup>53</sup> The TLD “.com” expanded the mark to “include Internet services that include ‘building’ or designing steel structures on the website and then calculating the appropriate price before ordering the unique structure.”<sup>54</sup> Again, the possible usage of “steelbuilding” as a verb denoting online services defeated denial of registration on generic grounds.

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<sup>47</sup> *In re Gould Paper Corp.*, 834 F.2d 1017, 1018 (Fed. Cir. 1987).

<sup>48</sup> *Id.* at 1019.

<sup>49</sup> *Steelbuilding*, 415 F.3d at 1299.

<sup>50</sup> *Id.* at 1298-99.

<sup>51</sup> *Id.*

<sup>52</sup> *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1175 (Fed. Cir. 2004).

<sup>53</sup> *Id.* at 1175-76.

<sup>54</sup> *Steelbuilding*, 834 F.3d at 1299.

*C. “STEELBUILDING.COM” Is Merely Descriptive*

Although the Federal Circuit vacated the generic analysis of the TTAB, it held that the record showed “STEELBUILDING.COM” was merely descriptive of the online services provided and devoid of secondary meaning.<sup>55</sup> Based on evidence from features listed on the website and in the applicant’s own advertisements, the Federal Circuit agreed with the TTAB’s conclusion that the sale of steel buildings was a significant feature of the applicant’s services.<sup>56</sup> Considering the impact of the TLD indicator, the Federal Circuit concluded that adding “.com” simply identified that the services were provided in an online environment.<sup>57</sup> In terms of descriptiveness, the record showed that a consumer would recognize the compound word “steelbuilding” as indistinguishable from the phrase “steel buildings,” meriting denial of registration.<sup>58</sup> The burden for showing the mark had acquired secondary meaning was on the applicant, whose advertising efforts and name recognition polling failed to show the mark had acquired distinctiveness.<sup>59</sup>

Ultimately, the Federal Circuit was not convinced that “steelbuilding” sufficiently led consumers to think of the specific applicant’s business. The dissenting opinion argued that the domain name was more than a mere address, and that recognition of the domain name was potentially a form of source identification.<sup>60</sup> In other words, the domain name would be distinctive as it communicated information regarding the source or the sponsor of the site. The dissent argued the TTAB did not

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<sup>55</sup> *Id.* at 1300.

<sup>56</sup> *Id.* at 1299.

<sup>57</sup> *Id.* at 1300.

<sup>58</sup> *Id.* The possibility of a “double entendre” must be validated by consumer appreciation of such an interpretation. The Federal Circuit would later use similar language in discussing “MATTRESS.COM,” observing that Dial-A-Mattress “presented no evidence that the relevant public finds such a double entendre.” *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359,1364 (Fed. Cir. 2009). However, it is unclear how “mattress” could have ever been construed to contain a double entendre.

<sup>59</sup> *Steelbuilding*, 834 F.3d at 1300-01.

<sup>60</sup> *Id.* at 1301.

properly weigh the advertising efforts and other evidence of customer recognition.<sup>61</sup> Instead of affirming, the dissent would have remanded to consider evidence that individuals viewed “STEELBUILDING.COM” as a source identifying the company, not just the product.<sup>62</sup>

#### IV. *IN RE 1800MATTRESS.COM*: A SIMPLER CASE OF GENERICNESS

Four years later, the Federal Circuit affirmed the TTAB’s denial of registration for a domain name purely on grounds that the name was generic.<sup>63</sup> In its evaluation of “MATTRESS.COM,” the court did not entertain the possibility of a descriptive category or secondary meaning.<sup>64</sup>

The TTAB found that the genus of the mark was online retail store services in the field of mattresses, beds, and bedding.<sup>65</sup> Reasoning that “MATTRESS.COM” would be understood by the relevant public primarily to refer to that genus, it was a generic term that could never be trademarked.<sup>66</sup> The addition of “.com” did not affect registrability because it did not create any additional meaning.<sup>67</sup> The TTAB did consider whether further services were offered online, but maintained that “even if the term ‘MATTRESS.COM’ might have significance for a different set of services [from those offered at a] brick and mortar store, [it was] irrelevant to whether the term was perceived by the public as naming the genus of services for which registration is sought, i.e., online mattress stores.”<sup>68</sup> Public perception, even if incorrect, affected the TTAB’s generic categorization.

The Federal Circuit agreed that “MATTRESS.COM” was

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<sup>61</sup> *Id.* at 1302.

<sup>62</sup> *Id.* at 1302-03.

<sup>63</sup> *1800Mattress*, 586 F.3d at 1362-63.

<sup>64</sup> *Id.* at 1364.

<sup>65</sup> *Id.* at 1361.

<sup>66</sup> *Id.*

<sup>67</sup> *Id.*

<sup>68</sup> *Id.* at 1362.

generic based on how the relevant public understood the term.<sup>69</sup> The court proceeded to analyze the two components of the mark, “mattress” and the TLD “.com,” and concluded that “MATTRESS.COM,” as understood by the relevant public, was no more than the “sum of its constituent parts, viz., an online provider of mattresses.”<sup>70</sup> Dictionary definitions and other domain names influenced the court’s decision. The Federal Circuit had recently affirmed the TTAB’s denial of a trademark for “hotels.com,” noting that the TTAB gave “controlling weight to the large number of similar uses of ‘hotels’ with a dot-com suffix, as well as the common meaning and dictionary definition of ‘hotels’ and the standard usage of ‘.com’ to show a commercial internet domain.”<sup>71</sup> In this case, even if some of the other websites containing “MATTRESS.COM” in their domain names did not actually sell mattresses online, the fact that many of them did conduct online sales supported the TTAB’s conclusion that the marks are of the same genus.<sup>72</sup> Consumers would then immediately associate “MATTRESS.COM” with a commercial website rendering retail services for mattresses, which is generic.<sup>73</sup>

The court disagreed with the applicant’s contention that “MATTRESS.COM” evoked the quality of comfort in mattresses and maintained that the mark is not a mnemonic.<sup>74</sup> Unlike the possible play on words in *Steelbuilding*, there was no evidence that the relevant public found a double entendre in the term “MATTRESS.COM.”<sup>75</sup> Quoting *Steelbuilding*, the Federal Circuit reiterated that only in “rare instances will the addition of a TLD indicator to a descriptive term operate to create a distinctive mark.”<sup>76</sup> Since the court was not engaging in an analysis of “MATTRESS.COM” as a descriptive term, it is unclear why the court felt it necessary to emphasize this point. There was no

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<sup>69</sup> *Id.*

<sup>70</sup> *1800Mattress*, 586 F.3d at 1363.

<sup>71</sup> *In re Hotels.com*, 573 F.3d 1300, 1306 (Fed. Cir. 2009).

<sup>72</sup> *1800Mattress*, 586 F.3d at 1364.

<sup>73</sup> *Id.*

<sup>74</sup> *Id.*

<sup>75</sup> *Id.*

<sup>76</sup> *Id.* (citing *Steelbuilding*, 415 F.3d 1293, 1297 (Fed. Cir. 2005)).

evidence that the “.com” TLD evoked anything but a commercial Internet domain.<sup>77</sup> As such, the mark was denied trademark protection on genericness grounds.

#### V. *ADVERTISE.COM*: GENERIC CATEGORIZATION IN AN INFRINGEMENT CASE

The registrability of a domain name has also been analyzed in a trademark infringement case. The Ninth Circuit recently addressed trademark protection of AOL’s “ADVERTISING.COM,” concluding that the district court incorrectly determined that the mark was descriptive.<sup>78</sup> The district court had granted a preliminary injunction against Advertise.com on the basis that “ADVERTISING.COM” was a valid descriptive mark.<sup>79</sup> Advertise.com appealed on the grounds that AOL’s “ADVERTISING.COM” mark was generic.<sup>80</sup>

The Ninth Circuit reiterated that “[c]ontext is critical to a distinctiveness analysis . . . [and the level of distinctiveness of a mark] can be determined only by reference to the goods or services that [the mark] identifies.”<sup>81</sup> In this case, the parties did not dispute that the genus of “ADVERTISING.COM” was “online advertising” or “Internet advertising.”<sup>82</sup> The Ninth Circuit looked at the impression conveyed by “advertising” and “.com,”<sup>83</sup> as well as how “ADVERTISING.COM” was understood by the consuming public.<sup>84</sup> Taken separately, the words are clearly generic.<sup>85</sup> But that did not mean the combined mark was generic. In an effort to clarify the distinction between generic and descriptive marks, the court returned to its “familiar” test, asking

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<sup>77</sup> *Id.*

<sup>78</sup> *Advertise.com, Inc. v. AOL Advertising, Inc.*, 616 F.3d 974, 977-78 (9th Cir. 2010).

<sup>79</sup> *Id.* at 976.

<sup>80</sup> *Id.*

<sup>81</sup> *Id.* at 977 (citing *Lahoti v. VeriCheck, Inc.*, 586 F.3d 1190, 1201 (9th Cir. 2009)).

<sup>82</sup> *Id.*

<sup>83</sup> *Id.* at 977-78.

<sup>84</sup> *Id.* at 977-78.

<sup>85</sup> *Id.*

“Who are you/What are you?”<sup>86</sup> In order to gain trademark protection, a descriptive mark must answer “the buyer’s questions, ‘Who are you? Where do you come from? Who vouches for you?’”<sup>87</sup> In contrast, “a [generic] name of the product answers the question, ‘What are you?’”<sup>88</sup> For “advertise.com,” dictionary definitions strongly suggested that the term was generic.<sup>89</sup> Similar to Federal Circuit precedent, the court acknowledged that the addition of “.com” to a mark generally does not strengthen the mark.<sup>90</sup> AOL’s analogy to *Steelbuilding* was inapposite: *Steelbuilding* represented the rare instance where further meaning was acquired once the “.com” was added.<sup>91</sup> But here, the services offered under “ADVERTISING.COM” “remain[ed], at core, the simple provision of online advertising services.”<sup>92</sup>

Furthermore, Advertise.com, the appellant, pointed to 32 separate domain names that incorporated some version of the terms “advertising.com.”<sup>93</sup> Providing trademark protection would have made it much more difficult for such companies to describe their services.<sup>94</sup> Generic marks cannot be trademarked because competitors would be foreclosed from using a “vast array of simple, easy to remember domain names and designations that describe the services provided.”<sup>95</sup> Nevertheless, the court stated that it was not creating a “per se rule against the use of domain names, even ones formed by combining generic terms with TLDs, as trademarks.”<sup>96</sup>

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<sup>86</sup> *Id.* at 978.

<sup>87</sup> *Id.*

<sup>88</sup> *Id.* (citing *Filipino Yellow Pages, Inc., v. Asian Journal Publ’ns Inc.*, 198 F.3d 1143, 1147 (9th Cir. 1999)).

<sup>89</sup> *Advertise*, 616 F.3d at 977-78.

<sup>90</sup> *Id.* at 979 (citing *Brookfield Commc’ns v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1055 (9th Cir. 1999)).

<sup>91</sup> *Id.*

<sup>92</sup> *Id.*

<sup>93</sup> *Id.* at 980.

<sup>94</sup> *Id.* at 981.

<sup>95</sup> *Id.*

<sup>96</sup> *Id.* at 982.

## VI. CASE LAW SYNTHESIS: VERBS, DOUBLE ENTENDRES, AND CONSUMER PERCEPTION

*Steelbuilding* stands out as the one recent case where two generic words combined into a compound, coupled with a TLD indicator, *almost* created a descriptive mark. The failed marks in *1800Mattress* and *Advertise* were generic single words that failed to create a distinctive mark when joined with a TLD. While it is difficult to say that a standard for the descriptiveness of domain names as trademarks has emerged in the federal courts, several factors seem to increase the likelihood that a court will categorize a domain name as descriptive.

First, melding two generic words into a compound word creates the possibility of new meaning that could distinctly identify the company behind the goods or services provided, thereby satisfying the “Who are you?” test. *Steelbuilding* linked an adjective with a noun to create a composite verb, such that the Federal Circuit looked not only at the possibility of selling steel buildings, but alternatively, the actual construction of steel buildings in an online environment. The two words potentially functioned as a verb, thereby moving the mark from purely generic into possibly descriptive.

Second, where a possible double entendre exists, it is much less likely that the mark will be termed generic, and this likelihood decreases further when two generic words are spliced together. The mark in *Steelbuilding* could have been viewed as an adjective and noun or one compound verb, depending on how the words were interpreted. It is much more difficult for this kind of layered meaning to emerge from a single word like “mattress” or “advertising,” which largely remain confined to one part of speech.

Third, there must be evidence of consumer perception of the company itself, not merely the umbrella genus of the goods or services provided. This remains true even if two words are linked to form a new word that is not necessarily generic. Despite the dissent’s objections, *Steelbuilding* failed this test, because its advertising, polling, repeat customers, and other evidence did not convince the court that consumers were targeting the company itself instead of the genus of services. A double entendre was possible, but there was no evidence that consumers actually



considered the mark as a verb.

Fourth, should there be a multitude of other domain names incorporating the same generic word and the same genus of goods or services, courts will look less favorably on the potential distinctiveness of the mark. This is best exemplified in *Advertise*, where giving trademark protection to AOL's mark would have precluded many other companies from using the most logical and immediate term to describe the services offered on their websites. The Ninth Circuit did not believe that when consumers visited "ADVERTISING.COM" they were specifically seeking AOL's advertising services.

Fifth, the addition of the TLD ".com" only adds potential distinctiveness if there is a uniquely interactive, online element to the goods or services provided over the Internet. The mere sale of goods or services on a website does not distinguish the mark from goods or services available in a brick and mortar store. *Steelbuilding* allowed consumers to do things online that they could not do in stores: there were creative elements of design that made the creation of the building more like solving an economic puzzle.

Nevertheless, none of the marks in *Steelbuilding*, *1800Mattress*, or *Advertise* were afforded trademark protection. What is significant is that "MATTRESS.COM" and "ADVERTISING.COM" were found to be generic, meaning that they could never be registered. In contrast, should "STEELBUILDING.COM" eventually acquire secondary meaning that satisfies a court that the mark identifies the company itself, not merely the product offered, it could become a federally registered mark.

## VII. NEW FRONTIERS: ".SPORTS" AND BEYOND

Upcoming expansion of TLDs will provide new trademark opportunities for companies seeking to register of domain names.<sup>97</sup>

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<sup>97</sup> See generally Eric Nuhl & Dennis S. Prah, *The New Generic Top-Level Domain Program: A New Era of Risk for Trademark Owners and the Internet*, 101 TRADEMARK REP. 1757 (2011).

On June 20, 2011, the Internet Corporation for Assigned Number and Names (ICANN) held a landmark vote to allow new domain endings in addition to common endings such as “.com,” “.org,” “.gov,” and “.edu.”<sup>98</sup> Prior to the vote, there were 22 available TLDs.<sup>99</sup> But soon, “people will be able to apply to ICANN to register most any word, in any language, as their domain ending.”<sup>100</sup> Applications will cost at least \$185,000, suggesting that the TLDs will be primarily for large corporations and governments.<sup>101</sup>

How this development will affect trademark registration is unclear, but it certainly opens up new possibilities. While the insertion of a generic noun TLD such as “MATRESS.BEDS” may be no more distinctive than “MATTRESS.COM,” a TLD like “STEELBUILDING.DESIGN” might push the mark into the descriptive category because a specific company’s additional online services would be highlighted by the TLD. Most companies, of course, will not have the financial resources to purchase such a specific TLD. But the availability of a more targeted TLD may create new opportunities for larger companies to trademark domain names that may have previously been deemed generic.

## CONCLUSION

Recent trademark domain name cases demonstrate that courts are reluctant to view marks that are logically related to the genus of the goods or services provided as anything but generic. Should the mark contain a compound word with additional meaning beyond its constituent parts, a double entendre, consumer recognition, minimal overlap with other domain names, or an online, interactive element, the likelihood of registrability as a descriptive mark increases. The courts have not ruled out the possibility of a descriptive domain name gaining distinctiveness to the point where

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<sup>98</sup> Doug Gross, *Explaining the Internet's New Domain Endings*, CNN.COM (June 20, 2011), [http://articles.cnn.com/2011-06-20/tech/domain.names.explainer\\_1\\_icann-domain-names-internet-corporation?\\_s=PM:TECH](http://articles.cnn.com/2011-06-20/tech/domain.names.explainer_1_icann-domain-names-internet-corporation?_s=PM:TECH).

<sup>99</sup> *Id.*

<sup>100</sup> *Id.*

<sup>101</sup> *Id.*

it is protectable.

The possibility of new generic TLDs creates further avenues for distinctiveness (such as if the TLD suggests the unique online services provided), but ultimately, if the TLD remains generic, the same problems arise when trying to pass the “Who are you?” test. A more dynamic universe of TLDs, however, provides further opportunities for the creation of distinctive verbs, wordplay, and double entendres, and the creation of a descriptive mark. Ultimately, if providers of online goods or services desire a registrable mark, they will want to move into the arbitrary/fanciful category. Should they insist on a word that relates to the genus of their goods or services, *Steelbuilding* and other recent cases provide some guidance for shifting the court’s lens from the generic to the descriptive, but also suggest caution regarding the likelihood of success.

#### PRACTICE POINTERS

- Because courts of appeals do not apply a bright line rule when reviewing whether a domain name is generic or descriptive, there is a premium on establishing a fact-intensive record at the trial-court level. These types of cases are won on the facts.
- The importance of building a factual record is reinforced by the relevant standards of review, which are deferential to the factual findings of the TTAB (“substantial evidence” standard) or the trial court (“clearly erroneous” standard).
- The prospect of new, diverse TLDs increases the possibility that a domain name could acquire trademark protection, but this remains an unexplored frontier.